

How to get a Global Patent Protection?

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“If I file a patent, will I have a global protection?” – This is a question that all patent attorneys are asked too very often. The answer is a pretty simple ‘NO’. The next question that is asked is “How do I protect my invention in more than one country?” The answer to this will be discussed in this post.

As a first lesson, the applicant must know that there are three different types of applications:

1. Ordinary application
2. Conventional application
3. PCT application

An application for patent filed in the Patent Office without claiming any priority of application made in a convention country or without any reference to any other application under process in the office is called an **ordinary application**. Patents are extremely territorial in nature, thus an ordinary application is meant to secure a patent protection only within a selected geographic area (country).

When an applicant files a patent application, claiming a priority date based on the same or substantially similar application filed in one or more of the convention countries, it is called a **convention application**.

An application filed under the provisions of the Patent Cooperation Treaty is known as a **PCT application**. By filing one international patent application under the PCT, applicants can simultaneously seek protection for an invention in 148 countries throughout the world. However, this does not mean, one would be able to patent the invention in all of the 148 countries. There is therefore nothing called a “Global Patent”.

Having understood the different types of applications that exist with respect to filing a patent, we can now move to the next question of “How do I protect my patent in more than one country?”

There are two routes available to an applicant if he wishes to file for a patent in more than one country, viz.

1. Conventional route (also known as the Paris convention route/
Direct filing)
2. PCT route.

Conventional Route:

The Paris Convention for the Protection of Industrial Property, established in 1883, was one of the first intellectual property treaties. Under the Paris Convention, an applicant who files for patent protection in a member country receives the same intellectual property rights as a national of that country would. The process of applying for a patent protection under the Paris Convention is therefore often referred to as “Direct Filing.”

After filing a priority application, applicants have up to 12 months to file directly into the foreign countries where they are seeking protection. There is no circumstance under which this time limit of 12 months could be extended.

“When should I consider the Convention Route?”

The Paris Convention has a total of 176 Contracting parties, which means it offers more countries in comparison to PCT. Countries like Argentina, Bangladesh, Bhutan, Cambodia, Nepal, Mauritius and Pakistan for instance are not members of the PCT. Hence, an applicant will do well to file an application directly in these countries under the Paris Convention.

It is often advised that whenever an applicant is fully aware of the market in select countries and especially when the applicant has three or fewer countries on mind, the Paris Convention would offer to be much more cost effective than PCT.

Given the fact that a patent has a life of 20 years in theory and 14-15 years in practicality, the Paris Convention route is faster in comparison to PCT. In Direct Filing, the application is directly filed in the convention country within the time limit of 12 months which is much shorter in comparison to PCT's 30/31 month time frame. Some technologies have a very short shelf life; under such circumstances a convention filing is always advantageous.

Please [contact us](#) directly to learn more about Direct filing/Conventional filing.

PCT Route:

The Patent Cooperation Treaty (PCT) is an international patent law treaty, concluded in 1970. It provides a unified procedure for filing patent applications to protect inventions in each of its contracting states. By filing one international patent application under the PCT, applicants can simultaneously seek protection for an invention in 148 countries throughout the world. Having said that, it needs to be reiterated that filing a PCT application does not *per se* result in the grant of a patent. The grant of patent is a prerogative of each national or regional authority.

You are entitled to file an international patent application if you are a national or resident of a PCT Contracting State. If there are several applicants named in an international application, only one of them needs to comply with this requirement.

“When should I consider the PCT Route?”

With the PCT, the filing of the PCT occurs within 12 months of the priority date and then the national stage ultimately occurs within 30 or 31 months of the priority date. PCT gives 30 to 31 months time to enter into various countries from the priority date or international filing date, whichever is earlier. Thus, the PCT route gives the inventor more time to assess the commercial viability of his/her invention. This is often helpful when the applicant is either unsure of the market potential of the invention or wants more time to understand the global markets.

The PCT route is used by many of the world's major corporations, research institutions, and universities when they seek international patent protection. It is also used by small and medium sized enterprises (SMEs) and individual inventors. An applicant is always suggested to use the PCT route if he/she is looking to patent the invention in at least 4 or more countries.

The total cost incurred through a PCT filing is significantly lesser in comparison to the costs that are incurred via a Direct filing / Convention filing.

“What is the advantage of a PCT filing?”

The advantages of PCT are briefly outlined below:

1. you have up to 18 months more than if you had not used the PCT to reflect on the desirability of seeking protection in foreign countries, to appoint local patent agents in each foreign country, to prepare the necessary translations and to pay the national fees;
2. if your international application is in the form prescribed by the PCT, it cannot be rejected on formal grounds by any PCT Contracting State patent Office during the national phase of the processing of the application;
3. the international search report and written opinion contain important information about the potential patentability of your invention, providing a strong basis for you to make business decisions about how to proceed;
4. you have the possibility during the optional international preliminary examination to amend the international application, enter into dialogue with the examiner to fully argue your case and put the application in order before processing by the various national patent Offices
5. the search and examination work of patent Offices in the national phase can be considerably reduced thanks to the international search report, the written opinion and, where applicable, the international preliminary report on patentability that accompany the international application;

6. you may be able to fast-track examination procedures in the national phase in Contracting States that have PCT-Patent Prosecution Highway (PCT-PPH) agreements or similar arrangements;
7. since each international application is published together with an international search report, third parties are in a better position to evaluate the potential patentability of the claimed invention;
8. you also achieve other savings in document preparation, communication and translations because the work done during the international processing is generally not repeated before each Office (for example, you submit only one copy of the priority document instead of having to submit several copies); and
9. if your invention appears to be not patentable at the end of the international phase, you may abandon the PCT application and you will have saved the costs you would otherwise have incurred by directly seeking protection in foreign countries, appointing local patent agents in each foreign country, preparing the necessary translations and paying the national fee.

Please [contact us](#) directly to learn more about PCT filing.

Reference [here](#)

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For further information and assistance on **Conventional filing or PCT filing**, write to contact@bananaip.com