

Patent Cooperation Treaty

New Zealand is a member of the Patent Cooperation Treaty (PCT) along with 142 other countries. A list of PCT member countries is shown in Table 1.

The PCT system is an international patent filing system that allows an applicant to delay incurring the significant costs associated with an extensive filing program for about 18 months. Ordinarily these costs would be incurred about 12 months after the first patent application (usually a provisional patent application) has been filed. Using the PCT route, the costs are delayed until 30 months (31 months in some countries) from the provisional application filing date.

In order to benefit from this extra time, your PCT international application must be filed within 12 months of your provisional patent application.

A simplified timeline is shown in Table 2, which indicates the basic structure of the PCT process.

Benefits

The primary benefit of the PCT system is that the additional 18 months may allow an applicant to generate cash flow from the invention to support the ongoing costs of obtaining granted patents in a number of countries. It also allows the commercial strengths and weaknesses of the invention to be better understood, meaning that more informed decisions can be made about whether or not to continue with patent protection in certain countries. As the PCT system also automatically provides an international novelty search and Written Opinion, as part of the cost of the process, the ability to make informed decisions is further enhanced.

Costs

The PCT system does add a level of cost to the overall investment. A PCT international application will normally cost between \$NZ8,500 and \$NZ12,000. This however represents a considerable reduction in cost 12 months into the international filing program. Filing directly into Europe, for example, via the European Patent Office, will alone exceed this amount using the alternative direct route. Costs will still be incurred when filing into the countries of relevance to you at the end of the additional 18 month period but typically the applicant will be in a better position by then, both commercially and financially, to proceed.

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New Zealand

While New Zealand is a country that can be included as part of a PCT filing program, there are significant uncertainties in doing this. Therefore, if you have filed a provisional patent application in New Zealand, we strongly recommend that this be continued at the same time as the PCT International application is filed. The cost of this is usually about \$2000.00.

PCT Contracting States (Effective 1 February 2010. Please note: this list is constantly being updated).

Table 1

| | |
|-------------------------------|---|
| Europe: | Albania, Armenia, Austria, Belarus, Belgium, Bosnia and Herzegovina, Bulgaria, Croatia, Cyprus, Czech Republic, Denmark, Estonia, Finland, France (including Overseas Departments and Territories), Georgia, Germany, Greece, Hungary, Iceland, Ireland, Italy, Latvia, Liechtenstein, Lithuania, Luxembourg, Malta, Republic of Moldova, The former Yugoslav Republic of Macedonia, Monaco, Montenegro, Netherlands, Norway, Poland, Portugal, Romania, Russian Federation, Serbia, San Marino, Slovakia, Slovenia, Spain, Sweden, Switzerland, Turkey, Ukraine, United Kingdom. |
| The Americas | Antigua and Barbuda, Barbados, Belize, Brazil, Canada, Chile, Colombia, Costa Rica, Cuba, Dominica, Dominican Republic, Ecuador, El Salvador, Grenada, Guatemala, Honduras, Mexico, Nicaragua, Peru, Saint Kitts and Nevis, Saint Lucia, Saint Vincent and the Grenadines, Trinidad and Tobago, United States of America (including the Territories of Guam, Puerto Rico, Samoa and the Virgin Islands). |
| Asia & The Pacific | Australia, Azerbaijan, China, Democratic People's Republic of Korea, India, Indonesia, Japan, Kazakhstan, Kyrgyzstan, Lao People's Democratic Republic, Malaysia, Mongolia, New Zealand, Papua New Guinea, Philippines, Republic of Korea, Singapore, Sri Lanka, Tajikistan, Thailand, Turkmenistan, Uzbekistan, Vietnam. |
| Africa: | Algeria, Angola, Benin, Botswana, Burkina Faso, Cameroon, Central African Republic, Chad, Comoros (K M.), Congo, Cote d'Ivoire, Egypt, Equatorial Guinea, Gabon, Gambia, Ghana, Guinea, Guinea-Bissau, Kenya, Lesotho, Liberia, Libyan Arab Jamahiriya, Madagascar, Malawi, Mali, Mauritania, Morocco, Mozambique, Namibia, Niger, Nigeria, Sao Tome and Principe, Senegal, Seychelles, Sierra Leone, South Africa, Sudan, Swaziland, Togo, Tunisia, Uganda, United Republic of Tanzania, Zambia, Zimbabwe. |
| Middle East: | Bahrain, Israel, Oman, Syrian Arab Republic, United Arab Emirates. |

PCT Time line

Table 2

| New Zealand Provisional Patent Application | PCT International Patent Application | Search Report & Written Opinion Issues | Publication of PCT International Application | International Preliminary Examination (Optional) | Filing into countries of relevance | Each country's Patent Examination Process |
|--|--------------------------------------|--|--|--|------------------------------------|---|
| | | | | | | |
| 0 months | 12 months | 16 months | 18 months | 19 - 25 months | 30 - 31 months | |