

INTERNATIONAL PATENTING OF INVENTIONS

Intellectual property laws, including those relating to patents are in the main national in scope. The patent laws have been, and are, used as instruments of national economic policy at least in part to encourage the establishment of new industry in the patenting national. As the business of technology has become increasingly international, some forms of international cooperation have arisen that make it easier to obtain multi-national patent protection. This article comments on three international treaties. These are:

The Paris Convention (1883 - 1967)

The European Patent Convention

The Patent Cooperation Treaty

Paris Convention 1883 - 1967

The Paris Convention of 1883 established the International Union for the Protection of Industrial Property in 1884. Members of the Union (referred to as Convention Countries) are obliged to give subjects of each other Convention Country the same protection and advantages as granted to their own nationals. In other words, a Convention Country is not supposed to discriminate against the citizens or subjects of another Convention Country.

The Paris Convention also established a "Convention Priority". This entitles anyone who applies for a patent, utility model registration, industrial design registration or trade mark registration in a Convention Country the right to claim the filing date of their first application as an effective filing date for corresponding applications in other Convention Countries. The later filed applications must be filed within a certain period after the first application. In the case of patents, the period is one year. However, national novelty requirements still apply to events taking place before the first application is

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filed so that disclosure of the invention to the public before the first application is filed will in many countries prevent the granting of a valid patent.

European Patent Convention

The European Patent Convention came into force in 1977. It established a single European Patent Office where a single patent application may be filed, examined and approved for multiple European countries, including most of the European economic community. The European Patent Convention has grown to reach 34 member states in 2008. Under the European Patent Convention, an approved application must be validated in each of the designated countries to create national patent rights in those countries. The system thus results in what may be referred to as a "bundle" of national patents. The advantages of the European patent system are the reduced costs involved in filing and prosecuting a single application in one language until the application has been approved. National government fees, translation costs and foreign representatives fees are all minimized.

National patent laws remain in effect in the various countries but have been brought into agreement. The national systems may be used as an alternative to the multi-national European patent system. Usually this is done where protection is sought in only a small number of European countries.

Patent Cooperation Treaty

The Patent Cooperation Treaty came into force in 1985. Canada became a member in January 1990. This treaty allows residents or nationals of member countries to file a single international application at their local Patent Offices (referred to as Receiving Offices). The application may designate over 130 countries or regional Patent Offices, including the European Patent Office. The application may claim Convention Priority from an earlier application or it may form the basis for a later claim for Convention Priority.

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Once filed, the international application is the subject of an international search carried out by an International Searching Authority. The Searching Authority may or may not be the Receiving Office. For applications filed by Canadian residents or nationals in Canada or with the International Bureau, the International Searching Authority is presently the Canadian Patent Office. The European Patent Office was the Searching Authority for international applications filed in Canada prior to July 26, 2004.

For most member countries, the applicant has 30 months from the filing date, or priority date if applicable, to enter a national phase in those countries where protection is sought. The applicant may request a preliminary examination by an International Preliminary Examining Authority within 22 months from the filing date, or priority date if applicable, of the international application or within 3 months from receiving the international search report from the International Searching Authority, whichever period expires later. For a small group of reservation countries, this request must be filed within 19 months from the earlier of the filing date and the priority date, if applicable, of the international application in order to take advantage of the 30 month time limit to enter the national phase. Otherwise, the time limit for entering the national phase in these countries is 20 months, rather than 30. For Canada, the International Preliminary Examining Authority is presently the Canadian Patent Office. For international applications filed in Canada prior to July 26, 2004, this authority was the European Patent Office.

Entering the national phase is somewhat simpler than filing a national application in the first instance, although translations are required and national fees and foreign agents charges must be paid.

The main benefits of the Patent Cooperation Treaty process are:

1. The ability to file a single application quickly, designating a large number of countries.
2. The deferral of national filing costs for up to 30 months. Viewed from this point of view, the Patent Cooperation Treaty process is the purchase of an option to file in the various designated states.

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3. Obtaining an international search and a preliminary Patent Office opinion regarding patentability before national filing fees are paid.

Other International Developments

There is a continuing international effort to harmonize national patent laws. These have brought about much more uniformity in both the formalities required for patent applications and the legal requirements for obtaining a patent. Canada's amendments to the Patent Act include a number of efforts to this end.

In addition to the European Patent Convention, multi-national patent systems are in effect in western Africa, eastern Africa and Eurasia. The Eurasian system covers much of the former Soviet Union.

The World Trade Organization (WTO) treaty also provides a one year right of priority, like that of the Paris Convention. A number of the countries adhering to this treaty do not belong to the Paris Convention.

In future, it can be expected that a European Community Patent will be available through the European Patent Office. This will be a single patent providing rights in most of the European Economic Community. Some countries might opt out of the process.

Despite all of these developments there remain some countries that must receive individual attention if patent protection is sought. Anyone considering the patenting of an invention internationally should seek the advice of their Patent Agent at an early stage to ensure that the correct options are being chosen and no rights are inadvertently lost.

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