

Entering the National Phase of a PCT Application

International patent applications filed under the Patent Cooperation Treaty (PCT) do not of themselves turn into patents. Although the World Intellectual Property Organisation (WIPO) that acts as the central clearing centre for international applications will carry out a search and examination and will report this to the applicant, patents are still granted only by national Patent Offices and to achieve this in any particular country the PCT application first has to be converted into one or more national applications in what is called the National or Regional phase.

The deadline for attending to this is usually either 30 or, in some countries or regions such as the EPO or UK, 31 months from the earliest priority date claimed. This is the case whether or not a Demand under Chapter II of the PCT has been filed, and since 2002 it has not been necessary to file one in order to be able to avail oneself of this longer Chapter II National/ Regional Phase deadline. An applicant can choose to enter the National/Regional phase in as few or as many of the territories designated in his original PCT application as he wishes. The choice will likely depend on the importance of the invention, the breadth of coverage required, the results of searches that have been received, the nature, favourable or otherwise, of the Written Opinion or International Report on Patentability (IPRP) and, of course, budget.

As with ordinarily filed national applications, the formalities required vary from country to country, but practically all of them require the appointment of one of the local firms of attorneys (whom we can suggest), the filing of documents and payment of local fees. Some forms signed by the applicant and by the inventor(s) (if not the applicant) may also be needed.

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A translation of the specification into the local language may also be required. Whilst a number of countries allow a short period after the local 30 or 31 month deadline for filing this, some others do not and this needs to be taken into account when deciding when and where to proceed. Costs at this stage would likely not be dissimilar from those of ordinarily filed national applications and could range from around £1500 in some English-speaking territories to several thousand pounds if the specification is lengthy and has to be translated.

Once the National/Regional Phase has been entered, the application in effect becomes a local application and is then subjected to a very similar treatment by way of examination to that of a normal locally-filed application. However, Patent Offices in some countries will start from the results of the original PCT search and examination, and if this had been favourable a few would go no further.

If it had been unfavourable, some countries would simply re-iterate the objections in the IPRP for the applicant to answer. Other regions/countries such as the EPO and USA might also carry out an additional search as part of the local examination, and depending on where the PCT search and IPRP were prepared, might re-examine completely afresh. Whilst a favourable IPRP might therefore encourage applicants to think that local examination will be more straightforward and grant more rapid, in practice it is often no guarantee of a smooth ride.

Further advice

If you would like any further advice please contact us at Dehns using the details below.



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