



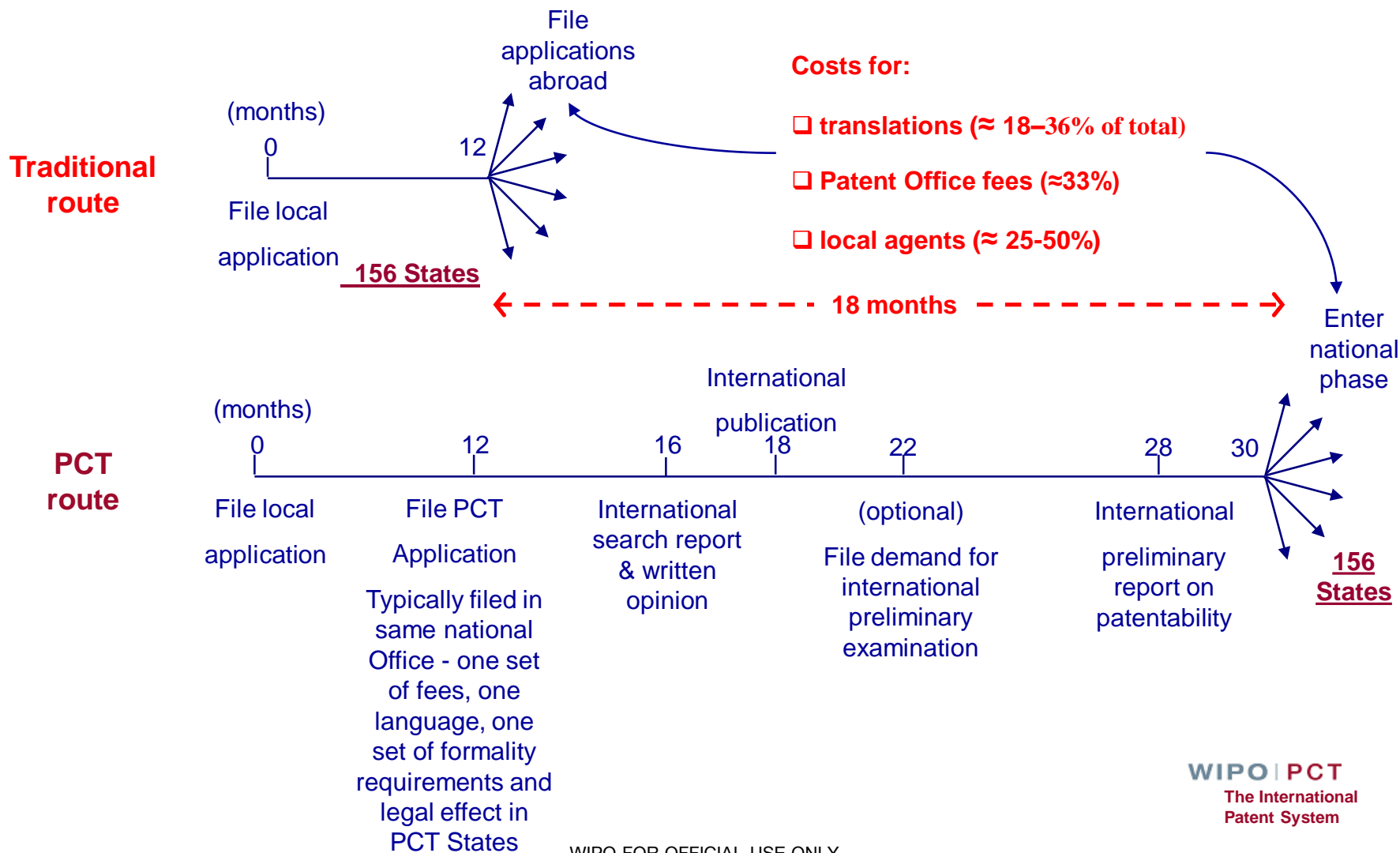
The Patent Cooperation Treaty (PCT)

- Overview
- Key Benefits
- Role of Patent Attorneys

**Dhaka
October 20, 2022**

Ms. Anjali Aeri, Counsellor
PCT International Cooperation, PCT Legal and International Affairs Department, World
Intellectual Property Organization (WIPO)
anjali.aeri@wipo.int

PCT vs. Paris route (traditional)



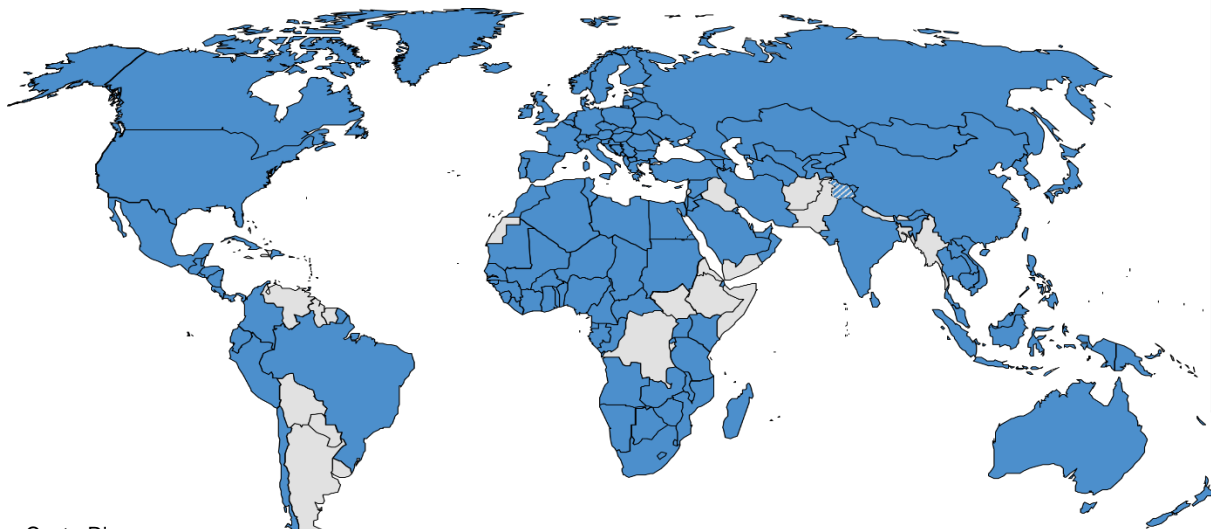
Key Advantages of the PCT

- **International reach:** One application has effect in 156 PCT Member States
- **Postponement of costs:** 18 extra months before you have to pay for local filings
- **Information gathering:** 18 extra months to receive substantive feedback on your patent application and to do market research and testing



PCT Statistics – Filings & Membership

156 PCT States



Recent accessions:

- Cabo Verde
- Iraq
- Jamaica
- Samoa

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
Cabo Verde (July 6, '22)
Cambodia
Cameroon
Canada
Central African Republic
Chad
Chile
China
Colombia
Comoros
Congo

Costa Rica
Côte d'Ivoire
Croatia
Cuba
Cyprus
Czech Republic
Democratic People's Republic of Korea
Denmark
Djibouti
Dominica
Dominican Republic
Ecuador
Egypt
El Salvador
Equatorial Guinea
Estonia
Finland
France
Gabon
Gambia
Georgia
Germany
Ghana
Greece
Grenada
Guatemala
Guinea

Guinea-Bissau
Honduras
Hungary
Iceland
India
Indonesia
Iran (Islamic Republic of)
Iraq (Apr. 30, '22)
Ireland
Israel
Italy
Jamaica
Japan
Jordan
Kazakhstan
Kenya
Kuwait
Kyrgyzstan
Lao People's Dem Rep.
Latvia
Lesotho
Liberia
Libya
Liechtenstein
Lithuania
Luxembourg
Madagascar

Malawi
Malaysia
Mali
Malta
Mauritania
Mexico
Monaco
Mongolia
Montenegro
Morocco
Mozambique
Namibia
Netherlands
New Zealand
Nicaragua
Niger
Nigeria
Norway
Oman
Panama
Papua New Guinea
Peru
Philippines

Poland
Portugal
Qatar
Republic of Korea
Republic of Moldova
Romania
Rwanda
Russian Federation
Saint Lucia
Saint Vincent and the Grenadines
Samoa
San Marino
Sao Tomé e Príncipe
Saudi Arabia
Senegal
Serbia
Seychelles
Sierra Leone
Singapore
Slovakia
Slovenia
South Africa
Spain
Sri Lanka
Sudan
Swaziland

St. Kitts and Nevis
Sweden
Switzerland
Syrian Arab Republic
Tajikistan
Thailand
The former Yugoslav Republic of Macedonia
Togo
Trinidad and Tobago
Tunisia
Turkey
Turkmenistan
Uganda
Ukraine
United Arab Emirates
United Kingdom
United Republic of Tanzania
United States of America
Uzbekistan
Viet Nam
Zambia
Zimbabwe

Countries not (yet) PCT Contracting States (37)

Afghanistan

Andorra

Argentina

Bahamas

Bangladesh

Bhutan

Bolivia

Burundi

Democratic Republic of Congo

Eritrea

Ethiopia

Fiji

Guyana

Haiti

Kiribati

Lebanon

Maldives

Marshall Islands

Mauritius

Micronesia

Myanmar

Nauru

Nepal

Pakistan

Palau

Paraguay

Solomon Islands

Somalia

South Sudan

Suriname

Timor-Leste

Tonga

Tuvalu

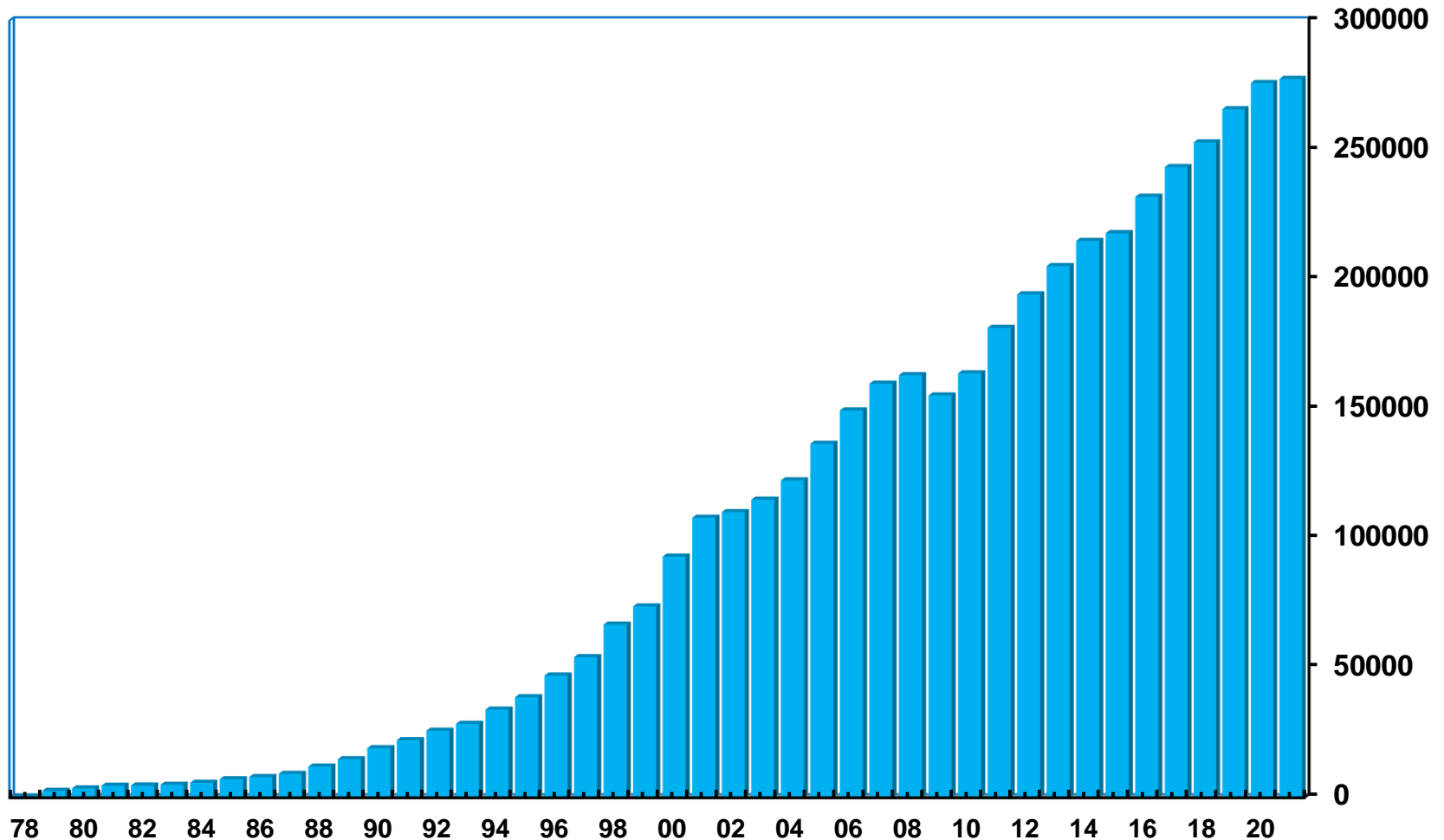
Uruguay

Vanuatu

Venezuela

Yemen

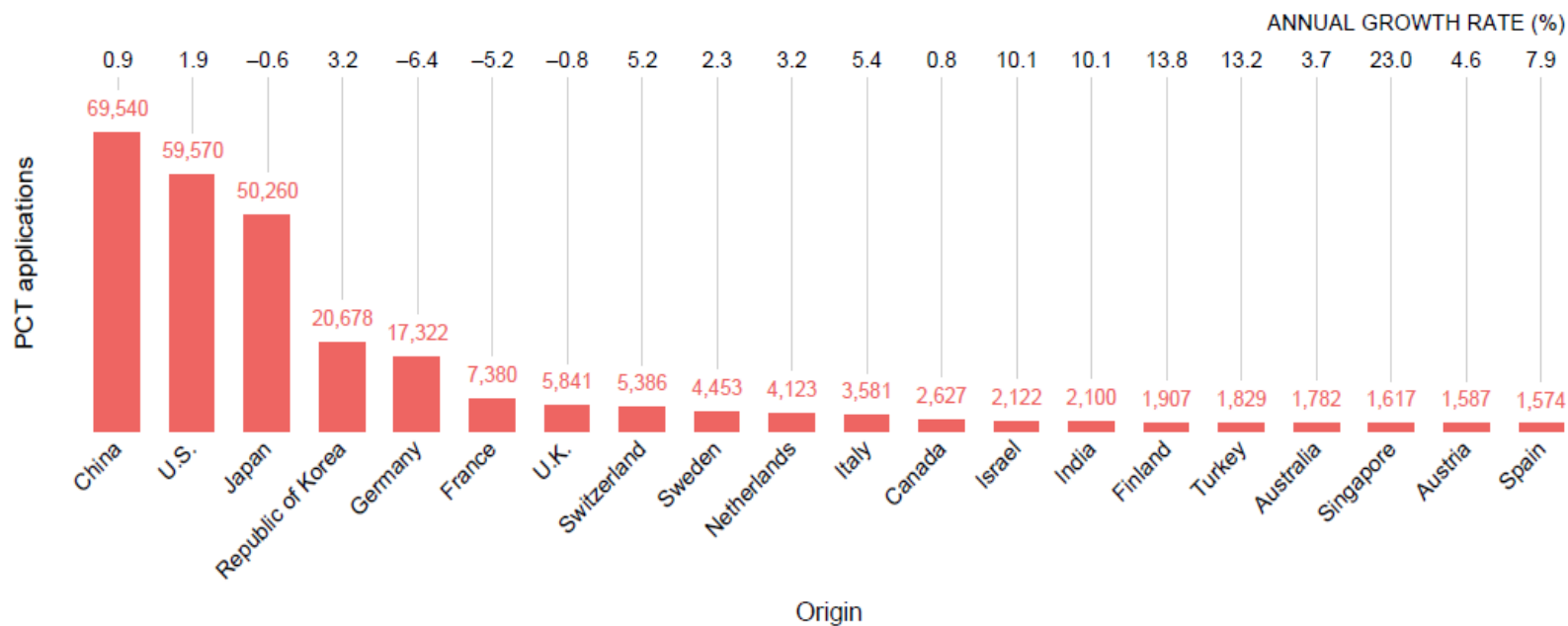
Growth of PCT Filings



2021: 277,500 applications (+0.9%)

PCT applications by country of origin in 2021

A8. PCT applications for the top 20 origins, 2021



Note: Data for 2021 are WIPO estimates.

Source: WIPO Statistics Database, March 2022.

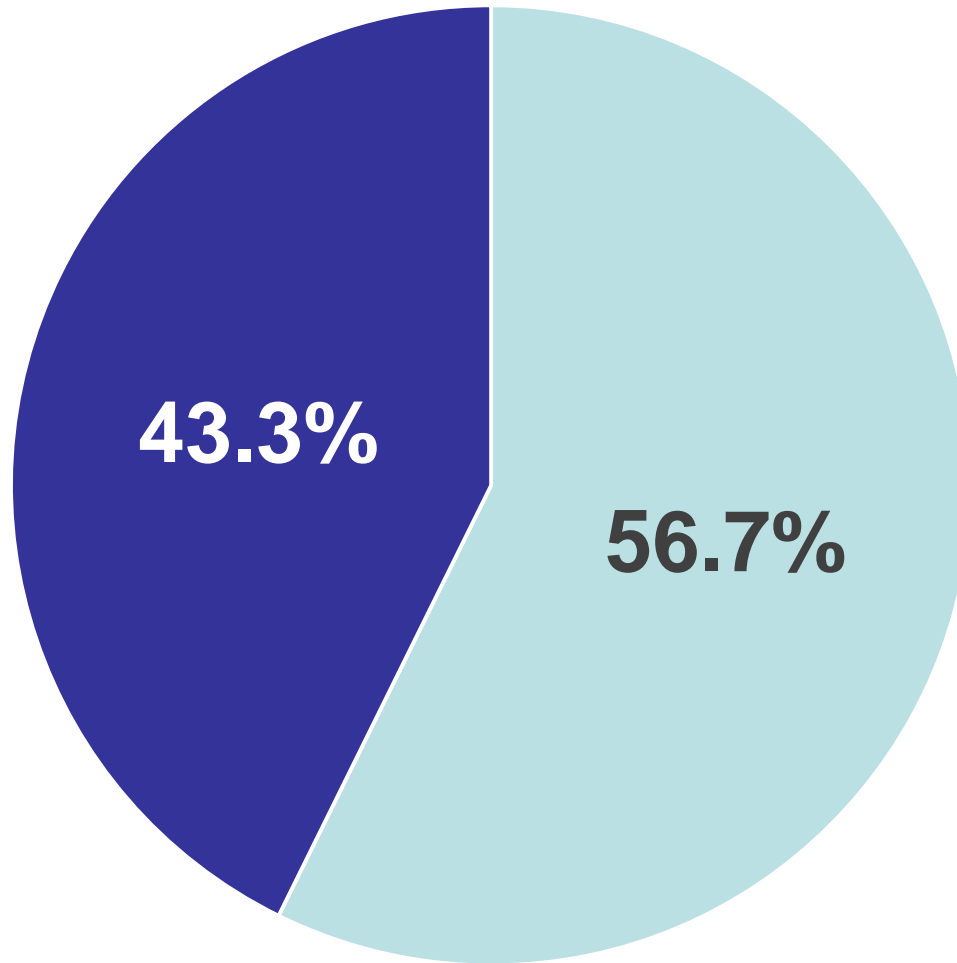
25.1% originating from China, 21.5% from US, 18.1% from Japan

Top 10 PCT applicants in 2021

1. Huawei Technologies—CN (6,952)
2. Qualcomm—US (3,931)
3. Samsung—KR (3,041)
4. LG Electronics—KR (2,885)
5. Mitsubishi Electric—JP (2,673)
6. Guang Dong Oppo Mobile Telecom—CN (2,208)
7. BOE Technology Group—CN (1,980)
8. Ericsson—SE (1,877)
9. Sony—JP (1,789)
10. Panasonic—JP (1,741)

*() of published
PCT applications*

Most Foreign Filings are via the PCT



■ PCT ■ Paris Convention



Key Advantages of the PCT for Bangladesh & Patent Attorneys

Key PCT Advantages (1)

Postpones major costs in “internationalizing” a patent application:

- **Translations** of the patent application (a highly technical document) into various national languages
- **Official fees for payment to national/regional Patent Offices** (for example, filing fees, claims fees, etc.)
- **PCT Fee reduction 90%** - an applicant, whether a natural person or not, who is a national and resident of Bangladesh re: filed PCT international applications


Key PCT Advantages (2)

- saves a considerable amount of time and financial resources for applicants when patent protection is sought for an invention in several countries;
- facilitates the work of national offices due to more efficient, simpler and less costly procedures;
- fosters and accelerates access by the public to the technical information contained in documents describing new inventions – i.e via **PATENTSCOPE**

PATENTSCOPE

- **PATENTSCOPE:** <https://patentscope.wipo.int>
- 4.4 million published PCT applications!
- 107 million patent documents (data from 72 regional or national collections)
- National Phase Entry Data for 66 countries
- Patent Register Portal:
https://www.wipo.int/patent_register_portal/en/index.html Over 200 jurisdictions and patent collections – i.e. ASEAN
- The WIPO COVID-19 Search Facility of PATENTSCOPE
<https://patentscope.wipo.int/search/en/covid19.jsf>

PATENTSCOPE Database – Search COVID-19 Innovations (2)

WIPO IP PORTAL MENU PATENTSCOPE HELP  ENGLISH LOGIN

Feedback Search ▾ Browse ▾ Tools ▾ Settings

PATENTSCOPE COVID-19 INDEX

The WIPO COVID-19 Search Facility of PATENTSCOPE will provide scientists, engineers, public health policymakers, industry actors and members of the general public with an easily accessible source of intelligence for improving the detection, prevention, and treatment of diseases such as the novel coronavirus.

"Given the drastic impact of the COVID-19 crisis on human health and welfare, the world needs easy access to every bit of information available for the successful innovation in the pursuit of vaccines, treatments and cures. Patent documents are rich sources of technological know-how acquired by humans over the centuries," said WIPO Director General Francis Gurry. "I am pleased that WIPO's new patent-searching tool helps disseminate information on technologies that others may build upon for the global fight against COVID-19."

At the time of release, the new PATENTSCOPE search facility provides dozens of search queries specially curated by patent information experts who have identified technological areas relevant to the detection, prevention and treatment of COVID-19.

PATENTSCOPE contains over 83 million patent and related documents, provides comprehensive searching of patent information with multi-lingual search capabilities and an automatic translation system that uses Artificial Intelligence (AI) technologies for highly accurate results.

Via the new COVID-19 functionality, thousands of documents deemed of potential use to innovators working on COVID-19 mitigation efforts would be returned.

[Full press release](#)

Artificial respiration Diagnostics Disinfection Informatics Medical Equipment Medical Facilities and Transport Medical Treatment

Medical treatment/Prophylactic Medical treatment/Therapeutic Personal protective equipment

IPC Symbol[s]	Title	Query
A61H 31/00	Artificial respiration or heart stimulation, e.g. heart massage	EN

Licensing Availability - Patentscope

Field Combination

	Front Page	=		?
AND	WIPO Publication Number	=		?
AND	Application Number	=		?
AND	Publication Date	=		?
AND	English Title	=		?
AND	English Abstract	=		?
AND	Applicant Name	=		?
AND	International Class	=		?
AND	Inventor Name	=		?
AND	Office Code	=		?
AND	English Description	=		?
AND	English Claims	=		?
AND	Licensing availability	=	<input type="checkbox"/>	
AND	Inventor Name	Is Empty:	<input checked="" type="radio"/> N/A <input type="radio"/> Yes <input type="radio"/> No	

Language: English Stem: Office: All [Specify](#)

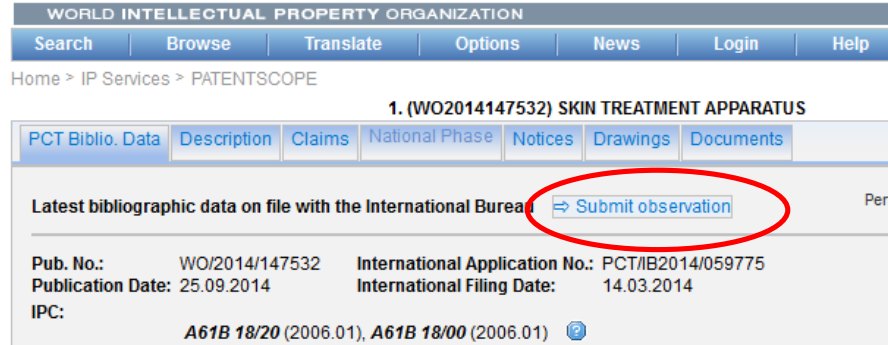
0 results [Search](#) [Reset](#)

[\(+\)](#) Add another search field | [\(-\)](#) Reset search fields [Tooltip Help](#)

Additional search fields can be selected

Third Party Observations

- The Third Party Observation system enables applicants and third parties to submit prior art observations (on novelty and inventive step) for use by examining Offices
- Accessible through PatentScope or **ePCT System!**



WORLD INTELLECTUAL PROPERTY ORGANIZATION

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1. (WO2014147532) SKIN TREATMENT APPARATUS

PCT Biblio. Data Description Claims National Phase Notices Drawings Documents

Latest bibliographic data on file with the International Bureau [⇒ Submit observation](#) Per

Pub. No.: WO/2014/147532 International Application No.: PCT/IB2014/059775
Publication Date: 25.09.2014 International Filing Date: 14.03.2014
IPC: A61B 18/20 (2006.01), A61B 18/00 (2006.01) ⓘ



Role of Patent Agents/Attorneys using the PCT

Preparing to file (1)

■ Decision-making process

- Leave enough time before end of priority period
- Have a clear decision-making structure in place
- Paris or PCT?
- Avoid last-day and even more so last-minute filings

■ State-of-the-art docketing system in place

- Two independent systems
- Second pair of eyes review

■ Review need for any foreign filing licenses

Preparing to file (2)

■ Choice of RO?

- What choices are available?
- Reasons not to use your home Office
- Advantages/disadvantages in using RO/IB
- Right to file with RO of choice

■ Know your RO

- filing methods available
- payment methods
- closing dates
- languages accepted

Preparing to file (3)

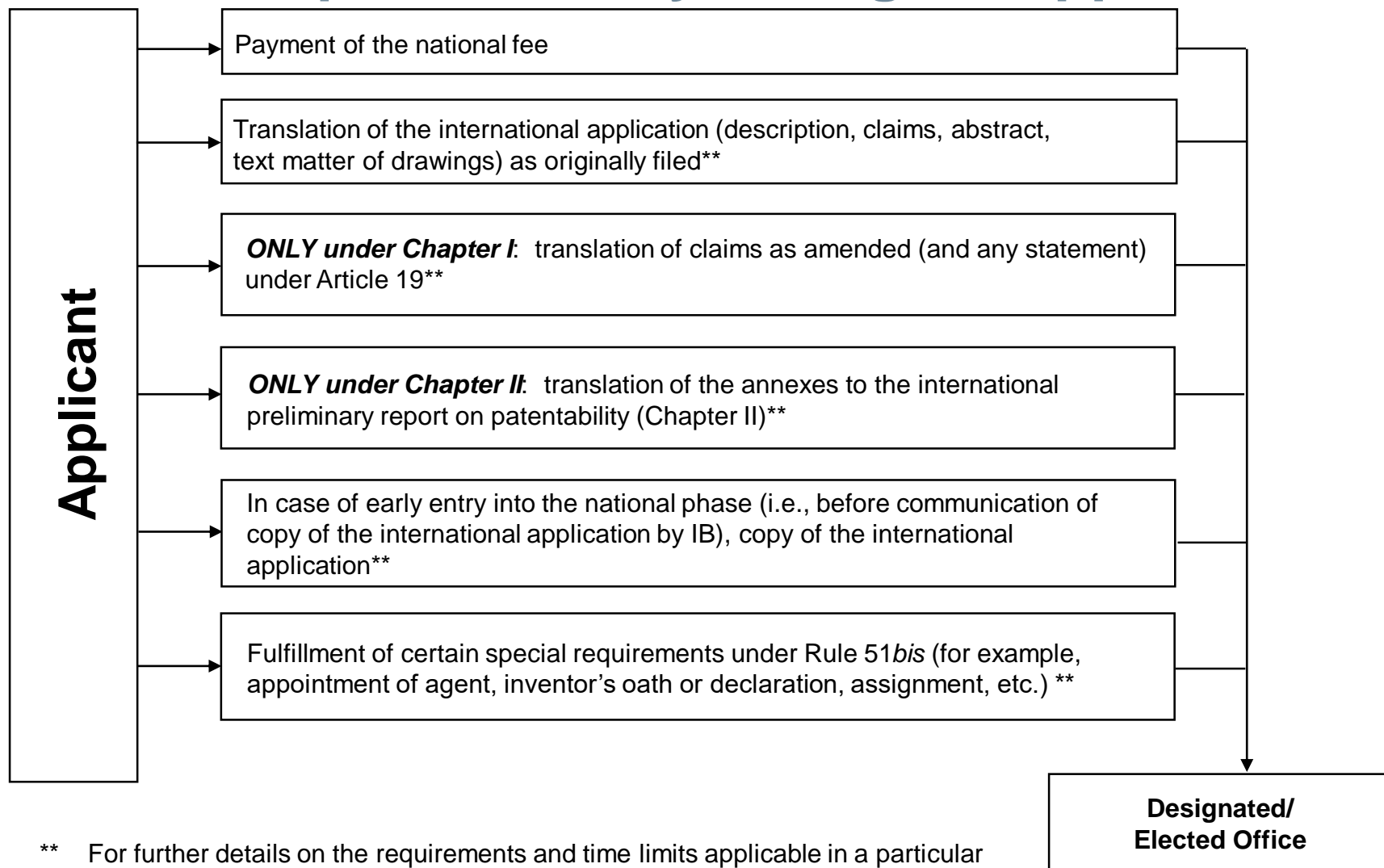
■ Choice of ISA?

- Whether and what choices you have depends on RO
- What choices would you have if you use RO/IB?
- If you have a choice, which factors to consider?
 - Search fee amount
 - Timeliness
 - Effect on national/regional phase
 - Quality of reports
 - Excluded subject matter
 - Languages searched
 - National phase fee reductions



Entry into the National Phase

Acts to be performed by the Agent/Applicant



** For further details on the requirements and time limits applicable in a particular designated/elected Office, see the relevant national chapter in the *PCT Applicant's Guide*, National Phase

Prepare for national phase entry

- Take relevant decisions as early as possible
- Double-check names of applicants to allow for last-minute *92bis* requests
- Provide local agent with all relevant information (via ePCT?)
- Instruct local agent how to further prosecute the case
 - National phase amendments?
 - How to argue the case
 - Continue to provide local agent with information

Use of PCT-PPH (Patent Prosecution Highway)?

- 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))

- Some benefits:
 - ❑ Reduces duplication of effort via patent office work-sharing
 - ❑ Increases grant rate
 - ❑ Reduces pendency and legal uncertainty
 - ❑ Streamlines prosecution
 - ❑ Reduces cost (by reducing number of office actions)

Time limit issues

- The time limit to enter national phase applies irrespective of possible delays in the international phase
- Where national phase entry time limit has been missed:
 - Does Rule 49.6 apply?
 - If yes, which criterion is applicable?
 - Which time limit applies?
 - Cases, where Rule 49.6 does not apply

Translation issues

- Most Offices require translation of international application as filed and as amended
- Translations must be accurate
- Text matter in drawings
- Defects in translations?

Amendments under national law

- PCT guarantees opportunity to amend application in the national phase
- Details of amendment practice are governed by national law
- Adapt claim drafting to national preferences
- Reduce number of claims to avoid/reduce claims fees
 - Special cases: CN, DE, IN
- Time limit

Special national requirements

- Time limit under Rule 51 *bis*.3
- Declarations should now pay off
- Translation of the priority document (Rule 51 *bis*.1(e))

The agent/attorney requires...for example

■ Legitimate cases:

- Original priority document where document was not furnished in time during international phase
- Proof or evidence concerning recorded changes under Rule 92*bis*

Affect of PCT Accession on Patent Filings

- The patent office of an acceding country experiences a sharp drop in non-resident filings in the first 18 months after accession
- Following this, PCT national phase entries will lead to a recovery of non-resident filings
- Usually, patent offices then receive the majority of non-resident filings via the PCT System; resident applicants, in turn, will similarly file a growing number of applications abroad via the PCT System

PCT Information and Training

- 29 video segments on PCT topics, available on WIPO's Youtube channel and WIPO's PCT webpage
- PCT distance learning course available in 10 PCT publication languages, and an advanced DL course under preparation
- PCT Webinars

PCT Webinars

Webinars are used by WIPO to deliver PCT information, training and updates to a remote audience using the Internet.

Please send an e-mail to pct.training@wipo.int if your firm, company or organization is interested in attending a webinar on a particular PCT topic.

Upcoming PCT webinar events

- **Everything you need to know about ePCT webinar series: ePCT, filing an international application with RO/IB**
June 2nd, 2021
Time: 9:00 to 10:30 AM (CEST)
[Registration](#)
- **Everything you need to know about ePCT webinar series: ePCT, filing an international application with RO/IB**
June 3rd, 2021
Time: 4:00 to 5:30 PM (CEST)
[Registration](#)

- In-person/Virtual PCT Seminars/training sessions: see PCT seminar calendar (<http://www.wipo.int/pct/en/seminar/seminar.pdf>)
- Monthly PCT Newsletter (<http://www.wipo.int/pct/en/newslett/>)



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Ms. Anjali Aeri, Counsellor, WIPO
anjali.aeri@wipo.int

PCT: <https://www.wipo.int/pct/en/>