



Advanced PCT Seminar For Patent Practitioners

Organized by



SCHWEGMAN ■ LUNDBERG ■ WOESSNER
PATENT PROTECTION FOR HIGH TECHNOLOGY

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Speakers

Carol Bidwell
pct-carol@wbhsi.net
520-825-7426

T. David Reed
David@TDRPatents.com
513-752-6261

US Consultants to WIPO on PCT Matters

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(ii)

Names & Abbreviations

The following words and expressions used throughout this document should be understood as follows:

Administrative Instructions	- the Administrative Instructions under the PCT
Article	- an Article of the PCT
Chapter I	- Chapter I of the PCT (and the procedures there under)
Chapter II	- Chapter II of the PCT (and the procedures there under)
Contracting State	- a State (country) party to the PCT
Demand	- a Demand for International Preliminary Examination
International Phase	- the phase under which an application is processed under the PCT
National Phase	- the phase under which an application is processed under national law
Regional Phase	- the phase under which an application is processed by a regional organization (EPO, EAPO, ARIPO, OAPI)
Regulations	- the Regulations under the PCT
Rule	- a Rule of the regulations of the PCT
Section	- a Section of the Administrative Instructions under the PCT

References to “national” Office or national fees, national processing, national phase, should be understood to include “regional” Office, regional fees, regional processing, regional phase, etc.

The following abbreviations used throughout this document should be understood as follows:

ARIPO	- African Regional Industrial Property Organization
DO	- Designated Office under the PCT (Chapter I)
EAPO	- Eurasian Patent Office
EO	- Elected Office under the PCT (Chapter II)
EPO	- European Patent Office
IB	- International Bureau (of the World Intellectual Property Organization)
IPE	- International Preliminary Examination
IPEA	- International Preliminary Examining Authority
IPER	- International Preliminary Examination Report (pre-1/1/2004 applications)
IPRP (Chapter I)	- International Preliminary Report on Patentability (Chapter I of the PCT)
IPRP (Chapter II)	- International Preliminary Report on Patentability (Chapter II of the PCT)
ISA	- International Searching Authority
ISR	- International Search Report
PCT	- Patent Cooperative Treaty
PPH	- Patent Prosecution Highway
OAPI	- Organisation Africaine de la Propriété Intellectuelle (African Intellectual Property Organization)
RO	- Receiving Office
SIS	- Supplementary International Search
SISA	- Supplementary International Searching Authority
SIS Report (SISR)	- Supplementary International Search Report
WIPO	- World Intellectual Property Organization
WOISA	- Written Opinion of the International Searching Authority
WTO	- World Trade Organization



An Overview the PCT System

General remarks on the PCT system (1)

- The PCT system is a patent “filing” system, not a patent “granting” system. There is no “PCT” or “international” patent
- The PCT system provides for
 - an international phase comprising:
 - filing of the international application
 - international search and written opinion of the ISA
 - international publication
 - optional supplementary international search and
 - optional international preliminary examination
 - a national/regional phase before designated Offices
- The decision on granting patents is taken exclusively by national or regional Offices in the national phase

General remarks on the PCT system (2)

- All PCT Contracting States must also be party to the Paris Convention
- An international application that has been accorded an international filing date has the same effect of a regular national application in each designated State as of its international filing date
- Only inventions may be protected via the PCT by applying for patents, utility models and similar titles
- Design and trademark protection cannot be obtained via the PCT; there are separate international conventions dealing with these types of industrial property protection (the Hague Agreement and the Madrid Agreement and Protocol, respectively)
- The PCT is administered by World Intellectual Property Organization (WIPO) as are other international conventions in the field of industrial property, such as the Paris Convention



PCT Contracting States (142) - Regional Offices (1)

States designated for regional and national protection except where otherwise indicated

<u>AP ARIPO Patent</u>	<u>EA Eurasian Patent</u>	<u>OA OAPI Patent</u>
BW Botswana	AM Armenia	▲ BF Burkina Faso
GH Ghana	AZ Azerbaijan	▲ BJ Benin
GM Gambia	BY Belarus	▲ CF Central African Republic
KE Kenya	KG Kyrgyzstan	▲ CG Congo
LR Liberia	KZ Kazakhstan	▲ CI Côte d'Ivoire
LS Lesotho	MD Republic of Moldova	▲ CM Cameroon
MW Malawi	RU Russian Federation	▲ GA Gabon
MZ Mozambique	TJ Tajikistan	▲ GN Guinea
NA Namibia	TM Turkmenistan	▲ GQ Equatorial Guinea
SD Sudan		▲ GW Guinea-Bissau
SL Sierra Leone		▲ ML Mali
▲ SZ Swaziland		▲ MR Mauritania
TZ United Republic of Tanzania		▲ NE Niger
UG Uganda		▲ SN Senegal
ZM Zambia		▲ TD Chad
ZW Zimbabwe		▲ TG Togo



PCT Contracting States (142) - Regional Offices (2)

States designated for regional and national protection except where otherwise indicated

EP European Patent

AL	Albania ¹	▲ GR	Greece	▲ MT	Malta
AT	Austria	HR	Croatia	▲ NL	Netherlands
▲ BE	Belgium	HU	Hungary	NO	Norway
BG	Bulgaria	▲ IE	Ireland	PL	Poland
CH	Switzerland	IS	Iceland	PT	Portugal
▲ CY	Cyprus	▲ IT	Italy	RO	Romania
CZ	Czech Republic	LI	Liechtenstein	RS	Serbia ²
DE	Germany	LT	Lithuania	SE	Sweden
DK	Denmark	LU	Luxembourg	▲ SI	Slovenia
EE	Estonia	▲ LV	Latvia	SK	Slovakia
ES	Spain	▲ MC	Monaco	SM	San Marino
FI	Finland	MK	The former Yugoslav Republic of Macedonia	TR	Turkey
▲ FR	France				
GB	United Kingdom				

▲ Regional patent only

¹ Became party to the EPO effective 1 May 2010

² Became party to the EPO effective 1 October 2010



PCT Contracting States (142)

States designated for national protection only except where otherwise indicated

AE	United Arab Emirates	GT	Guatemala	NG	Nigeria
AG	Antigua and Barbuda	HN	Honduras	NI	Nicaragua
◇ AL	Albania ¹	ID	Indonesia	NZ	New Zealand
AO	Angola	IL	Israel	OM	Oman
AU	Australia	IN	India	PE	Peru
◇ BA	Bosnia and Herzegovina	JP	Japan	PG	Papua New Guinea
BB	Barbados	KM	Union of the Comoros	PH	Philippines
BH	Bahrain	KN	Saint Kitts and Nevis	◇ RS	Serbia ²
BR	Brazil	KP	Democratic People's Republic of Korea	SC	Seychelles
BZ	Belize	KR	Republic of Korea	SG	Singapore
CA	Canada	LA	Lao People's Democratic Republic	ST	Sao Tome & Principe
CL	Chile	LC	Saint Lucia	SV	El Salvador
CN	China	LK	Sri Lanka	SY	Syrian Arab Republic
CO	Colombia	LR	Liberia	TH	Thailand
CR	Costa Rica	LY	Libyan Arab Jamahiriya	TN	Tunisia
CU	Cuba	MA	Morocco	TT	Trinidad and Tobago
DM	Dominica	ME	Montenegro	UA	Ukraine
DO	Dominican Republic	◇ MG	Madagascar	US	United States of America
DZ	Algeria	MN	Mongolia	UZ	Uzbekistan
EC	Ecuador	MX	Mexico	VC	Saint Vincent and the Grenadines
EG	Egypt	MY	Malaysia	VN	Viet Nam
GD	Grenada			ZA	South Africa
GE	Georgia				

◇ Extension of European patent possible

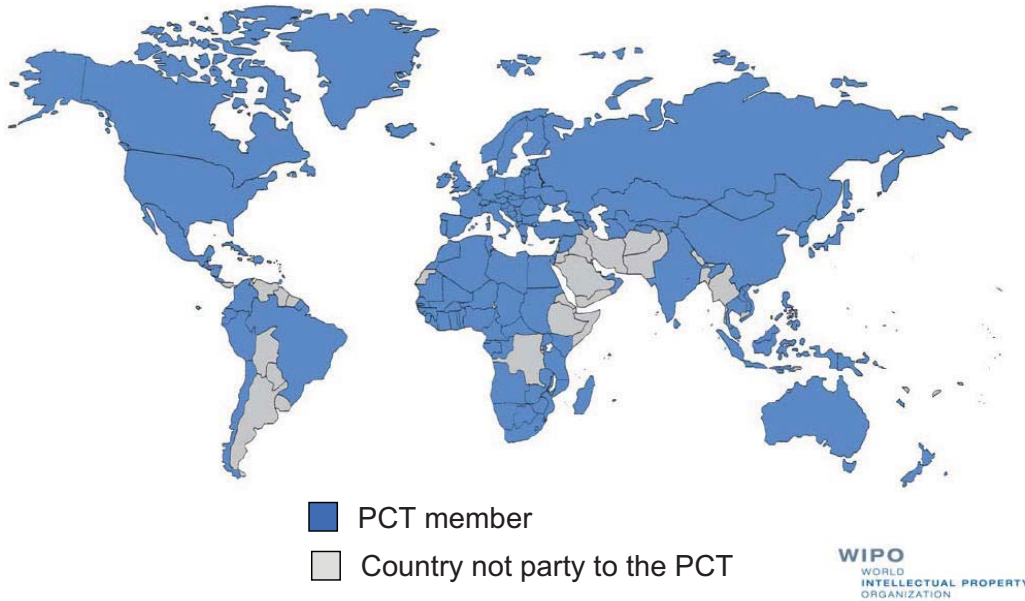
◆ Extension of European patent possible for applications filed on or after 1 March 2010

¹ Continues to apply to international applications filed before 1 May 2010

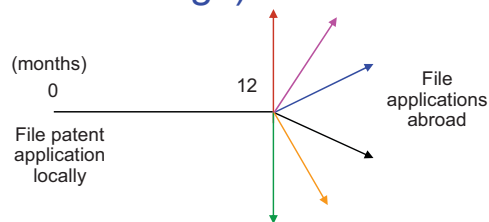
² Continues to apply to international application filed before 1 October 2010



PCT Contracting States (as of 1 December 2010)



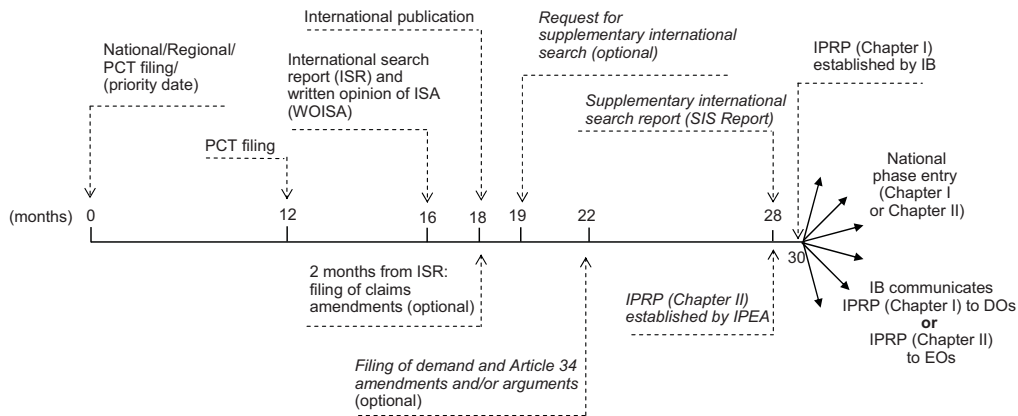
Traditional patent system (Paris Convention filings)



Local patent application followed within 12 months by multiple foreign applications claiming priority under Paris Convention:

- multiple formality requirements
- multiple searches
- multiple publications
- multiple examinations and prosecutions of applications
- translations and national fees required at 12 months

PCT timeline



Note: The national Offices of the following States have notified the International Bureau that they will not apply the 30 month time limit under Chapter I, as of 1 April 2002, for as long as modified Article 22(1) is not compatible with their national law:

LU	Luxembourg
TZ	United Republic of Tanzania
UG	Uganda

If no demand is filed before the expiration of 19 months, the national phase will have to be entered before the expiration of 20 or 21 months from the priority date. This reservation to the modified Article 22(1) timing does not apply when seeking patent protection in these countries via the EPO (LU) or ARIPO (TZ & UG).

Minimum requirements for a receiving Office to accord an international filing date (Article 11(1))

- At least one applicant must be a national or resident of a PCT Contracting State
- The application must be in a prescribed language
- The application must contain at least:
 - an indication that it is intended as an international application (Rule 4.2)
 - a request which has the effect of making all possible designations (Article 4 and Rules 3 and 4.9)
 - the name of the applicant (Rule 4.5)
 - a description (Rule 5)
 - a claim (Rule 6)

Competent receiving Office (RO)

- In order for a RO to be competent to accord an international filing date
 - at least one of the applicants must have the right to file with the RO for reasons of nationality or residence
 - the application must be in a language accepted by the RO
- Note that if:
 - at least one of the applicants is a resident or national of a PCT Contracting State but none of the applicants have the right to file with the RO for reasons of residence or nationality (Rules 18 and 19) or
 - the application is filed in a language not accepted by the RO for that purpose

that Office will transmit the application to the receiving Office of the International Bureau (RO/IB) for further processing (Rule 19.4)

Not required for obtaining an international filing date

- Payment of fees
- Translation into language of search or publication
- Applicant's signature
- Title of the invention
- Abstract
- Drawings, whether formal or not
 - however, attention should be given to the question of whether the drawings are necessary for the understanding of the invention;
 - later furnishing of drawings will, under certain conditions, result in a change of the international filing date (see Article 14(2) and Rule 20.5)

Concept and operation of designation system

- Automatic and all-inclusive designation of all PCT States bound
 - exception to the all-inclusive designation possible for DE, JP and KR, that is, countries with particular rules on “self-designation”
 - but only if the international application contains a priority claim to an earlier application filed in the State that is to be excluded (see Annex B1 of the PCT Applicant’s Guide for DE, JP and KR)
 - otherwise withdrawals of designations are possible
- Choice of type of protection is postponed until national phase entry (e.g. patent or utility model, national or regional patent)
- PCT request form may include specific reference to earlier to “parent” application for continuation or CIP applications

The PCT applicant (Article 9 and Rule 18)

- The applicant may be any natural person or legal entity, for example:
 - the assignee
 - the inventor
- It is possible to indicate different applicants for different designated States (Rule 4.5(d))
 - because the US is automatically designated, each inventor should be indicated as an applicant for the US
 - the legal entity cannot be an applicant for the US
- At least one of the applicants must be a national or resident of a PCT Contracting State (Rule 18.3)

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Using PCT Rule 4.17 Declarations

Inclusion of certain declarations during the international phase

- Purpose: possibility to anticipate certain national phase requirements during the international phase (Rule 51bis.2)
- Inclusion in request or subsequent filing is optional
- Declarations relate to the following matters (Rule 4.17)
 - i. identity of the inventor
 - ii. applicant's entitlement to apply for and be granted a patent*
 - iii. applicant's entitlement to claim priority of an earlier application
 - iv. declaration as to inventorship (for US designation only)
 - v. non-prejudicial disclosures or exceptions to lack of novelty
- Declarations must use standardized wording as prescribed in Sections 211 to 215 of the Administrative Instructions
- Where a declaration has been furnished, no documents or evidence as to that matter may be required by the designated/elected Office unless that Office may reasonably doubt the veracity of the declaration* (except evidence for non-prejudicial disclosures or exceptions to lack of novelty)

* Declaration not accepted in HU

Adding or correcting declarations (Rule 26ter)

- Applicants may add or correct declarations filed under Rule 4.17
- Time limit: until the expiration of 16 months from the priority date (or even later, provided that the declaration is received by the IB before completion of technical preparations for international publication)
- The RO or IB may invite applicant to correct any declaration that is not worded as required or in the case of the declaration of inventorship (Rule 4.17(iv)), is not signed as required
- When a declaration is furnished after the international filing date, no further page fee would be required



Using Rule 4.17(ii) and (iii) declarations

- In order to use these declaration sheets the assignment documents must have been executed prior to the international filing date
- Applicant should consider filing a Rule 4.17(ii) declaration (applicant's entitlement as of the international filing date, to apply for and be granted a patent) and a Rule 4.17(iii) declaration (applicant's entitlement, as of the international filing date, to claim priority of an earlier application)
 - either together with the international application or
 - adding each to the international application within the 26ter time limit

where the applicant for the designated/elected Office is not the inventor or is different than the applicant for the priority application

- This centralized procedure is more advantageous for applicants than complying with widely varying requirements of national laws, for example, legalization procedures, when entering the national phase



Box No. VIII (ii) DECLARATION: ENTITLEMENT TO APPLY FOR AND BE GRANTED A PATENT

The declaration must conform to the standardized wording provided for in Section 212; see Notes to Boxes Nos. VIII, VIII (i) to (v) (in general) and the specific Notes to Box No. VIII (ii). If this Box is not used, this sheet should not be included in the request.

Declaration as to the applicant's entitlement, as at the international filing date, to apply for and be granted a patent (Rules 4.17(ii) and 51bis.1(a)(ii)), in a case where the declaration under Rule 4.17(iv) is not appropriate:

in relation to this international application

CANDY WRAP UNLIMITED, INC., is entitled to apply for and be granted a patent by virtue of the following:

an assignment from:

JONES, Mary to CANDY WRAP UNLIMITED, INC., dated 20 January 2011 (20.01.2011).

This declaration is continued on the following sheet, "Continuation of Box No. VIII (ii)".

Box No. VIII (iii) DECLARATION: ENTITLEMENT TO CLAIM PRIORITY

The declaration must conform to the standardized wording provided for in Section 213; see Notes to Boxes Nos. VIII, VIII (i) to (v) (in general) and the specific Notes to Box No. VIII (iii). If this Box is not used, this sheet should not be included in the request.

Declaration as to the applicant's entitlement, as at the international filing date, to claim the priority of the earlier application specified below, where the applicant is not the applicant who filed the earlier application or where the applicant's name has changed since the filing of the earlier application (Rules 4.17(iii) and 51bis.1(a)(iii)):

in relation to this international application,

CANDY WRAP UNLIMITED, INC., is entitled to claim priority of earlier application US 61/999,999 by virtue of the following:

an assignment from:

JONES, MARY to CANDY WRAP UNLIMITED, INC., dated 20 January 2011 (20.01.2011)

This declaration is continued on the following sheet, "Continuation of Box No. VIII (iii)".

as to the applicant's entitlement to apply for and be granted a patent (Rule 4.17(ii)). For details on such a combined declaration, see Notes to Box No. VIII (ii), below. For details as to the declaration of inventorship for the purposes of the designation of the United States of America, see Notes to Box No. VIII (iv), below.

BOX No. VIII (ii)

Declaration as to the Applicant's Entitlement to Apply for and Be Granted a Patent (Rule 4.17(ii) and Section 212): The declaration must be worded as follows, with such inclusion, omission, repetition and re-ordering of the matters listed as items (i) to (viii) as is necessary to explain the applicant's entitlement:

"Declaration as to the applicant's entitlement, as at the international filing date, to apply for and be granted a patent (Rules 4.17(ii) and 51*bis*.1(a)(ii)), in a case where the declaration under Rule 4.17(iv) is not appropriate:

in relation to [this] international application [No. PCT/...],

... (*name*) is entitled to apply for and be granted a patent by virtue of the following:

- (i) ... (*name*) of ... (*address*) is the inventor of the subject matter for which protection is sought by way of [the] [this] international application
- (ii) ... (*name*) [is] [was] entitled as employer of the inventor, ... (*inventor's name*)
- (iii) an agreement between ... (*name*) and ... (*name*), dated ...
- (iv) an assignment from ... (*name*) to ... (*name*), dated ...
- (v) consent from ... (*name*) in favor of ... (*name*), dated ...
- (vi) a court order issued by ... (*name of court*), effecting a transfer from ... (*name*) to ... (*name*), dated ...
- (vii) transfer of entitlement from ... (*name*) to ... (*name*) by way of ... (*specify kind of transfer*), dated ...
- (viii) the applicant's name changed from ... (*name*) to ... (*name*) on ... (*date*)"

Items (i) to (viii) may be incorporated as is necessary to explain the applicant's entitlement. **This declaration is only applicable to those events which have occurred prior to the international filing date.** The possible kinds of transfer of entitlement in item (vii) include merger, acquisition, inheritance, donation, etc. Where there has been a succession of transfers from the inventor, the order in which transfers are listed should follow the actual succession of transfers, and items may be included more than once, as necessary to explain the applicant's entitlement. Where the inventor is not indicated in Box No. II or No. III, this declaration may be presented as a combined declaration explaining the applicant's entitlement to apply for and be granted a patent and identifying the inventor. In such a case, the introductory phrase of the declaration must be as follows:

"Combined declaration as to the applicant's entitlement, as at the international filing date, to apply for and be granted a patent (Rules 4.17(ii) and 51*bis*.1(a)(ii)) and as to the identity of the inventor (Rules 4.17(i) and 51*bis*.1(a)(i)), in a case where the declaration under Rule 4.17(iv) is not appropriate:"

The remainder of the combined declaration must be worded as indicated in the preceding paragraphs.

For details as to the declaration as to the identity of the inventor, see the Notes to Box No. VIII (i), above.

BOX No. VIII (iii)

Declaration as to the Applicant's Entitlement to Claim Priority of the Earlier Application (Rule 4.17(iii) and Section 213): The declaration must be worded as follows, with such inclusion, omission, repetition and re-ordering of

Notes to the request form (PCT/RO/101) (page 6) (January 2010)

the matters listed as items (i) to (viii) as is necessary to explain the applicant's entitlement:

"Declaration as to the applicant's entitlement, as at the international filing date, to claim the priority of the earlier application specified below, where the applicant is not the applicant who filed the earlier application or where the applicant's name has changed since the filing of the earlier application (Rules 4.17(iii) and 51*bis*.1(a)(iii)):

in relation to [this] international application [No. PCT/...],

... (*name*) is entitled to claim priority of earlier application No. ... by virtue of the following:

- (i) the applicant is the inventor of the subject matter for which protection was sought by way of the earlier application
- (ii) ... (*name*) [is] [was] entitled as employer of the inventor, ... (*inventor's name*)
- (iii) an agreement between ... (*name*) and ... (*name*), dated ...
- (iv) an assignment from ... (*name*) to ... (*name*), dated ...
- (v) consent from ... (*name*) in favor of ... (*name*), dated ...
- (vi) a court order, issued by ... (*name of court*), effecting a transfer from ... (*name*) to ... (*name*), dated ...
- (vii) transfer of entitlement from ... (*name*) to ... (*name*) by way of ... (*specify kind of transfer*), dated ...
- (viii) the applicant's name changed from ... (*name*) to ... (*name*) on ... (*date*)"

Items (i) to (viii) may be incorporated as is necessary to explain the applicant's entitlement. **This declaration is only applicable to those events which have occurred prior to the international filing date.** In addition, this declaration is only applicable where the person or name of the applicant is different from that of the applicant who filed the earlier application from which priority is claimed. For example, this declaration may be applicable where only one applicant out of five is different from the applicants indicated in respect of an earlier application. The possible kinds of transfer of entitlement in item (vii) include merger, acquisition, inheritance, donation, etc. Where there has been a succession of transfers from the applicant in respect of the earlier application, the order in which transfers are listed should follow the actual succession of transfers, and items may be included more than once, as necessary to explain the applicant's entitlement.

BOX No. VIII (iv)

Declaration of Inventorship (Rule 4.17(iv) and Section 214): The standardized wording for the declaration is pre-printed in Box No. VIII (iv).

The name, residence, address and citizenship must be indicated for each inventor. If the name and address of an inventor is not written in the Latin alphabet, the name and address must be indicated in the Latin alphabet. All inventors must sign and date the declaration even if they do not all sign the same copy of the declaration (Section 214(b)).

If there are more than two inventors, those other inventors must be indicated on the "Continuation of Box No. VIII (i) to (v)" sheet. The continuation sheet should be entitled "Continuation of Box No. VIII (iv)," must indicate the name, residence, address and citizenship for those other inventors, and at least the name and address in the Latin alphabet. In such a case, the "complete declaration" includes Box No. VIII (iv) and the continuation sheet. All inventors must sign and date a complete declaration even if they do not all sign the same copy of the complete declaration, and a copy of each separately signed complete declaration must be submitted (Section 214(b)).

Where the declaration was not included in the request, but is furnished later, the PCT application number MUST be indicated within the text of Box No. VIII (iv).

Declaration of inventorship (Rule 4.17(iv)) (only for US designation)

- All inventors need to be named in the same declaration
- Declaration must be signed and dated by all inventors (named as applicants)
- Signatures may appear on different copies of the same complete declaration
- Signature does not have to be an original (fax copy)
- DO/US accepts a seal as signature when the international application is filed with receiving Offices which accept seals as signatures
- It is only necessary to include prior applications filed in or for a country other than US, having a filing date earlier than the earliest priority date claimed in the PCT application

A new US declaration may be required during national stage proceedings

- A new declaration must be filed if:
 - there was a change in the international filing date pursuant to PCT Rule 20.5(c) (that is, caused by the addition of missing sheets) after the declaration was executed
 - there was a change in the inventive entity effected under PCT Rule 92*bis* after the declaration was executed and no declaration naming and executed by the new inventive entity has been filed in the application
- If a foreign priority claim has been added or corrected under PCT Rule 26*bis* during the international phase after the declaration was executed, applicant will be required to submit either a new declaration or an application data sheet correctly identifying the application to which priority is claimed

Publication of declarations

- Declarations received within the applicable time limits will be mentioned on the front page of the published international application
- The full text of the declarations will be published as part of the international application

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Priority under the Paris Convention for the Protection of Industrial Property

Claiming priority (PCT Article 8 and Rule 4.10)

- The international application may contain a declaration claiming the priority of one or more earlier applications
 - filed in or by way of a regional or international application for any country party to the Paris Convention and/or
 - filed in any Member of the World Trade Organization (WTO) that is not party to the Paris Convention

The Paris Convention for the Protection of Industrial Property

- Article 2 - National Treatment for Nationals of Countries of the Union
 - nationals of one Paris Convention country have the same right to protection of industrial property in other member countries as is offered by each other member country to its nationals
 - there is no requirement that the applicant must reside in the country where protection is claimed
- Article 3 - Same Treatment for Certain Categories of Persons as for Nationals of Countries of the Union
 - nationals of countries that are not members of the Paris Convention but who live in, or have real and effective industrial or commercial establishments in a Paris Convention country, shall be treated in the same manner as nationals of a Paris Convention country

Article 4 – Paragraph A

- A. — (1) Any person who has duly filed an application for a patent, or for the registration of a utility model, or of an industrial design, or of a trademark, in one of the countries of the Union, or his successor in title, shall enjoy, for the purpose of filing in the other countries, a right of priority during the periods hereinafter fixed.
- (2) Any filing that is equivalent to a regular national filing under the domestic legislation of any country of the Union or under bilateral or multilateral treaties concluded between countries of the Union shall be recognized as giving rise to the right of priority.
- (3) By a regular national filing is meant any filing that is adequate to establish the date on which the application was filed in the country concerned, whatever may be the subsequent fate of the application.

Article 4 - Paragraph B

B. —Consequently, any subsequent filing in any of the other countries of the Union before the expiration of the periods referred to above shall not be invalidated by reason of any acts accomplished in the interval, in particular, another filing, the publication or exploitation of the invention, the putting on sale of copies of the design, or the use of the mark, and such acts cannot give rise to any third-party right or any right of personal possession. Rights acquired by third parties before the date of the first application that serves as the basis for the right of priority are reserved in accordance with the domestic legislation of each country of the Union.

Article 4 - Paragraph C

C. — (1) The periods of priority referred to above shall be twelve months for patents and utility models, and six months for industrial designs and trademarks.

(2) These periods shall start from the date of filing of the first application; the day of filing shall not be included in the period.

(3) If the last day of the period is an official holiday, or a day when the Office is not open for the filing of applications in the country where protection is claimed, the period shall be extended until the first following working day.

(4) A subsequent application concerning the same subject as a previous first application within the meaning of paragraph (2), above, filed in the same country of the Union, shall be considered as the first application, of which the filing date shall be the starting point of the period of priority, if, at the time of filing the subsequent application, the said previous application has been withdrawn, abandoned, or refused, without having been laid open to public inspection and without leaving any rights outstanding, and if it has not yet served as a basis for claiming a right of priority. The previous application may not thereafter serve as a basis for claiming a right of priority.

Article 4 - Paragraph D

D. — (1) Any person desiring to take advantage of the priority of a previous filing shall be required to make a declaration indicating the date of such filing and the country in which it was made. Each country shall determine the latest date on which such declaration must be made.

(2) These particulars shall be mentioned in the publications issued by the competent authority, and in particular in the patents and the specifications relating thereto.

(3) The countries of the Union may require any person making a declaration of priority to produce a copy of the application (description, drawings, etc.) previously filed. The copy, certified as correct by the authority which received such application, shall not require any authentication, and may in any case be filed, without fee, at any time within three months of the filing of the subsequent application. They may require it to be accompanied by a certificate from the same authority showing the date of filing, and by a translation.

(4) No other formalities may be required for the declaration of priority at the time of filing the application. Each country of the Union shall determine the consequences of failure to comply with the formalities prescribed by this Article, but such consequences shall in no case go beyond the loss of the right of priority.

(5) Subsequently, further proof may be required. Any person who avails himself of the priority of a previous application shall be required to specify the number of that application; this number shall be published as provided for by paragraph (2), above.

Article 4 - Paragraphs E and F

E. — (1) Where an industrial design is filed in a country by virtue of a right of priority based on the filing of a utility model, the period of priority shall be the same as that fixed for industrial designs.

(2) Furthermore, it is permissible to file a utility model in a country by virtue of a right of priority based on the filing of a patent application, and vice versa.

F. — No country of the Union may refuse a priority or a patent application on the ground that the applicant claims multiple priorities, even if they originate in different countries, or on the ground that an application claiming one or more priorities contains one or more elements that were not included in the application or applications whose priority is claimed, provided that, in both cases, there is unity of invention within the meaning of the law of the country. With respect to the elements not included in the application or applications whose priority is claimed, the filing of the subsequent application shall give rise to a right of priority under ordinary conditions.

Article 4 - paragraphs G through I

G. — (1) If the examination reveals that an application for a patent contains more than one invention, the applicant may divide the application into a certain number of divisional applications and preserve as the date of each the date of the initial application and the benefit of the right of priority, if any.

(2) The applicant may also, on his own initiative, divide a patent application and preserve as the date of each divisional application the date of the initial application and the benefit of the right of priority, if any. Each country of the Union shall have the right to determine the conditions under which such division shall be authorized.

H. — Priority may not be refused on the ground that certain elements of the invention for which priority is claimed do not appear among the claims formulated in the application in the country of origin, provided that the application documents as a whole specifically disclose such elements.

I. — (1) Applications for inventors' certificates filed in a country in which the right to apply at their own option either for a patent or for an inventor's certificate shall give rise to the right of priority provided for by this Article, under the same conditions and with the same effects as applications for patents.

(2) In a country in which applicants have the right to apply at their own option either for a patent or for an inventor's certificate, an applicant for an inventor's certificate shall, in accordance with the provisions of this Article relating to patent applications, enjoy a right of priority based on an application for a patent, a utility model, or an inventor's certificate.

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Possible legal consequences of the USPTO accepting electronic applications on Saturday and Sunday

- International applications (or any other patent document) can be filed electronically in the USPTO during the hours of operation of EFS-Web every day of the week, including weekends and holidays
- Paris Convention Article 4C(3) says “If the last day of the period is an official holiday, or a day when the Office is not open for the filing of applications in the country where protection is claimed, the period shall be extended until the first following working day”
- Applicants should consider possible adverse consequences regarding the validity of a Paris Convention priority claim if they wait until Monday to file an international application in the RO/US where the priority year ends on a Saturday or Sunday

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Different language in the U.S. statute than the Paris Convention

- 35 U.S.C. 21(b) states:

When the day or the last day, for taking any action or paying any fee in the United States Patent and Trademark Office falls on Saturday, Sunday or a Federal holiday within the District of Columbia, the action may be taken or fee paid on the next succeeding secular or business day

- 35 U.S.C. 119(e)(3) states:

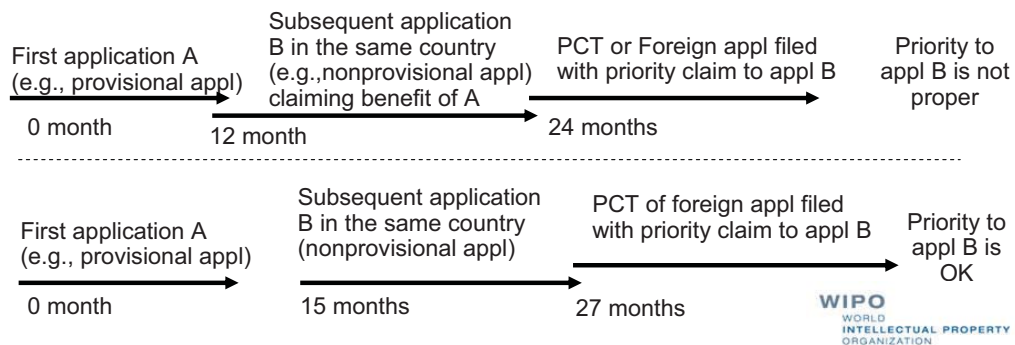
If the day that is 12 months after the filing date of a provisional application falls on a Saturday, Sunday or Federal holiday within the District of Columbia, the period of pendency of the provisional application shall be extended to the next secular or business day

- Under US law applicants are permitted to take action on the next business day when the last day for taking action falls on a weekend or Federal holiday, regardless of the mode or form of filing



When is a subsequent application concerning the same subject matter considered the “first” application within the meaning of Article 4 C (4)?

1. First application has been withdrawn, abandoned or refused AND
2. First application has not been laid open to public inspection AND
3. First application has left no rights outstanding AND
4. First application has not yet served as the basis for claiming the right of priority



States Party to the PCT and the Paris Convention and Members of the World Trade Organization (status on 14 October 2010)							
States/Members	PCT (142)	Paris (173)	WTO (153)	States/Members	PCT	Paris	WTO
Albania (AL)	X	X	X	Cape Verde (CV)	–	–	X
Algeria (DZ)	X	X	–	Central African Republic (CF)	X	X	X
Andorra (AD)	–	X	–	Chad (TD)	X	X	X
Angola (AO)	X	X	X	Chile (CL)	X	X	X
Antigua and Barbuda (AG)	X	X	X	China (CN)	X ¹	X ^{1,2}	X
Argentina (AR)	–	X	X	Colombia (CO)	X	X	X
Armenia (AM)	X	X	X	Comoros (KM)	X	X	–
Australia (AU)	X	X	X	Congo (CG)	X	X	X
Austria (AT)	X	X	X	Costa Rica (CR)	X	X	X
Azerbaijan (AZ)	X	X	–	Côte d'Ivoire (CI)	X	X	X
Bahamas (BS)	–	X	–	Croatia (HR)	X	X	X
Bahrain (BH)	X	X	X	Cuba (CU)	X	X	X
Bangladesh (BD)	–	X	X	Cyprus (CY)	X	X	X
Barbados (BB)	X	X	X	Czech Republic (CZ)	X	X	X
Belarus (BY)	X	X	–	Democratic People's Republic of Korea (KP)	X	X	–
Belgium (BE)	X	X	X	Democratic Republic of the Congo (CD)	–	X	X
Belize (BZ)	X	X	X	Denmark (DK)	X	X	X
Benin (BJ)	X	X	X	Djibouti (DJ)	–	X	X
Bhutan (BT)	–	X	–	Dominica (DM)	X	X	X
Bolivia (Plurinational State of) (BO)	–	X	X	Dominican Republic (DO)	X	X	X
Bosnia and Herzegovina (BA)	X	X	–	Ecuador (EC)	X	X	X
Botswana (BW)	X	X	X	Egypt (EG)	X	X	X
Brazil (BR)	X	X	X	El Salvador (SV)	X	X	X
Brunei Darussalam (BN)	–	–	X	Equatorial Guinea (GQ)	X	X	–
Bulgaria (BG)	X	X	X	Estonia (EE)	X	X	X
Burkina Faso (BF)	X	X	X	European Communities	–	–	X
Burundi (BI)	–	X	X	Fiji (FJ)	–	–	X
Cambodia (KH)	–	X	X	Finland (FI)	X	X	X
Cameroon (CM)	X	X	X	France (FR)	X	X	X
Canada (CA)	X	X	X	Gabon (GA)	X	X	X

[continued on next page]

States Party to the PCT and the Paris Convention and Members of the World Trade Organization (status on 14 October 2010)							
States/Members	PCT	Paris	WTO	States/Members	PCT	Paris	WTO
Gambia (GM)	X	X	X	Lebanon (LB)	–	X	–
Georgia (GE)	X	X	X	Lesotho (LS)	X	X	X
Germany (DE)	X	X	X	Liberia (LR)	X	X	–
Ghana (GH)	X	X	X	Libyan Arab Jamahiriya (LY)	X	X	–
Greece (GR)	X	X	X	Liechtenstein (LI)	X	X	X
Grenada (GD)	X	X	X	Lithuania (LT)	X	X	X
Guatemala (GT)	X	X	X	Luxembourg (LU)	X	X	X
Guinea (GN)	X	X	X	Macao, China (MO)	–	– ²	X
Guinea-Bissau (GW)	X	X	X	Madagascar (MG)	X	X	X
Guyana (GY)	–	X	X	Malawi (MW)	X	X	X
Haiti (HT)	–	X	X	Malaysia (MY)	X	X	X
Holy See (VA)	–	X	–	Maldives (MV)	–	–	X
Honduras (HN)	X	X	X	Mali (ML)	X	X	X
Hong Kong, China (HK)	– ¹	– ¹	X	Malta (MT)	X	X	X
Hungary (HU)	X	X	X	Mauritania (MR)	X	X	X
Iceland (IS)	X	X	X	Mauritius (MU)	–	X	X
India (IN)	X	X	X	Mexico (MX)	X	X	X
Indonesia (ID)	X	X	X	Monaco (MC)	X	X	–
Iran (Islamic Republic of) (IR)	–	X	–	Mongolia (MN)	X	X	X
Iraq (IQ)	–	X	–	Montenegro (ME)	X	X	–
Ireland (IE)	X	X	X	Morocco (MA)	X	X	X
Israel (IL)	X	X	X	Mozambique (MZ)	X	X	X
Italy (IT)	X	X	X	Myanmar (MM)	–	–	X
Jamaica (JM)	–	X	X	Namibia (NA)	X	X	X
Japan (JP)	X	X	X	Nepal (NP)	–	X	X
Jordan (JO)	–	X	X	Netherlands (NL)	X	X	X
Kazakhstan (KZ)	X	X	–	New Zealand (NZ)	X	X	X
Kenya (KE)	X	X	X	Nicaragua (NI)	X	X	X
Kuwait (KW)	–	–	X	Niger (NE)	X	X	X
Kyrgyzstan (KG)	X	X	X	Nigeria (NG)	X	X	X
Lao People's Democratic Republic (LA)	X	X	–	Norway (NO)	X	X	X
Latvia (LV)	X	X	X	Oman (OM)	X	X	X

[continued on next page]

States Party to the PCT and the Paris Convention and Members of the World Trade Organization (status on 14 October 2010)							
States/Members	PCT	Paris	WTO	States/Members	PCT	Paris	WTO
Pakistan (PK)	–	X	X	Sri Lanka (LK)	X	X	X
Panama (PA)	–	X	X	Sudan (SD)	X	X	–
Papua New Guinea (PG)	X	X	X	Suriname (SR)	–	X	X
Paraguay (PY)	–	X	X	Swaziland (SZ)	X	X	X
Peru (PE)	X	X	X	Sweden (SE)	X	X	X
Philippines (PH)	X	X	X	Switzerland (CH)	X	X	X
Poland (PL)	X	X	X	Syrian Arab Republic (SY)	X	X	–
Portugal (PT)	X	X	X	Taiwan, Province of China (TW) ³	–	–	X
Qatar (QA)	–	X	X	Tajikistan (TJ)	X	X	–
Republic of Korea (KR)	X	X	X	Thailand (TH)	X	X	X
Republic of Moldova (MD)	X	X	X	The former Yugoslav Republic of Macedonia (MK)	X	X	X
Romania (RO)	X	X	X	Togo (TG)	X	X	X
Russian Federation (RU)	X	X	–	Tonga (TO)	–	X	X
Rwanda (RW)	–	X	X	Trinidad and Tobago (TT)	X	X	X
Saint Kitts and Nevis (KN)	X	X	X	Tunisia (TN)	X	X	X
Saint Lucia (LC)	X	X	X	Turkey (TR)	X	X	X
Saint Vincent and the Grenadines (VC)	X	X	X	Turkmenistan (TM)	X	X	–
San Marino (SM)	X	X	–	Uganda (UG)	X	X	X
Sao Tome and Principe (ST)	X	X	–	Ukraine (UA)	X	X	X
Saudi Arabia (SA)	–	X	X	United Arab Emirates (AE)	X	X	X
Senegal (SN)	X	X	X	United Kingdom (GB)	X	X	X
Serbia (RS)	X	X	–	United Republic of Tanzania (TZ)	X	X	X
Seychelles (SC)	X	X	–	United States of America (US)	X	X	X
Sierra Leone (SL)	X	X	X	Uruguay (UY)	–	X	X
Singapore (SG)	X	X	X	Uzbekistan (UZ)	X	X	–
Slovakia (SK)	X	X	X	Venezuela (Bolivarian Republic of) (VE)	–	X	X
Slovenia (SI)	X	X	X	Viet Nam (VN)	X	X	X
Solomon Islands (SB)	–	–	X	Yemen (YE)	–	X	–
South Africa (ZA)	X	X	X	Zambia (ZM)	X	X	X
Spain (ES)	X	X	X	Zimbabwe (ZW)	X	X	X

1. China has notified the Director General of WIPO that the PCT and the Paris Convention apply also to the Hong Kong Special Administrative Region.
2. China has notified the Director General of WIPO that the Paris Convention applies also to the Macao Special Administrative Region.
3. Also referred to as "Chinese Taipei" or, within the context of the WTO, as "Separate Customs Territory of Taiwan, Penghu, Kinmen and Matsu."

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Procedural Safeguards

Procedural safeguards

- Incorporation by reference
- Restoration of the right of priority
- Adding and correcting priority claims
- Fee safeguards
- Preventing and postponing publication
- Recording changes
- Rectification of obvious mistakes
- National phase safeguards

Missing elements and parts of the international application (Rule 20)

- Objective:
 - To enable inclusion of accidentally omitted elements or parts that are contained in priority application without affecting the international filing date
 - element = all of the description or all of the claims
 - part = part of the description, part of claims or part or all of pages of drawings
- Conditions:
 - priority application contains the element or part (Rule 20.6(b))
 - request contains statement of (conditional) incorporation by reference (Rule 4.18)
 - timely confirmation of incorporation by reference (Rules 20.6 and 20.7)
- Competent Authority: RO

Confirmation of incorporation by reference (1) (Rules 20.6 and 20.7)

- Time limit: 2 months from filing or from invitation to correct (Rule 20.7)
- Documents to be filed (Rule 20.6):
 - notice of confirmation
 - missing sheets
 - copy of earlier application as filed unless priority document already submitted
 - translation if not in language of international application
 - indication as to where in the priority document (and translation) the missing sheets are contained

Confirmation of incorporation by reference (2) (Rules 20.6 and 20.7)

- If not all requirements for incorporation by reference are fulfilled (for example, if a missing element or part is not entirely contained in the earlier application):
 - the international application is assigned a later filing date (date of receipt of missing element or part),
 - applicant may request that missing part be disregarded (Rule 20.5(e))

Invitation by RO to correct defect under Article 11(1) (Rule 20.3)

- Where entire description or all claims are missing, the RO invites applicant to either:
 - furnish a correction under Article 11(2) and international application is accorded a later filing date or,
 - confirm under Rule 20.6(a) that the element is incorporated by reference under Rule 4.18 and the international filing date is maintained

Effect of incorporation by reference in national phase (Rule 82ter.1(b))

- DOs may, to a limited extent, review decision allowing the incorporation by reference
- Declarations of incompatibility with national law (reservations) were made by a number of ROs and DOs
See WIPO web site at:
http://www.wipo.int/pct/en/texts/reservations/res_incomp.html

Incorporation by reference Declarations of incompatibility with national law

- The following Offices have notified the International Bureau of the incompatibility of Rules 20.3(a)(ii) and (b)(ii), 20.5(a)(ii) and (d), and 20.6 with its national/regional law:
 - Incompatibility as RO (Rule 20.8(a)):
 - BE, CU, CZ, DE, HU, ID, IT, JP, KR, MX, PH
 - Incompatibility as DO (Rule 20.8(b)):
 - CN, CU, CZ, DE, HU, ID, JP, KR, LT, MX, PH, TR

Restoration of the right of priority

- Competent Authorities:
 - RO during the international phase (Rule 26*bis*.3)
 - DO during the national phase (Rule 49*ter*.2)

Criteria for restoration of the right of priority

- Two possible criteria for restoration:
 1. failure to file the application within the priority period occurred in spite of due care required by the circumstances having been taken
 2. failure to file the application within the priority period was unintentional
- All Offices must apply at least one of these criteria and may apply both; designated Offices may also apply a more favorable criterion in accordance with their national law
 - RO/US will apply the unintentional criterion only
 - RO/IB will apply both criteria

Restoration by RO (Rule 26bis.3)

- Conditions:
 - request to restore must be filed with the RO
 - time limit: within a period of 2 months from the date of the expiration of the priority period
 - filing of statement of reasons for failure to comply with the time limit
 - statement should preferably be accompanied by a declaration or other evidence to support such statement
 - where applicable, payment of the required fee
 - RO/US fee for requesting restoration is \$1410
 - RO/IB does not charge a fee for requesting restoration

Effects if priority right is not restored by RO (Rule 26bis.3)

- Any priority claim to an earlier application filed less than 14 months before the international filing date
 - will not be declared void even if priority is not restored by the RO
 - will serve as a basis to calculate time limits during the international phase
- The validity of such a priority claim in the national phase is not assured

Effect of RO restoration in the national phase (Rule 49ter.1)

- RO restoration based on the “due care” criterion is effective in all DOs
- RO restoration based on the “unintentional” criterion is effective in those DOs which apply that criterion (or a more lenient one)
- RO restoration is not conclusively binding on DOs: limited review by DOs is possible
- RO refusal to restore is not binding on DOs
- Declarations of incompatibility with the national law (reservations) can be found on the WIPO website at: www.wipo.int/pct/en/texts/reservations/res_incomp.html
- A chart of the restoration of the right of priority by ROs and DOs can be found on the WIPO website at: www.wipo.int/pct/en/texts/restoration.html

Reservations to restoration of priority

- The following Offices have notified the International Bureau of the incompatibility of Rule 26bis.3(a) to (i), Rule 49ter.1(a) to (d) and/or Rule 49ter.2(a) to (g) with their national/regional law:
 - Incompatibility as RO (Rule 26bis.3(j)):
 - BE, BR, CO, CU, CZ, DE, DZ, ES, GR, HU, ID, IN, IT, JP, KR, NO, PH
 - Incompatibility of the effect of decision of RO on DO (Rule 49ter.1(g)):
 - BR, CA, CN, CO, CU, CZ, DE, DZ, ES, HU, ID, IN, JP, KR, LT, MX, NO, PH, TR, US
 - Incompatibility as DO (Rule 49ter.2(h)):
 - BR, CA, CN, CO, CU, CZ, DE, DZ, ES, HU, ID, IN, JP, KR, LT, MX, NO, PH, TR, US

Adding or correcting priority claims (Rule 26bis)

- What can be added or corrected?
 - missing priority claim
 - missing priority date
 - missing indications of the date, number or country of filing
 - filing date of earlier application more than 12 months before the international filing date
- The RO or IB may invite applicant to correct a defect in priority claim if:
 - priority claim does not comply with requirements of Rule 4.10
 - any indication in the priority claim is inconsistent with the corresponding indication appearing in the priority document
 - international application has an international filing date outside the priority period

Invitation to correct priority claim by RO or IB (1)

- Forms used:
 - receiving Office: Form PCT/RO/110
 - International Bureau: Form PCT/IB/316
- The receiving Office will also draw the attention of the applicant to the possibility to request restoration of the priority right (Rule 26bis.3) if the international filing date is outside of the priority period but within a period of two months from the date of expiration of the priority period

Invitation to correct priority claim by RO or IB (2)

- If the applicant does not correct the priority claim in response to the invitation, the priority claim concerned will be considered void, for the purposes of the procedure under the PCT
- However, a priority claim will not be considered void only because:
 - the indication of the number of the earlier application is missing; or
 - an indication in the priority claim is not the same as the corresponding indication appearing on the priority document; or
 - the international filing date is outside of the priority period but within a period of two months from the date of expiration of the priority period

Invitation to correct priority claim by RO or IB (3)

- The finding that the priority claim is considered for the purposes of the procedure under the PCT void, would not prevent any designated Office from recognizing such a priority claim for the purposes of the national phase if so permitted or required by national law
- Warning to third parties: different priority dates may apply in different designated States (Rules 26*bis*.2(d) and 48.2(a)(ix))

Corrections or additions of priority claims which affect the priority date

- Cases concerned:
 - adding a priority claim with an earlier filing date than any priority claim present in the application
 - correction of the filing date of the earliest priority claim
- Applicable time limit:
 - within 4 months from the international filing date; or
 - possibly later, if the earlier of the following two time limits expires later than the 4-month time limit:
 - 16 months from the priority date before the correction or addition
 - 16 months from the priority date after the correction or addition
 - any correction received before the RO or IB has declared the priority claim to be void and not later than one month after the expiration of the above time limit, will be considered as timely received (Rule 26bis.2(b))
 - NOTE: This does not apply to late additions of priority claims

<http://www.wipo.int/pct/en/calculator/pct-calculator.htm>

PCT Time Limit Calculator

The PCT Time Limit Calculator assists applicants in the computing of essential PCT Time Limits.

Main Time Limits	Correct / Add Priority	Amended Claims	Demand	Suppl. Int. Search	Withdrawal	Record Changes	Other																
<p>To calculate the time limit for correcting or adding a priority claim, please enter the earliest priority date, the priority date as proposed to be changed and the international filing date.</p> <table> <thead> <tr> <th></th> <th>DD</th> <th>MM</th> <th>YYYY</th> </tr> </thead> <tbody> <tr> <td>Earliest Priority Date</td> <td>10</td> <td>08</td> <td>2009</td> </tr> <tr> <td>Priority Date as Changed</td> <td>08</td> <td>10</td> <td>2009</td> </tr> <tr> <td>International Filing Date</td> <td>08</td> <td>10</td> <td>2010</td> </tr> </tbody> </table> <p style="text-align: right;"> <input type="button" value="Calculate"/> <input type="button" value="Reset"/> </p> <div style="border: 1px solid gray; padding: 5px; margin-top: 10px;"> <p style="text-align: right;">Time Limit</p> <p style="text-align: right;">8 February 2011</p> </div> <p>Summary Print</p>									DD	MM	YYYY	Earliest Priority Date	10	08	2009	Priority Date as Changed	08	10	2009	International Filing Date	08	10	2010
	DD	MM	YYYY																				
Earliest Priority Date	10	08	2009																				
Priority Date as Changed	08	10	2009																				
International Filing Date	08	10	2010																				

Corrections or additions of priority claims which do not affect the priority date

- Cases concerned:
 - corrections which do not affect the filing date of the priority claim
 - adding a priority claim with a later filing date than the earliest priority claim present in the application (e.g., second priority claim)
 - corrections of the filing date of a priority claim which is not the earliest one
- Applicable time limit:
 - Rule 26*bis*.1(a):
 - within 4 months from the international filing date; or
 - within 16 months from the priority date, whichever time limit expires later
 - any correction received before the RO or IB has declared the priority claim to be void and not later than one month after the expiration of the above time limit, will be considered as timely received (Rule 26*bis*.2(b))

NOTE: This does not apply to late additions of priority claims

Publication related to priority claims

- Information concerning a priority claim considered void or only not considered void because:
 - the number was missing
 - inconsistency with the indications on priority document
 - the international filing date is outside of the priority period but with a period of two months from the date of expiration of the priority period

will be published by the International Bureau free of charge together with, where applicable, information furnished by the applicant concerning such priority claims (Rule 26*bis*.2(d))
- After the expiration of the applicable time limit to correct or add a priority claim, applicant may request the International Bureau to publish information concerning the priority claim concerned:
 - within 30 months from priority date; and
 - subject to the payment of a fee

Fee safeguards

- If the Chapter I fees due are not paid in full within the applicable time limit the RO:
 - invites applicant to pay the missing fees
 - may require a late payment fee of 50% of the missing amount (minimum = transmittal fee; maximum = 50% of the international filing fee)
- Consequence of non-payment of the Chapter I fees:
 - the international application will be considered withdrawn by the RO and the RO will so declare
- If the Chapter II fees are not paid in full within the applicable time limit the IPEA:
 - invites applicant to pay the missing fees within one month from the date of the invitation; and
 - may require a late payment of 50% of the missing amount (minimum = handling fee; maximum = double the amount of the handling fee)
- Consequence of non-payment of Chapter II fees:
 - if the amount paid is not sufficient to cover the examination fee, the handling fee and the late payment fee, the demand will be considered by the IPEA as if it had not been submitted and the IPEA will so declare

Preventing publication of the international applications (Rule 90bis.1(c))

How	- by withdrawing the international application
When	- before completion of the technical preparations for international publication
The notice of withdrawal must:	<ul style="list-style-type: none"> - be made in writing (use of form PCT/IB/372 recommended) - be signed by all the applicants or on their behalf (by the appointed agent or the appointed common representative) - reach the IB before completion of the technical preparation for publication
Safeguard	- the withdrawal should be made conditional on its being received by the IB on time to prevent publication
Consequences	- the international application will not be published and will cease to have effect

Postponing publication of the international applications (Rule 90bis.3(d) and (e))

How	- by withdrawing the (earliest) priority claim
When	- before completion of the technical preparations for international publication
The notice of withdrawal must:	<ul style="list-style-type: none"> - be made in writing (form PCT/IB/372 recommended) - be signed by all the applicants or on their behalf (by the appointed agent or the appointed common representative) - reach the IB before completion of the technical preparation for publication
Safeguard	- the withdrawal should be made conditional on its being received by the IB on time to prevent publication
Consequences	- all time limits computed on the basis of the priority date which have not yet expired are recalculated on the basis of any remaining priority date or the international filing date, in particular for international publication, filing of demand and entry into the national phase

Rectification of obvious mistakes (1) (Rule 91)

- No rectification shall be made except with the express authorization:
 - of the receiving Office if the mistake is in the request
 - of the International Searching Authority if the mistake is in any part of the international application other than the request or paper submitted to that Authority
 - of the International Preliminary Examining Authority if the mistake is in any part of the international application other than the request or in any paper submitted to that Authority
 - of the International Bureau if the mistake is in any paper, other than the international application or amendments or corrections to that application, submitted to the International Bureau
- Time limit: request for rectification must be submitted within 26 months from the priority date

Rectification of obvious mistakes (2) (Rule 91)

- The competent authority will authorize the rectification of an obvious mistake, if and only if,
 - it is obvious to that authority that something else was intended than what appears in the document concerned
 - AND
 - that nothing else could have been intended than the proposed rectification
- DO may disregard a rectification “if it finds that it would not have authorized the rectification if it had been the competent authority”, but must give the applicant an opportunity to make observations (Rule 91.3(f))

Publication of requests for rectification (Rule 48.2)

- Authorized request for rectification:
 - if this is received after technical preparations for publication have been completed, the IB will publish a statement reflecting the rectifications, any replacement sheets and the request for rectification together with the republished front page (Rule 48.2(i))
- Refused request for rectification:
 - this will be published, upon request by the applicant within two months from the refusal and against payment of a fee, together with the reasons for refusal and any brief comments by applicant (Rule 91.3(d)); if this is received after technical preparations for publication have been completed, it will be promptly published with the republished front page (Rule 48.2(k))

Uses of Rule 92bis to record various changes

- Change of the name of the applicant
- Change of the address: applicant, agent, inventor
- Change of the nationality or residence of the applicant
- Addition or removal of an applicant/inventor
- Death of an applicant/inventor
- Change of the agent

Request for recording of a change under Rule 92bis

- The request must be made in writing
- It may be filed with the International Bureau or the receiving Office
- Generally no evidence of the change is required during the international phase; the designated Offices may, however, require that evidence (for example, assignment) be submitted once the national phase has been entered
- The International Bureau will notify the applicant (using Form PCT/IB/306) that the requested change has been recorded

Time limit for filing request for recording a change under Rule 92bis

- The request must reach the International Bureau before the expiration of 30 months from the priority date
 Recommendation: use the PCT Online Document Upload Service to file it directly with the International Bureau to ensure that the change is recorded before 30 months
- If the request reaches the International Bureau after the expiration of 30 months, the change will not be recorded and the applicant will have to proceed with such request before each designated or elected Office concerned
- If the applicant wishes that a particular change be taken into account for the international publication of the international application, the request for recording of that change must reach the International Bureau before the completion of technical preparations for international publication (normally, 15 days before the actual date of publication)
- If the request for recording of a change reaches the International Bureau too late to be reflected in the international publication, the International Bureau will notify all designated or elected Offices concerned

Recording of a change in the person of the applicant under Rule 92bis

- Where the request for recording the change is made by a person not yet named in the PCT Request form (“the new applicant”) without the written consent of the (“old”) applicant, the International Bureau will require that a copy of an assignment or other documentary evidence supporting the change in person be filed with the request for the change
- Where such request is made by an agent of the new applicant, a power of attorney signed by the new applicant must be furnished at the same time
- Where such request is made by the agent of record, the new applicant should sign a power of attorney appointing the agent

Adding or removing an applicant for the US

- If a request to add or remove an applicant for the purposes of the US is sent to the RO/US, the RO/US will not forward such a request to the International Bureau unless signed by all applicants or accompanied by powers of attorney signed by them
- If such a request is sent directly to the International Bureau, the change will be recorded

National phase safeguards

- Applicant may request reinstatement of rights where applicant failed to meet the deadline for national phase entry (Rule 49.6)
- Applicant can request review and correction by the designated/elected Offices of decisions rendered during the international phase (Articles 24, 25, 26 and 48, Rules 82*bis* and 82*ter*)

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Supplementary International Search

Objectives

- To provide applicants with an additional means for discovering additional prior art before entering the national phase
- To expand the scope of search in the international phase taking into account the growing linguistic diversity in prior art

Main features

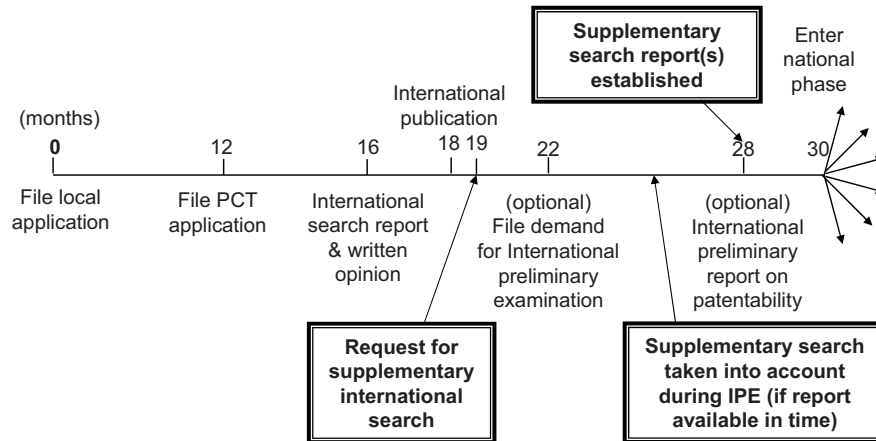
- Supplementary international search (SIS) is an optional service for applicants
- SIS is currently offered by the following Supplementary International Searching Authorities (SISAs): AT, EP, FI, SE, RU and XN
- An applicant can request supplementary search by any SISA offering this service except the one responsible for main international search
- Each SISA determines the scope and fees for its supplementary search
- SIS covers only one invention – there is no option for paying additional fees
- No written opinion is issued with the supplementary international search report

Timing and fees

- The supplementary search request must be filed with the International Bureau within 19 months from the priority date
- Fees must be paid in Swiss francs within 1 month of filing the request:
 - supplementary search handling fee*
 - supplementary search fee*
- The Authority begins SIS on receipt of the request and international search report (ISR), or 22 months from the priority date, at latest, if the main ISR is late
- The SIS Report is established by 28 months from the priority date

* see *PCT Applicant's Guide*, Annex SISA(AT), (EP), (FI), (RU), (SE), (XN)

SIS in the PCT system



Unity of invention

- Only one invention is searched by the SISA
 - there is no option of paying additional fees for additional inventions
- Usually the first claimed invention is searched
 - but if the ISA has found lack of unity of invention, the applicant may request the SISA to search another invention
 - however, the SISA is not obliged to search inventions which have not been searched by the ISA
- The SISA is not obliged to follow the views of the ISA on unity of invention
- A review procedure is available which is similar to the “protest” procedure for the main search

Scope of search

- Supplementary search is carried out on the claims as filed, that is, Article 19 and 34 amendments are not taken into account
- The SISA is not required to search:
 - subject matter which it would not normally search in accordance with Article 17(2)
 - claims which have not been searched by the main ISA
 - any international application which is subject to a limitation set out in the Agreement between WIPO and the Authority* defining the scope of their service
- The range of prior art to be searched is determined by the SISA
 - the search may be either a new search of all PCT minimum documentation as well as documents in other languages held by that Authority or
 - the search may be a complement to the main search, typically including a subset of language-related documentation held by that Authority

* see www.wipo.int/pct/en/access/isa_ipea_agreements.html

Specific services available (1)

- SISA/AT: three supplementary search service options
 - A search of at least German language documentation
 - A search of at least the European and North American documentation
 - A search of at least the PCT minimum documentation
- SISA/EP: supplementary search service
 - In addition to PCT minimum documentation, all documents held in its search collection
- SISA/FI: supplementary search service
 - In addition to PCT minimum documentation, at least documents in its collection in Finnish, Swedish, Norwegian and Danish

Specific services available (2)

- SISA/SE: supplementary search service
 - In addition PCT minimum documentation, at least documents in its collection in Swedish, Danish, Finnish and Norwegian
- SISA/RU: two supplementary search service options
 - the first includes Russian-language documentation and certain other patent documentation of the former Soviet Union and CIS States
 - the second is only available for applications where the ISA has made an Article 17(2)(a) declaration because of subject matter referred to in Rule 39.1(iv) (methods of treatment): includes at least the PCT minimum documentation, plus the above
- SISA/XN: supplementary search service
 - In addition to PCT minimum documentation, documents in its collection in Danish, Icelandic, Norwegian and Swedish



Fees payable to the IB for SIS

- Supplementary search handling fee: CHF 200
- Supplementary search fee
 - SISA/AT:
 - CHF 1,132 (of only German language documents)
 - CHF 1,584 (of only European and North American documents)
 - CHF 2,263 (of only PCT minimum documentation)
 - SISA/EP: CHF 2,376
 - SISA/FI: CHF 2,376
 - SISA/RU: CHF equivalent¹ of RUB 9,450 (13,500)²
 - SISA/SE: CHF 2,376
 - SISA/XN: CHF 2,376

¹ This amount refers to the equivalent amount in Swiss francs, at the exchange rate of the Central Bank of the Russian Federation, applicable on the date of payment.

² Amount in parentheses applies where a declaration referred to in PCT Article 17(2)(a) has been made by the International Searching Authority because of subject matter referred to in PCT Rule 39.1(iv) (methods of treatment).

Refunds when no search is carried out

- If the SISA commences work but no search is carried out
 - for reasons equivalent to those available to the ISA (subject matter, lack of clarity or lack of a sequence listing in electronic format) or
 - because the ISA has made an Article 17(2)(a) declaration the supplementary international search fee will not be refunded
 - because of limitations specific to the scope of the service offered by the SISA (for example, where the number of supplementary search requests received exceeds the number agreed to by the SISA), the supplementary search request is considered not to have been madethe supplementary search fee will be refunded

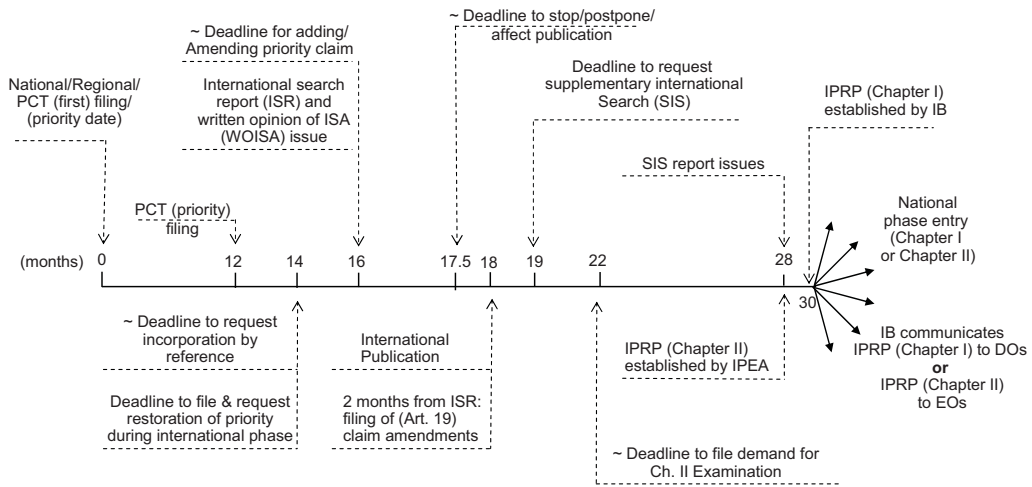
Supplementary international search report

- The supplementary international search report (form PCT/SISA/501) is very similar to the ISR
- The supplementary international search report is transmitted to the applicant and to the IB
- The IB makes the report publicly available (if the international application has been published)
- If the report is not in English, the IB will translate it into English
- The IB sends the report and translations, where appropriate, to the IPEA and designated Offices



The PCT Process from a User's Perspective

Key Decision Points in the PCT System



Decisions Before Filing

- Is filing under the PCT right for my application?
- How should the first application be filed?

Is Filing Under the PCT Right for My Application? Cost v. Benefits: Advantages of PCT Filing

- Additional time to make final “filing” decisions and get information, licensees, capital, partners, etc.
- Hold geographic “filing” options open for a longer time
- Global publicity for invention via PCT publication
- Easy of filing -- many states, one application
- A single search report and considered examination report plus an option to request supplementary searches
- The opportunity to advance prosecution in many states with effort of a single official action response
- Possible use of PPH in states accepting PCT examination results for entry to their PPH

How Should the First Application be Filed?

- Via the PCT:
 - Pros: Search report and written opinion available 9 months after filing
 - Cons: Patent term in all PCT states begins on the date of first (PCT) filing
- Via a US provisional application:
 - Pros: Low filing fee; filing date does not start the patent term in US
 - Cons: Provisional applications are not searched or examined
- Via a regular national/regional application:
 - Pros: Patent term begins with the international filing date (~12 months after the priority filing) in all but the first filed country
 - Cons: Priority filing decisions made without the benefit of the ISR/WOISA

Decisions When Preparing to File

- Choice of the receiving Office
- Decision to e-file or file on paper
- Decision on using PCT declarations
- Determination if DE, JP or KR must be “un-designated”
- Decisions on filing in non-PCT member states
- Decision on re-filing the priority application
- Decision on form of the Request – PCT/RO/101 or PCT- SAFE
- Choice of the International Searching Authority

Choice of the Receiving Office

- Filing options available (Express Mail, e-filing, fax)
- Availability of priority document via Request
- National security considerations
- Criterion used for restoration of priority claim
- Time zone differences
- Amount of transmittal fee
- International Searching Authorities available

Choice of International Searching Authority

(When filing in a receiving Office offering a choice)

- Initial cost
- Desire for more diversified (broader) search
- Source of ISA written opinion
- Limitations on selection of the IPEA
- Available Supplementary International Searching Authorities
- Potential reduced national/regional search fees
- Potential effect on national/regional phase entry strategy
- Personal preference
- Effect on the use of the PPH in AT, EP, ES, FI, JP, KR, RU and US

PCT-Patent Prosecution Highway Pilot (PCT-PPH)

A number of bilateral agreements have been signed between patent Offices to enable patent applicants to request a fast-track examination procedure where patent examiners can make use of the work products from the other Office(s). These work products can include positive results of the written opinion of the International Searching Authority, the written opinion of the International Preliminary Examining Authority or the international preliminary examination report issued within the framework of the PCT. By requesting that their applications be processed under this procedure, applicants can generally obtain patents more quickly before participating Offices. For further information concerning forms and administrative procedures of each participating Office see:

AT	Austrian Patent Office has PCT-PPH agreements with the following Offices:	
FI	National Board of Patents and Registration of Finland	PCT-PPH Request Form
US	United States Patent and Trademark Office This Office also has a number of PPH agreements which do not include PCT work products	
EP	European Patent Office has PCT-PPH agreements with the following Offices:	
JP	Japan Patent Office	PCT-PPH Request Form [PDF]
US	United States Patent and Trademark Office	PCT-PPH Request Form [PDF]
ES	Spanish Patent and Trademark Office has PCT-PPH agreements with the following Offices:	
JP	Japan Patent Office	PCT-PPH Request Form [WORD]
US	United States Patent and Trademark Office This Office also has a number of PPH agreements which do not include PCT work products	PCT-PPH Request Form [WORD]
FI	National Board of Patents and Registration of Finland	
AT	Austrian Patent Office	PCT-PPH Request Form
JP	Japan Patent Office This Office also has a number of PPH agreements which do not include PCT work products	PCT-PPH Request Form
JP	Japan Patent Office has PCT-PPH agreements with the following Offices:	
EP	European Patent Office	
ES	Spanish Patent and Trademark Office	
FI	National Board of Patents and Registration of Finland	
US	United States Patent and Trademark Office This Office also has a number of PPH agreements which do not include PCT work products	
KR	Korean Intellectual Property Office has PCT-PPH agreements with the following Offices:	
US	United States Patent and Trademark Office (information not yet available)	
RU	Federal Service on Intellectual Property, Patents & Trademarks of Russia	
US	United States Patent and Trademark Office	
US	United States Patent and Trademark Office has PCT-PPH agreements with the following Offices:	
AT	Austrian Patent Office	PCT-PPH Request Form [PDF]
EP	European Patent Office	PCT-PPH Request Form [PDF]
ES	Spanish Patent and Trademark Office	PCT-PPH Request Form [PDF]
JP	Japan Patent Office	PCT-PPH Request Form [PDF]
KR	Korean Intellectual Property Office	PCT-PPH Request Form [PDF]
RU	Federal Service on Intellectual Property, Patents & Trademarks of Russia This Office also has a number of PPH agreements which do not include PCT work products	PCT-PPH Request Form [PDF]

THE UNITED KINGDOM'S PCT (UK) FAST TRACK

The United Kingdom's [PCT \(UK\) Fast Track](#) system is not part of any PCT-PPH program but it allows applicants to request accelerated examination in the United Kingdom national phase if their international application has received a positive International Preliminary Report on Patentability (either Chapter I or Chapter II) regardless of which authority has issued that report).

Important Deadlines at ~Month 14

- Approximate deadline for submission of a request to incorporate material contained in the priority document into the international application
- Deadline for filing a request to restore the priority right during the international phase

Important Events at ~Month 16

- Final date for adding or correcting priority claims passes ~4 months after filing
 - additional time may be available in some circumstances, e.g., where the international application was filed less than one year after the earliest priority date
- International Search Report and Written Opinion of the ISA are scheduled to issue*

* The ISR and WOISA are to be issued three months after the receipt of the search copy by the ISA, which is at about four months after filing because it takes the RO ~ one month to complete the formalities review and issue the foreign filing license

Considerations at ~Month 16

- Continue to assess patentability in light of ISR and WOISA
- Determine if there is a need to amend the claims under Article 19 for publication
- Begin to consider the value of:
 - a Supplementary International Search
 - responding to the written opinion of the ISA
 - formally by filing a demand under Chapter II accompanied by arguments or
 - informally by filing informal comments with the IB

Important Deadline at ~Month 17½ Stopping or Delaying Publication

- Applicant can
 - stop publication by withdrawing the application
 - delay publication by withdrawing a priority claim
 by filing a notice of withdrawal provided that such notice reaches the IB before completion of technical preparation for publication*
- The notice must be signed by all the applicants where powers of attorney have not been filed or do not accompany the notice
 - the notice can be conditional on being able to stop publication
- Suggestions:
 - use form PCT/IB/372
 - work with the PCT Processing team
 - remember pending publication/laying-open in countries where direct national filings were made

* 15 days before scheduled publication

Important Event at Month 18: International Publication

- Upon publication:
 - the full disclosure becomes prior art worldwide
 - if the application designates the US and is published in English, the full disclosure becomes prior art under 35 U.S.C. 102(e) as of the international filing date*
 - provisional protection may begin in some countries

* Where priority is claimed to an earlier filed US application, the filing date of that earlier US application will be the “102(e) date”



Deadline at Month 19: Supplementary International Search

- A request for Supplementary International Search must be filed with the IB by Month 19
- Applicants should carefully consider the cost versus the benefit of requesting a supplementary search in light of:
 - the needs of the applicant
 - the SISAs available to conduct the SIS
 - the timing of the issuance of the SIS Report
 - the primary search being conducted by the ISA
 - the information available through other searches by national and regional patent offices, independent search services and applicant’s own search efforts



Deadline at Month 19: only for the national offices of LU, TZ & UG

- Consider if patent protection via national phase entry in Luxembourg (LU), the Republic of Tanzania (TZ) and Uganda (UG) is important
- If so either
 - prepare to enter the national phase from Chapter I in each of these designated Offices by 20 months or
 - file a demand for international preliminary examination by Month 19 in order to delay the time for national phase entry from Chapter II to 30 months

Important Deadline at Month 22: International Preliminary Examination

- The deadline for filing a demand for international preliminary examination is the later of:
 - 22 month from priority or
 - three months from the date of transmittal of the ISR/WOISA
- Filing a demand gives applicant
 - an opportunity to formally rebut the findings in the WOISA
 - an opportunity to amend the description, claims and drawings in the international application
 - an International Preliminary Report on Patentability (Chapter II) that considers applicant's arguments and amendments

Is International Preliminary Examination Advantageous?

- Should the examiner's findings in the Written Opinion be rebutted during the international phase?
 - formally by filing a demand under Chapter II accompanied by arguments or
 - informally by filing informal comments with the IB
- Is there a need to amend under Article 34?
- Do the advantages of receiving a more favorable IPRP justify the cost of a formal 'Chapter II' response?
- Is the use of the PPH in countries accepting positive PCT examination results for Highway entry advantageous?

Is International Preliminary Examination Advantageous?

- Do the advantages of having a more favorable IPRP justify the cost of a formal 'Chapter II' response?
 - if the EPO establishes a favorable IPRP for novelty, inventive step and industrial applicability, rapid acceptance can be obtained via accelerated exam*
 - if the US establishes a favorable IPRP for novelty, inventive step and industrial applicability:
 - search and examination fees payable in the US at the national stage are significantly reduced
 - the US national stage application will be picked up for examination "out of turn"
 - acceptance without further official action in many foreign countries based on favorable IPRP
 - a favorable IPRP may allow use of the PPH

* For the claims presented during the international phase

Considerations at ~ Month 28

- Chapter I Processing – Only:
 - Assess the chances of obtaining meaningful patent protection based on all the information available and determine if filing an informal response to the WOISA is advantageous
- Chapter I and II Processing:
 - Assess chances of obtaining meaningful patent protection based on the IPRP-Chapter II and all other information available
- In all situations:
 - Consider filing preliminary amendments and/or arguments to the DO/EO upon entry into the National Phase

National Phase Entry – Month 30

- Where should national phase entry be made?
- Reconsider continuing prosecution in non-PCT countries

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Recent Developments

January 2010 Changes

- E-mail notification
- WIPO Digital Access Service (DAS) for Priority Documents
- PCT online electronic document upload system
- Email notification only
- PCT-PPH pilot project

E-mail notification

- Applicants may request to receive notifications related to the international application as
 - advance e-mail notifications followed by the paper notifications or
 - as notifications exclusively sent by e-mail
 - currently only the IB sends notifications by e-mail

Digital Access Service for priority documents

- Effective 1 January 2010 applicant can request the IB to retrieve a priority document in lieu of having to provide a certified copy
- Offices currently participating in DAS:
 - AU - Australian Patent Office
 - ES - Spanish Patent and Trademark Office
 - GB - United Kingdom Intellectual Property Office
 - IB - International Bureau
 - JP - Japan Patent Office
 - KR - Korean Intellectual Property Office
 - US - United States Patent and Trademark Office

Steps for using DAS

1. Request the Office with which the earlier application was filed to make it available to DAS

In order for the IB to have permission to access a U.S. application prior to publication, mark the appropriate check box on the PTO/SB/01 (declaration form) filed in the U.S. application or file a PTO/SB/39 form

2. Go to the DAS web portal at https://webaccess.wipo.int/priority_documents/en/
 - register the application in DAS by providing the application number and access code* and
 - update the Access Control List to give access to the IB
3. Request the IB to retrieve the document by marking the box in Box No VI of the request form or the equivalent box of the request form prepared using PCT-SAFE

* The access code for U.S. applications is the confirmation number

https://webaccess.wipo.int/priority_documents/en/

The screenshot shows the WIPO PatentScope website. At the top, there is a search bar and navigation links for 'Español' and 'Français'. Below the search bar is a navigation menu with 'ABOUT WIPO', 'IP SERVICES', 'PROGRAM ACTIVITIES', 'RESOURCES', and 'NEWS & EVENTS'. The main content area is titled 'PATENTSCOPE® Priority Document Access Service'. It contains the following text:

The PatentScope® Priority Document Access Service offers a simple and safe digital alternative to filing paper copies of priority documents with multiple patent Offices.

It will enable a patent applicant claiming priority to ask patent Offices of second filing to retrieve a copy of the priority document themselves via the service. [Click here to access the service.](#)

A [demo version](#) of the service is available for comment on PatentScope® website.

On the right side, there is a 'SHORTCUTS' section with links to 'Why use this service?', 'FAQs for applicants', 'FAQs for offices', 'Participating Offices', 'Forms', 'Glossary', 'Background information', and 'System information'. On the left side, there are sections for 'PATENTSCOPE®' (About Patents, PCT Resources, PCT Service Centre, Database Search, Data Services, Publications, Projects & Programs, Patent Law, Priority Documents), 'RELATED LINKS' (Patent Classification: IPC, Statistics, Life Sciences, WIPO Standards), and 'E-NEWSLETTERS' (Subscription).

WIPO RESOURCES

WORLD INTELLECTUAL PROPERTY ORGANIZATION

ABOUT WIPO | IP SERVICES | PROGRAM ACTIVITIES | RESOURCES | NEWS & EVENTS

Priority Document Access Service

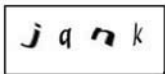
A service offering a simple and safe digital alternative to filing paper copies of priority documents with multiple patent Offices. It will enable a patent applicant claiming priority to ask patent Offices of second filing to retrieve a copy of the priority document themselves via the service.

A demo version of this service is available for comments on PATENTSCOPE® website. [Click here to access the demo version.](#) If you have any questions or comments [please contact us.](#)

Application info

Specify Priority Application Info

Access Code

Verification 

Enter the text in the image

For security reasons you need to log in within 5 minutes of loading the page - if you have had this page open for longer than that, press refresh before filling in the form.

Recommended Internet browsers for using this portal are Internet Explorer 7.0, Firefox 3.0 and NetScape 9.

DAS - Granting access permission

Priority Document Access Service

You are logged into the secured Priority Document Access Service - Test version. **Test** [Log out](#)

Priority Document: IL 192774

[Query Pdoc](#) | [Update Access Control List](#) | [Update Control Code](#) | [Update Applicant Email](#)

Select	Office code	State or Office of second filing	Access Granted on
<input type="checkbox"/>	AU	IP Australia P.O. Box 200 Woden ACT 2606	Mar 3, 2010
<input type="checkbox"/>	CA	Canadian Patent Office The Commissioner of Patents Ottawa Ontario K1A 0C9	Mar 3, 2010
<input type="checkbox"/>	CN	6 Xituchenglu, Jinen Bridge, Haidian District, P.O. Box 8020, Beijing 100088	Jun 10, 2010
<input type="checkbox"/>	EP	Phoenix Support Help Desk Attn: C. Hamer, Room 500G12, P.O. Box 5818 NL- 2280 HV Rijswijk	Oct 23, 2009
<input type="checkbox"/>	ES	Paseo de la Castellana 75, 28020 Madrid	Oct 23, 2009
<input checked="" type="checkbox"/>	FI	Arkadiankatu 6A FIN-00100 Helsinki	Oct 23, 2009
<input type="checkbox"/>	FR	Service de l'Examen des Demandes PCT 97, boulevard Carnot F-59040 Lille Cedex	Mar 23, 2010
<input type="checkbox"/>	GB	United Kingdom Intellectual Property Office (an operating name of the Patent Office) Concept House, Cardiff Road Newport, South Wales NP10 8QQ	Apr 16, 2010
<input checked="" type="checkbox"/>	IB	Bureau international de l'OMPI 34, chemin des Colombettes Geneva 20 12111	Mar 3, 2010
<input type="checkbox"/>	JP	403 Kasumigasaki 3-chome, Chiyoda-ku, TOKYO 100-8915	Mar 23, 2010
<input type="checkbox"/>	KR	Government Complex-Daejeon 139 Seonsa-ro, Seo-gu Daejeon 302-701	Oct 23, 2009

Mark the box to grant permission to the IB to retrieve the priority document

Making the request on the RO/101

Box No. VI PRIORITY CLAIM				
The priority of the following earlier application(s) is hereby claimed:				
Filing date of earlier application (day/month/year)	Number of earlier application	Where earlier application is:		
		national application: country or Member of WTO	regional application: regional Office	international application: receiving Office
item (1) 12 February 2009 (12.02.2009)	61/274,654	US		
item (2) 10 September 2009 (10.09.2009)	09187654.4	GB		
item (3)				

Further priority claims are indicated in the Supplemental Box.

The International Bureau is requested to obtain from a digital library, a certified copy of the earlier application(s) (if the earlier application(s) is available to it from a digital library) identified above as:
 all items item (1) item (2) item (3) other, see Supplemental Box

The receiving Office is requested to prepare and transmit to the International Bureau a certified copy of the earlier application(s) (if the earlier application(s) was filed with the Office which for the purposes of this international application is the receiving Office) or to obtain a certified copy of the earlier application(s) from a digital library and transmit a copy of it to the International Bureau (if the earlier application(s) is available to the receiving Office from a digital library), identified above as:
 all items item (1) item (2) item (3) other, see Supplemental Box

* Where the certified copy of the earlier application(s) is not stored in a digital library under the number of the earlier application indicated above but under the application number of another application which also claims priority from it, indicate that number in the supplemental sheet (item 4).

Making the request in PCT-SAFE

Details of Priority Claim of Earlier Application

National Regional International (PCT)

Country: GB United Kingdom

Filing date: 10 September 2009 19

Number: 0918765.4

The International Bureau is requested to obtain from a digital library a certified copy of the above-identified earlier application.

The receiving Office is requested to obtain from a digital library a certified copy of the above-identified earlier application and transmit it to the International Bureau.

The receiving Office is requested to prepare and transmit to the International Bureau a certified copy of the above-identified earlier application.

The receiving Office is requested to restore the right of priority

OK Cancel

PCT online document upload service (1)

- Applicants and/or agents may submit certain documents in PDF format electronically to the IB
- This service may not be used for initial filing of international applications with the RO/IB but can be used to file other documents with the IB such as
 - amendments to the claims under Article 19
 - requests for recording changes under Rule 92*bis*
 - notices of withdrawal
 - requests for Supplementary International Search
 - informal comments on the WOISA
 - general correspondence for the IB

PCT online document upload service (2)

- As of July 2010 the service has been expanded to upload post-filing documents to the RO/IB such as
 - requests for restoration of the right of priority under Rule 26*bis*.3
 - correction or addition of priority claims under Rule 26*bis*.1
 - requests for incorporation of elements or parts under Rule 20.6
 - replacement sheets under Rule 26
 - powers of attorney submitted to the RO/IB under Rule 90.4
 - declarations under Rule 4.17
- Documents can be uploaded only for applications filed
 - RO/IB upon receipt of form PCT/RO/105
 - any RO upon receipt of form PCT/IB/301

<https://webaccess.wipo.int/pctservice/en/>

WIPO RESOURCES

WORLD INTELLECTUAL PROPERTY ORGANIZATION

ABOUT WIPO | IP SERVICES | PROGRAM ACTIVITIES | RESOURCES | NEWS & EVENTS

PCT Service Center

Online Document Upload

International Application Number (e.g. US08/21)

International Filing Date (format: dd/mm/yyyy, e.g. 20/11/2008)

E-mail (e.g. john.smith@mymail.com)

Confirm E-mail (e.g. john.smith@mymail.com)

Check

Please enter the text in the image

Submit Reset

WIPO WORLD INTELLECTUAL PROPERTY ORGANIZATION

Patent Prosecution Highway (PPH) and the PCT

- The Trilateral Offices (USPTO, EPO and JPO) began a two-year pilot project on January 29, 2010
- Request for accelerated examination in the national phase can be based on a positive written opinion of the ISA, a positive written opinion of the IPEA or a positive international preliminary examination report, that is, the IPRP (Chapter II) issued by one of the trilateral Offices
- Conditions for PCT-PPH:
 - at least one claim was found to have novelty, inventive step and industrial applicability in the latest work product in the international application
 - ALL the claims in the application must sufficiently correspond to the claims in the PCT, that is, they are of the same or similar scope or they are narrower in scope than the claims in the international application
- USPTO began two-year PCT-PPH pilots with:
 - Korean Intellectual Property Office (KIPO) on June 1, 2010
 - Spanish Patent Office (SPTO), Austrian Patent Office (APO) and the Russian Federal Service for Intellectual Property, Patents and Trademarks (Rospatent) on October 1, 2010
 - National Board of Patents and Registration of Finland (NBPR) and IP Australia (IPAU) on January 24, 2011

Eligibility in the US

- Applications eligible in the US for the PCT-PPH project can be:
 - national stage of the international application
 - U.S. application that claims priority/benefit to the international application
 - U.S. parent application
 - corresponding U.S. application
- Substantive examination on the U.S. application has not begun
- All claims in the U.S. application must sufficiently correspond or be amended to correspond to those claims indicated as having novelty, inventive step and industrial applicability
 - claims may be narrower in scope than those with positive indications
 - such claims must be in dependent form

Requirements for Participation in the USPTO

- Applicant must submit:
 - a request for participation in the PCT-PPH pilot program
 - petition forms are found on the USPTO Internet site
 - petition fee has been eliminated effective May 25, 2010
 - a copy of the latest PCT work product on which participation is based -unless already present in the U.S. application
 - a copy of the claims from the international application indicated as having novelty, inventive step and industrial applicability and English translation if applicable
 - a claim correspondence table (in English)
 - an IDS listing the documents cited in the PCT work product from the corresponding international application
- The request for participation and supporting documents must be submitted via EFS-Web and indexed appropriately

USPTO's PPH Resources

- USPTO's PPH Agreements and Forms
www.uspto.gov/patents/init_events/pph/index.jsp
- PPH FAQs
www.uspto.gov/patents/init_events/pph/pph_faqs.pdf



July 2010 changes

- Further changes to amendment practice
 - Applicants must indicate the basis for the amendments in the application as filed
 - If the letter indicating the basis for the amendments in the application as filed is missing, the international preliminary report on patentability by the IPEA may be established as if the amendments had not been made
- E-payment service

E-Payment service

- As of 15 July 2010 certain fees can be paid to RO/IB and IB by credit card
 - via a secure online facility: webaccess.wipo.int/epayment_pct
- An online user's guide is available at:
www.wipo.int/patentscope/en/service_center/pdf/pct-e-payment_user_guide_en.pdf
- See the July/August issue of the PCT Newsletter for additional information

New PCT resource

- Text-searchable PCT case law database available at:
www.wipo.int/pctcaselawdb/en
- Contents
 - Decisions from national courts
 - Decisions from regional administrative bodies
 - Abstracts and legal references added by IB
- Any comments or submissions for addition can be sent to the IB at:
pct.legal@wipo.int

PATENTSCOPE® enhancements

- Full file contents available for international applications filed from 1 January 2009
- Information on national phase entry for 44 countries/regional Offices
- Access to searchable national collections: ARIPO, Cuba, Argentina, Republic of Korea, Mexico, Singapore, Viet Nam, South Africa, Israel, Brazil, Morocco, Spain, Colombia, Guatemala, Costa Rica, Panama, Peru, Uruguay
- Since May 2010: CLIR (Cross-Lingual Information Retrieval)
 - More search results possible because of translation of search terms (English, French, German, Japanese, Spanish)
 - www.wipo.int/patentscope/search/clir/clir.jsp
- Since August 2010: translation of description and claims in all languages supported by Google translate

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Strategies for Entering the National Phase

Decisions to be taken by the applicant

- Whether
 - proceed with or drop the international application ?
- When
 - at the end of 30 months (in some cases 31 months or more)
 - under Chapter I ?*
 - under Chapter II ?
 - early entry ?
- Where (choice limited to designated/elected Offices)
 - which national Offices
 - which regional Offices

* LU, TZ and UG continue to apply a 20-month time limit

Time limit for entry in the national phase

- The time limit applies irrespective of possible delays in the international phase due to:
 - late international search report and written opinion of the ISA
 - international preliminary examination delayed
 - late international preliminary report on patentability (Chapter II)
 - late translation of international preliminary report on patentability (Chapter II)

General national requirements Articles 22(1) and 39(1)(a)

- Requirements:
 - translation, if applicable
 - payment of national fee
 - copy of international application in particular circumstances only
- Time limit under Article 22(1): 30 months from the priority date
 - for additional time, see *PCT Applicant's Guide*, national phase summaries
 - for exceptions, see www.wipo.int/pct/en/texts/reservations/res_incomp.html
- Time limit under Article 39(1)(a): 30 months from the priority date
 - for additional time, see *PCT Applicant's Guide*, national phase summaries

Special national requirements (Article 27 and Rule 51*bis*.1)

- Time limit under Rule 51*bis*.3:
 - if requirements are not fulfilled within the time limit for entry into national phase under Article 22 or 39:
 - invitation by DO
 - at least 2 months from the invitation



Examples of special requirements under Rule 51*bis*.1 (1)

- Oath or declaration by the inventor (US only):

Where the corresponding declaration has been furnished during the international phase or directly to the DO/EO, no documents or evidence as to that matter may be required by DO/EO/US unless that Office may reasonably doubt the veracity of the declaration
- Assignment documents (of the priority rights or of the application):

Where the corresponding declaration has been furnished during the international phase or directly to the DO/EO, no documents or evidence as to that matter may be required by the DO/EO unless that Office may reasonably doubt the veracity of the declaration

 - Rule 51*bis*.2(a)(ii) does not apply to the following DO/EO*: HU

* See PCT Reservations at www.wipo.int/pct/en/texts/reservations/res_incomp.html



Examples of special requirements under Rule 51*bis*.1 (2)

- Translation of the priority document may only be required (Rule 51*bis*.1(e)):
 - where the validity of the priority is relevant to the determination of patentable
 - in cases of incorporation by reference
 This rule does not apply to DO/EO/ES*
- Appointment of local agent and submission of power of attorney
- Translation or other documents relating to the international application in more than one copy
- Certified translation of the international application (only where the Office may reasonably doubt the accuracy of the translation)

* See PCT Reservations at www.wipo.int/pct/en/texts/reservations/res_incomp.html

National requirements simplified for PCT applications (1)

- Priority document
 - the applicant does not need to furnish the priority document since the IB transmits copies to the DO/EOs
 - if the DO/EO did not receive a copy of the priority document from the IB, that Office must request a copy from the IB (not from the applicant)
- Drawings
 - if the drawings do not contain any text matter to be translated, a simple copy of the drawings as filed is required by a few DOs
 - if the drawings contain text matter to be translated, a set of drawings containing the translated text matter needs to be furnished

National requirements simplified for PCT applications (2)

- No legalized or certified translation of the international application
 - otherwise, a simple translation is required
 - a few Offices (such as, AU, GB, IN, NZ, SG) require a "verified" translation
- No special form required (but strongly recommended) for entry into national phase

Communication with DOs/EOs (Rule 93bis)

- Any communication, notification, correspondence or other document relating to an international application will be communicated by the International Bureau to DOs/EOs only upon their request and at the time specified by the Offices
- Most DOs/EOs will receive the majority of documents concerned only after an applicant has entered the national phase before its Office
- Almost all PCT Contracting States now receive the DVD collections containing the full texts of the published international applications

Furnishing by International Bureau of copies of priority documents (Rule 17.2(a))

- The International Bureau provides copies of priority documents to designated Offices:
 - upon request
 - after international publication, unless the applicant made a specific request for early processing under Article 23(2)
- Almost all Offices request a copy of the priority document only after the application entered the national phase
- Only the European Patent Office systematically receives copies of all priority documents

Recommendations for preparing for entry into the national phase

- Leave sufficient time, where necessary, to prepare the translation of the international application
- Send your local associate copies of the (relevant) documents: the published international application, the international search report and written opinion of the ISA, the international preliminary report on patentability, priority documents; note that none of these documents are required to be filed by the local associate at the local patent office
- In order to avoid paying additional claims fees or other applicable fees under particular national law, prepare the application and any amendments thereof according to the national practice
- Even though several designated/elected Offices provide longer time limits, docket the 30-month time limit for all Offices (see www.wipo.int/pct/en/texts/reservations/res_incomp.html for exceptions under Article 22(1))

A few more tips

- Remember to monitor time limits for entering national phase - they apply irrespective of delays in the international phase
- Make necessary indications that the application is entering the national phase, that is, make it clear that it is not a direct national filing
- The translation of the international application must be correct and complete - no subject matter can be added and/or deleted
- Pay the required fees - the amounts may be different than those applicable to a direct national filing

Reinstatement of rights by DO/EOs (Rule 49.6) (1)

- Available in certain DO/EOs, where the applicant has missed the time limit under Article 22 or 39(1) to enter the national phase:
 - unintentionally
 - or, at the option of the Office,
 - in spite of due care required by the circumstances
- Applicants may submit a request for reinstatement and enter the national phase within:
 - 2 months from the date of removal of the cause of the failure to meet the time limit to enter national phase; or
 - 12 months from the date of expiration of the time limit to enter national phase;whichever period expires first

Reinstatement of rights by DO/EOs (Rule 49.6) (2)

- Longer time limits and/or further requirements may apply depending on the applicable national law
- For further details, see for each DO/EO, the relevant National Chapter in the PCT Applicant's Guide, National Phase

DO/EOs to which Rule 49.6 does not apply

- Notifications of incompatibility with respective national law were filed in accordance with Rule 49.6(f) (see PCT Gazette No. 05/2003 on 30 January 2003) (11 offices – situation as of 15 March 2010):

CA Canada	LV Latvia
CN China	MX Mexico
DE Germany	NZ New Zealand
IN India	PH Philippines
JP Japan	PL Poland
KR Republic of Korea	

- Nevertheless the national law applicable by some of these Offices may provide for other forms of protection against loss of rights; for further details, see the relevant National Chapter in the PCT Applicant's Guide, National Phase for each DO/EO

Additional cases of protection against loss of rights

- Other than the (minimum) protection under Rule 49.6: excuse of delays in meeting time limits by designated/elected Offices (Article 48 and Rule 82*bis*)
- Rectification by designated/elected Offices of errors made by RO or IB (Rule 82*ter*)
- Review by and opportunity to correct before the designated/elected Offices (Articles 24(2), 25, 26 and 48, Rules 82*bis* and 82*ter*)

National Phase Entry Time Limits (1 July 2010)

Designated/Elected Office	Chapter I (Article 22)	Chapter II (Article 39(1))
AE	30	30
AG ¹	30	30
AL	30	31
AM ²	31	31
AO ¹	30	30
AP ³	31	31
AT ⁴	30	30
AU	31	31
AZ ²	30	31
BA	34	34
BB	30	30
BG ⁴	31	31
BH	30	30
BR	30	30
BW ⁵	31	31
BY ²	31	31
BZ	30	30 ⁶
CA	30 (42 ⁷)	30 (42 ⁷)
CH ^{4,8}	30	30
CL	30	30
CN	30	30
CO	31	31
CR	31	31
CU	30	30
CZ ⁴	31	31
DE ⁴	30	30
DK ⁴	31 ⁹	31 ⁹
DM ¹	30	30
DO	30	30
DZ	31	31
EC	31	31
EE ⁴	31	31
EG	30 (33 ⁷)	30 (33 ⁷)
EP ¹²	31	31
ES ⁴	30	30
FI ⁴	31	31
GB ⁴	31	31
GD ¹	30	30
GE	31	31
GH ⁵	30	30
GM ⁵	30	31
GT	30	30

National Phase Entry Time Limits (1 July 2010)

Designated/Elected Office	Chapter I (Article 22)	Chapter II (Article 39(1))
HR ⁴	31	31
HU ⁴	31	31
ID	31 ¹³	31 ¹³
IL	30	30
IN	31	31
IS ⁴	31	31
JP	30	30
KE ⁵	30	30
KG ²	31	31
KM ¹	30	30
KN ¹	30	30
KP	30	30
KR	31	31
KZ ²	31	31
LA ¹	30	30
LC ¹	30	30
LK	30	30
LR	30	31
LS ⁵	30	31
LT ⁴	31	31
LU ⁴	20 ¹⁰	30
LY ¹	30	30
MA	31	31
MD ²	31	31
ME ¹	30	30
MG	30	30
MK ¹¹	31	31
MN	31	31
MW ⁵	30	30
MX	30	30
MY	30	30
MZ ⁵	31	31
NA ⁵	31	31
NG	30	30
NI	30	30
NO ⁴	31	31
NZ	31	31
OA ¹⁴	30	30
OM ¹	30	30
PE	30	30
PG	31	31
PH	30 (31 ⁷)	30 (31 ⁷)

National Phase Entry Time Limits (1 July 2010)

Designated/Elected Office	Chapter I (Article 22)	Chapter II (Article 39(1))
PL ⁴	30	30
PT ⁴	30	30
RO ⁴	30	30
RS	30 ¹⁵	30 ¹⁵
RU ²	31	31
SC	31	31
SD ⁵	30	30
SE ⁴	31	31
SG	30	30
SK ⁴	31	31
SL ⁵	31	31
SM ¹⁶	31	31
SV ¹	30	30
SY	31	31
TJ ²	30	31
TM ²	30	31
TN ¹	30	30
TR ⁴	30 (33 ⁷)	30 (33 ⁷)
TT	30	31
TZ ⁵	21 ¹⁰	31
UA	31	31
UG ⁵	21 ¹⁰	31
US	30	30
UZ	31	31
VC	30	30
VN	31	31
ZA	31	31
ZM ⁵	30	30
ZW ⁵	30	31

¹ In the absence of information from the Office concerned, the time limits shown are those which would normally apply under PCT Articles 22(1) and 39(1)(a). If the Office decides to apply longer time limits, that information will be published in the *PCT Newsletter*.

² If designated/elected for a Eurasian patent, see EA as designated/elected Office (DO/EO) for the applicable time limits.

³ This Office acts as DO/EO for the following State which does not act in the capacity of DO/EO: SZ.

⁴ If designated/elected for a European patent, see EP as DO/EO for the applicable time limits.

⁵ If designated/elected for an ARIPO patent, see AP as DO/EO for the applicable time limits.

⁶ May be extended upon written request of the applicant.

⁷ Time limit applicable if applicant pays an additional fee for late entry into the national phase (see relevant national chapter of *PCT Applicant's Guide* for details).

⁸ This Office acts as DO/EO for the following State which does not act in the capacity of DO/EO: LI.

⁹ A special time limit of 20 months applies in respect of the Danish territories of the Faroe Islands.

¹⁰ This Office has notified the International Bureau of the non-applicability of the time limit under PCT Article 22(1), as modified with effect from 1 April 2002 – it does not yet apply the 30-month time limit for entering the national phase.

¹¹ For international applications filed on or after 1 January 2009 only: if designated/elected for a European patent, see EP as DO/EO for the applicable time limits.

¹² This Office acts as DO/EO for the following States which do not act in the capacity of DO/EO: BE, CY, FR, GR, IE, IT, LV, MC, MT, NL, SI.

¹³ This time limit may be extended provided that the applicant pays an additional fee for late entry into the national phase.

¹⁴ This Office acts as DO/EO for the following States which do not act in the capacity of DO/EO: BF, BJ, CF, CG, CI, CM, GA, GN, GQ, GW, ML, MR, NE, SN, TD, TG.

¹⁵ The time limit can be extended by 30 days if the applicant pays an additional fee for late entry into the national phase.

¹⁶ For international applications filed on or after 1 July 2009 only, if designated/elected for a European Patent, see EP as DO/EO for the applicable time limits.

Types of Protection Available via the PCT in PCT Contracting States (status on 18 February 2010)								
	National patent	ARIPO patent (AP)	Eurasian patent (EA)	European patent (EP)	OAPI patent (OA)	Utility model instead of national patent	Utility model in addition to national patent	Other
AE	X					X		Patent of addition
AG ¹	X							
AL	X					X		Extension of EP patent ²
AM	X		X			X		Provisional patent
AO	X					X		Certificate of addition
AT	X			X		X	X	Patent of addition
AU	X							Patent of addition
AZ	X		X			X		
BA	X							Patent of addition, extension of EP patent ²
BB	X							
BE				X				
BF					X	OAPI utility model		OAPI certificate of addition
BG	X			X		X	X	
BH	X						X	
BJ					X	OAPI utility model		OAPI certificate of addition
BR	X					X		Certificate of addition
BW	X	X				ARIPO utility model	ARIPO utility model	Utility model certificate
BY	X		X			X		
BZ	X					X		
CA	X							
CF					X	OAPI utility model		OAPI certificate of addition
CG					X	OAPI utility model		OAPI certificate of addition
CH + LI	X			X				
CI					X	OAPI utility model		OAPI certificate of addition
CL	X					X		
CM					X	OAPI utility model		OAPI certificate of addition
CN	X					X		
CO	X					X		
CR	X					X		
CU	X							Patent of addition, inventor's certificate, inventor's certificate of addition
CY				X				
CZ	X			X		X	X	
DE	X			X		X	X	Patent of addition

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Types of Protection Available via the PCT in PCT Contracting States (status on 18 February 2010)								
	National patent	ARIPO patent (AP)	Eurasian patent (EA)	European patent (EP)	OAPI patent (OA)	Utility model instead of patent	Utility model in addition to patent	Other
DK	X			X		X	X	
DM ¹	X							
DO	X					X		
DZ	X							Certificate of addition
EC	X					X		
EE	X			X		X	X	
EG	X					X		
ES	X			X		X		Patent of addition
FI	X			X		X	X	
FR				X				
GA					X	OAPI utility model		OAPI certificate of addition
GB	X			X				
GD ¹	X							
GE	X					X		
GH	X	X				ARIPO utility model	ARIPO utility model	Utility certificate
GM	X	X				ARIPO utility model	ARIPO utility model	
GN					X	OAPI utility model		OAPI certificate of addition
GQ					X	OAPI utility model		OAPI certificate of addition
GR				X				
GT	X					X		
GW					X	OAPI utility model		OAPI certificate of addition
HN ¹	X							
HR	X			X ³				"Consensual patent," extension of EP patent ^{2,4}
HU	X			X		X		
ID	X							
IE				X				
IL	X							Patent of addition
IN	X							Patent of addition
IS	X			X				
IT				X				
JP	X					X		
KE	X	X				National or ARIPO utility model	ARIPO utility model	
KG	X		X			X		
KM ¹	X							
KN ¹	X							
KP	X					X		Inventor's certificate
KR	X					X		
KZ	X		X			X		Provisional patent
LA ¹	X							

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Types of Protection Available via the PCT in PCT Contracting States (status on 18 February 2010)								
	National patent	ARIPO patent (AP)	Eurasian patent (EA)	European patent (EP)	OAPI patent (OA)	Utility model instead of patent	Utility model in addition to patent	Other
LC	X							
LI (see CH)								
LK	X							
LR	X	X ⁵				ARIPO utility model ⁵	ARIPO utility model ⁵	
LS	X	X				National or ARIPO utility model	ARIPO utility model	
LT	X			X				
LU	X			X				
LV				X				
LY	X							Patent of addition
MA	X							Certificate of addition
MC				X				
MD	X		X			X		Short-term patent
ME	X							Extension of EP patent ⁶
MG	X							Certificate of addition
MK	X			X ⁷				Patent of addition, extension of EP patent ^{2,8}
ML					X	OAPI utility model		OAPI certificate of addition
MN	X							
MR					X	OAPI utility model		OAPI certificate of addition
MT				X				
MW	X	X				ARIPO utility model	ARIPO utility model	Patent of addition
MX	X					X		
MY	X							"utility innovation"
MZ	X	X				National or ARIPO utility model	ARIPO utility model	
NA	X	X				ARIPO utility model	ARIPO utility model	
NE					X	OAPI utility model		OAPI certificate of addition
NG	X							
NI	X					X		
NL				X				
NO	X			X ³				
NZ	X							Patent of addition
OM	X					X		
PE	X					X		
PG	X							
PH	X					X		
PL	X			X		X		
PT	X			X		X	X	
RO	X			X				
RS	X							Patent of addition, petty patent, extension of EP patent ²

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Types of Protection Available via the PCT in PCT Contracting States (status on 18 February 2010)								
	National patent	ARIPO patent (AP)	Eurasian patent (EA)	European patent (EP)	OAPI patent (OA)	Utility model instead of patent	Utility model in addition to patent	Other
RU	X		X			X		
SC	X							
SD	X	X				ARIPO utility model	ARIPO utility model	
SE	X			X				
SG	X							
SI				X				
SK	X			X		X	X	
SL	X	X				National or ARIPO utility model	ARIPO utility model	
SM	X							
SN					X	OAPI utility model		OAPI certificate of addition
ST	X							
SV	X					X		
SY	X							Certificate of addition
SZ		X				ARIPO utility model	ARIPO utility model	
TD					X	OAPI utility model		OAPI certificate of addition
TG					X	OAPI utility model		OAPI certificate of addition
TH ⁹	X							Petty patent
TJ	X		X			X		
TM	X		X					Provisional patent
TN	X							
TR	X			X		X		Patent of addition
TT	X							Utility certificate
TZ	X	X				ARIPO utility model	ARIPO utility model	
UA	X					X		
UG	X	X				ARIPO utility model	ARIPO utility model	Utility certificate
US	X							
UZ	X					X		
VC	X							Utility certificate
VN	X							"Patent for utility solution"
ZA	X							Patent of addition
ZM	X	X				ARIPO utility model	ARIPO utility model	Patent of addition
ZW	X	X				ARIPO utility model	ARIPO utility model	Patent of addition

1 Information regarding any other type of national protection is not yet available.

2 A request for an extension may be made at the time of entry into the regional phase before the European Patent Office, provided that the designations of EP and/or of the State concerned have not been withdrawn. See the *PCT Applicant's Guide*, International Phase, paragraphs 41 and 89, and National Phase, National Chapter (EP) for further details as to the procedure to be followed.

3 Only for international applications filed on or after 1 January 2008.

4 Only for international applications filed before 1 January 2008.

5 Only for international applications filed on or after 24 March 2010.

6 Only for international applications filed on or after 1 March 2010.

7 Only for international applications filed on or after 1 January 2009.

8 Only for international applications filed before 1 January 2009.

9 Only for international applications filed on or after 24 December 2009.

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US National Stage Entry and By-pass Continuation Practice

Entry into the US national stage (1)

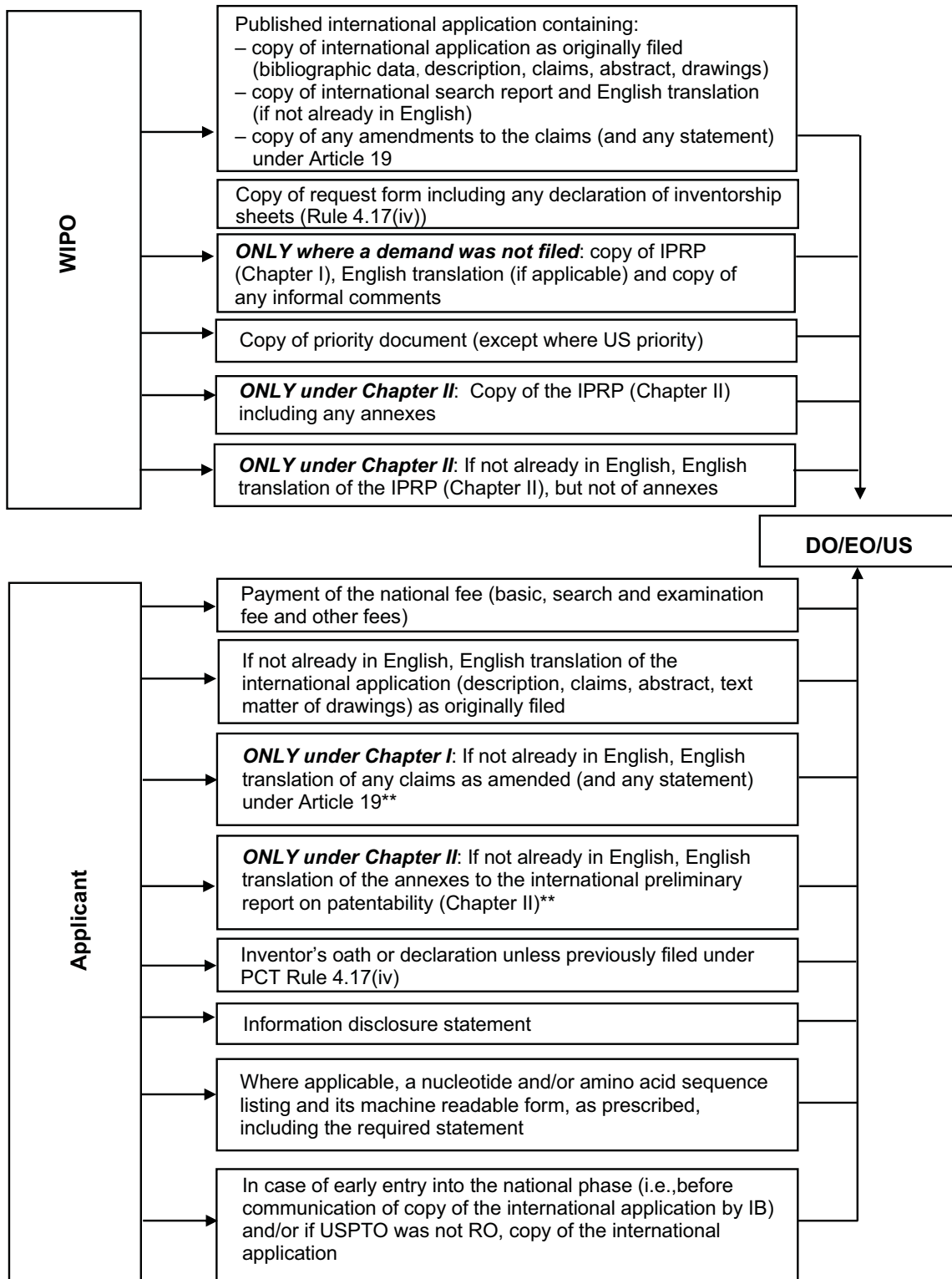
- Time limit: 30 months from the priority date for entry from Chapters I or Chapter II
- Requirements:
 - payment of the basic national fee
 - copy of the international application* and an English translation of the international application if published in a language other than English
 - translation of any amendments made under Article 19
 - inventor's oath or declaration (may have been executed before the PCT filing date)
 - translation of any annexes to the international preliminary report on patentability (Chapter II)
- See 35 U.S.C. 371(c) and 37 CFR 1.495

* Not required where the IB has communicated a copy to the DO/EO/US; or where the international application was filed with RO/US

Entry into the US national stage (2)

- The basic national fee MUST be paid within the 30-month time limit
- Failure to pay the basic national fee in full will result in the abandonment of the application (37 CFR 1.495(b)(2))
- Applicant may expressly request early commencement into the national phase at any time after the filing the international application
 - if any required documents and/or fees are missing, the national stage application cannot be processed prior to the expiration of 30 months or until the applicable requirements have been met

Entry into the national phase under Chapters I and II before the USPTO as DO/EO/US (within 30 months from the priority date)*



* For further details, see the *PCT Applicant's Guide*, National Phase, National Chapter (US)

** Amendments disregarded if translation not filed

National stage fees (37 CFR 1.492)

- In addition to the basic national fee applicant must pay
 - search fee*
 - examination fee*
 - application size fee* for each additional 50 pages or fraction thereof where the specification and drawings exceed 100 pages
 - claim fees for
 - each independent claim* in excess of 3
 - each claim* in excess of 20
 - a national stage application containing one or more multiple dependent claims*
- Surcharge* for filing the search fee, examination fee or the oath or declaration later than 30 months
- Fee for filing an English translation of the international application or any annexes later than 30 months

* reducible for small entities

Translation requirements where the application has been amended

- Translation of Article 19 amendments must be furnished within 30 months
 - if not furnished, the amendments will be considered cancelled
- Translation of annexes to the international preliminary report on patentability (Chapter II) must be furnished within 30 months
 - if not furnished, the amendments will be considered cancelled
 - however, if the basic national fee is paid within 30 months, but the oath or the translation of the application is not furnished, the “Notice of Missing Requirements” will also relate to the translation of the annexes

Oath or declaration

- An inventor's oath or declaration may be filed
 - as part of the request form (that is, Box No. VIII (iv)) or added within the time period set in PCT Rule 26*ter*
 - IB will provide DO/EO/US with a copy after national phase entry has begun as part of the "communication on request" documents
 - by 30 months from the priority date
 - in response to Notification of Missing Requirements
 - time limit set in Notification may be extended under 37 CFR 1.136(a)
- A surcharge is due if oath or declaration is filed after 30 month date (37 CFR 1.492(h))

Abandonment

- The international application will become abandoned in the US for failure to:
 - pay the basic national fee in full by the 30-month date*
 - file a copy of the international application by the 30-month date* (required if not communicated by the IB to the US or if not filed in RO/US)
 - file any required translation of the international application as set forth in the Notice of Missing Requirements (PCT/DO/EO/905)*
 - file a proper oath or declaration as set forth in the Notice of Missing Requirements*
 - pay any required national stage fee as set forth in the Notice of Missing Requirements*
 - file any required sequence listing*

* Revival is possible under 37 CFR 1.137(a) or (b)

Keep in mind

- The international filing date is the US filing date except as provided in 35 U.S.C. 102(e) (see 35 U.S.C. 363)
 - USPTO filing receipt lists the date of completion of the 371(c) requirements as the “filing or 371(c) date”
- Correct (that is, literal) translation of international application is required
 - it may be accompanied by a substitute specification containing an improved or rewritten text of the application where desired, together with a statement that the substitute specification contains no new matter
- The broader PCT unity of invention criteria apply during national phase examination (37 CFR 1.475 and 1.499)

Claiming benefit of an earlier US application (1)

- Claim for domestic priority benefit may be made to a prior-filed
 - US provisional application under the provisions of 35 U.S.C. 119(e)
 - copending US non-provisional application under the provisions of 35 U.S.C. 120
 - copending international application that designated the US under the provisions of 35 U.S.C. 365(c) and 120
- Claim should be made in the Request form
 - in the supplemental box if the PCT is to be treated as a continuation or CIP of an earlier filed US non-provisional application
 - in Box No. VI if the earlier US application (provisional or non-provisional) is filed within 12 months of the PCT

Claiming benefit of an earlier US application (2)

- Time limit for making domestic benefit claim in a national phase application is within the later of
 - 4 months from the date on which the national phase commenced under 35 U.S.C. 371(b) or (f) or
 - 16 months from the filing date of the earlier-filed application
- Domestic benefit claim may be added later only by petition when the claim was unintentionally delayed under the provisions of 37 CFR 1.78(c) & (e)

How to make a domestic benefit claim

- Claims made under 35 U.S.C. 119(e), 120 and/or 365(c)
 - must be made in
 - an application data sheet or
 - the first sentence of the specification
 - must identify an earlier
 - US application by application number, or
 - an earlier filed international application that designated the US by international application number and international filing date
 - must include the relationship to the earlier application, for example, “this application is a continuation-in-part of”

Claiming priority to a foreign application

- Priority to an earlier-filed foreign application must have been made on the PCT Request form or added within the 26bis time limit
- The national phase application must identify the foreign application on
 - the oath/declaration or
 - an application data sheet

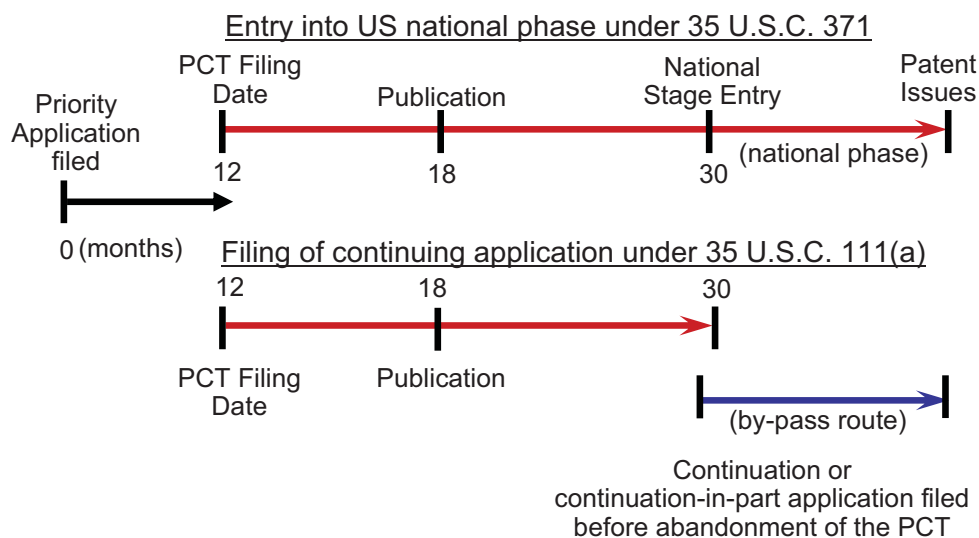
Duty of disclosure

- Applicant has a duty under 37 CFR 1.56 to disclose information material to patentability in applications filed under 35 U.S.C. 371
 - information disclosure statement (IDS) can be filed without fee or statement under 37 CFR 1.97(e)
 - within 3 months of national stage entry or
 - before first Office action
 - whichever is later
- Prior art documents listed on an ISR are not communicated to the USPTO from other Offices
 - applicant should list all documents cited on ISR and new references cited by the IPEA in an IDS and provide copies of documents that are not US patents or published US patent application

Biotech applications

- If the international application contains disclosure of nucleotide and/or amino acid sequences, applicant will need to comply with the provisions of 37 CFR 1.821 - 1.825 at the time of national phase entry
 - Notification of Missing Requirements will indicate lack of compliance
 - Notification to Comply with Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures (form PCT/DO/EO/920) will set forth the required items

Two routes to file in the US from an international application



Advantages of by-pass route

- English translation does not need to be an exact translation of the international application
- Applicant may add new matter to the disclosure by filing a continuation-in-part
- Applicant may claim priority to a foreign patent application in a by-pass application in accordance with 37 CFR 1.55 provided that the filing date of the foreign application is within one year of the filing date of the “parent” international application
- Extension of time under 37 CFR 1.136(a) is available for payment of the basic filing fee
- Inventors may be named in a continuing application that are different than those named in the international application without the need to file a statement and pay a processing fee



Disadvantages to by-pass route

- Applicant must file a complete application including any required formal drawings
- Applicant must file certified copies of all foreign priority documents*
- US restriction practice applies instead of broader unity of invention requirements, where multiple inventions are claimed

* DO/EO/US will automatically retrieve EPO, JPO and KIPO priority documents via the Priority Document Exchange Program (PDX)
<http://www.uspto.gov/web/patents/notices/prioritydocexch.html>



Advantages of national stage entry

- Ease of filing
 - Applicant provides:
 - indication of national stage entry using EFS-Web or other means
 - fees
 - translation into English (if applicable)
 - IB provides:
 - copy of the international application including the request form where a declaration of inventorship sheet was filed (if national stage entry occurs after publication)
 - copy of foreign priority documents (if timely provided to IB)
 - international search report (or declaration of non-establishment) and international preliminary report on patentability
- Restriction is made using unity of invention criterion
- Where the WOISA issued by ISA/US or IPRP (Chapter II) issued by IPEA/US indicates that all claims entering the national stage have novelty, inventive step and industrial applicability, the US national stage application will be taken up out of turn for examination

Disadvantages of national stage entry

- Subject matter cannot be added which goes beyond the disclosure of the international application as filed
- Applicant must file a literal English translation of the international application if published in another language
- Applicant may have to file an extensive preliminary amendment
 - to “clean up” the translation
 - to reduce the number of claims
 - to eliminate multiple dependent claims
- The basic national fee must be paid in full by 30 months
- Correction of the inventive entity requires a statement from each person being adding or deleted and a processing fee (37 CFR 1.497(d))

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Where Should I Seek Patent Protection

Where Should I Seek Patent Protection

- Four key factors
 - Business/commercial need for exclusivity
 - Initial and long-term cost
 - Quality of IP protection and enforcement
 - Return on investment

Business/commercial need for exclusivity

- The single most important consideration in deciding where to file is the business/commercial need for exclusivity in the country under consideration
- Remember
 - Any place you file should provide an adequate return on the money invested in IP protection
 - Any place you don't file, you will have no claim to exclusivity

Some questions to consider in determining the business/commercial need for exclusivity (1)

- Where is the market for the invention – local, regional, global? Who is the customer for the invention? Who is the competition?
- Where will the claimed product be manufactured or the claimed process used? Where does the competition manufacture its products?
- How easy (or difficult) would it be for competition to design around the claimed invention? How long and what resources would it take?
- How easy (or difficult) would it be for a third party to copy the invention? Is there an incentive to copy your invention in “unprotected” countries?
- How costly would it be for a third party to copy and market the invention?
- What is the smallest market size that would economically justify a third party copying the invention?
- How easy (or difficult) would it be for a third party to copy the invention? Is there an incentive to copy your invention in “unprotected” countries?
- How costly would it be for a third party to copy and market the invention?

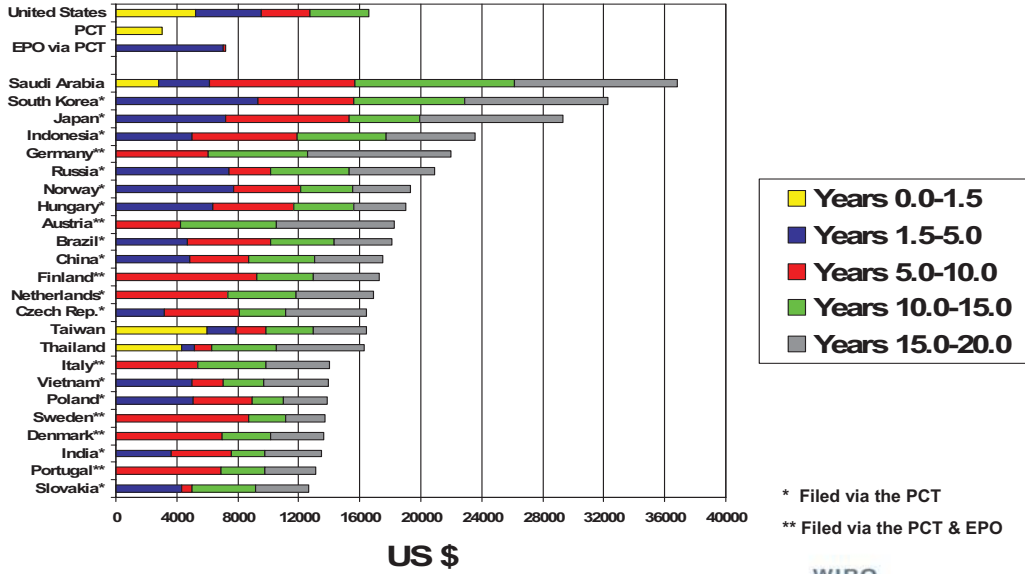
Some questions to consider in determining the business/commercial need for exclusivity (2)

- What is the smallest market size that would economically justify a third party copying the invention?
- Is the invention on-point with your marketing strategy or is it defensive?
- What are the consequences to your business if the invention is copied in some/all countries?
- By geographic area, what is more important, exclusivity, freedom-to-practice or both?
- What portion of your total market is represented by the country under consideration for filing/maintenance?
- For what period of time and where is exclusivity commercially important? How long does it take to get a patent in these countries? What is the local law regarding provisional protection?
- What is your patenting budget? What other developments are competing for this budget money?
- What is the current state of the patent law, procurement and enforcement systems? Is it changing for the better? Worse?

Initial and long-term cost

- The cost to file, prosecute, grant and maintain a patent varies widely by country
- Comparing the costs across different countries during various periods of time in a patent's life show the breadth of this variation

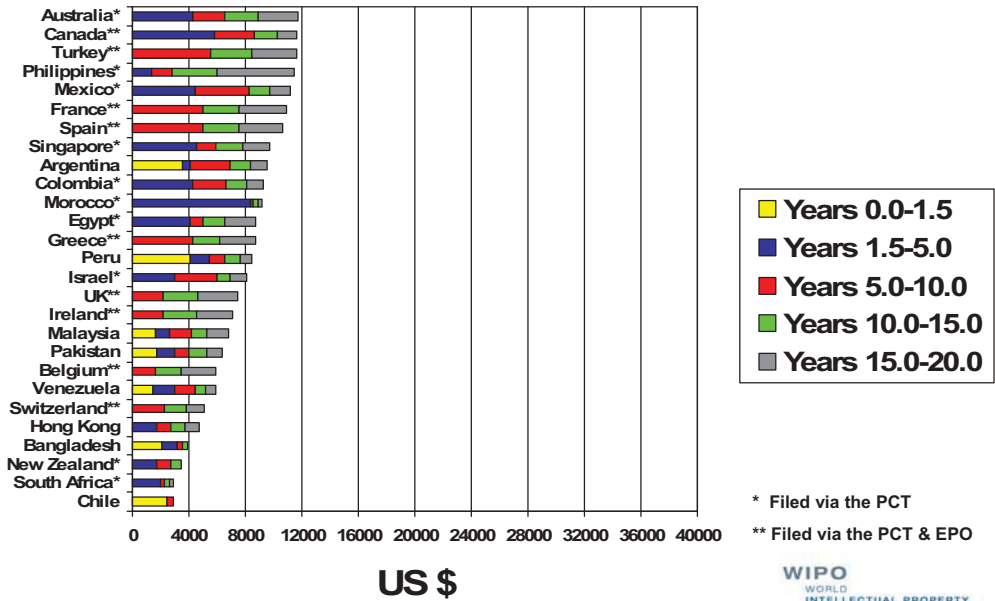
Relative cost to obtain and maintain a patent



* Filed via the PCT
 ** Filed via the PCT & EPO



Relative cost to obtain and maintain a patent



* Filed via the PCT
 ** Filed via the PCT & EPO



Caveats regarding cost data charts

- Cost data is a compilation of actual charges billed to the Company over a period of years coupled with current published annuity data
- The costs of Company attorneys and agents are NOT included in the figures (EP, US and PCT costs are separated from the other data as we act as our own agents for those proceedings)
- Data is current as of 2006; official fees and professional costs change over time
- Data is based on applications filed in English. Translation costs included in the data are for required translations into non-English languages
- Costs are in US\$ using conversions applicable at the time the charges were received
- Data should be used for “order of magnitude” cross-country cost comparisons ONLY. Figures are historic and are not sufficiently accurate to project actual cost of a new filing.

Quality of patent and ability to enforce

- The “adequacy” of the patent and legal systems including:
 - Considerations relating to enforcing the patent right, including costs, timing, immediate remedies, long-term remedies, availability/size of damage awards, etc.
 - The current and expected future state of the patent law
 - Considerations relating to obtaining an enforceable patent including costs, timing, quality of examination, etc.

are key to judging the quality of any patent system and the ability to enforce a patent

A process for evaluation the quality of a patent and enforcement system

Determine criteria critical to business

Possible key criteria relating to obtaining a patent (1)

- Cost and ease of filing and prosecution
- Competence and reasonableness of examiners
- Duration of examination
- Quality of examination
- Type, duration, cost and reasonableness of appeals
- Type, duration and cost of oppositions
- Announced/expected/contemplated changes in patent office operations

Possible key criteria relating to obtaining a patent (2)

- Patentable and unpatentable subject matter
 - Pharmaceuticals, secondary uses, business methods, software,
 - Methods of medical treatment, chemical compounds, etc.
- Novelty standards (for both publication and use)
- “Grace” periods following public exposure
- GATT/TRIPS compliance; Paris Convention/WTO membership
- PCT and/or regional office membership
- Provisional protection following publication/laying open

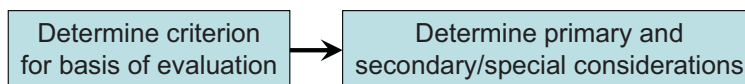
Possible key criteria relating to enforcing a patent (1)

- Working requirements/Consequences of non-working
- Parallel imports
- Prior user rights
- Border protection
- Technology transfer requirements/restrictions
- Other legal and regulatory requirements/laws
- Announced/expected/contemplated changes in the law
- Available remedies for infringement under local law
 - Preliminary/permanent injunctions, seizure actions, border actions, availability of and amounts of/limits on damage awards, criminal/civil penalties, etc.

Possible key criteria relating to enforcing a patent (2)

- System(s) for dispute resolution
 - Civil courts, patent courts, patent office proceedings, criminal courts, separate validity and infringement proceedings, mediation, arbitration, etc.
- How long for resolution? How expensive?
- Availability of and rules of discovery
- Technical competence of courts
- Historical level and direction of any court bias
- Political/judicial climate:
 - neutral or pro- or anti- patent
 - neutral or pro- or anti- foreign patentee
- Announced/Expected/Contemplated changes in enforcement procedures/systems/timing/costs
- Changes in political/judicial attitudes towards patents

A process for evaluating the quality of a patent and enforcement system



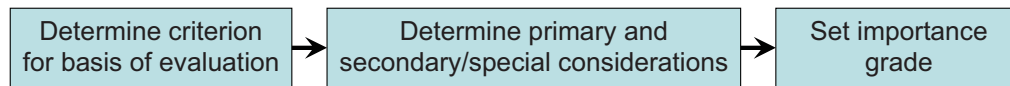
Primary criteria

- Related to obtaining:
 - Time to get a patent
 - Quality of examination
- Related to costs:
 - Cost to obtain
 - Cost to enforce
- National IP culture:
 - National posture toward IP rights of foreigners
- Related to enforcement:
 - Patent experience of courts
 - Availability of preliminary relief
 - Adequacy of border protection
 - Adequacy of permanent relief and/or availability of damages
 - Ability to enforce court judgments
 - Timeliness of enforcement actions

Secondary/special criteria

- Related to patentable subject matter:
 - Methods of treatment patentable?
 - Secondary (medical) uses patentable?
 - Business methods patentable?
 - Software patentable?
- Related to outside evaluations:
 - USTR report status
 - Index of economic freedom
 - Corruption perception index
- Others:
 - Protection for Rx regulatory data
 - Ability to conform claims to grant
 - Acceptability/availability of alternative dispute resolution

A process for evaluation the quality of a patent and enforcement system

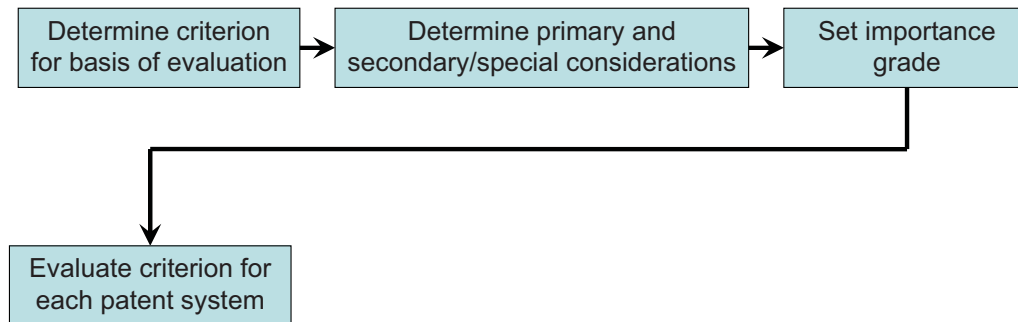


Setting the importance grade:

- Each criterion used for evaluation is assigned an importance grade indicating the weight each criterion will receive in the final evaluation:

- 4 = very important
- 3 = important
- 2 = moderate importance
- 1 = low importance

A process for evaluation the quality of a patent and enforcement system



Evaluate criterion for each patent system

- Each patent system of interest is evaluated against each of the primary and secondary/special criteria selected using a scale like:

4 = excellent

3 = good

2 = fair

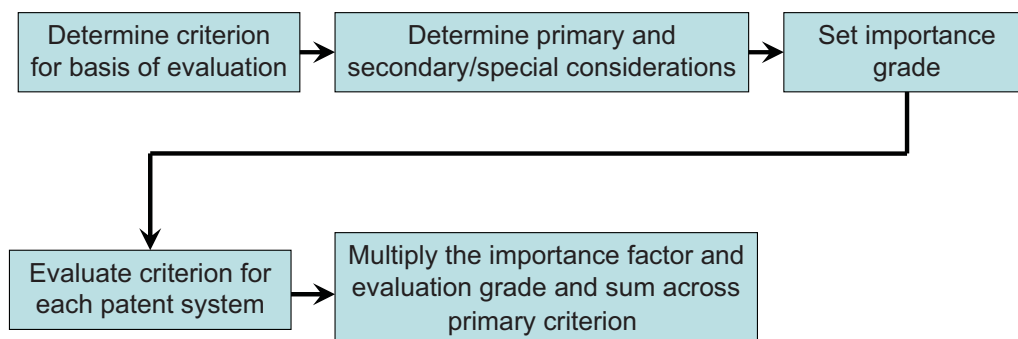
1 = poor

0 = unsatisfactory/non-existent

Data sources

- Surveys of foreign agents
- Surveys of multi-national agencies
- Personal experience
- USTR reports
- Experience of others
- Index of economic freed
- Published reports
- IP matter management data

A process for evaluation the quality of a patent and enforcement system



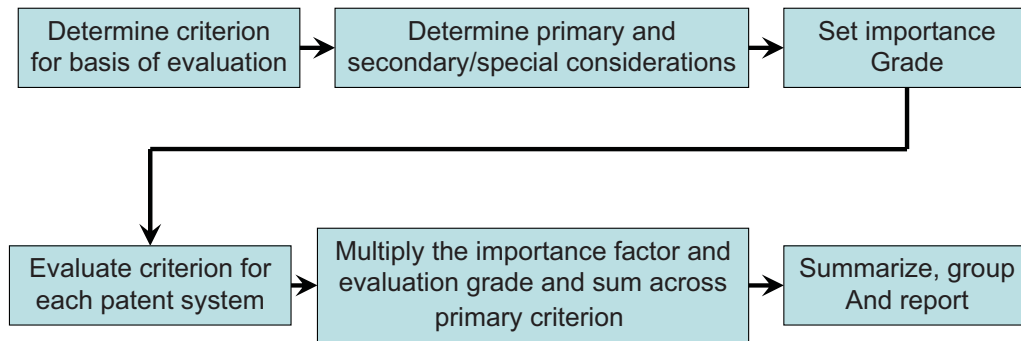
Patent System Overall Value Rating: ARGENTINA				
	Importance	Grade	Quality Points	Comments
	4 (high) to 1 (low)	4 (high) to 0	(Importance & Grade)	
Filing & Prosecution				
Time to Get a Patent (Shorter is Better)	1	2	2	6.65 years
Quality of Examination of Local System	2	2	4	
Enforcement				
Patent Experience of Forum/Courts	4	2	8	3-5 infringement suits per year; no special IP court; judges typically not have technical knowledge
Availability of Preliminary Relief (Injunctions/Seizures)	3	4	12	Prelim injunctions used in patent cases;
Adequacy/Availability of Border Protection	3	2	6	***
Availability/Adequacy of Permanent Relief (Injunctions/Damages)	4	3	12	Not same as US; no punitive damages available; but do have; not take into account profits made by infringer
Speed of Enforcement Actions	3	3	9	4 - 6 years
Ability to Enforce Court/Forum Decisions	4	4	16	Marval
Costs				
Cost to Obtain (Filing/Prosecution/Maintenance)	2	3	6	7500
Cost to Enforce (Cost of Litigation/Arbitration)	1	3	3	50 - 150M
National Attitude				
National/Governmental Posture Toward IP Rights Owned by Foreigners	2	0	0	neutral
TOTAL POINTS (Maximum 110)			78	
Special Considerations				
Are treatments for humans allowed?	1	0	0	
Are secondary uses allowed? (backup if no treatments allowed)	1	-1	-1	
Are business methods allowed?	1	0	0	
On USTR Watch List	1	-2	-2	AR made progress in decreasing its backlog of patent applications, due in part to hiring additional examiners, changing filing procedures and reducing the number of patents waiting to be examined. However, AR still does not provide adequate protection against unfair commercial use for data generated to obtain marketing approval. The US urges AR to implement an effective coordination system between its health and patent authorities to prevent the issuance of marketing approvals for patent-infringing pharmaceutical products, as well as to address problems that rights holders encounter in attempting to obtain timely and effective injunctions to stop such unfair commercial use. The US encourages stronger IPR enforcement actions.
Restricted Re-Use of Rx data (springboarding)	1	-2	-2	Per USTR
Economic Freedom Category (2007 Index of Economic Freedom*)	1	-1	-1	Argentina's economy is 57.5 percent free, according to our 2007 assessment, which makes it the world's 95th freest economy. Its overall score is 0.2 percentage point higher than last year, partially reflecting new methodological detail. Argentina is ranked 21st out of 29 countries in the Americas, and its overall score is slightly below the regional average. Argentina scores high in fiscal freedom, freedom from government, and monetary freedom. Top tax levels are comparable to those of the United States, as Argentina levies corporate and top income tax rates of 35 percent. While this is relatively high, government tax revenue as a percentage of GDP is low, and expenditure is correspondingly low as well. State ownership of businesses is also comparatively insignificant. Property rights, labor freedom, and freedom from corruption are all problems for Argentina (labor freedom less so than the others). Political interference with an inefficient judiciary hinders greater foreign investment, and numerous popular and official obstructions of due process make international courts preferable to Argentina.
Property Rights (2006 Index of Economic Freedom*)	1	2	2	30% free - The executive branch influences Argentina's judiciary, and independent surveys indicate that public confidence remains weak. Many foreign investors resort to international arbitration. An important violation of property rights is the "piquete," a form of protest in which protestors take over private business, causing extensive losses with no effective punishment by the police or the government. Argentine courts are notoriously slow, inefficient, secretive, and corrupt.
Does the PTO officially allow conformance to EPO or US?	1	1	1	
Corruption Perceptions Index 2006 (www.transparency.org)	1	-1	-1	2.9
A global settlement may not be honored in countries where there is no patent filing				
Ability for P&G to get a successful outcome in an infringement dispute by all means, including ex parte settlement.				
SubTotal Special Considerations			-4	
Grand Total			74	

Patent System Overall Value Rating: GERMANY				
	Importance	Grade	Quality Points	Comments
	4 (high) to 1 (low)	4 (high) to 0	(Importance & Grade)	
Filing & Prosecution (EPO)				
Time to Get a Patent (Shorter is Better)	1	3	3	5 years
Quality of Examination of Local System	2	4	8	
Enforcement				
Patent Experience of Forum/Courts	4	4	16	Duesseldorf Court is a globally recognized gold standard; 800 - 1000 infringement suits per year;
Availability of Preliminary Relief (Injunctions/Seizures)	3	3	9	Available; not easy to get; experience with patents
Adequacy/Availability of Border Protection	3	3	9	Free trade within EU, so some limitation; not able to stop pass-through; customs empowered to stop goods at border
Availability/Adequacy of Permanent Relief (Injunctions/Damages)	4	3	12	No punitive damages
Speed of Enforcement Actions	3	4	12	Quick (1-2 for simple; 3-4 for complex)
Ability to Enforce Court/Forum Decisions	4	4	16	Easy
Costs				
Cost to Obtain (Filing/Prosecution/Maintenance)	2	1	2	\$21,100
Cost to Enforce (Cost of Litigation/Arbitration)	1	2	2	several hundred thousand Euros
National Attitude				
National/Governmental Posture Toward IP Rights Owned by Foreigners	2	1	2	
TOTAL POINTS (Maximum 110)			91	
Special Considerations				
Are treatments for humans allowed?	1	0	0	
Are secondary uses allowed? (backup if no treatments allowed)	1	0	0	
Are business methods allowed?	1	1	1	
On USTR Watch List	1	-1	-1	
Restricted Re-Use of Rx data (springboarding)	1	0	0	
Economic Freedom Category (2007 Index of Economic Freedom*)	1	1	1	Germany's economy is 73.5 percent free, according to our 2007 assessment, which makes it the world's 19th freest economy. Its overall score is 0.5 percentage point lower than last year, partially reflecting new methodological detail. Germany is ranked 11th out of 41 countries in the European region, and its overall score is higher than the regional average. Germany enjoys strong business freedom, property rights, freedom from corruption, and investment freedom. Business regulations are clear and efficient, enforced by the rule of law, and free of political interference. The government imposes few restrictions on foreign capital, which is subject to the same regulations as domestic investment. There is almost no corruption. Freedom from government, financial freedom, and labor freedom are weaker. As in many other European social democracies, government spending and tax rates are exceptionally high in order to support an extensive welfare state. The labor market operates under restrictive conditions, although Germany has made a serious effort to lower its labor
Property Rights (2006 Index of Economic Freedom*)	1	5	5	90% free - Property is well protected in Germany. The judiciary is independent and efficient. Contractual agreements are secure, and the judiciary and civil service are highly professional. There are separate supreme courts to deal with cases on commercial, tax, labor, and constitutional issues.
Does the PTO officially allow conformance to EPO or US?	1	0	0	na
Corruption Perceptions Index 2006 (www.transparency.org)	1	1	1	8.0
A global settlement may not be honored in countries where there is no				
Ability for P&G to get a successful outcome in an infringement dispute				
SubTotal Special Considerations			7	
Grand Total			98	

Patent System Overall Value Rating: JAPAN				
	Importance	Grade	Quality Points	Comments
	4 (high) to 1 (low)	4 (high) to 0	(Importance & Grade)	
Filing & Prosecution				
Time to Get a Patent (Shorter is Better)	1	2	2	8.83 years
Quality of Examination of Local System	2	4	8	
Enforcement				
Patent Experience of Forum/Courts	4	4	16	average of 500-600 per year; have specialized court;
Availability of Preliminary Relief (Injunctions/Seizures)	3	4	12	available, easy to obtain, enforce
Adequacy/Availability of Border Protection	3	4	12	***
Availability/Adequacy of Permanent Relief (Injunctions/Damages)	4	4	16	max award 80MM; no obstacles to enforcement - smoothly executed;
Speed of Enforcement Actions	3	4	12	possible, including prelim injunction; no special procedure for speedy trial; ave 13 mo
Ability to Enforce Court/Forum Decisions	4	4	16	relatively easy;
Costs				
Cost to Obtain (Filing/Prosecution/Maintenance)	2	1	2	23M
Cost to Enforce (Cost of Litigation/Arbitration)	1	3	3	~250M
National Attitude				
National/Governmental Posture Toward IP Rights Owned by Foreigners	2	1	2	
TOTAL POINTS (Maximum 110)			101	
Special Considerations				
Are treatments for humans allowed?	1	0	0	
Are secondary uses allowed? (backup if no treatments allowed)	1	0	0	
Are business methods allowed?	1	2	2	
On USTR Watch List	1	0	0	
Restricted Re-Use of Rx data (springboarding)	1	0	0	
Economic Freedom Category (2007 Index of Economic Freedom*)	1	1	1	Japan's economy is 73.6 percent free, according to our 2007 assessment, which makes it the world's 18th freest economy. Its overall score is 1 percentage point lower than last year, partially reflecting new methodological detail. Japan is ranked 5th out of 30 countries in the Asia-Pacific region, and its overall score is much higher than the regional average. Japan enjoys high levels of trade freedom, property rights, business freedom, freedom from corruption, fiscal freedom, labor freedom, and monetary freedom. The average tariff rate is low, and business regulation is efficient. Virtually all commercial operations are simple and transparent. A very modest, stable deflation in prices has been occurring. Taxes are fairly high, and overall tax revenue is moderate as a percentage of GDP. Contracts in Japan are often imprecise, which can impede smooth judicial handling of commercial disputes. Despite the confusion, contract agreements are highly respected by the judiciary. There is very little corruption in the civil service. Japan is weaker in freedom from government and financial freedom. T
Property Rights (2006 Index of Economic Freedom*)	1	4	4	70% free - Property rights are generally secure in Japan. The courts do not discriminate against foreign investors but are not well suited to litigation of investment and business disputes. Japanese businesses tend to write their contracts in general terms, but despite this lack of precision, contracts are highly respected.
Does the PTO officially allow conformance to EPO or US?	1	0	0	
Corruption Perceptions Index 2006 (www.transparency.org)	1	1	1	7.6
A global settlement may not be honored in countries where there is no				
Ability for P&G to get a successful outcome in an infringement dispute				
SubTotal Special Considerations			8	
Grand Total			109	

Patent System Overall Value Rating: SAUDI ARABIA				
	Importance	Grade	Quality Points	Comments
	4 (high) to 1 (low)	4 (high) to 0	(Importance & Grade)	
Filing & Prosecution				
Time to Get a Patent (Shorter is Better)	1	1	1	11.91 years
Quality of Examination of Local System	2	2	4	Implemented exam system in last several years. Trained in Germany, but hired away by other businesses when trained.
Enforcement				
Patent Experience of Forum/Courts	4	1	4	Only 1 infringement suit settled; tribunal established, but lapsed;
Availability of Preliminary Relief (Injunctions/Seizures)	3	2	6	available, no experience
Adequacy/Availability of Border Protection	3	1	3	USTR is negative on border protection
Availability/Adequacy of Permanent Relief (Injunctions/Damages)	4	2	8	max ~55M USD damages; other remedies available
Speed of Enforcement Actions	3	2	6	speedy trial is possible; < 3 yrs for only trial held; rating is a 4, but no experience to speak of
Ability to Enforce Court/Forum Decisions	4	1	4	theoretically possible, but no experience
Costs				
Cost to Obtain (Filing/Prosecution/Maintenance)	2	1	2	\$33,975
Cost to Enforce (Cost of Litigation/Arbitration)	1	4	4	~100M USD is expected cost
National Attitude				
National/Governmental Posture Toward IP Rights Owned by Foreigners	2	1	2	USTR says progress being made
TOTAL POINTS (Maximum 110)			44	
Special Considerations				
Are treatments for humans allowed?	1	1	1	
Are secondary uses allowed? (backup if no treatments allowed)	1	0	0	
Are business methods allowed?	1	0	0	
On USTR Watch List	1	-1	-1	The US has been monitoring SA's progress on IPR issues since its accession to the WTO in 2005. While progress has been notable in several areas, including an increased number of IPR raids and a strengthening of SA's IPR legal regime through IPR amendments in connection with its WTO accession, Saudi Arabia should complete several IPR actions that it has initiated. For example, SA should increase transparency of its IPR enforcement regime, including in its judicial system; continue sustained raids and inspections to combat piracy and counterfeiting; ensure that courts impose deterrent sentences (including jail terms for serious offenses) against criminal IPR infringers; and improve border enforcement measures, among other IPR issues.
Restricted Re-Use of Rx data (springboarding)	1	0	0	
Economic Freedom Category (2007 Index of Economic Freedom*)	1	-1	-1	Saudi Arabia's economy is 59.1 percent free, according to our 2007 assessment, which makes it the world's 85th freest economy. Its overall score is 2.3 percentage points lower than last year, partially reflecting new methodological detail. Saudi Arabia is ranked 10th out of 17 countries in the Middle East/North Africa region, and its overall score is above the regional average. Saudi Arabia has high levels of fiscal freedom, labor freedom, property rights, and monetary freedom. Except for a mandatory Islamic 2.5 percent Zakat charitable contribution, the government imposes no taxes on personal or corporate income. Saudi Arabia's labor market is flexible, as the government imposes few costs on employing or firing workers. Inflation is less than 1 percent, and the government maintains no direct price supports. Saudi Arabia could improve its freedom from government, investment freedom, financial freedom, business freedom, and freedom from corruption. As in many other Gulf oil states, high government spending is supported by a large state-owned energy sector. The monarchy has begun to liberalize
Property Rights (2006 Index of Economic Freedom*)	1	3	3	50% free - Investors question the ability of Saudi courts to enforce contracts efficiently. The court system is slow and non-transparent, and the judiciary is influenced by the ruling elite.
Does the PTO officially allow conformance to EPO or US?	1	0	0	
Corruption Perceptions Index 2006 (www.transparency.org)	1	-1	-1	3.3
A global settlement may not be honored in countries where there is no				
Ability for P&G to get a successful outcome in an infringement dispute				
SubTotal Special Considerations			1	
Grand Total			45	

A process for evaluation the quality of a patent and enforcement system



Patent System Overall Value Rating:		AR	AT	AU	BD	BR	BE	CA	CH	CL	CO	CN	CZ	DE	DK	EG	EP	ES	FI	FR	GB	GR	HK	HU	ID	IE	IL	IN	IT
Country Quality Points																													
Importance																													
Filing & Prosecution																													
	Time to Get a Patent (Shorter is Better)	1	2	3	3	4	2	3	2	3	1	2	3	3	3	4	3	3	3	3	3	3	3	3	3	3	3	2	2
	Quality of Examination of Local System	2	4	8	8	2	6	8	6	8	4	4	6	8	8	8	4	8	8	8	8	8	8	6	8	4	8	6	4
Enforcement																													
	Patent Experience of Forum/Courts	4	8	8	16	4	12	8	12	8	8	0	16	4	16	8	8	0	12	12	8	16	8	4	12	4	8	8	4
	Availability of Preliminary Relief (Injunctions/Seizures)	3	12	9	12	6	12	12	9	6	9	12	9	9	12	9	9	0	12	9	9	9	6	9	6	9	6	9	9
	Adequacy/Availability of Border Protection	3	6	6	12	0	6	12	6	6	9	3	3	9	9	6	0	0	0	9	9	3	9	6	9	3	6	0	3
	Availability/Adequacy of Permanent Relief (Injunctions/Damages)	4	12	12	12	4	12	12	16	8	12	12	8	12	12	12	8	0	12	8	16	12	8	12	8	8	12	16	8
	Speed of Enforcement Actions	3	9	9	9	6	12	9	9	12	12	6	12	3	12	9	12	0	9	12	9	12	9	9	9	9	12	12	9
	Ability to Enforce Court/Forum Decisions	4	16	12	16	4	12	16	16	16	12	4	4	16	12	12	0	16	16	16	16	16	12	12	12	16	16	16	12
Costs																													
	Cost to Obtain (Filing/Prosecution/Maintenance)	2	6	2	4	8	2	6	4	6	8	4	2	2	2	4	6	0	6	2	6	6	6	8	2	2	6	6	4
	Cost to Enforce (Cost of Litigation/Arbitration)	1	3	3	2	1	4	4	1	3	3	4	4	4	2	3	4	0	4	4	4	2	4	2	4	2	2	3	4
National Attitude																													
	National/Governmental Posture Toward IP Rights Owned by Foreigners	2	0	2	2	0	0	2	2	2	2	-2	2	2	2	0	0	2	2	2	2	2	0	2	0	2	0	2	
TOTAL POINTS (Maximum 110)		78	74	96	39	80	92	83	78	80	57	69	63	91	76	67	11	93	85	84	95	76	74	69	63	78	76	56	
Special Considerations																													
	Are treatments for humans allowed?	1	0	0	1	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0	
	Are secondary uses allowed? (backup if no treatments allowed)	1	-1	0	0	0	0	0	0	0	0	-1	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0	0	
	Are business methods allowed?	1	0	1	2	0	0	1	0	1	0	0	2	1	1	1	0	1	1	0	1	1	1	0	1	0	1	0	
	On USTR Watch List	1	-2	-1	0	0	-1	-1	-1	-1	-2	-1	-2	-1	-1	-2	0	-1	-1	-1	-1	-1	0	-1	0	-1	-1	-2	
	Restricted Re-Use of Rx data (springboarding)	1	-2	0	-1	0	-2	0	-1	0	-2	0	-2	0	0	-2	0	0	0	0	0	0	0	-1	-2	0	-2		
	Economic Freedom Category (2006 Index of Economic Freedom)	1	-1	1	2	-2	0	1	1	1	1	0	-1	0	1	1	-1	1	1	0	2	-1	2	0	-1	2	0	-1	
	Property Rights (2006 Index of Economic Freedom)	1	2	5	5	1	3	5	5	5	2	2	4	5	3	4	5	4	5	3	5	4	5	3	4	2	5	4	
	Does the PTO officially allow conformance to EPO or US?	1	1	0	1	0	1	0	1	0	1	1	0	0	0	0	0	0	0	0	0	0	0	1	0	1	0	0	
	Corruption Perceptions Index 2006 (www.transparency.org)	1	1	1	1	-1	-1	1	1	1	1	-1	-1	1	1	1	-1	0	1	1	1	1	-1	1	0	-1	1	-1	
A global settlement may not be honored in countries where there is no patent filing																													
Ability to get a successful outcome in an infringement dispute by all means, including ex parte settlement.																													
Sub Total Special Considerations		-4	7	11	-2	0	7	6	7	4	0	-2	3	7	7	-3	1	5	6	5	8	1	9	3	-2	8	1	-3	
Grand Total		74	81	107	37	80	99	89	85	84	57	67	66	98	83	64	12	98	91	89	103	77	83	72	61	86	77	53	

Patent System Overall Value Rating:		JP	KR	LU	MA	MX	MY	NL	NO	NZ	PE	PH	PK	PL	PT	RU	SA	SE	SG	SK	TH	TR	TW	US	VE	VN	ZA		
	Country																												
	Quality Points																												
	Importance																												
	Filing & Prosecution																												
	Time to Get a Patent (Shorter is Better)	1	2	3	4	2	2	3	2	4	4	2	4	3	3	3	1	3	3	3	3	1	3	4	4	3	2	4	
	Quality of Examination of Local System	2	8	8	0	6	2	8	6	6	4	4	0	8	8	6	4	8	4	8	2	8	6	8	4	2	0		
	Enforcement																												
	Patent Experience of Forum/Courts	4	16	16	4	4	12	8	16	8	12	8	4	4	16	8	4	12	4	4	8	8	8	12	0	4	16		
	Availability of Preliminary Relief (Injunctions/Seizures)	3	12	12	9	9	12	9	12	9	9	12	6	6	3	12	9	6	9	9	9	9	6	12	9	9	6	9	
	Adequacy/Availability of Border Protection	3	12	9	6	6	9	12	6	3	3	3	3	6	12	6	3	6	3	6	0	3	6	12	6	3	6		
	Availability/Adequacy of Permanent Relief (Injunctions/Damages)	4	16	16	8	8	12	12	16	12	12	12	4	8	16	12	8	12	8	12	8	8	16	16	4	8	12		
	Speed of Enforcement Actions	3	12	12	6	9	12	12	12	12	9	6	6	9	9	12	6	9	12	3	9	12	9	9	9	3	9		
	Ability to Enforce Court/Forum Decisions	4	16	16	16	12	12	16	16	16	8	16	8	8	8	4	4	4	12	16	4	8	4	16	16	4	4	16	
	Costs																												
	Cost to Obtain (Filing/Prosecution/Maintenance)	2	2	2	8	4	4	2	2	2	8	6	4	6	4	4	2	2	4	6	4	2	4	2	4	6	4	8	
	Cost to Enforce (Cost of Litigation/Arbitration)	1	3	2	4	4	4	2	3	4	3	4	4	4	4	4	1	4	2	3	4	4	2	1	3	3	3		
	National Attitude																												
	National/Governmental Posture Toward IP Rights Owned by Foreigners	2	2	2	0	2	2	2	0	2	0	2	2	2	2	0	2	2	2	2	2	0	-2	2	2	-2	2	0	
	TOTAL POINTS (Maximum 110)	101	98	74	60	84	73	99	83	90	70	63	47	59	90	63	44	79	70	59	51	58	83	93	39	41	83		
	Special Considerations																												
	Are treatments for humans allowed?	1	0	0	0	0	0	0	0	0	0	0	0	0	0	0	1	0	0	0	0	0	0	0	1	0	0	0	
	Are secondary uses allowed? (backup if no treatments allowed)	1	0	0	0	0	0	0	0	0	-1	0	0	0	0	0	0	0	0	0	0	0	0	0	0	-1	0	0	
	Are business methods allowed?	1	2	2	1	0	0	0	1	0	0	0	0	1	1	0	0	1	0	1	0	1	0	1	0	2	0	0	0
	On USTR Watch List	1	0	-1	-1	0	-1	-1	0	0	-1	-1	-1	-1	-1	-1	-2	-1	-1	0	-1	-2	-2	-1	0	-2	-1	0	
	Restricted Re-Use of Rx data (springboarding)	1	0	0	1	0	-2	0	0	0	-1	0	-2	-2	0	-2	0	0	0	0	-2	0	0	0	0	-2	0	0	
	Economic Freedom Category (2006 Index of Economic Freedom)	1	1	0	5	-1	0	0	1	2	0	-1	-1	-1	-1	-1	-1	1	2	0	0	-1	1	2	-2	-1	0		
	Property Rights (2006 Index of Economic Freedom)	1	4	4	5	2	3	5	5	2	2	2	3	4	2	3	4	2	3	5	3	3	4	5	2	1	3		
	Does the PTO officially allow conformance to EPO or US?	1	0	0	0	1	1	0	0	1	1	0	1	0	0	0	0	0	1	0	1	0	0	0	0	0	1	1	
	Corruption Perceptions Index 2006 (www.transparency.org)	1	1	0	1	-1	0	1	1	1	-1	-1	-1	-1	-1	0	-1	1	1	1	-1	-1	0	1	-1	-1	-1		
	A global settlement may not be honored in countries where there is no patent filing																												
	Ability for P&G to get a successful outcome in an infringement dispute by all means, including ex parte settlement.																												
	SubTotal Special Considerations	8	5	12	1	0	1	7	7	9	-1	-1	-2	-1	5	-4	1	7	9	2	-1	-2	4	11	-6	-1	3		
	Grand Total	109	103	86	61	84	74	106	90	99	69	62	45	58	95	59	45	86	79	61	50	56	87	104	33	40	86		

KEY

Patent System Overall Value Rating:			
	Importance	Grade	Quality Points
	4 (high) to 1 (low)	4 (high) to 0	(Importance & Grade)
Filing & Prosecution			
Time to Get a Patent (Shorter is Better)	1		< 4 years = 4; ≥ 4 - < 6 years = 3; ≥ 6 - 9 = 2; ≥ 9 = 1 Formalities only = 0,1;
Quality of Examination of Local System	2		
Enforcement			
Patent Experiences of Forum/Courts	4		Specialized IP Court? No. of cases handled? Technical competence? 3-5 infringement suits per year = grade 2; questions 2, 3, 4 haven't have; difficulty in obtaining; 4 = available, easy to obtain, and used for patents; 3 = available, difficult to obtain, used with patents; 2 = available, difficult to obtain, no practical experience; 1 = unavailable; question 12
Availability of Preliminary Relief (Injunctions/Seizures)	3		stop in-transit shipments; willingness to enforce; 4 = court order readily available to seize product, good cooperation between govt agencies have/don't have; difficulty in obtaining; historical level of damages; punitive damages available; maximum on damages; questions 9, 15 how quickly will govt act to stop damage; 4 ≤ 3 yrs; 3 = 3 - 5 yrs; 2 = 5-7 years; 1 > 7 yrs; questions 6, 7
Adequacy/Availability of Border Protection	3		history; 4 = easy to enforce; demonstrated history, included in civil law; 3 = theoretically easy to enforce, no experience; 2 = expected to be difficult, no experience; 1 = demonstrated difficult; question 11
Availability/Adequacy of Permanent Relief (Injunctions/Damages)	4		
Speed of Enforcement Actions	3		
Ability to Enforce Court/Forum Decisions	4		
Costs			
Cost to Obtain (Filing/Prosecution/Maintenance)	2		≤ 5M = 4; 5 - 10M = 3; 10 - 15 M = 2; > 15M = 1; cost to file in the EPO is about \$1M per country; calculate maintenance for each EPO country separately
Cost to Enforce (Cost of Litigation/Arbitration)	1		4 = <100M; 3 = 100 - 500M; 2 = 500M - 1MM; 1 = 1 - 2MM; 0 > 2MM
National Attitude			
National/Governmental Posture Toward IP Rights Owned by Foreigners	2		US/STR report; political attitude: is patent law living (revised periodically)? 1 = pro-patent; 0 = neutral; -1 = anti-patent
TOTAL POINTS (Maximum 110)			
Special Considerations			
Are treatments for humans allowed?	1		1 = yes; 0 = no
Are secondary uses allowed? (backup if no treatments allowed)	1		0 = yes; -1 = no
Are business methods allowed?	1		2 = yes; 1 = yes, but limited; 0 = no
On US/STR Watch List	1		0 = not on list; -1 = watch; -2 = priority watch
Restricted Re-Use of Rx data (springboarding)	1		0 = no use allowed; -1 = some limitation; -2 = little or no limitation
Economic Freedom Category (2007 Index of Economic Freedom*)	1		free (80-100% free) = 2, mostly free (70 - 79% free) = 1, moderately free (60 - 69% free) = 0; mostly unfree (50 - 59% free) = -1, repressed (0 - 49% free) = -2; Freedom refers to economic freedom, e.g., free means a low level of government interference in the economy; repressed means a high level of government interference in the economy.
Property Rights (2006 Index of Economic Freedom*)	1		5 = very high (81 - 100%); 4 = high (61 - 80%); 3 = moderate (41 - 60%); 2 = low (21 - 40%); 1 = very low (0 - 20%)
Does the PTO officially allow conformance to EPO or US?	1		saves on prosecution costs if yes, or allows stronger post-grant claims if there is no substantive exam; 1 = yes officially or unofficially
Corruption Perceptions Index 2006 (www.transparency.org)	1		CPI Scores relates to perceptions of the degree of corruption as seen by business people and country analysts, and ranges between 10 (highly clean) and 0 (highly corrupt). CPI scores <5 = -1, 5.1 - 6.9 = 0; >7.0 = 1
A global settlement may not be honored in countries where there is no patent filing			
Ability for P&G to get a successful outcome in an infringement dispute by all means, including ex parte settlement.			
Sub Total Special Considerations			
Grand Total			
* http://www.heritage.org/research/features/index/countries.cfm			
*** Need to get more data from agents			

Arranging countries by quartiles based on Quality Point totals									
	Quality Points		Quality Points		Quality Points		Quality Points		Quality Points
	86 - 101	Group 2	71 - 85	Group 3	55 - 70	Group 4	39 - 54		
Group 1									
Australia	96	Argentina	78	Colombia	57	Bangladesh	39		
Belgium	92	Austria	74	China	69	Pakistan	47		
Germany	91	Brazil	80	Czech Rep	63	Saudi Arabia	44		
Great Britain	95	Canada	83	Egypt	67	Thailand	51		
Japan	101	Chile	80	Hungary	69	Venezuela	39		
Korea	98	Denmark	76	Indonesia	63	Vietnam	41		
Netherlands	99	Finland	85	India	56				
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		Luxembourg	74	Russia	63				
		Mexico	84	Singapore	70				
		Malaysia	73	Slovak Rep	59				
		Norway	83	Turkey	58				
		Taiwan	83						
		South Africa	83						
		Sweden	79						
		Switzerland	78						

Final thoughts regarding patent and enforcement systems

- The life of a patent is 20 years from filing
- The evaluation of the patent and enforcement systems is made before this 20 year period begins
- Patent laws and court systems can and do change with time. Today's poor system may well be tomorrow's good system
- Every applicant and practitioner should keep up-to-date on the patent and enforcement systems of interest factoring current trends and expected future patent system improvements

Return on investment (1)

- Considering patents, it should not be a surprise that seeking protection in a broad range of countries can prove to be very expensive
- The cost over the 20-year life of a broadly filed patent can exceed \$750,000
- Broad-based industrial design and trademark protection can likewise be very expensive
- Obtaining an adequate return on the investment made in filing, obtaining and maintaining patent applications is important to your business

Return on investment (2)

- A patent is a business tool and must “pay its own way.” If it does not, the patent is a drain on business assets and (most likely) should either not have been filed or maintained
- For applicants who license or sell their patents, an actual ROI can be determined from the investment and the revenue from the patent sale or license
- For applicants manufacturing and/or selling a product, learning the actual ROI may be impossible – you will never really know if the absence of a filed patent would have affected your commercial success, or *vice versa*

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US consultants to WIPO on PCT matters

Carol Bidwell (in Tucson, AZ)

E-mail: pct-carol@wbhsi.net

Tel: (520) 825-7426

Fax: (520) 825-7426

T. David Reed (in Cincinnati, OH)

E-mail: david@TDRPatents.com

Tel: (513) 752-6261

Fax: (513) 752-6281

Website: www.TDRPatents.com

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