

The Limited Monopoly™

INTERNATIONAL PATENT LAW: PCT Applications - Amendments and Demands

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This article discusses what happens after you file an international patent application under the Patent Cooperation Treaty (PCT). The PCT is a patent application process, rather than a patent granting process. Patents are granted in each country that you select to enter via the PCT. So actions that you take with your PCT application can influence prosecution in each country that you enter through the PCT. This article will discuss some actions that can be taken after the PCT application is filed and before each country is entered.

A Refresher

There are several ways to file foreign patent applications in countries where you wish to pursue patent protection. You can first file directly in each foreign country through a patent agent in that country. You can also first file a patent application in a Paris Convention or WTO member country, and then file separate patent applications in other Paris or WTO countries within 12 months of filing that first application claiming priority to the first filing date. You can also initially file a single “international” patent application that has effect in all countries (currently 141) that are members of the PCT. Utilizing the PCT can save money and time. The filing requirements of a PCT application and strict time deadlines are understood by agents that practice before the various PCT international authorities including the International Bureau of the World Intellectual Property Organization (WIPO). A brief summary of the PCT

is available in our Limited Monopoly column of November 2007¹.

International Search and Written Opinion

A PCT application may claim priority to an earlier filed provisional, utility or foreign patent application, provided that it is filed within 12 months from the filing date of that application (the “priority date”). Your PCT application can also be the first filed application. At the end of processing under the PCT, you can proceed with your application in the U.S. and other PCT member countries when you enter the “National Phase.” The period of processing under the PCT is known as the “International Phase.”

Approximately 16 months from the priority date (or nine months from the PCT application filing date if there is no prior application), you will receive the International Search Report (ISR) and Written Opinion (WO) of the International Searching Authority (ISA). The International Searching Authority will

be one of thirteen ISAs (soon to be fifteen) in the PCT system, for example, the United States, Europe, Korea, Japan, Canada, Australia. The ISAs available for any given international application depend upon the citizenship or nationality of the applicant(s) and the Receiving Office where the case is filed. The International Search and Written Opinion will address the novelty, non-obviousness, and industrial applicability of your invention.

Article 19 Amendments

You may disagree with the Written Opinion received from the ISA. You have several opportunities to address the issues raised in the Opinion. The first opportunity is through an Article 19 amendment, which must be filed within two months from the date of transmittal of the Search and Written Opinion or 16 months from the priority date, whichever is later. An Article 19 amendment allows an applicant to amend only the claims in the application. It may be accompanied by a statement explaining the amendments to the claims and indicating any impact that such amendments might have on the description and the drawings (which cannot be amended under Article 19). The statement must be limited to 500 words, and must not contain any disparaging comments on the International Search Report. It must also be in the language in which the international application will be published. The statement will be published with the application and the amended claims.

The Demand for International Preliminary Examination

You also have the option to request International Preliminary Examination. This optional procedure provides the applicant with an opportunity to amend all parts of the application as well as submit arguments countering the findings in the Written Opinion of the ISA. It establishes a preliminary non-binding opinion by the International Preliminary Examining Authority (IPEA) on novelty, inventive step, and industrial applicability of your invention as described and claimed. To request International Preliminary Examination, a “Demand” is filed along 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 choose to file a “Demand” for International Preliminary Examination, you are entering what is known as “Chapter II of the international phase.”

Article 34 Amendments

You are entitled to amend the claims, as well as the description and the drawings, under Article 34 if, and only if, you file a Demand for International Preliminary Examination. An Article 34 Amendment may contain amendments to the claims, description, and drawings, and also may contain a reply to the Written Opinion. Article 34 Amendments are entered to deal with obstacles to patentability that have been raised by the Written Opinion, and are similar to an Office action response in U.S. patent prosecution. (New matter cannot be added to the application by amendment under either Article 19 or 34.)

Why bother if no patent will be granted?

As no patent will ever issue from a PCT application, why bother filing an Article 19 Amendment, a Demand, or an Article 34 Amendment? The reason is simple. These actions will likely reduce prosecution costs when your PCT application enters the national phase and is examined in each country that you choose. Most examiners carefully consider the Search, Written Opinion, and International Preliminary Report on Patentability. So if you can amend your claims and provide sound arguments in an Amendment, resulting in an International Preliminary Report on Patentability that is favorable, your costs to prosecute patent applications in national phase countries will be reduced. You will not need to file the same amendments and arguments, along with

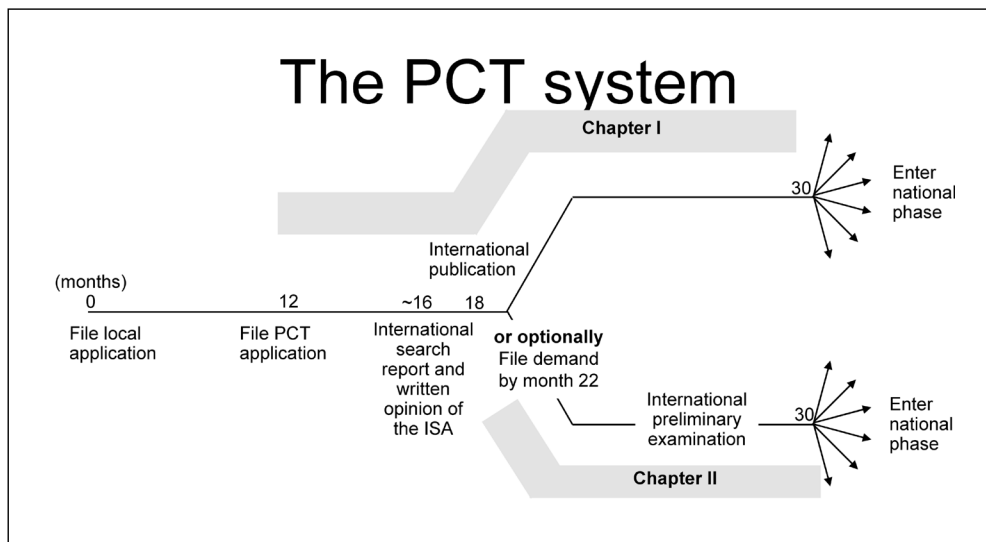
accompanying translations, fees, etc., in the patent applications that you file in each national phase country.

And on to the National Phase

After 30 months from the priority date, the international phase ends and, if the applicant chooses, the application enters the national phase in the various countries of interest. It is the responsibility of the applicant or the applicant’s agent to work with a patent agent in each country where patent protection is sought. The national phase starts by filing a request for entry moving the PCT application into the national examination process, in each of these countries. Most countries require a patent agent to be a citizen of that country in order to prepare and prosecute patent applications in that country.

Accordingly, patent agents that practice internationally typically contract with associate foreign patent agent firms to handle their foreign applications. Language, translations, and currency are just a few of the things that must be dealt with when practicing

international patent law. General knowledge of the patent laws in each country and a good network of foreign associates make the process much easier.



1. Reprints may be obtained at www.patenteducation.com/patentarticles.html under the topic “International Patent Applications.”

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