

The easier and cheaper way to international patent

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On October 6th, 2015 the International Patent Cooperation Union acting under the Patent Cooperation Treaty (“PCT”) by the World Intellectual Property Organization (“WIPO”) unanimously decided to give the Visegrad Patent Institute (“VPI”) a status of the International Searching Authority (“ISA”) and the International Preliminary Examining Authority (“IPEA”). Most likely already in July 2016 the applicants from the Visegrad Group countries will be able to use the VPI in order to conduct proceedings before this body for the international patent applications. It will be an alternative option to carry out a PCT international procedure before applicant’s own national office, in applicant’s own national language, and at a lower costs than it was before.

The Visegrad Patent Institute will be an intergovernmental organization based on the resources, knowledge, and skills of the National Industrial Property Offices from Poland, Hungary, the Czech Republic, and Slovakia.

A patent application filed under the PCT is a single application procedure but it allows, however, to ultimately obtain a patent protection in 148 countries through its continuation in the national and regional phases proceedings. An International patent application is subjected to the search procedure conducted by the ISA and possibly, on the applicant’s request, examination procedure carried out by the IPEA. The aforementioned bodies compile the International search report together with Written opinion of ISA and international preliminary examination report on patentability, respectively, and based on it the applicant is assessing further chances to obtain a patent. The Visegrad Patent Institute will therefore act as a body assessing the patentability in the international phase.

This valuable initiative aims to facilitate the access to the PCT system for applicants from the countries belonging to „V4” and the neighboring countries if their Patent Offices designate the VPI as the competent international body to conduct searches and examinations of the International patent applications.

The undoubted advantage, especially for small and medium-sized companies, will be the possibility to communicate with the Visegrad Patent Institute in a national language during international procedure, file an international application in a national language, and reduce application fees incurred by the applicants.

Currently, a Polish entity applying for a patent protection is capable of making an international patent application in the Patent Office of the Republic of Poland (“PPO”) in the European Patent Office (“EPO”) and in the International Bureau of the World Intellectual Property Organization (“IB WIPO”). So far, unfortunately, the International patent applications in the Polish language can only be filed at the IB WIPO and within a month from filing the applicant is obliged to file its translation for publication and examination purpose.

Currently, both the PPO and the EPO accept International applications from the Polish applicants only in English, German, and French. When the VPI initiates its activity, an applicant from Poland will obtain a possibility to file an International application in the PPO in a Polish language and they will have 14 months from the priority date to submit a translation for publication purposes. Depending on the date of filing of an international application, it may give more time necessary to prepare and file a translation of the application. The creation of VPI will also enable the applicants from Poland to choose another body than EPO acting as ISA or IPEA.

The introduction of a ‘competition’ on this service market will undoubtedly be an advantage but the choice of a particular authority conducting a search and examination shall be preceded by a detailed analysis of the applicant’s patent strategy. For example, the recently introduced by the EPO new service called ‘PCT Direct’ enables to submit in the PCT

procedure comments to searches and opinions issued by the EPO for international applications claiming priority from the earlier applications for which the examination was conducted by the EPO.

The applicants from the Central and Eastern Europe will be able to proceed an international application in the international phase before the Visegrad Patent Institute in a cheaper and easier way which, in turn, may be important for the development of innovation and competitiveness in our part of Europe. It is assumed that the fees will lower by 25-37% compared to the fees charged by EPO for the same services. Lowering the costs will be especially important for universities and research institutes but also for individual persons as well as for small and medium enterprises.

It shall be kept in mind that the success of VPI will be determined by the quality of searches and examinations conducted by this authority which – so as to make the body competitive – shall not diverge from the quality of search and reports issued by the EPO.