Patent Cooperation Treaty

In prior posts, I have discussed the Patent Cooperation Treaty (PCT) as it relates to patent issues. And as I look back on these posts, the PCT always seems to come off looking like some expensive loophole for people to use. That is not really fair and I want to use this post to try and set things straight.

First, the bad news: there is no such thing as an international patent. When an inventor wants protection in multiple countries, individual patent applications must be made, and fees must be paid, in each country where protection is desired. The Patent Cooperation Treaty sets up a procedure to allow for the filing and preliminary processing of a single application that can be used in all signatory countries. Currently, 148 countries participate in the PCT.

An advantage of the PCT is that it allows an inventor to get a search report, written opinion and, if desired, a preliminary examination before having to file the national patent applications. This gives the inventor a stronger basis on which to make their patenting decisions. Another advantage of the PCT is time. When applying directly to multiple national authorities, all patents must be filed within 12 months of the filing of the first patent application. Under the PCT, National Stage applications can be filed up to 30 months after the first application is filed. As a result, the PCT gives an inventor an additional 18 months to evaluate the commercial viability of the invention.

Applications can be filed through a local "Receiving Office" which is usually the national patent authority of the residence of the inventor. An application made through the PCT is similar to a USPTO patent. The difference is that a PCT application must also: 1) designate at least one member country that will receive the application in the "National Stage;" and, 2) identify the International Search Authority (ISA) that will generate reports and opinions. The ISA is a group of 17 national patent authorities that conduct patentability searches for the WIPO.

Once the application is received and accepted, the "International Stage" of the process begins. A priority date is assigned and a search report and written opinion is prepared by the International Searching Authority identified in the application. Once the patentability search is complete, an applicant can request a supplemental search report from a different ISA or a preliminary examination before the PCT applications are released to the national authorities for examination.

Before the 30 month deadline, the WIPO will forward the applications and reports to the countries designated in the applications. This ends the WIPO's involvement in the process and begins the "National Stage" of the application process. In the national stage, the applicant must deal directly with the national authorities where patent protection is desired.

When filing for an invention created in the US, US law requires that a foreign filing license be issued before a patent application can be filed with foreign authorities. For applications filed using the USPTO as the Receiving Office, the USPTO will assume the application implicitly includes a request for the foreign filing license and will issue one before the application is forwarded to the WIPO. A petition for the license can be made directly to the USPTO in cases where a different receiving office needs to be used.

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