



FOREIGN FILING

It is important to note that patent registration is territorial in nature, which means patent rights for an invention have to be individually acquired in interested countries or territories. Patent is not valid worldwide, therefore there is no worldwide patent.

DIRECT FILING:

Direct filing also known as the Convention application (under Paris Convention Treaty) patent application, within 12 months of the priority date (first filing date), in a particular country/territory of interest, directly. Once a foreign application is filed it shall have the national treatment and shall be prosecuted or examined for novelty, inventiveness or non-obviousness and industrial applicability according to the local laws of the country.

PCT FILING + NATIONAL PHASE FILING

Filing of a PCT application (under Patent Corporation Treaty) in World Intellectual Property Organization office, within 12 months of the priority date, followed by filing of national phase applications in individual country/territory of interest in another 18/19 months. It is important to remember that PCT just acts as a drop box that provides an extended time for the patent application to be filed in foreign countries individually.

The filing of PCT application within 12 months provides an additional 18 months (i.e. total of 30 months, in some countries 31 months) to be filed individually in different countries, called national phase filing. The application then proceeds as an ordinary patent application in each country or territory for which the national phase was made. This immensely helps the applicant to buy time for commercially exploiting the invention via exploring the licensing opportunities in a country.

COMPLETE SPECIFICATIONS

DIRECT FILING

Timeline: within 12 months of provisional or complete filing, calculated from the first filing date or priority date.

Advantage: cost effective in case less than 5 countries are opted.

Recommendations:

when invention is proposed to be protected in less than 5 countries; and/or

when invention has to be filed in the countries who are not the members of PCT such as UAE, Taiwan etc.

PCT FILING + NATIONAL PHASE FILING

Timeline: within 12 months of provisional or complete filing calculated from the first filing date or priority date a PCT application needs to be filed.

Advantage: Additional 18/19 months time (Total 30/31 months time from date of first filing) secured to decide the countries in which the patent application needs to be filed.

Recommendations:

when invention has to be protected in more than 5 countries; when inventor needs time for analyzing opportunities in different countries; and/or when an opinion about patentability is required (optional paid service).