

PCT NATIONAL PHASE FILING.

The filing of national applications, known in PCT parlance as ‘entering the national phase’, involves appointing local agents to submit the necessary forms and pay the appropriate fees in each country. In countries where English is not an official language, you will usually have to provide a translated version of the patent specification filed with the international application.

In most countries, applications filed through the international system are treated in the same way as directly-filed applications. This typically includes a further full examination being conducted by the national patent office. In some countries, such as the USA, national phase applications are automatically examined in turn. In other countries, including Australia, China, Japan and South Korea, a separate request for examination must be filed at a later date, along with an accompanying examination fee.

Additionally, there are some countries, such as Singapore, in which national phase applications are treated differently from direct filings. For example, examination and registration may be based upon the outcome of the International Preliminary Examination (where requested).

After a successful examination procedure in each country (patent offices and attorneys commonly refer to this process as

‘prosecution’ of the application), there is typically an allowance or acceptance procedure, followed by the payment of further official fees to enable a patent to be granted.

Most countries also require you to pay periodic maintenance fees to prevent a patent or application from lapsing. In some cases, these fees are payable while an application is still pending, while in others no fees are payable until a patent is actually granted. There are, however, a few countries (e.g. Japan and Indonesia) in which maintenance fees accrue on pending applications, and become payable at grant. These fees can become quite substantial, particularly in countries where the examination procedure may take many years to complete.

SELECTION OF COUNTRIES

The countries you select for national filings may depend on various factors, such as:

- the major markets for the products or services covered by

your patent claims;

- any additional import or export markets you may wish to protect; and/or
- specific commercial and patenting activities of key competitors, suppliers or customers.

We can help you to develop a filing strategy. For example we may be able to conduct patent searching and analysis to identify active markets for your technology, or research the filing strategies of your major competitors, customers or suppliers.

COSTS

As you will understand from the above brief description of the overall procedure, the costs of obtaining patents in different countries can vary significantly. The costs discussed below relate to the filing of the application only. We can provide further information regarding ongoing costs of prosecution, maintenance and grant in particular countries upon request.

COMPETE WITH CONFIDENCE.



In countries where a translation is required, this can add significantly to the overall cost, and will naturally vary depending upon the length of the patent specification. Additional translation costs may be incurred if urgency is required, for example if you are unable to provide filing instructions until shortly before the deadline for national filing.

Estimated costs for national phase applications in various countries and regions are set out below. These costs include Watermark's service fees, as well as fees charged by foreign agents and national patent office fees. They are based upon our past experience along with recent cost estimates, assuming a 'straightforward' patent specification including around 25 to 35 pages and 15 claims. In some countries, additional fees apply when the number of pages and/or claims exceed prescribed limits.

Country/region	Filing cost estimates AUD (ex GST)
Australia	\$1,570
China	\$5,500 - \$6,500
European Patent Office	\$9,000 - \$10,000
India	\$2,500 - \$3,500
Japan	\$10,000 - \$12,000
South Korea	\$7,000 - \$8,000
Mexico	\$6,500 - \$7,500
New Zealand	\$1,300
Singapore	\$2,500 - \$3,000
USA	\$5,000 - \$6,000

Costs are also incurred in prosecution, acceptance and grant of each national patent application. Many factors influence these costs, including the order in which different national applications are examined. A good rule of thumb is to assume that the costs of prosecution will be at least one to two times the cost of filing.

If you require specific estimates for your application in particular countries of interest, or require a cost estimate for a country that does not appear on the above list, please let us know.

EUROPEAN PATENT APPLICATION

The table above includes a cost estimate for filing a 'regional phase' application at the European Patent Office (EPO). The EPO provides a central examination and patent granting procedure, which can be conducted entirely in English, and results in a European patent which can be made enforceable in those European countries which are members of the European Patent Convention (EPC).

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Intellectual Property

Our Services:

- Patents & Designs
- Trade Marks
- IP Legal
- IP Advisory
- Competitive Business Intelligence