

# The Limited Monopoly™

## FILING INTERNATIONAL PATENT APPLICATIONS

### Tuning In To The Patent Cooperation Treaty

by Robert Gunderman, PE, John Hammond, PE and T. David Reed

*International Patent Applications are a complex topic as they involve local patent laws, translations, and a myriad of other complexities. Yet, in today's international economy, a basic understanding of what it takes to file international patent applications is vital. As this article goes to print, a seminar on international patents and the Patent Cooperation Treaty (PCT) will just be concluding on November 7 and 8 at the Lennox Tech Center. Copies of seminar materials will be available at [www.patenteducation.com](http://www.patenteducation.com) after the course for those who would like to obtain detailed information on the topic. For those who prefer the short version, here it is.*

#### Three ways to file

#### International Patent Applications

Essentially, there are three different ways to file international patent applications...

1. Contact patent agents in each foreign country where you plan to do business and file in each of these countries at the same time. Be sure to have ample cash on hand.
2. First file a patent application in a Paris Convention country and then file separate patent applications in other Paris Convention countries within 12 months of the filing of the first application.
3. Get up to speed and utilize the Patent Cooperation Treaty (PCT), a very useful way to file international patent applications that resulted from a multilateral treaty concluded in Washington in 1970 and entered into force in 1978. The PCT is administered by the international bureau of the World Intellectual Property Organization (WIPO), headquartered in Geneva, Switzerland.

#### The Patent

#### Cooperation Treaty (PCT)

The Patent Cooperation Treaty provides a way to initially file a single patent application that has effect in all countries that are a member of the Treaty. Currently, there are more than 135 member countries. Utilizing the PCT saves **money and time** -

two resources that are precious to most high tech companies. The decision to grant a patent still remains with each national patent office, but the PCT application consolidates much of the up front burden of filing a patent application internationally, and delays the major expenses of prosecution in individual countries. Under the PCT, an applicant can file a PCT application first, or file a PCT application claiming priority within 12 months of filing another application (such as a U.S. Provisional or Utility application.)

#### PCT Filing Requirements

The PCT application has specific filing requirements that many patent agents in the member countries of the PCT are familiar with. The PCT application can also be filed electronically in some countries. The PCT application can be filed with your national patent office (known as a "receiving office"), or directly with the International Bureau of the World Intellectual Property Organization in Geneva, Switzerland. It is important to note that you must be a resident or national of a PCT contracting state in order to file a PCT application. A listing of the PCT states can be found at [www.wipo.int/pct](http://www.wipo.int/pct). In the United States, for example, if the applicant is a U.S. inventor or company, the PCT application

can be filed through the United States Patent and Trademark Office (acting as the "receiving office"). This allows your U.S. patent agent to deal directly with the U.S. Patent and Trademark Office on a local basis, making for a streamlined and efficient process. The PCT process does, however,

have strict time deadlines that must be met to avoid potential abandonment of your application and possible loss of foreign patent rights. So know the process and treat it with respect. Mistakes can be costly.

A PCT application doesn't result in an issued patent by itself; that is the province of the national patent offices. PCT applications must enter the patenting process in most countries in which you are seeking patent protection within 30 months of the priority date. For applications filed at 12 months claiming priority to an earlier application, that's 18 months after the PCT filing date. The PCT process starts with the "international phase," starting with the initial filing of the PCT application, and ending with the entry and prosecution of patent applications in each country of interest (known as the "national phase"). This two step process gives you at least an additional 18 months to file in the foreign countries of interest than if you did not use the PCT. This extra time can be very useful to conserve cash resources, or to more closely evaluate and develop the business opportunities



and technical value of your invention in foreign countries. In addition to gaining more time to make your foreign patenting decisions, the PCT process also provides users with a comprehensive search report, an opinion on the criteria for patentability and an optional preliminary examination, to shed light on the chances of obtaining a patent in certain countries, thereby helping you to manage risk.

## Chapter I - The first part of the International Phase

When you file a PCT application, you are entering the first part of the international phase, known as **Chapter I**. Your patent application and drawings, formatted to comply with the PCT formality requirements, are filed in one language, in your local patent office or the international

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bureau and you pay one set of fees. Your PCT application is filed along with a form known as the “Request,” a document that contains vital information related to your PCT patent application. Your PCT application will also contain a request for a search, which is carried out by an international searching authority within 9 months of the PCT filing date if there is no prior application, or 16 months from the priority date of a prior application. This authority will issue an International Search Report and a Written Opinion on the novelty and non-obviousness of your invention. The International Search Report and Opinion contains information to help you to decide whether or not continuing to proceed with the expense and effort of the application process is worthwhile. You may also amend the claims of your PCT application to help further distinguish them from what was found in the search. If you want to file an amendment to your PCT claims, you must do it within two months of the date of the International



Search Report, or 16 months from your priority date, whichever is later.

18 months from your priority date, or close to that, your PCT patent application is published for the world to see. The International Search Report, and any claim amendments, are also published. If the search report is not ready at this time, it will be published later. The publication is done by the International Bureau of the World Intellectual Property Organization ([www.wipo.int](http://www.wipo.int)).

## Chapter II- An optional second part of the International Phase

You may also wish to rebut the findings in the written opinion through arguments or amendment. This can be done at your option by requesting international preliminary examination of your PCT application. This is done by filing a “Demand” for international preliminary examination. When a Demand is filed, it must be done with the necessary fees within the later of three months from the date of transmittal of the search report or 22 months from the priority date. If you do this, you are entering what is known as “Chapter II of the international phase.” You are entitled to respond to the Written Opinion on the patentability of your claims that was provided along with the International Search Report. After filing your response, the examining authority will consider your arguments and amendments, and then will issue an international preliminary report on patentability. This report is non-binding, but is carefully

considered by most examiners in the PCT member countries when the “national phase” is entered.

## The National Phase

The PCT process typically concludes at 30 months from priority when you enter the “national phase.” A number of countries give you more than 30 months to enter and some allow for extensions of time, but no country can require entry earlier than 30 months. This means obtaining a translation of your application into the local language, hiring a local agent (on most instances), paying all required fees and filing all necessary papers for that country. Your application will then follow the examination process of that country, as defined by the local patent laws. The search, opinion, and optional preliminary examination report, as well as any amendments made during the international phase, will all be considered by the examiners in the national offices when they make their decisions regarding patentability under local law.

In short, the PCT gives you more time to sort out your potential international market opportunities and the technical viability of your product on foreign soil while simplifying the highly complex task of obtaining patent protection in a number of countries. It also helps to defer the high cost of filing patent applications globally. □

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*Note: This short article is intended only to provide cursory background information, and is not intended to be legal advice. No client relationship with the authors is in any way established by this article.*

*This month we would like to thank T. David Reed, a senior PCT consultant from the World Intellectual Property Organization of Geneva, Switzerland, for his contributions to this article. Mr. Reed is also a registered Patent Agent in the U.S. and Canada. He is the featured speaker for our Comprehensive PCT Seminar held on November 7 and 8 at the Lennox Tech Center. The PCT seminar is being held by PatentEducation in cooperation with the World Intellectual Property Organization (WIPO).*