

PCT Update

Presentation to the PCT Issues Committee

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Outline

- (1) PCT Status**
- (2) Outcome of the WIPO 2007 Assemblies**
- (3) Things we're working on**



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PCT Status



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New PCT States

Angola--entry into force 27 December 2007

**Recent, earnest discussions on PCT
accession**

Chile

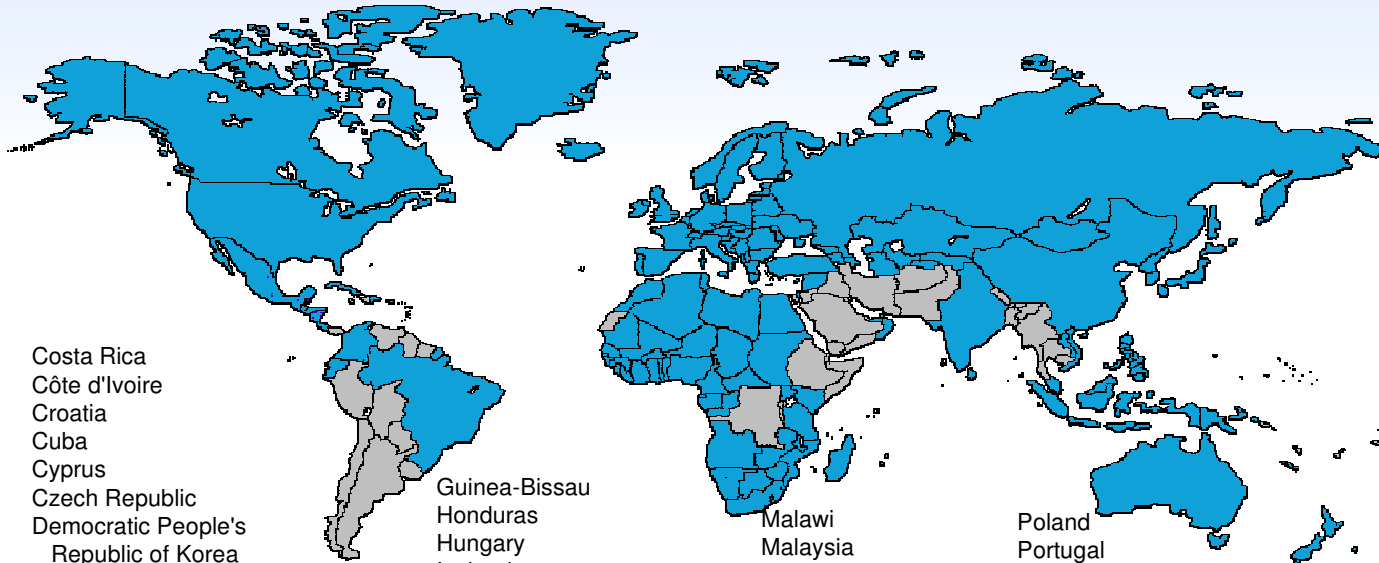
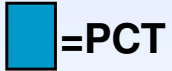
Thailand

Andorra



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138 PCT States

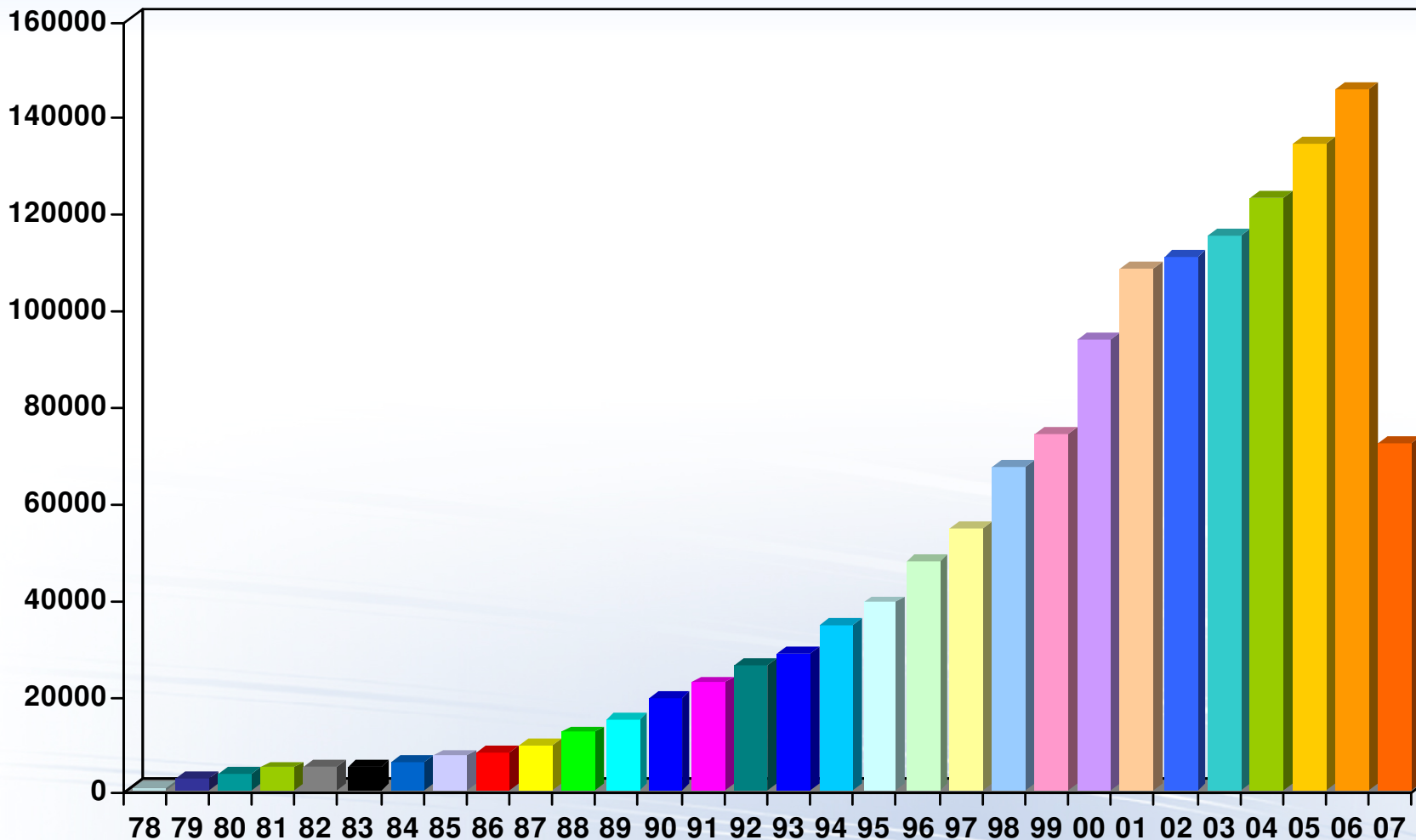


- | | | | | | |
|---------------------------|---------------------------------------|------------------------|------------------|----------------------------------|---|
| Albania | Costa Rica | Guinea-Bissau | Malawi | Poland | St. Kitts and Nevis |
| Algeria | Côte d'Ivoire | Honduras | Malaysia | Portugal | Sweden |
| Angola (27 December 2007) | Croatia | Hungary | Mali | Republic of Korea | Switzerland |
| Antigua and Barbuda | Cuba | Iceland | Malta | Republic of Moldova | Syrian Arab Republic |
| Armenia | Cyprus | India | Mauritania | Romania | Tajikistan |
| Australia | Czech Republic | Indonesia | Mexico | Russian Federation | The former Yugoslav Republic of Macedonia |
| Austria | Democratic People's Republic of Korea | Ireland | Monaco | Saint Lucia | Togo |
| Azerbaijan | Denmark | Israel | Mongolia | Saint Vincent and the Grenadines | Trinidad and Tobago |
| Bahrain | Dominica | Italy | Montenegro | San Marino | Tunisia |
| Barbados | Dominican Republic | Japan | Morocco | Senegal | Turkey |
| Belarus | Ecuador | Kazakhstan | Mozambique | Seychelles | Turkmenistan |
| Belgium | Egypt | Kenya | Namibia | Sierra Leone | Uganda |
| Belize | El Salvador | Kyrgyzstan | Netherlands | Singapore | Ukraine |
| Benin | Equatorial Guinea | Lao People's Dem Rep. | New Zealand | Slovakia | United Arab Emirates |
| Bosnia and Herzegovina | Estonia | Latvia | Nicaragua | Slovenia | United Kingdom |
| Botswana | Finland | Lesotho | Niger | South Africa | United Republic of Tanzania |
| Brazil | Gabon | Liberia | Nigeria | Spain | United States of America |
| Bulgaria | Burkina Faso | Libyan Arab Jamahiriya | Norway | Sri Lanka | Uzbekistan |
| Burkina Faso | Cameroon | Liechtenstein | Papua New Guinea | Sudan | Viet Nam |
| Cameroon | Canada | Lithuania | Philippines | Swaziland | Yugoslavia |
| Canada | Central African Republic | Luxembourg | | | Zambia |
| Central African Republic | Chad | Madagascar | | | Zimbabwe |
| Chad | China | | | | |
| China | Colombia | | | | |
| Colombia | Comoros | | | | |
| Comoros | Congo | | | | |
| Congo | | | | | |



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Growth in PCT filings



7.9%
increase in
2006

148,435 total
filings in
2006

2007
forecast:

158,900

6.7% growth



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Outcome of the WIPO 2007 Assemblies



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Decisions of the PCT Assembly

- **New ISAs/IPEAs**
- **New publication languages**
- **Supplementary international search**
- **Other PCT changes**
- **Other WIPO issues**



New ISAs/IPEAs

INPI Brazil--plans to begin operations early 2008

Indian Patent Office--not sure



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Two new publication languages

Korean

Portuguese

Effective date--The amendments will apply to international applications the international filing dates of which are on or after January 1, 2009



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PCT Fees

- **No reduction at this time, despite US/JP proposal (and internal proposal of PCT sector)**
- **No further change to developing country fee reduction (despite BR proposal), though agreed for IB to study, for '08 Assembly, new criteria for a developing country fee reduction that would be more inclusive than the existing one**



Supplementary international search (1)

- **Gives applicants option to request one or more supplementary (language-based) searches from participating ISAs in addition to the main PCT search**
- **Discussed since 2004**
 - **objective to benefit users by reducing likelihood of new prior art in national phase**
 - **takes into account the growing linguistic diversity in the prior art**



Supplementary international search (2)

- Request filed and fees paid to IB
- Subject to supplementary search and handling fees-- payable one month from supp. search request
- Time limit of expiration of 19 months from priority for SIS requests
- SSA begins SIS at latest by expiration of 22 months from priority
- Where lack of unity found by ISA, can request SSA to carry out SIS on other than main invention
- SSR transmitted to applicant and IB



Supplementary international search (3)

- **Effective date:** generally to IAs filed on or after January 1, 2009, but also to pending applications for which it would still be practicable, having regard to the time limits involved, for a supplementary search to be requested and carried out
- **Condition:** In any event, SIS will not be available in practice until such time as at least one ISA is prepared to offer that service.
- **PCT Assembly agreed Oct. 2007:**
 - IB to report on financial/operation situation of SIS system to Assembly
 - Assembly to review SIS in 2012



Other PCT changes

Amendments to Rules, effective July 1, 2008 :

- applicant may request ISA to take into account, in carrying out the international search, not only, as at present, the results of an earlier search carried out by that ISA but also the results of an earlier search carried out by another ISA or any national Office**
- permitting RO to extend the time limit for paying a fee for requesting restoration of priority**
- clarification that international publication can only be reliably prevented by way of an express withdrawal received by the IB prior to completion of technical preparations for international publication**



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Other WIPO issues

- **SCP Work program agreed**
- **Development agenda agreed**
- **Renewal of mandate of IGC**



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Things we're working on



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PCT-related projects currently underway

- **Priority document digital access service**
- **Extension of national phase entry information availability**
 - **30 Offices currently providing data, with 1.2 million national phase notifications, updated monthly**
- **Patent landscaping tools**
- **Private file inspection**
- **XML processing**
- **Terminology database/Multilingual searching**
- **National patent collections**



Future PCT Issues

- **Comprehensive review of PCT minimum documentation**
- **PCT solution for color drawings**
- **EPO future proposal for claims fees in PCT**
- **Ramifications for PCT of new US rules on claims and continuations**
- **Potential for creating online repositories of national and PCT search and examination reports**
- **New PCT translation paradigm, building on multilingual searching**



Questions?



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