

## **INTERNATIONAL (PCT) APPLICATIONS**

In the normal course of events, foreign patent applications have to be filed by an absolute deadline of 12 months from the filing of the first UK application, that is within the "priority year". Unless all the countries of interest can be covered by a European or other regional patent application, translations into local languages are needed at this early stage and the costs can be very high (see our separate information sheet on Foreign Patents).

It is often not clear at this stage whether the invention will be of commercial significance. In addition, the applicant is not usually aware of all the relevant prior art, and does not know what scope of patent protection will be obtainable. It may therefore be extremely difficult for the applicant to decide in which countries it is worthwhile to pursue protection.

By using the Patent Cooperation Treaty (PCT) procedure some of the above problems can be avoided.

A PCT application can be filed at the end of the priority year, in English, designating over 150 member countries. The PCT application cannot itself proceed to grant, but must instead be converted into national patent applications which keep the benefit of the PCT filing and priority dates. The important advantage of the PCT is that it allows the costs and decisions involved in filing these national patent applications to be delayed.

### **PCT Procedure**

The PCT procedure consists of two main phases:

- the international phase, during which the single PCT application is processed by the international authorities.
- the national phase, during which the resulting separate national or regional patent applications are processed by the national patent offices.

### **The International Phase**

We usually file a PCT application at the UK Intellectual Property Office, which acts as a receiving office for the World Intellectual Property Organisation in Geneva. The application automatically includes designations of all the member countries of the PCT. The application undergoes a formalities check and after a few months an international search report is issued. The search report is prepared by the European Patent Office and includes a list of documents

considered relevant to the novelty and inventiveness of the invention. The search report is accompanied by a preliminary written opinion on whether a patent should be granted, based on the results of the search and on any other grounds for objection found when the search was carried out.

At about 18 months after the priority date, a copy of the international patent application is published, together with the search report. In most cases, that is the end of the International Phase and before 30 months from the priority date the application must proceed to the national phases, as discussed below. However, the applicant does have the opportunity of requesting an international examination.

### **International Preliminary Examination**

If the written opinion on patentability that accompanies the search report is unfavourable, then it might be worthwhile to file a request (known as a “demand”) for an international preliminary examination. An examination fee must be paid to the European Patent Office and the deadline for filing the demand is 22 months from the priority date. The examination procedure allows amendments and/or arguments to be filed in response to the written opinion; and one or more rounds of correspondence with the examiner may follow in an attempt to obtain a favourable international preliminary examination report.

The international preliminary examination report is not binding on the national patent offices during the subsequent national phases of the application. It is most important to obtain a favourable international preliminary examination report if national phases are contemplated in countries with less well-developed patent systems, where the local patent offices are likely to rely more heavily on the recommendation of the international authorities. More developed patent offices, such as those in the US and Japan, will conduct their own examination and form an independent view of the patentability of the invention.

### **The National Phases**

Entering the national phases involves the payment of fees to each chosen national office, the filing of a translation into the local language and the appointment of a local representative, just as in the case of a standard foreign filing.

For a European patent application, the fees are reduced to take into account the fact that a search (and in some cases an examination) has already been carried out by the European Patent Office during the international phase.

## **Advantages of the PCT**

The total cost of obtaining patents through the PCT route is more than by using the national or European systems directly. However, the PCT route has the following distinct advantages:

- PCT defers by up to 18 months the period at which the patenting process becomes most expensive.
- On filing, all member countries are automatically designated. Therefore, a wide range of options can be kept open at the early stage.
- The international search and examination give a good idea of whether an invention is likely to be patentable, before the decisions concerning the national phases have to be made.
- Arguments and amendments can be presented centrally, in English to the international examiner, thus saving the cost of instructing local attorneys separately.

We hope that you will find this general information helpful but this is a complex area of law and we strongly recommend that you seek our advice in relation to any particular case.