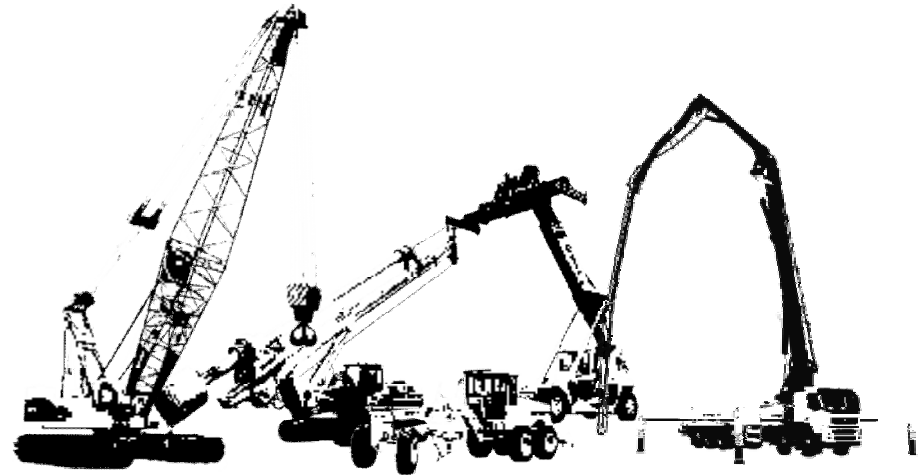




**SANY**



# Effective Use of PCT System

**Wei Shao**

**SANY HEAVY INDUSTRY CO., LTD**

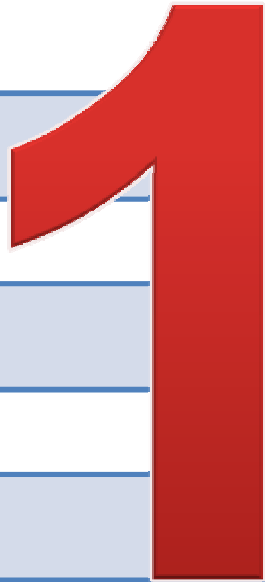
# OUTLINE

Decisions of international patent application

Fee controlling in international phase

Amendment and Change

Use of WIPO resources



Decisions of international patent application

Fee controlling in international phase

Amendment and change

Use of WIPO resources

## 1.1 Decision of international patent application

U Is it necessary to file patent applications abroad?

ü Market and potential market

ü Technical and commercial values of invention

ü Life cycle of the invention technology

ü Assessment of costs and benefits

## 1.1 Decision of international patent application

### └ PCT route or Paris Convention route?

#### └ Invention or appearance design

PCT system does not apply to appearance design, so Paris Convention route can be chosen for appearance design

#### └ What countries and regions want to enter

For cost reason, we propose to choose Paris Convention route if we want to enter less than 3 countries, and to choose PCT route if we want to enter 3 or more

#### └ Time to file national application

If you want to file a national application as soon as possible, you can choose Paris Convention route, if you want to postpone filing national application, you can choose the PCT route

## 1.2 Decision of the international phase

U File domestic application first or PCT application first?

Ü Benefits of filing domestic application first

Ø You can postpone protection period for one year, because most countries' patent protection period starts from the date of filing (PCT filing date), rather than the priority date

Ø You can amend the application before filing PCT application by including some newly improved features and examples

Ü Benefits of filing PCT application first

Ø You can complete applications for all PCT contracting states in one time with one application, including the domestic application

Ø You will receive International Search Report at an earlier date (9 months from the filing date), and go through the international preliminary examination in advance

## 1.2 Decision of the international phase

- U Whether to request for the international preliminary examination?
  - Ü The cost of the international preliminary examination (in China, application fee CHF 200, examination fee CNY 1500)
  - Ü Further understanding the examiner's opinion through the international preliminary examination
  - Ü International Preliminary Report on Patentability will not influence the examination in national phase
  - Ü We propose that you decide whether to start the international preliminary examination procedure **after receiving the International Search Report**

## 1.3 Decision of national phase entry

### U Whether to enter the national phase?

ü Carry out patentability assessment of the PCT application according to the International Search Report, the Written Opinion of the International Searching Authority and possible International Preliminary Report on Patentability

### U When to enter the national phase?

ü Enter at the expiration of 30 months from priority date?

Delay payment of the cost in national phase

ü Enter at 16 months from the priority date (receiving International Search Report and Written Opinion)?

Consideration on litigation, investment and licensing negotiations



## 1.3 Decision of national phase entry

- ┌ Which countries to enter in national phase?
  - ┆ Corporate patent strategy
  - ┆ Current major markets and potential market
  - ┆ Competitor's location and their major markets
  - ┆ Relevant countries' economic and technological development level
  - ┆ Relevant countries' intellectual property protecting environment
  - ┆ Costs (official fee and agent fee)

## 1.4 SANY practice

Each business division of SANY has a patent committee, which consisted of management, technical experts and patent experts, who make decisions on patent matters

Meetings for filing foreign patent application are held every quarter. In the meeting, international application filing assessment should be made for domestic applications within the priority period, and PCT national phase entry assessment should be made for PCT applications of 18-25 months from the priority date.



SANY's typical procedure for filing patent application abroad

## 1.4 SANY practice

### U Foreign application filing assessment

- ü Decide whether to file foreign application
- ü Decide file application with PCT route or Paris Convention route
- ü Not decide which country to enter
- ü Mainly consider technical factors, market and other factors

### U PCT national phase entry assessment

- ü Decide whether to enter the national phase as well as which countries to enter
- ü Before the meeting, inventors and patent engineers will carefully review the Written Opinion of the International Searching Authority, and express opinions on the patentability as reference to the committee
- ü Mainly consider patentability, market competition, patent strategy and other factors

# 2

Decisions of foreign patent application

Fee controlling in international phase

Amendment and change

Use of WIPO resources

## 2.1 Submit by yourself

- ☒ China's State Intellectual Property Office (SIPO) allows applicants to submit their PCT applications by their own (not via the agency)

- ☒ PCT application contents generally have little change compared to its domestic applications claimed for priority

- ☒ Using a local agent for the domestic application, then submit PCT application by yourself within the priority period, thus saving the agency fee in the international phase

- ☒ It's available for companies with strong patent teams

## 2.2 Fee reduction

- ü Cost reduction for electronic filing through PCT-SAFE software

- ü EASY mode, reduction of 100 CHF

- ü Fully electronic mode in PDF format, reduction of 200 CHF

- ü Fully electronic mode in XML format, reduction of 300 CHF

- ü When selecting the agency, it is required to submit the PCT application through PCT-SAFE

- ü When companies submit PCT applications by their own, PCT-SAFE shall be used

## 2.3 Page control of application documents

☒ On the filing day, try to control the PCT application documents within 30 sheets to avoid additional fee

☒ Five kinds of declaration can be submitted after filing of the PCT application, no later than the 16 months from the priority date

☒ When signing the application with PCT-SAFE, it can be signed by only one applicant/agent, to reduce the pages of application documents

☒ Co-applicants can be added within 30 months from the date of priority

☒ Based on the formatting requirement of the international publication, the pages of descriptions, claims and drawings can be reduced through adjusting the layout

## 2.4 Avoid paying late fee

U Payment of transmittal fee, international filing fee, search fee shall be made within 1 month after the office receive PCT applications.

U A surcharge shall be paid if the payment isn't made before the deadline

U If the full amount of the payment (including the late fee) is not made before the deadline set by the office, the application will be considered withdrawn



# 3

Decisions of foreign patent application

Fee controlling in international phase

**Amendment and change**

Use of WIPO resources

## 3.1 Amendment of the application documents

### U Amend when receiving International Search Report

- ü Agree with the Written Opinion of the International Searching Authority

- ü Amend claims according to searched references and the written opinion

- ü The effect of the amendment in international phase : effect of temporary protection

- ü Within 16 months from the priority date or within two months from the date of sending International Search Report, the claims can be amended once

## 3.1 Amendment of the application documents

### U Amendment in international preliminary examination phase

ü Learn more about the examiner's opinion through document amendment or statement of opinions

ü It's available to amend the claims, description, and drawings

ü Obtain a favorable International Preliminary Report in the international phase, to reduce the number of office action in the national phase, thus reduce agency cost and speed up the examination progress

ü Amend when submitting a demand of the preliminary examination or before preparing preliminary examination report

## 3.1 Amendment of the application documents

### U Amend when entering national phase

- Ü Agree with the written opinion of the International Searching Authority
- Ü Re-write the claims according to the searched references and the written opinion
- Ü Reduce the number of office action in the national phase
- Ü Remove the claims unable to enhance the patentability according to the written opinion to avoid additional fee in case of the number of claims exceeds certain amount prescribed by the receiving office in the national phase

## 3.1 Amendment of the application documents

⊍ Not amend when entering national phase or before

⊎ May obtain broader protection scope

⊎ Each national application may need to be amended in the examination stage in the national phase

⊎ May need to respond to more office actions in the national phase, and result in more cost

## 3.2 Change of the Index

- U Change applicant, applicant address, inventor and so on
- U Changes in the international phase take effect for all PCT contracting states
- U The change procedure is simple in the international phase, generally it is not required to submit proof of change, and there is no need for additional cost
- U Changes in the national phase need change in each country, which are cumbersome and costly

# 4

Decisions of foreign patent application

Fee controlling in international phase

Amendment and change

Use of WIPO resources

## 4.1 WIPO resources

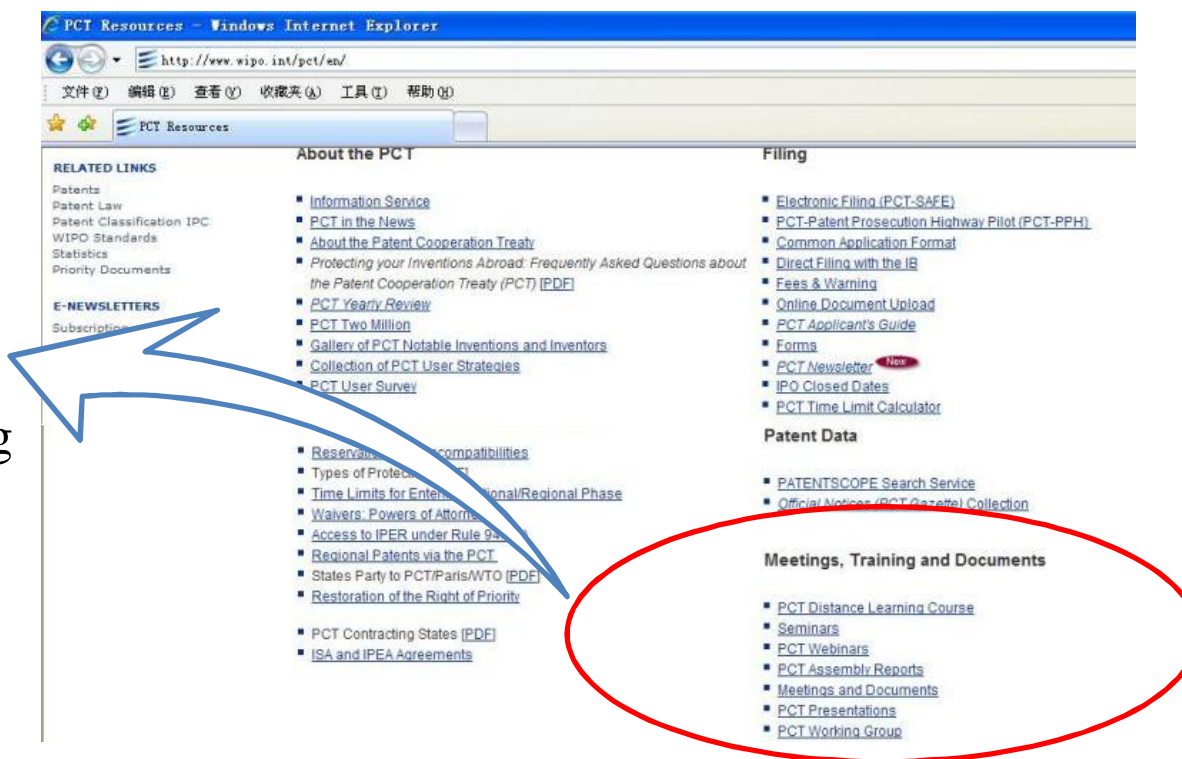
U PCT Applicant's Guide (<http://www.wipo.int/pct/en/appguide/index.jsp>)

ü International phase: Introduction of process and issues in international phase

ü National phase: introduction of process and issues in national phase

U Training materials  
(WIPO official website)

U WIPO's various training  
courses and seminars





## 4.2 SANY foreign patent application guide

U Based on WIPO's resources and SANY practice, "SANY's International Patent Applications Guide" is prepared

U "SANY's International Patent Applications Guide" is available to the company's management, R&D engineers, and patent team

U The main contents of "SANY International Patent Applications Guide" include SANY internal procedure of international patent application filing, international official application procedure (PCT route, Paris Convention route, and application procedures in Europe and the U.S.), strategies and practice skills of international patent application filing.

- U Thank WIPO and SIPO for inviting SANY to attend this international workshop
- U Thank the organizer for the warm reception
- U Thank you for listening

**THANK YOU**