



QUICK GUIDE TO PCT

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WAYS TO PATENT IN SEVERAL COUNTRIES

National route

National patent applications are filed separately in each relevant country claiming priority under the Paris Convention within 12 months of the first filing.

Regional route

The application is filed with a regional patent office, which carries out a centralised procedure, after which a validation must take place in the relevant states. The validation is an administrative step without local examination. Only regional coverage can be achieved.

PCT route

The application is filed under the Patent Cooperation Treaty (PCT) that facilitates the process of filing patents internationally with an almost global coverage (158 participating countries by end of 2024). Patent protection can be obtained in the national phase.

THE PCT PROCEDURE

The two phases of the PCT: international phase and national phase. The international phase is a very flexible process that helps applicants to obtain as much information as possible about the patentability of the invention contained in the international application in order to significantly increase the chances of patentability in the national phase. Patents are granted in the chosen countries in the national phase.



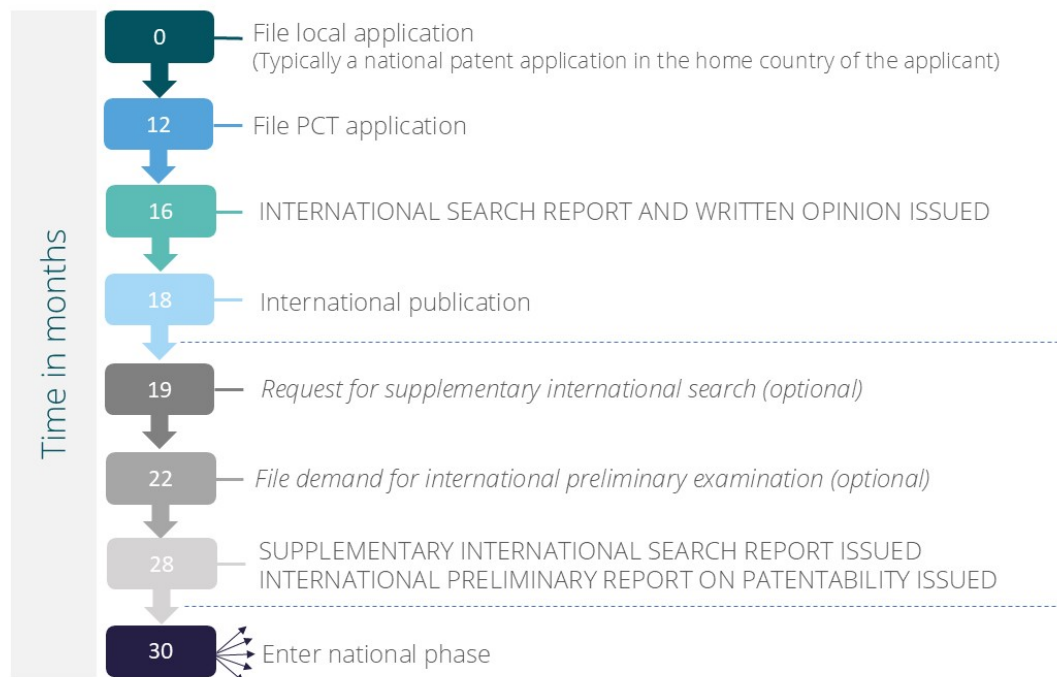
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EST. 1969

Patent in a nutshell

A patent is a “contract” between the society and the inventor in which the society agrees to grant the inventor/applicant a monopoly right on the exploitation of the invention for a specific period of time.

In return, the inventor agrees to make the technical solution contained in the invention publicly available. A patent is a territorial right granted by the authorities for a limited period of time.

THE PCT PROCEDURE



THE INTERNATIONAL PHASE OF THE PCT

The international phase is a single, centralised procedure during which the international application is filed and processed. The application has legal effect in all PCT member states, which means that the applicant can reserve the right to file the national application by maintaining the priority of the original application in all PCT countries with a single application.

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A supplementary international search can also be requested during the international phase. This optional search provides even more comprehensive information on the state of the art relevant to the application.

The international search report provides the applicant with a great deal of information on the patentability of the invention before entering the national phase in the selected countries. The application is published at the end of the international phase.

The international phase is one of the main strategic and financial advantages of the PCT route. It allows the priority of the invention to be maintained and delays the start of the costly national phase until the applicant has a better understanding of the chances of obtaining a patent.

KEY ELEMENTS OF THE PCT INTERNATIONAL PHASE

I. The international filing

The Receiving Office (RO), which is either the national office or the International Bureau, receives the application. The applicant indicates the chosen International Searching Authority (ISA), for example, the Visegrad Patent Institute. The ISA is selected by the applicant on the basis of the quality, the costs involved and the speed of the search.

The application goes through formalities check and receives a filing date.

II. The international search

The RO forwards the application to the ISA, which conducts the search in the “PCT minimum documentation”. This specifies which databases of which states/organisations are to be used in what time period. All data made public by means of written disclosure anywhere in the world is taken into account. The search provides a comprehensive picture on whether the application satisfies the patentability criteria (novelty, inventive step and industrial applicability).

DID YOU KNOW?

According to WIPO's PCT Yearly Review, the Visegrad Patent Institute was the fastest ISA in preparing and sending international search reports in 2023?

III. The International Search Report

The International Search Report (ISR) is a simple, clear and comprehensive document that lists the documents found against the patentability of the application.

- First column indicates the categories of the cited documents:
 - X – document relevant to novelty,
 - Y – relevant to inventive step,
 - A – relevant to state of art in general.
- Second column indicates the documents with source, title and publication date.
- Third column indicates which claims of the application the certain document is relevant to.

IV. The Written Opinion

The Written Opinion (WO) is established at the same time as the ISR. It gives a preliminary, non-binding opinion with detailed reasoning why the application does or does not fulfil the requirements of novelty, inventive step and industrial applicability.

V. Publication

The international application is published 18 months after the priority date. It becomes public and part of the state of the art/prior art.

VI. Optional International Preliminary Examination

A positive ISR is a serious argument in favour of obtaining a final patent and has a significant promoting effect in the national phase - during the examination and grant procedures carried out by the national offices - following the international phase. A positive ISR and WO is almost a complete success - with some exceptions.

A positive ISR does not always mean a successful patent application in the national phase due to differences in legislation between Contracting States. For example, agricultural methods are excluded from patentable inventions in India, other countries do not allow the patenting of smoking articles, etc. In most cases, however, there are no significant differences.

If the ISR is unfavourable, the flexibility of the PCT system can still help. There is an optional way to overcome the objections through amendments and thereby obtain a favourable International Preliminary Examination Report (IPER) before the national phase. In this International Preliminary Examination procedure, the amended application is re-examined and re-evaluated. During the subsequent national phase, a favourable IPER greatly simplifies the procedure before the national offices, reduces costs and increases the chances of successfully obtaining a patent.

The international phase ends after 30/31 months from the priority date depending on the individual rules of the PCT Contracting States, national phase begins. National offices conduct separate examination and grant procedures.

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The Visegrad Patent Institute accepts search fee refund forms electronically not only through the ePCT system, but also by e-mail and through the online form on the VPI website.



Key takeaways

- PCT system is a patent filing, not a patent granting system. No substantive decision on the status of the application (refused or granted) is made during the international phase, only information on patentability is obtained on the basis of which important strategic and economic decisions can be made.
- A single application can secure a near-global territorial coverage with 158 countries (as of end of 2024).
- The PCT system allows costs to be deferred to the national phase. National fees, translation and agent fees can be paid later when there is a better understanding of the chances of obtaining a patent.
- The international phase provides an early assessment of patentability (ISR, WO, IPER).
- Amendments help to minimise costs and maximise the chances of success.
- Electronic filing and administration make the whole process cheaper and easier via the ePCT system.