



Mesmer & Deleault, PLLC
41 Brook Street, Manchester, NH 03104
Satellite Office: One New Hampshire Ave., Suite 125
Portsmouth, NH 03801



“Tip of the Month”

PCT Filers Now Have Cheaper Search Option

Patent applicants who use the Patent Cooperation Treaty (“PCT”) to file international patent applications have long been able to select either the United States Patent and Trademark Office (“USPTO”) or European Patent Office (“EPO”) to perform the prior art search. The factors in deciding which office to perform the search are well known. Starting January 1, 2006, applicants in the US have a third choice for which office to perform the prior art search -- the Korean Intellectual Property Office (“KIPO”).

The USPTO has developed a sizable backlog of patent applications to search and examine over the past couple of years. As a result, the time it takes to get search results has increased for both PCT and regular US applications. For example, the search office is supposed to provide search results well before the 19 month deadline for filing a Demand for Preliminary Examination. The USPTO has been taking many more months beyond this deadline, thereby denying applicants the information necessary to decide whether to file a Demand or proceed to the national phase. The time to receive a first Office action for regular national applications has increased from 12 months to around 16 months.

One solution to this problem has just been enacted. It is the ability to select the KIPO as one of the three offices to perform the prior art search. Which office should *you* choose for *your* PCT applications?

Cost: There are several fees associated with PCT applications, but a variable cost is the international search fee. The current prices for each office are as follows. EPO: \$1871. USPTO, where there is no corresponding US application: \$1000. USPTO where there is a corresponding US application: \$300. KIPO: \$218. Note that applicants who later file for protection in the EPO receive a substantial discount if they choose the EPO as the search office. However, the KIPO is still the least expensive.

Quality: The EPO is generally regarded as having the best quality, and is the most stringent. The USPTO usually has good quality, but not always. The quality of KIPO searches is yet unknown.

Timeliness: The EPO supplies its search report on time, but the USPTO has become extremely tardy. The PCT international phase generally lasts only 30 months, and the results from the USPTO sometimes arrive afterwards. This makes the search useless for decision-making purposes. We do not yet know whether the KIPO will provide timely search results. Many applicants, however, only use the PCT system to delay the date when they have to pay expensive filing and translation fees in the national patent offices. In this case, it does not matter whether they receive timely search results.

By enabling PCT applicants to use the KIPO, the USPTO hopes to reduce its backlog of US applications. One of the results is that the PCT system has also become more complicated. The attorneys at Mesmer & Deleault are ready to advise you on your patent application needs.

If you have any questions about international patents, please give us a call at 668-1971 or contact us using e-mail at mailbox@biz-patlaw.com.

Frank B. Mesmer, Jr., Esq.
Robert R. Deleault, Esq.
Phillip E. Decker, Esq.

0106

(603) 668-1971

Fax (603) 622-1445

e-mail: mailbox@biz-patlaw.com

Web site: www.biz-patlaw.com