



Lecture
Notes

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Paper F Notes

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Chapter 1

Introduction to the Patent Cooperation Treaty — PCT

1.1 Historical Notes and Some Quick Facts

The **Patent Cooperation Treaty** (PCT) is an international patent law treaty, concluded in 1970. It provides a unified procedure for filing patent applications to protect inventions in each of its contracting states.

☞ Signed on June 19, 1970 in Washington D.C.. Entered into force on January 24, 1978. The first application was filed on June 1, 1978.

☞ A patent application filed under the PCT is called an international application, or **PCT application**.

☞ No case law. No appeal body – with exception of questions relating to unity of invention.

☞ Rules have to cover all situations that might occur – therefore are very detailed.

☞ Contracting States have agreed to accept international filing date and the form and content of an international application having the effect of a national application, but they **have not limited the freedom to grant patents** to an **International Authority (IA)**. This runs in contrast to the EPC — for example — where that freedom has been ceded.

☞ The international phase includes filing + search + publication + (optional) non-binding examination. No decision to grant.

Definition

“National phase” for the purposes of PCT should be understood to mean “national” or “regional phase.”

☞ Any signatory of the Paris Convention may accede to the PCT.

☞ The national office (NO) must approve form and content of the application as approved in the international phase.

☞ The cost of entering national phase is similar to a direct national application. Further search + examination may be carried out in the national phase, but the use of the **international search report (ISR)** and examination may result in a fee reduction at national phase.

☞ NO will grant patent on initial application with the same effect as on a direct national application.

☞ PCT is administered by the World Intellectual Property Organization (WIPO), which is a UN agency. The International Bureau (IB) of WIPO carries out admin for the International Patent Cooperation Union that the Contracting States make up.

☞ The international phase is carried out before International Authorities. There are > 120 of them and > 20 can act as **International Search Authorities (ISAs)** or **International Preliminary Examination Authorities (IPEAs)**.

☞ After the international phase, all NOs act as so-called **designated Offices (dO)** or **elected Offices (eO)** [the latter in *Chapter II*.]

1.2 The Paris Convention for the Protection of Industrial Property

Full Text

☞ Signed on March 20, 1883.

☞ Agreement between countries for mutual recognition of IP rights. Nationals of Signatory Countries enjoy the same rights in other States as nationals of those other States.

☞ It secured **the right of priority** of a first filing in one State for subsequent applications in other States.

☞ A **priority right** is a time-limited right triggered by the **first filing** of an application for a patent, industrial design, or trademark. It allows the applicant to file a **subsequent application** in another country that is effectively treated as if filed on the date of the first application, known as the **priority date**. To use this right, the applicant (**or their successor in title**) must **claim priority** in the subsequent application.

☞ The priority period is **12 months** for patents and utility models (the **priority year**) and **6 months** for industrial designs and trademarks. In the original Paris Convention it was 6 months and 3 months, respectively.

☞ For patents, this right is crucial because **novelty** and **inventive step** are assessed against prior art that was made public **before the priority date**, not the actual (later) filing date of the subsequent application.

Rationale

according to the EPO: “(...) *basic purpose [of the right of priority] is to safeguard, for a limited period, the interests of a patent applicant in his endeavour to obtain international protection for his invention, thereby alleviating the negative consequences of the principle of territoriality in patent law.*”

☞ § **Art. 19** of the Paris Convention allows for special agreements between Signatory Countries. The Paris Convention takes precedence over laws of the Countries and over such special agreements.

☞ EPC is a “regional patent treaty” in the sense of **Art. 19** of the Paris Convention, e.g., under **Art. 45 PCT**, a PCT applicant can obtain an EP patent by filing an initial international application.

Definition

$$\begin{cases} \text{Patent in a state} & = \text{national} \\ \text{Patent for a state} & = \text{regional} \end{cases}$$