

PATENT COOPERATION TREATY APPLICATIONS CAN BE A VALUABLE PART OF AN INTELLECTUAL PROPERTY PROTECTION STRATEGY

By: Ruy M. Garcia-Zamor

Deciding whether to invest in protecting an invention abroad can be difficult. If you are uncertain as to whether foreign patent applications are desired or in which countries foreign patent applications are to be pursued, filing a Patent Cooperation Treaty (PCT) application within applicable time limits can be advantageous.

PCT applications are typically filed with the U.S. Patent and Trademark Office acting as the local receiving office for the World Intellectual Property Organization (“WIPO”). WIPO is the international agency responsible for overseeing PCT applications. WIPO assigns PCT applications their serial number and filing date and sets forth the guidelines used to examine PCT applications.

A PCT application can never turn into an issued patent without making additional application filings. However, this PCT application does increase the amount of time available to file abroad while preserving an earlier priority date and can, to some extent, provide centralized examination to attempt to streamline costs when pursuing patent protection in many countries.

Most importantly, a PCT application makes it possible to, within strict time limits, seek patent protection for an invention in any of a large number of PCT member countries and regional organizations (such as the European Patent Office, the African Regional Industrial Property Organization, the African Intellectual Property Organization, or the Eurasian Patent Office) by filing subsequent national or regional phase patent applications.

WIPO will assign an Authorized Officer (the official responsible for determining the patentability of PCT applications) to conduct an "international search" for the subject matter of the claims of this PCT application. The search results will be identified in an "International Search Report" that lists all of published documents that the Authorized Officer believes might affect the patentability of the claimed invention. At the same time, the Authorized Officer will likely prepare a Written Opinion on patentability that briefly identifies the significance of the references identified by the search.

A response may be filed within two months after receiving the Written Opinion with amendments and arguments to attempt to overcome any rejections. Thereafter, another Written Opinion Examination Report may be issued but usually is not; if so, another response may be filed.

Within about eighteen months from its earliest priority date a PCT application will be published by the International Bureau and any information contained in the application will enter the public domain, except if it is eventually covered by patent protection.

If desired, a Demand for International Preliminary Examination must be filed with the U.S. and Patent and Trademark Office, acting as the U.S. International Preliminary Examining Authority, within nineteen months of the earliest priority date of the application requesting an examination of the application. At the same time, if desired, amendments to written description, claims, and/or the drawings of the application can also be filed as long as the amendments do not add new matter not supported by the international application as originally filed.

The filing of a Demand for an International Preliminary Examination results in the Authorized Officer applying the references of the international search to the claims and reviewing and finalizing the earlier Written Opinion as to the patentability of the claims to render an International Preliminary Examination Report.

Failure to file a Demand within nineteen months of the earliest priority date will result in some national phase applications needing to be filed within twenty months of the earliest priority date for this application. Failure to file applications in some countries by this deadline will result in any potential patent rights being abandoned.

Usually by twenty-eight months from the earliest priority date, an International Preliminary Examination Report is issued by the Authorized Officer, who takes into account the Written Opinion(s) and our Response(s). The only response to a negative International Preliminary Examination Report is to submit arguments and/or evidence of patentability to the patent offices of the individual countries or regions, rather than to the International Preliminary Examining Authority.

The Preliminary Examination Reports and the opinion of the Authorized Officer are non-binding on the Examiners in any of the designated countries or regions. Generally speaking, the examination reports and any amendments in response to them are likely to be accepted generally in any of the various countries.

The deadline for filing national and/or regional applications when a Demand is filed is thirty months from the earliest priority date for this application. Some, but not all, countries allow thirty months to file national phase applications even if no demand is filed. European Patent Office regional applications must be filed within thirty-one months of the earliest priority date.

Accordingly, the PCT process can provide additional time to commercialize an invention or to monitor competitor activity prior to deciding whether to invest in foreign patent protection. However, it is important that the decision to file a PCT application be made as part of an overall international invention protection strategy. Not all countries are members of the PCT. Please contact Garcia-Zamor Intellectual Property Law to discuss your specific situation.