

International Patent Filing systems - PCT & GCC Patents

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Patent Cooperation Treaty (“PCT”)

The World Intellectual Property Organization’s Patent Cooperation Treaty (PCT) provides the means to facilitate the filing and protection of patents internationally. In 2011 alone, more than 181,000 international patent applications were filed under the PCT.

This is the most international of patent applications one can file where a single filing can secure an effective filing date in all of its member countries. Its membership comprises a large number of countries and the list continues to grow.

The PCT system has in 2013 been adopted by 146 countries including numerous countries in the Middle East and North Africa, including:

- Algeria
- Bahrain
- Egypt
- Libya
- Morocco
- Oman
- Qatar
- Sudan
- Syria
- Tunisia
- UAE

The PCT patent application filing system includes two phases:

1. International Phase

The international application is filed and an International Search Authority undertakes an international search whereupon a search report containing citations of relevant prior art and a written opinion on the patentability of the invention is produced. The application is published as an International Publication and the applicant has an option whether to undertake international preliminary examination of an application.

2. National Phase

The national phase application is effectively filed in the various countries in which the applicant is ultimately seeking patent protection and it is at this stage that the application is substantively examined and a decision is taken to grant or reject a patent is made.

A PCT application does not mature into some kind of “international” patent registration. It merely acts as a vehicle facilitating the filing applications at each of the national patent offices of the member countries an

applicant is interested in. The PCT system provides for a “delay” of up to 18 months in having to incur the expenses of proceeding with applications at each national patent office of interest and accordingly buys an applicant valuable time in seeking funds from investors, finding partners or just to reassess the commercial viability of an invention.

The time bought through the use of the PCT system also affords applicants more time to reflect on the desirability of seeking protection in foreign countries, to appoint local patent attorneys in those countries, to prepare the required translations and to pay the local fees.

Applicants may rest assured that their PCT compliant national applications may not be rejected on formal grounds by any of the national offices during the national phase. They also have the benefit of the international search report and the written opinion to better assess the patentability of their inventions. Importantly, they have the opportunity of amending their international application before processing by the national offices.

Foreign applicants would note that a number of countries in the Middle East are not PCT members including Saudi Arabia and Kuwait. Apart from filing directly in these countries, a GCC patent application could be an appropriate tool for seeking patent protection in these countries.

GCC Patent System

The GCC patent system provides a convenient way for applicants to secure patent rights effective in each of the GCC member states.

The Cooperation Council for the Arab States of the Gulf, also known as the Gulf Cooperation Council (“GCC”), is an association comprising Bahrain, Kuwait, Oman, Qatar, Saudi Arabia and the UAE. The association forms a trade bloc and provides a common market, including coordination of customs regulations and various trade-related laws, and there is even a proposal for a unified currency under discussion.

The GCC patent system does not form part of the Patent Cooperation Treaty (PCT) nor is it a signatory to the Paris Convention. However, it is important to note that the GCC Patent Office (“GCCPO”) honours the Paris Convention priority rules and a GCC application can claim priority from a prior convention application as if the GCC were a signatory to the Paris Convention.

Paris Convention

The Paris Convention allows an applicant to delay the filing of a patent application in another member country by up to 12 months as long as the applicant has filed a patent application in one member country.

The practical benefit is that once the patent application is filed, the applicant can disclose the invention e.g. by selling products embodying the invention and still obtain patents for the same invention in other member countries of the Paris Convention providing that applications are filed within the 12 months grace period and a claim to Paris Convention priority is made.

Upon filing, examiners at the GCCPO examine a GCC patent application for compliance with formalities. The applicant then has an opportunity to address any objections arising from the examination of formalities. Substantive examination is then undertaken on behalf of the GCCPO by IP Australia, the Austrian Patent Office or the Chinese Patent Office.

Once the applicable patent opposition period has expired, and the GCCPO has granted a patent, the grant of the patent may be challenged before the responsible authority in Saudi Arabia – the Board of Grievances.

With respect to the enforcement of GCC patents, claims of patent infringement are heard by the

responsible courts in the relevant GCC member states where the infringement is alleged to have taken place.

For local UAE applicants, a common strategy is to file a UAE application followed by a PCT application if overseas markets outside of the GCC common market are of interest. Otherwise, if only the GCC countries are relevant to say a purely GCC focused product, then it would be expedient to file a GCC patent application.

The PCT and GCC patent systems are valuable tools at the disposal of patent applicants as they facilitate the protection of patents in multiple jurisdictions.

If you require any assistance in respect of the protection and enforcement of patent rights in the Middle East, please contact the author.