

IP STRATEGY GUIDES

**ENTERING PCT
NATIONAL PHASE**

GUIDE BY FRESH



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WHAT IS THE NATIONAL PHASE?

The national phase is the time when patent applicants that took advantage of the Patent Cooperation Treaty (PCT) need to make a final choice where they wish to seek protection for their patent.

PCT gave applicants more time beyond the initial 12 months to decide where to file their patent application, but this time ends at the national phase. Countries that have not been entered at this stage will be lost, almost always for ever.

WHEN DOES IT HAPPEN?

The national phase typically happens 30-31 months from the very first application. It depends on the country. A full list can be found on [WIPO website](#).

A GLOBAL PROJECT

The national phase is primarily about translating the application that has already been drafted (where suitable) and submitting the relevant form in each country. The firm executing the national phase takes a project-management role and coordinates firms in other countries. National phase tends to be more expensive and more complex than previous patent actions.

HOW CAN IT BE A SUCCESS

National phases tend to produce better results if the company has a clear IP strategy, if the input from the PCT and earlier searches is fully considered and if the specifics of the application, intended countries and competitive landscape have been taken into account.

UNDERSTANDING PCT DOCUMENTS

During the PCT stage, two important documents are created: the International search report (ISR) and the written opinion. The ISR is a list of references that the examiner believes to be relevant (or not) and the written opinion is a detailed analysis of how they are relevant.

A quick look at the ISR is often enough to give the patent owner an idea of the PCT examiner's view of the patentability of the invention. Xs or Ys mean that the examiner believes that certain claims are not patentable. Claims that don't have Xs or Ys are often patentable. A positive ISR could mean a good chance to get the patent granted. It also means that the application can be accelerated almost everywhere.

PLANNING AND REDUCING COST

The cost of national phase entry are typically made up of the costs of the local firm that project-manages the filing, the foreign associates (including translation costs) and government fees of patent offices. They vary massively and can often be reduced greatly. The costs of national phase entry are also just the beginning of long-term prosecution costs that can be reduced using carefully considered prosecution strategy.

CHOOSING COUNTRIES

IP owners often have a rough idea where their primary markets are. Here are some guidelines that can help when choosing where to file applications:

1. It is useful to obtain quotes early and estimates for future prosecution costs.
2. Some countries (India, Brazil) are very slow to grant patents. Others are resistant to particular type of patents (software, medical). Consider country-specific barriers.
3. Look at where competitors are filing applications.



For the full list:

https://www.wipo.int/pct/en/texts/time_limit_s.html

United States

Available, for a fee, for any application

Available without an official fee, with a positive ISR or some corresponding applications

Other grounds, such as the applicants age or health can be used to accelerate examination.

European Patent Office

Available, without an official fee, for any application

UK IPO

Available, without an official fee, for "green" applications that make an environmental contribution or for an unspecified but well supported business reason.

China

Available, without an official fee, with a positive ISR or a corresponding application allowed. China also allows utility models for system claims which are granted faster but provide more limited protection.

Japan

Available, with a positive ISR or a corresponding application allowed.

Canada

Available with a positive ISR or a corresponding application allowed.

Australia

Available with a positive ISR or a corresponding application allowed.

United States

The applicant can request reinstatement of rights if the abandonment is unintentional. This would normally be allowed (but don't rely on this as advice to not file your patents!)

European Patent Office

Applicant can request reinstatement for a limited time after loss of rights. Afterwards, it is almost impossible to record the application.

UK IPO

Almost impossible to recover applications not filed on time.

China

Applicants are awarded a further two months to submit applications. Afterwards, it is almost impossible to recover the application.

Japan

Applicants are awarded a further two months to submit **the translation**. Afterwards, it is almost impossible to recover the application.

Canada

The applicant can request reinstatement of rights if the abandonment is unintentional within 12 months of abandonment.

Australia

Almost impossible to recover applications not filed on time.

Approaching IP Strategy

IP Strategy is the development and utilization of intellectual property to enable a business to achieve its objectives. Therefore, to think strategically about IP, a business must understand its objectives and how IP can support them.

When we start looking at IP strategy, we usually take a 2-stage approach. We recommend you take the same approach with your favourite IP consultants:

First, we map the business objectives, the current assets and current processes. We focus on:

1. Formal management - all rights belonging to the business
2. Filing strategy
3. Competition.
4. Brand protection
5. Budget management
6. Staff training

We then produce a plan and policies and mechanisms to implement the plan.

Approaching national phase strategy

The sort of questions a business should ask itself when approaching national phase are similar. Here are some to start from:

1. Is this patent giving us value?
2. How are the ISR and other searches looking? Is there a good chance for grant?
3. What are the costs and do we want to spend them?
4. Where are our markets? Where are our competitors operating/filing?