

# The PCT: protecting inventions overseas.

An Australian patent provides protection only within Australia. If you want to apply for a patent in other countries, you generally have two choices.

Firstly, you could file separate patent applications in each country, which may be the best option if you have already identified the major target markets for your invention.

Or you could file a single international application under the Patent Cooperation Treaty (PCT) which designates all member countries (over 140 countries, including Australia).

If you adopt the second approach, your application will take effect in all of the PCT member countries for an interim period, with the need to meet the national requirements and incur the associated costs in each country being deferred for at least 18 months.

This gives you extra time to assess the value of your invention, and its export potential, before deciding which countries to pursue, and committing to the high costs involved. Whichever option you choose, you will still end up with separate patent applications in each country.

## **PCT Filing**

For Australian applicants, a PCT application is usually filed at the Australian Patent Office, which processes the application, and assigns a filing number. This process takes 3-4 weeks.

## **International Search Reports**

Having filed an international application, you will receive an International Search Report (ISR) and an International Search Opinion (ISO), usually within four months of filing the application.

These tell you if there are any prior publications, identified by a patent examiner, which may be relevant to your invention, and indicate their potential impact upon patentability of your invention. This helps you to refine your patenting strategy.

## **Publication**

The PCT application and the ISR are published (made available online to the public) at 18 months from the earliest priority date.

## **International Preliminary Examination**

After receiving an ISR and ISO, you then have the option to initiate a further process known as International Preliminary Examination (IPE). This provides an opportunity to respond to the ISO by filing permissible amendments to the application, and/or pertinent arguments addressing matters raised by the examiner.

At the end of the IPE process the examiner will issue a final International Preliminary Report on Patentability (IPRP). If there have been no amendments made, and the examiner is not persuaded by the arguments, the IPRP will be the same as the ISO.

The outcome of IPE is not binding upon any national patent office, each of which is entitled to conduct further examination in accordance with the relevant national laws, however the IPRP is influential in many PCT member countries. Requesting IPE also enables relevant issues raised in the ISO to be addressed once in respect of the international application, rather than separately within each national patent office.

## **The National Phase**

'Entering the national phase' is when you ask for your international application to proceed separately in selected member countries of the PCT. In most cases, you have up to 30 months from the priority date to do this. Once national phase has been entered, each selected national patent office will issue a local application number, and allow the application to proceed in the same manner as any other patent application.

In Australia, for example, national phase is entered by notifying the Australian Patent Office that you want the application to proceed and paying a fee. Some other countries, such as the US, require that additional formalities be completed, and documentation executed by the inventor(s) and/or applicant upon entry into the national phase.

## **Victoria**

T +61 3 9819 1664

## **New South Wales**

T +61 2 9888 6600

## **Western Australia**

T +61 8 9325 1900

E [mail@watermark.com.au](mailto:mail@watermark.com.au)

W [www.watermark.com.au](http://www.watermark.com.au)

B [www.intellectualassetmanagement.com.au](http://www.intellectualassetmanagement.com.au)

Twitter [@WatermarkIP](https://twitter.com/WatermarkIP)

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PCT

The diagram overleaf outlines, in a simplified form, the process for protecting your invention overseas via PCT (Patent Cooperation Treaty)

For more information on Watermark's comprehensive range of intellectual property services contact [mail@watermark.com.au](mailto:mail@watermark.com.au)



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