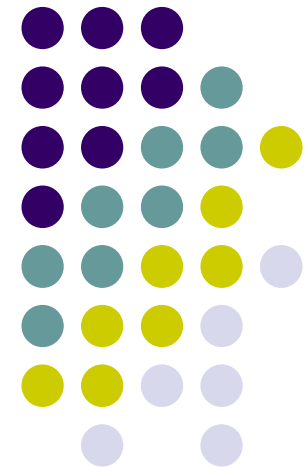


Patent prosecution via the PCT route

Entrepreneurship for Physicists and Engineers from Africa

iThemba LABS, Cape Town, South Africa 2009

Harry Thangaraj
St. George's University London





What is the PCT?

- Multilateral treaty administered by WIPO – entered into force 1978
- Route to obtain protection in any or all contracting states – including states that are party to certain regional treaties (ARIPO, Eurasian Patent Convention, European Patent Convention and OAPI)
- Important – still need to prosecute international application locally in national or regional offices – “procedural international patent application” – no such thing as a “granted international patent” results.



International Phase

- Filing of international application and processing by receiving office. (Should be done within 12 months of the filing of an earlier priority application if applicable)
- International search report (ISR) & written opinion by any one “International Searching Authority” (ISA) (search of prior art with novelty and inventive step considerations)
- Publication of application and ISR (& communication by IB of WIPO to national/regional offices – “designated offices” of the applicant)
- International Preliminary Examination (IPE) report on patentability by one “International Preliminary Examining Authority” (optional)



Benefits

- Deferred national processing (buy time and weigh options) – extra time => 18M more than patent systems based on the Paris Convention
- Simplified multiple filings – simultaneous protection in multiple jurisdictions (assuming successful outcomes)
- ISR and IPE report help evaluate patentability before incurring high costs of national procedures (after ISR can centrally amend claims to better distinguish invention from prior art)
- IPE report (nonbinding opinion on novelty, inventive step, industrial applicability) reassures the applicant that national/regional patents subsequently granted can be relied upon (compared to granted patents without the optional IPE report)



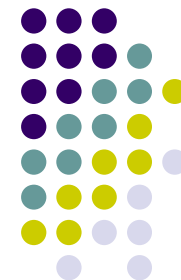
National Phase

- Fees to national/regional offices
- Translations where required
- Patent agent services may be necessary
- If there are different time entry points into national phases, then there may be simultaneous international phases for some designations and national phases for others
- Note: Some countries with significant markets (eg. Taiwan, Malaysia) not part of PCT



Timelines for Int'l phase

- 0M – first filing or provisional
- Int'l application to be filed within 12M of PD
- 1M from filing (13M of priority date) - PCT fee to be paid (extra month available with penalty)
- Following 3 month period time for ISR and written opinion of ISA to be established (13M-15M)
- 4-5 months after IA filed – ISR (prior art document list)
- Applicant has 2 months from mailing date of ISR or 16M from priority date to amend claims (whichever expires later)
- 18M – publication of application and ISR
- 20/21M from PD – National Phase entry for some countries if no “Demand” is filed within 19th month.



Timelines for Int'l phase - 2

- 22M – Demand filed for IPE (optional)
- 22M – 28M IPE process (amendments may be filed during this phase)
- 27-28M final date for IPER to issue
- 30-31M – Entry into national phase

WO0132714A1: RECOMBINANT FUSION MOLECULES



- **A1** Publ.of the Int.Appl. with Int.search report
- Published/Filed 2001-05-10 / 2000-11-03
- Priority No:1999-11-03 **GB1999000026084**
- **Priority date: 1999-11-03**

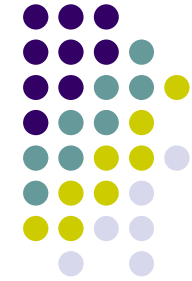
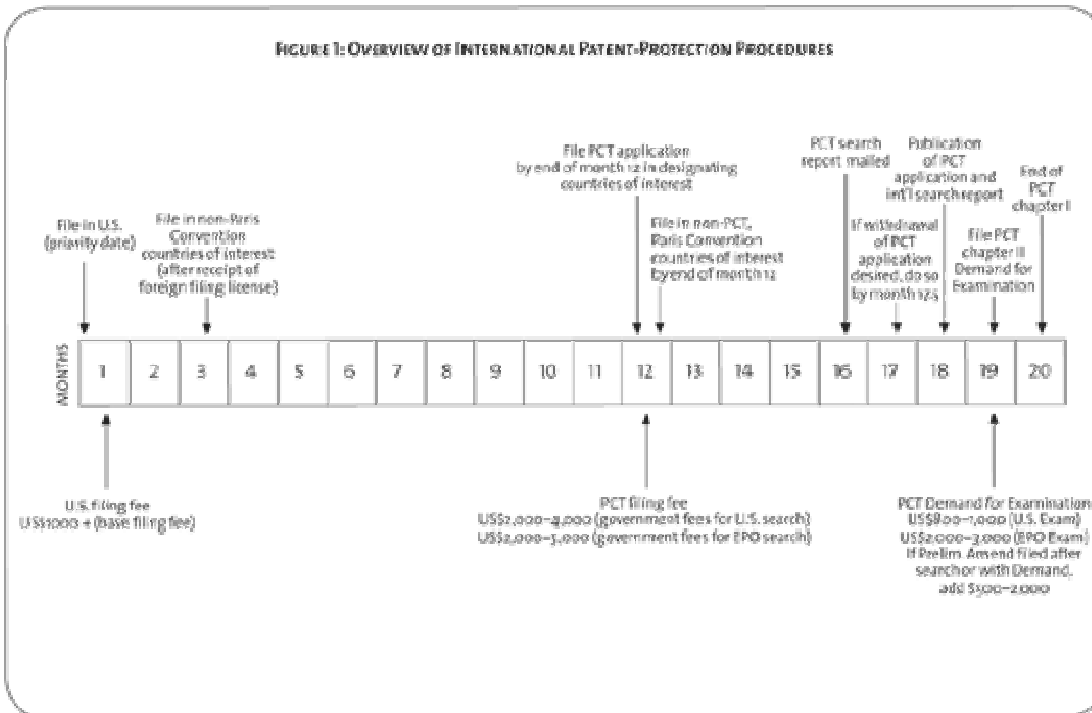


<u>Gazette date</u>	Code	Description (remarks)
2005-06-09	WWG +	Wipo inormation: grant in national office (AU11584/01)
2002-05-08	WWE +	Wipo information: entry into national phase (CN08147159)
2002-05-07	ENP	Entry into the national phase in: (JP XX0000000535412)
2002-04-26	WWE +	Wipo information: entry into national phase (AU11584/01)
2002-04-24	ENP	Entry into the national phase in: (CA0000002388955)
2001-08-30	DFPE	Request for preliminary examination filed prior to expiration of 19th month from priority date (pct application filed before 20040101)
2001-07-04	121	EP: the epo has been informed by wipo that ep was designated in this application
2001-05-10	AK +	Designated states cited in a published application with search report (AE AG AL AM AT AU AZ BA BB BG BR BY BZ CA CH CN CR CU CZ DE DK DM DZ EE ES FI GB GD GE GH GM HR HU ID IL IN IS JP KE KG KP KR KZ LC LK LR LS LT LU LV MA MD MG MK MN MW MX MZ NO NZ PL PT RO RU SD SE SG SI SK SL TJ TM TR TT TZ UA UG US UZ VN YU ZA ZW)

<u>Publication</u>	Title	Filed	AppINo
WO0132714A1	RECOMBINANT FUSION MOLECULES	2000-11-03	WO2000GB0004216
JP2003512860T2		2000-11-03	JP2001000535412
GB9926084A0			
EP1226178A1	RECOMBINANT FUSION MOLECULES	2000-11-03	EP2000000973028
CN1399646T	Recombinant fusion molecules	2000-11-03	CN2000000814715
CN1399646A	Recombinant fusion molecules	2000-11-03	CN2000000814715
CA2388955AA	RECOMBINANT FUSION MOLECULES	2000-11-03	CA2000002388955
BR0015287A	Moléculas recombinantes de fusão	2000-11-03	BR2000000015287
AU0779719B2	Recombinant fusion molecules	2000-11-03	AU2001000011584
AU0111584A5	Recombinant fusion molecules	2000-11-03	AU2001000011584



FIGURE 1: OVERVIEW OF INTERNATIONAL PATENT-PROTECTION PROCEDURES



Viksnius and
McCrackin. 2007. MIHR
IP Handbook
www.iphandbook.org

FIGURE 1 (CONTINUED)

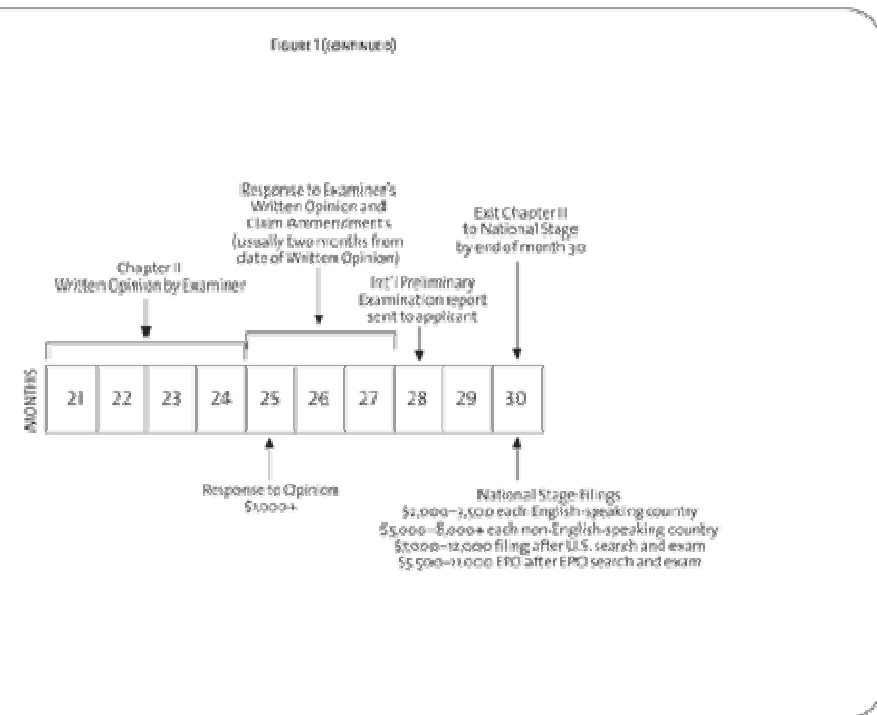
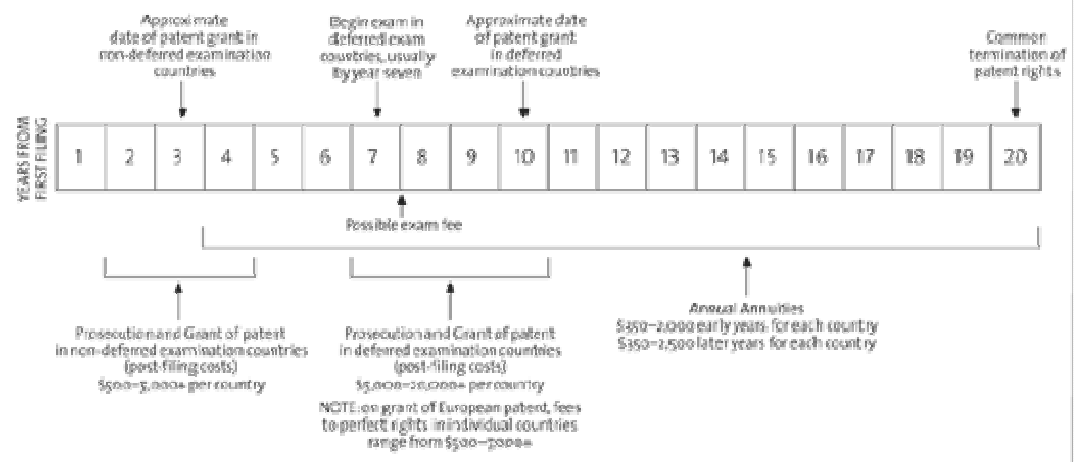




FIGURE 1 (CONTINUED)



Viksnins and McCrackin.
 2007 MIHR IP Handbook
www.iphandbook.org

FIGURE 2: PCT INTERNATIONAL PATENT OVERVIEW

