



Topic 8: Filing Patent Applications: Examples of Filing in Different Countries and under the Patent Cooperation Treaty (PCT)

WIPO Patent Drafting Course for Patent Agents from the
ARIPO Member States and Observer States

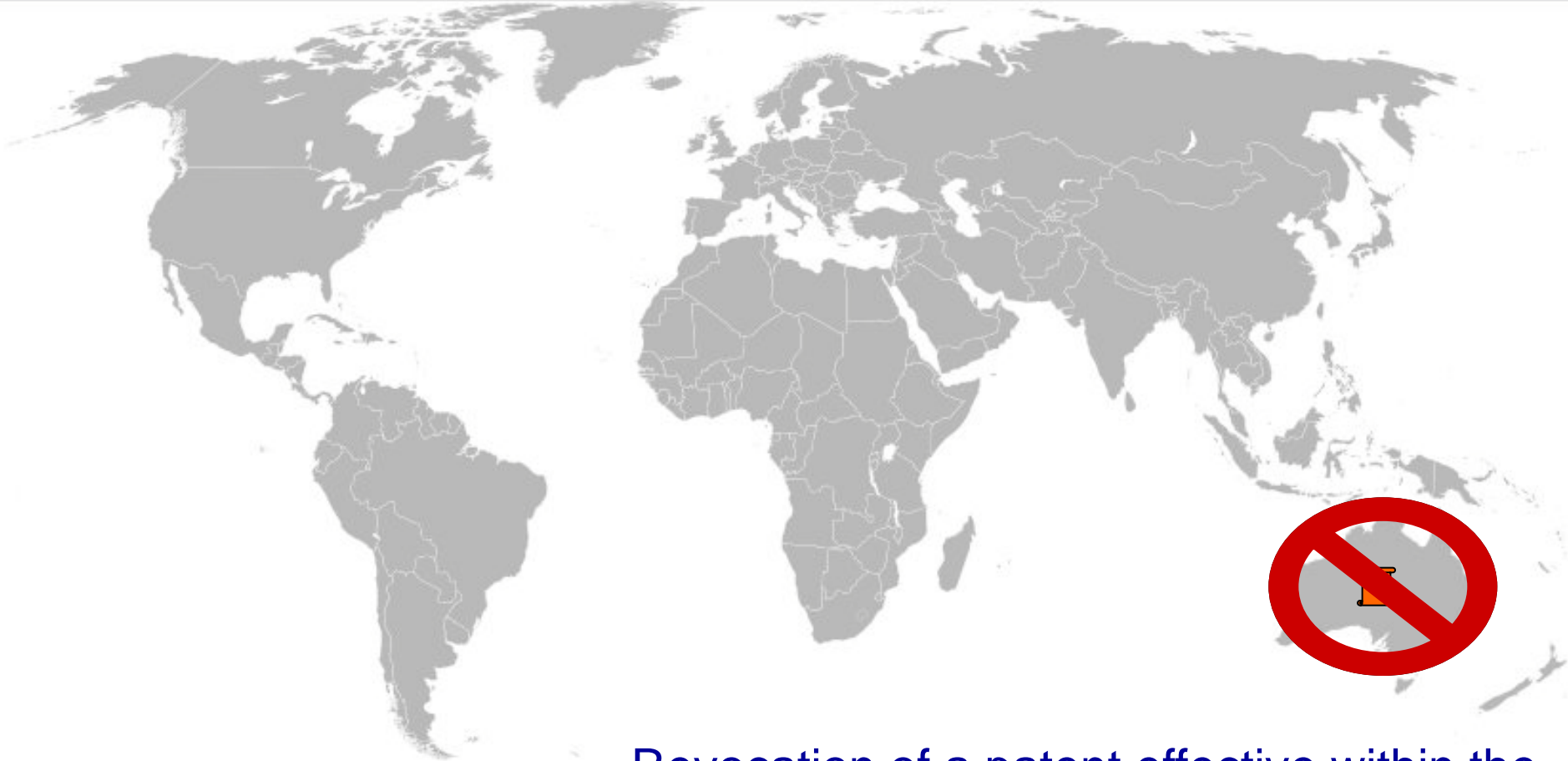
Harare

September 8, 2015

Tomoko Miyamoto
Head, Patent Law Section, WIPO

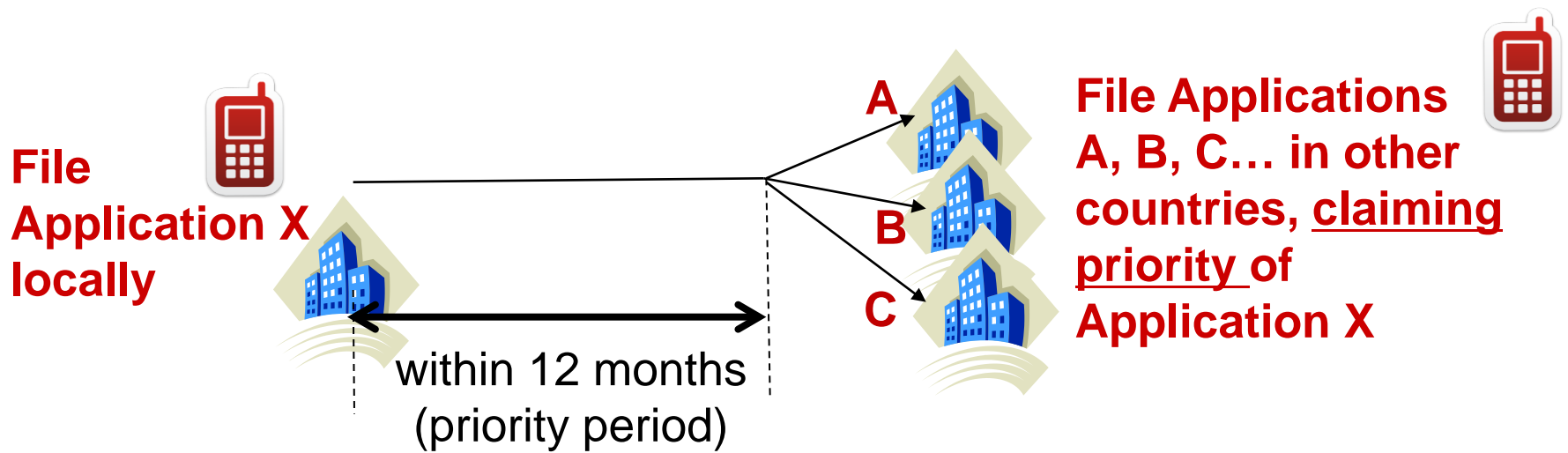
Territoriality

Patent rights enforceable within the country in which a patent is granted



Revocation of a patent effective within the country in which the patent is revoked

Filing foreign applications – Priority claim



Subsequent applications (A, B, C ...) shall not be invalidated by publications, public presentations etc. of the invention during the priority period

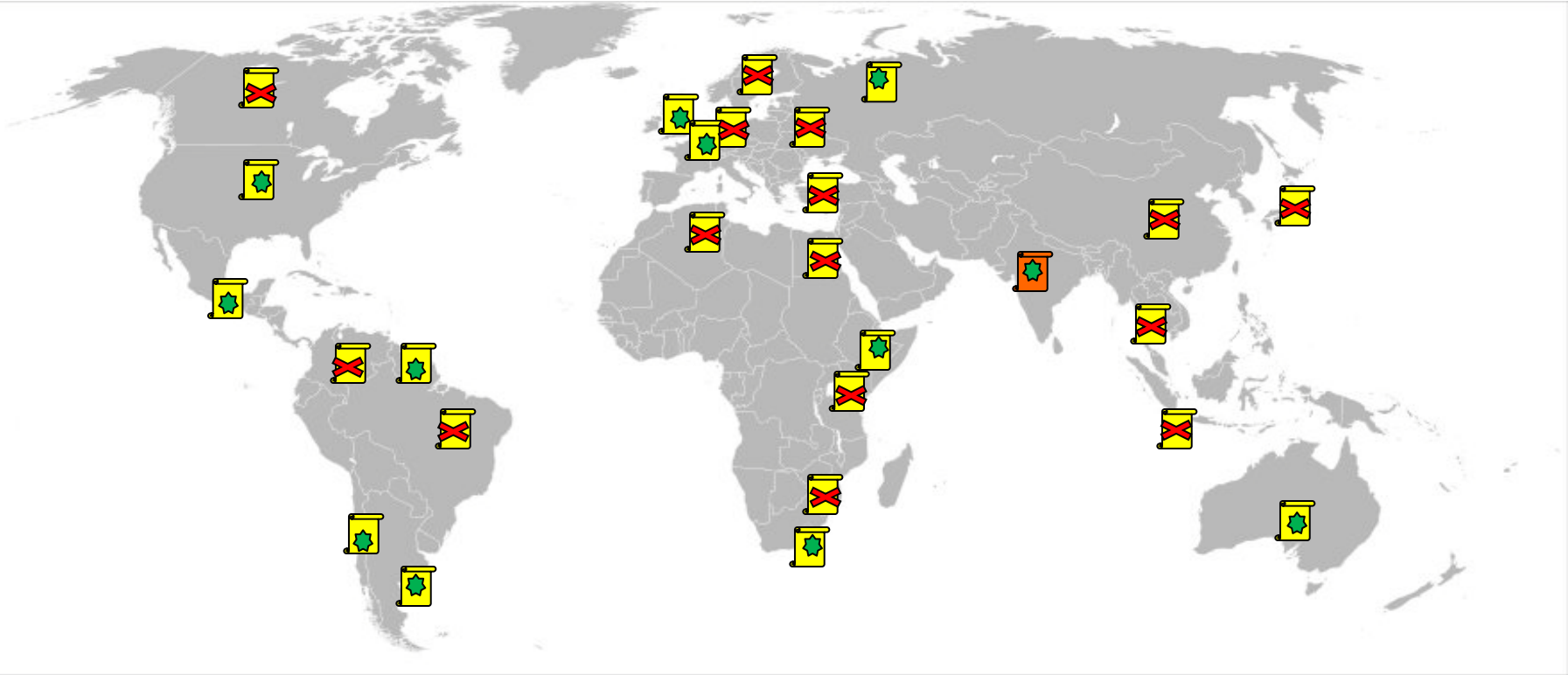
- Based on the Paris Convention (1883) – 176 Member States
- During the priority period, applicants may consider in which countries they wish to protect their inventions.

Seeking patent protection abroad

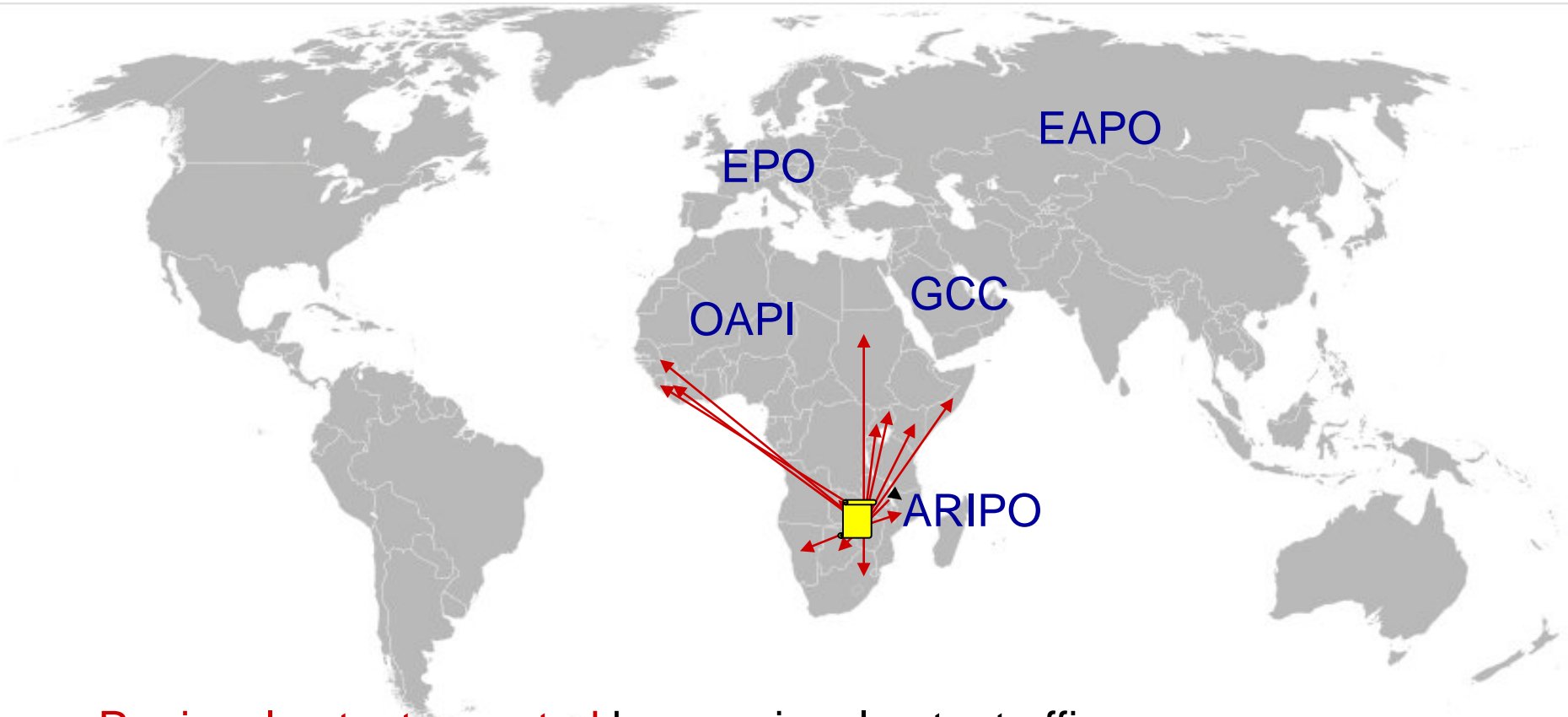
- Using **national patent systems**
- Using **regional patent systems**
 - ARIPO: African Regional Intellectual Property Organization
 - OAPI: African Intellectual Property Organization
 - EPO: European Patent Organisation
 - EAPO: Eurasian Patent Organization
 - GCC: Gulf Cooperation Council Patent Office
- Using the **Patent Cooperation Treaty (PCT)** system

Using national patent systems

- Different exclusions from patentable subject matter
- Different patentability requirements
- Different Forms, languages



Using regional patent systems



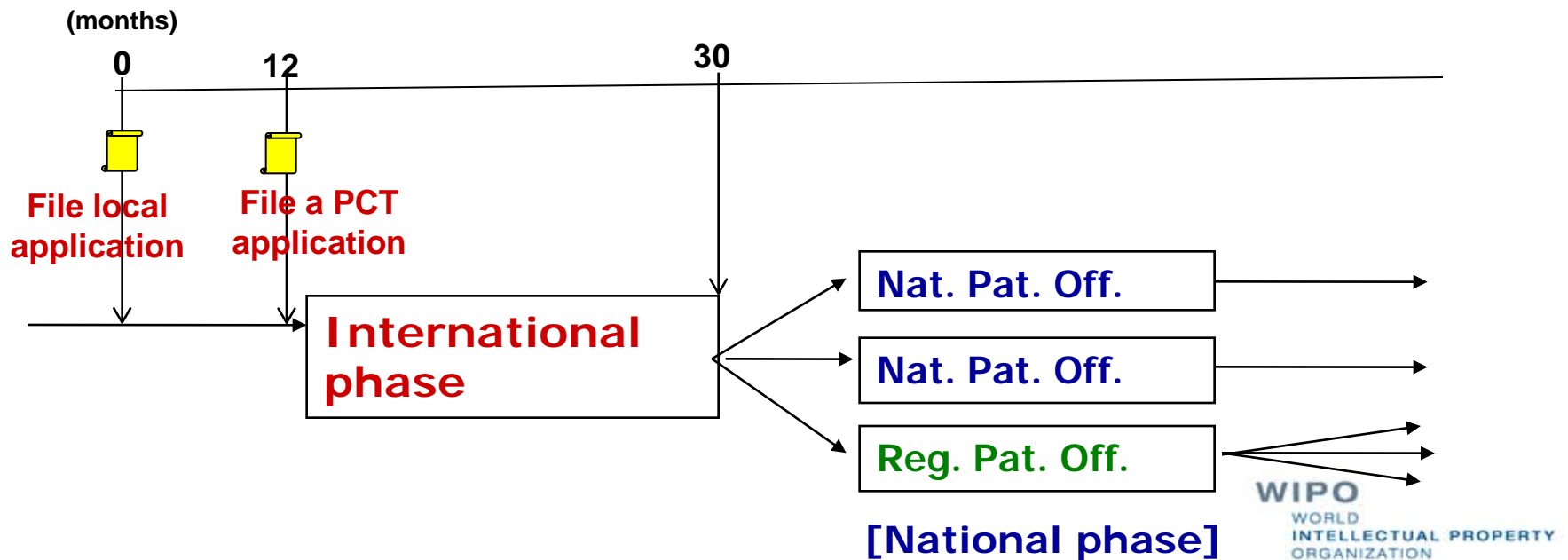
- **Regional patents granted** by a regional patent office
 - A regional patent having effect in all member states; or
 - A bundle of national patents (having effect in designated Member States)

Resources

- Directory of national / regional intellectual property offices
<http://www.wipo.int/directory/en/urls.jsp>
- National, regional and international IP laws (WIPO Lex)
<http://www.wipo.int/wipolex/en/>

Seeking patent protection abroad

- Using national patent systems
- Using regional patent systems (EPO, EAPO, OAPI, ARIPO, GCC)
- Using the **Patent Cooperation Treaty (PCT) system**



1. Often, before filing a PCT application, a national application is filed.

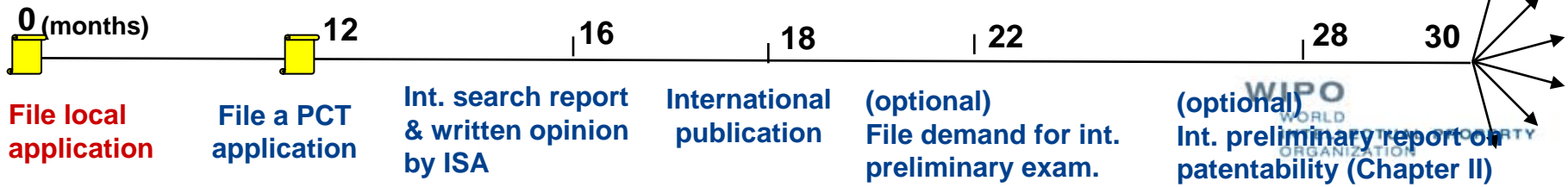
PCT

WORLD INTELLECTUAL PROPERTY ORGANIZATION
International Bureau



INTERNATIONAL APPLICATION PUBLISHED UNDER THE PATENT COOPERATION TREATY (PCT)

(51) International Patent Classification ⁶ : C07D 401/04, A61K 31/505 // (C07D 401/04, 239:00, 213:00)		A1	(11) International Publication Number: WO 99/03854
			(43) International Publication Date: 28 January 1999 (28.01.99)
(21) International Application Number: PCT/EP98/04427		(81) Designated States: AL, AM, AT, AU, AZ, BA, BB, BG, BR, BY, CA, CH, CN, CU, CZ, DE, DK, EE, ES, FI, GB, GE, GH, GM, HR, HU, ID, IL, IS, JP, KE, KG, KP, KR, KZ, LC, LK, LR, LS, LT, LU, LV, MD, MG, MK, MN, MW, MX, NO, NZ, PL, PT, RO, RU, SD, SE, SG, SI, SK, SL, TJ, TM, TR, TT, UA, UG, US, UZ, VN, YU, ZW, ARIPO patent (GH, GM, KE, LS, MW, SD, SZ, UG, ZW), Eurasian patent (AM, AZ, BY, KG, KZ, MD, RU, TJ, TM), European patent (AT, BE, CH, CY, DE, DK, ES, FI, FR, GB, GR, IE, IT, LU, MC, NL, PT, SE), OAPI patent (BF, BJ, CF, CG, CI, CM, GA, GN, GW, ML, MR, NE, SN, TD, TG).	
(22) International Filing Date: 16 July 1998 (16.07.98)			
(30) Priority Data: 1764/97 18 July 1997 (18.07.97) CH			
(71) Applicant (for all designated States except AT US): NOVARTIS AG [CH/CH]; Schwarzwaldallee 215, CH-4058 Basel (CH).			
(71) Applicant (for AT only): NOVARTIS-ERFINDUNGEN VERWALTUNGSGESELLSCHAFT MBH [AT/AT]; Brunner Strasse 59, A-1235 Vienna (AT).		Published <i>With international search report. Before the expiration of the time limit for amending the claims and to be republished in the event of the receipt of amendments.</i>	
(72) Inventors; and			
(75) Inventors/Applicants (for US only): ZIMMERMANN, Jürg [CH/CH]; Ahornweg 622, CH-4323 Wallbach (CH). SUTTER, Bertrand [FR/FR]; 6, rue des Pins, F-68220 Héisingue (FR). BÜRGER, Hans, Michael [DE/CH]; Maiengasse 28, CH-4123 Allschwil (CH).			
(74) Agent: BECKER, Konrad; Novartis AG, Patent- und Markenabteilung, Lichtstrasse 35, CH-4002 Basel (CH).			
(54) Title: CRYSTAL MODIFICATION OF A N-PHENYL-2-PYRIMIDINEAMINE DERIVATIVE, PROCESSES FOR ITS MANUFACTURE AND ITS USE			



2. A PCT application filed.

PCT

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International Bureau



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(22) International Filing Date: 16 July 1998 (16.07.98)		<p>(31) Designated States: AL, AM, AT, AU, AZ, BA, BB, BG, BR, BY, CA, CH, CN, CU, CZ, DE, DK, EE, ES, FI, GB, GE, GH, GM, HR, HU, ID, IL, IS, JP, KE, KG, KP, KR, KZ, LC, LK, LR, LS, LT, LU, LV, MD, MG, MK, MN, MW, MX, NO, NZ, PL, PT, RO, RU, SD, SE, SG, SI, SK, SL, TJ, TM, TR, TT, UA, UG, US, UZ, VN, YU, ZW, ARIPO patent (GH, GM, KE, LS, MW, SD, SZ, UG, ZW), Eurasian patent (AM, AZ, BY, KG, KZ, MD, RU, TJ, TM), European patent (AT, BE, CH, CY, DE, DK, ES, FI, FR, GB, GR, IE, IT, LU, MC, NL, PT, SE), OAPI patent (BF, BJ, CF, CG, CI, CM, GA, GN, GW, ML, MR, NE, SN, TD, TG).</p> <p>Published <i>With international search report. Before the expiration of the time limit for amending the claims and to be republished in the event of the receipt of amendments.</i></p>	
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(54) Title: CRYSTAL MODIFICATION OF A N-PHENYL-2-PYRIMIDINEAMINE DERIVATIVE, PROCESSES FOR ITS MANUFACTURE AND ITS USE			

0 (months)

File local application

12

File a PCT application

16

Int. search report & written opinion by ISA

18

International publication

22

(optional) File demand for int. preliminary exam.

28

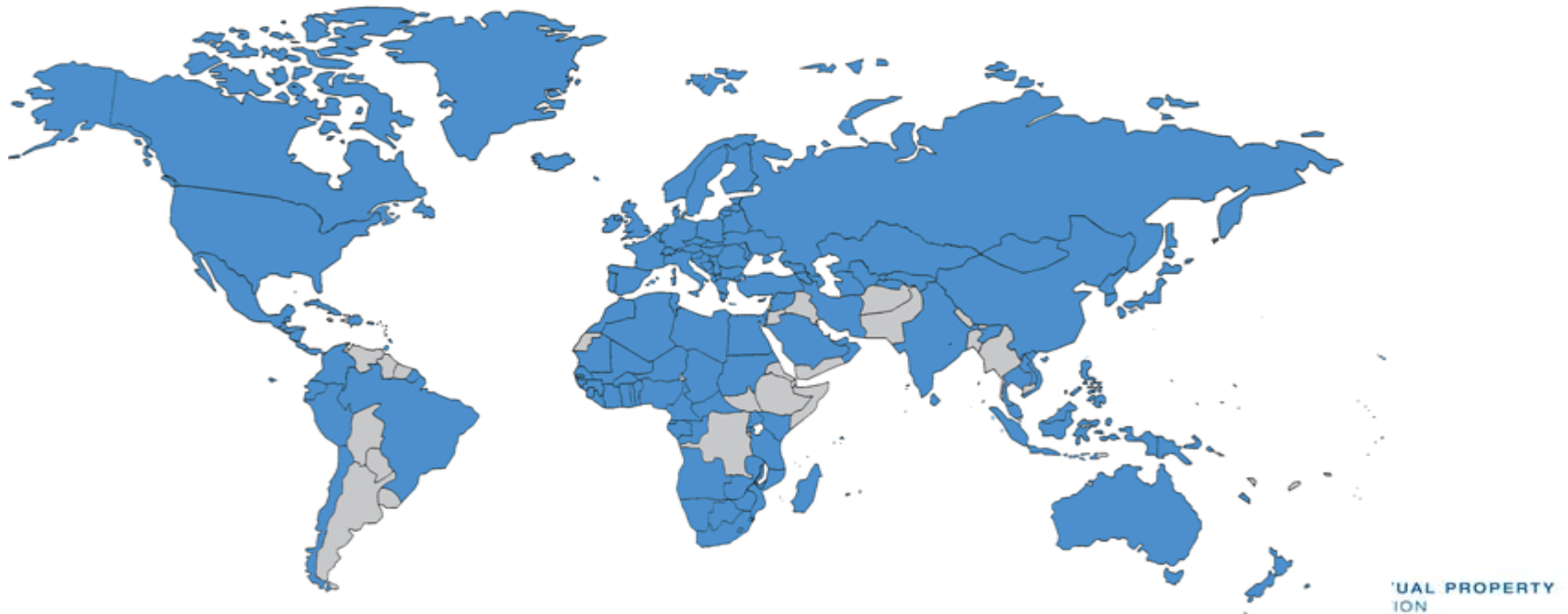
(optional) Int. preliminary report on patentability (Chapter II)

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PCT international application

- Filing **one “international” patent application** has the same effect as filing national applications in **148 PCT Contracting States**
- In general, an applicant may file a PCT application with its national office or WIPO. If permitted by the national law, possibility of filing with a regional patent office (applicants who are nationals or residents of the ARIPO MSs may file a PCT application with ARIPO).
- Possibility of 90% reductions of certain fees for LDC applicants and for a natural person from developing countries.



3. International search report and written opinion prepared by an International Search Authority (ISA)

INTERNATIONAL SEARCH REPORT

International Application No
PCT/EP 98/04427

A. CLASSIFICATION OF SUBJECT MATTER
IPC 6 C07D401/04 A61K31/505 //(C07D401/04,239:00,213:00)

According to International Patent Classification(IPC) or to both national classification and IF

B. FIELDS SEARCHED

Minimum documentation searched (classification system followed by classification symbols)
IPC 6 C07D A61K

Documentation searched other than minimum documentation to the extent that such docum

Electronic data base consulted during the international search (name of data base and, wh

Written opinion
a preliminary and non-binding opinion on whether the invention appears to meet the patentability criteria in light of the search report results.

Relevant prior art

C. DOCUMENTS CONSIDERED TO BE RELEVANT

Category	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
A	US 5 521 184 A (ZIMMERMANN JUERG) 28 May 1996 see example 21	1-13

0 (months)

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File local application

File a PCT application

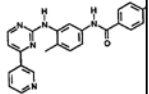
Int. search report & written opinion by ISA

International publication

(optional) File demand for int. preliminary exam.

(optional) WIPO WORLD INTELLECTUAL PROPERTY ORGANIZATION Int. preliminary report on patentability (Chapter II)

4. The PCT application and the international search report published on the WIPO PATENTSCOPE website.

PCT		WORLD INTELLECTUAL PROPERTY ORGANIZATION	
INTERNATIONAL APPLICATION PUBLISHED UNDER THE PATENT COOPERATION TREATY (PCT)			
(51) International Patent Classification ⁶ :	WO 99/03854	WO 99/03854	PCT/EP98/04427
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(21) International Application Number: PCT/EP98/04427			
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(74) Agent: BECKER, Konrad; Novartis AG, Patent- und Markenabteilung, Lichtstrasse 35, CH-4002 Basel (CH).			
(54) Title: CRYSTAL MODIFICATION OF A N-PHENYL-2-PYRIDIN-3-YLAMINO BENZAMIDE AND ITS USE			
			
(57) Abstract			

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File local application

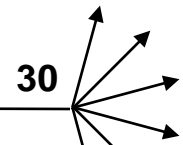
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File a PCT application

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Int. search report & written opinion by ISA

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International publication

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(optional)
File demand for int. preliminary exam.

28
(optional)
Int. preliminary report on patentability (Chapter II)



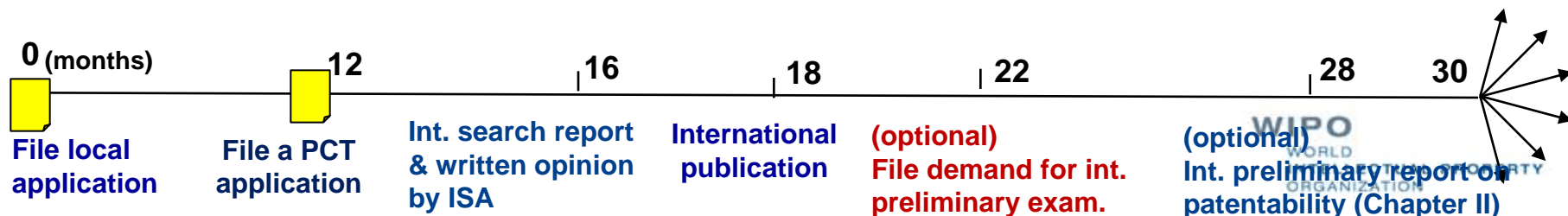
5. [OPTIONAL] An applicant may request an international preliminary examination by an International Preliminary Examining Authority.

- An applicant has an opportunity to amend the claims, description and drawings.

ex.

Claim 1 as filed: A form of the **methanesulfonic** acid addition salt of a compound of formula I, comprising crystals of the β -modification.

Claim 1 as amended: A form of the **monomethanesulfonic** acid addition salt of a compound of formula I, **comprising at least 90% by weight crystals of the β -modification**, said crystals of the β -modification being **non-hygroscopic and remaining essentially dry in a glass climatic chamber at 25°C and relative humidifies up to and including 93%**.



6. An international preliminary examination report is prepared and sent to the applicant and WIPO (→ to national offices).

PATENT COOPERATION TREATY		
PCT		
INTERNATIONAL PRELIMINARY EXAMINATION REPORT (PCT Article 36 and Rule 70)		
Applicant's or agent's file reference 4-30096/A		FOR FURTHER ACTION <small>See Notification of Transmittal of International Preliminary Examination Report (Form PCT/IPEA416)</small>
International application No. PCT/EP98/04427	International filing date (day/month/year) 16/07/1998	Priority date (day/month/year) 18/07/1997
International Patent Classification (IPC) or national classification and IPC C07D401/04		
Applicant NOVARTIS AG et al.		
<p>1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.</p> <p>2. This REPORT consists of a total of 5 sheets, including this cover sheet.</p> <p><input checked="" type="checkbox"/> This report is also accompanied by ANNEXES, i.e. sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 807 of the Administrative Instructions under the PCT).</p> <p>These annexes consist of a total of 3 sheets.</p>		
<p>3. This report contains indications relating to the following items:</p> <p>I <input checked="" type="checkbox"/> Basis of the report</p> <p>II <input type="checkbox"/> Priority</p>		

- A preliminary and non-binding opinion
 - Novelty
 - Inventive step
 - Industrial applicability
 - Other defects (ex. non-clarity of claims, claims not supported by the descriptions)

0 (months)
File local application

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File a PCT application

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International publication

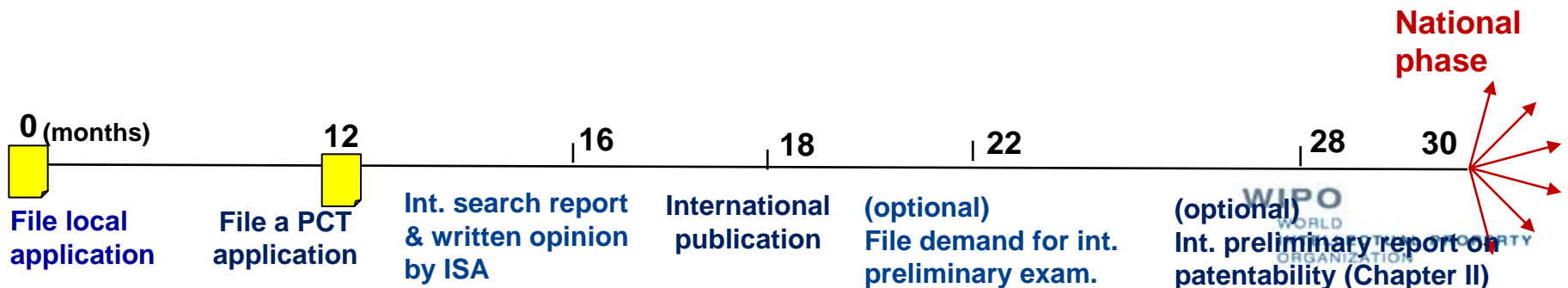
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File demand for int. preliminary exam.

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(optional)
Int. preliminary report on patentability (Chapter II)

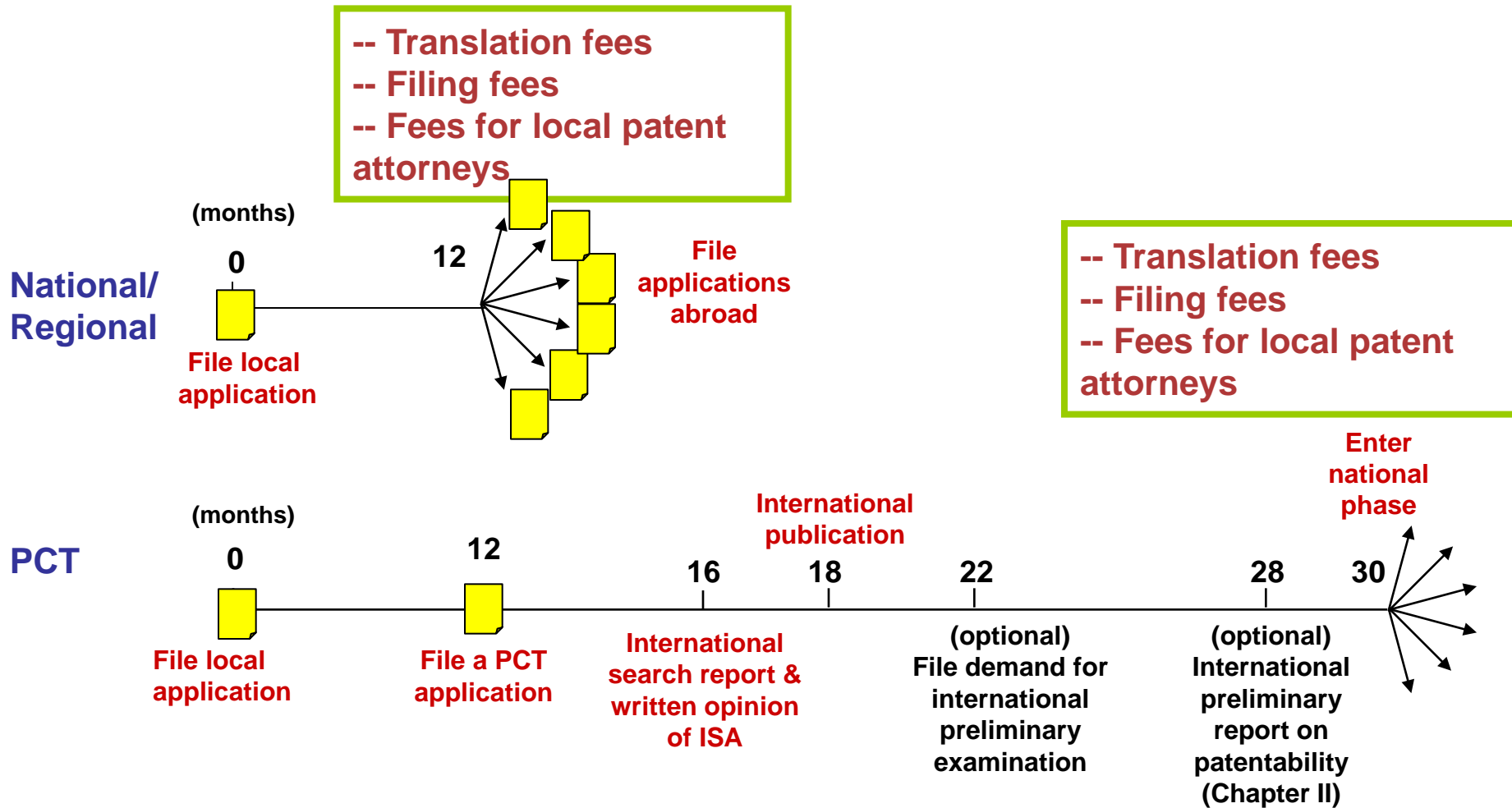
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7. The applicant decides whether, and with respect to which countries, he wishes to proceed with the international application.

- Typically, the applicant must pay national fees and, in some cases, file translations with the national offices.
- Each national office determines whether it grants patent or not, based on the substantive patentability requirements under its law.
 - The international search report & written opinion (and the international preliminary examination report, if any) facilitate, but does not bind, the examination at the national phase.



National/regional patent application vs. PCT international application



PCT: Advantages

- **One application** has the same effect of filing patent applications in 148 countries.

- **Postpone the major costs** associated with seeking patent protection internationally
 - Translations
 - Fees
 - Local patent attorneys

- Provide a basis for **patenting decisions**
 - International search report and written opinion
 - (optional) International preliminary report on patentability II

- **Better business prospect** and geographical coverage

Contact and assistance

PCT

Further information: <http://www.wipo.int/pct/>

- PCT Distance Learning Course (4h)
- Learn the PCT Video Series

General questions: pct.infoline@wipo.int

Thank you

Tomoko.miyamoto@wipo.int