

International Patent Applications under the Patent Cooperation Treaty (PCT)



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IP Brochure

The Patent Cooperation Treaty (PCT) enables applicants to initiate patent protection for an invention in almost any country of the world (as of March 2014, there are 153 PCT contracting states) by means of a single international patent application – the PCT application. Following a centralized search of the international patent application, the applicant obtains a detailed preliminary assessment of the patentability of the invention – the international preliminary report on patentability.

The international application, however, does not lead to an “international patent”. On the contrary, within 30 or 31 months (depending on the respective country) after the priority date of the international application, applicant has to select national/regional patent offices of the countries or regions, where patent protection is finally desired. Each selected national/regional patent office then independently decides on the patentability of the international patent application in the respective country/region.

Filing a single international patent application not only results in less administrative efforts in the early stages of the application but also has an important strategic advantage: since a considerable portion of the overall costs is postponed until the national/regional phases, applicants can use the time to evaluate the commercial success of the invention or to find investors. As a result, a sound selection can be made of the countries in which patent protection is eventually sought.

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1. Timeline

Although applicants may directly file an international patent application for an invention, an international patent application can also claim the priority of an earlier filing for the same invention, for example a preceding German, European or US (provisional) patent application. In this case, the international application has to be filed not later than 12 months after the filing of the first patent application. The actual PCT procedure comprises two main stages: an international phase and national phases, which are described in the following illustration:

2. International phase

Around 16 months after the priority date (*i.e.* either the filing date of the PCT application or the filing date of a preceding priority application) an International Search Report (ISR) and an accompanying Written Opinion of the International Search Authority (WOISA) are issued. The ISR is a listing of relevant prior art citations found in the search (patent documents, technical documentations, scientific publications, etc.). The WOISA includes a preliminary assessment of whether the invention appears to be novel, inventive and susceptible to industrial application. 18 months after the priority date, the PCT application is published together with the ISR (but without the WOISA). If the WOISA is positive with regards to the patentability of the invention, the applicant may directly enter the subsequent national/regional phases. In this case, the WOISA transforms into the International Preliminary Report on Patentability (IPRP). However, if objections are raised in the WOISA against the patentability of the invention, the applicant may try to overcome these objections already in the international phase by filing a request for international preliminary examination, together with a response to the WOISA and by amending the application, if necessary. Around 28 months from the priority date, the IPRP will then be issued which assesses the invention in view of the arguments and/or amendments provided in the response to the WOISA. The IPRP is transferred to the national/regional patent offices upon entry into the national/regional phase.

3. National phases

The entry into the national/regional phases – which is due within 30 months after the priority date in some countries and 31 months in others – marks the end of the international phase. At this point, the PCT application transforms into a number of independent national/regional patent applications all of which have the common filing date of the international patent application but which are examined independently from each other in front of the national/regional patent offices selected by applicant. While the national/regional patent offices – which ultimately decide on the patentability of the invention – are not bound to the assessment in the IPRP, experience shows that a positive IPRP improves applicant's position and may expedite the national/regional examination and granting procedures.

4. Benefits

4.1 Postponing costs when filing the invention

Without the PCT procedure, applicants would have to file within the priority year national/regional patent applications in all countries/regions in which patent protection is sought, typically in a variety of different languages. By means of the PCT procedure, only a single PCT application in one language is needed. As a result, the major part of the overall costs (e.g. translations of the specification into various languages, official fees charged by the national/regional patent offices and attorney fees) are only due when entering the national/regional phases, i.e. up to 30 or 31 months after the initial filing. This time may be used by the applicant to assess whether the invention is a commercial success, to find investors, or to further develop the related products.

4.2 Preliminary examination of the invention

In addition to the above benefits, the information on the patentability of the invention, which applicants obtain during the PCT procedure, i.e. the ISR, WOISA and IPRP, is helpful to decide whether or not to enter the national/regional examination procedures. As mentioned above, a positive IPRP improves applicant's position in front of the national/regional patent offices, which typically leads to faster and less costly national/regional examination procedures.

Who should consider a PCT application? Applicants should **consider** a PCT application, if

- it is yet to be seen whether the invention is going to be a commercial success and justifies the patenting costs,

- it has still to be decided for which markets (*i.e.* countries) the invention is relevant,

- an investor is still to be found (who bears the costs of the subsequent national/regional filings)

Who should not consider a PCT application? Applicants should **not consider** a PCT application, if

- the invention is only to be marketed in very few countries,
- it is already known before the expiry of the priority year in which additional countries patent protection is sought,
- it is important to obtain enforceable, *i.e.* granted patents as soon as possible, for example, if an infringer is already on the market.

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