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AN EASY APPROACH TO WORLDWIDE PATENT PROTECTION

If you are an inventor, the prospect of worldwide patent protection for your invention ought to sound very compelling. On the other hand, it may also sound complicated, time-consuming and expensive. Armed with the following explanation of the patent protection process and its benefits, any doubts about its worth should be set to rest.

As you may have heard, Thailand is now partner to the Patent Co-operation Treaty (PCT), a system that facilitates the process for obtaining worldwide patent protection. Thailand became the 142nd contracting state to the treaty on Sept 24, 2009, and the PCT entered into force in Thailand on Dec 24, 2009.

The advantages of the PCT are worth exploring in detail, as a clear understanding of the filing process will enable Thai applicants to develop a strategic approach to obtaining worldwide protection via the treaty. The system has two main phases: the International Phase and the National Phase. The International Phase starts with submitting a PCT application to a Receiving Office. If the applicants have already filed a Thai patent application, they must file the PCT application within 12 months from the earliest priority date.

In the International Phase, applicants obtain an "International Search Report" (ISR) compiled from high-quality



searches of patent documents and other technical literature, and an "International Preliminary Report on Patentability" (IPRP) from the International Searching Authority. The ISR helps applicants to better evaluate the chances that a patent will be issued before incurring costs associated with filing applications in the jurisdictions where protection is sought. If the report reveals that the invention is not new and does not involve an inventive step, the chances the invention will be granted a patent are reduced. The applicant will thus have saved money by only filing the PCT application instead of filing applications in multiple overseas jurisdictions. Applicants also benefit from the uniformity of requirements and from centralised international publication.

Afterward, applicants then have a 30-month period from the earliest priority date to enter into the PCT's "National Phase" for each designated state in which they would like to obtain patent protection.

In sum, filing a PCT application has

three major advantages: the filing of a single international application preserves the right to file in 142 member countries; the treaty provides a strong basis for patent decisions; and the costs of filing in multiple national patent offices can be delayed. These advantages cannot be found in the conventional filing system, whereby applicants have to file for the same invention in each country within 12 months of the earliest priority date without access to expert opinion on an invention's novelty and possession of an inventive step. However, as in the conventional system, granting a patent still rests with each national patent office.

Traditionally, keeping filing costs down has required careful planning. However, applicants should take heart that individuals who are Thai nationals and/or who reside in Thailand qualify for a 90% reduction on the international filing and handling fees. Furthermore, costs are based on the number of pages of the specification and the International Searching Authority (ISA) which is selected.

For example, if the application contains 30 pages of specification and an individual Thai applicant selects the China Patent Office as an ISA, the total government fees would be around 18,150 baht. Absorbing the filing fee for a PCT application is worthwhile since the applicant will gain an additional

18-month period to consider which countries to file the National Phase application in. In comparison, the conventional system requires direct filing with each Patent Office, leaving applicants only 12 months from the earliest priority date to decide where to file.

Given the lower filing fees for Thai nationals resident in Thailand, it may be more strategic to submit patent applications in the name of a Thai person rather than in the name of a company. After filing the PCT application, if required, the individual can proceed with the recording of assignment to the company seeking protection.

While obtaining patent protection via the PCT system does not dramatically decrease filing costs, the fee applicants must pay to file a PCT application enables them to receive information on patentability of the invention and helps them delay the costs of filing the patent application overseas. However, if the applicant would like to obtain patent protection in only one or two countries, the PCT application may not be necessary.

**By Thaneeya Lalitkuithorn, Patent Agent,
Intellectual Property Department, Tilleke &
Gibbins International Ltd. Please send
comments to Andrew Stoutley at
andrew.s@tillekeandgibbins.com.**