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Foreign Filing using the Patent Cooperation Treaty (PCT)

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If you intend to file a patent in multiple countries other than the United States, but are closing in on the one year date from the filing of your United States patent application and aren't sure yet which countries to file in, the [Patent Cooperation Treaty \(PCT\)](#) may be your best option. The traditional patent system requires filing a patent application for each country for which protection is sought, with a few exceptions, within twelve (12) months of the filing date of the initial application. This means the applicant must draft and file an application for each country where a patent is desired. This requires significant resources to be spent for translations and for patent attorneys in each of the various countries and fees for each of the countries, all while the applicant is unsure if the first patent will even issue. Once filed in foreign countries, formal examination of the patent is then carried out in each of the countries individually. Thus, a more efficient system was needed for filing international applications, which resulted in the Patent Cooperation Treaty patent application.

The Patent Cooperation Treaty is administered by the World Intellectual Property Organization (WIPO) and has other benefits than simply delaying the time for filing in a foreign country. It also may save the applicant money and the patent attorney time, although these latter two reasons alone are usually enough to convince an applicant to use the PCT system. Additionally, the PCT application allows you to delay the costs associated with foreign prosecution from twelve (12) months up to at least thirty (30) months from the date of your original US application. This allows an inventor time to ensure his U.S. patent issues and time to test or develop a market for his goods and/or services. After the thirty (30) months, you can then decide if you wish to pursue an application in any of the 137 contracting states of the PCT. Further, if you filed a Provisional Application in the United States, you would normally be required to file a non-provisional patent application within twelve (12) months. If you missed this date prior to the coming of the PCT, then you would have lost the ability to patent the subject matter within the provisional application. With the coming of the PCT, you can file your [PCT application](#) within twelve (12) months and list the U.S. as a Designated Office (DO). Your U.S. patent application then only needs to be filed before the thirty (30) months deadline of the PCT. Thus, your application and filing date back to your original provisional application are both retained.

The PCT allows you to delay the selection of countries in which you would like to file and their associated costs for up to thirty (30) months. Thus, you essentially gain an extra eighteen (18) months to make your decision in which foreign countries you wish to file. In addition to the ease of filing, more time to make final filing decisions and holding your geographic filing options open for a longer time, there are other reasons one would consider filing a PCT application. The publication of the application can often provide much needed publicity for the invention. This may be particularly important for new

technologies, universities, small businesses and/or start up companies. Additionally, a single search report and considered examination report affords the opportunity to subsequently advance prosecution in many foreign states with the effort of a single Office Action Response.

Although there is not an “[international patent](#)” *per se*, the Patent Cooperation Treaty facilitates filing in multiple countries by providing a single office at which to file your application. The PCT system is a patent filing system, not a patent granting system and thus, there is no “PCT Patent.” Specifically, the PCT system provides for an international phase during which the application is filed, an international search is conducted, and the international application is published, and optionally an international preliminary examination. After the international phase, the application is sent to each Designated Office (DO) or Elected Office (EO) and, upon payment of filing fees and/or provision of translated documents, the decision on granting patents is taken exclusively by the national or regional offices in their respective national phase. Each of these steps will be addressed in greater detail below.

The Request

The first step is the filing of the Request, which means that a PCT application is being filed with a request for a search. The PCT application, also known as an international application, is filed at a single Receiving Office (RO), thereby reducing the duplication of efforts both for the applicants and the national patent offices. If you are a citizen or resident of the U.S., you may file either with the United States Patent and Trademark Office (USPTO) or directly with the International Bureau (IB) at the World Intellectual Property Organization’s headquarters in Geneva, Switzerland. If you file the U.S. application first, you then have up to twelve (12) months in which to file the PCT application. Alternatively, if you file directly with the International Bureau, you may later elect the U.S. as a Designated Office (DO). Thus, it is beneficial to file the U.S. application first and gain an extra twelve (12) months before filing the PCT application, although the thirty (30) month time period still runs from the time of filing of the U.S. application. If you file your PCT application within twelve (12) months of filing your U.S. application, you are accorded the same filing date on the PCT application as you were on your U.S. application. That is, your PCT application will be treated in all countries in which you later file as if it was filed on the same day as your U.S. application. Further, your PCT application may automatically be designated to all 137 countries and as an added benefit, you only need to file in one of the approved languages (although translations may later be required). After the filing of the PCT application, an international search is conducted.

The search is conducted by the International Search Authority (ISA) to find the most relevant prior-art documents regarding the application. Relevant prior art, under the PCT, can briefly be described as consisting of everything which has been made available to the public anywhere in the world by means of a written disclosure, including the Internet, drawings and other illustrations. The International Search Authority (ISA) also checks unity of invention, the title of the application, the abstract of the application and

the selected figure of the application. Additionally, the International Search Authority (ISA) authorizes rectification of obvious errors if the error is in any part of the international application other than the request or in any paper submitted to the International Search Authority. After the international search is conducted on the application, an International Search Report (ISR) and an International Preliminary Report on Patentability (IPRP) will be issued.

The ISR (International Search Report)

The International Search Report (ISR) is normally provided by the International Search Authority (ISA) to the applicant three (3) months from the date of receipt of the search copy by the International Search Authority (ISA), nine (9) months after filing the application in the event of a first filing, or sixteen (16) months after the priority date in the event the application claims priority to a previous filing. The International Search Report (ISR) contains the International Patent Classification (IPC) for the invention, indications on the technical areas searched, indications relating to any finding of lack of unity, a list of relevant prior art documents and indication relating to any findings that a meaningful search could not be carried out in respect to certain, but not all, claims. The International Search Report (ISR) is published together with the international application (or as soon as possible afterwards). Any relevant prior art located will be addressed in the International Preliminary Report on Patentability (IPRP).

The IPRP (International Preliminary Report on Patentability)

The International Preliminary Report on Patentability – Chapter I (IPRP – Chapter I) contains an initial non-binding opinion regarding the patentability of the claims of a PCT application. Specifically, the International Preliminary Report on Patentability – Chapter I (IPRP – Chapter I) gives an opinion as to the novelty, inventive step (non-obviousness) and industrial applicability (narrowed utility) of an application. The IPRP – Chapter I will be sent along with the International Search Report (ISR) to the applicant. Although there is no formal procedure for responding to the IPRP – Chapter I, once it is received, the applicant may submit informal comments on the written opinion to the International Bureau, which then accompany the application to the Designated Offices (DO).

Upon receipt of the ISR and IPRP, a patent applicant has the opportunity to amend their claims (typically to overcome the references found in the ISR and the opinion as to the claims in the IPRP). This amendment via Article 19 must be accomplished within the later of two months of receipt of the ISR or 16 months from the priority date. Notwithstanding, even if not timely filed, the amendment may still be permitted if the technical preparation for publication of the application have not been completed.

All of the preceding processes are common to almost all PCT applications filed within the US; however, after the International Search Report (ISR) and the International Preliminary Report on Patentability issue, an applicant may choose PCT Chapter I in which the IPRP and any informal comments by the applicant, although initially confidential, are sent to all Designated Offices (DO) and become publicly available after

thirty (30) months from the priority date. Before the expiration of thirty (30) months from the priority date, the applicant may also enter the national phase as described in greater detail below. Alternatively, the applicant may choose to enter PCT Chapter II via filing a Demand.

The Demand

An applicant may optionally choose to proceed with PCT Chapter II. In this case, the applicant demands an International Preliminary Examination (IPE), the fees are paid and the International Preliminary Examination Authority (IPEA) issues a preliminary, non-binding opinion on novelty, inventive step (non-obviousness) and industrial applicability (narrowed utility) referred to as the International Preliminary Report on Patentability – Chapter II (IPRP – Chapter II). The International Preliminary Examination (IPE) does not, however, give an opinion on patentability according to the national laws of the various Elected Offices (EO) due to the differentiation of the laws. One of the major advantages of taking the Chapter II route is that the applicant is provided an opportunity to amend the entire PCT application under Article 34 before entering the national phase in the elected Offices, versus just attaching informal comments to the PCT application. Article 34 permits not only amendment of the claims, but also of the drawings and written specification, items that are not permitted under Article 19.

Further, the applicant also has the option to reply to the opinion and possibly have an oral interview with the Examiner. The International Preliminary Report on Patentability – Chapter II (IPRP – Chapter II) should be established by the International Preliminary Examining Authority (IPEA) the latest of twenty-eight (28) months from the priority date, eight (8) months from date of payment of fees or eight (8) months from date of receipt by International Preliminary Examining Authority (IPEA) of the translation. Once the IPRP – Chapter II is completed, the International Preliminary Examining Authority (IPEA) sends copies of the report to the applicant and to the International Bureau (IB). The International Bureau (IB) then forwards copies of the report and any required translations to the Elected Offices (EO) in which the applicant wishes to obtain a patent. Once the International Preliminary Report on Patentability – Chapter II is received at the Elected Offices, the National Phase begins.

National Phase Entry

National Phase begins as either Chapter I or Chapter II, dependant on route, and ends with the filing of the application in the selected countries. National Phase begins no later than thirty (30) months from the priority date for the PCT application (except for European Patent Application – 31 months - and a Canadian Patent Application 42 months with surcharges) and the applicant may select any or all of the 137 countries depending on which markets are most viable and where there is the highest likelihood of counterfeiting and/or infringement. National Phase entry simplifies many of the requirements of the Designated Offices (DO) or the Elected Offices (EO). Specifically, all priority documents will be transmitted by the International Bureau, the drawings will be transmitted to the Designated Offices (DO) or the Elected Offices (EO) unless there is

text in the drawings which requires translation and very few Offices require legalized or certified translations and simple translations generally suffice. Once in the National Phase, the prosecution of the patent begins and progresses as if the applicant had filed in that country originally. This means obtaining local counsel will likely be necessary and the application is subject to the formalities and examination of the Designated Offices (DO) or the Elected Offices (EO). Assuming all goes well, a [foreign patent](#) will issue in each of the offices as time progresses.

If you intend to file for patent protection in multiple countries, the PCT Application is often the best route to take to begin the process; however, it is recommended that you contact an attorney to discuss your options and obtain a legal opinion before making any final decision.

If you have any questions about this article, are interested in trying to obtain a patent in the United States, abroad and/or through the Patent Cooperation Treaty, please feel free to contact [Williamson Intellectual Property Law, LLC](#) of Atlanta, Georgia. Alternatively, feel free to read the other articles on similar subjects relating to both foreign and United States patent, trademark and copyright law.

The content of this article is not intended to be, and does not constitute, legal advice and does not create attorney-client privilege. Consult the attorney of your choice before embarking on any legal matter or any document preparation/filing.

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