

CASE STUDY: “Patenting the PCT”

Ask any inventor about the biggest stumbling block facing protection of his invention worldwide and you will get the same answer: cost. “It’s a double-edged sword,” says Australian patent attorney Justin Simpson. “To get sufficient financial backing to protect their idea, inventors will often reveal a prototype of their creation to a large, cashed-up company. But by doing so, they will actually eliminate their own ability to patent the invention – and lose out anyway.”

The Sydney-based attorney had long harbored a suspicion that there had to be an easier – and cheaper – way to get the ball rolling on international patent protection. Especially since some aspects of the work in filing patent applications internationally are relatively simple. “I thought, there must be a way to do this online,” says Mr. Simpson. “After all, once you’ve filed your international patent application [under the Patent Cooperation Treaty (PCT)], the actual process of entering the National Phase in your designated countries is just a matter of filling out the right forms, paying a fee and lodging them with the right patent office.”

So Mr. Simpson set about using his computer science background to develop an Internet-based solution. His system allows the user to complete the transaction of entering the national phase at the end of the PCT international phase, before the patent offices of the countries designated in the PCT application, in one easy step.

PCTFILER

Once he had designed his system for handling the administrative tasks of preparing and filing National Phase applications, Mr. Simpson took his own advice and applied for a patent on his system. “It was the first thing I did,” he said. A partnership under the name of “PCTFILER” is now the exclusive licensee of PCT Application No. PCT/AU01/01353, entitled “System and method of attracting and lodging PCT National Phase applications”. The international application defines a number of inventions, including:

1. A method and system for lodging a PCT national phase patent application with a patent office.
2. An interface for receiving PCT national phase filing instructions; and
3. A computer system for sending an e-mail to a patent attorney, inviting them to enter the national phase through PCTFILER.

Prospects for the eventual patentability of Mr. Simpson’s PCT-related invention look very bright; an International Preliminary Examination Report (IPER) has confirmed that the 74 claims examined appear to be novel and inventive in light of the known prior art.

Using PCTFILER

In order to use the PCTFILER system, PCT applicants must go online, enter the PCT application number and select the designated states in which they would like to enter the national phase. PCTFILER’s automated system then generates the correct forms for the chosen countries and sends them electronically to the PCTFILER partner attorney in each country. The forms are then printed and filed in that country’s patent office by the registered attorney for that jurisdiction.

PCTFILER currently offers national phase filing services in Australia, Brazil, Canada, India, New Zealand, Singapore, South Africa, the United Kingdom, and the United States of America as well as regional phase filing services before the European Patent Office. Mr. Simpson has plans to extend the service in the near future to Germany, Israel, and Japan and later to China and Indonesia.

He hopes that the system will one day become even more automated, thus eliminating the need for physical printing of each application. "For an industry that constantly deals with innovation, many patent offices still do things in a remarkably old-fashioned way," said Mr. Simpson. "Patent attorneys are in the business of new technology. We know that, our clients know that and they expect us to use technology in our business. And if it saves them money, they like that too."

Mr. Simpson recognizes that his system can be successful because the initial national phase entry transaction for any designated state is typically a straightforward matter. However, he acknowledges that the subsequent prosecution of a patent application in the national phase before a particular national or regional patent office can be more complex, thus requiring the specialized knowledge and skills of an experienced local patent attorney.

Where translations are required for national phase entry, PCTFILER's partner attorneys worldwide are ready to translate all the relevant documents, using their specialist technical knowledge, at highly competitive prices. The international network of PCTFILER attorneys is also available to handle the national phase prosecution, but applicants and inventors can choose any attorney they like.

Reduced cost

What is the biggest benefit of the PCTFILER system? Reduced costs. Mr. Simpson claims that by his calculation PCTFILER charges, on average, are less than half the fees currently charged by other patent attorneys for the same work. "I believe you shouldn't have to pay prohibitive fees to protect your invention on the world stage," said Simpson. "After all, a company's intellectual property is often its most valuable asset. That's why it's crucial to have adequate protection. PCTFILER makes it more affordable to enter the national phase in more of the PCT designated states, and that can only be a good thing for inventors."

For more information, visit <http://www.pctfiler.com>

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