



MEUNIER CARLIN & CURFMAN LLC

INTELLECTUAL PROPERTY LAW



PCT PRACTICE

A USER'S PERSPECTIVE

P R E S E N T E D T O :

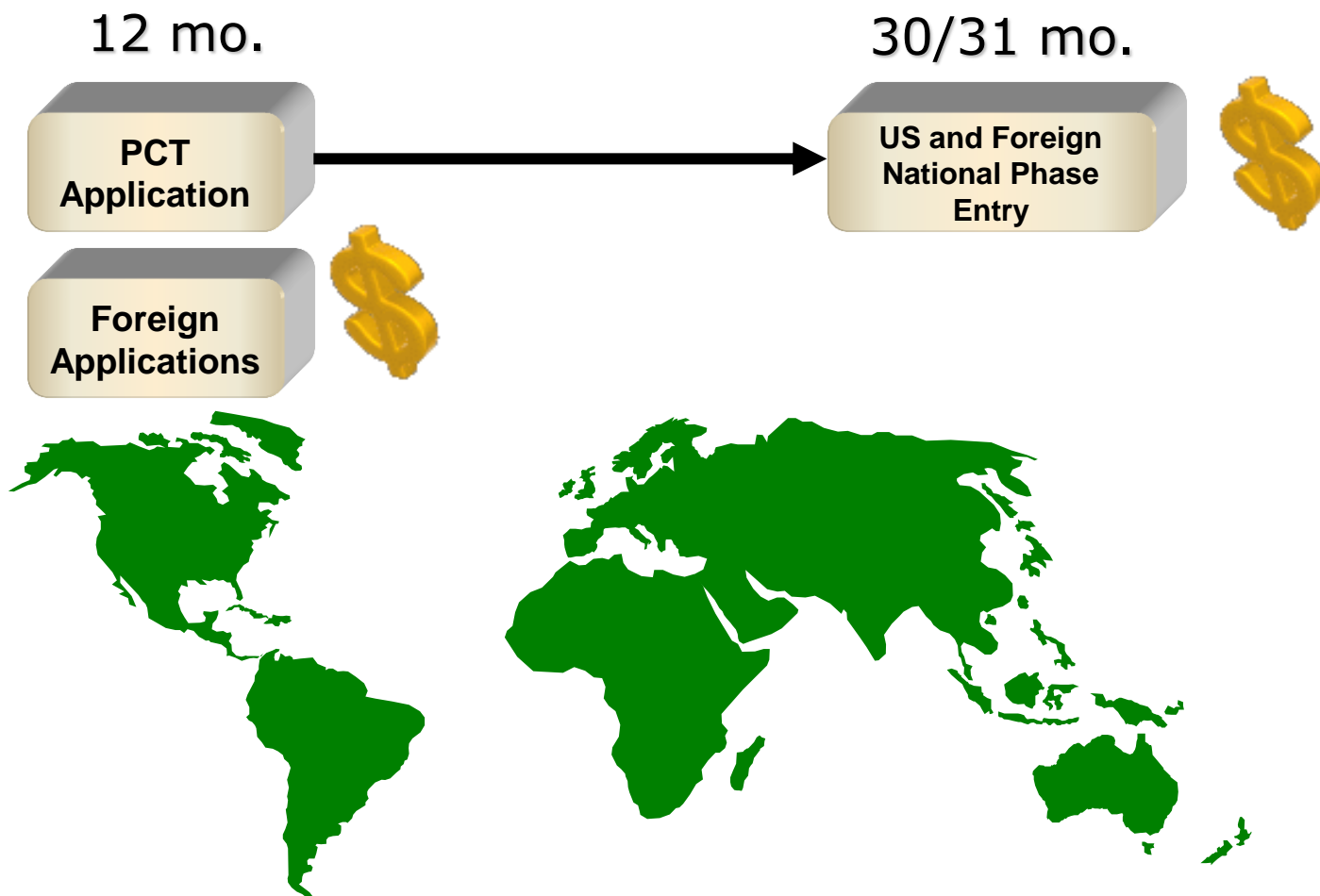
COMPANY

DATE

"Value Without Compromise"



BENEFITS OF PCT



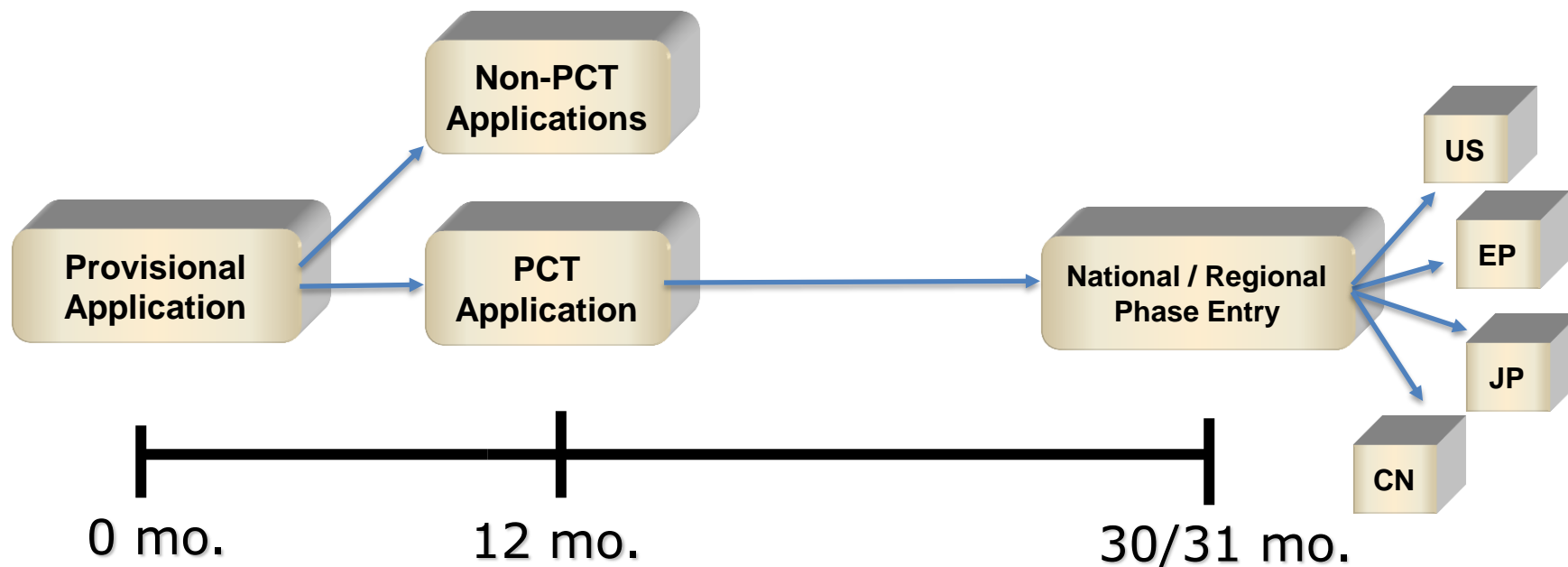


BENEFITS OF PCT

- Time to evaluate value of invention
- Time to evaluate where to protect the invention
- Provides search and written opinion to evaluate patentability
- Provides different filing strategies
- Permits use of Patent Prosecution Highway



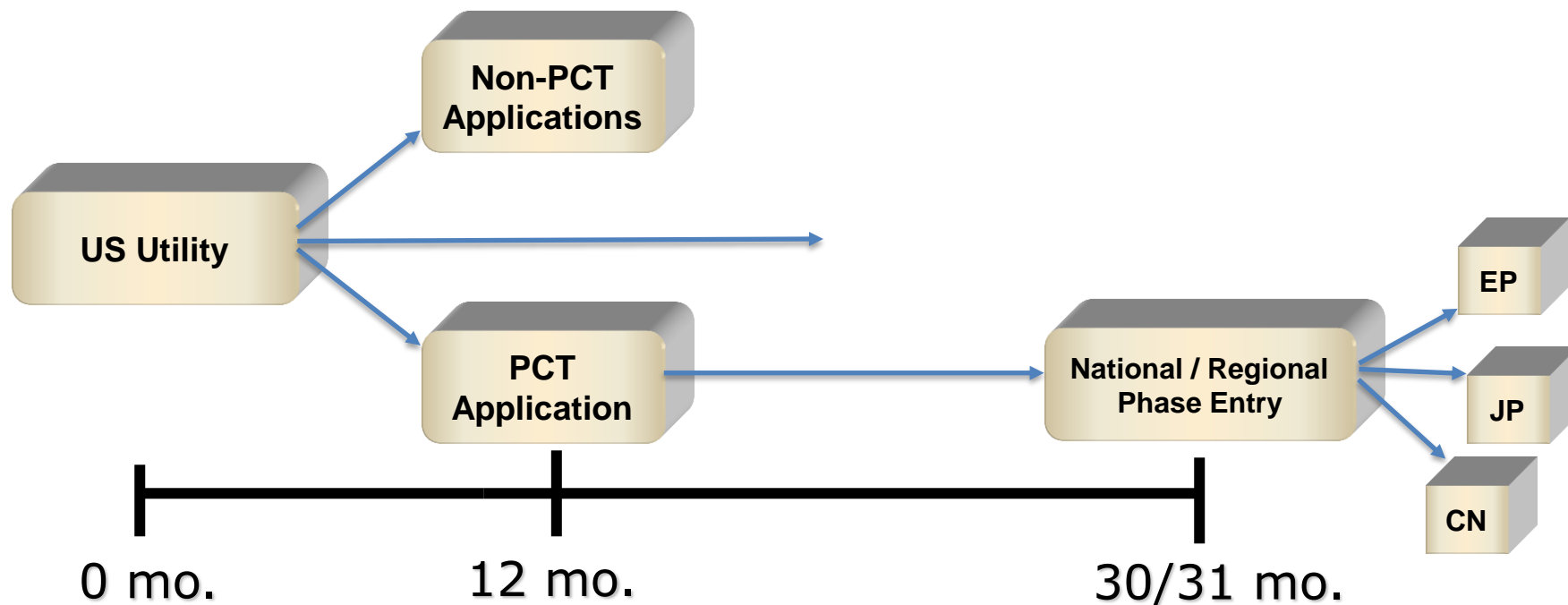
STRATEGIES FOR USING PCT



- Low up-front cost (provisional)
- Search results can inform decision to file in US and elsewhere
- Delays US prosecution
- PCT can have many claims and multiple dependent claims for support
- All patents expire at same time



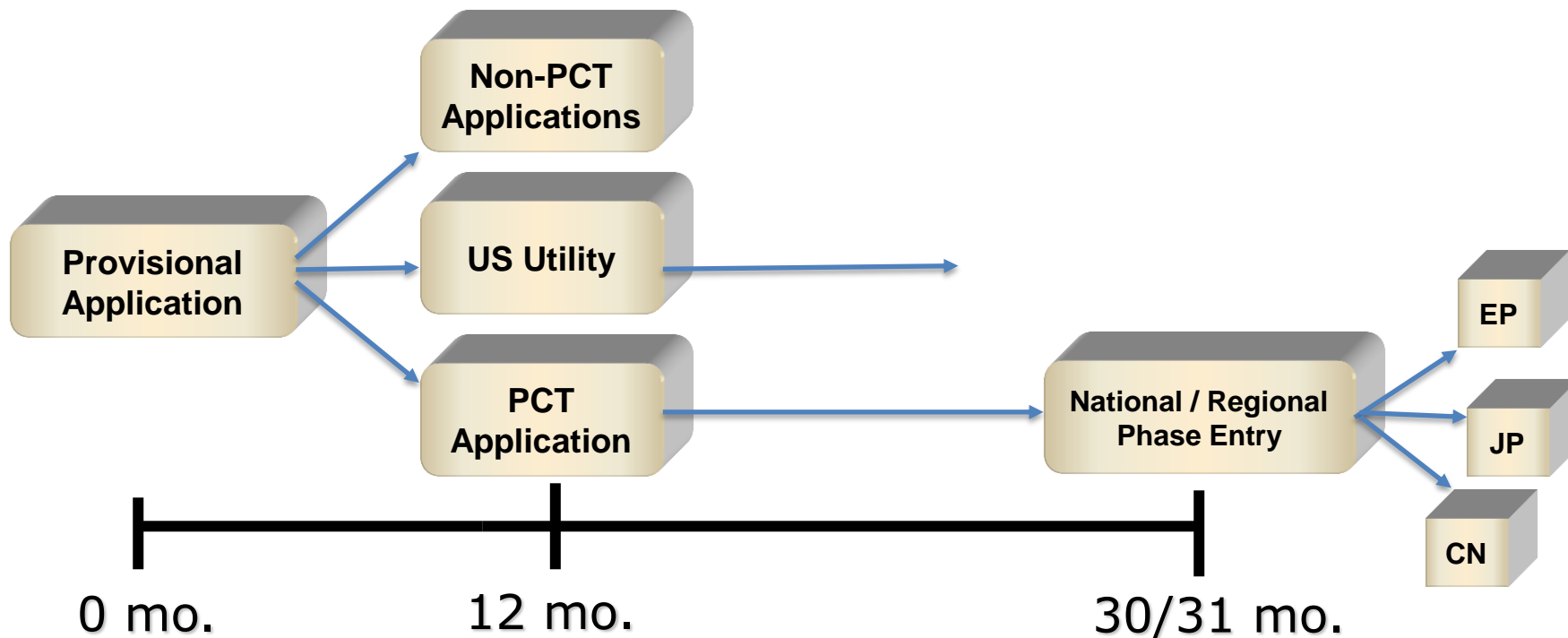
STRATEGIES FOR USING PCT



- More up-front cost (Utility)
- PCT search can come from a foreign patent office
- PCT can be route for second US application
- US patent term will be 1 year less than foreign patents



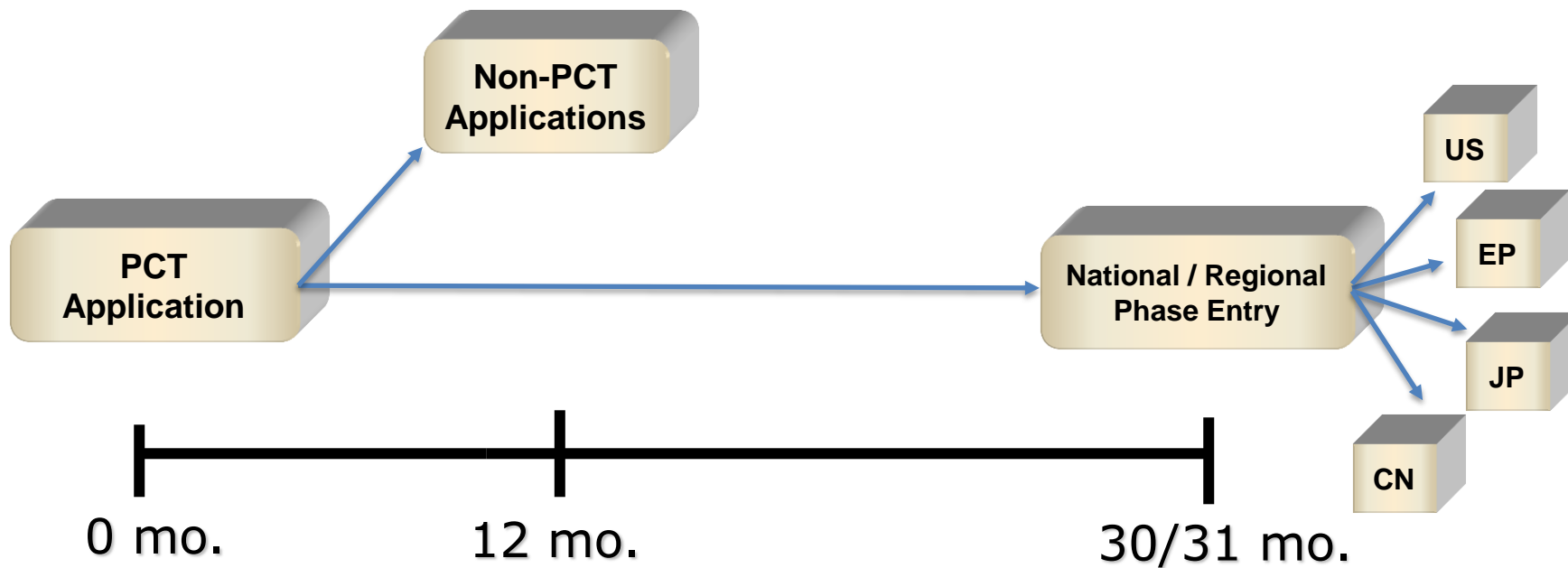
STRATEGIES FOR USING PCT



- Higher cost at 12 months (US and PCT prep and fees)
- PCT search results can come from foreign patent office
- PCT search can come before US prosecution begins and before foreign filing decisions (two searches)
- All patents expire at same time



STRATEGIES FOR USING PCT



- Delays US prosecution the most (but can enter US early)
- Long time to amend claims



INTERNATIONAL SEARCH AUTHORITY

The International Search Authority (ISA):

- Classifies the technology
- Looks for multiple inventions (unity)
- Searches the invention for relevant prior art
- Prepares an International Search Report and Written Opinion
- Determines the International Examining Authority



SELECTING THE ISA

- The Receiving Office (RO) determines which ISA are available
- The choice of RO is based on nationalities and domiciles of Applicants
- For US Applicants, you can use RO/US or RO/IB (always an option)
- RO/US allows you to specify one of the following 8 ISAs:

AU, EP, IL, JP, KR, RU, SG, US

- There may be more RO's available (e.g., a Chinese inventor residing in US = RO/CN, RO/US, RO/IB)
- RO/IB lets you add up all available ISAs because of other RO's available to you

*** You need foreign filing license to file in any other RO besides RO/US**



SELECTING AN ISA: FACTORS

- Cost
- Timeliness
- Subject Matter (e.g., medical uses)
- Quality
- Language
- PPH benefits
- Effect on later national/regional stage



SELECTING AN ISA: COST

\$2097 – EP

\$2080 – US (large entity)

\$1578 – SG

\$1560 – AU

\$1295 – JP

\$1120 – KR

\$1040 – US (small entity)

\$912 – IL

\$520 – US (micro entity)

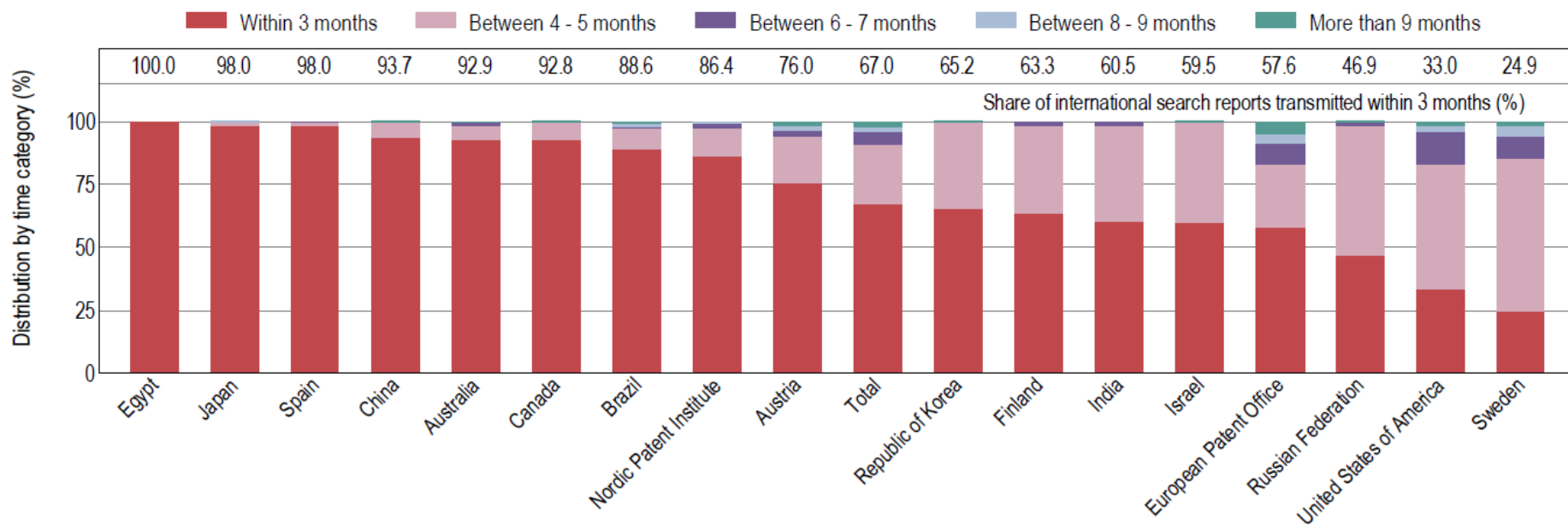
\$388 – RU

* Get a search fee discount on National Phase entry



SELECTING AN ISA: TIMELINESS

ISA must establish search report (ISR) within 3 months of receipt of the search copy or 9 months from priority date (whichever is later).





SELECTING AN ISA: SUBJECT MATTER

- Business methods are not searchable by EP, JP, RU
- Medical treatments are not searchable by KR, JP
- AU has a long list of subject matter it will not search
- JP is limited to fields of green technology
- US has the greatest scope of subject matter searched

SELECTING AN ISA: EFFECT ON NAT'L PHASE

- EP considers PCT as first stage of EP prosecution; discounted search fee if EP/ISA
- US will conduct new search on entering US national stage; discounted search fee if US/ISA; out of order examination if no rejections or are dealt with by amendment



SELECTING AN ISA: QUALITY

- US can outsource searches
- US has limited language capabilities
- EP are usually given full faith and credit to search
- EP includes English, French, German refs
- KR is known for doing good work in electronic arts
- KR and JP include English, Korean, Japanese refs

SELECTING AN ISA: PPH

- US/ISA has agreements with AT, AU, CA, CN, CZ, EP, ES, FI, IL, IS, JP, KR, NO, PH, PI, PT, RU, SE
- EP/ISA has agreements with CA, CN, IL, JP, KR, MX, SG, US
- KR/ISA has agreements with AT, CN, EP, ES, IL, JP, SE, US



AMENDING PCT APPLICATIONS

Article 19 Amendments when:

- Claims have errors
- Claim additional embodiments (cover competitor's products)
- Claims are clearly anticipated
- Amendments are to be published and are not examined

Article 34 Amendments (Chapter II) when:

- You want amendments considered and get a positive IPRP
- You want to enter non-prosecuting countries with PCT claims
- Amendments are not published



PCT-PPH

- A system of work sharing that improves examination efficiency by reducing duplication of effort among patent offices
- Enables an applicant who has received a determination of allowable claims in an application from ISA/WO or IEA/IPRP to obtain fast track processing of corresponding claims in other offices
- Increases grant rate
- Reduces pendency and legal uncertainty
- Compacts prosecution
- Reduces cost
- Increases applicant patent strategy flexibility
- Overall – will always get quicker and faster results, and probably more favorable results as well



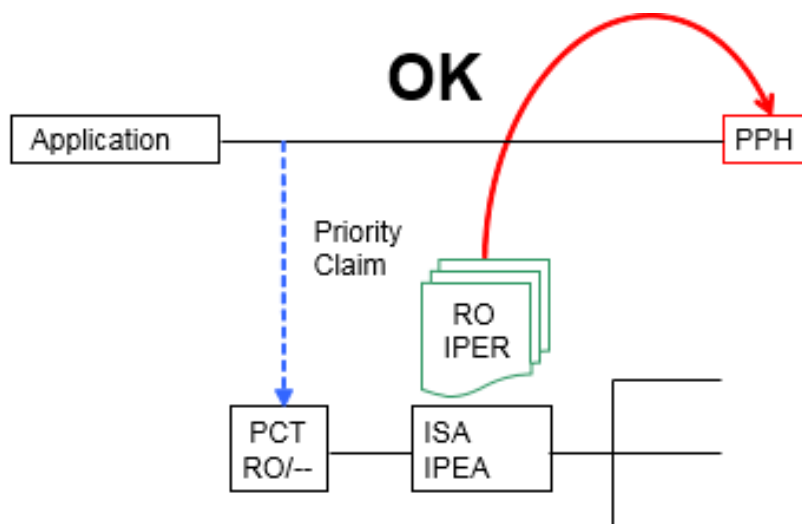
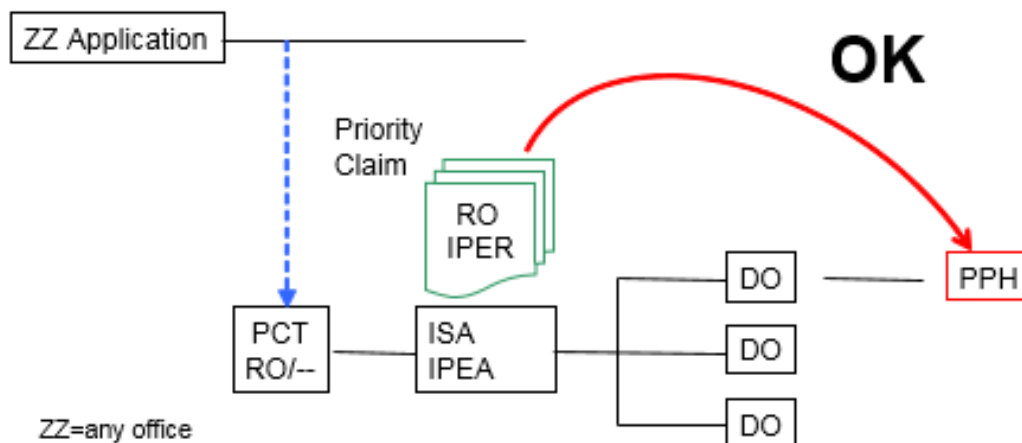
PCT-PPH: ELIGIBILITY

- Applications in both offices share same priority date
- For PCT a determination of Novelty, Inventive Step and Industrial applicability is accepted
- All claims presented for examination must correspond to one or more of the claims found allowable
- The Office of Later Examination (OLE) has not begun substantive Examination



GLOBAL AND IP5 PPH







THANK YOU

Christopher L. Curfman, JD, PhD

Meunier Carlin & Curfman LLC

999 Peachtree Street NE, Suite 1300

Atlanta, GA 30309 USA

O: 404-645-7700

F: 404-645-7707

D: 404-645-7717