



National Workshop on the Patent Cooperation Treaty (PCT) System

Session 1

Overview on the Patent Cooperation Treaty (PCT) and the Role of an International Searching Authority (ISA)

Nagpur, India
November 28 and 29, 2016

Mr. Kenichiro NATSUME
Director
PCT International Cooperation Division
Patents and Technology Sector



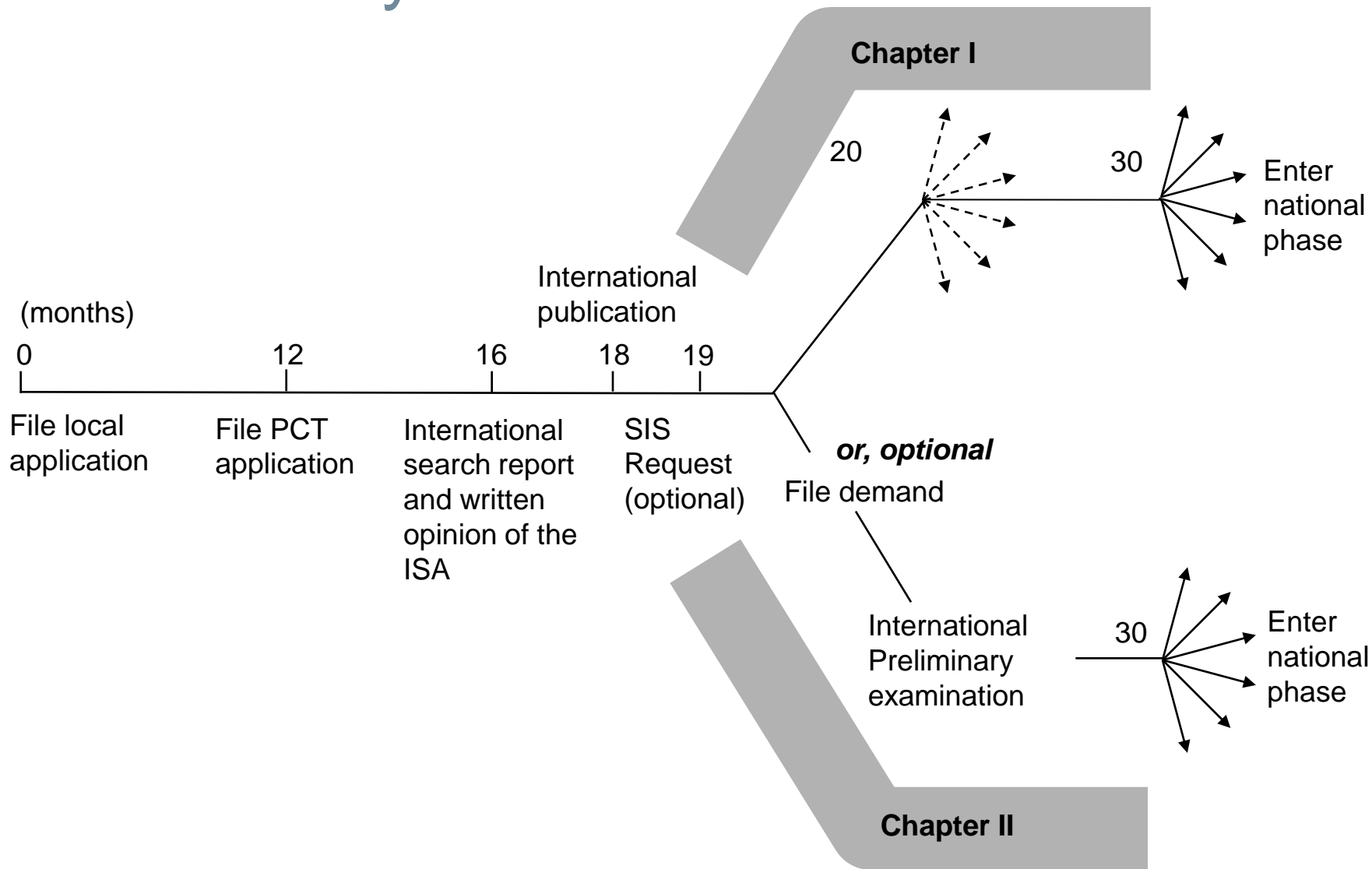
Introduction to the PCT System

Goal of This Workshop

- Obtain skills needed to prepare
 - Written Opinion of ISA
 - International Preliminary Report on Patentability
Chapter II

- This will be done through the Case Study (2 cases)

The PCT system





International Search and Written Opinion of the ISA

The International Searching Authority (1)

- Checks unity of invention (Rules 13 and 40)
- Checks title (Rule 37); checks abstract (Rule 38)
- Searches claimed invention (Article 15(3), Rule 33.3)
- Authorizes rectification of obvious mistakes if the mistake is:
 - in any part of the international application other than the request, (Rule 91.1(b)(ii)) or
 - in any paper submitted to that Authority (Rule 91.1(b)(iv))

The International Searching Authority (2)

- Establishes international search report (ISR) (Rules 42 and 43) and/or declaration that no international search report will be established (Article 17(2))
- Establishes written opinion of the ISA (Rule 43*bis*): non-binding first opinion on novelty, inventive step (non-obviousness) and industrial applicability of claimed invention

International Searching Authorities (22 in total)

- AT – Austria
- AU – Australia
- BR – Brazil
- CA – Canada
- CL – Chile
- CN – China
- EG – Egypt
- ES – Spain
- FI – Finland
- IL – Israel
- IN – India
- JP – Japan
- KR – Republic of Korea
- RU – Russian Federation
- SE – Sweden
- SG – Singapore
- UA – Ukraine
- US – United States of America
- EP – European Patent Office
- XN – Nordic Patent Institute
(Denmark, Iceland, Norway)
- XV – Visegrad Patent Institute (VPI)
(Czech Republic, Hungary, Poland,
Slovakia)
- TR – Turkish Patent Institute (TPI)
(not yet operational)

Prior art for international search (Article 15(2) and Rule 33)

■ Prior art:

- everything which has been made available to the public,
- Where??,**
- What kind of disclosure??,**
- which is capable of being of assistance in determining that the claimed invention is or is not new and that it does or does not involve an inventive step,
- provided the making available to the public occurred prior to **what date? (and why?)**.

■ PCT Minimum Documentation (Rule 34)

International Search Report (ISR) (Rules 42 and 43)

■ Contains:

- IPC (International Patent Classification) symbols
- indications of the technical areas searched
- indications relating to any finding of lack of unity
- a list of the relevant prior art documents
- indications relating to any finding that a meaningful search could not be carried out in respect of certain (but not all) claims

■ Time limit to establish ISR and written opinion of the ISA:

- ?? months from the date of receipt of the search copy by the ISA (usually within approximately 16 months from the priority date if priority is claimed); or
- ?? months from the priority date, whichever time limit expires later

Cases where no international search report will be established (1)

- The application relates to a subject matter which the ISA is not required to search, and in the particular case decides not to search (Article 17(2)(a)(i) and Rule 39.1)
- The description, claims or drawings do not comply with the prescribed requirements to such an extent that a meaningful search cannot be carried out in respect of any of the claims (Article 17(2)(a)(ii))
- The application contains the disclosure of a nucleotide and/or amino acid sequence, but:
 - no listing of that sequence is furnished,
 - the listing furnished does not comply with the Standard set out in Annex C of the Administrative Instructions or is not in electronic form (Rule 13*ter*.1(d)), or
 - the fee for late furnishing of the sequence listing has not been paid within the applicable time limit (Rule 13*ter*.1(d))

Cases where no international search report will be established (2)

■ Consequences:

- ❑ the ISA will declare that no international search report has been established and that declaration will be published as part of the published international application (Rule 48.2(a)(v))
- ❑ the application remains valid but the IPEA will not be obliged to carry out the international preliminary examination for lack of an international search report (Rule 66.1(e))

Written opinion of the ISA (Rule 43*bis*) (1)

- Initial preliminary non-binding opinion on:
 - novelty (not anticipated)
 - inventive step (not obvious)
 - industrial applicability
- A written opinion will be established for all international applications at the same time as the ISR
- The written opinion is sent to applicant and the International Bureau together with the ISR

Written opinion of the ISA (Rule 43bis) (2)

- The written opinion is made publicly available on PATENTSCOPE in its original language as of the date of publication of the international application
- No formal procedure for applicants to respond to written opinion of the ISA
- Possibility to submit informal comments to the International Bureau
 - They are made publicly available together with the written opinion in their original language
 - They are communicated to the DOs together with the IPRP (Chapter I) if and when it is sent
- Note: The IPRP Chapter I and its translation are established at 30 months from the priority date

Prior art for written opinion of the ISA (Rules 43*bis*.1(b) and 64.1)

■ Prior art:

- same as for international search purposes; BUT:
- relevant date: everything made available to the public prior to what date?? Why?


- The ISA may request a copy of a priority document from the International Bureau (Rule 66.7(a)); however, even if, at the time of establishment of the written opinion of the ISA, a copy cannot be made available to the ISA, the written opinion will nevertheless be established on the assumption that the priority date is the relevant prior art date, except if the applicant had failed to comply with his obligations under Rule 17.1

International preliminary report on patentability (IPRP) (Chapter I of the PCT) (Rule 44*bis*)

- If applicant does not file a demand for international preliminary examination:
 - IB establishes the IPRP (Chapter I) on the basis of the written opinion of the ISA
 - IPRP (Chapter I) and its translation
 - are sent to designated Offices
 - are made publicly available on PATENTSCOPE (but not “published” like the international application and ISR) at the expiry of 30 months from the priority date

Use of the written opinion of the ISA for the purposes of the Chapter II procedure (Rule 66.1 *bis*)

- If applicant files a demand for international preliminary examination:
 - written opinion of the ISA becomes written opinion of the IPEA (exception: IPEA decides not to accept written opinions by certain ISAs)
 - informal comments by applicant on written opinion of ISA will not be sent to IPEA (Article 34 amendments/arguments only)
 - if an international preliminary examination report is established, any informal comments submitted to the IB will not be sent to DOs or EOs



Filing of Demand for International Preliminary Examination

What is a demand?

- The demand is a request for International Preliminary Examination under Chapter II of the PCT
- International Preliminary Examination is an optional procedure that provides for continued examination of the PCT application before an International Preliminary Examining Authority (IPEA)
- Filing a demand constitutes the automatic “election” of all designated PCT Contracting States

Why file a demand? (1)

- Provides an opportunity during international preliminary examination to make amendments to the description, claims and drawings
- Can submit arguments to address patentability objections raised by the ISA
- International preliminary examination is the final opportunity to obtain a more positive patentability assessment during the international phase

Why file a demand? (2)

- Results in the establishment of an International Preliminary Report on Patentability (Chapter II)
- Likelihood of more favorable treatment in the national phase on the basis of a positive patentability report

Who is entitled to make a demand? (Article 31(2)(a) and Rule 54.2)

The applicant, or if there are two or more applicants, at least one of them,

- who is a resident or national of a PCT Contracting State, and
- whose international application has been filed with a receiving Office of or acting for a Contracting State (currently all States)

The demand form

- ePCT
- Electronic filing software provided by the IPEA
- Printed demand form (PCT/IPEA/401)
- Computer-generated demand (Rule 53.1(a) and Section 102(h) and (i))
 - Same requirements regarding layout and contents as for request form

The demand for international preliminary examination: contents (Rule 53)

- The demand must contain the following indications:
 - ❑ a petition
 - ❑ particulars enabling the international application to be identified (for example, the international application number)
 - ❑ the name of the applicant(s) under Chapter II
 - ❑ where appropriate, the name of the agent
 - ❑ the basis on which international preliminary examination should be carried out (a statement concerning amendments)
 - ❑ the language for the purposes of international preliminary examination
 - ❑ the signature of (at least one of) the applicant(s) or of the agent

Signature of demand (Rule 53.8)

- Only the persons indicated as applicants for the States elected in the demand need to sign the demand
- If these applicants have appointed an agent or a common representative, that agent or common representative may sign
- If there is no appointed agent or common representative, it is sufficient that the demand is signed by at least one of the applicants (see Rule 60.1(a-ter))
- Note that some Authorities do not require that a separate power of attorney or a copy of a general power of attorney is furnished (Rules 90.4 and 90.5)

Where to file the demand? (Rule 59) (1)

- Directly with the competent IPEA
 - specified by the RO
 - if more than one is specified by the RO, applicant has the choice
- In making his choice, the applicant must take into account
 - the language(s) accepted by the IPEA
 - that some IPEA(s) accept only international applications which have been searched by certain ISAs (that is the case, for example, of IPEA/EP)

Where to file the demand? (Rule 59) (2)

- If the international application was filed with IB as RO, the competent IPEAs will be those which would have been competent if the international application had been filed with (any of) the national Office(s) which, on the basis of applicant's nationality or residence, could be a competent RO
- Choice of IPEA should be indicated in the demand

Transmittal of demand to competent IPEA (Rule 59.3)

- Where a demand is submitted to a non-competent IPEA or to a RO, an ISA or the IB, that Authority or Office must:
 - mark the date of receipt on the demand and,
 - either forward it to the IB, which will in turn transmit it to the competent IPEA (or, if more than one, to the competent IPEA chosen by the applicant)
 - or transmit it directly to the competent IPEA (or, if more than one, to the competent IPEA chosen by the applicant)
- Any demand so transmitted to the competent IPEA will be considered to have been received on behalf of that Authority on the date on which it was received by the RO, ISA or IB or the non-competent IPEA concerned

When should a demand be filed? (Rule 54bis.1(a)) (1)

- At any time prior to the expiration of whichever of the following periods expires later:
 - 3 months from the date of transmittal of the ISR and WO of the ISA
 - 22 months from the priority date
- In respect of designated Offices for which the 20-month time limit under Article 22(1) continues to apply, prior to the expiration of 19 months from the priority date, in order to delay national phase from 20 to 30 months from the priority date
 - Only applies to LU, TZ and UG

When should a demand be filed? (Rule 54*bis*.1(a)) (2)

■ Recommendation:

Upon receipt of the international search report and the written opinion of the ISA, evaluate the cited prior art documents and decide whether to proceed further, and if so, file the demand as soon as possible thereafter together with any amendments/arguments in light of the written opinion, thus allowing maximum time prior to issuance of international preliminary examination report (i.e, usually 28 months from the priority date)

Defects under Chapter II (1)

- Defects whose correction results in a later filing date of the demand
 - no eligible applicant for filing the demand (Rule 54.2)
 - international application not identifiable (Rule 60.1(b))
- A demand filed after the expiration of 19 months from the priority date but within the applicable time limit under Rule 54*bis*.1(a), is valid but entry into the national phase will not be postponed until 30 months (Article 39(1)(a)) for LU, TZ and UG

Defects under Chapter II (2)

- Defects which can be corrected without any adverse consequences:
 - ❑ demand not filed with a competent IPEA (Rule 59.3)
 - ❑ form of the demand (Rule 53.1)
 - ❑ indications relating to applicants and agents (Rules 53.4 and 53.5)
 - ❑ language of the demand (Rule 55.1)
 - ❑ lack of at least one signature (Rules 53.8 and 60.1(a-ter))
 - ❑ amendments under Article 34 referred to but not furnished (Rule 53.9(a)(i))

ePCT and the filing of a demand

- ePCT private services can be used to prepare and file a demand
- Fields are automatically populated
- Automatic validations are done at the time of preparation
- All accompanying documents may be attached, e.g., Article 19 amendments, Article 34 amendments, translations, etc.
- The International Bureau automatically transmits the demand to the competent IPEA

Chapter II correction procedure

- Invitation by the IPEA to correct defects (Rule 60.1)
- Invitation by the IPEA to pay missing fees (Rule 58*bis*)
- Further possibilities:
 - request rectification of obvious mistakes before IPEA (Rule 91)
 - request review by and use opportunity to correct before the designated or elected Offices (Articles 25, 26 and 39(3))



International Preliminary Examination

International preliminary examination (1)

- Results in the establishment by the IPEA of a non-binding opinion on
 - novelty (not anticipated) (Article 33(2) and Rule 64)
 - inventive step (not obvious) (Article 33(3) and Rule 65)
 - industrial applicability (Article 33(4))
- International preliminary examination provides an opportunity to make amendments and to address patentability issues raised by the ISA

International Preliminary Examination (2)

- Only claims relating to the invention(s) searched by the ISA will be examined by the IPEA (Rules 66.1(e) and 66.2(a)(vi))

Start of international preliminary examination (Rule 69.1)

- When the IPEA is in possession of:
 - the demand
 - the international search report (or the declaration under Article 17(2)(a)) and the written opinion of the ISA
 - the preliminary examination and handling fees

provided that the IPEA shall not start the international preliminary examination before the expiration of the applicable time limit under Rule 54bis.1(a) unless the applicant expressly requests an earlier start

- If the demand contains a statement about amendments, when copies of these amendments are available (see Rule 69.1(c), (d) and (e))
- If international preliminary examination is to be carried out on the basis of a translation of the international application, when that translation is available (see Rule 55.2(c))

Finding of lack of unity of invention (Rule 68)

- Same criteria as for international search (Rule 13 and paragraphs 10.20 to 10.59 of the International Search and Preliminary Examination Guidelines)
- Invitation by the IPEA to restrict the claims or to pay additional fees (which can be paid under protest)
- Applicant can select invention as “main invention” and those inventions for which additional fees are paid

Prior art for IPE (Rule 64.1) (1)

■ What is considered prior art?

Everything made available to the public anywhere in the world by means of written disclosure (including drawings and other illustrations) provided that such making available occurred prior to what date??

Prior art for IPE (Rule 64.1) (2)

■ What is the relevant date?

- ❑ the date of the earlier application of which priority is claimed unless the IPEA considers that the priority claim is not valid for reasons other than the fact that the international filing date is later than the date on which the priority period expired, but is within two months from that date; or
- ❑ the international filing date of the international application in all other cases

Mandatory top-up search (Rule 66.1 *ter*)

- Aims at uncovering any prior art not available at the time when the ISR was established, in particular “secret” prior art (patent applications published on or after the date of establishment of the ISR but which have an earlier priority date)
- Exceptions:
 - Only in respect of claims for which the IPEA establishes an IPRP Chapter II
 - Where a search would serve no useful purpose, e.g. where the IPEA considers that the documents cited in the ISR are sufficient to demonstrate lack of novelty of the entire subject matter

Mandatory top-up search (Rule 66.1 *ter*)

- What is top-up search?

Written opinion of IPEA (Rules 66.2 and 66.6)

- The written opinion of the ISA is considered to be the written opinion of the IPEA (exception: IPEA decides not to accept written opinions by certain other ISAs)
- Where the written opinion of the ISA is taken as the written opinion of the IPEA, no second written opinion has to be issued
- If a second written opinion is issued, the applicant may respond within the time limit fixed in that second written opinion
- Possibility to request an interview with the examiner at the IPEA (Rule 66.6)

The international preliminary report on patentability (Chapter II) (1)

■ Must be established by the IPEA within:

- ?? months from the priority date
- ? months from the time provided under Rule 69.1 for the start of the international preliminary examination
- ? months from date of receipt by IPEA of translation under Rule 55.2,

whichever expires last (Rule 69.2)

The international preliminary report on patentability (Chapter II) (2)

- May contain “annexes” (Rule 70.16):
 - replacement sheets containing amendments under Art. 19 or Art. 34 and any letter indicating the basis for the amendments
 - replacement sheets containing rectifications of obvious mistakes authorized under Rule 91 by the IPEA and accompanying letter
 - when referred to in the report, any sheet and letter concerning the rectification of an obvious mistake which has not been taken into account because it was not available in time (Rule 66.4*bis*)

The international preliminary report on patentability (Chapter II) (3)

- May contain “annexes” (Rule 70.16):
 - earlier amendments when later amendments are not used as a basis for the report because they are
 - considered to go beyond the disclosure in the international application or
 - not accompanied by a letter indicating the basis for the amendments
- Not annexed to the report: any other correspondence or copies of amendments superseded by later amendments

The international preliminary report on patentability (Chapter II) (4)

- No provisions for appeal or further proceedings during the international phase before the International Authorities
- Sent to the applicant and the IB (Rule 71.1)
- IB forwards copies of the report, and any required translation of the report into English (prepared by the IB), to the elected Offices (Article 36(3)(a) and Rule 72.1)
- The annexes are not translated by the IB (Article 36(3)(b))

The international preliminary report on patentability (Chapter II) (5)

■ Calls attention to:

- non-written disclosures (see Rules 64.2 and 70.9)
- certain published documents (see Rules 64.3 and 70.10)

■ Shall cite (Rule 70.7):

- all documents considered to be relevant for supporting statements made concerning claims
- documents whether or not they are cited in the ISR
- documents cited in the ISR when the IPEA considers them relevant

Reasons for delays in international preliminary examination (1)

■ On the part of the applicant:

- late payment of fee(s)
- late correction of defects in the demand
- incomplete statement, in the demand, concerning amendments
- failure to attach amendments referred to in the statement
- late furnishing of any required translation of the international application or of amendments
- late response to invitation to pay additional examination fees in case of finding of lack of unity
- late response to written opinion
- failure to file replacement sheets containing amendments

Reasons for delays in international preliminary examination (2)

■ On the part of the ISA:

- late issuance of international search report

■ On the part of the IPEA:

- finding of lack of unity
- late issuance of written opinion



Amendments under the PCT

- Amendments under Article 19
- Amendments under Article 34
- How to make amendments
- Amendments upon National Phase Entry

Amendments under Article 19 (Rule 46) (1)

- One opportunity to amend the claims only after receipt of the international search report and written opinion of the ISA
- Amended claims must not go beyond disclosure of the international application as filed (Article 19(2)) (compliance with that requirement is, however, not checked at this point)
- Amended claims may be accompanied by a statement (Article 19(1), Rule 46.4)
- Normally must be filed within two months from the date of transmittal of the international search report and written opinion of the ISA (Rule 46.1)

Amendments under Article 19 (Rule 46) (2)

- Filed directly with the IB (Rule 46.2)
- Generally used to better define provisional protection, where available
- Published as part of the international application at 18 months, together with the claims as originally filed (Rule 48.2(f))

Amendments under Article 34 (Rules 53.9 and 66.3 to 66.9) (1)

- Description, claims and drawings may be amended in connection with the international preliminary examination under Chapter II
- They should be filed
 - together with the demand for international preliminary examination so that examination will be based on the application as amended (Rule 53.9); or
 - at least before the expiration of the time limit to file a demand (Rule 54*bis*.1(a))
- Attention: amendments need not be taken into account by the examiner if they are received after he has begun to draw up another written opinion or the report (Rule 66.4*bis*)

Amendments under Article 34 (Rules 53.9 and 66.3 to 66.9) (2)

- Amendments shall not go beyond the disclosure of the international application as filed (Article 34(2)(b))
- If an amendment goes beyond the disclosure in the international application as filed, the international preliminary examination report shall be established as if that amendment had not been made, and the report shall so indicate
- The report shall also indicate the reasons why the amendment is considered to go beyond the disclosure in the international application as filed (Rule 70.2(c))

Comparison between types of amendments during international phase

Chapter I (Article 19)

- have effect in all DOs
- claims only
- filed upon receipt of the ISR and written opinion of ISA
- filed directly with IB (not ISA)
- formality examination by IB
- published as part of the international application by IB
- serve as basis for examination by IPEA unless reversed

Chapter II (Article 34)

- have effect in all EOs
- description, claims, drawings
- filed best together with the demand, or during examination by IPEA
- filed directly with IPEA
- formality and substantive examination by IPEA
- are confidential between IPEA and the applicant, are not published during the international phase
- serve as basis for examination by IPEA unless superseded

How to make amendments (Rules 46.5 and 66.8)

- Where claims are amended under Article 19 or 34, they have to be presented in the form of replacement sheets containing a complete set of claims
- Applicants must indicate the basis for the amendments in the application as filed, otherwise the IPRP (Ch.II) may be established as if the amendments had not been made
- In case of cancelation of certain claims, no renumbering of the remaining claims is required
- An accompanying letter explaining what has been amended is required
- Further details: Administrative Instructions Section 205

Replacement sheets for amendments under Article 19

- May not be filed with the receiving Office
- Must be filed directly with the IB preferably using ePCT
- Requests for rectification of obvious mistakes (Rule 91) are to be distinguished from Article 19 amendments and are sent directly to the ISA

Replacement sheets containing amendments under Article 34

- Can be filed in ePCT when preparing the demand
- Otherwise, must be filed directly with the competent IPEA
- Requests for rectification of obvious mistakes (Rule 91) are to be distinguished from Article 34 amendments

Amendments upon entry into the national phase (Articles 28 and 41 and Rules 52 and 78)

- Description, claims and drawings may be amended
- Time limit = normally at least one month from the date of fulfillment of the requirements for entry into the national phase (i.e. not from the time limit under Article 22 or 39(1))
- Any later time limits under the national law apply
- Different amendments possible for different DOs and EOs
- Generally, any claims fee due for the national phase will be calculated on the basis of the number of claims valid at the time of entry into the national phase



Amendments to the PCT Regulations as from 1 July 2017

PCT Rule Changes (1)

■ Amendment to PCT Rules 12*bis*, 23*bis* and 41

□ Transmittal of earlier search and/or classification results by ROs to ISAs

- General Rule: ROs forward the search/classification results from priority applications without the applicant's express permission

- Exception:

- ROs which have notified the IB (before April 14, 2016) of incompatibility of such forwarding with applicable national law are not required to do so
- Even in cases in which an RO in principle applies the procedure above, they may allow applicants to request, at the time of filing of the PCT application, to not have the earlier search results forwarded to the ISA, if the RO notified the IB accordingly (before April 14, 2016)

□ Effective as from 1 July 2017 for applications filed on or after that date

PCT Rule Changes (2)

■ Amendment to PCT Rules 86 and 95

- ❑ Obligation for designated Offices to timely send national phase entry and related data to the IB
- ❑ Data required to be transmitted:
 - Date national phase entered
 - National application number
 - Number and date of national publication
 - Date of grant, and number and date of national publication as granted
- ❑ Time limit for reporting: 2 months from event (or as soon as reasonably possible thereafter)
- ❑ Objective: visibility of the status of PCT application during the national phase on PATENTSCOPE under the “National phase” tab
- ❑ Effective as from 1 July 2017 for applications in respect of which the acts referred to in Article 22 or Article 39 are performed on or after that date