

Overseas applications – PCT vs Convention

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**CHAMPIONS
OF INNOVATION.**

Patent rights are territorial. This means that if you require patent protection in more than one country, a separate patent must be filed in each country.

However, it can be difficult to assess those countries in which patent protection may be required before a new product or process is commercialised (which is when patent protection must be sought). The cost of multiple filings may also be difficult to meet before receiving an income stream from that product or process.

Fortunately, there are options for delaying the decision of which countries to file in and the associated costs.

Convention application

A “convention” application is filed under an international agreement (the “Paris Convention”). Under the Paris Convention if patent application A is filed in one country within 12 months of the date of filing corresponding patent application B in another country, patent application A is given the same filing date as patent application B.

For example, if a patent application is filed in New Zealand on 1 March 2011, and the same patent is applied for in Australia on or before 1 March 2012, the Australian patent application will be given a filing date of 1 March 2011.

This is important as the disclosure of any identical or similar inventions after 1 March 2011 (including publication or use by the patent applicant itself) cannot be cited against the Australian patent application.

Most of our major trading partners recognise the Paris Convention or provide an equivalent arrangement.

Convention applications can be used to delay the decision of which countries to file patent applications in for up to 12 months after the date of first filing an application for the same invention, as well as delaying the associated costs.

PCT application

A PCT (Patent Co-Operation Treaty) application is a way of filing a single patent application in many countries.

Most PCT applications are filed within 12 months of filing the first patent application relating to the subject invention (although they can be filed earlier if necessary).

A PCT application must ultimately be followed up by applications in individual countries (as there is no such thing as a single granted international patent) but it provides a number of benefits.

Firstly, an international examiner will provide a preliminary assessment of patentability during what is known as the “international phase”. After the international phase, a PCT application enters the “national phase”, in which applications are filed and examined in individual countries. Amendments to the PCT application may be made in the international phase which may streamline the later process of examination in the national phase, saving time and cost.

A further advantage of a PCT application is that it can delay the filing of applications in individual countries for up to 18 months from the filing of the PCT application (or 30 months from the filing of the first patent application relating to the subject invention) meaning more time is available to assess potential markets.

National phase PCT applications can be filed in most of our major trading partners, although notable exceptions are Argentina, Saudi Arabia and Taiwan.

Which option is best: PCT or Convention?

Regardless of which option you choose, a patent application must be filed in one country prior to any disclosure or commercial use of the invention. Although it is possible to file that application in other countries, for cost reasons most New Zealanders file their first patent application in New Zealand. If protection is required overseas then either a PCT or convention application(s) must be filed within 12 months of that first application.

A PCT application should be considered in the following situations:

- Applications are required in several overseas countries (typically more than 3);
- The patentability is questionable and a preliminary assessment by an international examiner is desirable;
- The invention is likely to require further development before being finalised; and/or
- The capital for filing multiple applications is not yet available.

Convention applications should be considered in the following situations:

- Applications are required in only a few overseas countries (typically 1-3);
- There is a need to obtain granted patents quickly, for example to stop an infringer;
- The overall cost of the patent process is more important than when the costs are incurred; and/or
- Protection is required in countries not party to the PCT agreement (for example Taiwan, Saudi Arabia and Argentina).

It is always important to discuss your requirements with your IP advisor to ensure maximum protection can be taken from the intellectual property system.