

The Patent Cooperation Treaty (PCT): status update and recent/future developments



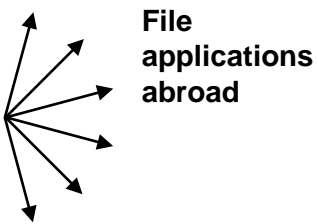
Skolkovo Patent School
October 13, 2016



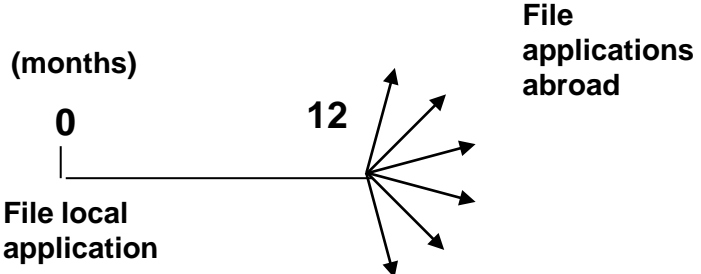
- Speaker: Matthew Bryan, Director, PCT Legal Division, Patents and Technology Sector, WIPO

PCT Background

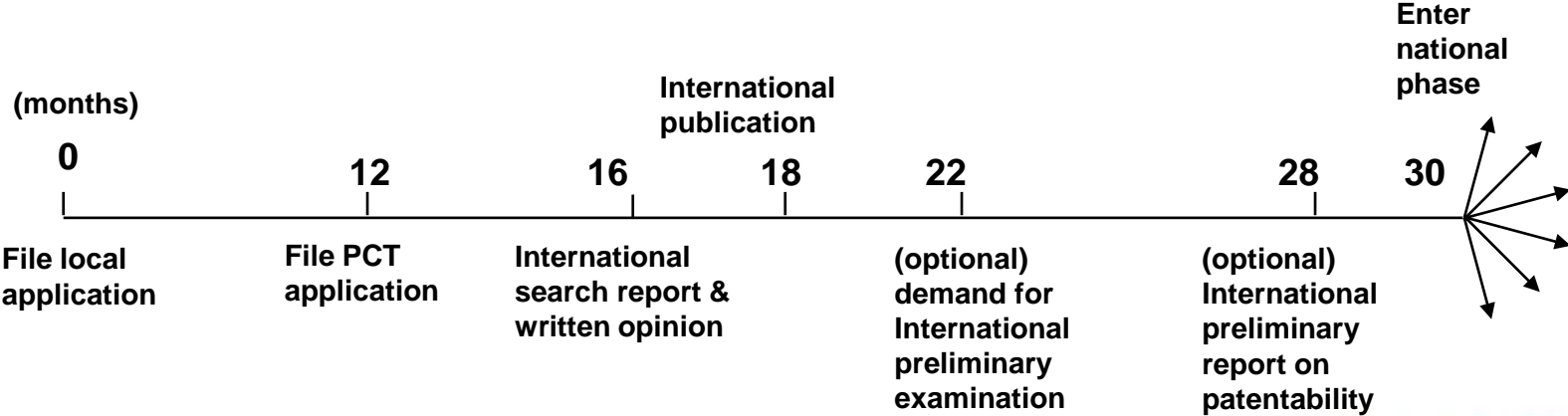
Seeking patents multinationally: 3 theoretical options



Traditional/
Paris



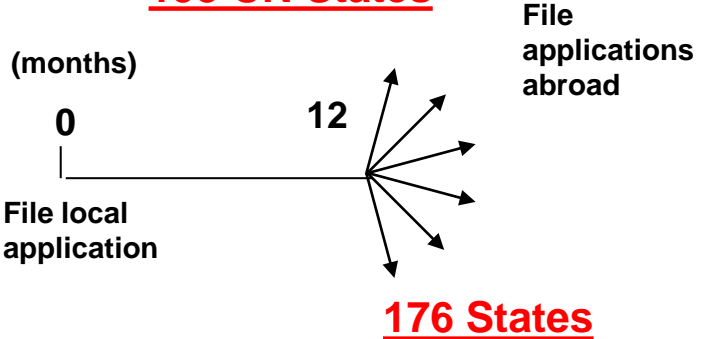
PCT



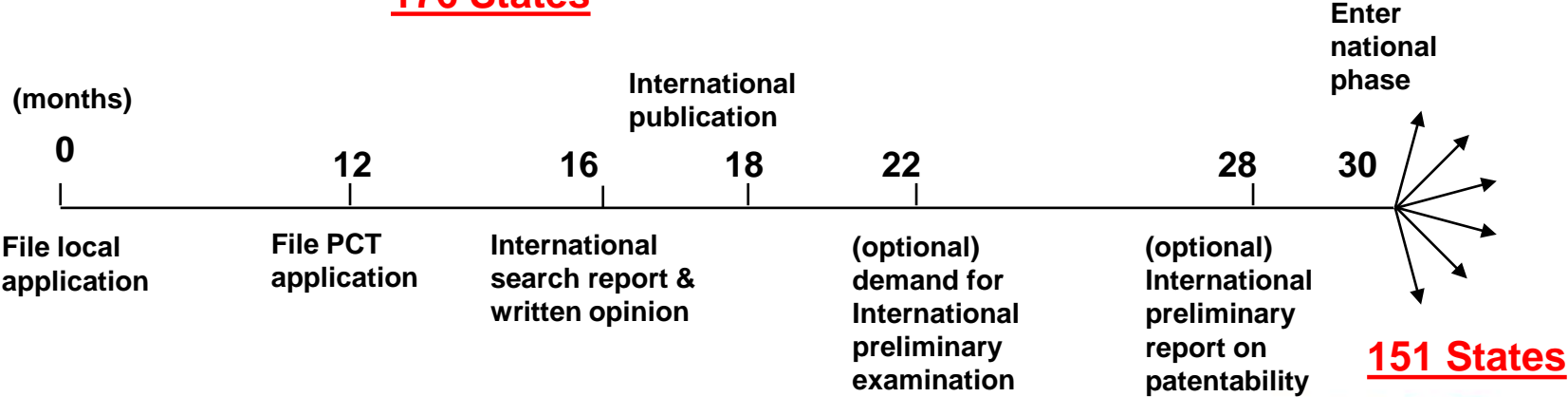
Seeking patents multinationally: 3 theoretical options



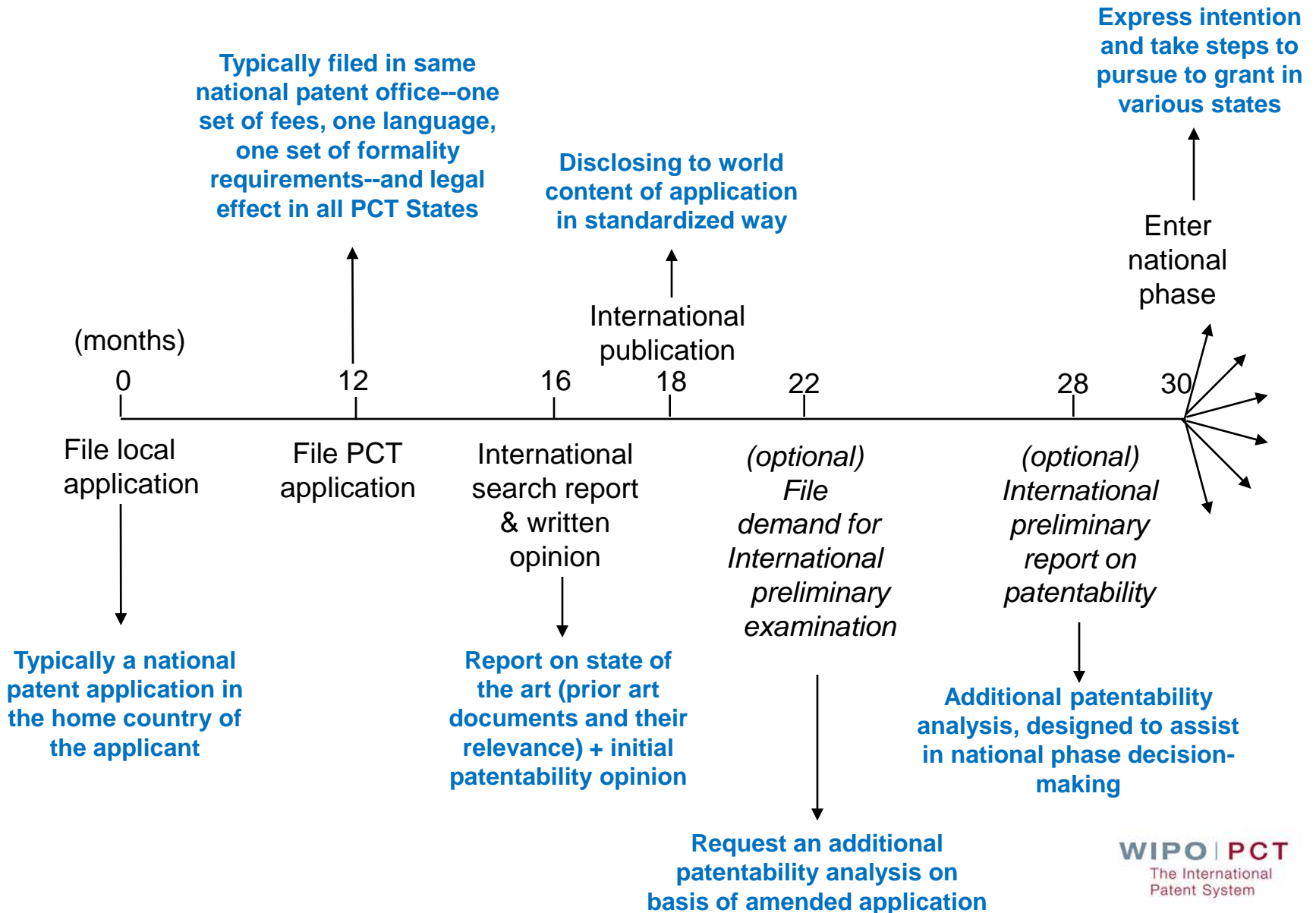
Traditional/
Paris



PCT



The PCT System



Certain PCT Advantages

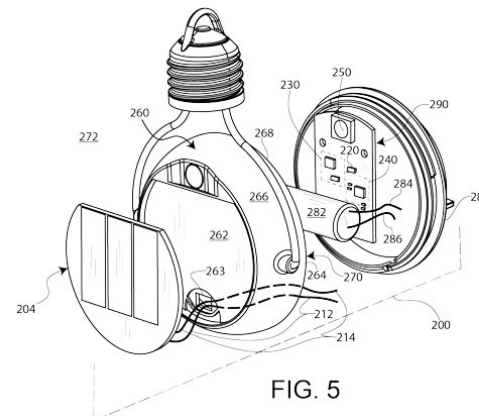
The PCT, as the cornerstone of the international patent system, provides a worldwide system for simplified filing and processing of patent applications, which—

1. postpones the major costs associated with internationalizing a patent application
2. provides a strong basis for patenting decisions
3. harmonizes formal requirements
4. protects applicant from certain inadvertent errors
5. evolves to meet user needs
6. is used by the world's major corporations, universities and research institutions when they seek multinational patent protection
7. can result (if PCT reports are positive) in accelerated national phase processing

PCT Testimonial: Start-up

Nokero (produces solar-powered lights which replace kerosene lamps and candles used in developing and least -developed countries--it has so far distributed over 1.4 million lights in 120 countries and is the only solar company to win the United States Patent and Trademark Office's Patents for Humanity Award)

“When it comes to patenting, because we operate in so many different markets, we use WIPO’s Patent Cooperation Treaty (PCT). Every start-up has limited funds and the PCT is a great mechanism for delaying patent filing costs, allowing time to test the market and overcome any unforeseen technical problems. Without the PCT, protecting an invention in international markets would be a high-risk strategy with huge upfront costs.”



PCT Testimonial: Inventor

- Professor Shuji Nakamura—co-winner of the 2014 Nobel Prize for Physics for his work on blue LED technology—is quoted in a December 2014 *WIPO Magazine* article:



“... The PCT is critical for these early stage technologies because it gives us the opportunity to protect our patents globally while allowing the market and the technology to mature further before determining which countries might be most valuable to commercial partners.”

PCT Testimonial: Large Company

Qualcomm:

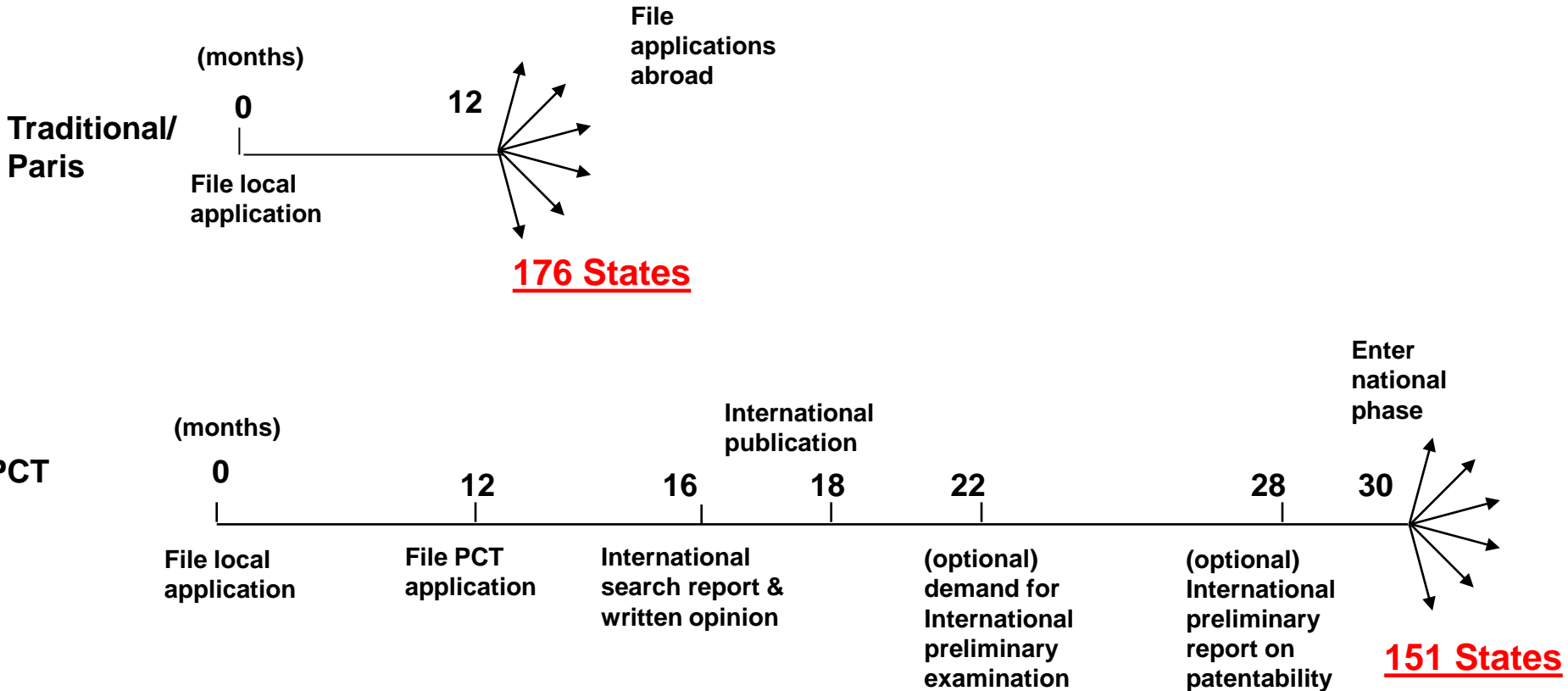
- Started in 1985 with 7 people
- Today more than 170 offices in more than 40 countries, and 33,000 employees
- \$25.3 billion in revenue in FY 2015
- #2 user of PCT in 2015: 2442 PCT applications published



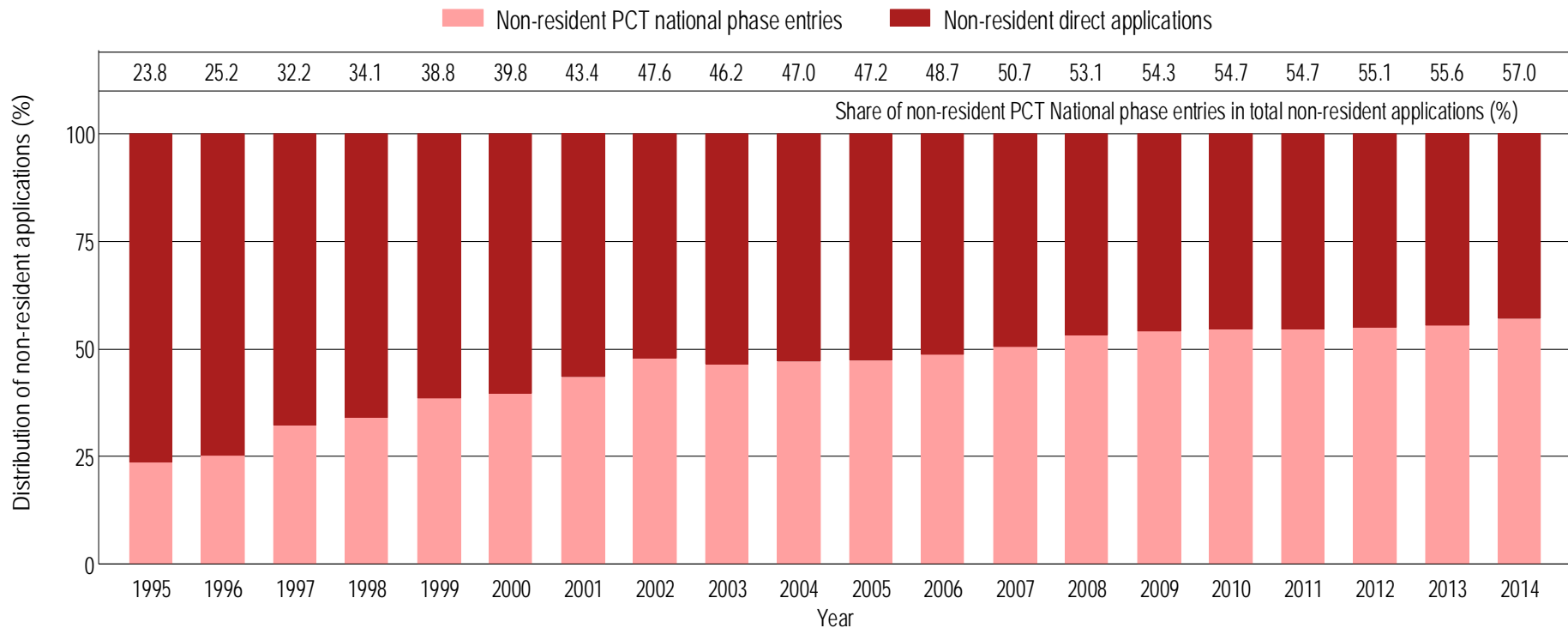
“Over the past 25 years, Qualcomm has been one of the largest users of the PCT system. To date we have filed more than 9,000 patent applications. International patent applications are important to the protection of innovations around the globe. The PCT helps put innovation into practice by providing a simple and cost-effective way to file international patent applications. The PCT is critical for Qualcomm because we are, above all, an innovation company....[PCT] has been a vital partner in the success of our company and the growth of the wireless industry.” CEO Paul Jacobs, 2011

PCT Status

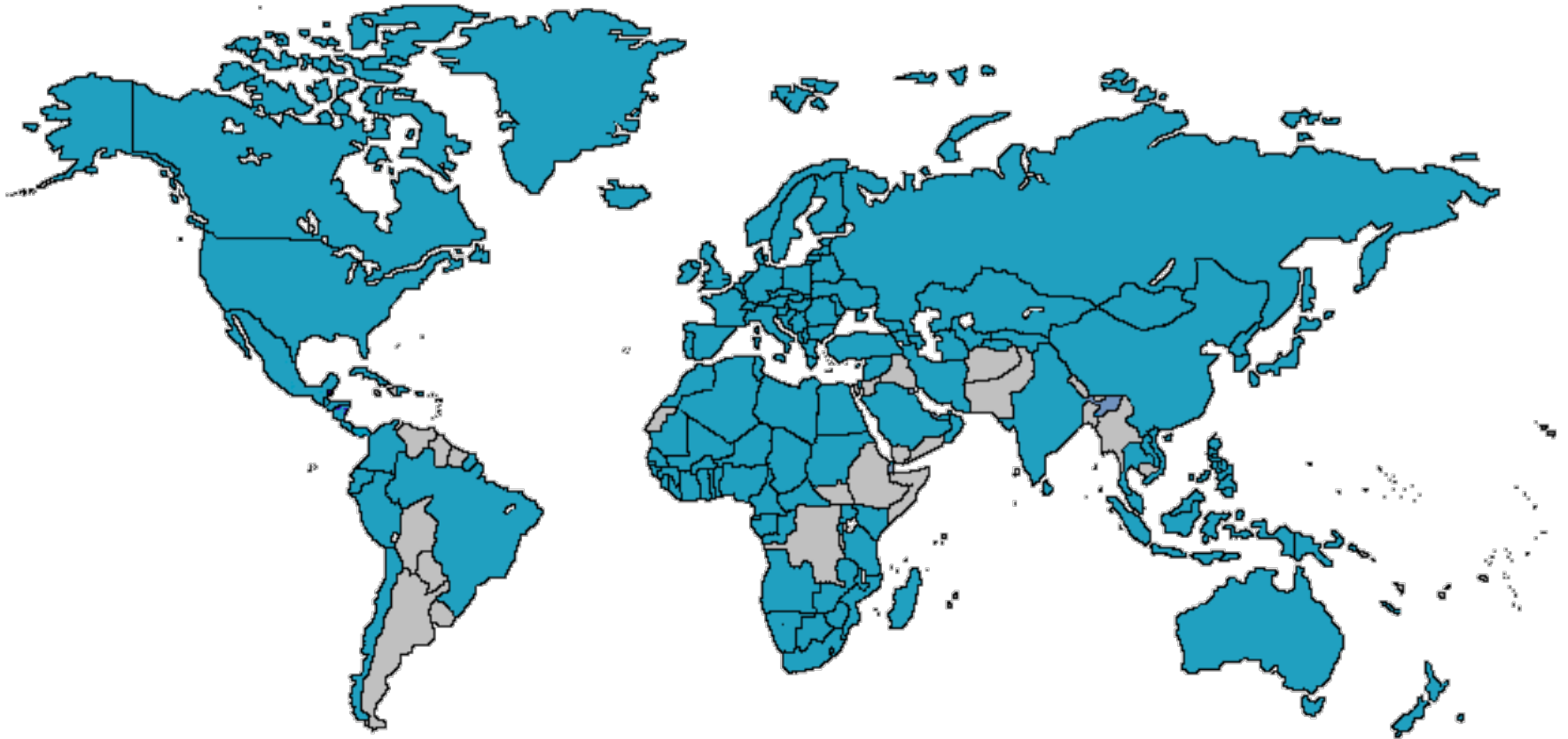
The two main pathways to multinational patent protection



Paris route vs. PCT national phase



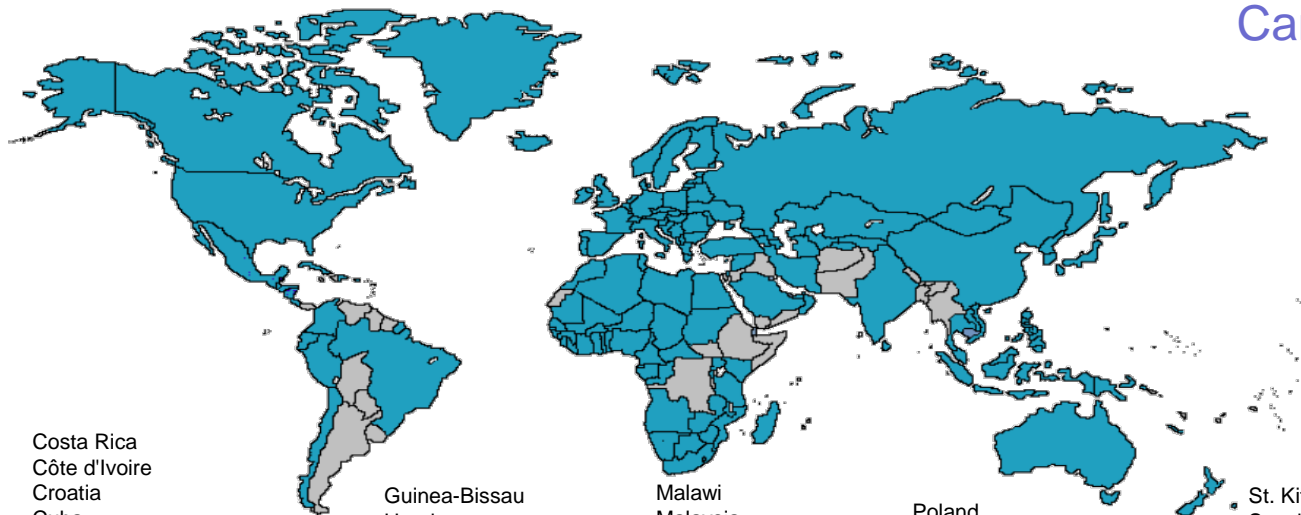
PCT Coverage Today



151 PCT States

Recent accessions:

Kuwait
Djibouti
Cambodia



Albania
Algeria
Angola
Antigua and Barbuda
Armenia
Australia
Austria
Azerbaijan
Bahrain
Barbados
Belarus
Belgium
Belize
Benin
Bosnia and Herzegovina
Botswana
Brazil
Brunei Darussalam
Bulgaria
Burkina Faso
Cambodia (8 Dec. '16)
Cameroon
Canada
Central African Republic
Chad
Chile
China
Colombia
Comoros
Congo

Costa Rica
Côte d'Ivoire
Croatia
Cuba
Cyprus
Czech Republic
Democratic People's
Republic of Korea
Denmark
Djibouti (23 Sept. '16)
Dominica
Dominican Republic
Ecuador
Egypt
El Salvador
Equatorial Guinea
Estonia
Finland
France
Gabon
Gambia
Georgia
Germany
Ghana
Greece
Grenada
Guatemala
Guinea

Guinea-Bissau
Honduras
Hungary
Iceland
India
Indonesia
Iran (Islamic Republic of)
Ireland
Israel
Italy
Japan
Kazakhstan
Kenya
Kuwait (9 Sept. '16)
Kyrgyzstan
Lao People's Dem Rep.
Latvia
Lesotho
Liberia
Libyan Arab Jamahiriya
Liechtenstein
Lithuania
Luxembourg
Madagascar

Malawi
Malaysia
Mali
Malta
Mauritania
Mexico
Monaco
Mongolia
Montenegro
Morocco
Mozambique
Namibia
Netherlands
New Zealand
Nicaragua
Niger
Nigeria
Norway
Oman
Panama
Papua New Guinea
Peru
Philippines

Poland
Portugal
Qatar
Republic of Korea
Republic of Moldova
Romania
Rwanda
Russian Federation
Saint Lucia
Saint Vincent and
the Grenadines
San Marino
Sao Tomé e Príncipe
Saudi Arabia
Senegal
Serbia
Seychelles
Sierra Leone
Singapore
Slovakia
Slovenia
South Africa
Spain
Sri Lanka
Sudan
Swaziland

St. Kitts and Nevis
Sweden
Switzerland
Syrian Arab Republic
Tajikistan
Thailand
The former Yugoslav
Republic of Macedonia
Togo
Trinidad and Tobago
Tunisia
Turkey
Turkmenistan
Uganda
Ukraine
United Arab Emirates
United Kingdom
United Republic of Tanzania
United States of America
Uzbekistan
Viet Nam
Zambia
Zimbabwe

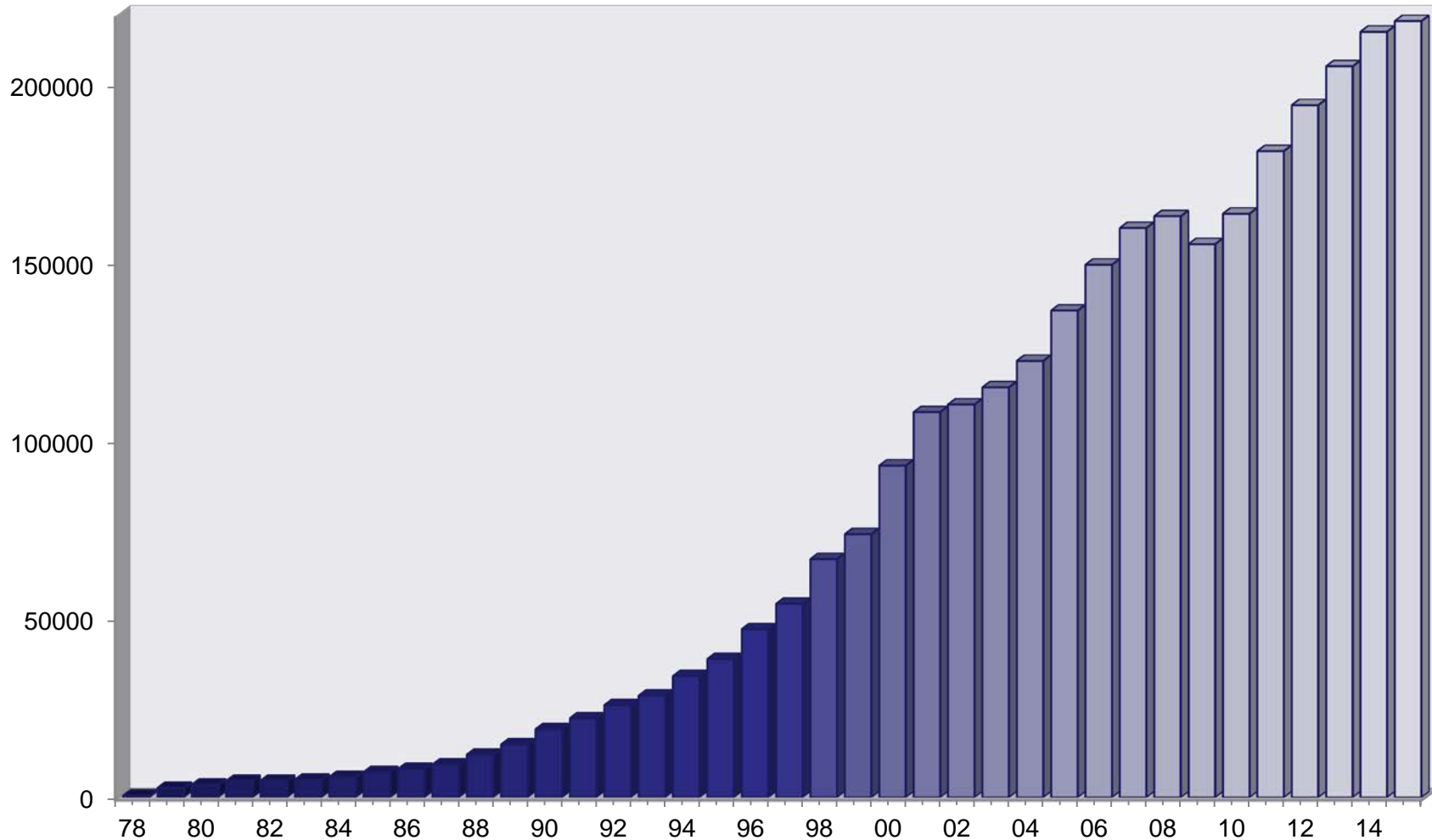
UN Member States not yet in PCT

Afghanistan	Jordan*	Timor-Leste
Andorra*	Kiribati	Tonga
Argentina**	Lebanon	Tuvalu
Bahamas	Maldives	Uruguay**
Bangladesh*	Marshall Islands	Vanuatu
Bhutan	Mauritius	Venezuela
Bolivia	Micronesia	Yemen
Burundi	Myanmar	
Cape Verde	Nauru	(42)
Democratic Republic of Congo	Nepal	
Eritrea	Pakistan	
Ethiopia	Palau	
Fiji	Paraguay**	
Guyana	Samoa	
Haiti	Solomon Islands	
Iraq	Somalia	
Jamaica	South Sudan	
	Suriname*	

**preparing to accede*

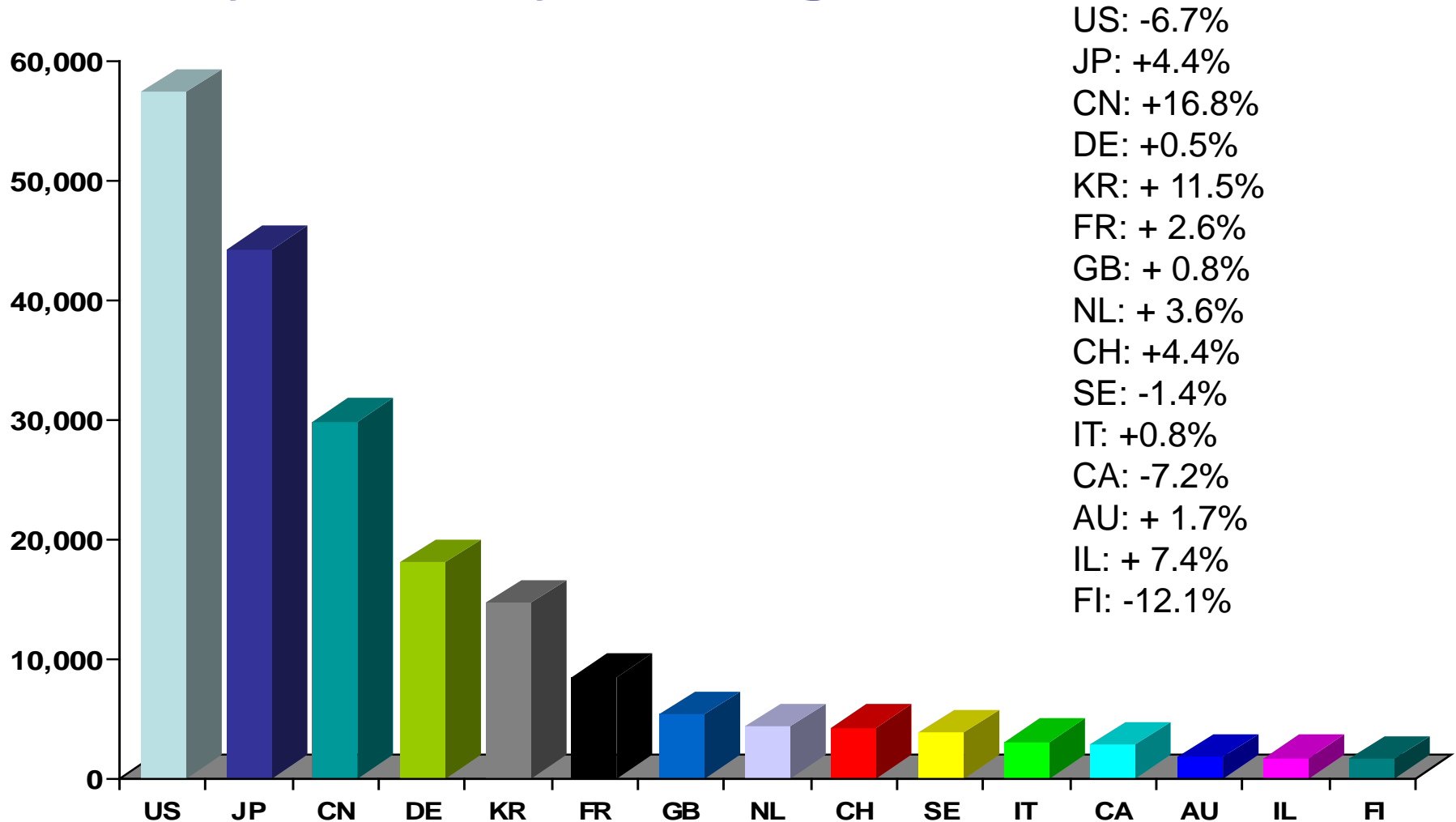
***PCT discussions ongoing*

PCT Applications



- 2015: 218,000 (+1.7%)
- WIPO Chief Economist predicting +3.3% in 2016

International applications received in 2015 by country of origin



- 26+% originate in US
- 75% from top 5 countries; 92+% of filings from top 15 countries
- PCT applications filed by applicants from 132 countries

Top PCT Applicants 2015*

() of published
PCT applications

1. Huawei Technologies—CN (3,898)** +450
2. Qualcomm—US (2,442)
3. ZTE—CN (2,155)
4. Samsung—KR (1,683) +300, up from #11
5. Mitsubishi Electric—JP (1,593)
6. Ericsson—SE (1,481)
7. LG Electronics—KR (1,457) +320, up from #16
8. Sony—JP (1,381) +400, up from #21
9. Philips—NL (1,378)
10. Hewlett-Packard—US (1,310) +485, up from #25
11. Siemens—DE (1,292)
12. Intel—US (1,250)
13. Bosch—DE (1,247)
14. Boe Technology—CN (1,227)
15. Toyota—JP (1,214)
16. Panasonic—JP (1,185)
17. Hitachi—JP (1,165)
18. Halliburton—US (1,121)
19. Sharp—JP (1,073)
20. Tencent Technology—CN (981)

2015:

- 85% businesses
- 8% individuals
- 5% universities
- 2% government and research institutions

*48,539 total PCT
applicants in 2015

**more than 15
per WIPO working
day

PCT International Searching Authorities

The appointed ISAs are the following 21 offices:

Australia
Austria
Brazil
Canada
Chile
China
Egypt
European Patent Office
Finland
India
Israel
Japan
Nordic Patent Institute
Republic of Korea
Russian Federation
Singapore
Spain
Sweden
Ukraine
United States of America
Visegrad Patent Institute (1 July 2016)

Additional offices seeking appointment as ISAs:

Turkish Patent Institute

Selected RU PCT statistics

- RU ranked #7 in national patent applications filed (2014) and #21 in PCT filings
 - 839 PCT applications filed in 2015 at RO/RU
- Individuals in RU filed 56.6% of PCT applications in 2015 (highest in world)
- 0.5% (939) of PCT applications filed in Russian language (2015) (8th language, after English, Japanese, Chinese, German, Korean, French and Spanish)
- National phase entries:
 - 13,451 national phase entries at DO/RU --#10 in 2015
 - PCT national phase entries accounted for 82.3% of total non-resident filings (2015)
- Federal Service for Intellectual Property (Rospatent)
 - ISA/RU performed 2,482 PCT searches in 2015 (1.14% of total)
 - SISA/RU performed the 2nd highest number of supplementary searches

New/recent Developments

July 1, 2016 PCT Rule Amendments (1)

- legal basis and procedure for removing/withholding certain “sensitive information” from public access on applicant’s request (Rules 9, 48 & 94)
 - upon reasoned request by the applicant to the IB
 - Information will be omitted from publication/public file access, if
 - 1) it does not obviously serve the purpose of informing the public about the international application,
 - 2) publication of or public access to such information would clearly prejudice the personal or economic interests of any person, and
 - 3) if there is no prevailing public interest to have access to that information
 - effective as from 1 July 2016 for applications filed on or after that date
- language of communication with IB via ePCT opened to all publication languages (Rule 92)

July 1, 2016 PCT Rule Amendments (2)

- required transmittal by RO to IB of documents submitted in support of requests for restoration of priority right (Rules 26*bis* & 48)
 - Exception: if “sensitive information” standard (Rule 48(I)) met
- “general unavailability of electronic communications services” as grounds for excuse of delay in meeting certain time limits (Rule 82*quater*)
 - Extension of *force majeure* provisions to time limits missed due to “general failures of electronic communication services”
 - PCT Assembly: “covers outages that affect widespread geographical areas or many individuals, as distinct from localized problems associated with a particular building or single user”
 - Effective as from 1 July 2016 for applications filed on or after that date, and for applications filed before that date where the “event” occurred on or after that date

July 1, 2017 PCT Rule Amendments (1)

- transmittal by RO of earlier search and/or classification results to ISA, where national law permits (Rules 12*bis*, 23*bis* & 41))
 - General Rule: ROs forward the search/classification results from applications of which priority is claimed without the applicant's express permission, where permitted by national law
 - Exception:
 - ROs which have notified the IB (before April 14, 2016) of incompatibility of such forwarding with applicable national law are not required to do so
 - USPTO (and 10 other ROs) made this notification
 - Even in cases in which ROs in principle apply the procedure, when filing the PCT application applicants may request to not have the earlier search results forwarded to the ISA (ROs which act in this way are to notify the IB in advance)
 - Effective as from 1 July 2017 for applications filed on or after that date

July 1, 2017 PCT Rule Amendments (2)

- designated Offices required to provide IB with timely national phase entry and related data (Rules 86 & 95)
 - Objective: visibility of the status of PCT application during the national phase on PATENTSCOPE under the “National phase” tab
 - Obligation for designated Offices to timely send national phase entry and related data to the IB (within 2 months from expiry of national phase deadline or asap thereafter)
 - Data required to be transmitted:
 - Date national phase entered
 - National application number
 - Number and date of any national publication
 - Number and date of grant
 - Effective as from 1 July 2017 for applications in respect of which the acts referred to in Article 22 or Article 39 are performed on or after that date

PCT Working Group 2016 (1)

■ Outcomes:

□ Amendments to the PCT Regulations (entry into force: 1 July 2017)

➤ Only very minor changes:

- Modifying time limit to request Supplementary International Search (from 19 to 22 months)
- Further small change to Rule 23bis
- Removal of unnecessary incompatibility provisions

□ Report provided on upcoming 3rd pilot of IP5 collaborative search and examination

➤ Planned that all IP5 offices will participate, will be applicant driven (to assess business interest), involve at least 100 PCT applications per office and last up to 3 years

□ IB will consult with Offices and user groups on:

- proposed pilot for ePCT national phase entry functionality
- technical/legal/administrative issues related to color drawings
- translation difficulties relating to the number of words in abstracts and drawings
- inclusion of CPC/other national classification symbols on front page of published international applications

PCT Working Group 2016 (2)

■ Outcomes (cont.):

□ Examiner training (provided by larger offices to smaller offices)

➤ IB will:

- compile info on examiner training provided by offices
- invite offices to provide training to examiners from other offices
- develop concept for improved coordination of examiner training
- invite sharing of training materials

□ No agreement on proposals concerning:

- same day priority claims
- missing parts/erroneously filed procedure
- fee reductions proposed by Brazil for universities and public research organizations—for further discussion next year
- proposed amendments to Schedule of Fees and Rule 92*bis* to assist IB in responding to potentially abusive use of PCT fee reductions

Other related developments

■ WIPO PEARL

- ❑ terminology portal, providing access to multilingual technical terms derived from patent documents
- ❑ helps promote accurate and consistent use of terms across different languages

■ PATENTSCOPE

- ❑ planning to release new functionality for searching chemical compounds (“Chemsearch”)
- ❑ Will recognize chemical compounds in patent text and drawings, and users can search by name, structure, INN or draw the structure

Ongoing/future Developments

The PCT—1978 to 2016 (1)

- As filing tool: PCT has been extremely successful
 - preferred route for international patenting ($\approx 218,000$ applications in 2015, $> 57\%$ “market share”)
 - harmonization of formal and procedural requirements, beyond PCT
 - national laws; Patent Law Treaty (PLT)

The PCT—1978 to 2016 (2)

- As worksharing tool: (which it was intended by its founders to be), PCT has not been as effective in practice
 - had it been successful up to now in this sense, it would have been of more assistance in addressing national quality of examination and (for some Offices) backlogs in processing
 - Expectation/hope/intention by founders was: “flying start” for offices, which would complete, further check, and criticize ...
 - reality: many Offices start “from scratch”, perhaps not in complete isolation, but to a great degree ...
- What is needed: build more trust between patent offices, so that duplicative international phase and national phase processing can be reduced

Continued areas of PCT focus (1)

■ Quality:

- ❑ Improve the quality and consistency of PCT international phase reports
- ❑ Develop quality metrics for measuring usefulness of international phase reports
- ❑ Develop quality feedback system for offices (e.g., DO to ISA)
- ❑ Explore collaborative search and examination
 - 3rd pilot (IP5) beginning soon
- ❑ Improve timeliness of PCT work

■ Help designated Offices to better understand reports

- ❑ Search strategies, standardized clauses, explanations of relevance of cited documents, etc.

■ Improve access to national search and examination reports

- ❑ PATENTSCOPE, WIPO-CASE, Global Dossier

■ Make further progress against misleading invitations sent to PCT users

INTERNATIONAL INTELLECTUAL PROPERTY OFFICE
PATENT REGISTRATION APPLICATION
Administration for Commerce & Industry
Here: We acknowledge recording your patent



INVOICE



Amount: USD 1588,00
Date :
Reference Number :

Classification International :

Publication No :

Publication Date :

Application No :

Filing Date :

Title:

Please transfer the amount to the bank account mentioned below within 8 days.

Charges of registration	USD 1588,00
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Total amount	USD 1588,00

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REGISTRATION OF THE INTERNATIONAL PATENT



• International Application No:

• Publication Number:

• Publication Date:

• International Filing Date:

• Order Number: • Sent Date:

• Int Class:

• Title:

• Payment Details:

Subject	Amount
Filing Fee for Order 1160500654	1.829,00 EUR
Processing Fee	25,00 EUR
Additional Fee	0,00 EUR
Total Filing Fee	1.854,00 EUR

• Payment Methods:

Payment by Wire Transfer:

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Bank name: Slovenska sporitelna, a. s.
IBAN: SK20 0900 0000 0050 8040 0057
BIC/SWIFT: GIBASKBX
Account no.: 5080400057
Bank address: Tomesikova 4B
832 37 Bratislava
Slovak Republic

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130 00 Praha 3
Czech Republic

Please pay the Amount, within 14 days. Don't forget to quote the Order Number: **1160500654**



• Registration of the International Patent:

The international patent has been published in the WIPO-Gazette, which is edited by Bureau of the World Intellectual Property Organization. This publishing forms the basis of our offer. Please note, registration is not affiliated with the publication of the official International Patent Application registration and is not a registration by a government entity. This form is solely the offer for the concluding of the contract, being the year registration of your international patent application in our internet database and access to all database services. Applicant in the sense of the provision § 1744 law no. 89/2012 Coll., Civil Code, accepts this motion of Provider to the concluding of the contractual relationship by the execution of the non-cash settlement of the annual registration price to the account of Provider. To access the database, identify the offer number. By the settlement of the price Applicant agrees that the contractual relationship shall be governed by the company general terms of business, specified on the second page of this application; the issues not modified by these terms shall be governed by the law no. 89/2012 Coll., Civil Code. By the acceptance of this motion Applicant hereby declares to familiarize himself with the General Terms of Business and to read them; furthermore, he declares to agree with their wording. Due to legal reasons, all and any back-payment claims and complaints filed directly or via the bank, will neither be processed or accepted by us. The bank cannot refund you without our approval. Please save our as well as your precious time and choose the shortest way for a settling of your complaint and approach us directly at cancel@ipti.biz.

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452B05AE



INVOICE



Amount : EUR 1477,00
Date : 2015-12-11
Reference Number : 0291977 / 2015



REG: INTERNATIONAL PATENT APPLICATION
PUBLICATION NUMBER:



INVOICE

DATE:

INVOICE/ACCOUNT NUMBER:
597047

APPLICATION REGISTRATION/PUBLICATION FEE
1.998,80 €

PAYMENT TERMS:
APPLICATION REGISTRATION/PUBLICATION FEE
NEEDS TO BE PAID **WITHIN 8 DAYS** OF RECEIPT
OF PAYMENT NOTIFICATION

PAYMENT DETAILS:
BENEFICIARY: WIPO-WORLD INTELLIGENT
PROPERTY OFFICE
BANK: RAIFFEISENBANK
ACCOUNT: 1610000121500271
IBAN: BA391610000121500271
SWIFT/BIC: RZBABA2S

IMPORTANT: UPON PAYMENT RECEIPT IN THE AMOUNT OF EUR 1.998,80
BY THIS OFFICE, APPLICATION PROCESSING WILL COMMENCE
APPLICATION REGISTRATION/PUBLICATION OF YOUR INTERN. PATENT APPLICATION:
Below find summarized of published Intern. Patent Application in the WIPO Patentscope Gazette

Title:	Priority Data:	International Application No.:
Publication Date:	Publication Number:	International Filing Date:

IMPORTANT: APPLICATION REGISTRATION/PUBLICATION FEE IN THE AMOUNT OF **EUR 1.998,80** NEEDS TO BE
PAID **WITHIN 8 DAYS** OF RECEIPT OF PAYMENT NOTIFICATION FOR APPLICATION PROCESSING

INVOICE/ACCOUNT NUMBER : 597047			
ITEM	DESCRIPTION	CURRENCY	AMOUNT
001	APPLICATION REGISTRATION/PUBLICATION FEE INTL. PATENT APPLICATION INTL. APPLICATION NUMBER: PUBLICATION DATE:	EUR	1.998,80
002	PROCESSING FEE	EUR	0,00
	USE BELOW DETAILS FOR PAYMENT: BENEFICIARY: WIPO-WORLD INTELLIGENT PROPERTY OFFICE BANK: RAIFFEISENBANK ACCOUNT: 1610000121500271 IBAN: BA391610000121500271 SWIFT/BIC: RZBABA2S	SUBTOTAL	EUR 1.998,80
		TRANSFER FEE	EUR 0,00
		ADDITIONAL PUBLICATION FEE	EUR 0,00
	INVOICE TOTAL	EUR	1.998,80

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Classification International :

Title:

Publication No :

Publication Date :

Application No :

Filing Date :

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Extra charges	EUR 0,00
Total amount	EUR 1477,00

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WARNING: Requests for Payment of Fees

It has come to the attention of the International Bureau that PCT applicants and agents are receiving invitations to pay fees that do not come from the International Bureau of WIPO and are unrelated to the processing of international applications under the PCT. Whatever registration services might be offered in such invitations, they bear no connection to WIPO or to any of its official publications.

PCT applicants and agents should note that it is the International Bureau of WIPO alone which publishes all PCT applications promptly after the expiration of 18 months from the priority date (see PCT Article 21(2)(a)); there is no separate fee for such international publication, and the legal effects of international publication are set out in PCT Article 29.

The invitations often identify a particular PCT application by its international publication number (eg: WO 02 xxxxxx), publication date, title of the invention, international application number, priority information and IPC symbols; examples of such invitations can be viewed below.

IIP – International Intellectual Property Office

Published on February 22, 2016

IPTI – International Patents & Trademark Index

Invitation not listed here? E-mail us a copy

- [Trademarks \(Madrid System\)](#)
- [Patents \(PCT System\)](#)

Mitigating this unscrupulous practice

- WIPO invites its customers to use and adapt this standard text to notify applicants and inventors about such fee requests. [\[WORD\]](#)
- Circular letter addressed by WIPO Director General, Francis Gurry to all PCT Contracting States and Regional Organizations. [PDF](#)

How to make a complaint?

Continued areas of PCT focus (2)

- Helping developing countries benefit from the PCT
 - improve training for patent examiners (especially in developing and least developed countries), and better coordinate training already provided, so they can make appropriate use of the content of the PCT international phase reports
- Making PCT accessible to applicants of all types from all Contracting States
 - explore fee reductions (SMEs, universities, research institutes, individual applicants)

Continued areas of PCT focus (3)

■ ePCT: online interface to entire PCT international phase process (filing, submission of data and documents, file access) and ultimately national phase entry)

- real time access to IB files and bibliographic data
- flexible applicant-controlled access rights system
- where possible, replace applicant letters with directly usable input in system
- notifications of significant events and approaching deadlines
- Online electronic preparation and filing with real-time validations (currently with 43 receiving offices, including IB, Algeria, Austria, Australia, Azerbaijan, Brazil, Brunei, Bulgaria, Canada, Chile, Colombia, Cuba, Czech Republic, Denmark, EAPO, Estonia, EPO, Finland, Hungary, Iceland, India, Indonesia, Israel, Iran, Latvia, Malaysia, Mexico, New Zealand, Norway, Oman, Philippines, Poland, Portugal, Qatar, Republic of Korea, **Russian Federation (as of Jan. 1, 2016)**, Saudi Arabia, Slovakia, Sweden, Singapore, Turkey, South Africa, and the United States of America)
- Multilingual (10 language) interface available
- Bulk ePCT upload by IB possible for users
- Working on centralized fee payment mechanisms
- Also contains features/facilities for Office and Authority use (e.g., authoring search reports and written opinions)

Conclusion

- PCT has been and continues to be remarkably successful
- It continues to be refined, through constructive cooperation between patent offices, WIPO and PCT users
- There is more that can be improved to optimize the PCT's impact and its contribution to the international patent system

PCT Resources/Information

For further information about the PCT, see

<http://www.wipo.int/pct/en/>

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