

RECENT DEVELOPMENTS IN PCT PRACTICE

Diane Dunn McKay & David P. Krivoshik
ddunmckay@mathewslaw.com dkrivoshik@mathewslaw.com
Mathews, Shepherd, McKay & Bruneau, PA
100 Thanet Circle, Suite 306, Princeton, New Jersey 08540-3674
<http://mathewslaw.com>

presented at

**The Eighteenth Annual Joint Seminar Program - Patent Practice Update
May 2, 2002, New York, New York**

Sponsored by the Joint Patent Practice Continuing Legal Education, Inc. and co-sponsored by the Connecticut Patent Law Association, New Jersey Intellectual Property Law Association, New York Intellectual Property Law Association, and Philadelphia Intellectual Property Law

Abstract

Changes occurring in the PCT system are driven by the exploding volume of filings. Utilization of electronic distribution of information greatly reduced costs while providing instantaneous availability of the information. Changes in the effect of filing a demand simplifies the decisions an application must make while reducing the work load in processing a PCT application.

Recent Developments in PCT Practice

Diane Dunn McKay, Esq. & David P. Krivoshik, Esq.

ddunmckay@mathewslaw.com dkrivoshik@mathewslaw.com

Mathews, Shepherd, McKay & Bruneau, PA

The Patent Cooperation Treaty (PCT) provides a single international patent application which has legal effect in the countries which are bound by the treaty and which are designated by the applicant, consolidating and streamlining the patenting procedures and reduces costs, providing applicants with a solid basis for important decision-making. The PCT application provides a single description and claims in a single language filed at a single office, the “receiving Office”. The number of PCT member States and regional members has more than doubled in the last eight years, to 110, and the number of international applications has exploded by 3500% since 1979.

The World Intellectual Property Organization has extensively enhanced their web site with respect to PCT materials and provides an extensive resource¹, including general information, filing information, legal texts, the PCT Gazette, PCT News and more. The PCT Legal Texts, including: Treaty, Regulations and Administrative Instructions, as in force from 1 April 2002, are available in English, French and Spanish in HTML and PDF formats, and in German in PDF format only (the HTML format is under preparation)².

While the paperless electronic filing of a PCT application is not yet available³, PCT-Easy⁴ software provides enables the submission of a diskette containing the material in the “Request” form.

The PCT application process is extremely procedural, with strict requirements for the format of the disclosure and the “Request” form⁵ filed with the disclosure. The reduction in the maximum fee for designation all Regional and National patents to 6 designations provides a typical strategy wherein all States (except the US if there was a prior US patent application) are designated. The majority of participating PCT member States and regional members previously required entry into the national phase within 20 months from the earliest priority date, unless a demand was filed within 19 months from the earliest priority date. Except when accompanied by an amendment of the disclosure, the filing of a demand is a

¹ Access to the various materials in English can be found at <http://www.wipo.int/pct/en/>.

² Access to this material can be found at http://www.wipo.int/pct/en/access/legal_text.htm.

³ As of January 7, 2002, any PCT receiving Office having the necessary technical systems in place can decide to accept the filing of international applications in electronic form, which would be published in the PCT Gazette. No receiving Office has yet decided to do so, therefore not yet possible for international applications to be filed in electronic form with any receiving Office.

⁴ Information on PCT Easy can be found at <http://pcteasy.wipo.int/en/index.html>.

⁵ Editable versions of the PCT forms are available at <http://www.wipo.int/pct/en/forms/index.htm> and can be accessed with Adobe Acrobat Reader 4.0, although version 5.0 is recommended. Sample completed forms are also provided and updated as changes occur.

purely procedural matter handled by properly completing the “Demand” form⁵ and submitting it with the necessary fee.

By the filing of the “Demand” the time requirement to enter in the national phase was essentially extended until 30 months from the earliest priority date. In addition to the procedural effect, the filing of a demand provided an opportunity for an applicant to amend the description, claims and drawings without having to submit the amendments separately to each of the elected offices (States). An International Preliminary Examination Report (IPER) is also prepared which while not binding is strongly considered by most of the elected offices (States).

A new (30-month) time limit replacing the previous 20 month time limit for entering the national phase has been put into place effective April 1, 2002. The effect of this change the way in which the time limit for entry into the national phase is calculated is dependent on the date of the earliest priority document. Where the 20-month time limit expired before April 1, 2002 and no demand was filed, the time limit for entry into the national phase, even after April 1, 2002, is 21 months⁶ from the priority date. Where the 20-month time limit expires on or after April 1, 2002 and where a demand has not been filed, the time limit for entry into the national phase is 30 months⁷ from the priority date.

As various changes to national laws are required to implement the new time limits not all members have done so yet. A table of the time limits for entering the national or regional phase under PCT Chapters I and II after April 1, 2002, undated on April 9, 2002 is attached as an appendix. It should be noted that the time limits for entering the national or regional phase vary from 20 months (unchanged) to up to 42 months⁸. However most of the time limits are 30 or 31 months to enter the national or regional phase.

There is no change with respect to an applicant’s ability to file a demand. However it may not be necessary to do so. More importantly, where an applicant did not file a demand, they may still be able to enter the national phase within 30/31 months (42 months for Canada) for many of the member States.

If receiving an IPER is important to making various decisions regarding entry into the national and regional phase, than, in order to increase the likelihood that the International Preliminary Examining Authority (IPEA) will be able to provide the IPER within a time

⁶ For example, an international application with a priority date of July 5, 2000, the 20-month time limit expired on March 5, 2002, which is, before 1 April 2002. Thus the time limit is April 5, 2002, which is, 21 months from the priority date.

⁷ For example, an international application with a priority date of August 2, 2000, the 20-month time limit expired on April 2, 2002, which is, after April 1, 2002. Thus, the time limit is February 2, 2003, which is, 30 months from the priority date.

⁸ The Canadian Patent Office permits extending entry into the national phase from 30 months to 42 months. The time limit for this *late entry* into the national phase is in effect if the applicant pays an additional fee.

frame that will enable you to make your decisions, it is recommended that a demand be filed as early as possible.

While the PCT Assembly has recommended that any member State in which modification to the time limits for entry into the national or regional phase is not compatible with their national law take urgent action to amend its law as soon as possible, it is not possible to predict when this will occur. Updates on this status can be found in the PCT Newsletter⁹.

Another highly visible change will be in the color of forms that the International Bureau currently issues. The forms which are sent to the applicants, receiving Offices, International Searching and Preliminary Examining Authorities and third parties are printed on pink paper. As part of an ongoing PCT automation project at the International Bureau, the use of pink paper for the printing some PCT forms will, starting in mid-2002, be phased out and will gradually be replaced by white paper.

A valuable resource for free searching PCT applications and EPO applications published in the most recent 24 months, which can be displayed in full as a PDF document, and patent applications published in over 50 countries including PCT and EPO applications older than 24 months can be found at <http://ep.espacenet.com/> which is the web site of esp@cenet which is a free service on the internet provided by the European Patent Organization through the EPO and the national offices of its members states.

In conclusion, the changes occurring in the PCT system are driven by the exploding volume of filings. Utilization of electronic distribution of information greatly reduced costs while providing instantaneous availability of the information. Changes in the effect of filing a demand simplifies the decisions an application must make while reducing the work load in processing a PCT application.

⁹ Access to the PCT Newsletter can be found at <http://www.wipo.int/pct/en/newslett/index.htm>.

PCT Contracting States and Two-Letter Codes as of April 1, 2002

AE United Arab Emirates	GD Grenada	MW Malawi (AP) ¹²
AG Antigua and Barbuda	GE Georgia	MX Mexico
AL Albania ¹⁰	GH Ghana (AP) ¹²	MZ Mozambique (AP) ¹²
AM Armenia (EA) ¹²	GM Gambia (AP) ¹²	NE Niger (OA) ^{11,12}
AT Austria (EP) ¹²	GN Guinea (OA) ^{11,12}	NL Netherlands (EP) ^{11,12}
AU Australia	GQ Equatorial Guinea (OA) ^{11,12}	NO Norway
AZ Azerbaijan (EA) ¹²	GR Greece (EP) ^{11,12}	NZ New Zealand
BA Bosnia and Herzegovina	GW Guinea-Bissau (OA) ^{11,12}	OM Oman
BB Barbados	HR Croatia	PH Philippines
BE Belgium (EP) ^{11,12}	HU Hungary	PL Poland
BF Burkina Faso (OA) ^{11,12}	ID Indonesia	PT Portugal (EP) ¹²
BG Bulgaria	IE Ireland (EP) ^{11,12}	RO Romania ¹⁰
BJ Benin (OA) ^{11,12}	IL Israel	RU Russian Federation (EA) ¹²
BR Brazil	IN India	SD Sudan (AP) ¹²
BY Belarus (EA) ¹²	IS Iceland	SE Sweden (EP) ¹²
BZ Belize	IT Italy (EP) ^{11,12}	SG Singapore
CA Canada	JP Japan	SI Slovenia ¹⁰
CF Central African Republic (OA) ^{11,12}	KE Kenya (AP) ¹²	SK Slovakia
CG Congo (OA) ^{11,12}	KG Kyrgyzstan (EA) ¹²	SL Sierra Leone (AP) ¹²
CH Switzerland (EP) ¹²	KP Democratic People's Republic of Korea	SN Senegal (OA) ^{11,12}
CI Côte d'Ivoire (OA) ^{11,12}	KR Republic of Korea	SZ Swaziland (AP) ^{11,12}
CM Cameroon (OA) ^{11,12}	KZ Kazakhstan (EA) ¹²	TD Chad (OA) ^{11,12}
CN China	LC Saint Lucia	TG Togo (OA) ^{11,12}
CO Colombia	LI Liechtenstein (EP) ¹²	TJ Tajikistan (EA) ¹²
CR Costa Rica	LK Sri Lanka	TM Turkmenistan (EA) ¹²
CU Cuba	LR Liberia	TN Tunisia
CY Cyprus (EP) ^{11,12}	LS Lesotho (AP) ¹²	TR Turkey (EP) ¹²
CZ Czech Republic	LT Lithuania ¹⁰	TT Trinidad and Tobago
DE Germany (EP) ¹²	LU Luxembourg (EP) ¹²	TZ United Republic of Tanzania (AP) ¹²
DK Denmark (EP) ¹²	LV Latvia ¹⁰	UA Ukraine
DM Dominica	MA Morocco	UG Uganda (AP) ¹²
DZ Algeria	MC Monaco (EP) ^{11,12}	US United States of America
EC Ecuador	MD Republic of Moldova (EA) ¹²	UZ Uzbekistan
EE Estonia	MG Madagascar	VN Viet Nam
ES Spain (EP) ¹²	MK The former Yugoslav Republic of Macedonia ¹¹	YU Yugoslavia
FI Finland (EP) ¹²	ML Mali (OA) ^{11,12}	ZA South Africa
FR France (EP) ¹¹	MN Mongolia	ZM Zambia (AP) ¹²
GA Gabon (OA) ^{11,12}	MR Mauritania (OA) ^{11,12}	ZW Zimbabwe (AP) ¹²
GB United Kingdom (EP) ¹²		

¹⁰ Extension of European patent possible.

¹¹ May only be designated for a regional patent (the "national route" via the PCT has been closed).

¹² Where a State can be designated for a regional patent, the two-letter code for the regional patent concerned is indicated in parentheses (AP = ARIPO patent, EA = Eurasian patent, EP = European patent, OA = OAPI patent).