

## **How to use the Patent Cooperation Treaty: Focusing on South-East Asia**

### **What is the PCT?**

The Patent Cooperation Treaty (PCT) is a multilateral treaty that was established in Washington in 1970 and is administered by the World Intellectual Property Organisation (WIPO). The treaty makes it possible to obtain simultaneous patent protection for an invention in each PCT Contracting State by filing an international patent application. An application may be filed by a national citizen or a resident of a PCT Contracting State. All European countries, as well as China, are contracting parties to the PCT and in South-East Asia, all nations except for Cambodia and Myanmar are contracting parties.

Filing an international PCT application automatically includes all countries bound by the PCT. The application has the same effect in each country as if a national patent application had been filed with the national patent office. Therefore if an SME wishes to enter into several different South-East Asian markets, it would be time –efficient to file an international PCT application rather than preparing several different applications for individual countries.

### **The Benefits of PCT**

There are a number of advantages of applying for PCT:<sup>1</sup>

1. applicants have up to 18 months to reflect on the benefits of seeking protection in foreign countries, appoint local patent agents in each foreign country, prepare the necessary translations and pay national fees;
2. applicants can rest assured that if their international application is in the form prescribed by the PCT, it cannot be rejected on formal grounds by any designated office during the national evaluation phase;
3. Using the international search report and the written opinion, applicants can gauge a reasonable idea of the chances of their invention being patented;
4. applicants have the opportunity, during the optional international preliminary examination, to amend the international application and thus put it in order before it is processed by various patent offices;
5. examination requirements by patent offices are significantly reduced thanks to the international search report, the written opinion and, where applicable, the international preliminary report on patentability which are shared with designated offices together with the international application;
6. because the application is published with an international search report, third parties are in a better position to formulate a well-founded opinion about the potential patentability of the claimed invention;
7. for applicants, international publication puts their application on a global platform, which can provide an effective means of advertising and looking for potential licensees.

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<sup>1</sup> As written in: [http://www.wipo.int/treaties/en/registration/pct/summary\\_pct.html](http://www.wipo.int/treaties/en/registration/pct/summary_pct.html)

Ultimately, the PCT brings the world within reach, omits the major costs associated with international patent protection, provides a strong medium for making patenting decisions and is used by the world's major corporations, research institutions and universities.

### **How to apply?**

The PCT application procedure consists of two phases – the ‘international phase’ and the ‘national phase’. The international phase consists of the applicant filing an international patent application either with the national patent office of the contracting state to the PCT or with the International Bureau of WIPO in Geneva. The national phase follows the international phase and this involves the applicant communicating with the national patent offices of the countries in which they wish to be granted a patent.

#### How to apply: the international phase

Any resident or national of the Contracting States to the PCT can file an international patent application with the national patent office of the respective Contracting State. Any international application must contain the following elements:

- application request form (Form PCT/RO/101) in printed version, downloadable from [www.wipo.int/pct/en/forms/](http://www.wipo.int/pct/en/forms/)
- description of the invention
- claim or claims, defining the matter for which the protection is sought
- one or more drawings (where drawings are necessary for the understanding of the invention)
- abstract consisting of a summary of the disclosure as contained in the description, the claims and any drawings
- application fees

If the international application is filed in a language other than Arabic, Chinese, English, French, German, Japanese, Korean, Portuguese, Russian or Spanish, a translation to one of these official languages needs to be provided.

To ensure careful preparation of the international application and smooth processing, the WIPO recommends that applicants employ a professional patent attorney or patent agent, who can help with the filing and make sure that the application is filled out accurately. An agent can be appointed by requesting the agent in the specific section of the application form or by providing a separate ‘power of attorney’ document.

All international applications are subject to three types of fees – transmittal fees fixed by the receiving patent office, search fees fixed by the respective International Searching Authority, and international filing fees fixed by WIPO. The WIPO fixed fee is 1330 Swiss franc, plus 15 Swiss francs for each sheet of the international application in excess of 30 sheets. All fees can be paid together at the national patent office, where the international application is filed.

#### International application process

After filing the application, the international application is checked by the receiving Office to determine whether it meets the requirements prescribed by the PCT regarding language, form and content. This procedure is formal in nature and does not go into the substance of the invention. In this stage, the receiving Office would allow for corrections to be made to the application, so that it can meet the formal requirements. Once the application meets all formal requirements, it is given an application number and an international filing date. Thereafter, the receiving Office sends the documents to the International Bureau and to the International Searching Authority. In case the receiving Office has not transferred the documents, the International Bureau will notify the applicant and the applicant can then ask the receiving Office to provide the record copy to the applicant, so that the applicant can take it to the International Bureau.

Upon receiving the relevant documents, the International Searching Authority will carry out an international search with the aim of determining whether the claimed invention is new, whether it involves an inventive step and whether it was made available to the public prior to the international filing date. After 3 months from receiving the documents, the International Searching Authority will issue an international search report and a written opinion, which establishes whether the invention appears to be novel, involves an inventive step and is industrially applicable. The applicant then has 19 months from the priority date (if there has been no priority claim, then priority date is the international filing date) to file an application for a supplementary international search.

A supplementary international search is carried out by an International Authority other than the Authority that carried out the first search. Supplementary international search is recommended as it reduces the risk of new prior art being cited in the national phase. The increasing diversity of prior art in different languages and different technical fields means that the Authority carrying out the main international search is not always capable of discovering all of the relevant prior art. Requesting one or more supplementary international searches expands both the linguistic and technical scope of the search. It may also be possible to have the supplementary search carried out in a country where the SME is likely to enter the national phase later on. Supplementary International search requests must be filed with the International Bureau either in English or in French and there are two additional fees, 200 Swiss francs each, for handling the search. The supplementary search shall be carried out within 28 months from the priority date.

Regardless of whether a supplementary search has been requested, the International Bureau will publish an international search report 18 months after the priority date. On the same date the international application is published, the bibliographic data, the title of the invention, the abstract and a characteristic drawing (if any) of each published international application are made available on [PATENTSCOPE](#). However, if the International Searching Authority's feedback is negative and/or the applicant decides not to register for a patent after all, the application could be withdrawn before the expiry of the 18 months period, and then no search report will be published. Otherwise, this time period can be used for preparing all necessary documents for the national phase of the PCT application.

#### National phase of the PCT application

After the international phase, the applicant must complete the national phase, by approaching the state authority in which it wishes to be granted protection under. Applicants should bear in mind that they

will not receive any notifications inviting them to start the national phase. Normally, the applicant needs to enter the national phase within 30 months after the priority date. However, some designated Offices (the national patent office of your destination country) may limit the time to 20 months from the priority date. All South-East Asian countries part of the PCT set the time limit at 30 months. Indonesia and Philippines allow for an extension of 1 month, provided that a late entry fee is paid. China allows for an extension of 2 months and Singapore allows for an extension of 18 months, provided that a late entry fee is paid.

When entering the national phase, the applicant must pay the national processing of the application depending on the respective Office, which in South-East Asia varies between EUR 30 and EUR 130. In some countries the applicant is requested to provide translations of the international application. In most South-East Asian countries no translation is required, if the application was filed in English. The only exemptions are Thailand, Indonesia and Vietnam, which require a translation of all the documents into their respective languages. The international application is forwarded to the designated Offices by the International Bureau upon the request of the respective Office after the international application and search report have been published.

Applicants should also keep in mind that some countries require the applicant to be represented by an agent when entering into the national phase, if the applicants are not residents of that country. This is a requirement for most of the South-East Asian countries, except for Singapore and Brunei Darussalam, where an applicant does not have to be represented by an agent if they have a business address in the country. Even though, no new application forms will be required in the national phase, some countries nevertheless have special requirements. For example, Indonesia requires the international application to be presented before its patent office in 3 translated and notarized copies. Further specific requirements could be found in WIPO's Patent Treaty Guide, available on WIPO's website: <http://www.wipo.int/pct/en/appguide/index.jsp>.

Based on the international search report, each designated office decides whether they want to grant patent rights to the applicant's invention. In the national phase, the designated offices will carry out their own substantive search. The PCT leaves each state free to determine their own conditions of patentability. This is particularly relevant for the definition of 'prior art'. However, since the requirements of prior art, as defined in the PCT, are generally as strict as, or stricter than, those defined in any national law, the chances of experiencing any unpleasant surprises, such as uncited prior art references being raised are reduced. The national phase then ends either with the designated office granting or rejecting the patent.

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