

INTERNATIONAL (PCT) PATENT APPLICATIONS

PCT Applications

There is no such thing as an “international patent.” However, it is possible to file an “international patent application” (also called a “PCT application”) which, for a certain period of time, takes the place of the many individual foreign patent applications that would otherwise be required for protection abroad. After that period, the PCT application is converted into individual foreign patent applications, one in each country where patent protection is to be sought, and these patent applications may then be pursued individually to obtain foreign patents.

IN BRIEF

These PCT applications are made possible by the Patent Cooperation Treaty (PCT), which is an international agreement administered by the World Intellectual Property Organisation (WIPO) and covers most of the major industrial countries of the world. See our information sheet entitled PCT Member States.

Note that the PCT system does not examine patent applications fully and it does not grant patents. However, the PCT system

does enable you to delay the very expensive step of filing many individual foreign patent applications, and it does provide you with some information for assessing the prospects of actually obtaining granted patents, and their potential scope of protection, before major costs are incurred.

IT IS POSSIBLE TO FILE A SINGLE “INTERNATIONAL” OR “PCT” PATENT APPLICATION

Patent protection abroad

Usually, an applicant begins by filing a patent application at the local national patent office, for example the UK Intellectual Property Office. This establishes a priority date. If patent protection is required abroad, it is necessary to file foreign patent applications. If these foreign patent applications are filed within one year from the priority date (the priority period), then they count as if they had been filed on the priority date.

International patent applications

Instead of filing many individual foreign patent applications, it is possible to file a single “international” or “PCT” patent application, if all of the required countries/regions are members of the PCT. For a period, referred to as the International Phase, this PCT application takes the place of the many individual foreign patent applications that would otherwise have been required.

Afterwards, in a period referred to as the National/Regional Phase, the PCT application is converted into many individual foreign patent applications, one in each country where patent protection is to be sought.

The International Phase

The International Phase begins with the filing of the PCT application and ends when the PCT application is taken into (“enters”) the National/ Regional Phase. The International Phase consists of a Chapter I Phase and, if an optional Demand has been filed, a Chapter II Phase.

PCT applications are automatically subject to both search and examination. The examination may be without interaction between the applicant and the Examiner (under Chapter I) or with interaction between the applicant and the Examiner (under Chapter II).

The Chapter I Phase includes: filing the PCT application; preparation of the International Search Report (ISR) and the Written Opinion of the International Search Authority (WOISA); the optional filing of amended claims in response to the ISR; the optional filing of “informal comments” in response to the WOISA; and the publication of the international patent application, with the ISR and any amended claims which have been filed. If a Demand is not filed (see below), the WOISA is later reissued as the International Preliminary Report on Patentability under Chapter I (IPRP/ Chapter I).

The optional Chapter II Phase includes the filing of a Demand, usually with amendments and/or arguments to address any objections raised in the WOISA, and the subsequent preparation of the IPRP/Chapter II.

The Applicant(s)

Not everyone is allowed to file a PCT application. There must be at least one applicant who is a resident or national of a country that is a member of the PCT. The residences and nationalities of the applicants also determine where the PCT application can be filed. Note that if the PCT application is to cover the USA, then the inventors are also applicants.

If none of the applicants is a resident or national of a member state, then a PCT application cannot be filed. The UK is a member of the PCT. Thus, a UK company or a UK national or resident is entitled to file a PCT application, and it can be filed at the UK Intellectual Property Office. If none of the applicants is a UK resident or national, but at least one applicant is a resident or national of a PCT member state, then a PCT application can still be filed. Depending upon the details, we may still be able to file the PCT application on your behalf, for example at the European Patent Office (EPO) or at the International Bureau (IB) of WIPO in Geneva.

A PCT application automatically covers many countries, and it is possible to have different applicants for different countries.

Ownership

When any applicant in the PCT application is not also an inventor, we strongly recommend that, at the time of filing the PCT application, the inventor(s) sign an assignment document. This is intended to avoid or reduce possible difficulties of establishing ownership in various countries, particularly the USA, later on in the process, for example at the time of entry into the National/Regional Phase, when an inventor may be unavailable or unwilling to sign new documents. If you would like further information on assignments, please let us know.

Filing Formalities

If there is at least one applicant who is a UK resident or national, the PCT application is usually filed at the UK Intellectual Property Office. In such cases, the patent specification and the associated formal papers are filed in English.

It is generally necessary to provide the names, contact addresses and nationalities of the applicants, including the inventors. Again, if the PCT application is to cover the USA then the inventors are also applicants, and their details must be provided.

It is no longer necessary to choose which countries/regions or which types of protection (e.g., patents, utility models, etc.) you wish. Instead, the PCT application provides automatic coverage for all member states and all types of protection available under the PCT at the time of filing the PCT application. At present there are about 140 countries/regions: see our information sheet entitled PCT Member States.

Although in most cases it is no longer necessary to file additional documents (e.g. Appointment of Agent forms) signed by the applicants and inventors, this is still sometimes recommended. Also, it may be necessary to file good quality versions of any drawings.

The ISR and WOISA

Shortly after the PCT application has been filed, a copy will be forwarded to a competent national/regional patent office, who will act as the International Searching Authority (ISA) (for PCT applications filed at the UK Intellectual Property Office, the ISA is the EPO). The ISA will conduct a search of the relevant prior art, and will prepare both an International Search Report (ISR) and a Written Opinion (WOISA).

The ISR may include, for example, documents considered to be relevant for novelty and inventiveness. The WOISA is an initial opinion on the core patentability requirements: novelty, inventiveness and industrial applicability.

It is possible to file amended claims in reply to the ISR. It is also possible to file informal comments in reply to the WOISA. It is also possible to challenge the initial findings in the WOISA by filing a Demand (see below). If a Demand is not filed, the WOISA is later reissued without change as the IPRP/Chapter I.

Publication

The international patent application will be published on a Thursday shortly after 18 months from the priority date. The published claims will form the basis for “provisional protection” in those countries which offer it. If possible, the ISR will be included in the publication. If not, it will be published separately. If amended claims are filed in response to the ISR, these too will be published, and they will form the basis for “provisional protection.” The WOISA, and any informal comments filed in reply to the WOISA, will not be published. Publication can only be prevented by withdrawing the international patent application, no later than about three weeks before the expected publication date.

Chapter II Demand

PCT applications are automatically subject to examination. By default, the examination is performed without interaction between the applicant and the Examiner (under Chapter I). However, if a Demand is filed, examination is performed with interaction between the applicant and the Examiner (under Chapter II). For a more detailed discussion of the Chapter II Phase, please refer to our information sheet entitled Chapter II Demand.

Examination under Chapter II will be of most interest to applicants who wish to address one or more objections expressed in a negative WOISA, and thereby attempt to obtain a more positive IPRP. Also, examination under Chapter II permits central prosecution of the application before a single patent office, and can be used to reduce the number of objections that will need to be addressed later, during the National/Regional

**A PCT APPLICATION
AUTOMATICALLY COVERS
MANY COUNTRIES**

**THE INVENTORS ARE
ALSO APPLICANTS**

Phase, before individual patent offices. This is especially true for the European Regional Phase, where further examination essentially continues from where the international examination stopped.

The deadline for filing the Demand is the later of: 22 months from the priority date, and 3 months from the issuance of the WOISA. Amendments and/or arguments addressing the objections raised in the WOISA must be filed by the same deadline, and are usually filed at the same time as the Demand. The Examiner then reconsiders the WOISA, in view of any amendments and/or arguments that have been filed, and issues the IPRP/Chapter II.

The IPRP

The IPRP, whether under Chapter I or Chapter II, is a non-binding opinion on the core patentability requirements: novelty, inventiveness and industrial applicability. The IPRP often gives a good indication of the prospects of actually obtaining granted patents, and their potential scope of protection.

Many countries will use the IPRP as the starting point for further examination in the National/Regional Phase. However, some countries will ignore the IPRP and will conduct examination in the National/Regional Phase “from scratch”.

THE NORMAL DEADLINE FOR ENTERING THE NATIONAL PHASE IS 30 MONTHS

Entering the National/Regional phase

The PCT application itself will never become a patent. Instead, the PCT application must be taken into the National/Regional Phase in those countries/regions where patent protection is to be sought. This must be done by the appropriate deadline. Each of the resulting individual National/Regional Phase patent applications is then pursued, before the respective national/regional patent offices, in order to obtain individual granted foreign patents.

The normal deadline for entering the National/Regional Phase is 30 months from the priority date. Individual countries/regions may allow more time and, in practice, the deadline for most countries/regions is either 30 or 31 months from the priority date. In general, you will need to decide in which countries/regions you wish to proceed well before 30 months from the priority date. Note that, if desired, it is possible to enter the National/Regional Phase “early”, before the deadline.

Before April 2002, the deadline for entering the National/Regional Phase was 20 months from the priority date, unless a Chapter II Demand was filed by 19 months from the priority date, in which case the deadline for entering the National/Regional Phase was extended to 30 months from the priority date. In April 2002, the PCT was amended so that the deadline for entering the National/Regional Phase is 30 months from the priority date, whether or not a Demand has been filed by

19 months from the priority date. However, some “reservation” countries gave formal notification that their national laws were not compatible with the amended PCT and that the old deadline would continue to apply in their country. Most of these countries have since withdrawn their reservations. As at 1st December 2008, there are only three reservation countries: Luxembourg, Tanzania and Uganda. However, each of these countries can be reached via “Regional Phase” patent applications filed via the European Patent Office (EPO) and the African Regional Property Organisation (ARIPO) by the normal (30 or 31 month) deadline, and so, if the regional route is employed, then it is not necessary to file a Demand. However, if you wish to enter the National Phase in any of these countries (rather than the corresponding Regional Phase), then it is necessary to file a Demand by 19 months from the priority date if you wish to delay the National Phase deadline from 20 to 30 months.

Entry into National/Regional phase

The requirements for entering the National/Regional Phase are different for each country/region, and usually involve appointing a foreign attorney as your representative, filing a few formal documents, paying certain official fees and submitting a translation of the application into a local official language if necessary. Again, it may be necessary to obtain certain formal documents, signed by the applicants and the inventors.

For example, for an English language PCT application, it is necessary to prepare and file a Japanese language translation of the entire application within two months of entering the Japanese National Phase. Note that, for many countries, the translation must be filed no later than the National/Regional Phase deadline, and so you must allow sufficient time, before the deadline, for its preparation.

Further Examination

When the PCT application enters the National/Regional Phase, it is handled according to the usual treatment of patent applications in the countries or regions involved, and all of the local time limits, laws, rules, and procedures must be observed.

Some countries/regions, such as the USA and the EPO, may perform their own supplementary search before examining the application. After entering the European Regional Phase, further examination will almost certainly be performed by the same EPO Examiner who prepared the IPRP. If the IPRP was positive, then there should be no serious problems during the European Regional Phase

However, after entering the US National Phase, the US Examiner may pay little heed to what happened during the International Phase, and further examination may well be “from scratch”.

Advantages and Disadvantages of PCT

Advantages of the PCT route, as compared to filing individual foreign patent applications, include:

- lower costs at the end of the priority period;
- decisions about where to pursue patent protection, and the substantial costs of filing individual foreign patent applications, are delayed until the end of the International Phase (typically an additional period of about 18 months);
- if the decision to seek foreign patent protection is taken very near to the end of the one year priority period, there may not be sufficient time to prepare and file individual foreign patent applications; instead, a single PCT application, in English, can be filed.

Disadvantages of the PCT route, as compared to filing individual foreign patent applications, include:

- the overall costs are higher;
- it usually takes longer to get patents granted via the PCT route.

Costs

As a rough guide, the minimum cost of filing a PCT application, including the official fees but excluding the costs of drafting the specification, is approximately £3500 (excl. VAT). Typically, the total cost of filing a PCT application is about £4500-£6500 (excl. VAT).

The cost of filing an optional Demand, including the official fees but excluding the costs of filing any arguments and/or amendments in reply to the WOISA, is approximately £1500 (excl. VAT). Usually, about £450 of this cost will be recouped when entering the European Regional Phase.

The cost of entering the National/Regional Phase in a particular country/region is roughly the same as the cost of filing a "direct" patent application in that country/region. Typically, the cost for each country/region is in the range £1000-£4000 (excl. VAT), plus the cost of preparing a translation into a local official language if necessary. We can provide more precise estimates on a case-by-case basis.

This information is simplified and must not be taken as a definitive statement of the law or practice. For more information on Mewburn Ellis LLP and other intellectual property matters, please contact us or visit our website at www.mewburn.com. Mewburn Ellis LLP is a Limited Liability Partnership registered in England (no. OC306749). Registered Office at 33 Gutter Lane, London EC2V 8AS

London
33 Gutter Lane
London
EC2V 8AS
Tel: 020 7776 5300
Fax: 020 7776 5399

Bristol
22-24 Queen Square
Bristol
BS1 4ND
Tel: 0117 945 1234
Fax: 0117 926 5692

Manchester
Bridgewater House
Whitworth Street
Manchester M1 6LT
Tel: 0161 247 7722
Fax: 0161 247 7766

Cambridge
Newnham House
Cambridge Business Park
Cambridge CB4 0WZ
Tel: 01223 420383
Fax: 01223 423792