



The PCT

The Patent Cooperation Treaty (PCT) is an international agreement under the Paris Convention to promote international cooperation in the field of patents. The PCT is administered by the World Intellectual Property Organisation (WIPO) and has over 150 member states around the world. A PCT application is not an 'international patent' application as such, but it allows applicants to file a single patent application and seek protection in any of the member states. The PCT system does not grant patents of its own authority, however. After an initial search and examination procedure, the application is passed to the national offices of the member states in which protection is sought, where it is treated as a national application in that member state and fully examined, leading to potential grant.

The PCT procedure can be split into two phases – the International Phase, and the National Phase. The International Phase begins with the filing of the PCT application and ends at the beginning of the National Phase when the application is passed to the national offices of each member state in which patent protection is required.

The key milestones in the PCT application procedure are: Filing, International Search, International Publication, Supplementary International Search (optional), International Preliminary Examination (optional), and National Phase Entry.

Filing

Typically, applicants begin the procedure of obtaining protection for their invention by filing a patent application at their local national patent office. Within 12 months of that initial filing date (the priority date), the applicant can choose to file a PCT application, and claim priority from the initial application to retain the same initial filing date.

To file a PCT application, the applicant must be a national or a resident of a PCT member state. If

there are multiple applicants, at least one of them should meet this requirement. For example, a UK national or resident, or a UK company can file a PCT application as the UK is a PCT member state.

A PCT application can be filed directly with WIPO at its International Bureau (IB) or, if the applicant meets nationality or residency requirements, at the national or regional office of a PCT member state. For a UK applicant, a PCT application can be filed with either the UK Intellectual Property Office (UKIPO), the European Patent Office (EPO), or the IB of WIPO.

The office that the PCT application is filed with is referred to as the 'Receiving Office'. When the application is filed, the Receiving Office checks whether the application meets certain formality requirements. For instance, a PCT application should contain a request, a description of the invention, one or more claims, and any drawings. The request contains the applicant's details and serves to automatically cover all contracting states of the PCT system. Unlike many national patent systems, it is necessary to include at least one claim when filing a PCT application. Fees are due within 1 month of filing the application.

One advantage of the PCT system is that the application only needs to be filed in a single language. A translation may need to be provided later if the language is not accepted by the Receiving Office or the International Searching Authority (ISA), or if it is not a language of publication. Languages of publication include Arabic, Chinese, English, French, German, Japanese, Korean, Portuguese, Russian, and Spanish.

International Search and Written Opinion

After filing, the Receiving Office forwards the application to a patent office which acts as the 'International Searching Authority' (ISA). Each Receiving Office has at least one linked ISA which can perform the international search; for example, for PCT applications filed at the UKIPO, the ISA would be the EPO. Other Receiving Offices may have other linked ISAs, and it is important to consider which patent office you would like to perform the search when choosing which Receiving Office to file the application at.

The ISA produces an International Search Report (ISR) showing relevant prior art (i.e. published patent documents and other literature which may be relevant to the patentability of the invention), together with a 'Written Opinion' (WO), explaining whether the application meets the requirements for patentability. These must be issued within 3 months from the receipt of the search copy by the ISA, or 9 months from the priority date, if later. The ISR and WO, although not binding on the national offices, provide an early indication of the likelihood of achieving grant of the application once it enters the national phase.

It is possible to file amended claims in response to the ISR and WO, which will be published with the application. It is also possible to file informal comments in response, which will not be examined by the Examiner, but may be taken into account in the National Phase. Alternatively, to establish a further dialogue with the Examiner, it is possible to file a Demand for International Preliminary Examination (IPE).

Publication

The application is published shortly after 18 months from the priority date. After publication, third parties will be able to view documents relating to the application on WIPO's online patent database (PATENTSCOPE), including the ISR and WO. Applicants can prevent an application from being published by withdrawing their application approximately three weeks before publication.

Publication can also provide a basis for provisional protection before grant in member states which have this provision in their law. This protection is based on the claims as published, including any amendments filed in response to the ISR and WO.

International Preliminary Examination

IPE provides an opportunity for the application to be examined further during the International Phase. Opening up a dialogue with the Examiner provides an opportunity to achieve a positive

opinion on patentability before entering the National Phase. A positive opinion may positively influence the examination of the application before national offices. This may be particularly helpful in cases where there are many issues to be addressed that can be dealt with centrally during the International Phase, thereby reducing the number of objections that need addressing during the National Phase.

To enter IPE, the applicant must file a Demand and pay a fee before the expiry of 22 months from the priority date (or before 3 months from the issuance of the Written Opinion if this date is later). The applicant can also file arguments to address any objections raised in the Written Opinion and/or amendments to the description, drawings, and claims. The Examiner then examines the application, taking into account any arguments and/or amendments filed, and issues a second Written Opinion. The applicant has an opportunity to reply to the second Written Opinion with further arguments and/or amendments, with a typical deadline of 2 months. Following this, the Examiner issues an International Preliminary Report on Patentability (IPRP) at around 28 months from the priority date.

Although the IPRP provides an indication of the chance of achieving granted patents in the National Phase, it is non-binding on the national offices. Accordingly, a positive IPRP is not a guarantee that the application will be granted, as national offices may have slightly different patentability requirements and are free to come to their own conclusion.

If the applicant does not opt for IPE, the content of the IPRP will correspond to that of the first Written Opinion of the ISA.

Supplementary International Search

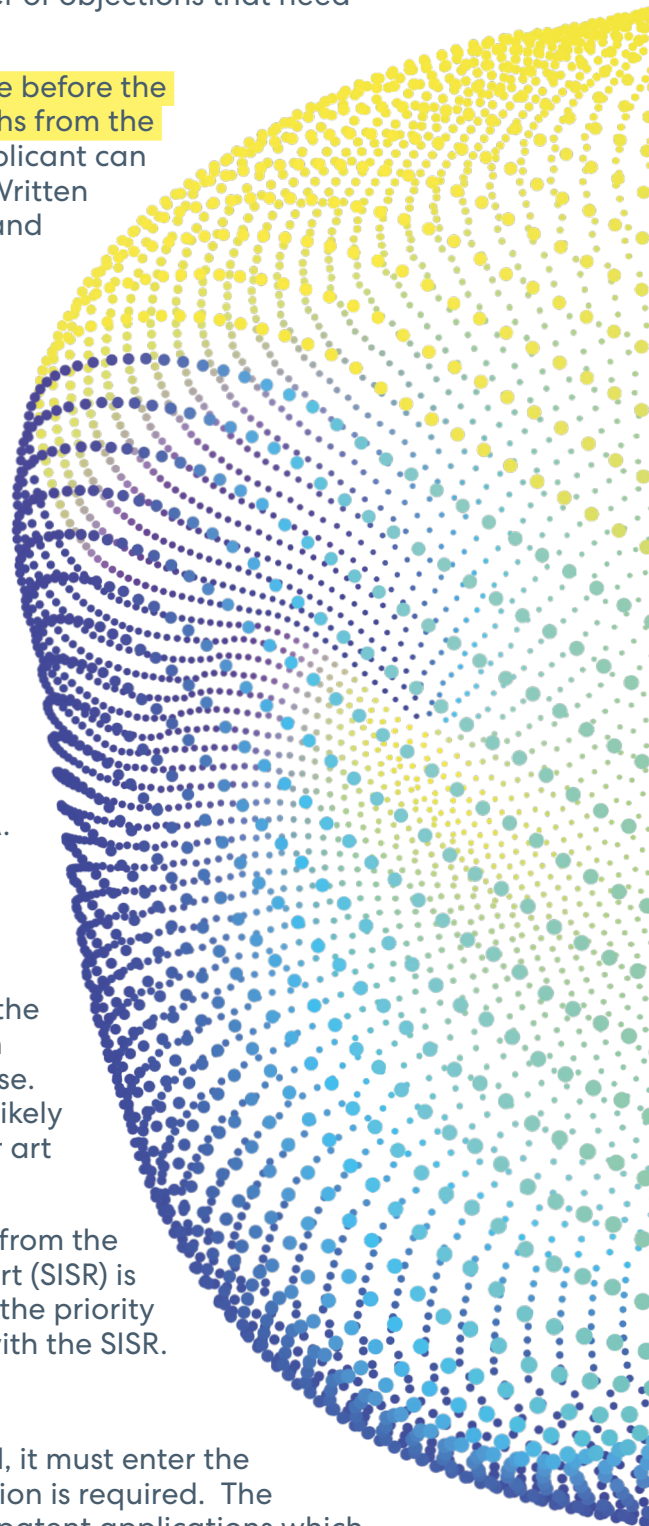
Although rarely used, Supplementary International Search (SIS) allows the applicant to request an additional search to be done by a different ISA. This allows for more diversity in the technical and linguistic scope of the search and can result in more relevant prior art being found in the International Phase. Opting to have an SIS in a country where the application is likely to enter the national phase may reduce the risk of new prior art being cited later on.

The SIS should be requested before the expiry of 22 months from the priority date. The Supplementary International Search Report (SISR) is similar in content to the ISR and is issued at 28 months from the priority date. However, unlike the ISR, no written opinion is issued with the SISR.

National Phase

For the PCT application to have the possibility to be granted, it must enter the National Phase in countries or regions where patent protection is required. The application is then treated as individual National/Regional patent applications which need to be pursued separately before the respective offices. The deadline for entering the national phase is typically either 30 or 31 months from the priority date depending on the country or region in which protection is being pursued (although there are some exceptions to this). As an example, the deadline for entering the regional phase before the EPO or the national phase before the UKIPO is 31 months from the priority date.

The requirements for entering the national phase can be different for each country/region. Typically, the applicant will need to pay fees, appoint a representative, and file a translation of the application into a local language.



After entry, the application is examined as a local application by the relevant national/regional patent office and will need to satisfy the local laws and procedural rules to achieve grant. Some patent offices will base their examination on the IPRP that was issued during the International Phase. Others, such as the EPO, will complete an additional search if the EPO was not the ISA.

Why use the PCT?

Delayed costs

When applications are filed directly in multiple countries without making use of the PCT procedure, costs such as translation fees, national office fees and local attorney fees are usually payable for each of the relevant countries on or soon after filing (i.e. around 12 months from the priority date). If the number of countries where protection is being pursued is large, these costs can be considerable. By instead filing a PCT application, these costs are delayed until the relevant national phases are entered (normally around 30/31 months from the priority date).

Reduced costs

A negative Written Opinion citing relevant prior art may persuade some applicants not to pursue protection in certain countries before national filing costs are incurred. A positive Written Opinion or amendments made to address objections during the international phase may reduce the prosecution costs during the national phase.

Flexibility

Markets, technology, and budgets may change during the prosecution of an application, which can influence which countries it is most beneficial to protect the invention in. The PCT route gives applicants more time (approximately 18 months) and information (via the Written Opinion) to decide which countries they would like patent protection in.

Is the PCT always the best option?

There are a few scenarios where using a non-PCT filing strategy may be better for an applicant.

Filing and prosecuting a PCT application incurs costs, so if the applicant already knows which countries they need protection in and the number of countries is small (e.g. less than 3), then it may be more cost-effective to file individual national applications and not use the PCT procedure.

Additionally, the delay offered by the PCT route may not always be desirable, particularly if the prospects of patentability are known to be strong early on or the applicant is certain about which countries they wish to pursue protection in.

In another example, if an applicant wishes to protect their invention in a country not bound by the PCT (e.g. Argentina), they would need to file an individual national application in that country.

An applicant should weigh-up whether the PCT route or the non-PCT route would be more suitable for their invention and budget. We can work with you to develop an international filing strategy that will help you get the most out of your intellectual property.

This is for general information only and does not constitute legal advice. Should you require advice on this or any other topic then please contact hlk@hlk-ip.com or your usual HLK advisor.