

## Detailed Topics

### PCT Boot Camp

#### **Introduction to the PCT System**

- PCT Terminology
- PCT Texts and information sources
- Member States (countries)
- Statistics

#### **PCT Basics**

- PCT timeline
- The international application
- Minimum requirements for filing
- The applicant
- Where to file

#### **Filing of the PCT International Application**

- Required elements
- Detailed information on filling-out the paper version of the request (application) form

#### **PCT Fees**

- What fees are payable
- When to pay

#### **Introduction to PCT SAFE (Electronic filing)**

- Different options
- Fee reductions
- Benefits

#### **Priority Claims**

- What is priority
- How to claim priority
- Furnishing the priority document including Digital Access Service (DAS)

#### **An Overview of how to Correct Defects**

- Which corrections will not effect the filing date
- Which corrections will effect the filing date
- How to make corrections
- Information on WIPO's ePCT services

#### **Introduction to ePCT (with live demo)**

- How to set up an account
- Requesting a digital certificate
- Services with and without strong authentication

#### **Search and Written Opinion of the International Searching Authority**

- What is a search report
- What is a written opinion of the international searching authority

#### **International Publication**

- When does publication take place
- What is published

### **Amendments under the PCT**

- Amendments to the claims under Article 19
- Amendments to the description, claims and drawings under Article 34

### **Overview of Chapter II – filing the demand for preliminary examination**

- Basics of preliminary Examination
- Where, when and how to file a Demand for preliminary examination

### **Entry into the national phase**

- Time limits
- What is required

### **Where to get help**

- USPTO
- WIPO (Geneva)

## **Proposed Topics for PCT Strategy Presentation**

**Haynes Boone**

**(1 ½ Hours)**

- Brief overview of the PCT system (if needed)
- Selecting a receiving office (RO/US or RO/IB) - pros and cons of each
- Choosing an ISA - the advantages and disadvantages of each ISA available to US applicants
- Amendments under Articles 19 and 34 - when it makes sense to amend an IA
- Why/when to file a Demand for Chapter II
- National phase entry vs. "Bi-pass" continuation
- Using the PPH with the PCT

## **Curriculum Vitae for Gary Smith**

Mr. Smith is the founder and Managing Director of the PCT Learning Center, providing Patent Cooperation Treaty (PCT) training throughout the US. The company, founded in 2008 has delivered more than 60 public and private seminars in a dozen states. Mr. Smith is the principle lecturer based on his extensive background in patents and the PCT.

From 1995 through 2002, Mr. Smith served in the United Nations diplomatic corps as the Director of the Patent Cooperation Treaty at the World Intellectual Property Organization (WIPO). The PCT harmonizes the filing and processing of international patent applications in 152 member countries. In his last year at WIPO over 110,000 international patent applications were filed worldwide. Mr. Smith directed 500 staff from over 50 countries carrying out the legal, operational, administrative, and developing-country activities related to the treaty. During this period Mr. Smith oversaw reform that made the PCT system more user-friendly and cost efficient. While at WIPO he lectured extensively and presented numerous workshops to patent offices and patent practitioners throughout the world on the use of the PCT system, including India, China, Singapore, Korea, The Philippines, Kenya, Tanzania, Russia, Australia, Mexico and Brazil.

After leaving WIPO in Geneva, Switzerland and returning to the United States at the end of 2002, Mr. Smith continues his work in intellectual property as an IP consultant. In 2005, he completed a three-year World Bank-funded advisory to the management of the Turkish Patent Institute in Ankara Turkey on strategic, managerial, and operational issues. As a consultant with several different companies, Mr. Smith completed advisories to the Egyptian Patent Office (2004 – 2010 and 2015) that focused on issues related to patenting and organizational development as part of a USAID and EU funded projects. In 2008, he worked in Belgrade, Serbia on a USTDA funded project advising the Intellectual Property Office on process and organizational development issues. Recently, Mr. Smith assisted the IP Offices of Peru and Colombia in areas of Patent Cooperation Treaty (PCT) implementation and long term business planning. At the beginning of 2017 Mr. Smith completed an IP project in the Caribbean (Belize, Jamaica and Trinidad & Tobago).

Prior to his international work, Mr. Smith served 25 years at the US Patent and Trademark Office as a patent examiner, supervisory patent examiner, and Director of the PCT International Division. In recognition for outstanding contributions, Mr. Smith received many honors including the US Department of Commerce Gold medal.

Mr. Smith is a patent agent, registered to practice before the U.S. Patent and Trademark Office, member of the California State Bar IP Section (affiliate member) and is active in the San Diego Intellectual Property Law Association.