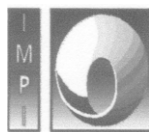


WIPO/INV/MTY/02/20

ORIGINAL:English

DATE:April2002



MEXICANINSTITUTEOF
INDUSTRIALPROPERTY



WORLDINTELLECTUAL
PROPERTYORGANIZATION



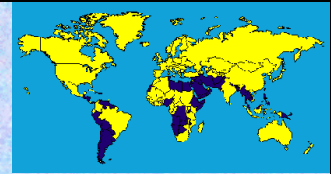
INSTITUTEOFTECHNOLOGYAND
SUPERIORSTUDIESOFMONTERREY

**INTERNATIONALWORKSH OPON
MANAGEMENTANDCOMME RCIALIZATIONOFINVENT IONS
ANDTECHNOLOGY**

organizedby
theWorldIntellectualPropertyOrganization(WIPO)
incooperationwith
theMexicanInstituteofIndustrialProperty(IMPI)
and
theInstituteofTechnologyandSuperiorStudiesofMonterrey(ITESM)
Monterrey(Mexico),April17to19,2002

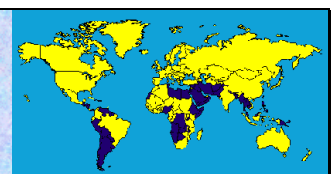
PATENTINGSTRATEGIEANDTHEPATENTCOOERATIONTREATY(PCT)

*DocumentpreparedbyMr.JohnH.Hornickel,ChiefIntellectualPropertyCounsel,
Bridgestone/FirestoneAmericasHolding,Inc.,Akron,
Ohio,UnitedStatesofAm erica*

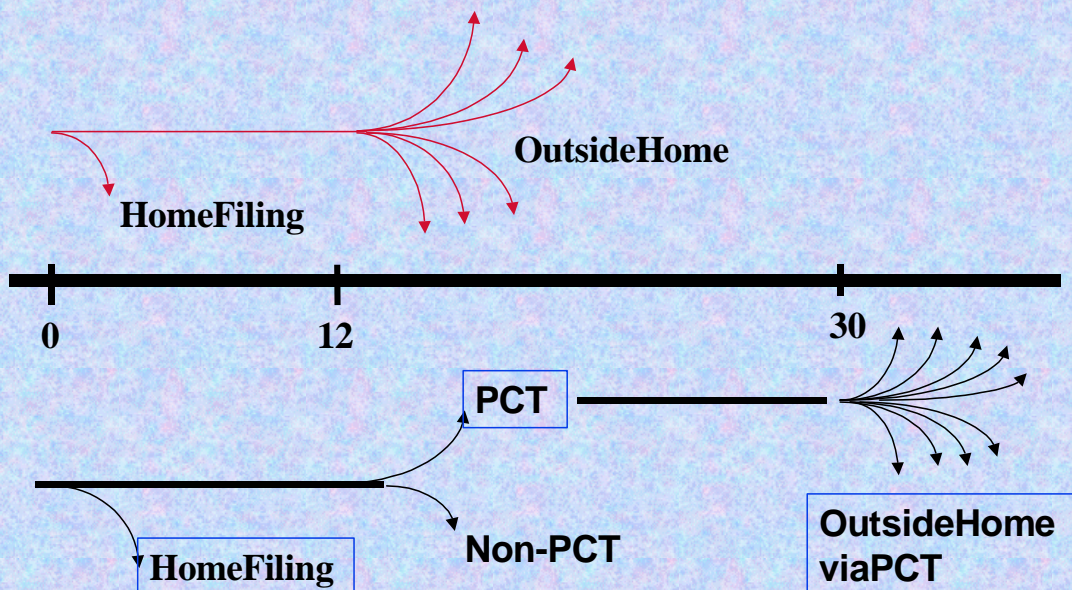


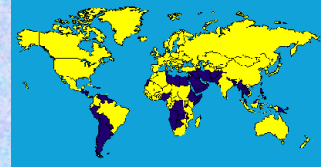
The Patent Cooperation Treaty

- A Cooperation Among Governments to Benefit Inventors and Investors
- Now Over 100 Countries Participate
- Inventors Use One Patent Application to Seek Protection
- Investors Have One Source of Information to Make Decisions



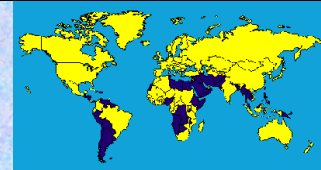
Basic PCT Timeline





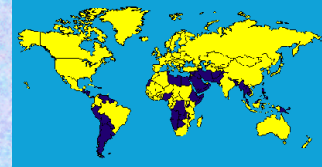
ThePCT

- APatentSystemThatProtectsInventorsand
InformsInvestorstofromMarkets
- MajorWorldLanguagesUsed
- InventorsGetaFormalitiesExamination,a
Search,aPublication,andaPreliminary
SubstantiveExamination
- InvestorsGetPublicationInformationand
ExaminationInformation



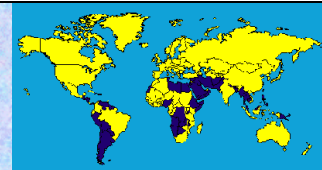
ThePCT (Continued)

- InventorsGetTIME
- InvestorsGetTIME
- TheMarketHasItsOwnTime
- Publicationat18MonthsfromFirstApplication
FilingSetsTimeinMotion



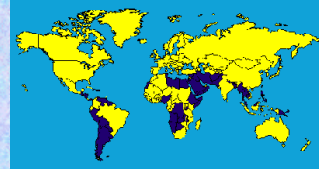
The PCT (Continued)

- Consolidates Inventor Efforts
- Delays Inventor and Investor Expenses
- Maintains Options for Both Inventor and Investor
- Predicts Results of Patenting Systems
- Preserves Unity of Invention



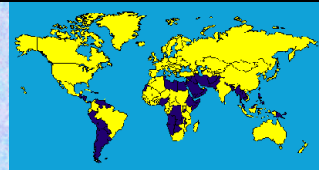
PCT Preamble

- Desiring to Make A Contribution to the Progress of Science and Technology
- Desiring to Perfect the Legal Protection of Inventions
- Desiring to Simplify and Render More Economical ... the ... Protection for Inventions
- Desiring to ... Accelerate Access to Technical Information [of] ... Inventions



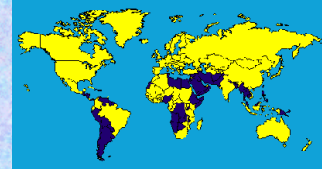
PCT Preamble

- **Desiring to Foster and Accelerate Economic Development of Developing Countries ... to Increase the Efficiency of their Legal Systems ... Instituted for the Protection of Inventions,**
- **The Contracting States have adopted the PCT.**



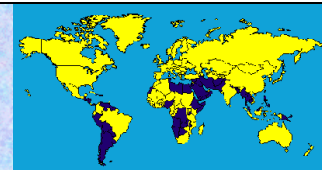
PCT Formalities

- **One Application, One Set of Drawings, Variable Claim Options**
- **Standardized Request and Demand Forms**
- **“PCT Easy” Software**
- **Efficient Regional Patent Designations**
- **>6 Designations at One Price**



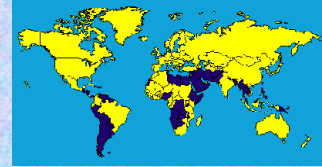
PCTSearch

- Various Authorities including European Patent Office (EP)
- EP is Premier Searching Authority With Three Official Languages and Major Venue for European Patenting
- EP has Quite Refined Customized Functional Searching Classifications



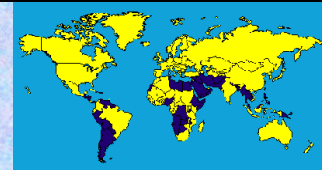
PCT Publication

- Information for Investors and the Market
- One Document (The “Pamphlet”) Contains Names of Inventor(s)/Applicant(s); Invention; Claims; Search Results
- Easily Available on Paper, CDROM, Internet -- Public and Private Sources
- “Mystery” of Investment -- All Designations



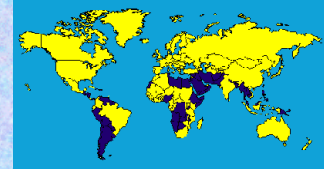
Article 19 Amendments

- Opportunity to Adjust Claims between Search Results and Publication
- Helpful for Preliminary Protection Designations
- First Opportunity to Amend Application
- Conservative Use Unless Major Unexpected Prior Art Found in PCT Search Results



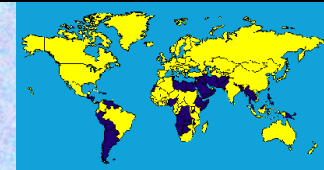
PCT Preliminary Examination

- Various Authorities including EPO (EP)
- Identify in Demand Form before 19 Months from First Application Filing
- EP is Premier Substantive Examination Location
- “Unofficial” Start to EP Regional Examination



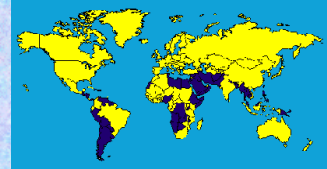
PCT Preliminary Exam

- EPPatentAttorneyAssistanceIsOptional
- DirectEPPatentPracticeisVery EfficientandEducational
- UseofSubstitutePagestoAmendApplication andClaims
- Goalofa “PositiveReport ” fromEPO Examiner



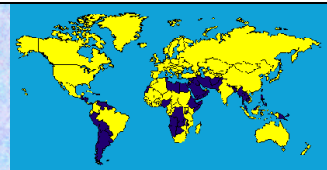
PCT “PositiveReport ”

- *VeryPersuasive* Decision
- AsCloseAsInventorsandInvestorsHavetoa WorldwidePatentingDecision
- ThePCTApplicationofthePositiveReport BecomesRegisteredin “Registration” Countries
- APositiveReportfromEPExaminer MinimizesEPRegionalExamination



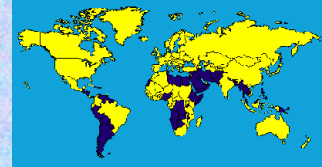
PCT National or Regional Stage

- Decision at 30 Months Before Large Expenses of Translations and National Filing/Associate Fees
- What Elected States to Delete
- What Countries in Regional Election to “Add”
- Use IPER to Best Advantage



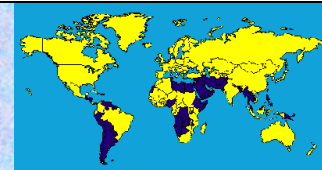
International Phase Advantages

- One Application
- One Language
- One Extended Timeline
- Multiple Choices--One Best for Each Invention



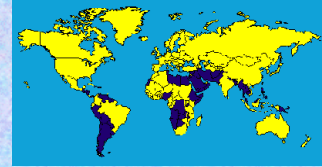
PCTChoice#1

- Wheretofile?
- ApprovedLocalReceivingOffice
- WIPOInternationalBureau(IB)
- NationalSecurityConsiderations



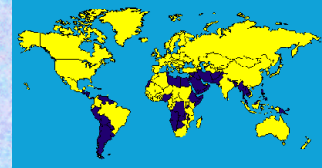
PCTChoice#2

- Whentofile?
- PriorityApplication
- ParisConventionorWTO TreatyApplication



PCTChoice#3

- When in Paris Convention Year?
- At 11 Months, 29 Days
 - Client Decisions
 - Patent Term Starts as Late as Possible
- At 4-5 Months
 - Patent Term Starts Earlier
 - Search Results Available in Paris Convention Year

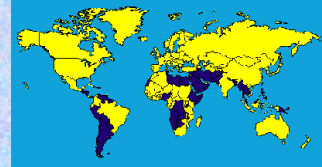


PCTChoice#4

- What Countries to Designate?
- USA (English)
 - Inventor Signatures
 - Unity of Invention vs. Restriction Practice
- EPO (English)
 - One Designation Saves Choice to Regional Stage
- ARIPO (English)



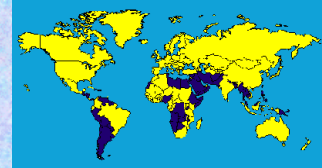
PCTChoice#4 (Continued)



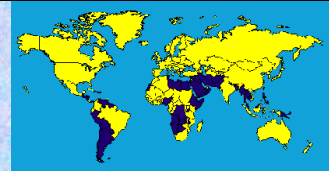
- OAPIRegion(French)
- EurasianRegion(Russian)
- China
- India
- Japan
- Canada
- Mexico



PCTChoice#4 (Continued)

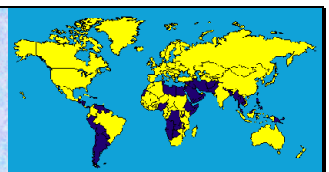


- Australia
- NewZealand
- UnitedArabEmirates
- SouthKorea
- Singapore
- Israel



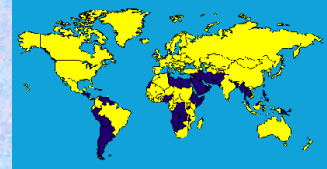
PCTChoice#4 (Continued)

- Non-EPO European Countries
 - Norway
 - Central Europe
- Latin America
 - Cuba
 - Costa Rica
 - Colombia
 - Ecuador



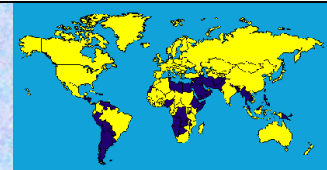
PCTChoice#5

- What Claims to Prosecute in National Stage?
- Those Searched.
 - No Demand Needed
- Those Preliminary Examined.
 - What Was IPER Result?
 - Methods of Medical Treatment
 - Methods of Doing Business



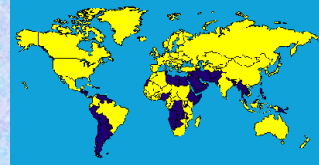
PCTChoice#6

- WhentoEnterNationalStage?
- ChapterIafterSearchandPublication
- ChapterIIafterPreliminaryExamination
- ChapterIIDuringPreliminaryExamination
 - USANationalStageIssues
 - 102(e)StatuswithNationalStage
 - PCTArticle 40 vs. “EarlyProcessing”



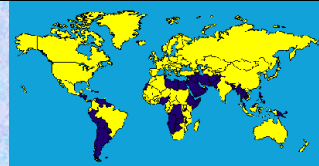
PCTChoice#7

- WhentoRequestFinalExamination?
- USAand102(e)Issues
- Japanbefore7YearsfromPCTFilingDate
(Soontobe3Years)
- Canadabefore7YearsfromPCTFilingDate
- Koreabefore5YearsfromPCTFilingDate



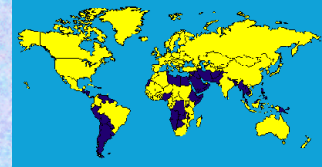
Inventors and Investors at 50 Months from PCT Filing

- A Formalities Examination
- A Publication of Invention with Search Report
- A Preliminary Examination of Substance
- A Clear Route to Registration
- A Refined Route to Substantive Allowance
- All Before Translations and Local Fees
- A Choice of 100+ Countries



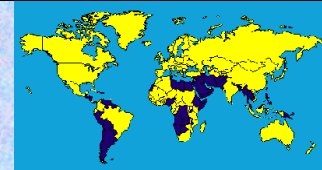
PCT Costs and Benefits

- Rules Familiarity
- Forms Familiarity
- Docketing Familiarity
- Payment for Added Time and Service
- Claims of Priority
- Added Choices Reduce Mechanization of Office Procedure



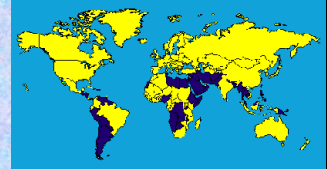
PCTResources

- LittleRedBookofTreatyandRegulation
- PCTApplicant'sGuide
- WIPOInternetWebSite
 - PCTPublications
 - OfficialGazette
 - AdministrativeInstructions
 - SearchandExaminingGuidelines



PCTResources Continued

- PCTNewsletter
- WIPOPCTHelpDesk
- WIPOPCTLegalDivision
- AIPLAPCTIssuesCommittee
- EPOExaminationGuidelines(Maroon)
- EPOCaseBook(White)



Thankyou.



BRIDGESTONE/FIRESTONE

AMERICAS HOLDING, INC.

1200FirestoneParkway

Akron,Ohio44317 -0001

JohnH.Hornickel

ChiefIntellectualPropertyCounsel
Phone:330 /379-4605Fax:330/379 -3816

Email: HornickelJohn@bfusa.com

[Endofdocument]