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Independence Day

“Tip of the Month”

Using a PCT Patent Application to Obtain Foreign Patents

Many people are aware that a US patent can protect an invention in the US, but it will not provide protection outside of the US. Does this mean inventors are forced to file a separate patent application for each country in which they want protection? Thankfully, most countries around the world have recognized this problem and have entered into the Patent Cooperation Treaty (PCT). The PCT provides a uniform pathway for inventors wishing to obtain foreign patents.

Filing a PCT application is similar to filing a US patent application. A PCT application, like a US application, includes a written description of the invention, a set of drawings to aid in the description of the invention, and a set of claims that specify the protectable parts of the invention.

The applicant files the PCT application in the International Receiving Office in Geneva. The applicant also selects an International Searching Authority (ISA) that will conduct a preliminary search of prior art related to the invention. The applicant has 30 months (for most countries) to choose the specific countries (which are members of the treaty) where the applicant would like to have the invention examined. This is known as entering the national stage.

Filing a PCT application provides advantages over filing individual patent applications in foreign countries. The first advantage is that initially, only one patent application needs to be filed. This saves time and money. A second advantage is that the ISA will provide a search report and a written opinion regarding the patentability of the invention before the deadline for entering the national stage in various countries. The report and opinion provide a good general idea on the patentability of the invention to determine the worthiness of entering the national stage in various countries.

A third advantage is the extended 30 months granted to applicants before having to enter the national stage. Applicants typically have only a year to file foreign applications after filing either a provisional or nonprovisional US patent application. The extended 30-month period gives applicants the time to test whether the invention might have sufficient commercial value to justify spending the money to enter the national stage in various countries.

While the PCT application can be a useful tool in acquiring foreign protection for an invention, potential users should be aware of certain things. There is no such thing as an “international patent.” A PCT application by itself will not lead to a patent. Individual countries under the PCT still retain sovereignty over the decision to issue a patent or not. Thus, if an inventor wants protection in any particular country, the inventor needs enter the national stage in that country before the 30-month period ends. Additionally, while PCT applications can save a lot of money on the front end for applicants wishing patents in multiple countries, the total overall costs may end up being similar to national filings.

If you would like more information about the PCT international patent application process, please give us a call at 668-1971, or contact us by email at mailbox @ biz-patlaw.com.

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