

Patent Cooperation Treaty (PCT) related matters



IP Information Roundtable
Geneva – October 30, 2018

- Speaker: Christine Bonvallet, Head
PCT User Resources Section
PCT Legal and User Relations Division



WIPO | PCT
The International
Patent System

Outline

- PCT Status Report
- PCT Working Group 2018
- PCT Assembly – Oct. 2018 – 1 July 2019 changes
- Transmission of National Phase Entry Data
- PCT Minimum Documentation
- PCT Recent Developments

Patent Cooperation Treaty Overview

Overview of the PCT System

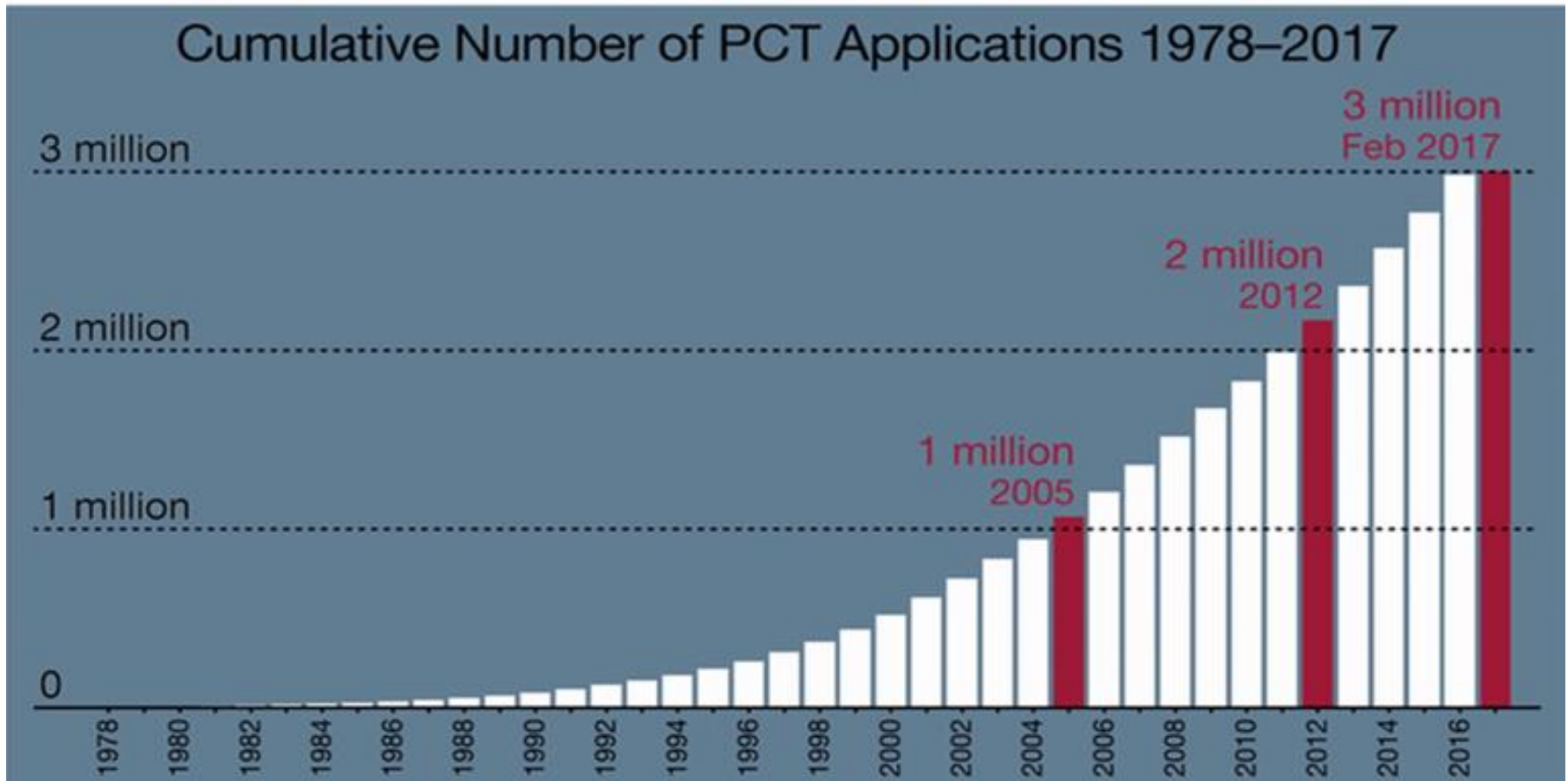


Benefits

- One PCT application with legal effect in all PCT Contracting States
- Harmonized formal requirements
- Receive patentability information to support strategic decision-making
- Postpone significant costs for national processing by 18 months

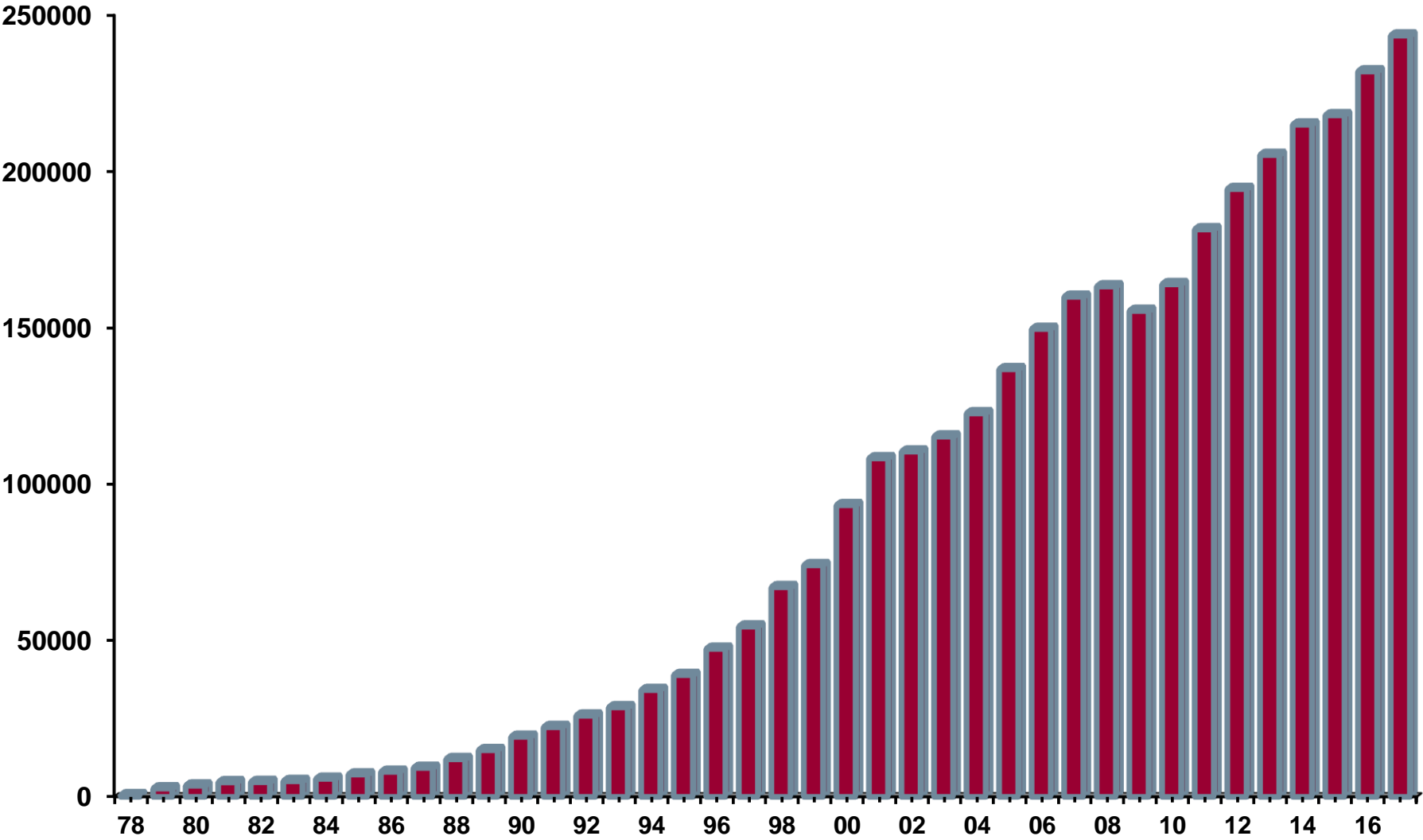
Source: WIPO, April 2018

Key Moments in PCT History



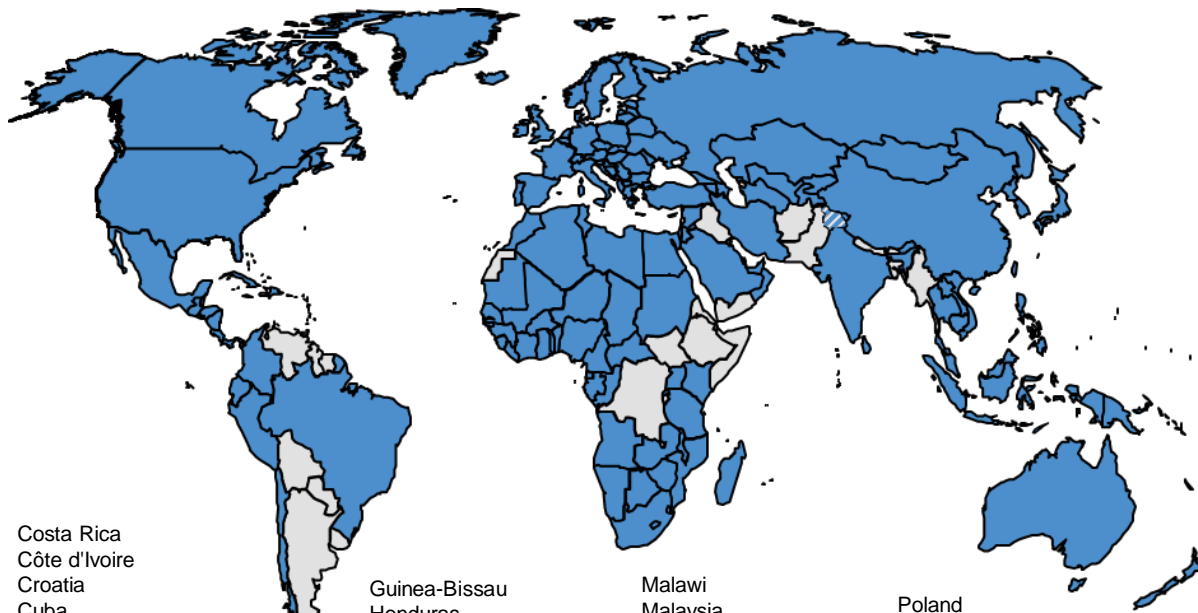
- 26 years to 1st million
- 7 years to 2nd million
- 5 years to 3rd million

PCT Applications



2017: 243,500 (+4.5%)

152 PCT States



Albania
Algeria
Angola
Antigua and Barbuda
Armenia
Australia
Austria
Azerbaijan
Bahrain
Barbados
Belarus
Belgium
Belize
Benin
Bosnia and Herzegovina
Botswana
Brazil
Brunei Darussalam
Bulgaria
Burkina Faso
Cambodia
Cameroon
Canada
Central African Republic
Chad
Chile
China
Colombia
Comoros
Congo

Costa Rica
Côte d'Ivoire
Croatia
Cuba
Cyprus
Czech Republic
Democratic People's
Republic of Korea
Denmark
Djibouti
Dominica
Dominican Republic
Ecuador
Egypt
El Salvador
Equatorial Guinea
Estonia
Finland
France
Gabon
Gambia
Georgia
Germany
Ghana
Greece
Grenada
Guatemala
Guinea

Guinea-Bissau
Honduras
Hungary
Iceland
India
Indonesia
Iran (Islamic Republic of)
Ireland
Israel
Italy
Japan
Jordan
Kazakhstan
Kenya
Kuwait
Kyrgyzstan
Lao People's Dem Rep.
Latvia
Lesotho
Liberia
Libyan Arab Jamahiriya
Liechtenstein
Lithuania
Luxembourg
Madagascar

Malawi
Malaysia
Mali
Malta
Mauritania
Mexico
Monaco
Mongolia
Montenegro
Morocco
Mozambique
Namibia
Netherlands
New Zealand
Nicaragua
Niger
Nigeria
Norway
Oman
Panama
Papua New Guinea
Peru
Philippines

Poland
Portugal
Qatar
Republic of Korea
Republic of Moldova
Romania
Rwanda
Russian Federation
Saint Lucia
Saint Vincent and
the Grenadines
San Marino
Sao Tomé e Príncipe
Saudi Arabia
Senegal
Serbia
Seychelles
Sierra Leone
Singapore
Slovakia
Slovenia
South Africa
Spain
Sri Lanka
Sudan
Swaziland

St. Kitts and Nevis
Sweden
Switzerland
Syrian Arab Republic
Tajikistan
Thailand
The former Yugoslav
Republic of Macedonia
Togo
Trinidad and Tobago
Tunisia
Turkey
Turkmenistan
Uganda
Ukraine
United Arab Emirates
United Kingdom
United Republic of Tanzania
United States of America
Uzbekistan
Viet Nam
Zambia
Zimbabwe

UN Member States not yet in PCT

Afghanistan

Andorra

Argentina

Bahamas

Bangladesh

Bhutan

Bolivia

Burundi

Cape Verde

Democratic Republic of

Congo

Eritrea

Ethiopia

Fiji

Guyana

Haiti

Iraq

Jamaica

Kiribati

Lebanon

Maldives

Marshall Islands

Mauritius

Micronesia

Myanmar

Nauru

Nepal

Pakistan

Palau

Paraguay

Samoa

Solomon Islands

Somalia

South Sudan

Suriname

Timor-Leste

Tonga

Tuvalu

Uruguay

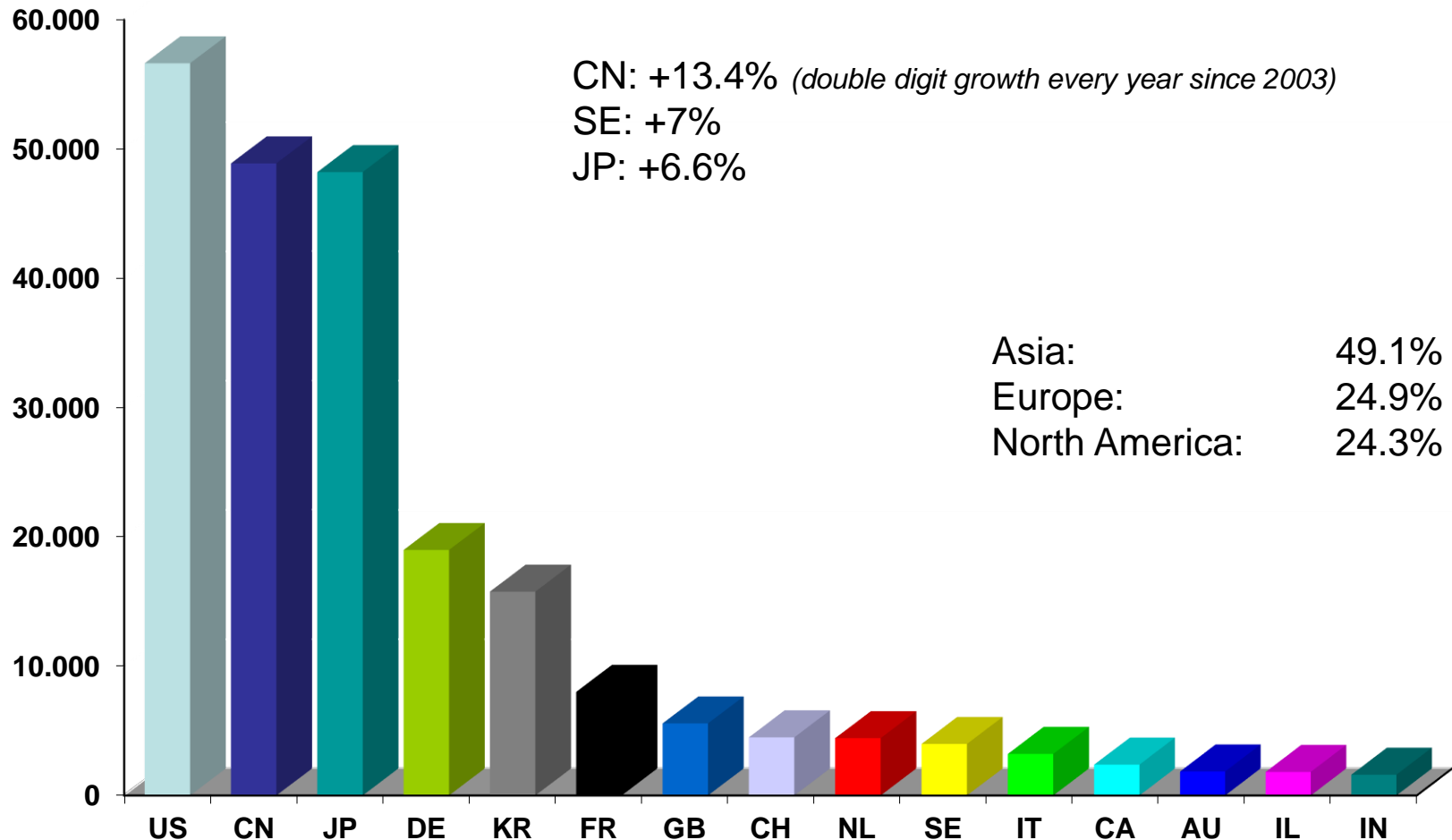
Vanuatu

Venezuela

Yemen

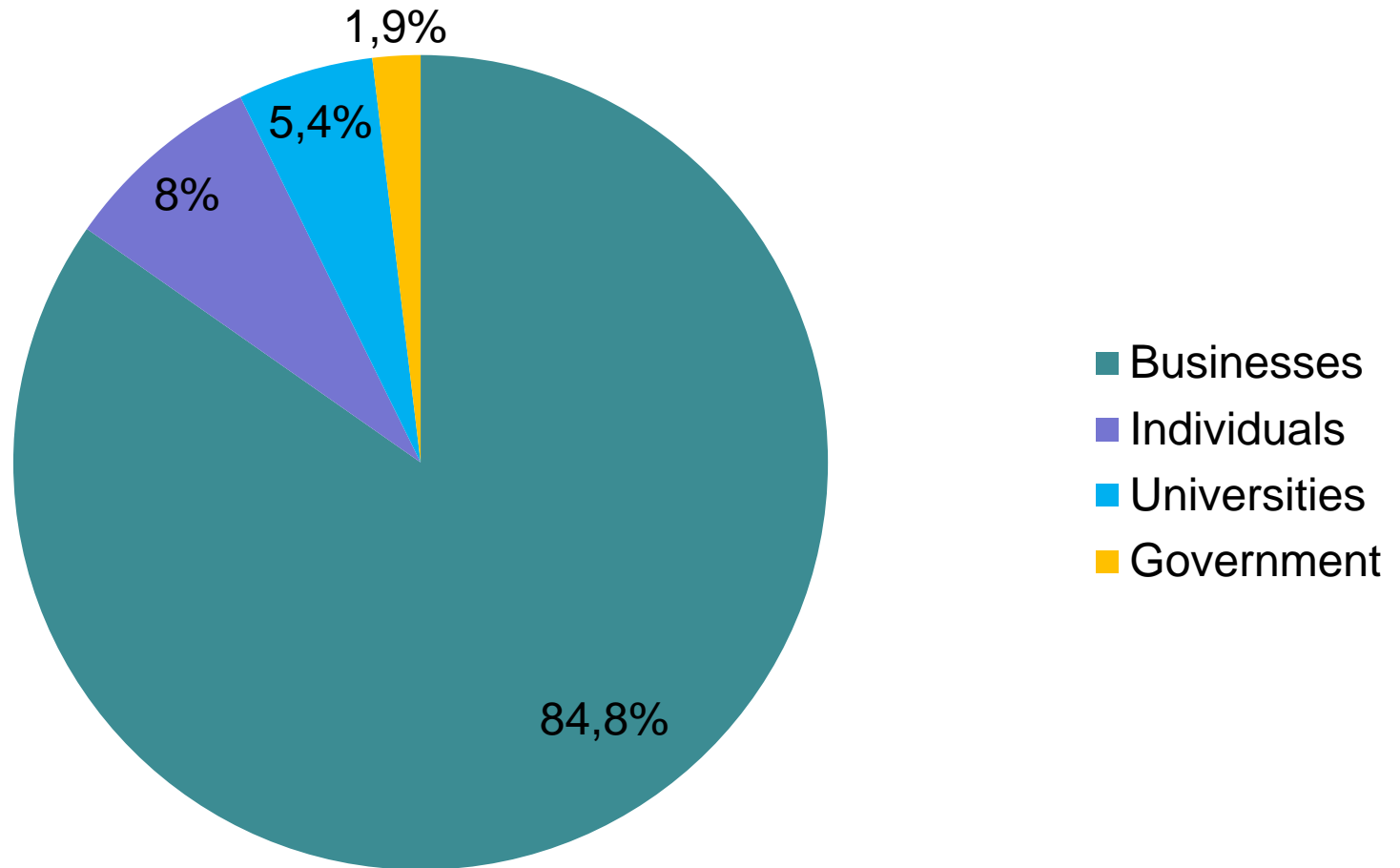
(41)

International applications received in 2017 by country of origin



- 23.3% originating in US, 20% in China, 19.8% in Japan
- 63% from the top 3 countries, 77% from top 5 countries, 93% of filings from top 15 countries

Distribution of PCT Applicants in 2017



Top PCT Applicants 2017

*() of published
PCT applications*

Top 50 applicants:

JP (15)

US (13)

CN (10)

DE (5)

KR (3)

NL (2)

FR (1)

SE (1)

1. Huawei Technologies—CN (4,024)
2. ZTE—CN (2,965)
3. Intel—US (2,637)
4. Mitsubishi Electric—JP (2,521)
5. Qualcomm—US (2,163)
6. LG Electronics—KR (1,945)
7. BOE Technology Group—CN (1,818)
8. Samsung—KR (1,757)
9. Sony—JP (1,735)
10. Ericsson—SE (1,564)
11. Microsoft—US (1,563)
12. Hewlett-Packard—US (1,519)
13. LE Holdings —CN (1,397)
14. Bosch—DE (1,354)
15. Panasonic—JP (1,280)
16. Philips—NL (1,077)
17. Siemens—DE (1,063)
18. Shenzhen China Star Optoelectronics—CN (972)
19. Fujifilm—JP (970)
20. Denso—JP (968)

Top University PCT Applicants 2017

1. University of California (US)
2. Massachusetts Institute of Technology (US)
3. Harvard University (US)
4. University of Texas (US)
5. Johns Hopkins University (US)
6. University of Florida (US)
7. Seoul National University (KR)
8. Hanyang University (KR)
9. Stanford University (US)
10. Korea Advanced Institute of Science and Technology (KR)
11. Shenzhen University (CN)
12. Columbia University (US)
13. University of Tokyo (JP)
14. University of Michigan (US)
15. China University of Mining and Technology (CN)
16. King Abdullah University of Science and Technology (SA)
17. University of Pennsylvania (US)
18. Korea University (KR)
19. Tsinghua University (CN)
20. Tohoku University (JP)

Top Government and Public Research Organization PCT Applicants 2017

1. Commissariat à L'Energie Atomique et aux Energies Alternatives (FR)
2. Fraunhofer-Gesellschaft Zur Förderung Der Angewandten Forschung E. V. (DE)
3. China Academy of Telecommunications Technology (CN)
4. Institut National de la Santé et de la Recherche Médicale (FR)
5. Centre National de la Recherche Scientifique (FR)
6. Agency of Science, Technology and Research (SG)
7. National Institute of Advanced Industrial Science and Technology (JP)
8. Korean Electronics Technology Institute (KR)
9. Shenzhen Institute of Advanced Technology (CN)
10. Mayo Foundation for Medical Education and Research (US)
11. Council of Scientific and Industrial Research (IN)
12. Sloan-Kettering Institute for Cancer Research (US)
13. Consejo Superior de Investigaciones Científicas (ES)
14. Korea Institute of Machinery & Materials (KR)
15. Commonwealth Scientific and Industrial Research Organisation (AU)
16. Cedars-Sinai Medical Center (US)
17. Nederlandse Organisatie Voor Toegepastnatuurwetenschappelijk Onderzoek TNO (NL)
18. Institute of Physical and Chemical Research (JP)



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PCT Working Group 2018

PCT WG 2018 Outcomes

- Agreed amendment to Rule 69.1(a), allowing IPEA to begin IPE when in possession of demand, fees, ISR and WO (effectively reversing current default, unless applicant requests postponement)
- IB to draft new amendment proposals for 2019 WG on “erroneously filed elements and parts”
- IB to consult member States on issues relating to proposed fee reduction for universities and prepare document for 2019 WG on options and implementation issues
- IB invited to work with Offices and users on requirements and proposals for systems to assist national phase entry
- Noted:
 - IB-proposed priorities and directions for future development of PCT
 - document on PCT applications linked to UN Security Council sanctions, and concluded that IB’s existing arrangements for handling such cases are appropriate and fully consistent with PCT
 - preparations for launch of 3rd pilot on collaborative search and examination between IP5 offices



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PCT Assembly – October 2018

PCT Rule Changes – 1 July 2019

- Amendment to PCT Rule 69.1(a):
 - IPEA can start the IPE once it is in possession of the demand, the fees, the ISR (or Article 17.2(a) declaration) and written opinion, unless the application expressly requests to postpone the start of the IPE until the expiration of the time limit under PCT Rule 54*bis*.1(a)
 - Adopted a [document](#) for appointment of an ISA
- Above amendments enter into force on July 1, 2019 and will apply to PCT applications for which a Chapter II demand is filed on or after that date



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Transmission of National Phase Entry Data

Transmission of National Phase Entry Data (NPE) – Aims

Before July 1, 2017

- Designated Offices provided NPE data to International Bureau on voluntary basis
- 50 designated Offices had provided data, but only 16 on a “regular” basis

Aims of Rule Changes from July 1, 2017:

- Improved access to information on where protection is sought
- Better linkage to national phase publications in languages different from international application

Revised Data Format for Collection of National Phase Information (1)

Revised Data Format Specifications for the Collection of PCT National Phase Information ([version number 4.1](#))*

Offices required to send within 2 months the following data items for events in national phase:

- Office code ([WIPO Standard ST.3](#))
- International application number
- National application number
- Event type
- Event date
- National publication number (where relevant)
- Kind code of publication (where relevant)

Revised Data Format for Collection of National Phase Information (2)

Compulsory event types:

- National phase entry
- National publication
- Date of grant of patent (publication of granted patent or notice of grant)

Optional event types:

- Refusal
- Withdrawal
- Continuation of processing after refusal or withdrawal
- Divisional application

Data transmitted in CSV or XML format

Transmission of National Phase Entry Data -- Update

NPE – Status Report ([Document PCT/WG/11/10](#))

- ❑ In addition to the PCT Electronic Data Interchange (PCT-EDI) system, national entry data can be also provided by means of an ‘Action’ through ePCT
- ❑ In the context of IPAS, WIPO has updated the WIPO Publish software application to include automatic process for furnishing national phase entry data (on this, please find additional information in document [WIPO/IP/ITAI/GE/18/4](#))
- **63** designated Offices have provided data, 32 on a “regular” basis (Reminder: maximum number of DOs supplying national phase entry data is 124[152])



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PCT Minimum Documentation

PCT Minimum Documentation – Definition

[PCT Rule 34](#) defines the minimum documentation that an International Searching Authority is required to consult:

- national patent documents (as specified in Rule 34.1(c))
- published international (PCT) applications, published regional applications for patents and inventors' certificates, and published regional patents and inventors' certificates
- other published items of non-patent literature as the International Searching Authorities shall agree upon and which shall be published in a list by the International Bureau ...

PCT Minimum Documentation – Lists of Patent Documents and Periodicals

[WIPO Handbook on Industrial Property Information and Documentation](#)

■ Part 4.1 – Inventory of Patent Documents (1920 – 2000)

- Last updated in November 2001
- People's Republic of China and Republic of Korea since added to Rule 34.1(c)
- Numbers contained as ranges – unused numbers not always identified
- Scope of national patent documents part of minimum documentation under Rule 34.1(c)(vi)

■ Part 4.2 – List of Non-Patent Literature

- Last updated in February 2010

PCT Minimum Documentation – Issues

PCT minimum documentation requires revision:

- Definition of patent documents for electronic searching
 - Standards for Offices to have their national collections included in the PCT minimum documentation and allow access to Authorities and database providers
 - Types of documentation – utility models
 - Components of patent data that should be present in patent collections in PCT minimum documentation
- Non-patent literature
 - Electronic access to periodicals
 - Traditional knowledge databases (Indian TKDL)

PCT Minimum Documentation Task Force

- European Patent Office took over leadership in 2016
- Four objectives (EPO High Level Position Paper – Appendix to document [PCT/MIA/24/4](#))
 - ❑ Objective A: Create up-to-date inventory (patent and non-patent parts)
 - ❑ Objective B: Recommend criteria and standards for including a national patent collection
 - ❑ Objective C: Propose bibliographic and text components of patent data that should be present in patent collections
 - ❑ Objective D: Recommend criteria and standards for non-patent literature and assess proposal for adding Indian TKDL

PCT Minimum Documentation Task Force – State of Play

- **Objective A** – Create up-to-date inventory (patent and non-patent parts)
 - Discussions on lists of Patent Publications belonging to the PCT minimum documentation updated by the EPO: Document dated October 27, 2017
 - Discussions on lists of Non-Patent Literature belonging to the PCT minimum documentation updated by the EPO: Document dated October 27, 2017
 - Comments due by November 13, 2017
- **Objective B** – Recommended criteria and standards for including a national patent collection in the PCT Minimum Documentation
 - Discussions on PCT Minimum Documentation – Language Issues updated by the EPO: Document dated May 16, 2018

PCT Minimum Documentation Task Force – State of Play

■ Objective B (*Continued*)

- ❑ Discussions on proposal to include utility models in the PCT Minimum Documentation updated by the EPO: Document dated May 16, 2018
- Comments due by September 10, 2018

■ Objective C – Proposed clearly-defined bibliographic and texts components of patent data in patent collections belonging to the PCT Minimum Documentation

- ❑ Discussions based on the latest document issued by the EPO, dated May 16, 2018 ([WIPO Standard ST.37](#))
- Comments due by September 10, 2018

PCT Minimum Documentation Task Force – State of Play

- **Objective D** – Discussions to be led by the United States Patent and Trademark Office (USPTO) and assess proposal for adding Indian TKDL
 - Circular [C. PCT 1544](#) (July 9, 2018): Questionnaire sent to ISAs and IPEAs (currently, comments under review)
 - Report to Meeting of International Authorities in February 2018 (documents [PCT/MIA/25/4](#) and [PCT/MIA/25/9](#))
- Sept-Nov. 2018 Round 4 discussions
- Final report to MIA with Recommendations in Dec. 2018



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Recent developments

Recent Developments

- New ISAs/IPEAs
- PCT Highlights
- PCT Collaborative Search and Examination Pilot Group (CS&E)
- Licensing availability
- Third Party Observations
- ePCT Coverage

New ISAs/IPEAs

- Twenty three (23) Offices now hold the status as ISA/IPEA
 - The State Intellectual Property Service of Ukraine (SIPSU) started operations as an ISA/IPEA on 5 February 2016
 - The Visegrad Patent Institute started operations as ISA/IPEA on 1 July 2016
 - Turkish Patent and Trademark Office started operations as from 8 March 2017
 - The Intellectual Property Office of the Philippines has been appointed as an ISA/IPEA (2017) (*not yet operational*)

PCT Highlights

- High-level summary of recent and future developments in the PCT, with hyperlinks to more detailed information, databases, videos, etc.
- Targeted, in particular, at managers and attorneys
- Possibility to subscribe to the PCT Highlights mailing list for update notifications

PCT Highlights

The International Patent System

PCT recent and future developments

Collaborative search and examination: third pilot launched on 1 July 2018

After having completed the first and second pilot (see evaluation report [PDF](#)), the operational phase of the [third pilot](#) will be launched on July 1, 2018 and is expected to run for at least three years; for further reading see [Collaborative Search and Examination](#) (and document PCT/WG/11/15 [PDF](#)).

PCT Working Group

The eleventh session took place from June 18 to June 22, 2018. The [meeting documents](#) and the [Summary](#), prepared by the Chair of the Meeting, are now available.

Meeting of International Authorities (MIA)

The 25th session of the Meeting of International Authorities took place from February 21 to 23, 2018 (Madrid, Spain). The [meeting documents](#) and the [Summary](#), prepared by the Chair of the Meeting, are now available.

PCT Filings in 2017

International patent applications grew by 4.5% to 243,500 in 2017, setting a new annual record.

Email updates

PCT Highlights – High-level overview of recent and future developments in the PCT. 1-2 per year.

[Sign up](#)

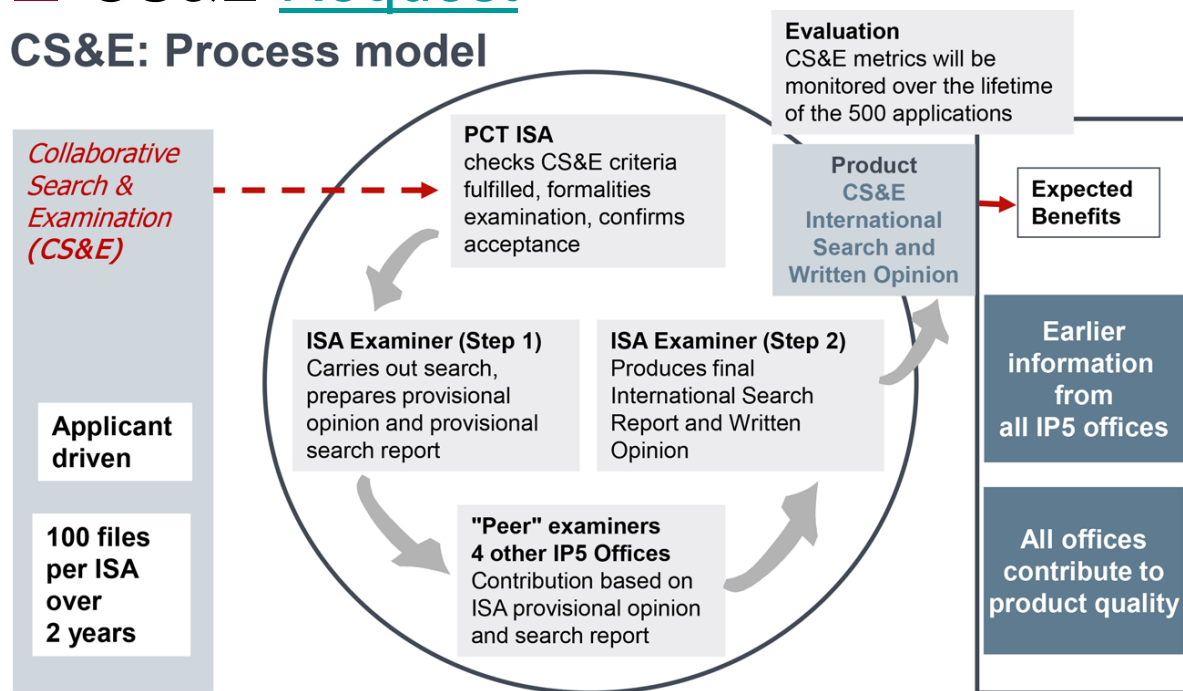
<https://www.wipo.int/pct/en/highlights/index.html>

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Collaborative search & examination

- 3rd pilot on a collaborative search & examination
- IP5 Offices (EPO, USPTO, JPO, SIPO, KIPO)
- 100 files per Offices over the first two years
- CS&E [Request](#)

CS&E: Process model



Licensing availability (1)

- Applicants interested in concluding license agreements in relation to their international application may request the International Bureau to make this information available in PATENTSCOPE:
 - How? Applicants should submit a “Licensing Availability Request” to the IB using an ePCT “Action”
 - Alternatively, Form PCT/IB/382 may be used
 - When? At the time of filing or within 30 months from the priority date
 - Free of charge
 - Applicants can file multiple licensing requests or update previously submitted ones (within 30 months from the priority date)

Licensing availability (2)

- ❑ Licensing indications will be made publicly available after international publication of the application
- ❑ The licensing indications will be visible on PATENTSCOPE under the “*Bibliographic data*” tab with a link to the submitted licensing request itself
- ❑ International applications containing licensing information can be searched for in PATENTSCOPE
- ❑ The licensing indication displayed under the “*Bibliographic data*” tab may be revoked by the applicant at any time, that is, also after 30 months from the priority date

Field Combination

AND	Front Page		
AND	WIPO Publication Number		
AND	Application Number		
AND	Publication Date		
AND	English Title		
AND	English Abstract		
AND	Applicant Name		
AND	International Class		
AND	Inventor Name		
AND	Office Code		
AND	English Description		
AND	English Claims		
AND	Inventor Name	Is Empty:	<input checked="" type="radio"/> N/A <input type="radio"/> Yes <input type="radio"/> No
AND	Licensing availability		<input checked="" type="checkbox"/>

Licensing availability request		
Date	Title	View
13.09.2018	(IB/382) Request for indication of availability for licensing purposes	PDF (1p.)

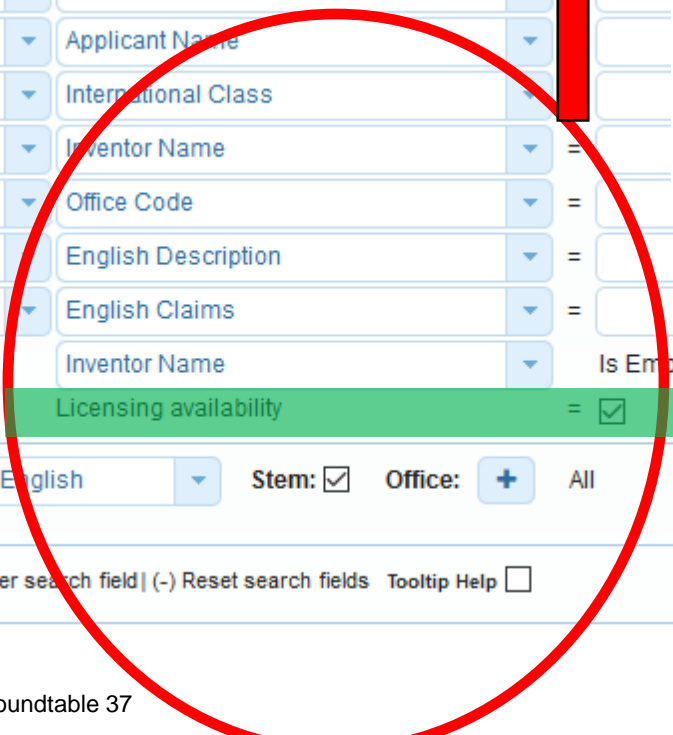
1. The applicant hereby requests the International Bureau to indicate the availability for licensing purposes of the invention(s) claimed in this international application on the PATENTSCOPE website.

2. Licensing terms (optional): The applicant is willing to license the claimed invention(s):

in:

all PCT Contracting States

all PCT Contracting States except (indicate each State by its two-letter code): _____



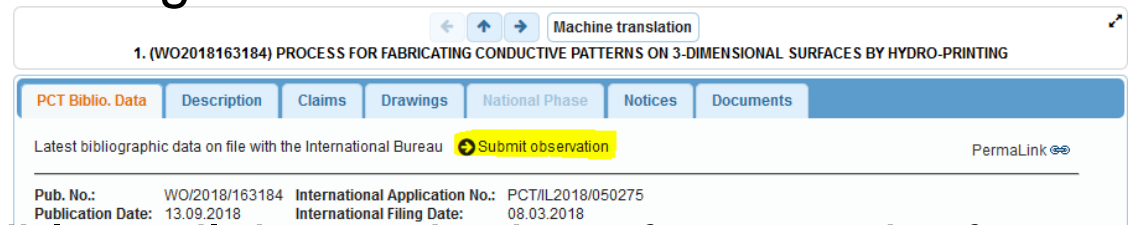
Language: English Stem: Office: + All

(+) Add another search field | (-) Reset search fields | Tooltip Help

992 results Search Reset

Third Party Observations - Main Features

- Allows third parties to submit prior art observations relevant to novelty and inventive step
- Web-based system using ePCT or web-forms in PATENTSCOPE
- Free-of-charge
- Submissions possible until the expiration of 28 months from the priority date
- Applicants may submit comments in response until the expiration of 30 months from the priority date
- Anonymous submission of third party observations possible
- Third-party supplied documents will not be available via PATENTSCOPE, but will be made available to International Authorities and national Offices



Third Party Observations – Role of the IB

- Checks for spam
- Notifies the applicant of submission of observations
- Makes observations available in PATENTSCOPE
- Sends to International Authorities and designated Offices observations, cited documents, and applicant responses
- Available since July 2012

Search and Examination-Related Documents			
Date	Title	View	Download
07.03.2018	Third Party Observation	PDF (1p.)	PDF (1p.), ZIP(XML + TIFFs)
07.03.2018	Additional comments submitted with observation	PDF (1p.)	PDF (1p.), ZIP(XML + TIFFs)
19.10.2017	Search Strategy	PDF (1p.)	PDF (1p.), ZIP(XML + TIFFs)
19.10.2017	(ISA/237) Written Opinion of the International Search Authority	PDF (7p.)	PDF (7p.), ZIP(XML + TIFFs)
19.10.2017	(ISA/210) International Search Report	PDF (4p.)	PDF (4p.), ZIP(XML + TIFFs)

PATENT COOPERATION TREATY
PCT
THIRD PARTY OBSERVATION
(PCT Administrative Instructions Part 8)

Applicant's or agent's file reference 71S0612WO6	
International application number PCT/IB2017/052010	International filing date (day/month/year) 07 Apr 2017 (07/04/2017)
Applicant MODULA S.P.A. CON SOCIO UNICO	
Third party observation submitted by Anonymous	Observation submitted on behalf of
Date of submission(day/month/year) 28 Feb 2018 (28/02/2018)	Language of observation English

Basis and contents of observation

- The observation is made on the basis of the claims in the international application as filed.
- The observation comprises:
References to documents: 1
Uploaded copies of documents: 0
- Further explanations:
Uploaded copies of documents: 1

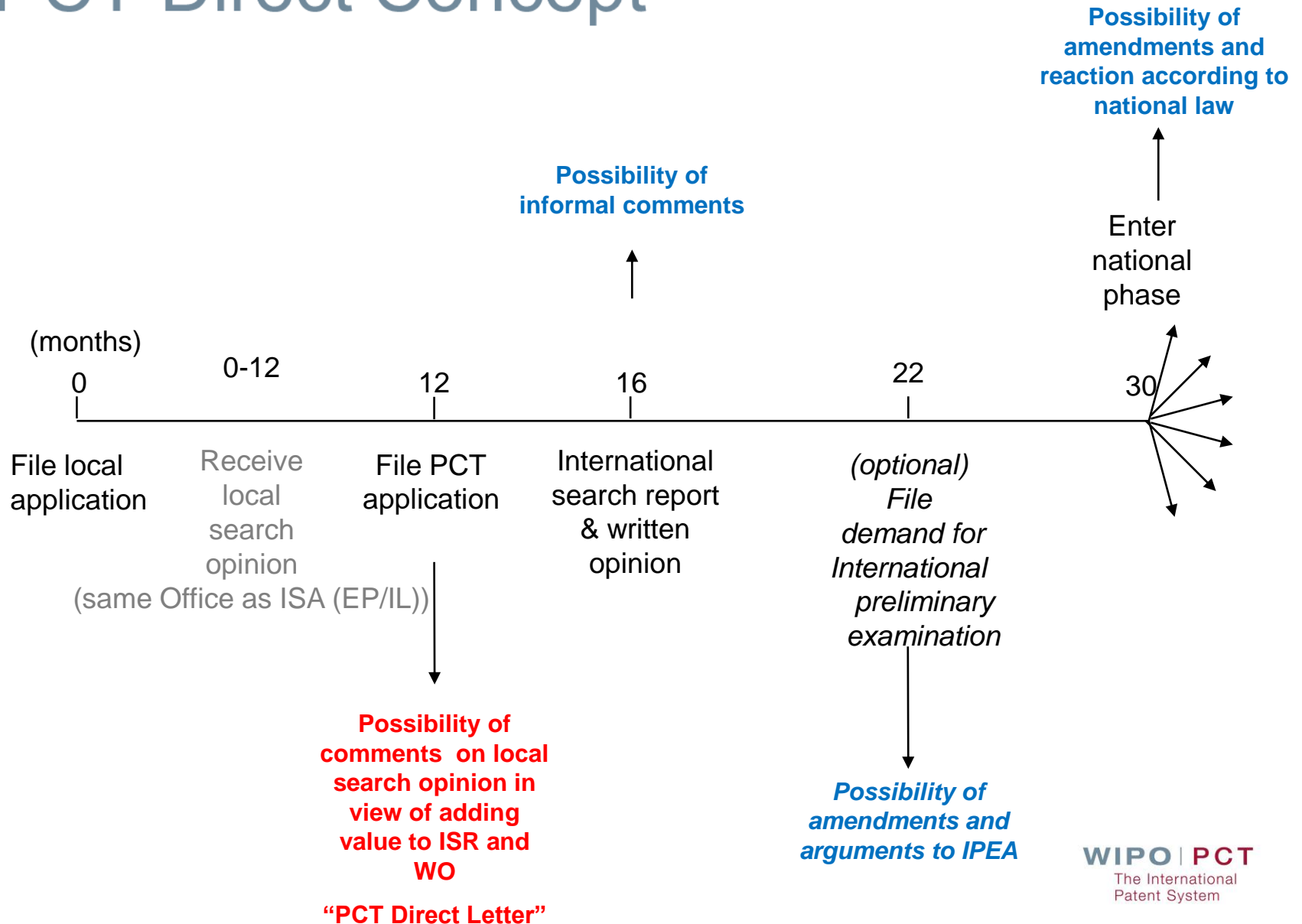
Citation # 1 (Patent/utility model) (# uploaded documents: 0):

Country code: EP	Publication number: 2692668	Document kind code: A1
Patent Applicant/Patent Owner: Ulma Manutencion S Coop		Title of invention:
Link to document:		
Publication Date: 05 Feb 2014 (05/02/2014)	Filing Date:	Priority Date:
Source of Abstract:	Accession number:	Publication Date of Abstract:
		Retrieval Date of Abstract:

“PCT Direct” (1)

- New service offered by:
 - EPO since 1 November 2014
 - Israel Patent Office since 1 April 2015
- During the PCT procedure, applicants can address patentability issues raised in the search opinion established for the priority application by the same office
- Aims at improving the efficiency and quality of the procedure before the ISA
- Further details can be found on the EPO website:
<http://www.epo.org/law-practice/legal-texts/official-journal/2014/09/a89.html>
- Further details can be found on the Israel Patent Office website:
<http://index.justice.gov.il/En/units/ILPO/Departments/PCT/News/Pages/PCTDirect.aspx>

PCT Direct Concept



“PCT Direct” (2)

■ Requirements:

- the informal comments are filed together with the PCT application
 - with any RO if ISA/EP is chosen
 - with RO/IL if ISA/IL;
- EPO or Israel Patent Office is selected as ISA;
- the PCT application claims priority of an earlier application searched by the
 - EPO (European first filing or national first filing)¹
 - Israel Patent Office

■ Form:

- the informal comments are filed in form of a “PCT Direct Letter” in a single document in PDF format and the words “PCT Direct/informal comments” have been indicated under “Other” in Box IX of the PCT request form (Form PCT/RO/101)

“PCT Direct” (3)

■ Informal comments:

- ❑ They are arguments regarding the patentability of the claims of the PCT application
- ❑ May include explanations regarding any modifications to the application documents, in particular to the claims, in comparison with the earlier application (e.g. marked-up copy)
- ❑ Aim at overcoming objections raised in the search opinion established for the priority application
- ❑ Do not form part of the PCT application, but are made publicly available on PATENTSCOPE

ePCT – Coverage and Statistics– Update

- ePCT filings represent over 75% of all PCT applications
- Top-10 countries of ePCT users: US, IN, DE, JP, GB, CN, FR, BR, CA and AU
- **ePCT-Filing** now extends to 55 receiving Offices (March 1, 2018) (43 to IB-hosted filing server)
- **Subsequently-filed** documents to 73 Offices
 - (58 ROs, 15 ISA/IPEAs)
- eSearch Copies ISA-RO pairs 22
- ePCT Uploads:
 - ePCT with strong authentication: 610'000
 - ePCT without strong authentication: 248'000
- More information: <https://pct.wipo.int/ePCT>

Thank you for your attention !

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PCT Legal and User Relations Division
PCT Legal and International Affairs Department
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