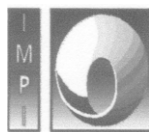


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MEXICAN INSTITUTE OF
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WORLD INTELLECTUAL
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INSTITUTE OF TECHNOLOGY AND
SUPERIOR STUDIES OF MONTERREY

**INTERNATIONAL WORKSHOP ON
MANAGEMENT AND COMMERCIALIZATION OF INVENTIONS
AND TECHNOLOGY**

organized by
the World Intellectual Property Organization (WIPO)
in cooperation with
the Mexican Institute of Industrial Property (IMPI)
and
the Institute of Technology and Superior Studies of Monterrey (ITESM)
Monterrey (Mexico), April 17 to 19, 2002

**THE PATENT COOPERATION TREATY (PCT) AS A STRATEGY FOR FILING
FOREIGN APPLICATIONS**

Document prepared by the International Bureau of WIPO

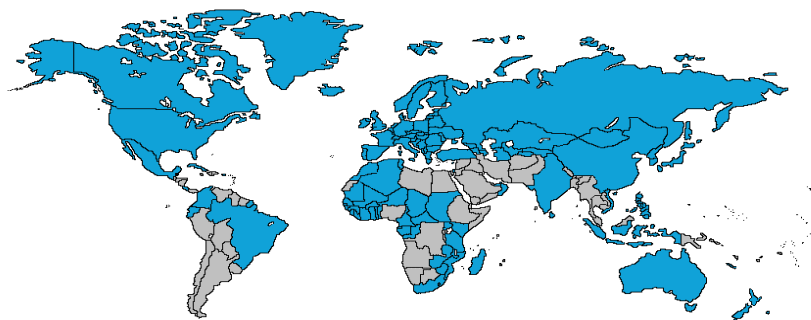


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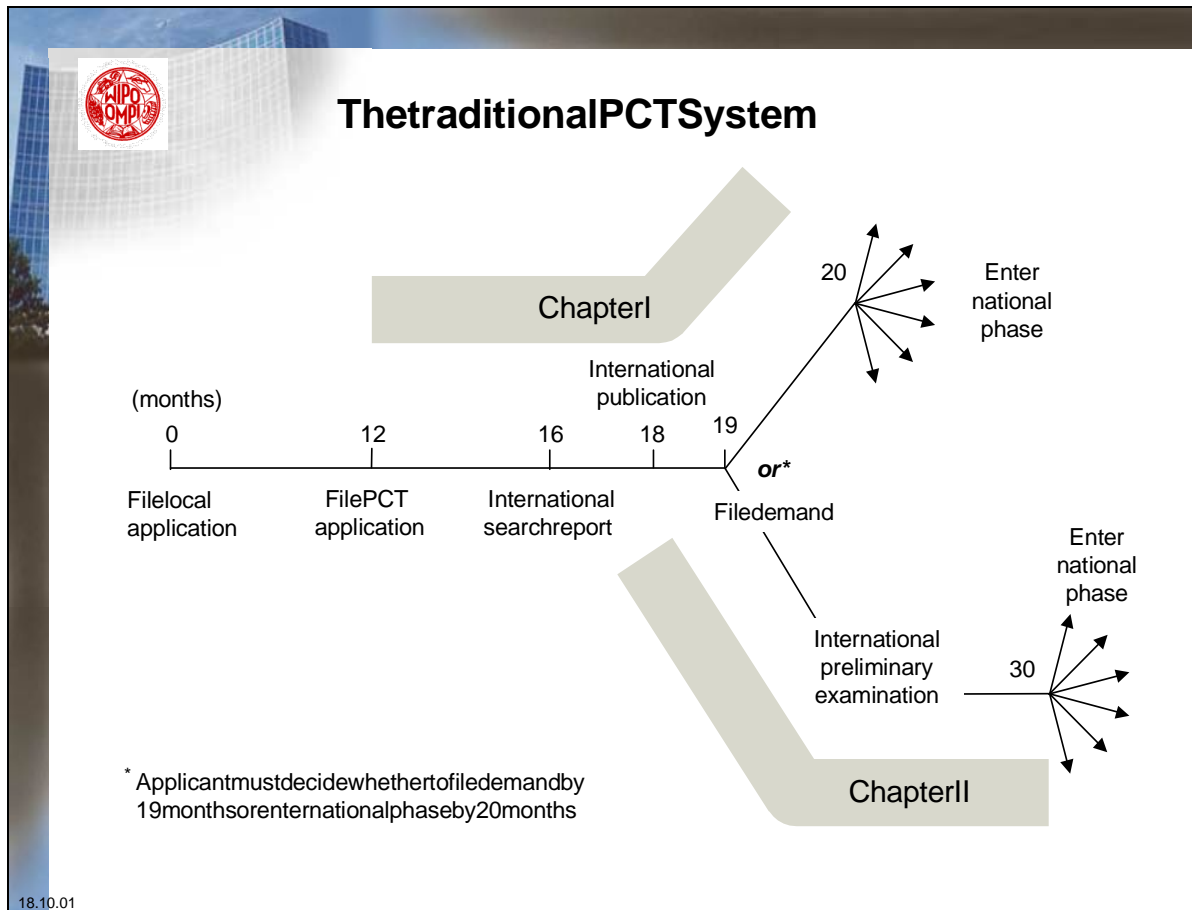
- I. Introduction of the PCT system:
 - A. The traditional system
 - B. General remarks
 - C. The new system
 - D. Transitional provisions
 - E. Practical cases
- II. The PCT as a strategic tool
- III. Advantages of filing national application first (Timeline A)
- IV. Advantages of filing PCT application first (Timeline B)
- V. Conclusion




The PCT world (115 Contracting States on December 31, 2001)



Albania	Chad	Gabon	Latvia	Philippines	Tajikistan
Algeria	China	Gambia	Lesotho	Poland	The former Yugoslav
Antigua and Barbuda	Colombia	Georgia	Liberia	Portugal	Republic of Macedonia
Armenia	Congo	Germany	Liechtenstein	Republic of Korea	Togo
Australia	Costa Rica	Ghana	Lithuania	Republic of Moldova	Trinidad and Tobago
Austria	Côte d'Ivoire	Greece	Luxembourg	Romania	Tunisia (Dec. 10, 2001)
Azerbaijan	Croatia	Grenada	Madagascar	Russian Federation	Turkey
Barbados	Cuba	Guinea	Malawi	Saint Lucia	Turkmenistan
Belarus	Cyprus	Guinea-Bissau	Mali	Senegal	Uganda
Belgium	Czech Republic	Hungary	Mauritania	Sierra Leone	Ukraine
Belize	Democratic People's	Iceland	Mexico	Singapore	United Arab Emirates
Benin	Republic of Korea	India	Monaco	Slovakia	United Kingdom
Bosnia and Herzegovina	Denmark	Indonesia	Mongolia	Slovenia	United States of America
Brazil	Dominica	Ireland	Morocco	South Africa	Uzbekistan
Bulgaria	Ecuador	Israel	Mozambique	Spain	Viet Nam
Burkina Faso	Equatorial Guinea	Italy	Netherlands	Sri Lanka	Yugoslavia
Cameroon	Estonia	Japan	New Zealand	Sudan	Zambia (Nov. 15, 2001)
Canada	Finland	Kazakhstan	Niger	Swaziland	Zimbabwe
Central African Republic	France	Kenya	Norway	Sweden	
		Kyrgyzstan	Oman (Oct. 26, 2001)	Switzerland	



 **General remarks on the PCT system**

1. The PCT system is a patent “filing” system, not a patent “granting” system. There is no “PCT patent”.
2. The PCT system provides for
 - an international phase comprising:
 - * filing of the international application
 - * international search
 - * international publication and
 - * international preliminary examination
 - a national/regional phase before designated Offices
3. The decision on granting patents is taken exclusively by national or regional Offices in the national phase.



MODIFICATION APPROVED BY THE PCT ASSEMBLY

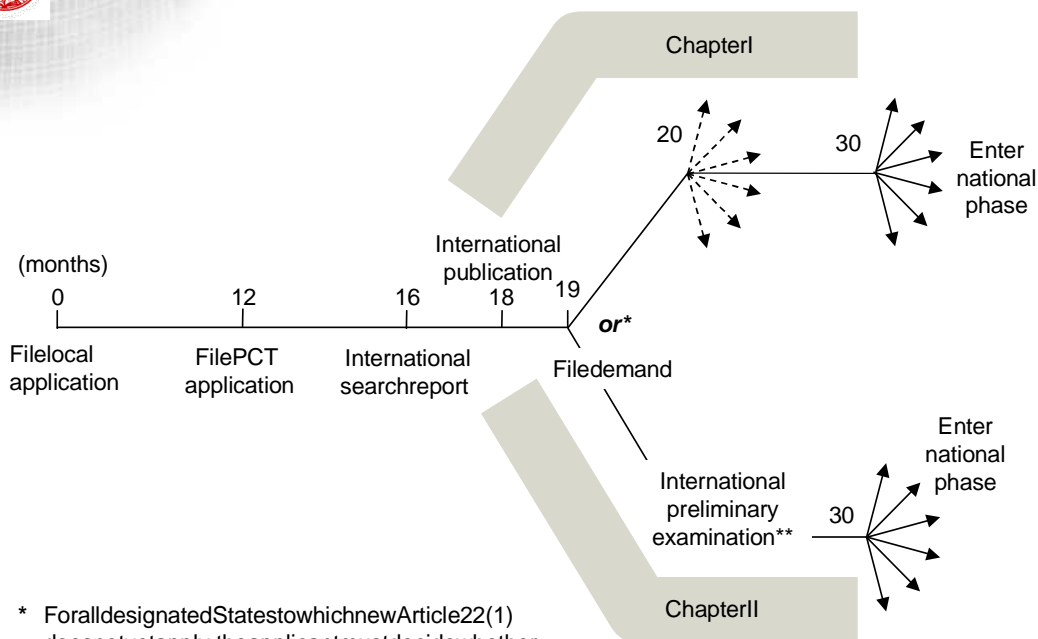
Article 22

Copy, Translation, and Fee, to Designated Offices

(1) The applicant shall furnish a copy of the international application (unless the communication provided for in Article 20 has already taken place) and a translation thereof (as prescribed), and pay the national fee (if any), to each designated Office not later than at the expiration of **(20) 30** months from the priority date. Where the national law of the designated State requires the indication of the name of and other prescribed data concerning the inventor but allows that these indications be furnished at a time later than that of the filing of a national application, the applicant shall, unless they were contained in the request, furnish the said indications to the national Office for acting for the State not later than at the expiration of **(20) 30** months from the priority date.



The new PCT System (as of 1 April 2002)



* For all designated States to which new Article 22(1) does not yet apply, the applicant must decide whether to file a demand by 19 months or enter the national phase by 20 months

** If the applicant wants to receive an international preliminary examination report, he must file a demand



TRANSITIONAL PROVISIONS

I. The modifications of the time limits fixed in Article 22(1) shall, subject to paragraphs (2) and (3), enter into force on April 1, 2002. The modifications shall apply, so far as any designated Office is concerned, to any international application in respect of which the period of 20 months from the priority date expires on or after the date on which the modifications enter into force in respect of that Office and in respect of which the acts *referred to in Article 22(1) have not yet been performed by the applicant .

*Not later than at the expiration of 20 months from the priority date, the applicant has the legal obligation before each designated Office of:

(I) paying the national fee (if any); and

(II) furnishing:

(i) a copy of the international application if the communication provided for in Article 20 has NOT already taken place;

(ii) a translation thereof (as prescribed);

(iii) the indications of the name of and other prescribed data concerning the inventor where the national law of the designated State requires such indications, unless they were contained in the request.



TRANSITIONAL PROVISIONS

II. If, on October 3, 2001, any such modification is not compatible with the national law applied by a designated Office, it shall not apply in respect of that Office for as long as it continues not to be compatible with that law, provided that the said Office notifies the International Bureau accordingly by January 31, 2002. *The notification shall be promptly published by the International Bureau in the Gazette.

* 24 countries made use of this reservation: Australia (AU), Bulgaria (BG), Brazil (BR), Switzerland (CH), China (CN), Denmark (DK), Estonia (EE), Finland (FI), United Kingdom (GB), Croatia (HR), Hungary (HU), Israel (IL), Japan (JP), Republic of Korea (KR), Luxembourg (LU), Norway (NO), Sweden (SE), Singapore (SG), Slovakia (SK), United Republic of Tanzania (TZ), Uganda (UG), Yugoslavia (YU), South Africa (ZA) and Zambia (ZM). Out of the 24 member states which have expressed reservations, it is worth noting that 6 are EPO members (UK, Sweden, Denmark, Finland, Luxembourg and Switzerland) and 4 are future EPO members, as from July 2002 (Bulgaria, Estonia, Hungary, Slovakia). This is of particular importance since applicants who choose to use the euro - PCT route can, in any case, make use of the allowed 31 months from the priority date before entering the European phase and designate these countries accordingly.



TRANSITIONAL PROVISIONS

III. Any notifications sent to the International Bureau under paragraph (2) may be withdrawn at any time. Such withdrawal shall be promptly published by the International Bureau in the Gazette and the modifications shall enter into force two months after the date of such publication or on such earlier or later date as may be indicated in the notice of withdrawal.

IV. It is recommended that any Contracting State whose national law is not compatible with the modification stake urgent action to amend its law to make it compatible so that a notification does not have to be given under paragraph (2) or, if such a notification must be given, so that it can be withdrawn under paragraph (3) as soon as possible thereafter .



TRANSITIONAL PROVISIONS

PRACTICAL CASES

1. An application with a priority date from JULY 15, 2000. The period of 20 months from the priority date expires on March 15, 2002. The result would be that the modifications of the time limits **DONOT APPLY**, regardless of whether or not the applicant has performed the acts referred to in Article 22(1).
2. An application with a priority date from AUGUST 15, 2000. The period of 20 months from the priority date expires on April 15, 2002. The result would be that the modifications of the time limits **DO APPLY** for those designated Offices without reservation if the applicant has not yet performed the acts referred to in Article 22(1). Regarding those designated Offices with reservation the modifications of the time limits **DONOT APPLY**, and therefore, the applicant will still need to file a demand before the expiration of 19 months from the priority date.
3. An application with a priority date from AUGUST 30, 2000. The period of 20 months from the priority date expires on April 30, 2002. The applicant has performed the acts referred to in Article 22(1) in respect of one designated Office. The result would be that the modifications of the time limits **DONOT APPLY** for that designated Office and those designated Offices which have made a reservation but **DO APPLY** for the remaining designated Offices which have not made a reservation.



The PCT as a strategic tool (I)

- Early or late filing in the priority year.
- Designation of all States which may be of interest.
- Payment of 5 designation fees – and designation of all countries of possible interest – even if only 4 or 5 patents desired at the time of filing.
- Division of countries into groups according to type and importance of the invention facilitates decision about designation to be made.
- In industry, patent department takes provisional decision on group of countries to be designated.
- Final decision by management or client need to be made only prior to entry into the national phase.
- Filing of a demand for international preliminary examination in all cases or only if the international search report is positive.
- 8 or 18 months more time during which improved translations can be prepared for entry into the national phase.



The PCT as a strategic tool (II)

- Gain time to
better identify possible markets;
find partners (licenses); and
better evaluate the technical value of the invention.
- Increased chance for obtaining stronger foreign patents.
- The final version of the claims is drafted when the commercial value of the invention is better known.
- Early entry into the national phase – early issuance of patent.
- Better information about possible conflicting applications by competitors prior to national entry, enabling adjustment of filing strategy and negotiating position.
- International publication informs third parties about designated States in which protection is sought.



Advantages of filing national application first (Timeline A)

1. Deferring PCT filing costs by one year.
2. Patent term in most countries begins with filing date (that is, PCT filing date) not with priority date.
3. More time to evaluate merit of invention before incurring foreign filing expenses.
4. Reports on search and examination of national application may be available before PCT filing.
5. Application can be redrafted before PCT filing to include improvements and discovered features and examples.
6. Additional countries may become bound by the PCT before PCT filing.



Advantages of filing PCT application first (Timeline B)

1. All filings for PCT countries including the national application done at one time, in one application.
2. International search report received earlier (within 9 months from the filing date), i.e.
 - before designation fees are due;
 - before direct Paris Convention filings in non-PCT countries;
 - leaving option of withdrawing the international application before the 18-month publication.
3. If demand is filed early international preliminary examination can start early, thereby allowing more time before issuance of the report at 28 months from priority date.
4. Concurrent domestic and foreign prosecution, less chance of later discovered prior art.



CONCLUSION

The PCT route offers substantial flexibility if proper use is made of its numerous options

THANK YOU VERY MUCH FOR YOUR ATTENTION

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