

The Limited Monopoly™

INTERNATIONAL PATENT LAW:

National Phase Entry - Life Worldwide After The PCT

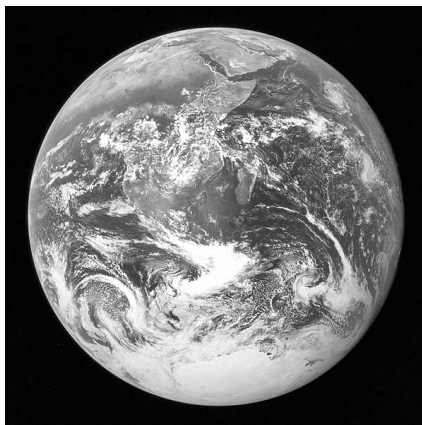
by Robert Gunderman, PE and John Hammond, PE

Filing Internationally

In today's world, most businesses cross international boundaries as a normal course of doing business each day. From materials purchased and goods sold to having a web site that can be seen by nearly anyone in the free world with access to a computer or a mobile device, the realities of international business are everywhere. Thus it is important to be aware of international intellectual property issues. If international patent protection is important to your business, you may have filed a Patent Cooperation Treaty (PCT) Application. A PCT Application provides a way to initially file a single patent application that has effect in all countries that are members of the treaty¹. A PCT Application does not, however, result in a patent. PCT applications must enter the patenting processes of all countries in which patent protection is desired within 30 months of the priority date in order to pursue protection in those countries. This is known as entering the "national phase," and there is a lot to know about this critical next step.

The 30 Month Deadline

Thirty months from your first priority date, you must file a national phase application in most countries. The priority date of a PCT Application is the earliest filing date that a PCT Application claims priority to. This may be a United States Utility Application, a United States Provisional Patent Application, a foreign patent application for non-U.S. entities. Alternatively, the PCT Application may be the first filed application, in which case the priority date is the filing date of the PCT Application itself. Filing a national phase entry typically involves working with your patent practitioner to obtain the services of a foreign patent agent who is licensed in that particular country. Most countries require their patent agents to be citizens and residents of their respective countries of practice. Foreign filings are complex, and involve meeting the deadlines and requirements of each country, dealing with translations as necessary, dealing with currency exchange, and ensuring that things are as represented by the patent agent in that country. This latter concern is typically not a problem with most reputable foreign firms in major industrialized countries, but there are horror stories of fees being paid in some of the more obscure countries, with no patent application being submitted. In the United States, most U.S. Patent Agents and Patent Attorneys who have an established international practice have built good relationships with foreign associates in most of the major countries, and will handle all of the details of the national phase entries. These services are termed "foreign liason services," since a U.S. patent practitioner cannot file in a foreign country directly, but instead requires the services of a foreign patent agent licensed in that country.



Eligible Countries

To file a national phase entry through the Patent Cooperation Treaty, a country must be a member of the treaty. Currently there are 144 member countries. These countries are listed in the PCT Applicant's Guide, available through the World Intellectual Property Organization (WIPO) at www.wipo.int. Suffice it to say that most, if not all, of the major industrialized nations are members of the treaty. Each country has its own patent laws and procedures to follow. While discussing each country would be impractical in this column, covering some of the key points of filing in a few of the major countries is in order.

Europe

Europe is considered a "region," and not a country. Accordingly, a filing in Europe through the European Patent Office (EPO) proceeds differently than filings in individual countries. The European Patent Office, headquartered in Munich, Germany, began in 1977 and is regulated by a treaty known as the European Patent Convention. The EPO is not part of the European Union, but is instead a separate organization. There are currently 38 member states in the European Patent Organisation. Also, there are several Extension States that must be designated at filing (for a fee) that will recognize European Patents upon request. Currently, those states are Bosnia and Herzegovina, and Montenegro. To file a national phase entry in Europe, one has 31 months from the first priority date (instead of 30), to make the deadline. There is an excess claims fee for claims that exceed 15, and it is common to amend claims at filing to avoid these fees. The Applicant must designate the countries in which patent protection is sought and pay a fee. Applications may be filed in English as well as French or German, and are prosecuted in the language of filing. A Request For Examination must be filed in order for the application to be examined. Examination typically involves Official Communications and Objections. Rejections can be taken to oral proceedings and finally to an appeal at the Board of Appeals. The decision of the Board of Appeals in Europe is final; there is no court of law to review its decision like in the U.S. Once an application has made it through prosecution, allowed by the Examiner, and granted as a European Patent, the Applicant must file translations in the designated countries within a specified time period or the invention enters the public domain in that country. It should also be noted that a European Patent is subject to the possibility of a third party opposition for nine months after patent grant. Additionally, an annual maintenance fee (an annuity) is required to be paid each year, whether the patent has been granted or not.

Japan

A patent application in Japan through the Patent Cooperation Treaty must be filed within 30 months of the first priority date. There are no extensions. A Request For Examination need not be filed at the initial filing date, but is required to have the patent application move to an Examiner and be prosecuted. A translation into Japanese must also be provided, but can be submitted up to two months after the initial filing date. Prosecution takes place in Japanese, and responses to Official Actions by the Examiner must be filed in Japanese. Once an application has been allowed, a registration fee is required along with prepayment of the first to third year annuities. Annuity payments for the life of the patent are required to keep the patent in force.

China

China is a member of the Patent Cooperation Treaty, and is a very popular choice for national phase entries. While their intellectual property system is still not perfect, each year it improves. With many companies doing business and manufacturing in China, Chinese Patent Applications are on the rise each year, and are one of the top national phase entry designations. A patent application in China through the Patent Cooperation Treaty can be filed 32 months from the first priority date by paying a nominal extension fee. A translation into Chinese is required at the time of filing (either 30 months, or 32 months with an extension). Like many other countries, an Examination Request must be filed in order for prosecution to take place. In China, there is an excess claims fee for claims over 10 and the claims count is based on the application as published, not the application as filed in China.

South Korea

South Korea requires a national phase entry to take place within 31 months of the first priority date. Filing must be in Korean, and the translation cannot be provided later, but must be provided at filing. Unlike many countries that require original signed documents like Power of Attorney forms, the Korean Patent Office will accept electronically transmitted documents (scanned or faxed).

India

India, like South Korea, requires a national phase entry to take place within 31 months of the first priority date. A translation must be provided at filing. In India, there is an excess claims fee for claims over 10 and the claims count is based on the application as published, not the application as filed in India. So it is not possible to reduce the claims fee by amending the claims at national phase entry. Like many other countries, a Request for Examination must be filed, and can be deferred.

Australia

Australia requires a national phase entry to take place within 31 months of the first priority date. Applications are filed in English and there are no excess claims fees. Like many other countries, examination can be deferred.

Canada

A national phase entry in Canada has a deadline of 30 months from the first priority date, but this deadline can be extended a full 12 months for a fee. Applications are filed in English and there are no excess claims fees. Examination can be deferred.

Mexico

Mexico requires a national phase entry to take place within 30 months of the first priority date. Applications are filed in Spanish, and a translation extension can be had with a fee. There are no excess claims fees, and an Examination Request is included with the initial filing.

Brazil

Brazil requires a national phase entry to take place within 30 months of the first priority date. Applications are filed in Portuguese, and a translation extension can be had with a fee; however, the claims must be translated by the national phase deadline. There are no excess claims fees, and Examination can be deferred.

United States

The United States can be a national phase entry either by a foreign entity or a U.S. entity. In fact, a U.S. applicant can choose to file a PCT as a first filed application and then enter the U.S. by way of a national phase filing via the PCT.² In the United States, a national phase entry must take place within 30 months of the first priority date. Applications are filed in English, and there are fees incurred for excess claims. The Examination Request is included in the initial application, and the United States, unlike most other countries, accepts electronic reproductions of original documents.

And on to filing...

While these are only a representative sampling of the top national phase entry countries, there are others. In fact, Russia sees a fair number of national phase entries, as does South Africa, Israel, New Zealand, Singapore, and many others. The decision to file in a specific country involves not only the business benefits to be gained, but also the ability to enforce a patent in that country should the need arise. This component is often overlooked, but very important. Costs of enforcement, as well as the strengths and weaknesses of the courts in that particular country, should all be considered. National Phase entries are expensive, and represent a significant decision for any company. Understanding some of the particulars of each potential national phase entry country is important for good decision-making.

1. See also [“The Limited Monopoly”™ November 2007. Filing International Patent Applications- Tuning in to the Patent Cooperation Treaty](#)
2. See also [“The Limited Monopoly”™ April 2010. Obtaining a United States Patent via the Patent Cooperation Treaty.](#)

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