



WIPO | PCT

The International
Patent System



Outline of PCT International Search and Preliminary Examination

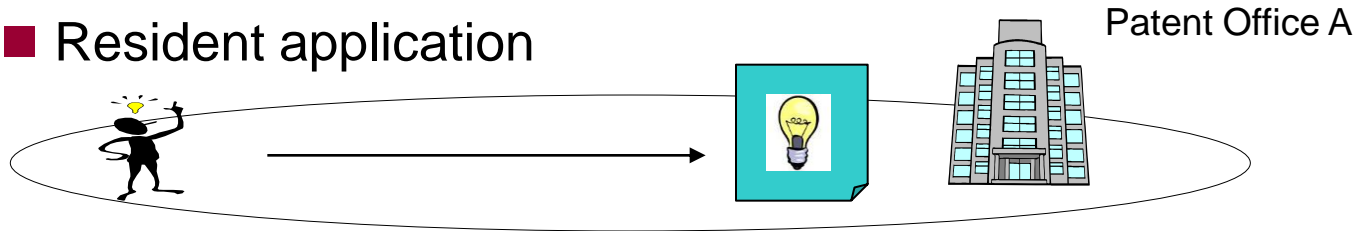
Takashi Yamashita

Director, PCT International Cooperation Division, WIPO

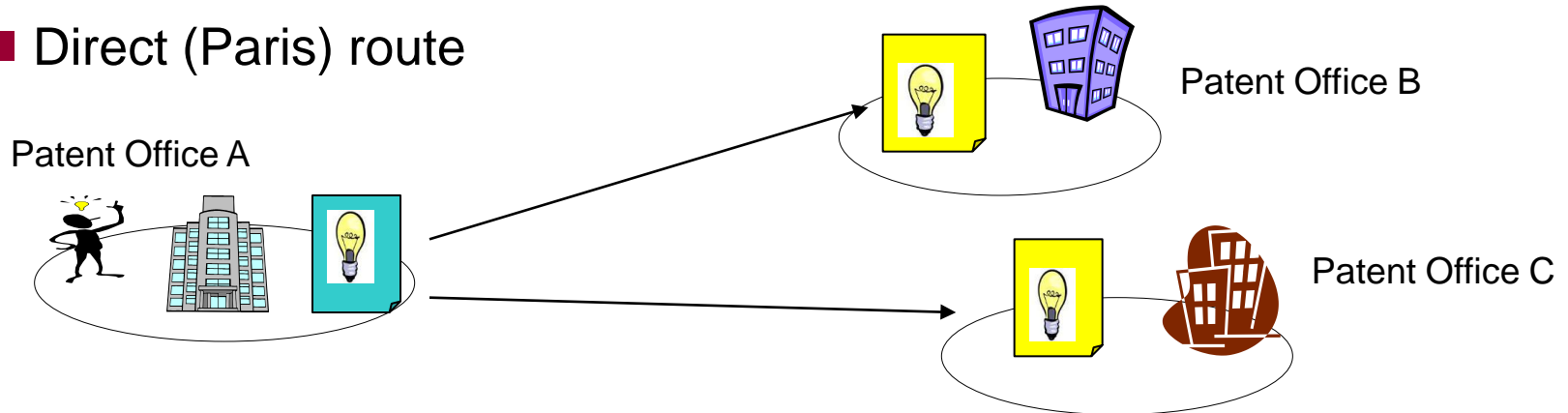
**PCT Workshop Tokyo
February 27-March 1
2013**

Global patenting activities

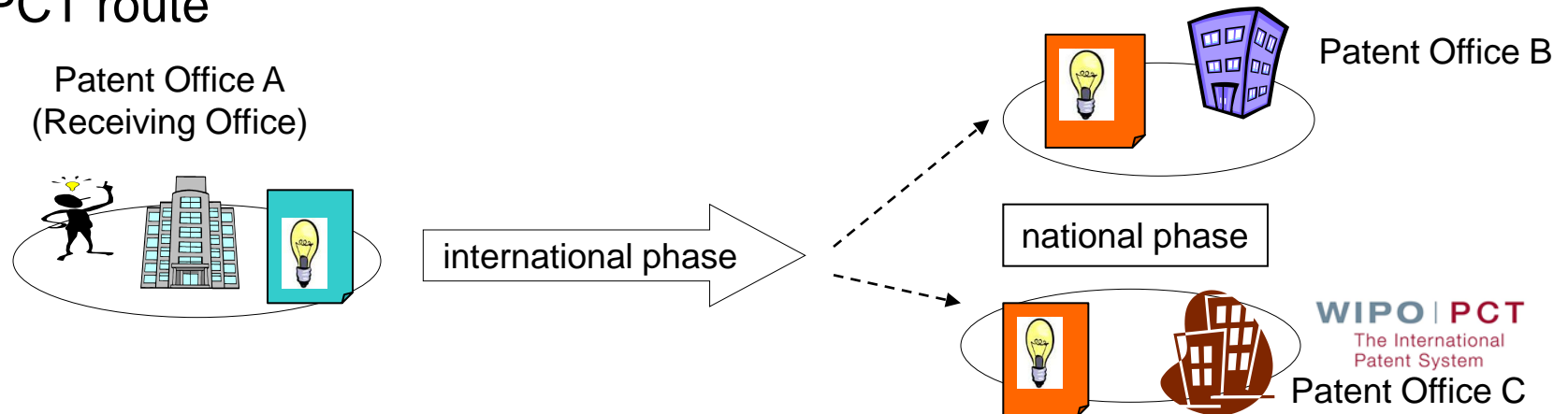
Resident application



Direct (Paris) route

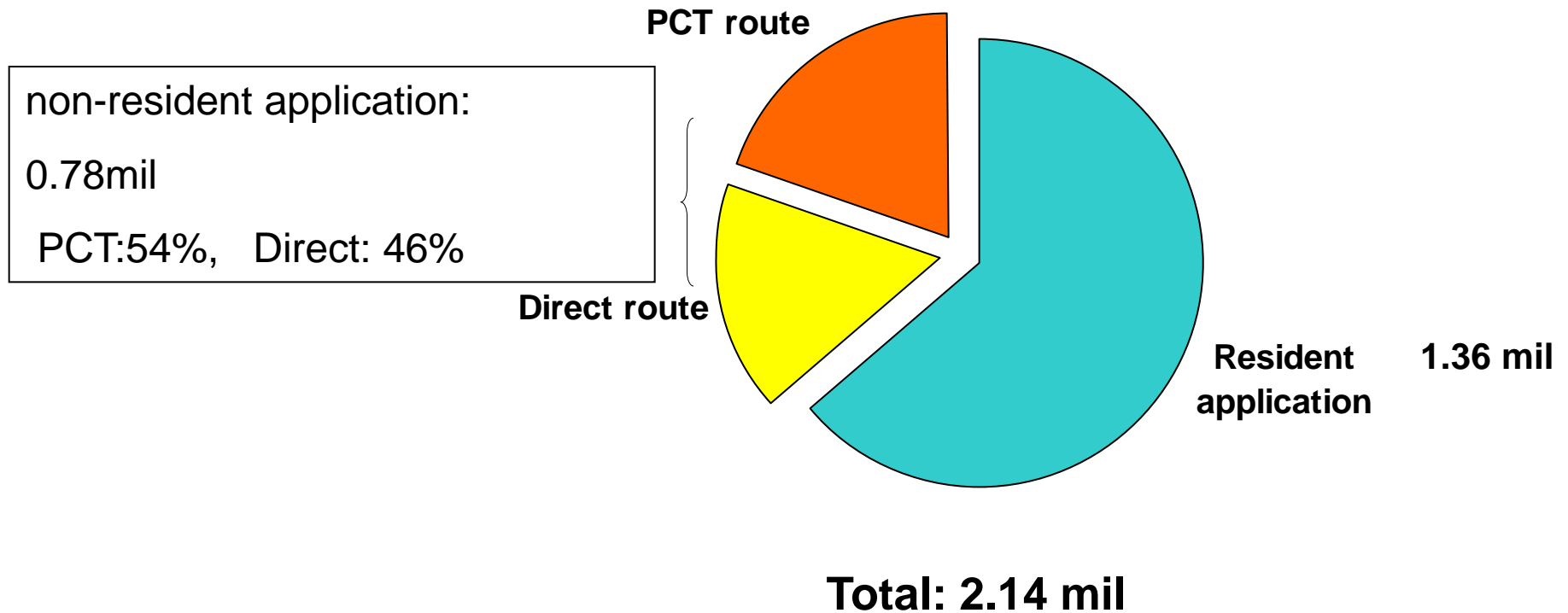


PCT route

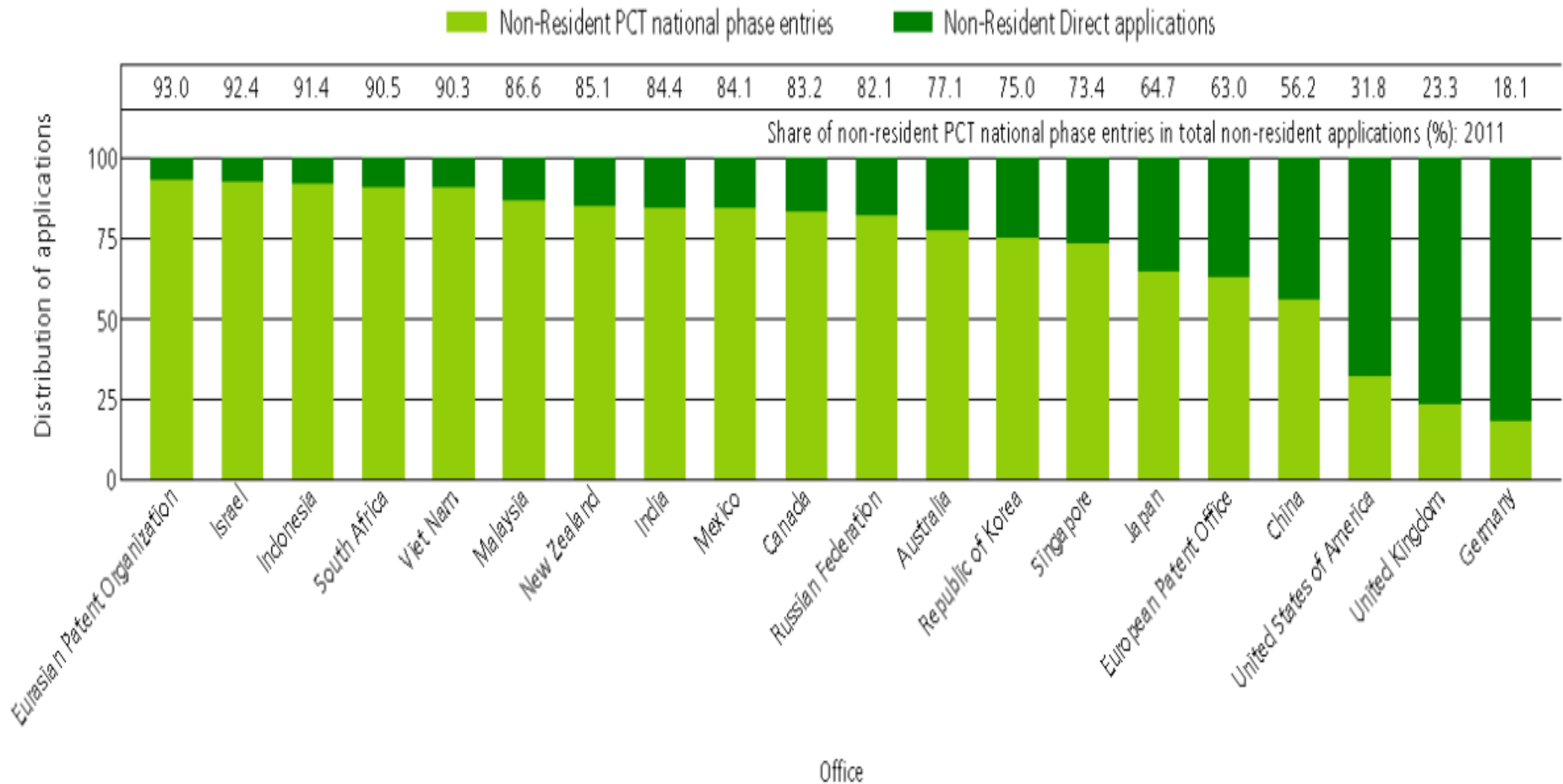


Global patenting activities

Global patent application composition (2011)



Share of PCT non-resident national phase entries in total non-resident applications for selected offices, 2011



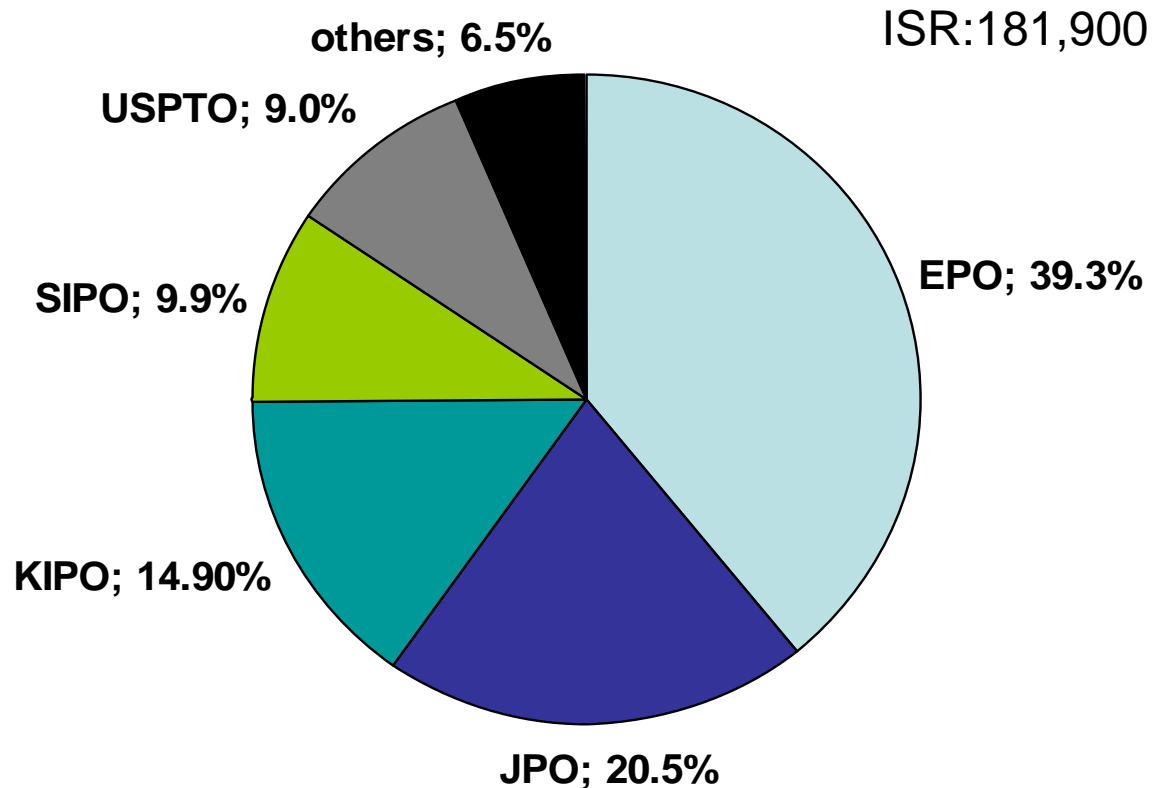
Source: World Intellectual Property Indicators 2012 Fig. A.5.3.3

ISA/IPEA

International Authorities (ISA/IPEAs) are the following 18 Offices
(as of February 2013)

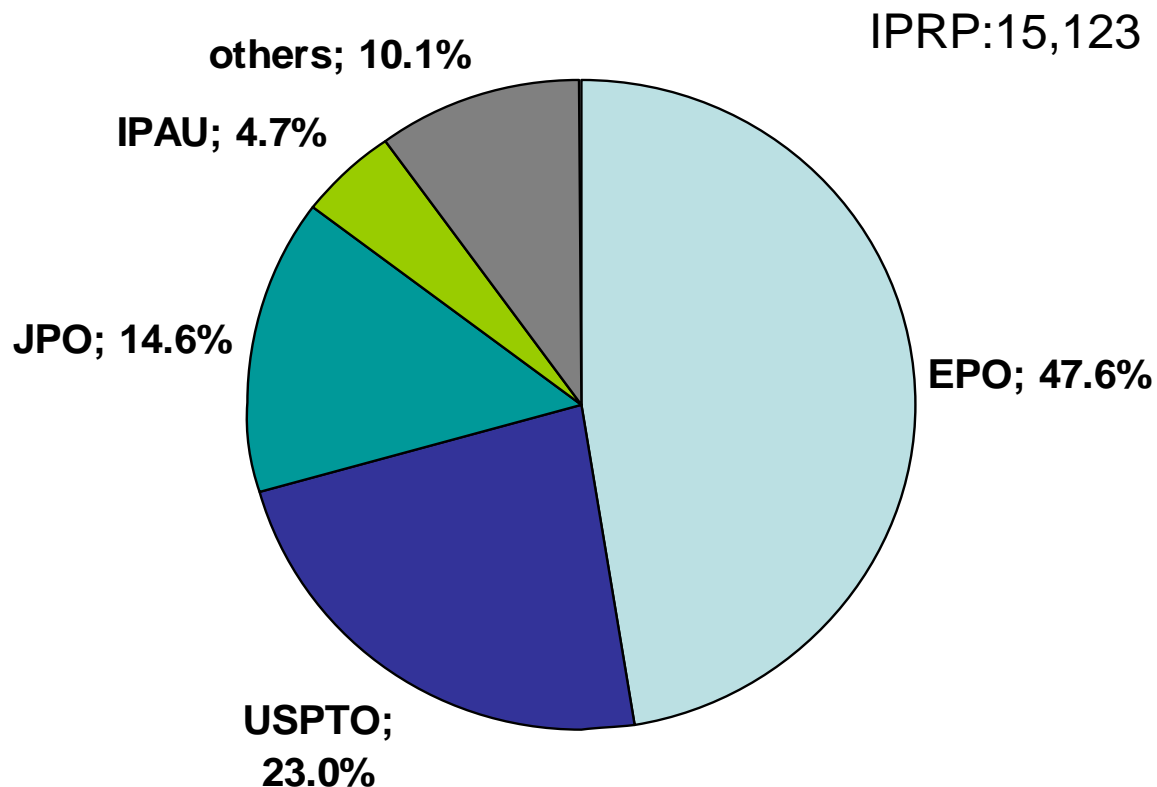
- Australia
- Austria
- Brazil
- Canada
- Chile (not yet operational)
- China
- Egypt (not yet operational)
- Finland
- India (not yet operational)
- Israel
- Japan
- Republic of Korea
- Russian Federation
- Spain
- Sweden
- United States of America
- European Patent Office
- Nordic Patent Institute

Distribution of ISR by ISA (2011)



Source: WIPO PCT Yearly Review 2012 Table B.3.1

Distribution of IPRP by IPEA (2011)



Source: WIPO PCT Yearly Review 2012 Table B.5.1

Examination model for offices with small capacity

	Outsource + Follow-up examination	Full examination
Resident application	Active outsourcing (demand driven) ■ results by donor office	-
Non-resident application	Passive outsourcing ■ PCT ISR, IPRP ■ results by OFF (e.g., PPH)	-

Follow-up examination (if any)

- consider applicant's arguments
- consider amendments
- top-up search

} Final own decision !

Examination model for offices with sufficient capacity

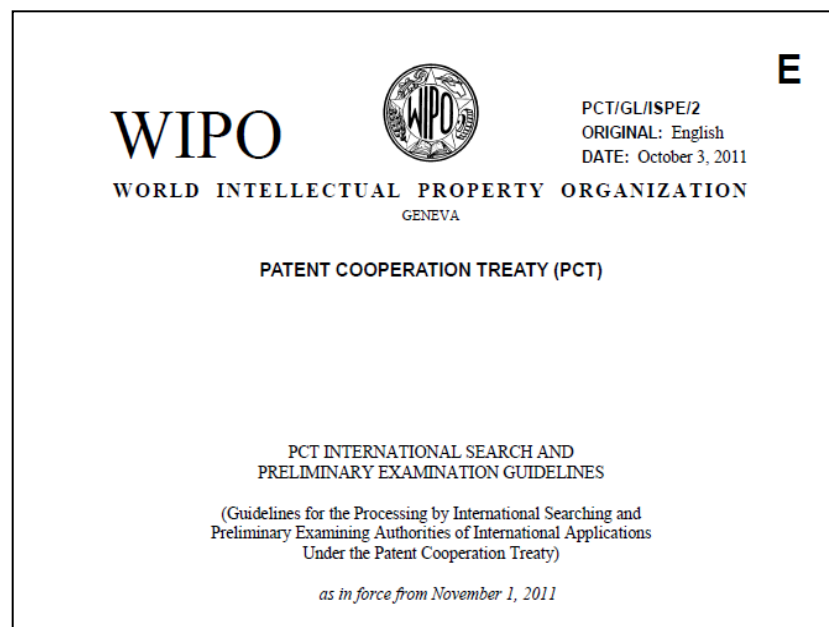
	Outsource + Follow-up examination	Full examination
Resident application	-	yes
Non-resident application	Passive outsourcing <ul style="list-style-type: none"> ■ PCT ISR, IPRP ■ results by OFF (e.g., PPH) 	yes/no, depending on quality and trust for previous results

Objectives of the workshop

- How national office examiner should utilize the international search and preliminary examination reports effectively
 - for this purpose, it is important to understand;
 - how ISA/IPEA establish the reports
 - how to read the reports
 - how to conduct follow-up national examination to reach its own final decision
- These objectives is expected to be applied to national examination through other outsourcing model

Guidelines

- PCT International Search and Preliminary Examination Guidelines (ISPE)
- Guidelines for the processing international applications by ISA/IPEA
- PCT/GL/ISPE/2 (effective as from November 1, 2011)
- PCT/GL/ISPE/2 Add (effective as from July 1, 2012)
- <http://www.wipo.int/pct/en/texts/gdlines.html>



Guidelines

■ Purpose and status of ISPE

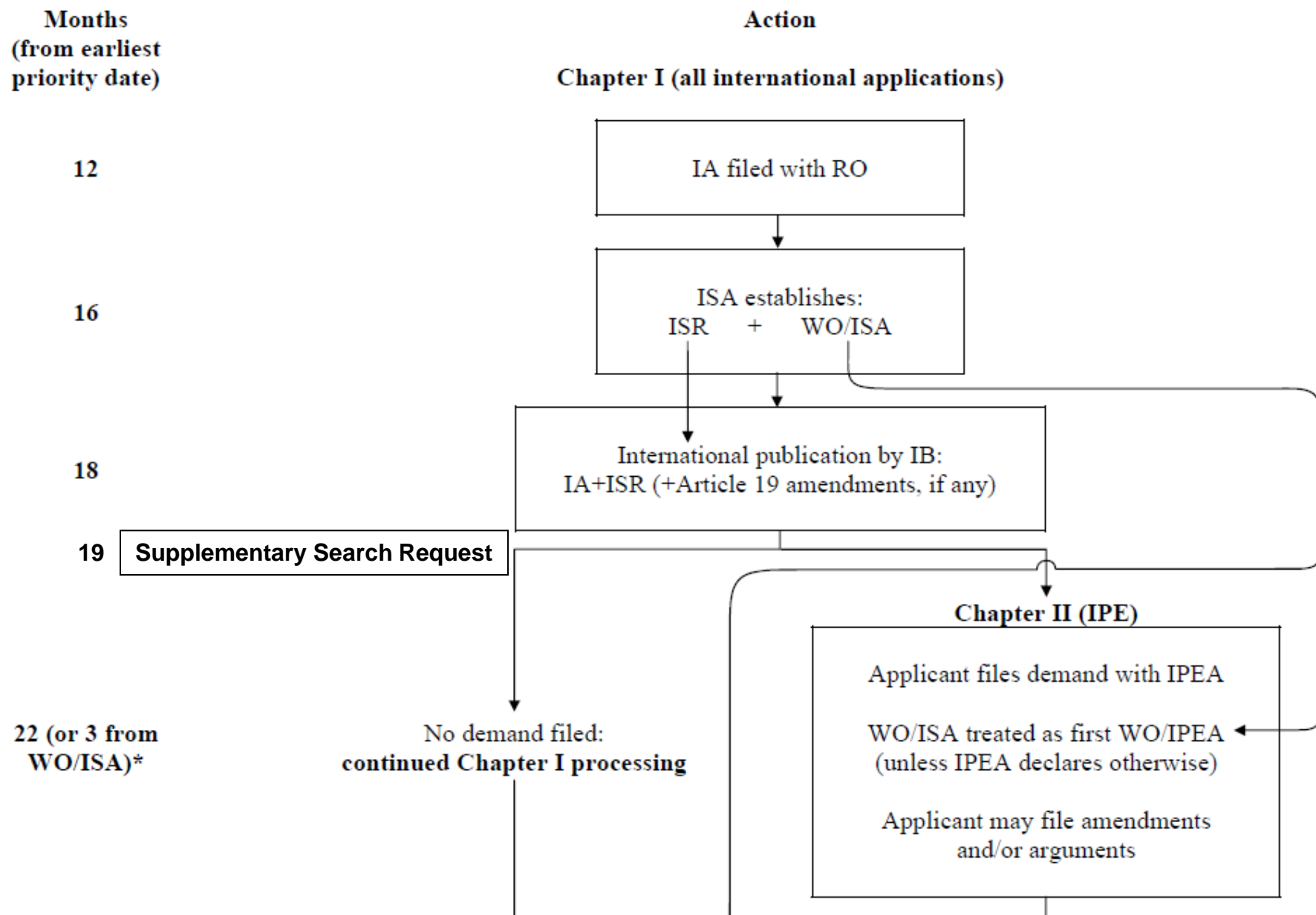
- Guidelines to be followed by ISA/IPEA at IS/IPE stage
- primarily addressed to examiners in ISA/IPEA
- will also be useful for applicants and practitioners
- established by IB after consultation with ISA/IPEA
- do not have the binding authority of a legal text
- Any Contracting State may apply additional or different criteria for deciding patentability at the national stage.
- Although ISPE deals with international application, it may be used *mutatis mutandis* by national Offices in dealing with national applications if the national law so permits.

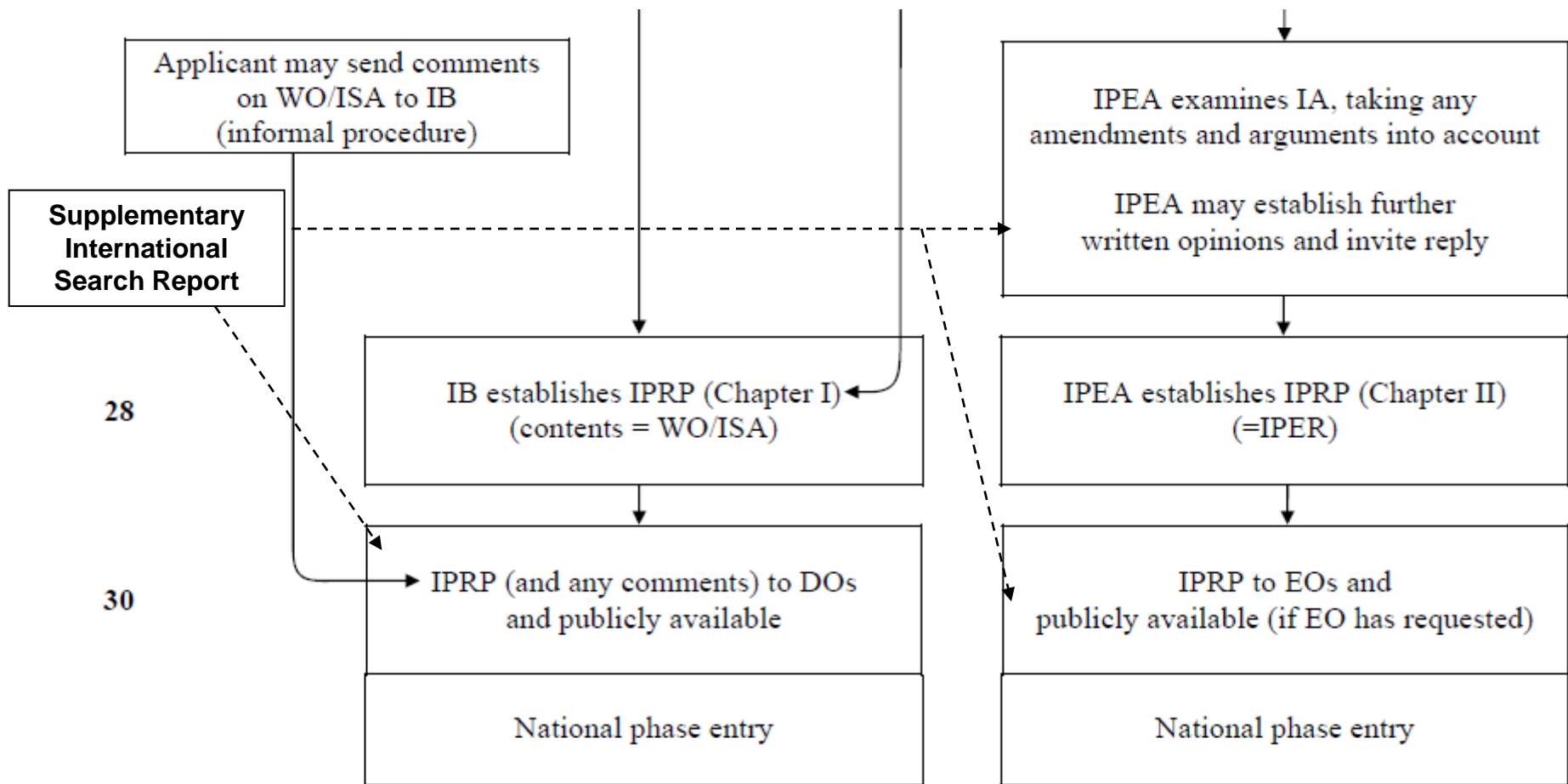
Guidelines

■ Contents

- Part I: Introduction and overview
- Part II: The international application
- Part III: Examiner considerations common to both the international searching authority and the international preliminary examining authority
- Part IV: The international search
- Part V: Written opinion/International preliminary examination report
- Part VI: The international preliminary examination stage (other than the international preliminary report)
- Part VII: Quality
- Part VIII: Clerical and administrative procedures

Flowchart of Typical International Application Processing





*Demand must be filed by 19 months for A22 transitional reservation countries (Luxembourg, Uganda, Tanzania)

Overview of IS stage

Objectives

- discover “relevant prior art” for determining whether the claimed invention is novel or involves an inventive step (A15(2),R33.1(a))
- “relevant prior art” is;
 - everything which has been made available to the public anywhere in the world by means of written disclosure
 - useful in determining that the claimed invention is or is not new and that it does or does not involve an inventive step
 - made available to the public prior to the international filing date
- IS is not required where (III-9,10):
 - scope of the claims is too uncertain
 - application covers excluded subject matter
 - more than one invention is claimed

IS process

- determine classification (R43.3,II-7)
- consider unity of invention and whether to invite applicant to pay additional search fee if applicable (A17(3),R40,III-10)
- consider whether the subject matter relates to what the Authority is not required to search (A17(2),R39,III-9)
- consider whether there are any obvious errors or matter contrary to public order (R9,91,IV-15)
- determine whether to use the results of any earlier search and to consequently authorize any appropriate refund (R16.3,41)
- determine whether to invite applicant to provide a sequence listing in compliance with Administrative Instructions Annex C standard (R13ter.1,IV-15)
- perform IS to discover relevant prior art (A15,17(2),IV)

IS process (cont)

- consider whether title and abstract are appropriate and, if not, draft alternatives, also select any figure accompanying the abstract (R8.2,37,38,IV-16)
- establish ISR, or make a declaration that a search was either not required or would not be meaningful (A17(2),R43,III-9,IV-16)
 - ISR or declaration are translated into English (A18(3),R45)
- establish WO/ISA as to whether the international application is novel, involves inventive step, and is industrially applicable (R43bis,V-17)
 - IPE process applies *mutatis mutandis* (R43bis.1(b))
- Some of the above matters, especially unity of invention, may be the subject of ongoing consideration, depending on the outcome of the search. Nevertheless it is important to consider matters at an early stage in view of the limited time available to obtain corrections or additional fees from applicant.

Required skill

- able to understand the invention
- knowledge for the technological field covering the invention
 - technological trend
 - well known art in the field
- search skill
 - use search tool
 - build search strategy
 - find out search/examination results of family applications
- able to evaluate the prior art
 - comparative analysis between claimed subject matter and prior art
- others?

Overview of IPE stage

Objectives

- IPE is optional, when applicant files a “demand”
- to formulate a preliminary and non-binding opinion of novelty, inventive step, and industrial applicability
- secondarily to identify any defects in the form or contents of international application (e.g., clarity)
- “election” indicates an intention to use IPE in the relevant States
 - by default all States are supposed to be “elected” (R53.7)

IPE process

- consider unity of invention and whether to invite applicant to restrict claims or pay additional search fee if applicable (A34(3)(a),R68,III-10)
- consider whether the subject matter relates to what the Authority is not required to examine (A34(4),R67,III-9)
- consider whether A19 or A34 amendments go beyond the disclosure of international application as filed (A19(2),34(2)(b),R70.2(c),VI-20)
- consider whether to need to obtain from IB a priority document, or to invite applicant to furnish its translation (R66.7,VI-18)
- determine whether to invite applicant to provide a sequence listing in compliance with the Administrative Instruction standard (R13ter.2,VI-18)
- consider any arguments or amendments by applicant in response to WO/ISA and issue additional WO/IPEA if necessary (R66.4,VI-19)
 - If IPEA does not recognize WO/ISA as its first WO/IPEA, it will issue its first WO/IPEA (R66.1bis(b),66.2,V-17)
- establish IPER as to whether the international application is novel, involves inventive step, and is industrially applicable (A35,R70,V-17)

Required skill

- able to understand the invention
- able to evaluate the prior art
 - comparative analysis between claimed subject matter and prior art
- able to analyze novelty and inventive step
 - convincing story on how a person skilled in the art would arrive at a claimed invention based on prior arts and well known arts
- able to write down opinion clearly and concisely understandable to relevant parties
- others?

National stage examination

Basis of national stage examination

- International application, ISR/declaration, A19 amendments, as published (A20,R47,76.5(i),87,93bis)
- English translation of ISR/declaration (R45,47.1(d),76.5(i))
- IPRP (Chap. I or II) and annexes (A36(3)(a),R44bis.2,73.2(a))
- English translation of IPRP (Chap. I or II) (A36(2),R44bis.3,72.1)

- These documents can be obtained through:
 - DVD delivered periodically by IB via postal services
 - PADOS
 - PATENTSCOPE web-services
 - PATENTSCOPE web-site

Basis of national stage examination (cont)

- translation of international application as applicable: by applicant (A22(1),39(1)(a),R49.1(a)(i))
- translation of A19 amendments as required: by applicant (R49.5(a)(ii),(c-bis),76.5(iv))
- translation of annexes to IPER: by applicant (A36(3)(b),R70.16,74.1)
- priority document on request: by IB (R17.2(a))
- translation of priority document as applicable: by applicant (R17.2(a),51bis(e),76.4,76.5)
- copies of citation documents on request: by ISA/IPEA (A20(3),36(4),R44.3,71.2), or applicant if applicable
- any amendments on claims, description, or drawing which have been made after entering into national stage (A28,41,R52,78)

Process of national stage examination

- Similar as IPE process except for being examined based on **the national law**

- consider unity of invention (III-10)
- consider whether there are any subject matter national office is not required to examine (III-9)
- consider whether any amendments effective in national stage go beyond the disclosure of international application as filed (VI-20)
- examine novelty/inventive step/ industrial applicability or written requirements (sufficiency, support) (II-4,5,III-12-14)
 - utilize search results or logic in IPRP
 - take into account arguments during international stage, e.g., informal comments by applicant on WO/ISA, any arguments during IPE, third party observation
 - top-up search and examination

Further search and examination

- top-up search and examination
 - if amendments or arguments during international stage were not considered in IPER (R66.4bis)
 - if amendments during national stage add any features which necessitate additional search and examination (A28,41,R52,78)
 - to search earlier filed (or prioritized) but later published application (international application or national/regional application) which were not searched by ISA/IPEA
 - to search for avoiding double patenting, if applicable

Further search and examination (cont)

- find and utilize earlier national/regional examination results
- Example
 - find out patent family, using Espacenet
 - click on “EP register” to view file wrapper information at EP regional stage
 - enter US publication number into US-PAIR to view file wrapper at US national stage
 - enter JP publication number into AIPN (Office use) to view file wrapper at JP national stage
 - enter either US/EP/JP publication number into trilateral Common Citation Document (CCD) site to get patent family information as well as citation documents
- Espacenet:
http://worldwide.espacenet.com/numberSearch?locale=en_EP
- US-PAIR: <http://portal.uspto.gov/external/portal/pair>
- CCD: <http://ccd.trilateral.net/20120503/>

Required skill

- able to understand the invention
- able to retrieve and evaluate the prior art in the ISR, WO, or IPER
- able to understand the logic described in the WO or IPER
- able to determine whether to write opinion based on IPRP or change logic or conduct top-up search/examination
- able to find out search/examination results of family applications
- others?

Thank you !