

PCT

PROTECTING YOUR INVENTIONS ABROAD: FREQUENTLY ASKED QUESTIONS ABOUT THE PATENT COOPERATION TREATY (PCT)



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INTRODUCTION

Set out below are a collection of frequently asked questions and their corresponding answers about the Patent Cooperation Treaty (PCT). For further information and contact points, see Question 26.

1) I have an invention. How can I protect it in several countries?

You have a few options. For example:

- (a) you can file separate patent applications at the same time in all of the countries in which you would like to protect your invention (for some countries, regional patents may be available);
- (b) you can file a patent application in a Paris Convention country (one of the Member States of the Paris Convention for the Protection of Industrial Property), and then file separate patent applications in other Paris Convention countries within 12 months from the filing date of that first patent application, giving you the benefit in all those countries of the filing date of the first application;
- (c) you can file an application under the PCT, which is simpler, easier and more cost-effective than either (a) or (b).

2) What is the Patent Cooperation Treaty (PCT)?

The PCT is an international treaty, administered by the World Intellectual Property Organization (WIPO), between more than 125 Paris Convention countries. The PCT makes it possible to seek patent protection for an invention simultaneously in each of a large number of countries by filing a single “international” patent application instead of filing several separate national or regional patent applications. The granting of patents remains under the control of the national or regional patent Offices in what is called the “national phase”.

Briefly, an outline of the PCT procedure includes the following steps:

Filing: you file an international application, complying with the PCT formality requirements, in one language, and you pay one set of fees.

International Search: an “International Searching Authority (ISA)” (one of the world’s major patent Offices) identifies the published documents which may have an influence on whether your invention is patentable and establishes an opinion on your invention’s potential patentability.

International Publication: as soon as possible after the expiration of 18 months from the earliest filing date, the content of your international application is disclosed to the world.

International Preliminary Examination: an “International Preliminary Examining Authority (IPEA)” (one of the world’s major patent Offices), at your request, carries out an additional patentability analysis, usually on an amended version of your application.

National Phase: after the end of the PCT procedure, you start to pursue the grant of your patents directly before the national (or regional) patent Offices of the countries in which you want to obtain them.

These steps in the PCT procedure are considered in more detail below.

FILING

3) What is the effect of an international patent application?

In general terms, your international patent application, provided that it complies with the minimum requirements for obtaining an international filing date (see PCT Article 11), has the effect of a national patent application (and certain regional patent applications) in all PCT Contracting States.¹ An international patent application must be prepared in accordance with certain formal requirements set out in the Treaty and Regulations, which have become international standards effective in all of the PCT Contracting States. If you comply with these requirements, subsequent adaptation to varying national (or regional) formal requirements (and the cost associated therewith) will not be necessary.

1. The list of those States can be found on the WIPO web site at www.wipo.int/treaties/en/documents/word/m-pct.doc.

4) Who has the right to file an international patent application under the PCT?

You are entitled to file an international patent application if you are a national or resident of one of the PCT Contracting States. If there are several applicants named in the international application, only one of them needs to comply with this requirement.

5) Where can I file my international patent application?

You can file an international patent application, in most cases, with your national patent Office, or directly with WIPO if permitted by the national security provisions in your national law. Both of those Offices act as PCT “receiving Offices”. If you are a national or resident of a country which is party to the ARIPO Harare Protocol, the OAPI Bangui Agreement, the Eurasian Patent Convention or the European Patent Convention, you may alternatively file your international patent application with the regional patent Office concerned, if permitted by the applicable national law.

6) Can I file PCT applications electronically?

You can file PCT applications electronically with receiving Offices which accept such filings. Full electronic filing is possible with the PCT receiving Office at WIPO. WIPO’s electronic filing software, PCT-SAFE (“Secure Applications Filed Electronically”), which can be downloaded from the PCT web site or obtained free of charge on a CD-ROM, helps PCT applicants to prepare their international applications in electronic form and to file them either via secure on-line transmission or on CD-R or diskette. While the data about the application is being entered, the PCT-SAFE software validates the entered data and draws the applicant’s attention to incorrectly or inconsistently completed parts. It is possible to attach the application text and drawings in XML (eXtensible Markup Language) as well as in other electronic formats, such as PDF or TIFF format (the file formats available depend on the receiving Office selected). Applicants who file electronically are entitled to certain PCT fee reductions – the highest reductions are applicable when the filing format is XML. More details about PCT electronic filing can be found at www.wipo.int/pct-safe/en/.

7) What are the costs associated with the filing and processing of an international application under the PCT?

PCT applicants generally pay three types of fees with the filing of their international applications: an international filing fee of 1,400 Swiss francs (the equivalent of approximately 1,100 US dollars depending on the applicable exchange rate), a search fee which can vary from approximately 180 to 1,900 US dollars depending on the International Searching Authority chosen, and a small transmittal fee which varies depending on the receiving Office. Because an international patent application is effective in all PCT Contracting States, you do not incur, at this stage in the procedure, the costs that would arise if you prepared and filed separate applications for all of those States; you have to pay only a single set of fees for filing the international patent application with the PCT receiving Office. These fees cover the filing, searching and publication of the international patent application, and are payable in the currency, or one of the currencies, accepted by the receiving Office. Further information about PCT fees can be obtained from the receiving Offices, the *PCT Applicant's Guide* and the *PCT Newsletter* (see Question 26).

The fees you will need to pay as you enter the national phase represent the most significant pre-grant costs. They can include fees for translations of your application, national (or regional) Office filing fees and fees for acquiring the services of local patent agents. In several Offices, national filing fees are lower for international patent applications than they are for direct national applications. You should also remember that in the case of all granted patents, whether or not the PCT is used to obtain them, you will need to pay maintenance fees in each country in order to keep the patents alive.

8) Are there any fee reductions available under the PCT?

PCT fee reductions are available to applicants who file electronically, based on the type of filing and the format of the application submitted (see Question 6). In addition, an applicant who is a natural person and who is a national of and resides in a State whose per capita national income is below 3,000 US dollars is entitled to a reduction of 75% of certain fees, including the international filing fee. This same 75% reduction applies to any person, whether a natural person or not, who is a national of and resides in a country

classified by the United Nations as a “least developed country”. If there are several applicants, each must satisfy those criteria. For more details, including the list of the PCT Contracting States the nationals and residents of which are eligible for such fee reductions, please refer to the *PCT Applicant’s Guide* or contact the PCT Information Service (see Question 26).

9) How long does the PCT process take?

You have, in most cases, 18 months from the time you file your international patent application (or 30 months from the filing date of the initial patent application of which you claim priority – see Question 10) before you have to begin the national phase procedures with individual patent Offices. This means that you normally have at least 18 additional months before you have to fulfill the national requirements (see Question 23) than if you do not use the PCT.

This additional time can be useful for evaluating the chances of obtaining patents and exploiting your invention commercially in the countries in which you plan to pursue patent protection, and for assessing both the technical value of your invention and the continued need for protection in those countries.

It is important to note, however, that you don’t have to wait for the expiration of 30 months from the earliest filing date of your patent application (“priority date”) before you enter the national phase – you can always request an early entry into the national phase (see PCT Articles 23(2) and 40(2)).

In the national phase, each patent Office is responsible for examining your application in accordance with national or regional patent laws, regulations and practices resulting in, if all things are favorable, the grant of a patent. The time required for the examination and grant of a patent varies across patent Offices.

10) Can priority of an earlier patent application be claimed?

Generally, patent applicants who wish to protect their invention in more than one country first file a national or regional patent application with their national or regional patent Office, and within 12 months from the filing date of that first application (a time limit set in the Paris Convention for the Protection of Industrial Property), they file their international application

under the PCT. Thus, in an international patent application, you may claim the priority, under the Paris Convention – and to a certain extent within the framework of the World Trade Organization –, of one or more earlier patent applications for the same invention, whether they were national, regional or international applications, for up to 12 months after the filing of the earliest of those applications. If you do not claim priority of an earlier application, the priority date for the purposes of the PCT procedure will be the international filing date of the international application. During the PCT procedure, priority claims can be added and corrected, within certain time limits.

11) In what languages can an international patent application be filed?

In general, an international patent application can be filed in any language which the receiving Office accepts. If you file your application in a language which is not accepted by the International Searching Authority that is to carry out the international search, you will be required to furnish a translation of the application for the purposes of international search. Receiving Offices are, however, obliged to accept filings in at least one language which is both a language accepted by the competent International Searching Authority that is to carry out the international search (see Question 12) and a “publication language”, that is, one of the languages in which international patent applications are published (Chinese, English, French, German, Japanese, Russian and Spanish). You therefore always have the option of filing your international patent application in at least one language from which no translation is required for either PCT international search or publication purposes.

INTERNATIONAL SEARCH

12) Who will carry out the international search of my PCT application?

The following have been appointed by the PCT Contracting States as International Searching Authorities (ISAs): the national Offices of Australia, Austria, Canada, China, Finland, Japan, the Republic of Korea, the Russian

Federation, Spain, Sweden and the United States of America, and the European Patent Office. The availability of a particular ISA to the nationals or residents of a country is determined by the receiving Office where the international application was filed. Some receiving Offices provide a choice of more than one competent ISA. If your receiving Office is one of those, you can choose any one of them, taking into account differing requirements relating to language, fees, etc.

13) What is a PCT international search?

A PCT international search is a high quality search of the relevant patent documents and other technical literature in those languages in which most patent applications are filed (that is, English, French and German, and in certain cases, Chinese, Japanese, Russian and Spanish, and from April 1, 2007, Korean). The high quality of the search is assured by the standards prescribed in the PCT for the documentation to be consulted (see PCT Rule 34), and by the qualified staff and uniform search methods of the ISAs, which are all experienced patent Offices. The international search is carried out in accordance with the International Search and Preliminary Examination Guidelines (available on the PCT web site: www.wipo.int/pct/en/texts/gdlines.htm) and results in an international search report and a written opinion of the ISA on the potential patentability of your invention.

14) What is an international search report?

The international search report consists mainly of a listing of references to published patent documents and technical journal articles which might affect the patentability of the invention claimed in the international application. The report contains indications for each of the documents listed as to their possible relevance to the critical patentability questions of novelty and inventive step (non-obviousness). Together with the search report, the ISA prepares a written opinion on patentability, which will give you a detailed analysis of the potential patentability of your invention (see Question 16). The international search report and the written opinion are to be communicated by the ISA to you by the fourth or fifth month after the filing of the international patent application.

15) What is the value of the international search report?

The report enables you to evaluate your chances of obtaining patents in PCT Contracting States. An international search report which is favorable, that is, in which the documents cited would appear not to prevent the grant of a patent, assists you in the further processing of your application in those countries in which you wish to obtain protection. If a search report is unfavorable (for example, if it lists documents which challenge the novelty and/or inventive step of your invention), you have the opportunity to amend the claims in your international patent application (to better distinguish your invention from those documents), and have them published, or to withdraw the application before it is published. The high quality of the international search assures you that any patent granted from an international application is less likely to be successfully challenged, and thus provides valuable input in support of investment decisions.

16) What is the written opinion of the International Searching Authority?

For every international application filed on or after 1 January 2004, the ISA will establish, at the same time that it establishes the international search report, a written opinion which is a preliminary and non-binding opinion on whether the invention appears to meet the patentability criteria in light of the search report results. That opinion is sent to you and to WIPO together with the international search report. The written opinion helps you understand and interpret the results of the search report with specific reference to the text of your international application, being of special help to you where you want to evaluate your chances of obtaining a patent without incurring the additional cost of international preliminary examination.

Applicants can, if they wish, submit informal comments to WIPO in response to this written opinion; in this way, they have an opportunity to respond to the reasoning and conclusions of the written opinion even if they do not plan to take advantage of international preliminary examination (see Question 18).

If you do not request international preliminary examination, the written opinion of the ISA will form the basis of the international preliminary report on patentability (IPRP (Chapter I)) which will be communicated by the International Bureau to all PCT Contracting States patent Offices which request it, together with any informal comments submitted. However, if you do request international preliminary examination, the written opinion of the ISA will, in general, be used by the International Preliminary Examining Authority (IPEA) as its own first written opinion, unless the IPEA notifies WIPO to the contrary.

The content of the IPRP (Chapter I) will also be very useful for patent Offices in deciding whether or not to grant the patent, especially for those Offices which do not carry out significant substantive examination.

This report is made available to the public once 30 months from the priority date have expired.

INTERNATIONAL PUBLICATION

17) What does international publication under the PCT consist of?

WIPO publishes the international application shortly after the expiration of 18 months from the priority date (if it has not been withdrawn earlier), together with the international search report. You receive a copy of the published international application, and each PCT Contracting State receives a copy of all published international applications.

In addition, WIPO publishes the weekly *PCT Gazette* which contains basic data about the international applications published that week in a uniform and abbreviated format. The *Gazette* can be found at www.wipo.int/pct/en/gazette/index.jsp – it is searchable (by bibliographic data, text of the title and abstract, and by full text soon after publication), and the interface is multilingual (English, French, Spanish).

INTERNATIONAL PRELIMINARY EXAMINATION

18) What is international preliminary examination?

International preliminary examination is a second evaluation of the potential patentability of the invention, using the same standards on which the written opinion of the ISA was based. If you wish to make amendments to your international application in order to overcome documents identified in the search report and conclusions made in the written opinion of the ISA, international preliminary examination provides the only possibility to actively participate in the examination process and potentially influence the findings of the examiner before entering the national phase – you can submit amendments and arguments, and are entitled to an interview with the examiner. At the end of the procedure, an international preliminary report on patentability (IPRP Chapter II) will be issued. The International Preliminary Examining Authorities (IPEAs) which carry out the international preliminary examination are the International Searching Authorities mentioned above (see Question 12). For a given international patent application, there may be one or more competent IPEAs; your PCT receiving Office can supply details or you may consult the *PCT Applicant's Guide* and the *PCT Newsletter*.

19) What is the value of the international preliminary report on patentability (Chapter II)?

The IPRP (Chapter II) which is provided to you, with copies also being sent to WIPO and by WIPO on to the patent Offices of the Contracting States which request it, consists of an opinion on the compliance with the international patentability criteria of each of the claims which have been searched. It provides you with an even stronger basis on which to evaluate your chances of obtaining patents, and, if the report is favorable, a stronger basis on which to continue with your application before the national and regional patent Offices. The decision on the granting of a patent remains the responsibility of each of the national or regional Offices in which you enter the national phase; the international preliminary examination report should be considered by the Offices but is not binding on them.

ADDITIONAL GENERAL QUESTIONS CONCERNING THE INTERNATIONAL PHASE

20) What is the role of WIPO in the PCT?

For each PCT application filed, WIPO is responsible for:

- receiving and storing all application documents;
- performing a formalities examination;
- publishing the application;
- publishing the *PCT Gazette* (data about the application);
- translating various portions of the PCT application and certain associated documents into English and/or French, where necessary;
- communicating documents to Offices and third parties; and
- providing legal advice on request to Offices and users.

WIPO also:

- provides a framework for overall coordination of the PCT system;
- provides assistance to existing, new and potential Contracting States and their Offices;
- provides advice on implementing the PCT in the national legislation and on setting up internal procedures in the Contracting States' patent Offices;
- publishes the *PCT Applicant's Guide* and the *PCT Newsletter*;
- creates and disseminates PCT information via the PCT web site, paper publications and through telephone and e-mail assistance;
- organizes and gives PCT seminars and training courses.

21) Who uses the PCT?

The PCT is used by the world's major corporations, research institutions and universities² when they seek international patent protection. And it is likewise used by small and medium-sized enterprises and individual inventors. The *PCT Newsletter* (see www.wipo.int/pct/en/newslett/index.jsp) contains a yearly list of the largest PCT filers.

2. Such as Philips, Siemens, Matsushita, Sony, Nokia, Motorola, 3M, Intel, Procter & Gamble, Du Pont, Mitsubishi and the University of California.

22) Can third parties access documents contained in the file of the international patent application? If so, when?

Until international publication (18 months after the priority date), no third party is allowed access to your international patent application unless you request or authorize it. If you wish to withdraw your application (and you do so before international publication), international publication does not take place and, as a consequence, no access by third parties is permitted. However, where international publication occurs, certain documents in the international application file are made available electronically together with the published international application (see “PCT Online File Inspection” at www.wipo.int/patentscope/en/database/search-adv.jsp) and third parties can request copies of most other documents contained in the file of the international application (see PCT Rule 94); such requests may be made either to WIPO or the national or regional Offices, depending on the document concerned. Under certain conditions, third parties can also have access to the written opinion established by the International Searching Authority, including any informal comments submitted by the applicant, and to the international preliminary examination report.

NATIONAL PHASE

23) How do I enter the national phase?

It is only after you have decided whether, and in respect of which States, you wish to proceed further with your international application that you must fulfill the requirements for entry into the national phase. These requirements include paying national fees and, in some cases, filing translations of the application. These steps must be taken, in relation to the majority of PCT Contracting States’ patent Offices, before the end of the 30th month from the priority date. There may also be other requirements in connection with the entry into the national phase – for example, the appointment of local agents. More information on national phase entry in general can be found in Volume II of the *PCT Applicant’s Guide*, and specific information concerning fees and national requirements can be found in the national chapters for each PCT Contracting State in the same *Guide*.

24) What happens to my application in the national phase?

Once you have entered the national phase, the national or regional patent Offices concerned begin the process of determining whether they will grant you a patent. Any examination these Offices may undertake should be made easier by the PCT international search report and the written opinion, which enable you to make necessary amendments to the claims in the application even before the national procedure starts. It is facilitated even more by the international preliminary examination procedure during which further amendments (and their patentability evaluation) are possible. You also achieve other savings in communications, postage and translations because the work done during the international processing is generally not repeated before each Office (for example, you submit only one copy of the priority document instead of having to submit several copies).

ADVANTAGES

25) What are the advantages of the Patent Cooperation Treaty?

The procedure under the PCT has great advantages for you as an applicant, for the patent Offices and for the general public:

- (i) you have up to 18 months more than if you had not used the PCT to reflect on the desirability of seeking protection in foreign countries, to appoint local patent agents in each foreign country, to prepare the necessary translations and to pay the national fees;
- (ii) you can rest assured that, if your international application is in the form prescribed by the PCT, it cannot be rejected on formal grounds by any PCT Contracting State patent Office during the national phase of the processing of the application;
- (iii) on the basis of the international search report and the written opinion, you can evaluate with reasonable probability the chances of your invention being patented;

- (iv) you have the possibility during the optional international preliminary examination to amend the international application and thus put it in order before processing by the various patent Offices;
- (v) the search and examination work of patent Offices can be considerably reduced or eliminated thanks to the international search report, the written opinion and, where applicable, the international preliminary report on patentability that accompany the international application;
- (vi) since each international application is published together with an international search report, third parties are in a better position to formulate a well-founded opinion about the potential patentability of the claimed invention; and
- (vii) for you as an applicant, international publication puts the world on notice of your application, which can be an effective means of advertising and looking for potential licensees.

Ultimately, the PCT:

- brings the world within reach;
- postpones the major costs associated with international patent protection;
- provides a strong basis for patenting decisions; and
- is used by the world's major corporations, research institutions and universities when they seek international patent protection.

FURTHER INFORMATION

26) Where can I find out more about the PCT?

In the various PCT publications:

- *PCT Applicant's Guide* (www.wipo.int/pct/guide/en/index.html);
- *PCT Newsletter* (monthly) (www.wipo.int/pct/en/newslett/index.jsp);
- *PCT Gazette* (weekly) (www.wipo.int/pct/en/gazette/);

and on the PCT web site (www.wipo.int/pct/en/).

If you are considering filing an international patent application under the PCT, we advise you to consult a qualified patent attorney or agent in your country, and/or your national or regional patent Office.

PCT Information Service (for general questions about the PCT):

Telephone: (+41 22) 338 83 38

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E-mail: pct.infoline@wipo.int

For filing international applications directly with WIPO, please contact:

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Orders sent by fax, mail or e-mail have the following payment options in addition to credit cards:

- payment to WIPO account No. 487.080-81 at the Swiss Credit Bank, 1211 Geneva 70;
- debit from current account at WIPO.



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