January 2020

Memorandum - Patent Cooperation Treaty

DO YOU WANT TO PROTECT YOUR INVENTION IN SEVERAL COUNTRIES?

The Patent Cooperation Treaty ("the PCT") facilitates obtaining patent protection for inventions in any one or all of the PCT contracting states (see attached list). It provides for the initial filing of one patent application instead of filing separate national and/or regional patent applications at the outset. In due course, the international application is then prosecuted in the national phase before the national or regional offices, by filing national and regional patent applications based on the PCT application.

DO YOU WANT TO EVALUATE YOUR CHANCES OF SUCCESSFULLY PROTECTING YOUR INVENTION, BEFORE MAJOR COSTS IN FOREIGN COUNTRIES ARE INCURRED?

Once a PCT patent application has been filed, an International Searching Authority (ISA), which is typically one of the large patent offices such as the European Patent Office or the United States Patent and Trademark Office, establishes an "International Search Report" (ISR) and issues a preliminary non-binding Written Opinion on the patentability (i.e. the issues of novelty, inventive step and industrial applicability) of the invention, in the light of the prior art disclosed by the ISR. The applicant can then submit amendments to the claims of the PCT patent specification under Article 19 PCT, if necessary, and can even informally submit written comments on the ISA's written opinion; however, unless a so-called "Demand for International Preliminary Examination" is then filed and the applicable official fees paid, the applicant will not receive any feedback from the ISA as to the success of any claims amendments. Instead, an International Preliminary Report on Patentability (IPRP) with essentially the same content as the written opinion of the ISA will be issued under Chapter I of the PCT.

If a "Demand for International Preliminary Examination" is filed and the applicable fees paid, an International Preliminary Examining Authority (IPEA), which again typically is a large patent office such as the European Patent Office, is appointed and will usually consider the Written Opinion of the ISA as its own. However, the applicant then has the opportunity of filing amendments to the description and drawings as well as the claims of the PCT patent specification under Article 34 PCT, and can also submit arguments concerning the Written Opinion originally issued by the ISA. The IPEA may, at its discretion, issue further Written Opinions after submission of the applicant's arguments and/or amendments, provided *inter alia* that sufficient time is available. Such further Written Opinions are however rare. Finally (and usually following the submission of the applicant's arguments and/or amendments in response to the Written Opinion of the ISA without a further Written Opinion having issued), a nonbinding written International Preliminary Report on Patentability (IPRP) under Chapter II of the PCT will be issued by the IPEA, in general at around 28 months from the priority date of the PCT application (i.e. typically 28 months from the filing date of the South African provisional patent application from which the PCT application claims priority).

Thereafter, the applicant proceeds with patent applications in elected countries if the applicant is still positive about the patentability and/or commercial prospects of the invention. A favourable IPRP established by the ISA or the IPEA can have a strong positive influence in some of the various elected countries, whereas a poor or unfavourable examination report can, equally, have an adverse effect on the elected national phase patent applications. One of the advantages of making use of the PCT is that the claims of the patent specification can be amended, before filing national phase patent applications, with a view to limiting prosecution costs in the various national phase applications. A further advantage is that, if the ISR and the IPRP are negative, and the applicant consequently decides to abandon the PCT application and not to file any national phase applications, substantial costs involved in national filings and prosecutions can be saved.

DO YOU WANT TO KEEP YOUR OPTIONS OPEN TO PROTECT YOUR INVENTION WHILE INVESTIGATING ITS COMMERCIAL POSSIBILITIES ABROAD?

If a "Demand for International Preliminary Examination" is filed, entry into the national phase is postponed for at least 30 months from the priority date of the PCT application (typically the date of filing of your provisional patent application) for all countries. However, if such a request is not filed, then entry into the national phase must occur within 20 or 21 months of the priority date for a few countries, such as Luxembourg, Tanzania and Uganda, or within 30 or 31 months for the majority of the other PCT member countries. By filing a Demand for International Preliminary Examination, more time is therefore afforded for evaluation of the commercial success of an invention in all countries, and the costs associated with the filing of national phase applications in all countries can thus be deferred for as long as possible.

DO YOU WANT TO HAVE MORE RELIABLE PATENTS ABROAD?

Substantial benefit is obtained from the International Search Report and the International Preliminary Report on Patentability in that international standards are applied by the searching and examining authorities of the PCT. Accordingly, any patents subsequently granted on national patent applications flowing from the international application can be relied upon by the applicant to a greater extent than would have been the case without the benefit of the International Search Report and the International Preliminary Report on Patentability, particularly in non-examining countries. The International Search is normally a high quality search of patent documents and other technical literature, and the search is in accordance with international standards prescribed by the PCT.

DO YOU QUALIFY FOR A DISCOUNT IN OFFICIAL FEES?

An applicant for an international application who is a natural person (i.e. not a company, close corporation or other juristic person) and who is a national of and resident in the Republic of South Africa is entitled to a reduction of 90% of the official international filing fee (including the fee per sheet over 30 sheets) and the official handling fee. If there are several applicants, each applicant must satisfy those criteria, and at least one applicant must be a national of and/or reside in a PCT contracting state, such as South Africa.

For more comprehensive details on the PCT please contact one of our offices in Pretoria, Johannesburg, Cape Town or Durban.

PCT CONTRACTING STATES AND TWO-LETTER CODES
(153 on 1 December 2019)

AE	United Arab Emirates	EC	Ecuador		Republic	RS	Serbia (EP)
AG	Antigua and Barbuda	EE	Estonia (EP)	LC	Saint Lucia	RU	Russian Federation (EA)
AL	Albania (EP)	EG	Egypt	LI	Liechtenstein (EP)	RW	Rwanda (AP)
AM	Armenia (EA)	ES	Spain (EP)	LK	Sri Lanka	SA	Saudi Arabia
AO	Angola	FI	Finland (EP)	LR	Liberia (AP)	SC	Seychelles
AT	Austria (EP)	FR	France (EP)[2]	LS	Lesotho (AP)	SD	Sudan (AP)
AU	Australia	GA	Gabon (OA)[2]	LT	Lithuania (EP)[2]	SE	Sweden (EP)
AZ	Azerbaijan (EA)	GB	United Kingdom (EP)	LU	Luxembourg (EP)	SG	Singapore
BA	Bosnia and Herzegovina[1]	GD	Grenada	LV	Latvia (EP)[2]	SI	Slovenia (EP)[2]
BB	Barbados	GE	Georgia	LY	Libya	SK	Slovakia (EP)
BE	Belgium (EP)[2]	GH	Ghana (AP)	MA	Morocco[4]	SL	Sierra Leone (AP)
BF	Burkina Faso (OA)[2]	GM	Gambia (AP)	MC	Monaco (EP)[2]	SM	San Marino (EP)
BG	Bulgaria (EP)	GN	Guinea (OA)[2]	MD	Republic of Moldova[4]	SN	Senegal (OA)[2]
BH	Bahrain	GQ	Equatorial Guinea (OA)[2]	ME	Montenegro[5]	ST	Sao Tome and Principe (AP)
BJ	Benin (OA)[2]	GR	Greece (EP)[2]	MG	Madagascar		
BN	Brunei Darussalam	GT	Guatemala	MK	North Macedonia (EP)	SV	El Salvador
BR	Brazil	GW	Guinea-Bissau (OA)[2]	ML	Mali (OA)[2]	SY	Syrian Arab Republic
BW	Botswana (AP)	HN	Honduras	MN	Mongolia	SZ	Eswatini (AP)[2]
BY	Belarus (EA)	HR	Croatia (EP)	MR	Mauritania (OA)[2]	TD	Chad (OA)[2]
BZ	Belize	HU	Hungary (EP)	MT	Malta (EP)[2]	TG	Togo (OA)[2]
CA	Canada	ID	Indonesia	MW	Malawi (AP)	TH	Thailand
CF	Central African Republic (OA)[2]	IE	Ireland (EP)[2]	MX	Mexico	TJ	Tajikistan (EA)
		IL	Israel	MY	Malaysia	TM	Turkmenistan (EA)
CG	Congo (OA)[2]	IN	India	MZ	Mozambique (AP)	TN	Tunisia[6]
CH	Switzerland (EP)	IR	Iran (Islamic Republic of)	NA	Namibia (AP)	TR	Turkey (EP)
CI	Côte d'Ivoire (OA)[2]	IS	Iceland (EP)	NE	Niger (OA)[2]	TT	Trinidad and Tobago
CL	Chile	IT	Italy (EP)[2]	NG	Nigeria	TZ	United Republic of Tanzania (AP)
CM	Cameroon (OA)[2]	JO	Jordan	NI	Nicaragua		
CN	China	JP	Japan	NL	Netherlands (EP)[2]	UA	Ukraine
CO	Colombia	KE	Kenya (AP)	NO	Norway (EP)	UG	Uganda (AP)
CR	Costa Rica	KG	Kyrgyzstan (EA)	NZ	New Zealand	US	United States of America
CU	Cuba	KH	Cambodia[3]	OM	Oman	UZ	Uzbekistan
CY	Cyprus (EP)[2]	KM	Comoros (OA)[2]	PA	Panama	VC	Saint Vincent and the Grenadines
CZ	Czechia (EP)	KN	Saint Kitts and Nevis	PE	Peru		
DE	Germany (EP)	KP	Democractic Peoples' Republic of Korea	PG	Papua New Guinea	VN	Viet Nam
DJ	Dijbouti			PH	Philippines	***WS***	***Samoa (from 2 January 2020)***
DK	Denmark (EP)	KR	Republic of Korea	PL	Poland (EP)		
DM	Dominica	KW	Kuwait	PT	Portugal (EP)	ZA	South Africa
DO	Dominican Republic	KZ	Kazakhstan (EA)	QA	Qatar	ZM	Zambia (AP)
DZ	Algeria	LA	Lao Peoples' Democratic	RO	Romania (EP)	ZW	Zimbabwe (AP)

1 Extension of European patent possible.
2 May only be designated for a regional patent (the "national route" via the PCT has been closed)
3 Validation of European patent possible for international applications filed on or after 1 March 2018.
4 Validation of European patent possible.
5 Only extension of European patent possible. Applicants wishing to obtain patent protection in Montenegro should enter the regional phase before the European Patent Office (EPO) and seek the extension of the European patent application and the granted European patent to Montenegro as there is no national phase before the Intellectual Property Office of Montenegro.
6. Validation of European patent possible for international applications filed on or after 1 December 2017.

Where a state can be designated for a regional patent, the two-letter code for the regional patent concerned is indicated in parentheses (AP = ARIPO patent; EA = Eurasian patent; EP = European patent; OA = OAPI patent). For further information on regional patent protection, please refer to our foreign pamphlet.

Important: This list includes all States that have adhered to the PCT by the date shown in the heading. Any State indicated in ***bold italics*** has adhered to the PCT but will only become bound by the PCT on the date shown in parentheses; it will not be considered to have been designated in international applications filed before that date.
Note that even though the filing of a request constitutes under PCT Rule 4.9(a) the designation of all Contracting States bound by the PCT on the international filing date, for the grant of every kind of protection available and, where applicable, for the grant of both regional and national patents, applicants should always use the latest version of the e-filing software used to generate the request form, or the latest versions of the request form (PCT/RO/101) and demand form (PCT/IPEA/401) (the latest versions are dated 1 July 2019). The request and demand forms can be printed from the website, in editable PDF format, at http://www.wipo.int/pct/en/forms), or obtained from receiving Offices or the International Bureau, or, in the case of the demand form, also from International Preliminary Examining Authorities. Where possible, applicants are encouraged to use ePCT-Filing in order to benefit from the most up-to-date PCT data.

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