



Topic 1: Overview of Search and Examination under the Patent Cooperation Treaty (PCT)

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Agenda

- PCT system
- International phase and its examination results/products
- National phases and their examination results/products
- Options and challenges in national phase

Obtaining patent protection abroad

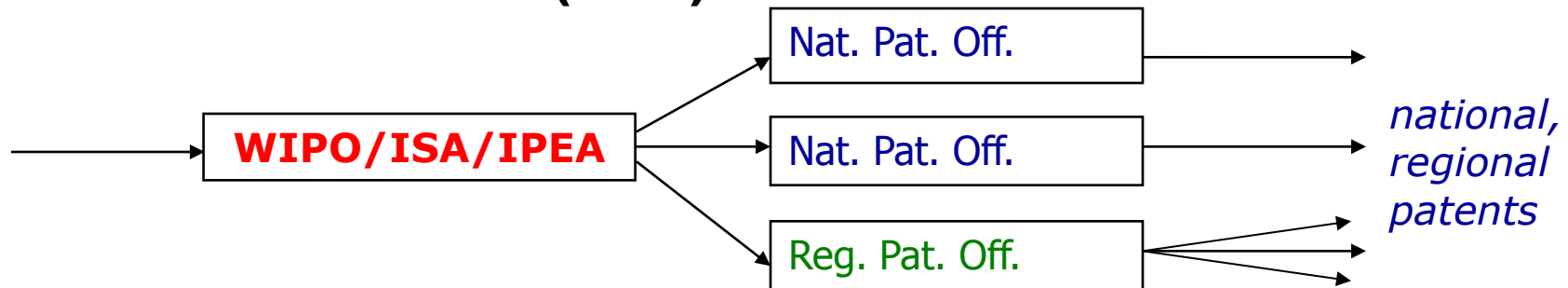
1. National Routes



2. Regional Route



3. International Route (PCT)



[International phase]

[National phases]

Patent Cooperation Treaty - PCT

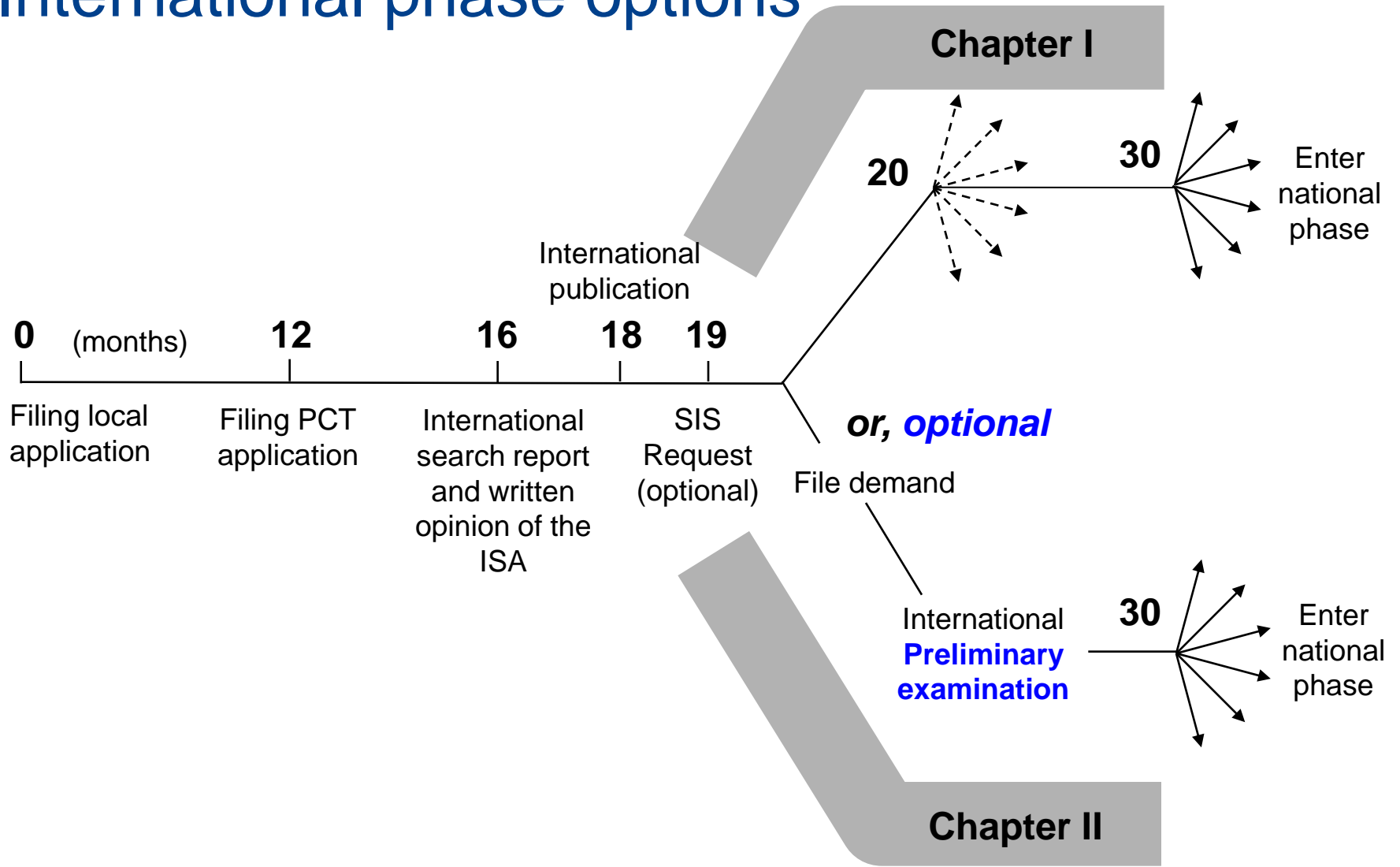
- „One-stop shop“ for parallel filing in several states
- Filing with „receiving office“
- Paris convention priority may be claimed or not
- **International phase** administered by WIPO: preliminary search and examination by selected ISAs; optional preliminary examination of amended claims by IPEA
- **National phases** administered by national IPOs:
 - Decision on entry into national phase at the latest 30 months after filing/priority date
 - National granting procedures/laws/regulations apply
- Total of national patents/publications of PCT application constitute a **family** > opportunities for efficient national procedures

Sovereign national prosecution

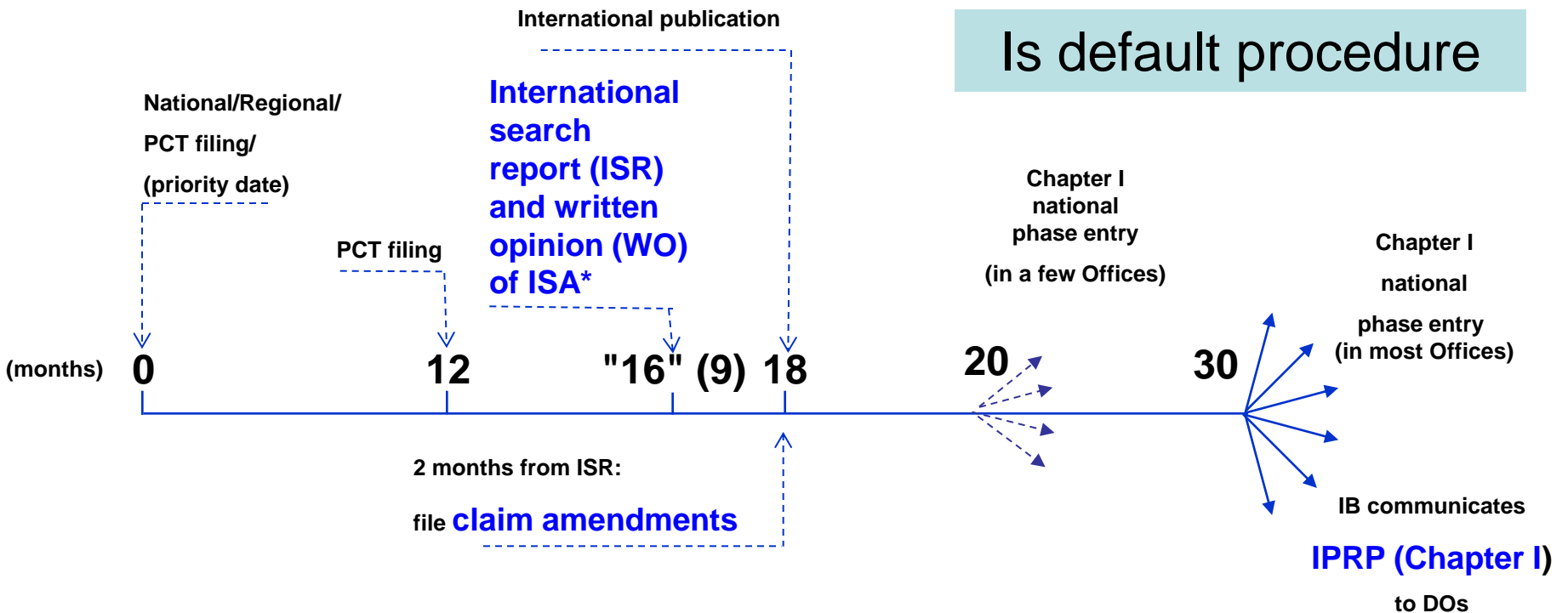
Paris Convention 1883:

- **No obligation** to follow/adopt conclusions of other IPOs or to use their results (**Article 4bis**)
- http://www.wipo.int/treaties/en/ip/paris/summary_paris.html
- Each IPO has obligation to observe national legislation
- Each IPO has responsibility/liability for quality patents
- Lawyers often refer to grants at other IPOs: just ignore that!

International phase options

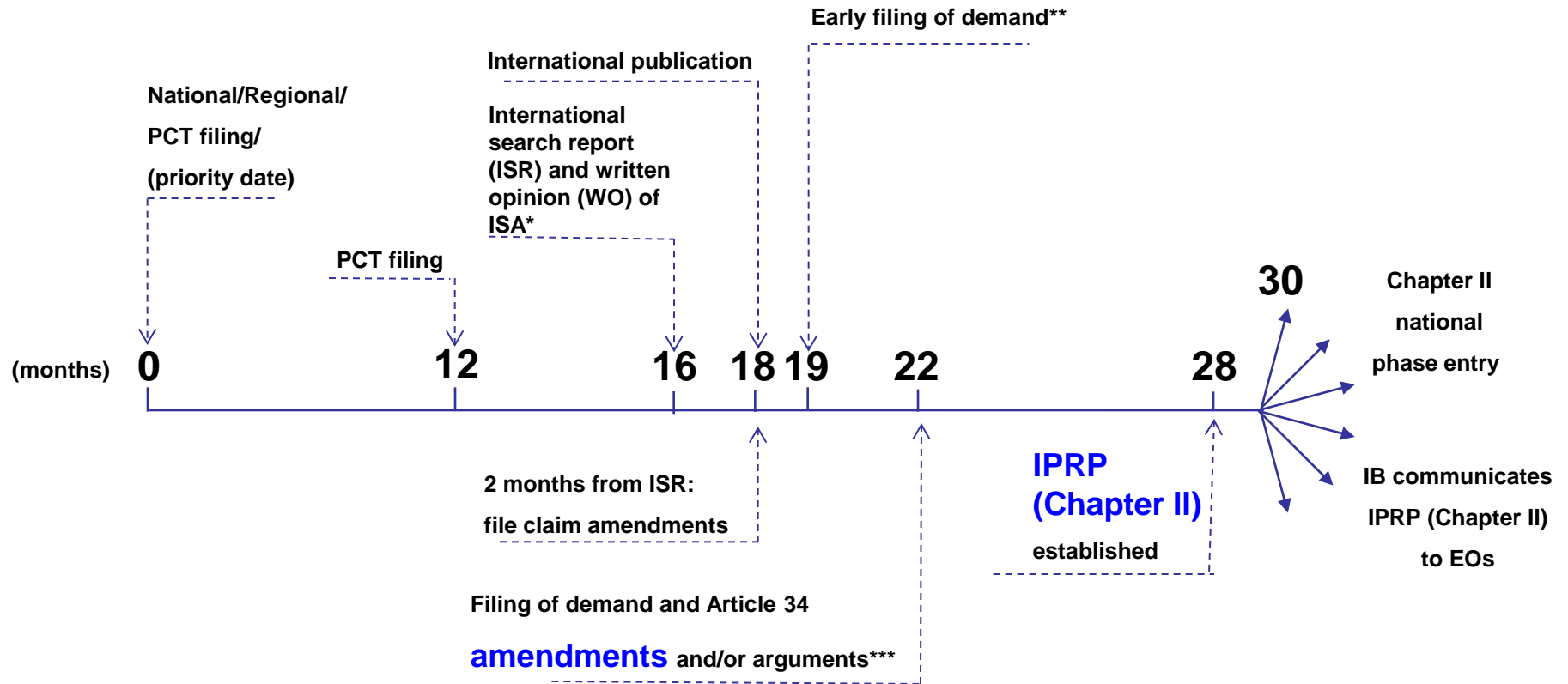


PCT timeline (Chapter I)



* If PCT is a first filing, the ISA is to establish the ISR and WO of the ISA before the expiration of 9 months from the priority date (Rule 42.1)

PCT timeline (Chapter II)



* If PCT is a first filing, the ISA will establish the ISR and WO of the ISA before the expiration of 9 months from the priority date (Rule 42.1)

** In respect of LU, TZ and UG, the time limit of 30 months to enter national phase will, however, only apply if those States have been elected in a demand filed before the expiration of 19 months from the priority date

*** A demand for international preliminary examination may be filed at any time prior to the expiration of 3 months from the date of transmittal of the ISR and WO of the ISA, or 22 months from the priority date, whichever time limit expires later (Rule 54bis.1(a)).

Various Offices and Authorities involved

- Receiving Office (**RO**)
- International Searching Authority (**ISA**): ISR, WO-ISA, IPRP (Ch. I)
- International Bureau (**IB**): publications, file inspection
- International Preliminary Examining Authority (**IPEA**): IPRP (Ch. II)
- Designated/Elected Offices (national and regional) (**DO/EO**)

Legal framework

- International
 - Treaty
 - Regulations
 - Administrative Instructions
 - Agreements between IB and ISA/IPEAs
 - Notifications (published in PCT Gazette)
 - Guidelines (RO, IS/IPE)
 - Governing body – PCT Assembly
- National
 - National laws implementing certain PCT related aspects (especially national phase processing and effects)
 - Patent law, regulations, examination guidelines, case law

Main products of international phase

- **Publication of international application** (bibliographic data, abstract, description, drawings, claims)
- **International search report (ISR)**
- **Written opinion of ISA (WO-ISA)**
 - prepared as part of international search, but deals in substance with examination matters
- (Where applicable) supplementary international search report (SISR)
- (Optional) informal comments by applicant on WO-ISA
- **International preliminary report on patentability (IPRP)**
 - IPRP (Chapter I) = WO-ISA plus cover sheet
 - IPRP (Chapter II) = international preliminary examination report (IPER)

International publications

- 18 month after filing/priority date: **WO-A1** or **WO-A2**
- **WO-A1**: international application (IA) + international search report (ISR)
- **WO-A2**: two distinct types of publications
 - International application as filed if no ISR is available yet
 - Optional at later stage: Declaration that no ISR will be established (Article 17(2)(a))
- **WO-A3**: Later publication international search report + front page
- **WO-A4**: Later publication of amended claims and/or statement (Article 19)
- **WO-A8**: Republication front page with corrections
- **WO-A9**: Republication of full application or ISR with corrections, alterations or supplements

Search reports

International Search Report (ISR)

- Established by (selected) competent ISA
- Search based on claims as originally filed (Article 15)
- Search performed according to PCT Examination Guidelines
- Prior art is everything made available to the public (Rule 33)
 - in written disclosure (may refer to oral disclosure, exhibition)
 - **prior to the international filing date** (i.e. priority is irrelevant, in case priority claims is invalid for certain subject matter)
- Not any written disclosure is to be searched: only PCT minimum documentation (Rule 34)
- In case of lack of unity, only "first" invention will be searched (Rule 40), unless additional fees are paid
- ISA can decline search of certain subject matter (Rule 39), namely subject matter that is often excluded from patentability in national laws (PCT does not define what is patentable!)

Rule 39 (similar Rule 67 for IPEA)

Rule 39

Subject Matter under Article 17(2)(a)(i)

39.1 Definition

No International Searching Authority shall be required to search an international application if, and to the extent to which, its subject matter is any of the following:

- (i) scientific and mathematical theories,
- (ii) plant or animal varieties or essentially biological processes for the production of plants and animals, other than microbiological processes and the products of such processes,
- (iii) schemes, rules or methods of doing business, performing purely mental acts or playing games,
- (iv) methods for treatment of the human or animal body by surgery or therapy, as well as diagnostic methods,
- (v) mere presentations of information,
- (vi) computer programs to the extent that the International Searching Authority is not equipped to search prior art concerning such programs.

Agreements with ISA and IPEA

ISA and IPEA Agreements

Agreements with the International Bureau of WIPO in relation to the functioning of the following Authorities as International Searching and International Preliminary Examining Authorities under the PCT (in PDF format):

AT	Austrian Patent Office
AU	Australian Patent Office
BR	National Institute of Industrial Property (Brazil)
CA	Canadian Intellectual Property Office
CN	State Intellectual Property Office of the People's Republic of China
EG	Egyptian Patent Office
EP	European Patent Office (EPO)
ES	Spanish Patent and Trademark Office
FI	National Board of Patents and Registration of Finland
IL	Israel Patent Office
IN	Indian Patent Office
JP	Japan Patent Office
KR	Korean Intellectual Property Office
RU	Federal Service for Intellectual Property, Patents and Trademarks (Russian Federation)
SE	Swedish Patent and Registration Office
US	United States Patent and Trademark Office (USPTO)
XN	Nordic Patent Institute

http://www.wipo.int/pct/en/access/isa_ipea_agreements.html

Example of ISA/IPEA agreement

Annex B

Subject Matter Not Excluded from Search or Examination

The subject matter set forth in Rule 39.1 or 67.1 which, under Article 4 of the Agreement, is not excluded from search or examination, is the following:

all subject matter which is searched or examined under the Canadian patent grant procedure.

ISR

- ISR is "enriched" search report as it includes
 - List of relevant prior art documents (citations)
plus indications:
 - For which claims a document is relevant
 - Which parts of the document are relevant (e.g. line 5-6, page 7; drawing 6) for those claims
 - Why the document is relevant (challenging novelty, inventive step; describing background art)
 - IPCs of the claimed subject matter
 - Limited search strategy: technology areas (IPC) searched
- Includes observations regarding lack of unity, or whether no meaningful search could be performed (clarity of claims)

Enriched prior art search reports



EUROPEAN SEARCH REPORT

Application Number
EP 09 16 8955

Application number

DOCUMENTS CONSIDERED TO BE RELEVANT			
Category	Citation of document with indication, where appropriate, of relevant passages	Relevant to claim	CLASSIFICATION OF THE APPLICATION (IPC)
X	EP 0 813 338 A2 (ROCKWELL INTERNATIONAL CORP [US]) 17 December 1997 (1997-12-17) * column 6, line 12 - column 8, line 26 * * column 8, line 52 - column 9, line 4; figure 1 *	1-13	INV. G01T1/17
Y	US 6 128 039 A (CHEN DATONG [US] ET AL) 3 October 2000 (2000-10-03) * column 3, line 57 - column 4, line 28; figure 2 *	1,3-7	
Y	US 6 163 029 A (YAMADA SHINICHI [JP] ET AL) 19 December 2000 (2000-12-19) * column 15, line 30 - column 16, line 45; figures 2,15,16 *	1,3-7	
A	FR 2 864 628 A1 (COMMISSARIAT ENERGIE ATOMIQUE [FR]) 1 July 2005 (2005-07-01) * page 4, line 18 - page 6, line 15; figure 3 *	1-13	
A,D	WO 2004/064168 A1 (SCHERRER INST PAUL [CH]; BROENNIMANN CHRISTIAN [CH]; SCHMITT BERND [CH]) 29 July 2004 (2004-07-29) * the whole document *	1-13	TECHNICAL FIELDS SEARCHED (IPC) G01T
E	WO 2009/131151 A1 (HAMAMATSU PHOTONICS KK [JP]; MORI HARUMICHI [JP]; KYUSHIMA RYUJI [JP];) 29 October 2009 (2009-10-29) * figure 12 *	1	
The present search report has been drawn up for all claims			
Place of search The Hague		Date of completion of the search 23 March 2010	Examiner Wulveryck, J
<p>CATEGORY OF CITED DOCUMENTS</p> <p>X : particularly relevant if taken alone Y : particularly relevant if combined with another document of the same category A : technological background O : non-written disclosure P : intermediate document</p> <p>T : theory or principle underlying the invention E : earlier patent document, but published on, or after the filing date D : document cited in the application L : document cited for other reasons & : member of the same patent family, corresponding document</p>			

International Patent Classification

Category X, Y, A, etc.

Relevant to Claim ...

Cited documents

Technical Fields Searched

Searching Authority

Date of Completion of the Search

Examiner

ISR

- Communicated to applicant when established (≈15 months from priority date)
- Communicated to DOs/EOs at national phase entry
- Available to general public through publication by IB (WO-A1/A3)
 - i.e. at the earliest 18 months after filing/priority date
- After publication also accessible as separate records in databases, with enrichments, in
 - CCD
 - EP-Register (if EPO national phase entry)
- If no ISR is established a respective declaration is published (additional WO-A2) (Article 17, Rule 48)
- After receipt of ISR, applicant may amend claims and submit statement

Common Citation Document (CCD)

Trilateral - CCD

Number:

EP20030746705
EP20060123454

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Timeline

CCD Viewer

#	CC	Cat.	Citation details	Claims
1	EP		Application N° EP20060123454 (EP06123454) - 3 November 2006	
National Search Report				
	X	US2003035726 A1	(TIEMANN PETER, , et al) - 20 February 2003 Page 4, paragraph 44 - page 4, paragraph 45 Figure 4	1- 9
	X	EP0541207 A1	(GEN ELECTRIC [US]) - 12 May 1993 Column 5, line 33 - column 5, line 37 Figure 2, 3	1- 9
	A	US5695321 A	(GEN ELECTRIC [US]) - 9 December 1997 Column 6, line 28 - column 6, line 32 Figure 4 - 6	2
	A	Impingement cooling in a rotating curved square annular duct with crossflow effect from rib-roughened surfaces Authors: SHOU-SHING HSIEH, JUNG-TAI HUANG, HUANG-HSIU TSAI Publication data: INSPEC		8,9
		Abstract		
2	CA		Application N° CA20062567126 (CA002567126) - 3 November 2006	
3	FR		Application N° FR20050053357 (FR0553357) - 7 November	

Inspector: classifications and fields searched

Classifications

EP

IPC **F01D5/18**
EC F01D9/04B, F01D5/18G2C, F01D9/06C

CA

IPC **F01D5/18, F01D25/12**
EC F01D9/04B, F01D5/18G2C, F01D9/06C

FR

IPC **F01D5/18**
EC F01D9/04B, F01D5/18G2C, F01D9/06C

JP

IPC **F01D9/02, F01D1/18**
FI F01D1/18, F01D9/02&102
FTERM 3G002/CA03, 3G002/CA06, 3G002/CA07, 3G002/CB01, 3G002/CB04, 3G002/CB05, 3G002/GA08, 3G002/GB01, 3G202/CA03, 3G202/CA06, 3G202/CA07, 3G202/CB01, 3G202/CB04, 3G202/CB05, 3G202/GA08, 3G202/GB01

EC F01D9/04B, F01D5/18G2C, F01D9/06C

RU

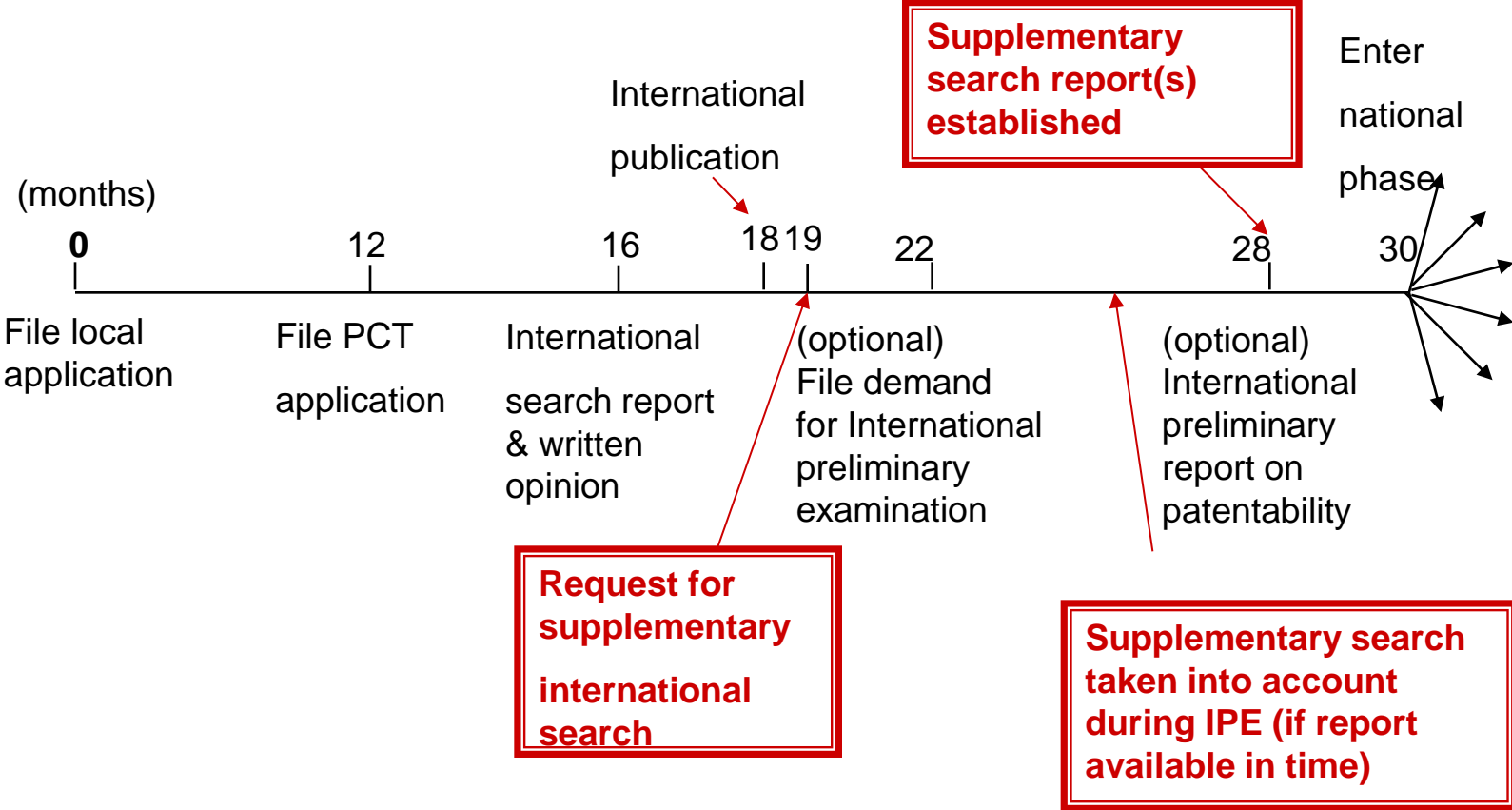
IPC **F01D5/18**
EC F01D9/04B, F01D5/18G2C, F01D9/06C

Simple families: 1 Total family members: 6

Supplementary Int. Search Report (SISR)

- Addresses applicants' concerns about additional prior art not found by ISA, e.g. because of linguistic diversity
- Search of supplementary subject matter not covered by ISR
- Established by alternative authority, currently offered only by AT, EP, FI, RU, SE and XN (applicant has free choice)
- No written opinion
- Translated into English if necessary
- Not published but made available to public (file inspection)

SIS in the PCT System



Written opinions/examination reports

Written Opinion (WO) & IPRP (chapter I)

- WO is established together with ISR but not published with ISR
- Deals in substance with examination matters; Initial preliminary non-binding opinion on:
 - novelty (not anticipated)
 - inventive step (not obvious)
 - industrial applicability
- Relevant date for prior art is priority date!
- Provided to applicant with ISR
- WO is converted to IPRP (chapter I) if no chapter II preliminary examination is requested, and communicated to DO (30 months) together with any informal comments of the applicant on WO-ISA
- Made publicly accessible (file inspection) after 30 months (Rule 44ter), e.g. in
 - Patentscope, EP-Register
 - not yet CCD

PCT – WO

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING
AUTHORITY (SEPARATE SHEET)

International application No.

PCT/US2010/020787

Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes: Claims	<u>3, 19</u>
	No: Claims	<u>1, 2, 4-18, 20</u>
Inventive step (IS)	Yes: Claims	
	No: Claims	<u>1-20</u>
Industrial applicability (IA)	Yes: Claims	<u>1-20</u>
	No: Claims	

2. Citations and explanations

see separate sheet

Form PCT/ISA/237 (April 2007)

Statements
(Rule 70.6)

Explanations
(Rule 70.8)

Re Item V

Reasoned statement with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1 Reference is made to the following documents:

- D1 US 2002/186921 A1 (SCHUMACHER LYNN C [CA] ET AL) 12 December 2002 (2002-12-12)
- D2 WO 2007/136816 A2 (MASSACHUSETTS INST TECHNOLOGY [US]; BULOVIC VLADIMIR [YU]; KYMISSIS IO) 29 November 2007 (2007-11-29)

2 The present application does not meet the criteria of Article 33(1) PCT, because the subject-matter of claims 1, 4-15, 17-18, 20 is not new in the sense of Article 33(2) PCT.

2.1 D1 discloses

an optical fiber capable of being diagnosed non-invasively comprising an optical fiber (12) for conveying a light beam; said optical fiber comprising a first end for receiving said light beam and a second end opposed thereto, a core (14) comprising an inner wall, and a cladding (16) surrounding said core, said optical fiber further comprising at least one uncladded portion comprising a plurality of quantum dots (26) dispersed in a medium, wherein said quantum dots become activated by evanescent wave coupling resulting from total internal reflection of said light beam contacting said inner wall of said optical fiber core and wherein said activation results in emittance of light from said quantum dots (Fig. 2c; paragraphs [0033], [0045]).

Therefore, the subject-matter of present claim 1 is not novel over the teachings of D1.

2.2 D1 also discloses

International preliminary examination

- IPE may be chosen, e.g., after negative ISA-WO
 - To have additional opportunities to amend claims, description, drawings
 - Communicate to some extent with examiner
- Examination is based on claims amended after ISR (Art. 19) or claims amended with request for IPEA (Art. 34)
- Claims relating to subject matter not searched by the ISA need not be examined by the IPEA (Rules 66.1(e))
- Relevant date for prior art is priority date (priority period for claiming priority is extended to 14 month; Rule 64.18b)(iii))
- Prior art described in ISR and SISR is considered; additional prior art may be considered
- No obligation of IPEA to conduct additional search

IPEA & IPRP (chapter II) (=IPER)

- IPEA obliged to issue a WO before issuing negative IPRP (right to be heard), or in case of other defects (Rule 66.2)
- Applicant is invited to respond and submit amendments
 - No obligation of IPEA to respond to responses
- Multiple WO (IPEA) and responses/amendments by applicant are possible (Rule 66.4), however limited time frame for IPRP
- Applicant can request hearing
- IPEA completes with the issuing of the IPRP (ch II) (=IPER)
- IPRP may cite additional prior art, no extra search report is issued
- Statements and explanations on novelty, inventive step, ind. applicability; no statement on patentability (! e.g. exemptions/exclusions)
- IPRP shall call attention to non written prior art and "certain documents" (later published prior art) (Rule 70.9, 70.10)

I PRP (chapter II)

- Communicated to EOs (30 months)
- Mostly available through file inspection, e.g.
 - Patentscope
 - EP-Register
 - not yet CCD

Requirements of patentability (generic)

■ Examination has to check

■ Technical nature

■ Unity

■ ~~No case of **exclusion**~~

■ Industrial applicability

■ Novelty

■ Inventive step

■ ~~Sufficient disclosure~~

■ Legal certainty of claims (clarity)

■ Additions to initial disclosure

PCT: ISA may decline search

Should be checked before prior art search

Requires prior art search

PCT: Not examined

What can applicants do (after filing) ?

- Request rectifications
- Amend claims after receipt of ISR (amendments **before IB**; **Article 19**)
- Submit comments on 1st WO
- Amend claims, description, drawings **before DO** (**Article 28**), ie in national phase
- Request IPE
 - Amend claims, description, drawings **before IPEA** (**Article 34**)
 - Request hearing before issuing of IPRP (chapter II)
 - Respond to 2nd and further WOs
 - **Further amendments** during IPE (**Article 66.4**)
- Amend claims, description, drawings **before EO** (**Article 41**), i.e. in national phase

National phase challenges

- Claims different from claims in international phase
 - Not or not fully covered by ISR, IPRP
- ISA/IPEA assumes validity of priority if priority document is not available; requires checking of validity in national phases
- Different law, e.g. exclusions, examination guidelines;
- In particular, there is no "international" case law on interpretation of PCT Treaty and Regulations (since there is no appeal); consequently ISA/IPEA apply their respective case law.
- Trust/confidence in IPEA/ISA
- Small IPOs: same task like bigger offices but limited resources

IPO's challenges in many DCs

- Efficient patent prosecution procedures for
 - **foreign** (including PCT; 90% of applications) and
 - **truly domestic** patent applications
- with **limited resources** (e.g. number of staff, legal and technical expertise of staff, access to databases..) in comparison to major IPOs
- **despite similar patentability and quality requirements**
- Strategies for coping with limited resources:
 - Avoid duplication of work and exploit work/results of other IPOs where available (“**passive worksharing**”)
 - Active (i.e. coordinated) worksharing between IPOs

"National phases" in general

Categories of patent applications

- **PCT national phase entries**

- application is member of **patent family**

- **non-PCT foreign filings (second filings)**

- priority claimed, i.e. is member of (Paris) **patent family**

- priority not claimed:

- > **"technical" family** because same invention

- **Truly national/domestic first filing**

- second filing abroad is possible, i.e. application may become member of **patent family**

Patent family > application is processed at several IPOs

Opportunities through patent families

- Utilisation of external examination results is possible if same or similar invention was filed in several IPOs
 - OFF: Office of First Filing
 - OSFs: Office(s) of Second Filing
 - Simple family (usually same invention, ie most likely similar claims)
 - Extended family (at least similar invention, claims may differ)
 - Technical family
- „**Passive worksharing**“: Use results that were obtained for family members at other IPOs
- **Active worksharing**: avoid duplication of work by active organisation of the work distribution; e.g. OFF treats applications with priority and OSFs wait for results
 - Some collaborations have started, e.g. Vancouver Group (AU, CA, UK)
 - Trilateral offices (EPO, JPO, USPTO)

Passive worksharing

- PW is a very effective strategy for small IPOs to cover all technical areas
- Utilization of examination results obtained by other IPOs provides general **benefits** and may improve patent quality at **any IPO**, because:
 - Other IPOs may have access to other information resources
 - Individual examiners at other IPO may have particular expertise in a certain field
 - Learning from/improving other search strategies
 - Examination reports may include valuable arguments/particular views
- Can be done by respectively trained examiners acting like "state patent attorneys"

Required examiner capacities

Patent Examiner

Scientist / Engineer

Legal Specialist

„**State Patent Attorney**“

Dependent on
application

Specific technical expertise in area of subject
matter

Knowledge in patent law, regulations:
Novelty, Inventive Step, Claim Wording,...

Independent of
application

Types of examination results

- Intermediary or **pre-grant** results
 - Search reports (basic; enriched, e.g. including search strategies)
 - Written opinions, examination reports
 - Communications between applicant and examiner
 - Third party observations
- **Final** results
 - Granted claims
 - Rejections; withdrawals following substantive reports
- **Post-grant** results
 - Additional prior art from opposition/re-examination
 - Amended claims
 - Communications between involved parties (3+)

Patent prosecution – summary of options

Option 1

- ▶ Doing full substantive examination in **all** or **some** areas of technology

Option 2

- ▶ Rely fully on **grants/rejections** of other IPOs
- requires identical claims & cooperative applicants
- requires claims compatible with national law
- implies considerable delay because final results have to become available

Option 3

- ▶ Use only **pre-grant results**, e.g. search reports, of other IPOs, e.g. via ICE, ASPEC, AIPN, KPION..
- implies some but smaller delay than option 3

Example: Cambodia

Article 37.-

The Registrar shall take into account, for the purposes of Article 36 of this Law, as following:

- (i) the results of any international search report and any international preliminary examination report established under the PCT in relation to the application; and/or
- (ii) a search and examination report submitted under item (i) of the 1st paragraph of Article 31 of this Law relating to, or a final decision submitted under item (iii) of the 1st paragraph of Article 31 of this Law on the refusal to grant a patent on, a corresponding foreign application; and/or
- (iii) a search and examination report which was carried out upon his request by an external search and examination authority.

Retrieval options

- Active retrieval by examiner, i.e.
 - **Research family information** and
 - **Check examination status** and
 - **Retrieve results** from online resources
- Request applicant to submit information; some legislations provide for a respective obligation

Article 124 EPC

(1) The European Patent Office may, in accordance with the Implementing Regulations, **invite the applicant to provide information on prior art taken into consideration in national or regional patent proceedings** and concerning an invention to which the European patent application relates.

(2) **If the applicant fails to reply deemed to be withdrawn.**

Example: Cambodia

Article 30.-

The applicant shall, at the request of the Registrar, furnish him with the date and number of any application for a patent filed by him abroad (“foreign application”) relating to the same or essentially the same invention as that claimed in the application filed with the Ministry in charge of industry.

Above request covers

- Other foreign filings claiming same priority
- Other filings not claiming priority, i.e. members of the technical family

Example: Cambodia

Article 31.-

The applicant shall, at the request of the Registrar, furnish him with the following documents relating to one or more of the foreign applications referred to in Article 30 of this Law:

- (i) a copy of any communication received by the applicant concerning the results of any search or examination carried out in respect of the foreign application;
- (ii) a copy of the patent granted on the basis of the foreign application;
- (iii) a copy of any final decision rejecting the foreign application or refusing the grant requested in the foreign application.

The applicant shall, at the request of the Registrar, furnish him with a copy of any final decision invalidating the patent granted on the basis of the foreign application referred to in the 1st paragraph of this Article.

Issues with final results

Utilization of final results (grants/refusals), e.g. PPH

- Requires identical/similar invention (simple family)
 - E.g. if original claims are similar

For grants:

- Requires cooperative lawyers/applicants that agree to use/submit the claims granted abroad
- Requires those claims to be compatible with national law, e.g. exclusions
- Requires confidence in the work of other IPOs
- Results from different IPOs may be different
- Implies considerable delay because final results have to become available

Issues with final results

Utilization of final results (grants/refusals)

- Requires identical/similar invention (simple family)
 - E.g. if original claims are similar

For rejections:

- Requires access to file wrapper (file inspection) to see rejection ruling
- Rejection ruling only applicable if claims to be rejected are similar

Issues with intermediary results

- Implies some but smaller delay than waiting for final results
- Searches are based on claims: the foreign search results may be incomplete/inappropriate if claims are different
- Requires checking whether same priorities
- Different priorities and priority dates can lead to different claims or prior art
- Usually no problems if simple family
- Using results for members of extended family which are not in same simple family may be problematic (compare claims !)

Differences of national legislations

- Basic categories of requirements are the same in most jurisdictions (unity, novelty, inventive step, technical nature)
- Some differences exist in how the term "invention" or "patentable invention" is defined (positively, negatively)
- Differences, however exist mostly in terms of exclusions, e.g.
 - US do grant business methods, software patents,..
 - DE/EP grants new use of known compound, PK does not
 - Islamic countries exclude, e.g., inventions related to pork
- For analysis, see e.g. SCP studies on WIPO website:
http://www.wipo.int/edocs/mdocs/scp/en/scp_13/scp_13_3.pdf

Differences of national legislations

- Paris convention and PCT treaty do not address exclusions from patentability
 - PCT permits ISA to exclude certain subject matter from search
- TRIPS permits exclusions of certain subject matter
- Further important differences exist in case law, e.g.
 - Technical nature of software related patents
 - Inventive step
- Further important differences exist with respect to limitations of the rights of the owner of a granted patent (not relevant for this workshop), e.g. the research privilege

Example: exemptions in Cambodia

Article 4.-

The following inventions, shall be excluded from patent protection:

- (i) discoveries, scientific theories and mathematical methods;
- (ii) schemes, rules or methods for doing business, performing purely mental acts or playing games;
- (iii) methods for treatment of the human or animal body by surgery or therapy, as well as diagnostic methods practiced on the human or animal body; this provision shall not apply to products for use in any of those methods;
- (iv) **pharmaceutical products** as provided in Article 136 of this Law;
- (v) plants and animals other than micro-organisms, and essentially biological processes for the production of plants or animals;
- (vi) Plants varieties.

Thank you

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