WIPO | PCT
The International Patent System

# The PCT system: current status and recent developments

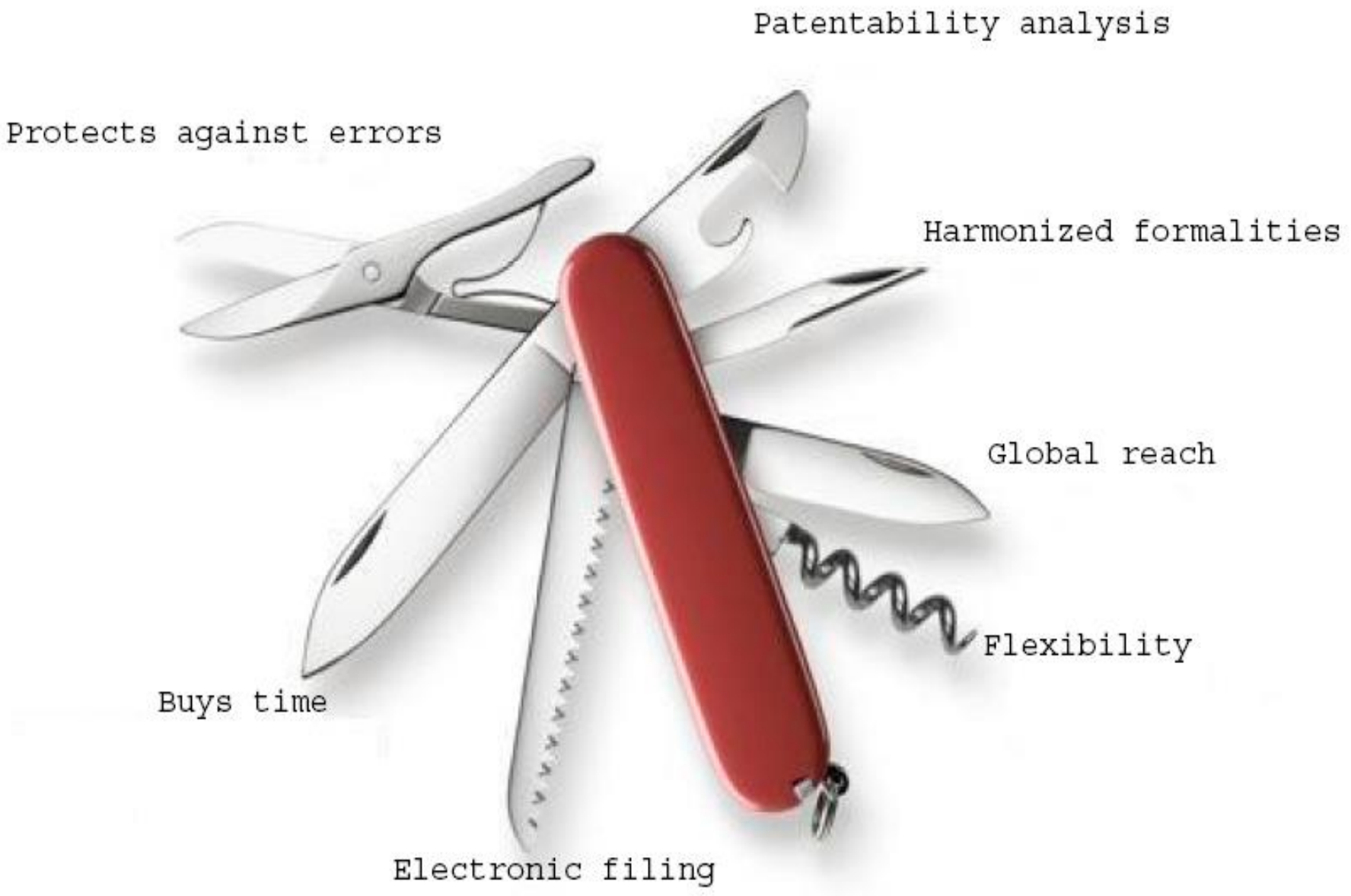
Matthias Reischle
Deputy Director, PCT Legal Division, WIPO

September 25, 2014

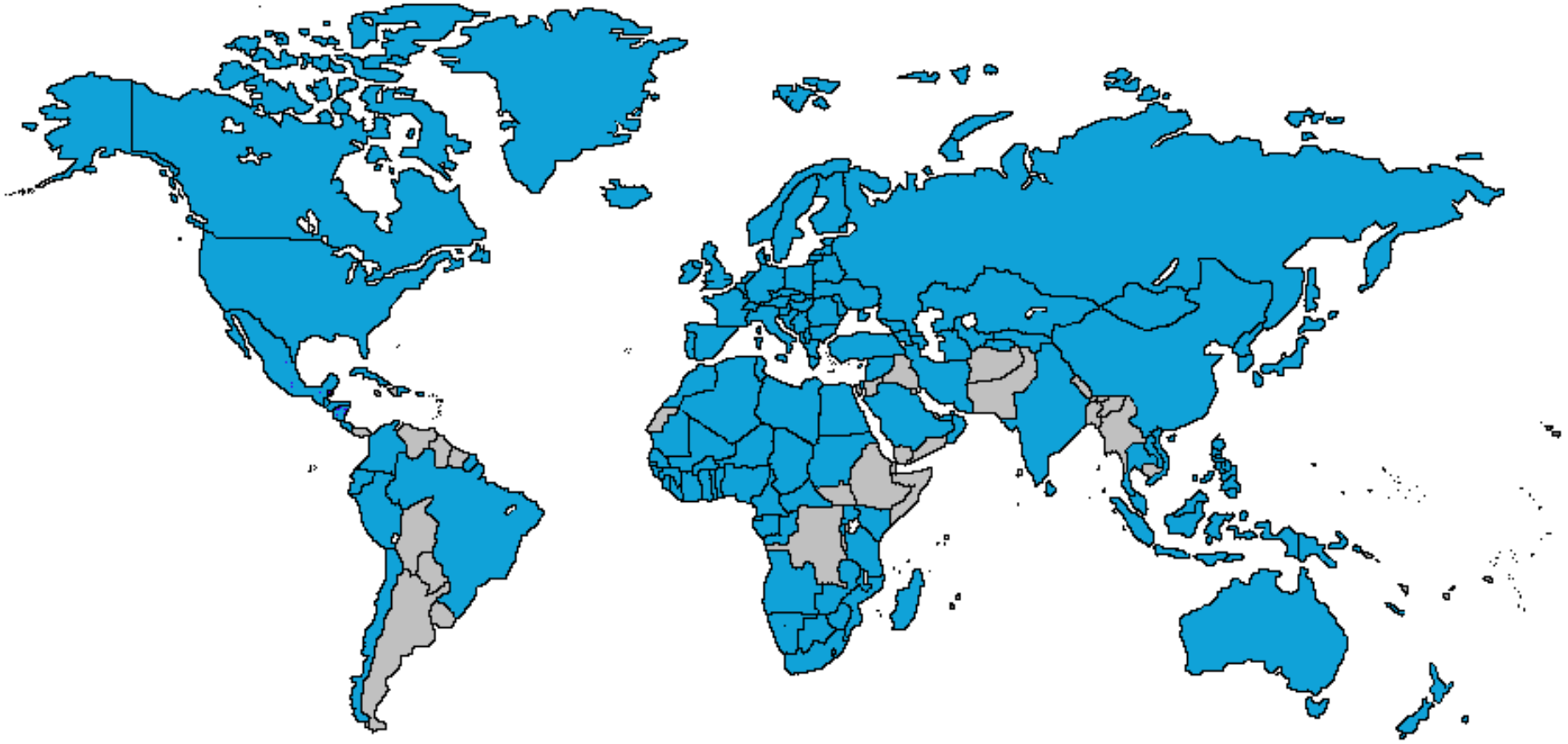
# How Many Users See the PCT

Buys time

# Your PCT Tool



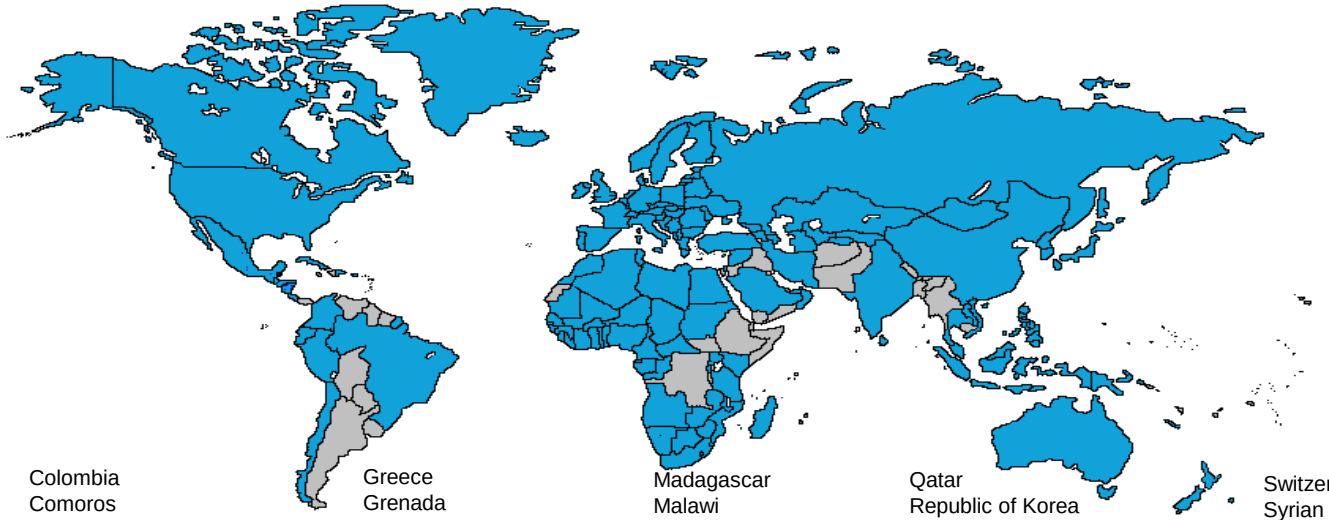
# PCT Coverage Today



WIPO | PCT
The International Patent System

# 148 PCT States

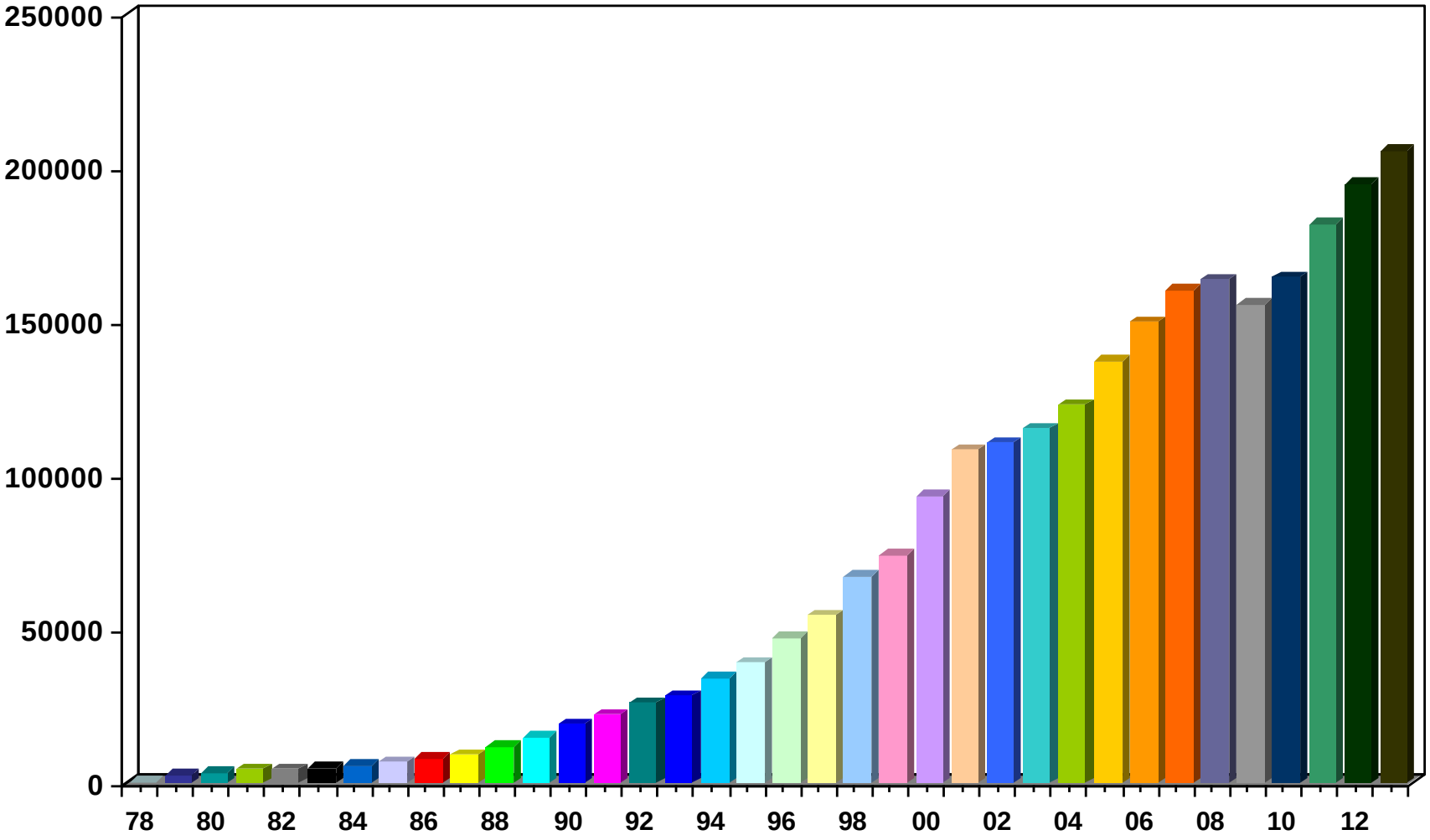
=PCT



Albania
Algeria
Angola
Antigua and Barbuda
Armenia
Australia
Austria
Azerbaijan
Bahrain
Barbados
Belarus
Belgium
Belize
Benin
Bosnia and Herzegovina
Botswana
Brazil
Brunei Darussalam
Bulgaria
Burkina Faso
Cameroon
Canada
Central African Republic
Chad
Chile
China
Colombia
Comoros
Congo
Costa Rica
Côte d'Ivoire
Croatia
Cuba
Cyprus
Czech Republic
Democratic People's Republic of Korea
Denmark
Dominica
Dominican Republic
Ecuador
Egypt
El Salvador
Equatorial Guinea
Estonia
Finland
France
Gabon
Gambia
Georgia
Germany
Ghana
Greece
Grenada
Guatemala
Guinea
Guinea-Bissau
Honduras
Hungary
Iceland
India
Indonesia
Iran (Islamic Republic of)
Ireland
Israel
Italy
Japan
Kazakhstan
Kenya
Kyrgyzstan
Lao People's Dem Rep.
Latvia
Lesotho
Liberia
Libyan Arab Jamahiriya
Liechtenstein
Lithuania
Luxembourg
Madagascar
Malawi
Malaysia
Mali
Malta
Mauritania
Mexico
Monaco
Mongolia
Montenegro
Morocco
Mozambique
Namibia
Netherlands
New Zealand
Nicaragua
Niger
Nigeria
Norway
Oman
Panama
Papua New Guinea
Peru
Philippines
Poland
Portugal
Qatar
Republic of Korea
Republic of Moldova
Romania
Rwanda
Russian Federation
Saint Lucia
Saint Vincent and the Grenadines
San Marino
Sao Tomé e Principe
Saudi Arabia
Senegal
Serbia
Seychelles
Sierra Leone
Singapore
Slovakia
Slovenia
South Africa
Spain
Sri Lanka
Sudan
Swaziland
St. Kitts and Nevis
Sweden
Switzerland
Syrian Arab Republic
Tajikistan
Thailand
The former Yugoslav Republic of Macedonia
Togo
Trinidad and Tobago
Tunisia
Turkey
Turkmenistan
Uganda
Ukraine
United Arab Emirates
United Kingdom
United Republic of Tanzania
United States of America
Uzbekistan
Viet Nam
Zambia
Zimbabwe

WIPO | PCT
The International Patent System

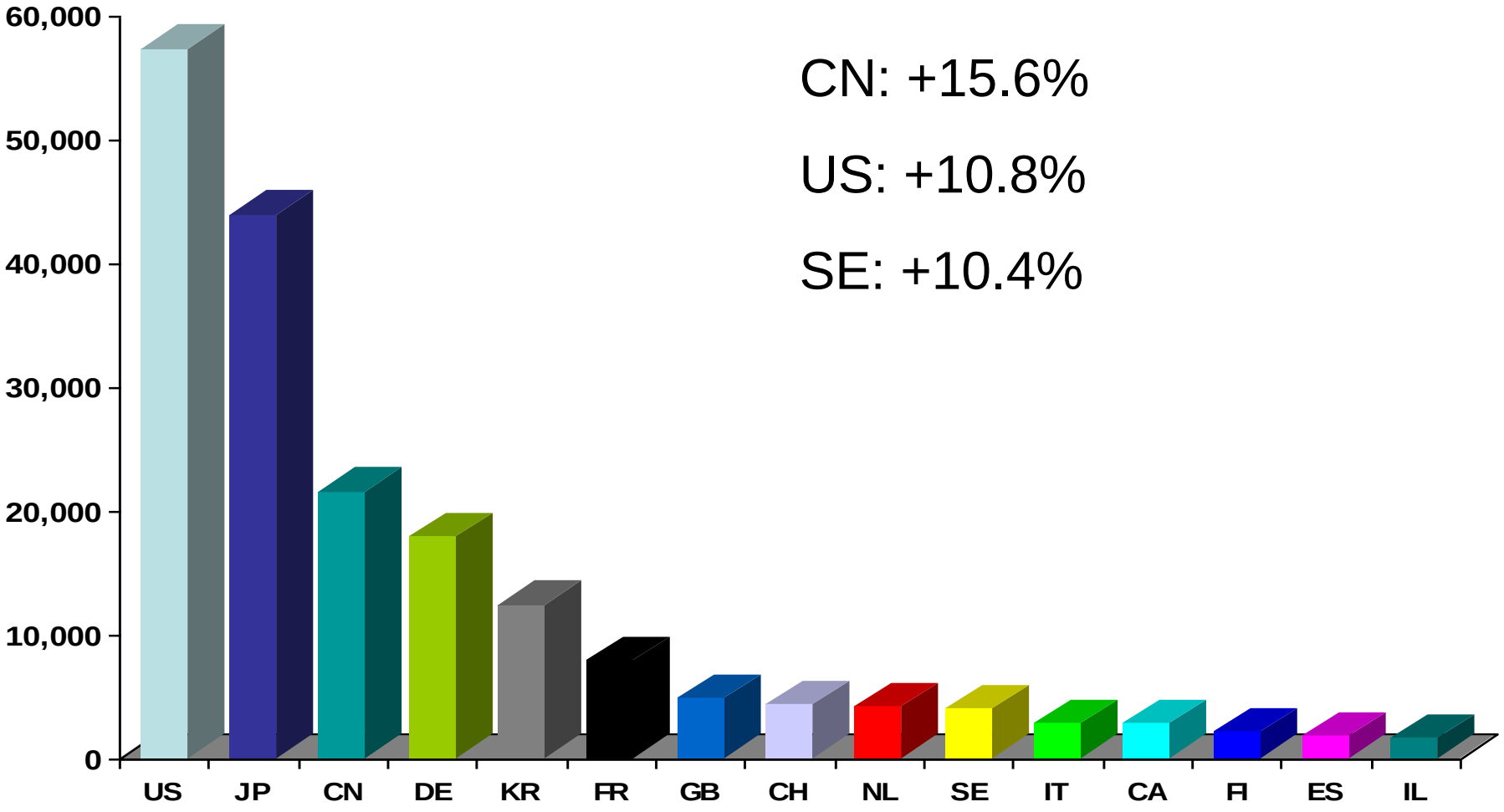
# PCT Applications 2013




**2013: 205,300 PCT applications (+5.1%)**

WIPO | PCT
The International Patent System

# International applications received in 2013 by country of origin



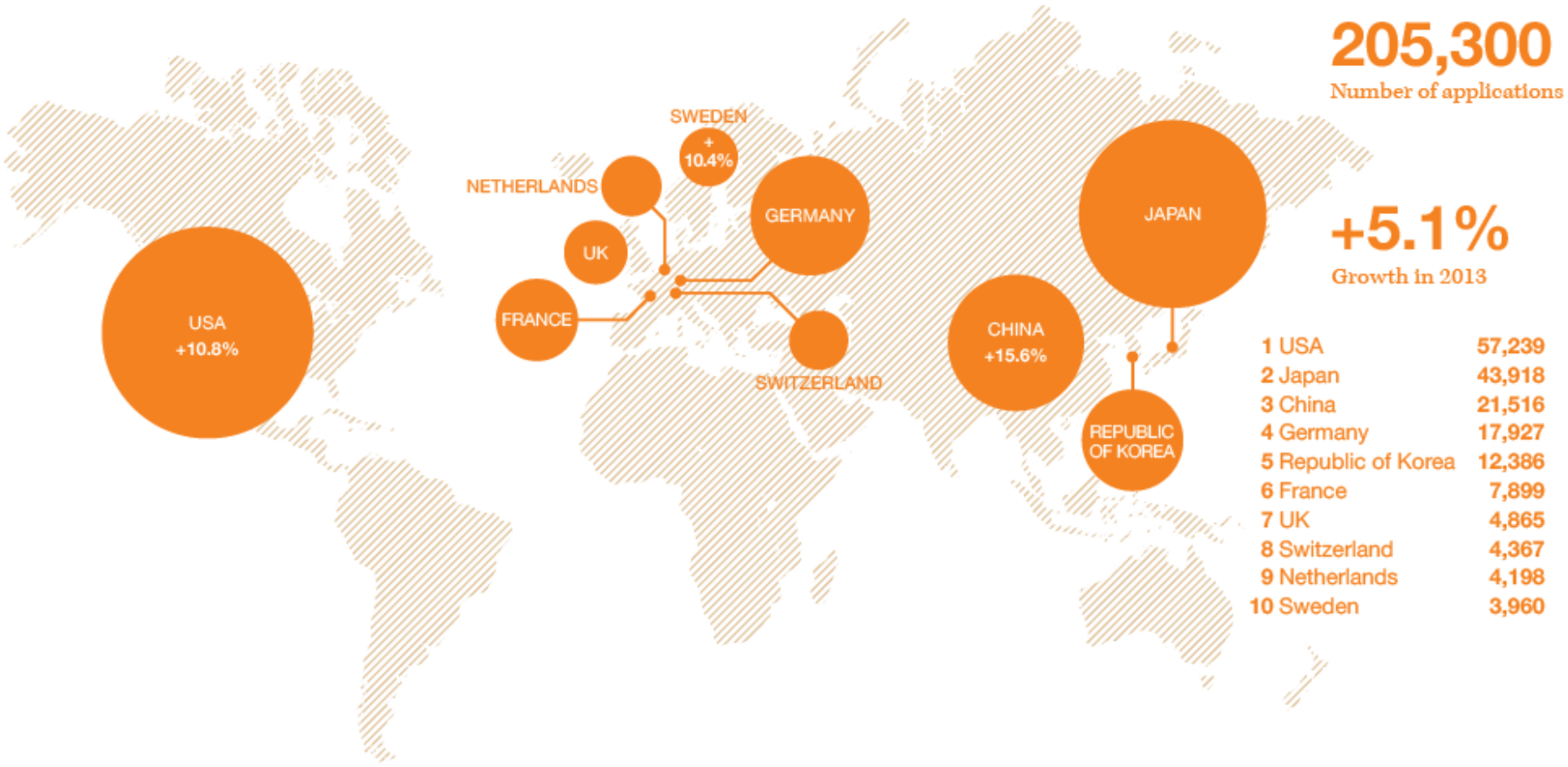

CN: +15.6%

US: +10.8%

SE: +10.4%

WIPO | PCT
The International Patent System

# Main PCT filing countries: 2013



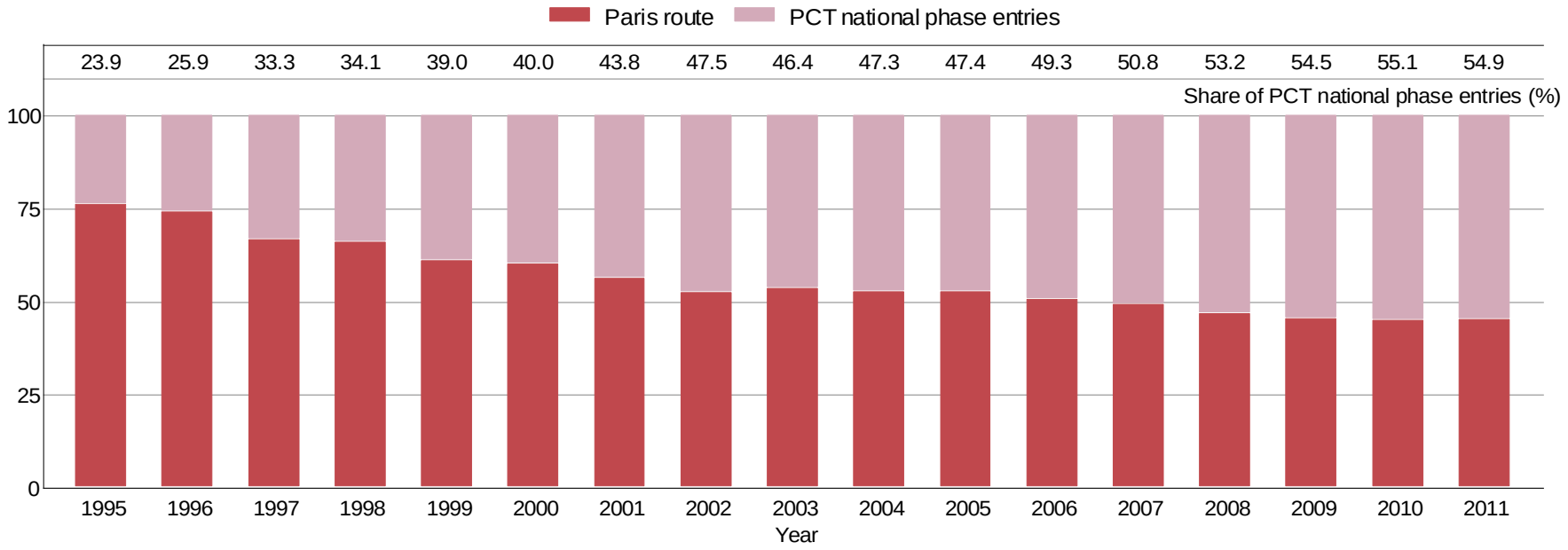

**205,300**
Number of applications

**+5.1%**
Growth in 2013

| | | |
|---|---|---|
| 1 | USA | 57,239 |
| 2 | Japan | 43,918 |
| 3 | China | 21,516 |
| 4 | Germany | 17,927 |
| 5 | Republic of Korea | 12,386 |
| 6 | France | 7,899 |
| 7 | UK | 4,865 |
| 8 | Switzerland | 4,367 |
| 9 | Netherlands | 4,198 |
| 10 | Sweden | 3,960 |

WIPO | PCT
The International Patent System

# Paris route vs. PCT national phase




WIPO | PCT
The International Patent System

# PCT International Searching Authorities

The ISAs are the following 19 Offices*:

- Australia
- Austria
- Brazil
- Canada
- Chile (not yet operating)
- China
- Egypt
- Finland
- India
- Israel
- Japan
- Republic of Korea
- Russian Federation
- Spain
- Ukraine (not yet operating)
- United States of America
- European Patent Office
- Nordic Patent Institute

* Office of filing decides on which ISAs are available

WIPO | PCT
The International Patent System

# Top PCT Applicants 2013

1. Panasonic—JP (2881)
2. ZTE—CN (2309)
3. Huawei—CN (2094)
4. Qualcomm—US (2036)
5. Intel—US (1852)
6. Sharp—JP (1840)
7. Bosch—DE (1786)
8. Toyota—JP (1696)
9. Ericsson—SE (1467)
10. Philips—NL (1423)
11. Siemens—DE (1323)
12. Mitsubishi Electric—JP (1312)
13. Samsung Electronics—KR (1193)
14. NEC—JP (1190)
15. LG Electronics—KR (1170)
16. Fujifilm Corporation (1008)
17. Shenzhen China Star Optoelectronics—CN (916)
18. Sony—JP (915)
19. Hitachi—JP (841)
20. Nokia—FI (807)

() of published PCT applications

WIPO | PCT
The International Patent System

# Top University PCT Applicants 2013

1. University of California (US)
2. MIT (US)
3. Columbia University (US)
4. University of Texas (US)
5. Harvard University (US)
6. Johns Hopkins (US)
7. Korea Advanced Institute of Science and Technology (KR)
8. Leland Stanford University (US)
9. Cornell University (US)
10. Cal Tech (US)
11. University of Florida (US)
12. Postech Foundation (KR)
13. Seoul National University (KR)
14. Peking University (CN)
15. Nanyang Technical University (CN)
16. University of Tokyo (JP)
17. Isis Innovation Limited (GB)
18. University of Pennsylvania (US)
19. University of Michigan (US)
20. National University of Singapore (SG)

# Recent PCT developments

- Amended PCT Regulations— 1 July 2014
- Third Party Observation system
- Indication of availability for license
- ePCT
- PCT-PPH
- WIPO AMC fee reduction for PCT users
- Misleading invoices

# Amended PCT Regulations—July 2014

- PCT Rules 66 and 70: IPEAs are required to conduct top-up searches during the Chapter II procedure

- PCT Rule 44*ter* (deleted) and Rule 94: the written opinion of the ISA will be available to the public via PATENTSCOPE at international publication

- These amendments to the PCT Regulations have entered into force on July 1, 2014, for demands for IPE filed on or after that date, and for applications filed on or after that date, respectively

WIPO | PCT
The International Patent System

# Third Party Observation System

- Allows third parties to submit prior art observations relevant to **novelty** and **inventive step** as to published PCT applications
  - Goal: Improve patent quality--give national offices (and PCT Authorities) better/more complete information on which to base their decisions
- Web-based system using in PATENTSCOPE or via ePCT public services
- Free
- Submissions possible until the expiration of **28 months** from the priority date
- Applicants may submit comments in response to submitted observations until the expiration of **30 months** from the priority date
- Anonymous submission of third party observations possible

# Indication of availability for license

- PCT applicants can indicate that the invention disclosed in the application is available for license
  - How? By submitting a “licensing request” (see PCT Form PCT/IB/382) directly to the IB
  - When? At the time of filing or within 30 months from the priority date
  - Cost? Free
  - Applicants can file multiple licensing requests or update previously submitted ones (within 30 months from the priority date) and such requests may be revoked by the applicant at any time, that is, also after 30 months from the priority date
- Submitted licensing indications made publicly available after international publication of the application on PATENTSCOPE under “*Bibliographic data*” tab with a link to the submitted licensing request itself
- International applications containing such licensing indication requests can be searched in PATENTSCOPE
- Most use thus far from universities/research institutions

WIPO | PCT
The International Patent System

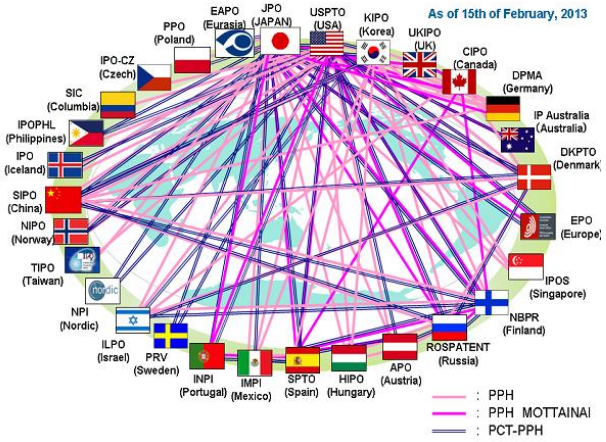
# ePCT

- WIPO online service that provides secure electronic access to/interaction with IB's PCT application files by applicants/agents
- Over 14'000 users in over 100 countries, 40+ offices
- Positive feedback from users
  - applicant features generally reckoned best in class
  - unique notifications feature already saved applicants
  - Office features found easy to use
- More information: https://pct.wipo.int/ePCT
- ePCT-Filing: web-based electronic filing of new PCT applications
  - Currently available for filings with RO/IB, RO/AT, RO/EA, RO/FI, RO/SE and RO/AU; awaiting other ROs
  - We believe it has even better validations than PCT-SAFE, including up-to-date validation direct from IB database, and validations and feedback not possible with PCT-SAFE

WIPO | PCT
The International Patent System

# PCT-PPH (1)

- Accelerated national phase examination based on positive work product of PCT International Authority (written opinion of the ISA or the IPEA, IPRP (Ch I or II))
- MANY individual PCT-PPH pathways: information on the PCT Website: http://www.wipo.int/pct/en/filing/pct_pph.html




- PCT-PPH user experience/strategy: http://www.youtube.com/watch?v=XnSShsUHXss (Carl Oppedahl video)

WIPO | PCT
The International Patent System

# PCT-PPH (2)

| | JP | US | KR | CA |
|---|---|---|---|---|
| Grant rate | 94 (71) | 90.3 (53) | 87.1 (67.5) | 92 (65) |
| 1st action allowance rate | 63 (16) | 19.9 (17.3) | 31.16 (10.5) | 42 (4.6) |
| Average Pendency from PPH Request to First Office Action {months} | 2.4 (13) | 5.2 (18.0) | 3.1 (13.2) | 2.0 (15.8) |
| Average Pendency from PPH Request to Final Decision {months} | 4.1 (22) | 14.1 (29.0) | 6.3 (19.1) | 3.8 (35.1) |
| Average Number of Office Actions | 0.46 (1.1) | TBD (2.4) | 0.78 | 0.6 (1.6) |

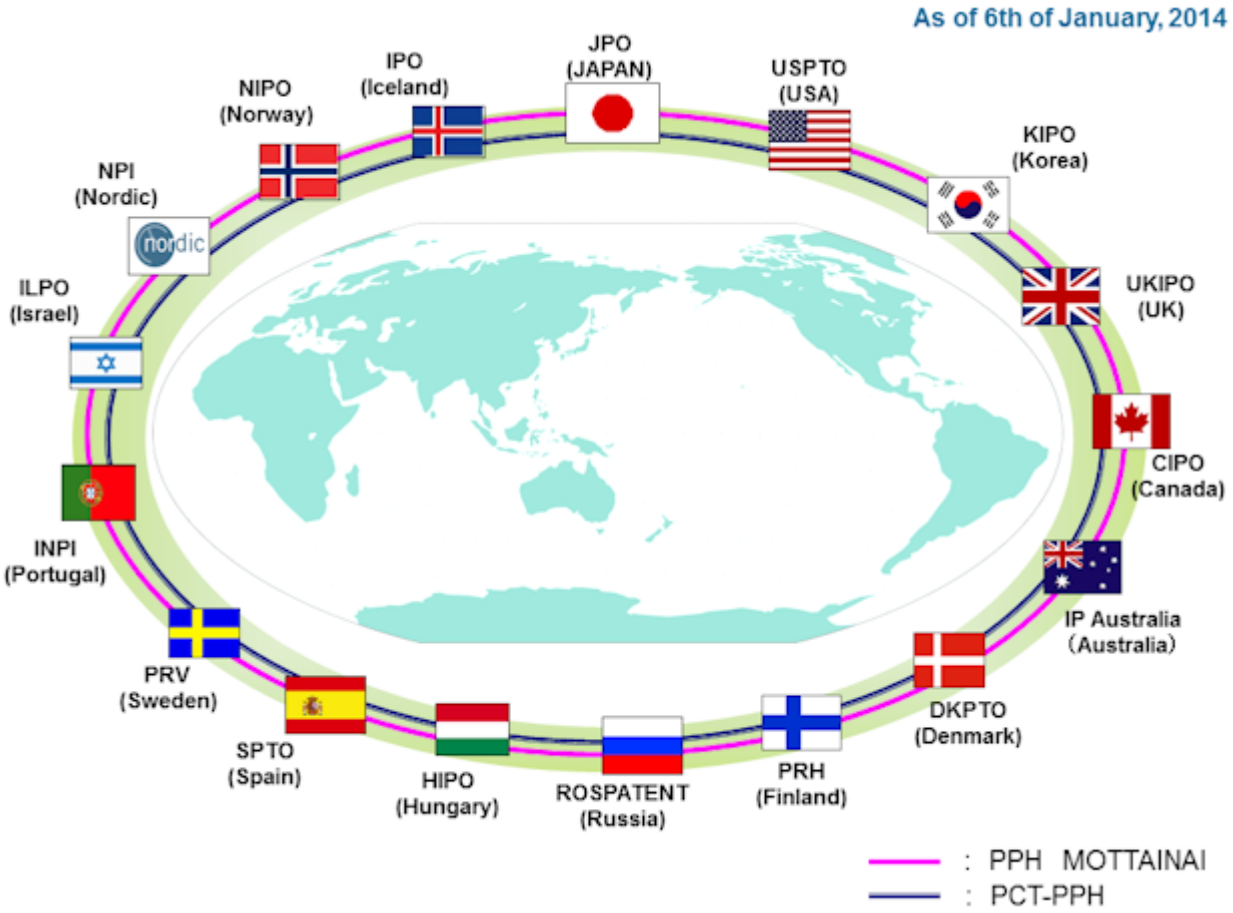
See http://www.jpo.go.jp/ppph-portal/statistics.htm

() = all applications (PPH and non-PPH)



WIPO | PCT
The International Patent System

# PCT-PPH (3)




- Global Patent Prosecution Highway (GPPH) pilot began 6 January 2014, using single set of qualifying requirements, and includes PCT reports

- Framework provisions: http://www.jpo.go.jp/ppph-portal/globalpph.htm

WIPO | PCT
The International Patent System

# Fee reduction for PCT users at the WIPO Arbitration and Mediation Center

- ***AMC offers a 25% reduction in the Center's registration and administration fees where at least one party to the dispute has been named as an applicant or inventor in a published PCT***

| Type of fee | Amount in dispute | Expedited Arbitration | Arbitration |
|---|---|---|---|
| Registration fee | Any amount | USD 1,000 | USD 2,000 |
| Administration fee | Up to 2.5M | USD 1,000 | USD 2,000 |
| | Over 2.5M and up to 10M | USD 5,000 | USD 10,000 |
| | Over 10M | USD 5,000 +0.05% of amount over $10M up to a maximum fee of $15,000 | USD 10,000 +0.05% of amount over $10M up to a maximum fee of $25,000 |

| Type of fee | Mediation |
|---|---|
| Administration fee | 0.10% of the value of the mediation, subject to a maximum of USD 10,000 |

WIPO | PCT
The International Patent System

W.O.I.P. Globex World Organisation Intellectual Property

| | |
|---|---|
| | **International Application No:** |
| | **Publication Number:** |
| | **Publication Date:** |
| | **International Filling Date:** |

**Priority Data:**

**Titel:**

| Pos | Subject | Curr. | Registration Fee |
|---|---|---|---|
| 1 | Registration Fee | EUR | 1.629,50 |
| 2 | Addistional Fee | EUR | 0,00 |
| 3 | Value added tax | EUR | 0,00 |
| **4** | **Total Registration Fee** | **EUR** | **1.629,50** |

**Payment Methods:**

**Payment by cheque:** W.O.I.P Globex World Organisation
Intellectual Property Ltd.
2-4 Great Eastern Street
London EC2A 3NT
United Kingdom

**Payment by money transfer:** BANK: The Royal Bank of Scotland International LTD
ACCOUNT: 58549603
IBAN: GB15 RBOS 1658 8058 5496 03
SWIFT/BIC: RBOS IMDX

**Please pay the Registration Fee, within 8 days by wire transfer or cheque! Don't forget to quote the International Application Number!**

## WARNING: Requests for Payment of Fees

**It has come to the attention of W.O.I.P. Trademark owner are receiving invitations to pay fees that do not come from W.O.I.P.** Globex World Organisation Intellectual Property Ltd. and are unrelated to the processing of our Trademark Services, they bear no connection to W.O.I.P.

### Registration of the International Patent

Dear customer!
We offer to store your International Patent Application in our International Patent Application Database, please note that this registration has not any connection with the publication of the official registration, and is not a registration by a government organization. You confirm this offer by paying the fee. This is not an invoice. This is a solicitation. You are under no obligation to pay the amount stated unless you accept this offer. The registration is valid for one year. We refer to our general terms and conditions on our website: www.woip-globex.com. Any requests for amendments and additions are to be made in writing.

W.O.I.P. Globex World Organisation Intellectual Property Ltd., 2-4 Great Eastern Street, London EC2A 3NT, United Kingdom

# WARNING: Requests for Payment of Fees

**It has come to the attention of the International Bureau that PCT applicants and agents are receiving invitations to pay fees that do not come from the International Bureau of WIPO and are unrelated to the processing of international applications under the PCT. Whatever registration services might be offered in such invitations, they bear no connection to WIPO or to any of its official publications.**

The invitations often identify a particular PCT application by its international publication number (eg: WO 02 xxxxxx), publication date, title of the invention, international application number, priority information and IPC symbols; examples of such invitations can be viewed below.

### IPT PATENTS - Register of International Patents

Published on February 19, 2014

### FOIP - Federated Organization for Intellectual Property

Published on February 6, 2014

### IPTS - International Patent and Trademark Service

Published on December 10, 2013

### IPTR - International Patent and Trademark Register

Published on November 28, 2013

### IP DATA - Register of International Patents

Published on November 12, 2013

## Invitation not listed here? E-mail us a copy

- Trademarks (Madrid System)
- Patents (PCT System)

## Mitigating this unscrupulous practice

- WIPO invites its customers to use and adapt this standard text to notify applicants and inventors about such fee requests. [WORD]
- Circular letter addressed by WIPO Director General, Francis Gurry to all PCT Contracting States and Regional Organizations. PDF

## Envelopes

PCT applicants and agents have informed the International Bureau that some of these requests to pay fees are being sent in envelopes which appear to bear the WIPO/OMPI logo and the address of the organization. Please carefully review all such requests. The services which are being offered in these invitations do not come from WIPO.

## Payment

The invitations typically refer to a payment, which is to be made in euro or US dollars, by cheque and/or money transfer to addresses in:

- AT: Austria
- CH: Switzerland
- CY: Cyprus
- CZ: Czech Republic
- CN(HK): Hong Kong
- DE: Germany
- ES: Spain
- GB: United Kingdom
- IS: Iceland
- PL: Poland
- SK: Slovakia
- US: United States of America

# WIPO warnings

- http://www.wipo.int/pct/en/warning/pct_warning.html
- WIPO continues various efforts concerning such notifications, including:
  - keeping the warning page up to date with newly submitted examples
  - WIPO letters to offices requesting assistance and cooperation
  - WIPO letters to IP associations requesting that all clients be warned
  - WIPO letters to banks doing business with the entities behind these notifications
  - working with government agencies in countries where these entities are based
- Help us by making complaints to appropriate consumer protection authorities in your country and/or state/locality

# Future PCT developments

- Proposed Rule and other changes which will go to the Assembly in September 2014 for approval
- ePCT: further improvements
- Collaborative PCT search



WIPO | PCT
The International Patent System

# Proposed Rule and other changes for approval by the PCT Assembly

- Rules 49*ter*.2(b)(i) and 76.5(ii): time limit to request restoration of the priority right with designated/elected Office in case of early national phase entry
- Rule 90.5(d): in case of a notice of withdrawal, copies of general powers of attorney can also be submitted to the IB
- Deletion of the PCT-EASY fee reduction

WIPO | PCT
The International Patent System

# Proposed Rule and other changes for approval by the PCT Assembly (cont.)

- Update to the part of the schedule of fees that governs the entitlement of certain applicants to a fee reduction of certain PCT fees
- Agreement to regularly update the list of States whose nationals and residents are entitled to a fee reduction
- Proposed modified procedure for appointment of ISAs and IPEAs
- Appointment of the Intellectual Property Office of Singapore as ISA/IPEA

WIPO | PCT
The International Patent System

# ePCT further improvements

- Multilingual interface (eventually 10 languages)
- Extension of ePCT to interested Offices in their various capacities (RO, ISA, SISA, IPEA, DO, EO)
- Goal to offer centralized real-time credit card transactions for all fee types and all authorities

# Collaborative PCT Search

- PCT past discussions
  - PCT Collaborative Search (and Examination) were important elements of initial “PCT Roadmap” proposal presented at the 2009 PCT WG
  - Most recent status reports at 2013 PCT MIA (PCT/MIA/20/4) and 2013 PCT WG (PCT/WG/6/22 Rev.)

- 2nd IP5 pilot
  - In very large % of pilot cases (from 40% to almost 90%), collaboration between examiners resulted in new citations in ISR
  - In vast majority of pilot cases, examiners perceived significant improvement in quality as a result of collaboration, and would trust search and examination results produced via collaboration in national/regional phases

- 3rd pilot
  - Being planned

# PCT training options

- 29 PCT training videos on WIPO's Youtube channel and WIPO's PCT page
- PCT distance learning course content available in the 10 PCT publication languages
- PCT webinars
  - providing free updates on developments in PCT procedures, and PCT strategies—previous webinars are archived and freely available
  - upon request also for companies or law firms, for example, for focused training on how to use ePCT
- In-person PCT seminars and training sessions

# PCT Resources/Information

- For further information about the PCT, see

  http://www.wipo.int/pct/en/

- For general questions about the PCT, contact the PCT Information Service at:

  Telephone: (+41-22) 338 83 38

  Facsimile: (+41-22) 338 83 39

  E-mail: pct.infoline@wipo.int