



Patent Cooperation Treaty (PCT) applications

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Why should I file an international patent application?

When you are considering filing foreign patent applications, it's often not clear whether your invention will be commercially successful. In addition, you may not be clear about the scope of patent protection available, making it difficult to decide where you'll need to apply. This is where an international patent application under the Patent Cooperation Treaty (PCT) can be useful.

Eventually, an international patent application can be converted into one or more national and regional patent applications which keep the benefit of the international filing and priority dates. The significant advantage of the PCT system is that it allows the costs and decisions involved in filing these national and regional patent applications to be delayed by 18 months.

We can file the international patent application for you and help you through the subsequent steps.

When do I need to apply?

An international patent application can be filed at any time before the end of the so-called "priority year", i.e., twelve months from the filing date of your UK patent application. The international patent application will claim priority from the UK patent application and its "priority date" will be the date on which the earlier UK patent application was filed.

What does it involve?

The PCT process consists of two separate phases:

- The "international phase", during which the single international patent 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 (IPO), which acts as a receiving office for the World Intellectual Property Organisation (WIPO) in Geneva. The application is filed in English and automatically covers all the member countries of the PCT system – there are currently over 140. Once it has undergone a formalities check, an international search report is issued after a few months. This report is prepared by the European Patent Office (EPO) and includes a list of documents considered relevant to the novelty and inventiveness of the invention. It will be accompanied by a preliminary written opinion on whether a patent should be granted, based on the search results and any other grounds for objection found when the search was carried out.

Approximately 18 months after the priority date, a copy of the international patent application is published by WIPO, together with the search report. In most cases, nothing further is done during the international phase and the application proceeds to the national phase.

What if I don't agree with the written opinion?

If the written opinion that accompanies the search report is unfavourable about the patentability of your invention, then it might be worthwhile filing a request (known as a "demand") for international preliminary examination. We'll need to pay an examination fee to the EPO within 22 months of the priority date. The examination procedure allows amendments and/or arguments to be filed in response to the written opinion.

The international preliminary examination report will be considered by the national patent offices but it's not binding on them. It can be important to obtain a favourable international preliminary examination report if you are considering entering the national phase in countries with less well-developed patent systems, especially those where local patent offices are likely to rely heavily on the recommendation of the international authorities. More developed patent offices, such as those in Europe, the US and Japan, will conduct their own examination and form an independent view of the patentability of the invention.

The national phase

The national phase must be started no later than 30 months (or in some countries, 31 months) from the priority date of the international patent application. This is typically about 18 months after the international patent application was filed. We work with a worldwide network of patent attorneys so we can instruct a local attorney to take care of the national phase entry and, if necessary, to arrange for translation of the application into the local language. Once on file, the national applications usually go through their own search and examination procedure.

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 EPO during the international phase. If you want to convert the international patent application into a European patent application then this is something that we can handle for you directly.

What are the benefits of using the PCT route?

Although the total cost of obtaining patents via the PCT route may be higher than filing national or European patent applications during the priority year, it does offer the following distinct advantages:

- The most expensive part of the patenting process is deferred by up to eighteen months.
- On filing, all member countries of the PCT are automatically designated, so you can keep a wide range of options open before deciding which countries are most suitable for protection.
- The international search and optional 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 costs of translations and of instructing multiple local attorneys.