

OBTAINING PATENT PROTECTION AROUND THE WORLD



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There are several different options available for obtaining patent protection internationally and how you proceed may depend on considerations such as how many countries you want patents in and whether or not you wish to delay costs.

One option is to file a patent application in each country where you wish to obtain protection, such as a Japanese patent application or a United States patent application.

Another option is to file a regional patent application which allows you to obtain patent protection in a number of countries, for example, a European Patent Application, or an international patent application under the Patent Co-operation Treaty (PCT). These options are discussed below.

The European Patent Application

A European patent application is a single patent application filed with the European Patent Office which designates all of the states which contract to the European Patent Convention. A European patent application also designates extension states (such as Bosnia and Herzegovina and Montenegro) and validation states (such as Moldova and Morocco) by default.

A European patent application will be subjected to an examination procedure and, if it is successful, the European Patent Office will grant a patent based on it. A European patent application remains a single patent application until grant. However, once it has been granted, it stops being a single patent application. The applicant must then validate the accepted patent application in some or all of the designated states. They are then left with a basket of separate granted patents in individual states.



A European patent application provides a cost-effective way of obtaining granted patents in multiple European states as only one examination procedure is required. By filing a European patent application, the decision as to what and how many contracting states you wish to have a granted patent in is delayed until after the grant of the actual patent. The delay in associated costs might be attractive to some clients requiring time to investigate the commercial prospects of the invention.

The International Patent Application

An international patent application can designate some or all of the countries and regions which are party to the Patent Co-operation Treaty (PCT). Despite its name, an international application does not cover all countries, a notable exclusion being Taiwan. Patent protection in Taiwan needs to be sought as an individual national patent application.

An international patent application is searched and receives at least a basic written opinion, with the option of detailed international preliminary examination. The international patent application must then be nationalised in individual countries and regions selected from those which were previously designated. The deadline for nationalisation is typically thirty months from the earliest claimed priority date, although there is some variation between countries and regions. Thereafter, it becomes a family of separate national and regional patent applications.

One important benefit of an international patent application is that it allows the applicant to delay making a final choice as to the countries and regions where they wish to obtain protection. For most countries and regions which are party to the PCT, the deadline for nationalising the international patent application is thirty months from the earliest claimed priority date.

The filing of an international patent application also allows the applicant to delay the costs of filing patent applications in individual countries and regions which are party to the PCT. It would otherwise be necessary to file these applications and incur costs by a deadline of twelve months from the earliest claimed priority date. This is partly offset, however, by the cost of the PCT application itself.

The search and optional, detailed examination procedure included in the international patent application procedure can also help an applicant establish how likely they are to receive broad patent protection before they have to commit to the costs of individual national and regional patent applications.

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