

## Global patent protection under the PCT system

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Abraham Lincoln once said, "The patent system added the fuel of interest to the fire of genius." It was an unmistakably true statement; patents have undoubtedly become an essential tool for protecting new inventions. Not only do patents guard against the unauthorised use of an inventor's creation, but they foster innovation by granting exclusive legal rights for limited durations.

However, one may ask how legal patent rights can be obtained on a global scale. Clearly, a patent's efficacy is severely limited if its privileges and effects are limited to just a single country. The solution to this question may lie with the Patent Cooperation Treaty (PCT). This article will discuss how patent owners can extend protection for their inventions under this system.

The PCT is an international treaty regulated by the World Intellectual Property Organisation (Wipo). It provides member states with a unified protocol for filing patent applications. Currently, 148 countries including Thailand, which joined in 2009, are members of the PCT.

In recent years, filing patent applications through the PCT has attracted much interest from Thai individuals, businesses and legal entities. But there is still a misunderstanding that filing a patent application through the PCT will grant worldwide patent protection.

In fact, the PCT does not offer universal or worldwide protection for a claimed invention; it only offers a provisional solution for the unified processing of an application, and it establishes whether or not the claimed invention meets the patentability requirements. Therefore, it helps to ascertain whether or not patent protection is worth pursuing. For PCT applications that meet the patentability requirements, the process for obtaining a fully-protected patent in each PCT-adhering jurisdiction is much quicker and more straightforward.

Obtaining patent protection through the PCT begins with filing an International Application either at the national or regional patent office (known as the Receiving Office) or directly with Wipo. Next, the application will proceed to the International Search and International Publication stages. During the search stage, the appointed patent office will conduct a worldwide search to locate any existing inventions, patents, and non-patent literature (known as "prior art") that may compromise the patentability of the claimed invention.

After this search is completed, an International Search Report (ISR) and a written opinion will be issued, which list all the documents that may affect the patentability of the claimed invention, and which contain the examiner's opinion as to why the invention may or may not be patented. In the event of an unfavourable ISR, there will be an opportunity to amend the claims and/or description to improve patentability, and a chance to discuss with the examiner ways to further improve patentability.

As mentioned above, Wipo does not issue a lawfully protected patent; it merely evaluates how likely it is to obtain a patent in a PCT member state. Therefore, PCT applications must be filed at the patent office of a PCT member state to obtain a legally protected patent in that jurisdiction.

Since the PCT process already evaluates the patentability of the claimed invention, any advantageous assessments contained within the ISR and/or written opinion can be used to further facilitate the acceptance of the claimed invention, which reduces the time between filing and grant of a patent. Patent offices of PCT member states are required to accept all PCT applications, and fewer formal documents are required.

From a business perspective, filing a patent application through the PCT offers a number of advantages. For instance, protection can be obtained in 148 member states by filing a single PCT application in one language. PCT applications can also delay payments relating to the filing and prosecuting of a patent application before a national or regional patent office, as they provide an extended time limit for filing additional applications in other member states.

During this extended period, more market research can be conducted to locate potential business partners or investors, and the commercial value of a claimed invention can also be further evaluated. Most importantly, the PCT evaluation allows an informed decision to be made with regard to pursuing a claimed invention, which effectively lowers the cost of filing an application at a national or regional patent office. Ultimately, the PCT system reduces the chance of making a bad investment.

Clearly, the PCT offers many valuable advantages over other patent application systems; but careful steps must be taken to ensure a PCT application will yield its full range of benefits. Armed with a full understanding of how the PCT system works, patent owners will be in a much stronger position to derive commercial advantages from their inventions.