

INTERNATIONAL REGISTRATION OF A PATENT

Right of Patent is a right given to the inventors to protect their ideas, inventions, machinery, processes, devices etc. This right ensures that no one else can market or sell their work subject to the rules laid down by the patent law. To obtain these rights however, the subject matter must be registered with the appropriate authority.

Registration of patent ensures that the inventor can exclusively benefit from the idea and no one else can make profits from that idea without his consent. The inventor can market his idea without any competition in the market. If someone breaches the patent right then the owner can take legal action against him.

Since patent laws are territorial in nature, the protection of patent lies only within the territory where the patent is registered. Hence in order to obtain a complete protection, it is generally advisable to make a registration in other countries also thereby extending the rights of your patent.

There are basically three methods by which one can make an international patent registration. One is by directly filing separate patent applications at the same time in all of the countries in which patent is desired (for some countries, regional patents are available).

Another option is, after 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), filing 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

The most viable and preferred option is however is to 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.

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”.

There are basically three steps that need to be completed to make a successful international registration of a patent under PCT. They are:

Filing of international application in a Receiving Office (RO)

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

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

The receiving office keeps one copy of international application for record named ‘Home Copy’, sends one copy of international application to International Bureau (IB) of WIPO named ‘Record Copy’ and sends one copy of international application to the International Searching Authority (ISA) named the ‘Search Copy’

International Search by an International Searching Authority (ISA)

Every international application is subject to international search by an International Searching Authority (ISA). 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 from 15th October 2013. Currently the Patent Office - Delhi branch functions as ISA.

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. 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 by an International Preliminary Examining Authority (IPEA)

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). If the applicant does not opt for IPE, the International Bureau of WIPO publishes the WOSA as International Preliminary Report on Patentability.

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.

By following these steps, the patent can be registered in multiple countries. This extends the protection of the law to multiple countries thereby protecting your ideas and inventions internationally.