

**Government of India
Department of Industrial
Policy and Promotion
Ministry Of Commerce and
Industry**



**Office of the Controller
General of Patents, Designs &
Trademarks**

Filing international applications for patent under the Patent Cooperation Treaty

How to file a patent application simultaneously in different countries?

- **Direct** : directly file separate patent applications at the same time in all of the countries in which patent is desired (for some countries, regional patents are available)
- **Paris Convention**: having filed the first patent application in a Paris Convention country (one of the Member States of the Paris Convention for the Protection of Industrial Property), file separate patent applications in other Paris Convention countries within 12 months from the filing date of that first patent application, with the benefit of claiming the filing date of the first application in all other countries
- **Patent Cooperation Treaty** : file an application under the PCT, directly or within the 12-month period provided for by the Paris Convention from the filing date of a first application, which is valid in all Contracting States of the PCT

What is PCT?

- The **Patent Cooperation Treaty (PCT)** is an international treaty with more than 145 Contracting States. It is administered by the World Intellectual Property Organisation (WIPO)
- The PCT makes it possible to seek patent protection for an invention simultaneously in a large number of countries by filing a single “international” patent application instead of filing several separate national or regional patent applications.
- The granting of patents remains under the control of the national or regional patent Offices in what is called the “national phase”.

Advantages of PCT filing

- A single application in a single language filed in a single country called the international application
- This single application has the effect of filing simultaneously in different countries (designated countries)

Steps involved in PCT

- Filing of international application in a Receiving Office (RO)
- International Search by an International Searching Authority (ISA)
- International Preliminary Examination by an International Preliminary Examining Authority (IPEA)

Where to file (RO/IN or RO/IB)

- Nationals/Residents of India can file an international application with
 - the Indian Patent Office at Delhi, Chennai, Mumbai or Kolkata as the Receiving Office (RO/IN)
or
 - the International Bureau of WIPO as the Receiving Office (RO/IB)

The international application

- A Request (Form PCT/RO/101) accompanied by description, claims, abstract (and drawings if required) of the invention in English or Hindi
- The international application to be filed in triplicate
- Fees payable:
Transmittal fee, International Filing Fee and Search fee (all fee to be paid within one month from the date of receipt of the international application)

Transmittal Fee for RO/IN

Transmittal fee is payable to the Receiving Office within one month from date of filing of the international application

Transmittal fee	Natural person	Small entity	Other than small entity
For e-filing (applicable when the Office starts accepting the filing of international applications in electronic form)	3200 INR	8000 INR	16000 INR
For physical filing	3250 INR	8800 INR	17600 INR

International filing fee for Indian applicant

as on 19.8.2014

(see <http://www.wipo.int/export/sites/www/pct/en/fees.pdf> for fee updates)

International Filing Fee is payable to
International Bureau of WIPO within one month
from date of filing

International filing fee	1471 USD
Fee per sheet over 30	17 USD
Reduction in fee for PCT easy filing	111 USD

Search fee for Indian applicant choosing Indian Patent Office as ISA, payable within one month from date of filing

	Filing by individual(s)	Other than individuals
Search Fee	2500 INR	10000 INR

International Filing Date

- The Receiving Office India (RO/IN) accords as the international filing date the date of receipt of the international application, after the following checks:
 - (i) the applicant is a resident/national of India
 - (ii) the international application is in English or Hindi,
 - (iii) the international application contains at least the following elements:
 - (a) an indication that it is intended as an international application,
 - (b) the designation of at least one Contracting State,
 - (c) the name of the applicant, as prescribed,
 - (d) a part which on the face of it appears to be a description,
 - (e) a part which on the face of it appears to be a claim or claims.

The International Filing Date is considered to be the actual filing date in each country designated in the Request

Home, Record and Search copies

- RO keeps one copy of international application for record named 'Home Copy'
- RO sends one copy of international application to International Bureau (IB) of WIPO named 'Record Copy'
- RO sends one copy of international application to the International Searching Authority (ISA) named the 'Search Copy'

International Search and Preliminary Examination

- Every international application is subject to international search by an International Searching Authority (ISA)
- An applicant may opt for international preliminary examination by an International Preliminary Examining Authority (IPEA)

ISA and IPEA

- Few Patent Offices in the world have been recognized by WIPO to function as International Searching Authority and International Preliminary Examining Authority under the PCT.
- The Indian Patent Office started functioning as ISA/IPEA from 15th October 2013. Currently the Patent Office - Delhi branch functions as ISA/IPEA.

ISA and IPEA for IA filed at RO/IN

- An applicant from India can choose any one of the following ISA/IPEA for international search and preliminary examination
 - Indian Patent Office
 - Australian Patent Office
 - Austrian Patent Office
 - European Patent Office
 - State Intellectual Property Office of the People's Republic of China
 - Swedish Patent and Registration Office or
 - United States Patent and Trademark Office

International Search

- ISA establishes International Search Report (ISR) which identifies the published patent documents and technical literature (“prior art”) which may have an influence on whether the invention is patentable,
- ISA also establishes Written Opinion of Search Authority (WOSA) on the invention’s potential patentability.

Publication by WIPO

The international application along with International Search Report is published by WIPO after expiry of 18 months from the priority date of the application

International Preliminary Examination (IPE)

- After establishment of ISR/WOSA and publication by WIPO, the applicant may opt for International Preliminary Examination (IPE). IPEA establishes International Preliminary Report on Patentability (IPRP) (Chapter II of the Patent Cooperation Treaty)
- If the applicant does not opt for IPE, the International Bureau of WIPO publishes the WOSA as International Preliminary Report on Patentability (Chapter I of the Patent Cooperation Treaty)

Filing for IPE

- IPE is optional
- Residents/Nationals of India can file a Demand (Form PCT/IPEA/401) for international preliminary examination in the Delhi branch of the Indian Patent Office which acts as IPEA/IN.
- Fees payable:
 - Preliminary Examination fee and Handling fee (all fee to be paid within one month from the date of receipt of the international application)

Preliminary Examination fee

Preliminary Examination fee	Filing by individual(s)	Other than individual
where the ISR was issued by ISA/IN	2500 INR	10000 INR
where the ISR was not issued by ISA/IN	3000 INR	12000 INR

Handling fee

- Handling fee for Indian applicant is 221 USD as on 19 August 2014.
- For fee updates please visit <http://www.wipo.int/export/sites/www/pct/en/fees.pdf>

International Preliminary Examination

- IPEA carries out an additional patentability analysis.
- IPEA sends Written Opinion(s) to Applicant
- Applicant may make amendments to international application
- IPEA establishes International Preliminary Report on Patentability (IPRP)(Chapter II of PCT)

National Phase

- After the end of the PCT procedure, either after international search or after international preliminary examination and before 30/31 months from the priority date, applications for the grant of patents can be filed before the national (or regional) patent offices of the countries in which patent protection is desired.
- The filing procedure, fee and processing are as per the requirements of national law relating to patents in each country.
- The filing date is the international filing date in all such countries

National phase in India

- For grant of patent in India, the applicant has to file a national phase application in India before the expiry of 31 months from the priority date of the application.
- The international application as filed under the PCT is treated as corresponding application in India.

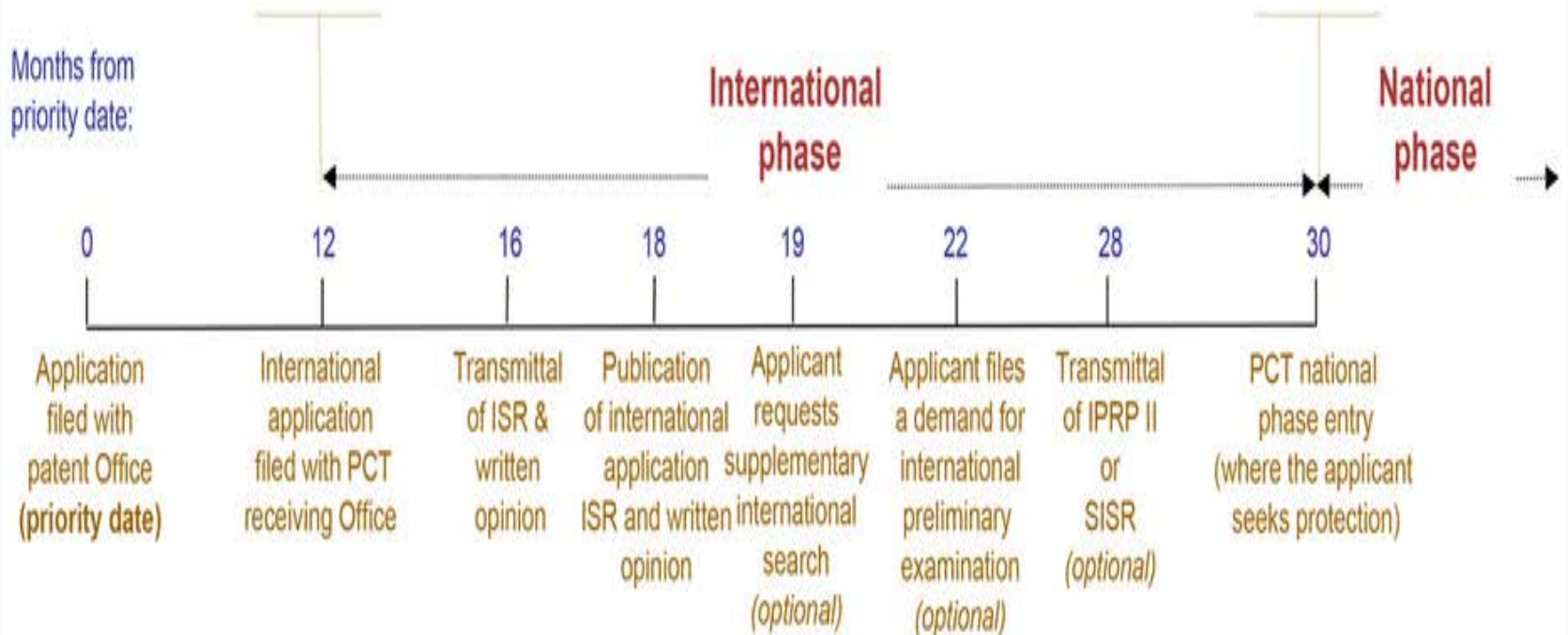
Flow under the PCT

(source - www.wipo.int)



Timelines under PCT

(source - www.wipo.int)



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[For further reference please visit:](#)

www.ipindia.nic.in

www.wipo.int/pct