

Patent Cooperation Treaty (PCT) related matters



IP Information Roundtable
Geneva – October 21, 2019

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PCT Legal and User Relations Division



WIPO | PCT
The International
Patent System

Overview

■ PCT system

- ❑ Historical features and PCT coverage

- ❑ Statistics

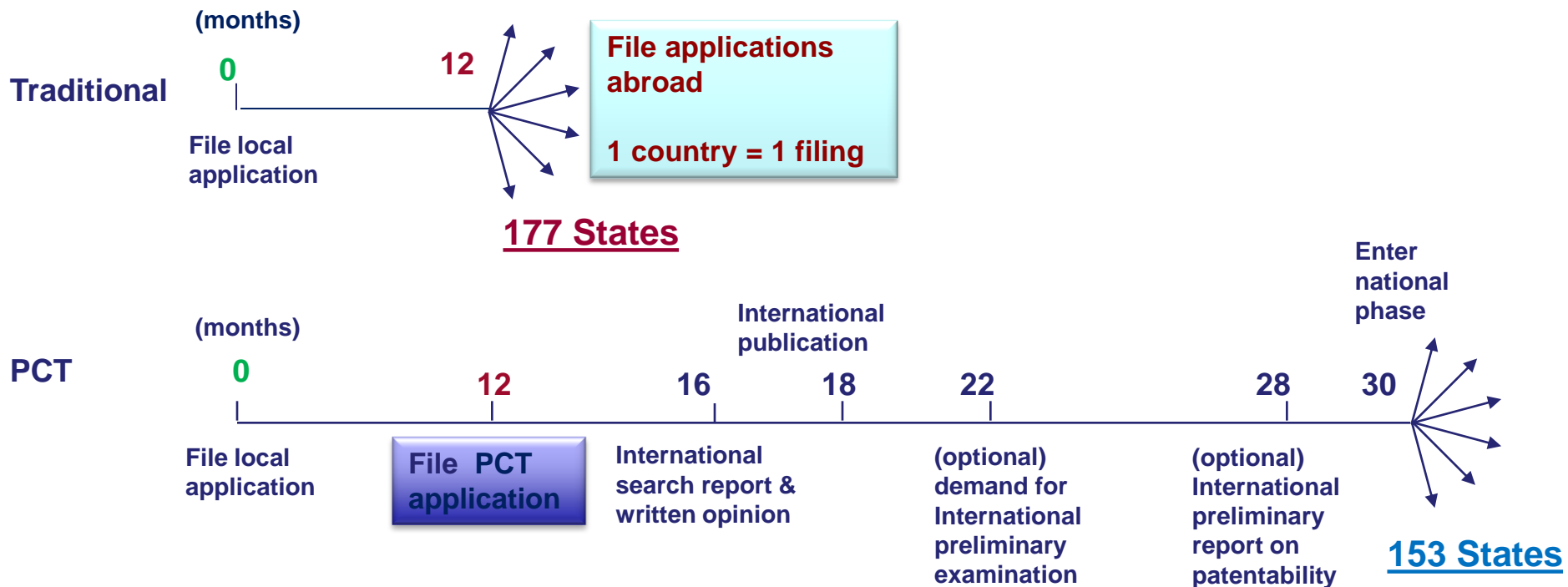
■ and updates:

- ❑ Amendments to PCT Regulations as from 1 July 2019

- ❑ PCT Assembly 2019

- ❑ Recent Developments (new PCT features)

Seeking patents multinationally: traditional patent system (“Paris Route”) vs. PCT system



Patent Cooperation Treaty Overview

Overview of the PCT System

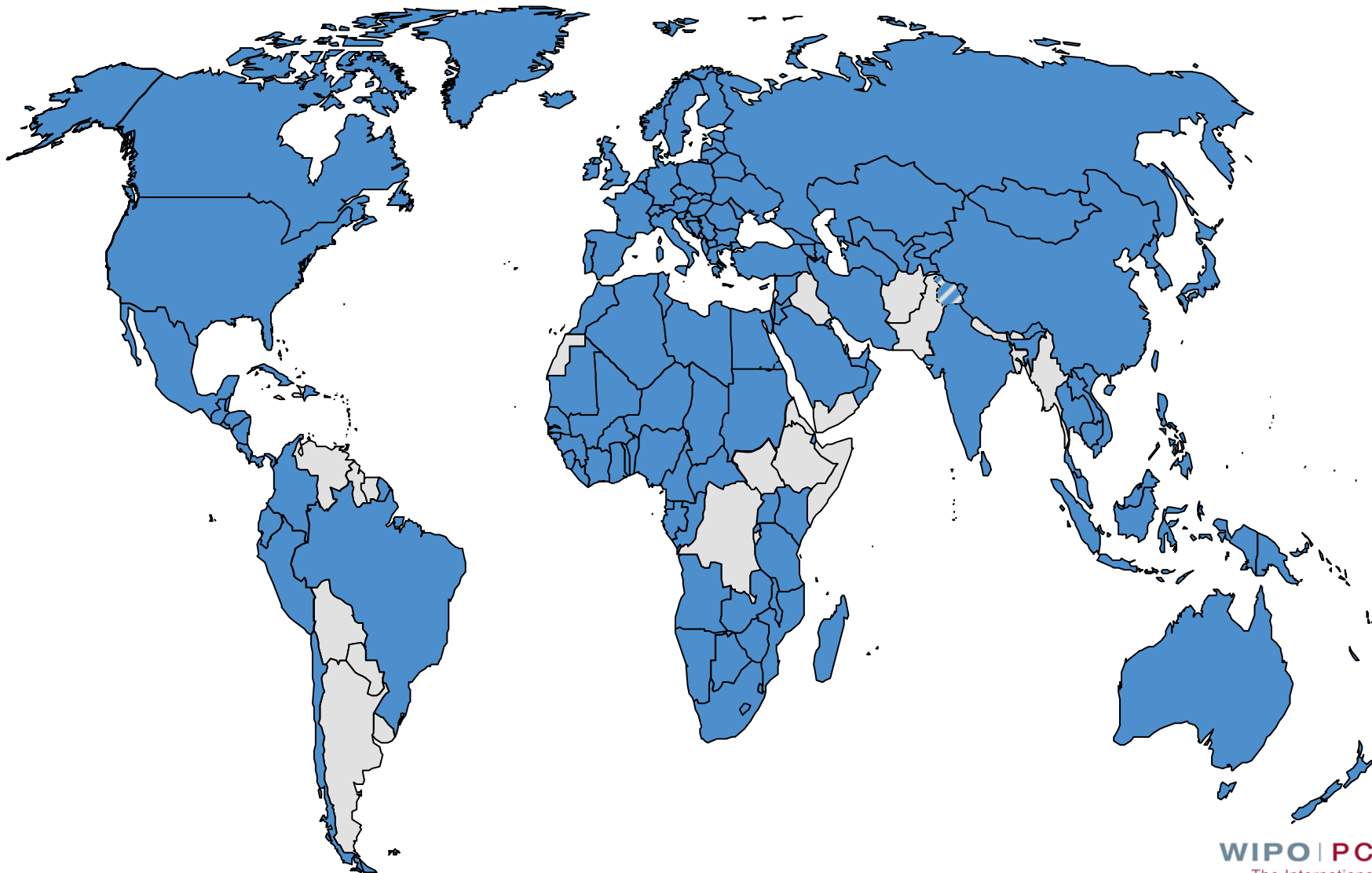


Benefits

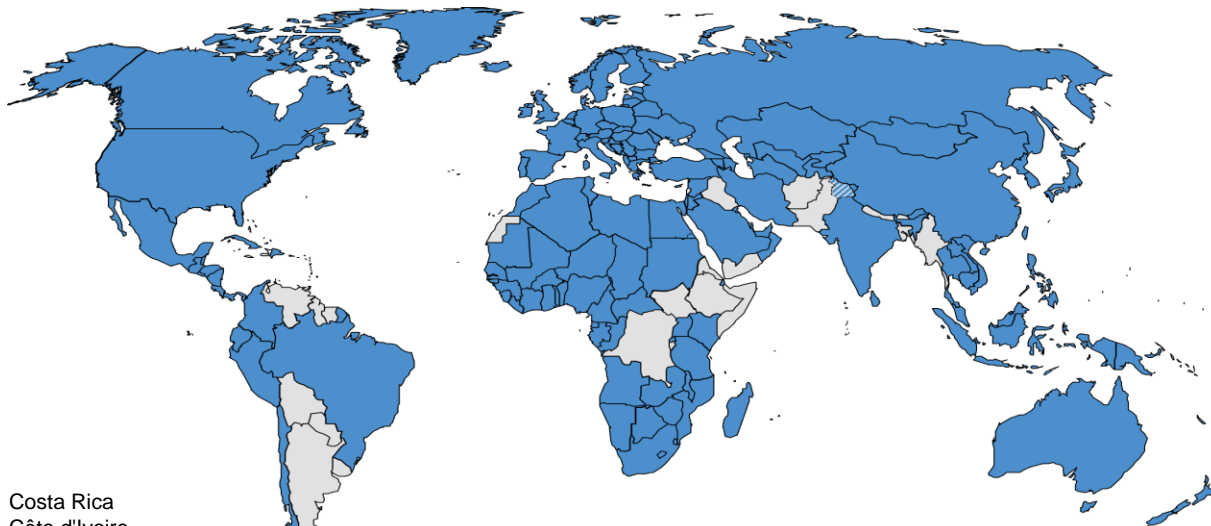
- One PCT application with legal effect in all PCT Contracting States
- Harmonized formal requirements
- Receive patentability information to support strategic decision-making
- Postpone significant costs for national processing by 18 months

Source: WIPO, April 2018

PCT Coverage Today



153 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
Libya
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
Samoa (Jan 2, 2020)
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

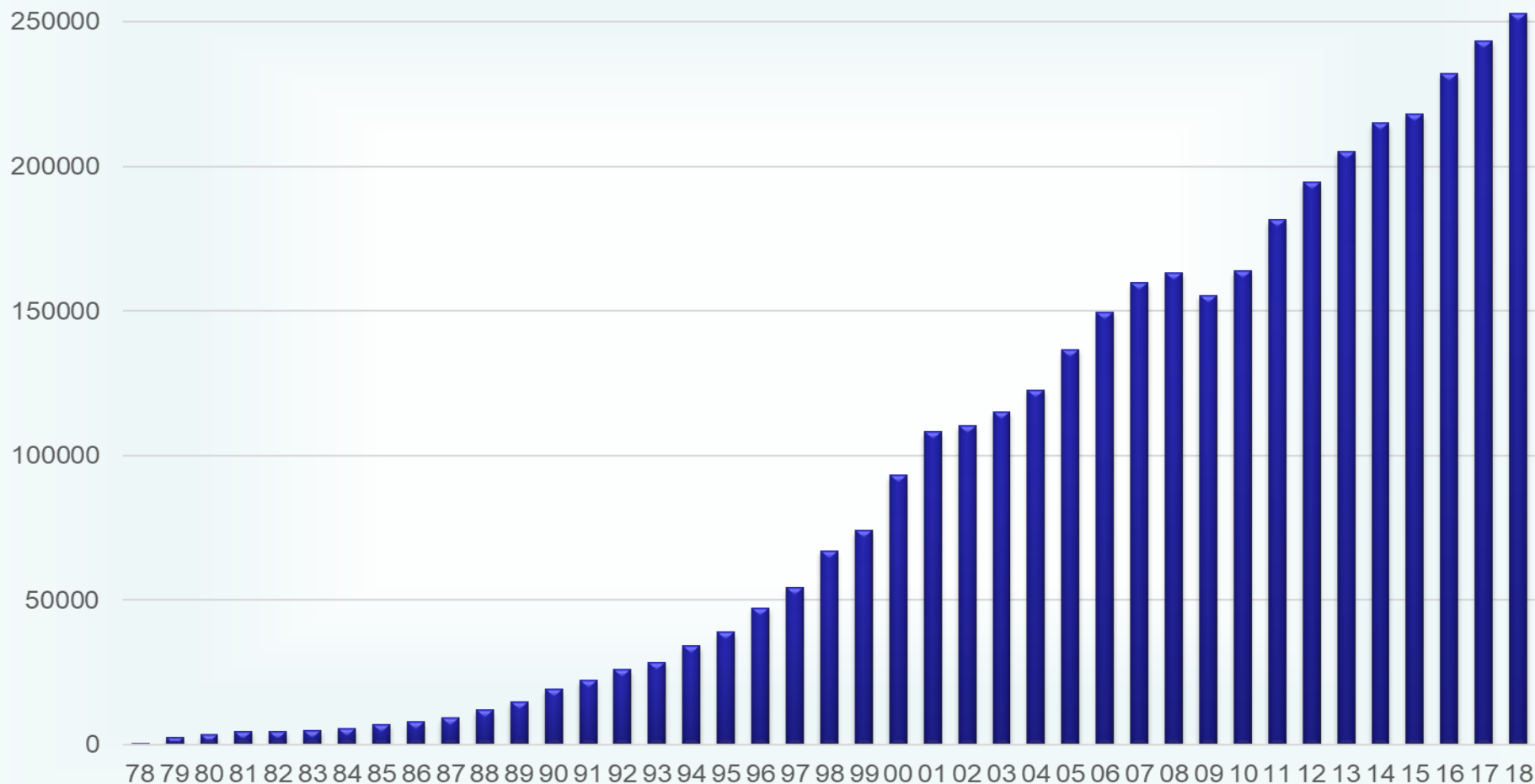
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UN Member States not yet in PCT

Afghanistan	Kiribati	Tuvalu
Andorra	Lebanon*	Uruguay
Argentina*	Maldives	Vanuatu
Bahamas	Marshall Islands	Venezuela
Bangladesh*	Mauritius*	Yemen
Bhutan*	Micronesia	
Bolivia	Myanmar	(40)
Burundi	Nauru	
Cape Verde	Nepal	
Democratic Republic of Congo	Pakistan	
Eritrea	Palau	
Ethiopia	Paraguay	
Fiji	Solomon Islands	
Guyana	Somalia	
Haiti	South Sudan	
Iraq	Suriname	
Jamaica	Timor-Leste	
	Tonga	

Tremendous growth in PCT applications since 1978

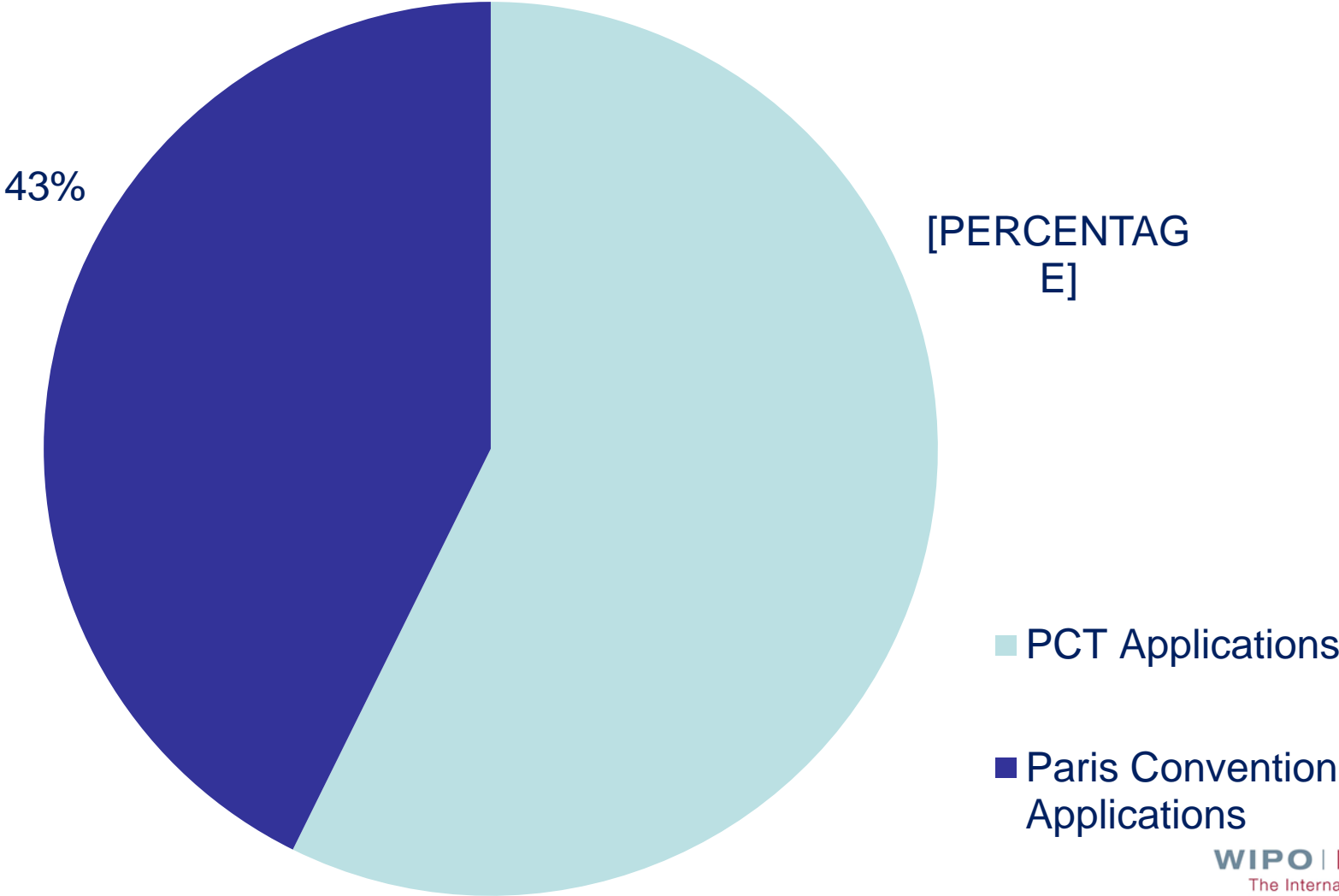
2018: **253.000 (+3,9%)**



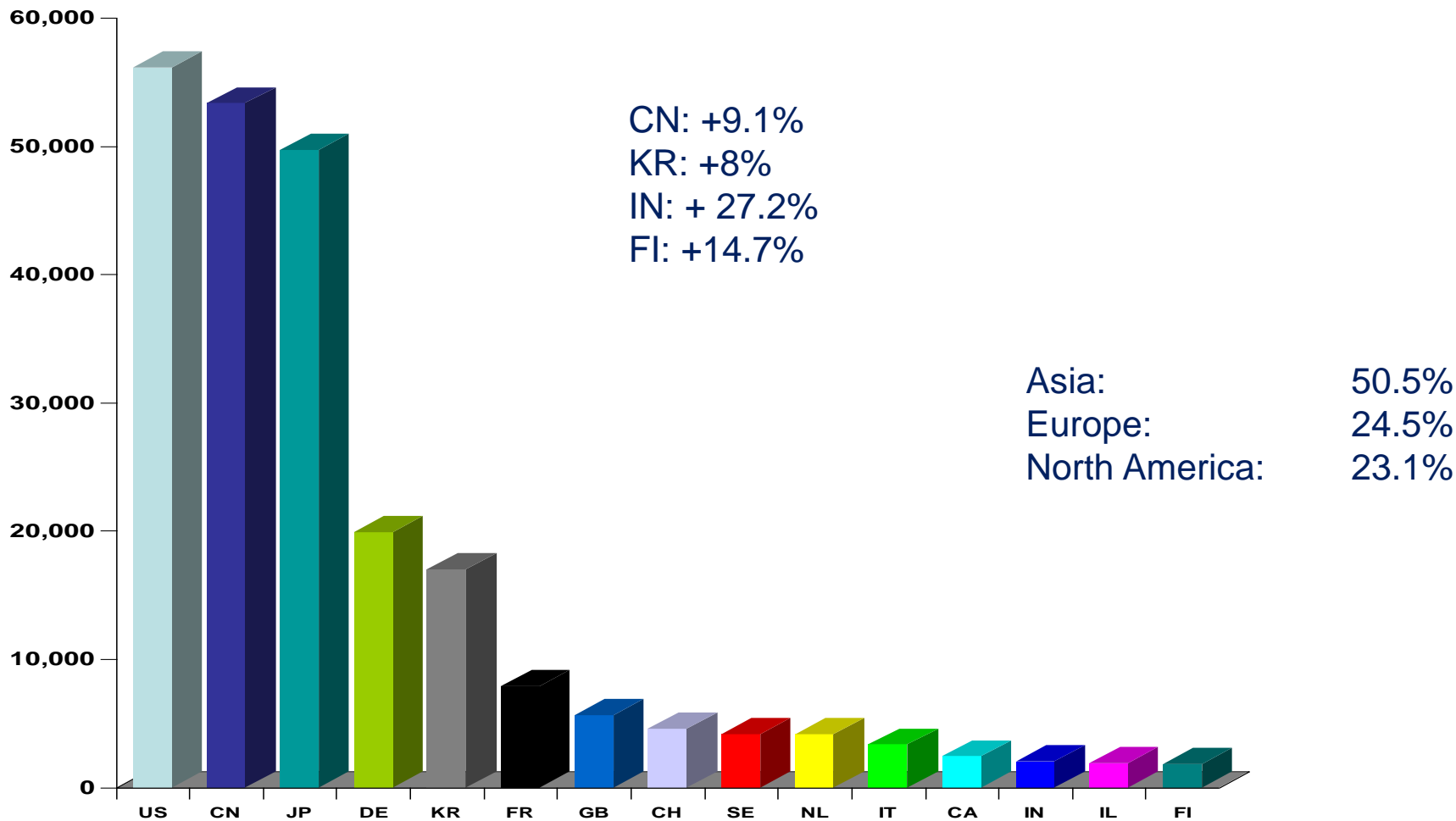
2018: 253,000 filed (average 700/day)

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The PCT has overtaken the Paris Convention

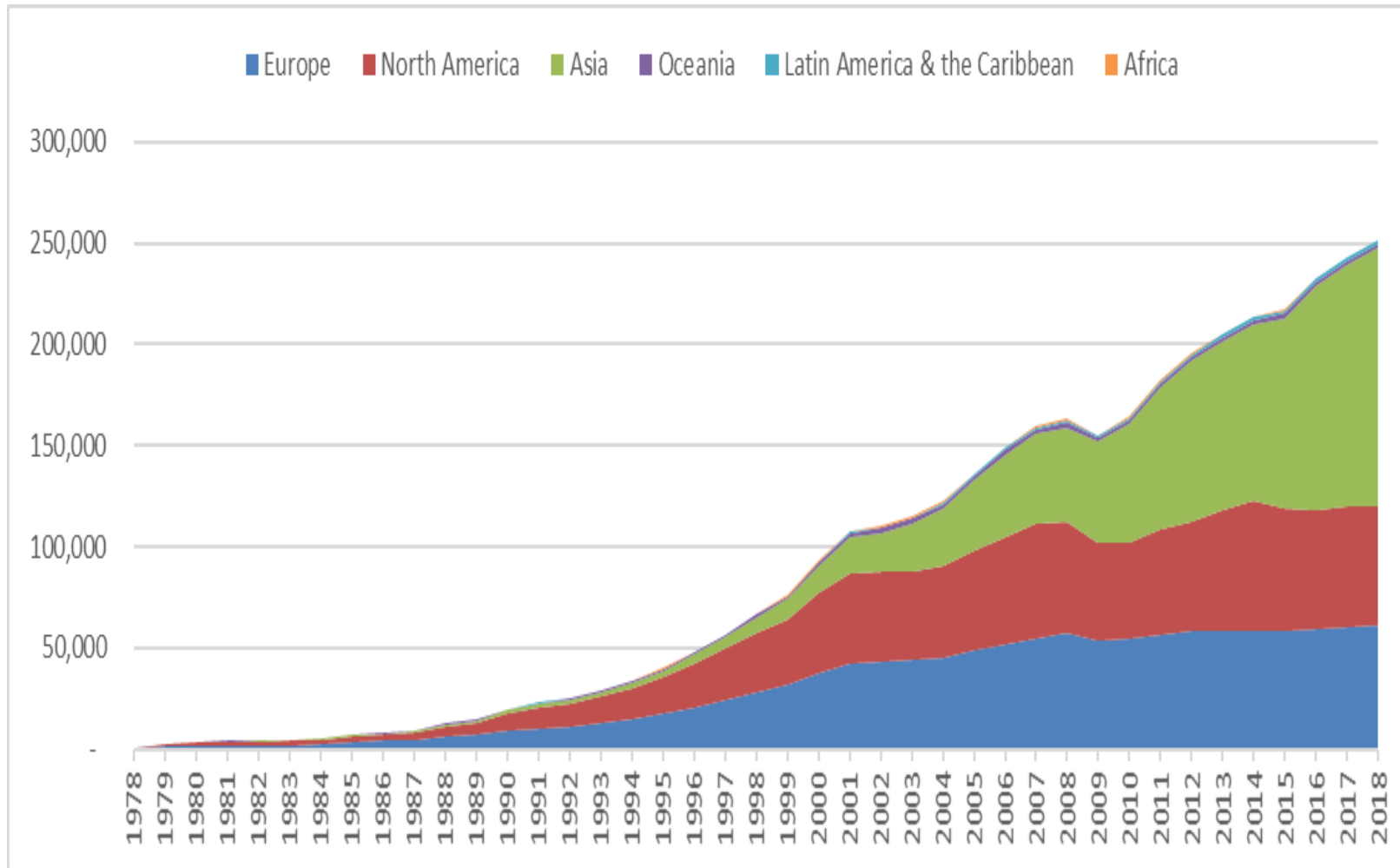


International applications received in 2018 by country of origin

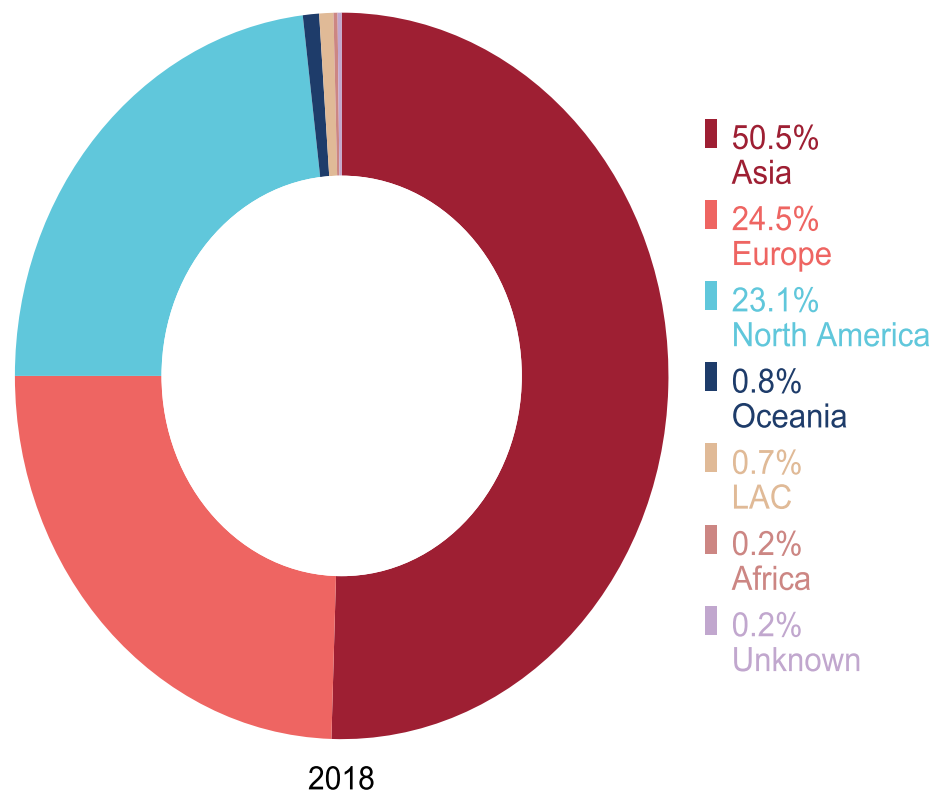
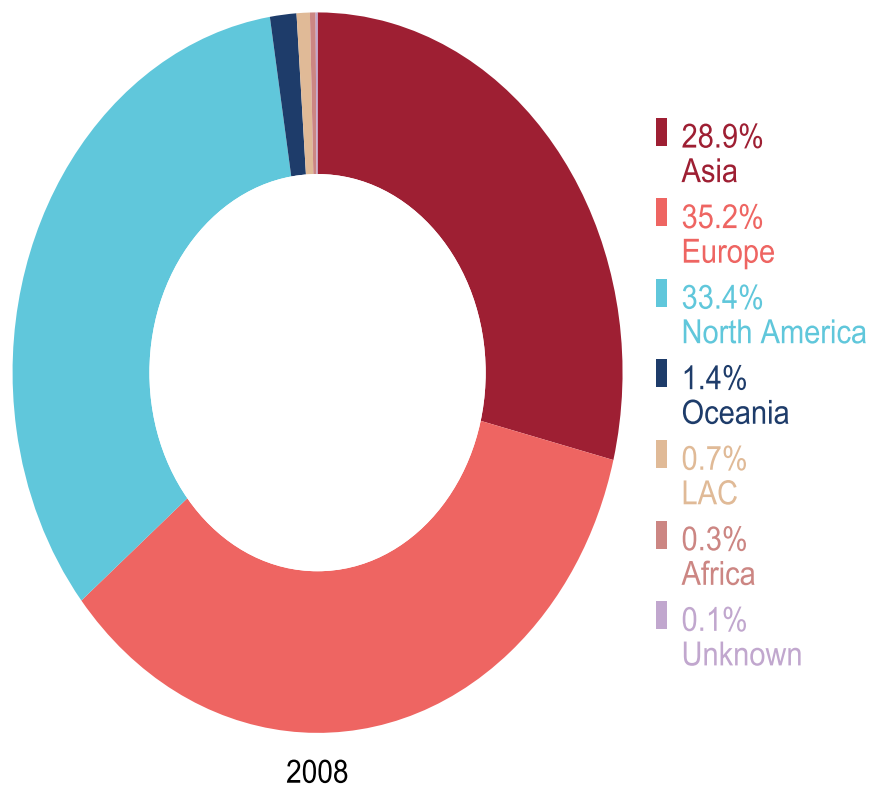


- 22.1% originating in US, 21% in China, 19.6% in Japan
- 62.7% from the top 3 countries, 77.5% from top 5 countries, 92.4% of filings from top 15 countries

PCT applications by region, 1978-2018



PCT applications by region 2008 and 2018

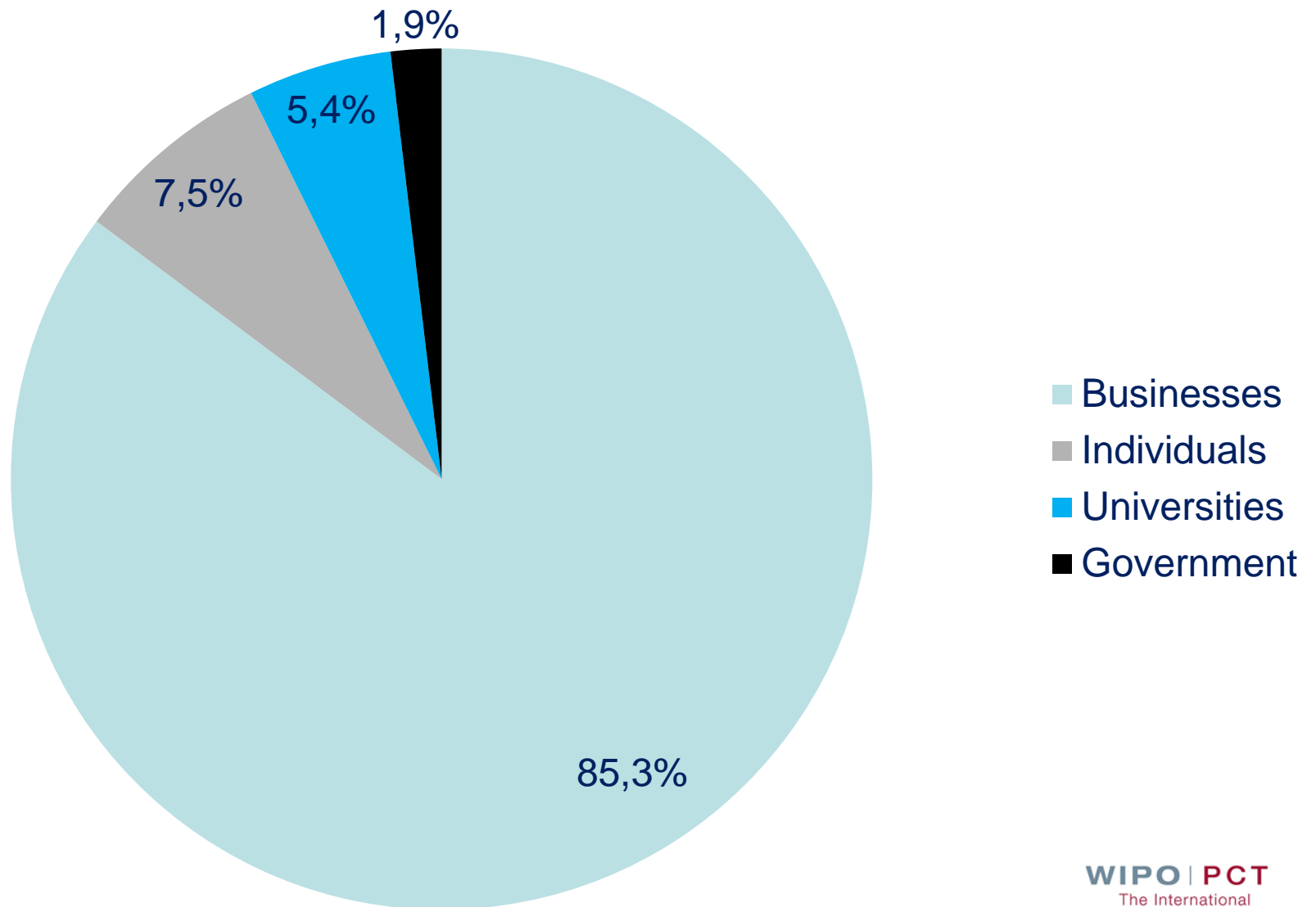


Top PCT applicants in 2018

1. Huawei Technologies—CN (5,405)
2. Mitsubishi Electric—JP (2,812)
3. Intel—US (2,499)
4. Qualcomm—US (2,404)
5. ZTE—CN (2,080)
6. Samsung—KR (1,997)
7. BOE Technology Group—CN (1,813)
8. LG Electronics—KR (1,697)
9. Ericsson—SE (1,645)
10. Bosch—DE (1,524)
11. Microsoft—US (1,476)
12. Panasonic—JP (1,465)
13. Sony—JP (1,342)
14. Siemens—DE (1,211)
15. Hewlett-Packard—US (1,170)

() of published PCT applications

PCT Applicants in 2018



Top University PCT Applicants in 2018

1. University of California (US)
2. Massachusetts Institute of Technology (US)
3. Shenzhen University (CN)
4. South China University of Technology (CN)
5. Harvard University (US)
6. University of Texas (US)
7. Tsinghua University (CN)
8. Seoul National University (KR)
9. Stanford University (US)
10. China University of Mining and Technology (CN)
11. Osaka University (JP)
12. Johns Hopkins University (US)
13. Korea Advanced Institute of Science and Technology (KR)
14. University of Tokyo (JP)
15. Hanyang University (KR)

Top Government/PRO PCT Applicants in 2018

1. Fraunhofer-Gesellschaft (DE)
2. China Academy of Telecommunications Technology (CN)
3. Commissariat a L'Energie Atomique et aux Energies Alternatives (FR)
4. Institut National de la Sante et de la Recherche Médicale (FR)
5. National Institute of Advanced Industrial Science and Technology (JP)
6. Centre National de la Recherche Scientifique (FR)
7. Agency of Science, Technology and Research (SG)
8. Shenzhen Institute of Advanced Technology (CN)
9. United States of America, Secretary of Health and Human Services (US)
10. Mayo Foundation for Medical Education and Research (US)
11. Korea Electronics and Technology Institute (KR)
12. Riken (Institute of Physical and Chemical Research) (JP)
13. Sloan-Kettering Institute for Cancer Research (US)
14. Electronics and Telecommunications Research Institute of Korea (KR)
15. Korea Institute of Industrial Technology (KR)

International Searching Authorities (23)

- AU – Australia
- AT – Austria
- BR – Brazil
- CA – Canada
- CL – Chile
- CN – China
- EG – Egypt
- ES – Spain
- FI – Finland
- IN – India
- IL – Israel
- JP – Japan
- KR – Republic of Korea
- PH – Philippines
- RU – Russian Federation
- SE – Sweden
- SG – Singapore
- TR – Turkey
- UA – Ukraine
- US – United States of America
- EP – European Patent Office
- XN – Nordic Patent Institute (Denmark, Iceland, Norway)
- XV – Visegrad Patent Institute (Czech Republic, Poland, Hungary and Slovakia)



Amendments to the PCT Regulations as from 1 July 2019

PCT Rule Changes

■ Amendment to PCT Rule 69.1(a)

□ Allows the IPEA to start the international preliminary examination when:

- it is in possession of the demand, relevant fees, ISR and written opinion;
- unless the applicant expressly requests the IPEA to postpone the start of the examination until expiration of the time limit for filing a Chapter II demand (Rule 54*bis*.1(a)) (as opposed to starting examination only once that time limit has expired)

□ Effective for demands made on or after July 1, 2019

PCT Assembly 2019

■ Agreed:

□ new Regulation amendment proposals:

- permit incorporation by reference of correct elements or parts of IAs in case of erroneously filed elements and parts (as opposed to existing Rules on missing parts) ([PCT/WG/12/9](#)) [New Rules 20.5*bis* & 40*bis*]
- IPEAs to be required to copy certain documents in their files to the IB, which would make them available to the public on behalf of elected Offices (will increase the transparency of the international preliminary examination) ([PCT/WG/12/12](#))
- permit correction or addition of Rule 4.11 indications (on kind of protection sought e.g. parent/child relationship, such as continuation or continuation-in-part for US) ([PCT/WG/12/8](#)) [New Rule 26*quater*]
- legal basis to permit fee transfers via the IB (enabling future centralized payment) ([PCT/WG/12/20](#))
- excuse of delay in meeting time limits because of Office electronic system unavailability (due to unforeseen Office system outages or scheduled maintenance) ([PCT/WG/12/17](#)) [New Rule 82*quater*.2]

□ Amendments will enter into force generally on July 1, 2020

PCT WG 2019

■ Not agreed:

- proposed fee reduction for universities
- proposal to give all PCT applicants choice of all ISAs
- Further work will be done on these two proposals

■ Noted Progress reports on:

- IP5 Collaborative Search and Examination Pilot
- Netting of PCT fees
- PCT sequence listing standard
- PCT online services
- PCT Minimum Documentation

■ User groups attending:

- APAA, AIPPI, FICPI, EPI, I3PM, UNION-IP, JIPA, JPAA

PCT Minimum Documentation Task Force: state of play?

■ PCT Minimum Document Task Force:

- ❑ Objective A: updated inventory of patent collections, expected to be published in coming months
- ❑ Objectives B & C: significant progresses made on the legal requirements and technical requirements for a patent collection to belong to the PCT Minimum Documentation
- ❑ Objective D: inclusion of NPL and TK-based prior art: questionnaire launched by the USPTO (leader on this objective) Minimum Documentation task Force :
 - For further details, see Documents [PCT/WG/12/16](#) and [PCT/WG/12/25](#)
 - Further discussions expected at MIA 2020



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Recent developments

Recent Developments: Overview

- Color drawings
- Use of fax at the IB
- *PATENTSCOPE / WIPO Pearl / Patent Register Portal*
- Collaborative Search & Examination Pilot
- PCT and PPH
- *IP Portal*

Practical development: color drawings (1)

- IB has implemented an “interim solution” on color drawings in PCT applications:
 - Electronic applications filed with ROs using ePCT-Filing (or PCT-SAFE for RO/IB) can indicate that the application as uploaded contains color images
 - This indication triggers a notification on the front page of the published application that the originally-filed application contains color drawings which are available for download from PATENTSCOPE

- may be helpful for DOs which accept color drawings, although:
 - the legal PCT requirement still has not yet changed
 - color images or greyscale will be converted by the IB to black & white and published that way in the officially published version of the application
 - DOs may still require black & white in the national phase

Practical development: color drawings (2)

- the interim practice's purpose is not to encourage the use of color images but to recognize that many IAs do in fact contain color images and allow/assist DOs which accept them to more easily access them
- eventual goal is to have full color processing through international phase and into national phase, and adapted legal requirements

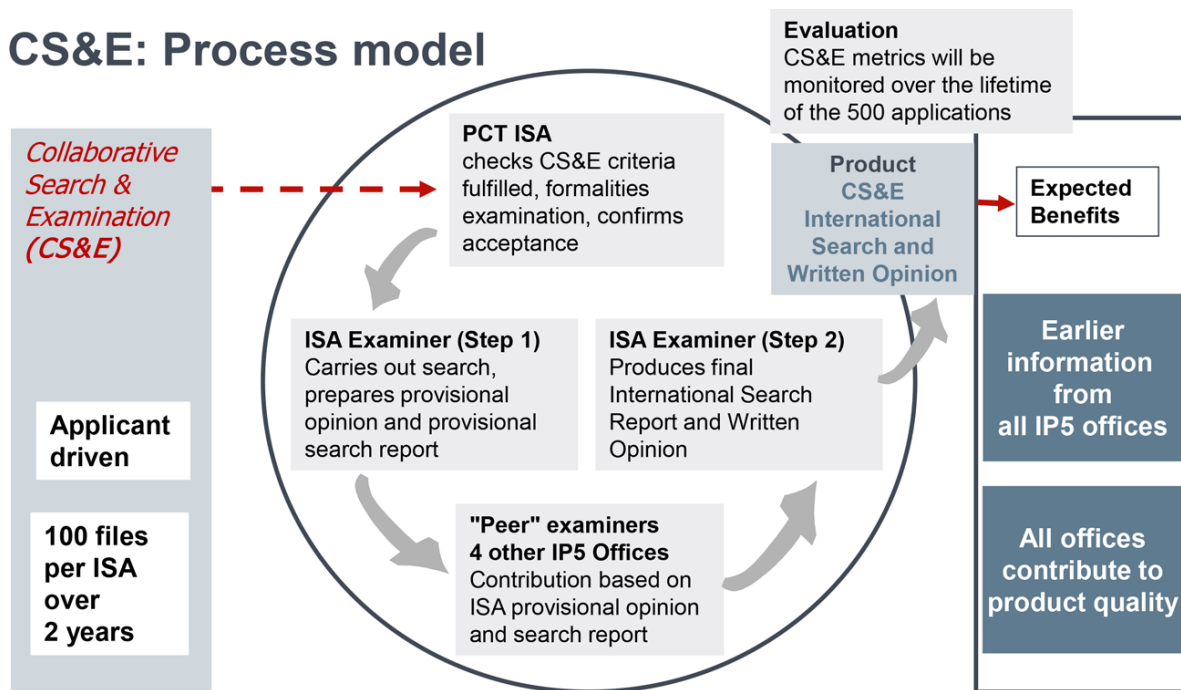
Practical development: contingency upload

- Providing an alternate means for submitting documents and filing applications without having to use ePCT or for use in the exceptional situation that ePCT is not available
 - <https://pct.wipo.int/ePCTExternal/pages/UploadDocument.xhtml>
 - Allows uploading of PDF documents without having to sign into a WIPO account—you provide email address which is validated, then get a link to the service. You upload the document(s) and get an automated confirmation of receipt
- WIPO continues to strongly encourage use of ePCT for filing and submitting subsequent documents
- Demo version of the contingency service available for testing

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

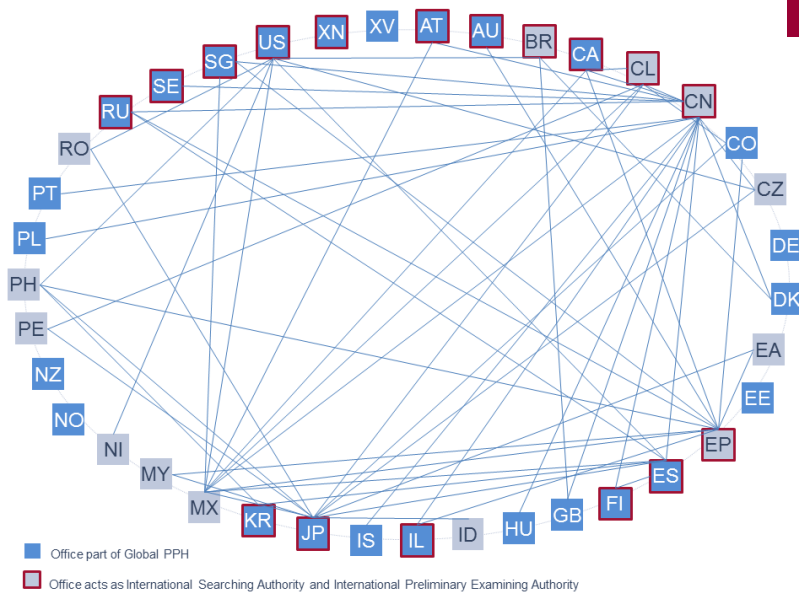
CS&E: Process model



Patent Prosecution Highway (PPH) and PCT

- Accelerated examination in the national phase based on a positive work product of an International Authority (written opinion of the ISA or the IPEA, IPRP (Chapter I or II))
- Conditions:
 - At least one claim has been determined by the ISA or the IPEA to meet the PCT criteria of novelty, inventive step and industrial applicability; and

- ALL the claims must sufficiently correspond to the claims deemed to meet the PCT criteria (they are of the same or similar scope or they are of narrower scope than the claims in the PCT application)



Patent Prosecution Highway (PPH) and PCT

- Global PPH complements existing bilateral PPH agreements
 - Introduction of Global PPH Pilot in January 2014
 - Single set of qualifying requirements that simplifies the existing PPH network so that it is more accessible for users
 - Global PPH includes PCT-PPH

■ PCT Website:
www.wipo.int/pct/en/filing/pct_pph.html

■ Information on the PPH Portal:
www.jpo.go.jp/ppph-portal/index.htm

■ Information on procedures and forms can be found on the websites of the participating Offices

■ The IB requests feedback on experience with PCT-PPH at pct.legal@wipo.int





Thank you for your attention !

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