



Obtaining International Patent Protection

In securing Patent protection for a new product or process, one must consider the main markets for the product, in addition to countries where potential competitors have a manufacturing base. It is also worth considering countries where it might be possible to find a licensee.

The European patent system enables one to obtain protection in over 30 countries, and the PCT (Patent Cooperation Treaty) route opens up the possibility of securing Patent protection in most of the industrialised countries of the world (around 140 countries are currently members). Alternatively, one can select individual countries of interest and file in just those countries.

Any foreign Applications must be on file within twelve months of filing the basic Application. The cost of obtaining Patent protection in a large number of foreign countries can be substantial, ranging anywhere from €3,000 to €50,000 depending on the number of countries concerned. One basically has to assess the cost against the commercial value of the monopoly position in the various markets. This must be a business decision and before incurring such costs, one must be fairly sure that this will produce a return. In considering the cost, one should also consider the expenditure already incurred in getting the product to the prototype and production stages and should be in a position to put a value on the technology.

European Patents

As the European Union continues its expansion, the importance and success of the European Patent system increases. The [member states](#) of the European Patent Convention have a combined population well in excess of 300 million compared to around 280 million in the United States.

The European patent system allows one to file a single application in English to cover all of these member states. The patent examination procedure is conducted completely in English, and only after grant is it necessary to incur the expense of translating the patent specification into the national languages of those countries which have opted not to recognize English-language patents.

In general, if one is considering filing an application outside (say) Ireland, the UK and one or two additional countries, it is far more cost effective to file a European patent application than to pursue individual patent applications in each country.

The Patent Co-operation Treaty

The Patent Co-Operation Treaty (PCT) provides a way of filing a single International application in English as a first step towards securing patent rights in any of the 140 or so member countries.

Member countries include all EU countries and the EPO, the USA, Canada, Australia, China, Japan and India as well as the vast majority of industrialized countries.

The PCT system does not result in an international patent. Instead it provides a centralized filing procedure, leading to a single comprehensive search. The results of this search can be used by the Applicant to evaluate the strength of patent protection which is likely to be granted before the Applicant

makes a decision on which of the 140 countries to proceed in. One must follow up by filing the application ("entering the national phase" in PCT parlance) in those countries which are of interest.

The deadline for national phase entry is 30 months (or two and a half years) from the initial priority application.

Advantages

The single biggest advantage of the PCT system is that, at a relatively low cost, it can delay the considerable expense of filing national or regional applications. This is important in many cases where cashflow problems arise in the early stages of a new product's life cycle, or where there is uncertainty as to how widely (if at all) a product will be commercialized. The 30 month deadline allows the Applicant to defer many of the major costs and decisions until that point, 18 months after the normal priority year expires, at the expense of a single PCT filing in English. Translation costs do not arise until the national and/or regional filings.

Please Note

While this guide has covered several topics, it is intended as a very basic introduction to Patents, and certain procedures surrounding them, and as such, it is no substitute for consulting with a qualified patent attorney.

If you have any further questions, or if you have covered the information in this guide and wish to proceed with the filing of a patent application, please [contact us](#).

© **FRKelly**

Dublin, 27 Clyde Road, Dublin 4, Ireland

T:+353 1 231 4848

F:+353 1 614 4756

E: dublin@frkelly.com

Belfast, 4 Mount Charles, Belfast BT7 1NZ, United Kingdom

T:+44 28 9023 6000

F:+44 28 9023 5454

E: belfast@frkelly.com