

INFORMATION SHEET

Filing and prosecuting a PCT international application

The Patent Cooperation Treaty ("PCT") establishes a system of international cooperation under which an applicant can initiate patent filing in several countries and patent granting regions by filing one international application. There are currently over 140 contracting jurisdictions to the PCT.

The PCT also provides a mechanism for a preliminary international examination of the patent application. The PCT does not eliminate the necessity of prosecuting the patent application before the patent office of each designated jurisdiction. It does, however, provide the advantage of delaying this step.

It is assumed for the purposes of the following discussion that a patent specification has already been prepared.

The PCT process can be divided into an international phase and a national phase. The international phase includes a mandatory search and written opinion on patentability conducted by the International Searching Authority and an optional further Preliminary Examination conducted by the International Preliminary Examining Authority. The national phase refers to the prosecution of the application before the patent offices of the chosen individual countries or patent granting regions.

Under the PCT, an applicant may either file an international application initially as a first filed application, or within 12 months of the priority date established by another first filed application. The date of filing the PCT application is called the "international filing date." The PCT adheres to a strict timeline and, in general, most deadlines are non-extendible. If you proceed with a PCT application, you must be prepared to meet these strict deadlines and understand that failure to meet a deadline may result in a loss of rights under the PCT.

Chapter I of the PCT. To file under the PCT, a Request is submitted to the PCT Receiving Office, along with a copy of the patent specification. Upon filing, the PCT application enters the first part of the international phase (Chapter I) and an Examiner with the International Search Authority conducts a search for prior references that are relevant to the patentability of the invention claimed in the application.

International search report. The International Search Authority endeavours to produce a search report and a written opinion on patentability within nine months of the PCT filing date if the PCT filing date is the priority date (i.e. there is no claim to priority from an earlier filed application) or within 16 months of the priority date if the PCT application claims priority from an earlier filed application. The International Search Report will list references uncovered by the International Search Authority and the written opinion on patentability will indicate the extent to which such references are relevant to the specific claims of the application. On your instructions, we can review these references and provide an opinion as to their relevance and whether or not any previous opinion as to the patentability of the invention is changed by the search results. You can then decide whether or not to proceed with the expense and effort of the application process.

It should be noted that the International Search Authority might find that the PCT application contains more than one invention. When this happens, the International Search Authority may invite the applicant to pay additional fees for each additional invention. Although payment of the additional fees is not mandatory, a Search Report will only be produced for the first identified invention unless the requested fees are paid.

OTTAWA

55 Metcalfe Street Suite 900
PO Box 2999 Station D
Ottawa ON K1P 5Y6
Canada
t. 613.232.2486
f. 613.232.8440
ottawa@smart-biggar.ca

TORONTO

Box 111 Suite 1500
438 University Avenue
Toronto ON M5G 2K8
Canada
t. 416.593.5514
f. 416.591.1690
toronto@smart-biggar.ca

MONTREAL

Suite 3300
1000 De La Gauchetière Street West
Montreal QC H3B 4W5
Canada
t. 514.954.1500
f. 514.954.1396
montreal@smart-biggar.ca

VANCOUVER

2300-1055 West Georgia Street
PO Box 11115
Vancouver BC V6E 3P3
Canada
t. 604.682.7780
f. 604.682.0274
vancouver@smart-biggar.ca

smart-biggar.ca

SMART & BIGGAR

FETHERSTONHAUGH

Barristers & Solicitors • Patent & Trade-mark Agents

Once the International Search Report has been produced, the claims of the application can be amended in order to distinguish them more clearly from the references located in the search. The deadline for submission of such amendments is the later of two months from the date of the International Search Report or 16 months from the priority date.

The specification of the PCT application, together with the International Search Report and any claim amendments, is published by the International Bureau 18 months after the priority date. If the Search Report is not complete, it is published separately, later. At this time other parties may obtain copies of your published application.

Chapter II of the PCT. The International Preliminary Examination phase is referred to as Chapter II. To enter Chapter II, the applicant must file a Demand for International Preliminary Examination (a "Demand"), and the necessary fee payments, within the later of three months from the date of transmittal of the search report and 22 months of the priority date. This deadline is not extendable.

If an applicant does enter Chapter II, then the applicant is entitled to respond to the written opinion on the patentability of the claims that was received with the international search report.

After filing a response to the written opinion, the Examination Authority may issue another written opinion. At the conclusion of the process, the Examination Authority issues an International Preliminary Examination Report on Patentability. Where the applicant does not enter Chapter II, the written opinion received with the international search report is normally converted into the International Preliminary Examination Report on Patentability. The Report is an opinion on the question of whether the claimed invention appears to be novel, to involve an inventive step and to be industrially applicable. The Report is non-binding, however, it is considered by the Examiners of the jurisdictions in which patent protection is pursued and is very persuasive in some jurisdictions. The Report normally issues 28 months after the priority date, if not earlier.

National phase entry. Through appropriate national and regional filings, the deadline for entering the national phase of an international application can be delayed to at least 30 months from the priority date.

Entering the national phase involves obtaining translations of the specification for each non-English speaking jurisdiction and paying filing fees for each jurisdiction designated. Upon filing the necessary paperwork and paying the fees, the application is treated as though it was filed directly in each jurisdiction and is subject to the domestic examination process. Generally, the examination process in any given jurisdiction may involve filing requests for examination, paying maintenance fees to keep the application in force and receiving or responding to written objections of the jurisdiction's Patent Office.

The Search Report and International Preliminary Examination Report on Patentability produced during the international phase may form a basis for rejections of the claims of the application in individual jurisdictions. Individual jurisdictions are, however, permitted to conduct further searches and examinations, which may also form the basis of claim rejections.

The actual costs of examination at the national level in each jurisdiction will vary depending on the jurisdiction concerned. National phase examinations can take anywhere from one to several years.

When the Examiner in a designated jurisdiction is satisfied that the application is allowable, the payment of an issue fee to the respective Patent Office of the designated jurisdiction is usually required before a patent will issue in that jurisdiction. The term of a patent in any given jurisdiction is dependent upon the laws of that jurisdiction.

Through our network of associates, Smart & Biggar/Fetherstonhaugh has the expertise to handle all of your PCT questions and applications in Canada, in the United States and throughout the world. Please contact any one of our offices for more information.