

ENTERING THE PCT NATIONAL PHASE IN BELIZE

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INTRODUCTION

This article provides an outline of the procedure involved in the filing and processing of Patent cooperation Treaty (PCT) applications in Belize. The article commences with an overview of the PCT and the procedure involved in the international phase of the PCT. The article then traces the steps necessary to enter the national phase in Belize, including the national application, priority claims, examination, refusal or grant of a patent, and the duration and maintenance of a patent.

THE INTERNATIONAL PHASE

The PCT is a World Intellectual Property Organisation (WIPO) administered treaty that provides for the filing of international applications with a view to obtaining patent protection in a large number of countries.¹ A patent is the title granted to protect an invention.² The PCT provides a simplified procedure for an inventor or applicant to apply for and eventually to obtain a patent. The PCT is a special agreement under the Paris Convention for the Protection of Industrial Property (Paris Convention), and the principal objective of this agreement is to render the obtaining of patent protection in several countries more effective and economical.³

The PCT process involves the filing of an international application by the applicant.⁴ This single international application has the same effect as filing separate applications with the patent offices of PCT Contracting States that are designated in the application.⁵ Nationals of PCT contracting States, as well persons who have their place of business or residence in such states, are entitled to file PCT applications.⁶

The application is processed through several stages. The first stage is the general stage known as the international phase. There are four main steps in the international phase. The first step is the filing of the international application, designating countries of interest (designated offices); the second step is the international search; the third step is the international publication; and the fourth step is the international preliminary examination.⁷

The international search leads to an international search report that contains the International Patent Classification symbols, indications of the technical areas searched and relating to any finding of lack of unity, a list of relevant prior art documents, and indications relating to any finding that there was a lack of a meaningful search in respect of certain claims.⁸ The international preliminary examination produces a report on a number of basic questions such as patentable subject matter, novelty, inventive step and industrial applicability.⁹ These reports are very invaluable for offices like the Belize Intellectual Property Office (BELIPO), and they provide the foundation upon which BELIPO grants or refuses patent applications.

The PCT does not provide for the granting of an “international patent”. The privilege of granting patents is reserved for the various national offices such as BELIPO or for regional offices such as the European Patent Office (EPO).¹⁰ If the PCT applicant wishes to take advantage of this privilege, the applicant then proceeds to the second stage of the PCT process, which is known as the national phase. This national phase involves the filing of patent applications in the intellectual property offices of the different designated countries, which are still of interest to the applicant.

THE NATIONAL PHASE

The Application

BELIPO acts as a Designated Office in respect of an international application in which Belize is designated, and as an Elected Office in respect of an international application in which Belize is designated if the applicant elects Belize for the purposes of an international preliminary examination and entry into national phase.¹¹

BELIPO processes international applications in accordance with the provisions of the PCT, the Patents Act, the Patents Regulations and the Patents (General Procedures) Administrative Instructions.¹² An international application designating Belize is regarded as a patent application filed under the Patents Act, and having, as its filing date, the international filing date under the PCT.¹³ The appointment of an agent shall be formalized by the filing of a Power of Attorney with BELIPO.¹⁴

The applicant is required, before the expiration of the time limit applicable under Article 22 or 39 of the PCT, to pay the prescribed national fee of BZ\$900

(US\$450 – including filing, publication, address for service, and grant fees) to BELIPO, and to file a translation of the international application with BELIPO (if the international application was not filed or published in the English language).¹⁵ The time limit under Article 22 or 39 of the PCT is 30 months from the priority date. Failure by the applicant to pay the prescribed national fee, and file an English language translation of the international application (where necessary), would cause the international application to lose its effect in Belize, with the same consequences as the withdrawal of any national application in Belize.¹⁶

It is worth noting that the description, the claims, the drawings (if necessary), and the abstract, are usually submitted to BELIPO by the International Bureau of WIPO.¹⁷ **Therefore, it is not necessary for the applicant to file the national phase application with copies of the relevant international application, specification, international search report, and international preliminary examination report.**¹⁸ These documents together with the international search report and the international preliminary examination report are relied on by BELIPO in the determination of whether to grant or refuse the application.

An applicant may also apply online when entering the PCT national phase in Belize by clicking on the QUICKPAT link on www.belipo.bz. This webpage contains electronic forms for a petition for a patent (not required for PCT national phase applicants),¹⁹ application for an address for service and power of attorney.²⁰ The electronic forms may be signed by using any combination of letters, numbers, spaces or punctuation marks placed between two forward slash (“/”) symbols.²¹ Examples of acceptable signatures for electronic application forms include /ramses/, /drl/, and /577-34567/.²² The electronic forms may also be signed by printing, completing and faxing or emailing the Facsimile Signature Form.²³ An applicant must notify the Office of his particular method of electronic signature.²⁴

An applicant may file the electronic forms without submitting copies of the relevant PCT international application, specification, international search report, and international preliminary examination report.²⁵

An applicant can pay the patent application fees at BELIPO, or by posting a cheque to BELIPO endorsed in the name of the Government of Belize.

An application may be withdrawn at any time before the patent is granted. Also, the application may be amended at any time before the patent is granted.²⁶ This is based on the fact that the PCT allows the applicant to amend the

description, the claims and the drawings before any Designated or Elected Office.²⁷ However, such amendment shall not include any matter that was not disclosed at the time of the filing of the initial application.²⁸

Right of Priority

The request for a patent may also contain a declaration claiming priority, as provided for in the Paris Convention, of one or more earlier national, regional or international applications filed by the applicant in or for a Member State of the Paris Union or the World Trade Organisation.²⁹ The period for claiming priority is twelve months from the date of filing of the first application.³⁰

The Registrar is empowered to request the applicant to furnish a copy of the earlier national, regional or international application certified as correct by the Office with which it was filed.³¹ According to Rule 48 of the Patent Regulations, a Convention priority **“may be claimed either at the time of filing the application or at some later time before the grant of the patent, but not thereafter”**. Where the earlier application is not in English, the Registrar may also require the applicant to submit a verified English translation of the earlier application to BELIPO.³² Failure by the applicant to comply with these requirements shall lead to the Convention priority declaration being regarded as having not been made.³³

Examination, Refusal or Grant of Patent

The Registrar shall examine the application in order to determine whether it complies with the Patents Act and Regulations, and whether the information concerning corresponding foreign applications has been provided.³⁴ If the requirements of the Patents Act and the Regulations have not been complied with, the Registrar shall refuse the application and shall send a written notice of refusal to the applicant, stating the reasons for the refusal.³⁵

If the Registrar is satisfied that the application complies with the Patents Act and Regulations, the Registrar shall grant the applicant a patent.³⁶ After granting the patent, the Registrar shall publish a notice of the grant of the patent in the Intellectual Property Journal.³⁷ The Registrar shall then issue a certificate of the grant of the patent to the applicant, and record the patent in the Patents Register.³⁸

The owner of the patent may request the Registrar to amend the text or drawings of the patent in order to limit the extent of the protection conferred by the patent.³⁹ However, such amendment shall not result in the disclosure contained in

the patent going beyond the disclosure contained in the initial application on the basis of which the patent was granted.⁴⁰

Duration and Maintenance of Patent

The duration of the protection of a patent is 20 years after the filing date of the application.⁴¹ This term of protection is derived from Article 33 of the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS).⁴² A patent or patent application is maintained by the payment of an annual fee, each year starting one year after the international filing date of the application.⁴³ The annual fees are stipulated in Schedule I to the Patents Regulations.⁴⁴ If the period for payment of the annual fee expires without the payment of the fee, the Registrar shall give the owner of the patent or the applicant, as the case may be, a six months period of grace, within which the annual fee must be paid.⁴⁵ Payment of the annual fee after the expiry of the prescribed period shall be accompanied by the payment of a surcharge of BZ\$100 (US\$50) for the late payment.⁴⁶ This surcharge is not levied for the period before entry into the national phase.

Section 28 (5) of the Patents Act states that “a patent shall lapse or a patent application shall be deemed to have been withdrawn if the annual fee is not paid in accordance with the provisions of this section”. The Registrar is required to enter the lapse in the Register and to publish it in the Intellectual Property Journal.⁴⁷

CONCLUSION

Professor W.R. Cornish has described the PCT as a “one-stop” procedures that enables patent applicants to “initiate international patent applications in a number of countries throughout the world”.⁴⁸ This “one-stop” procedures is a testament to the globalization of the patent application process. This globalization has produced a cost-effective and efficient PCT regime. One can only conclude by observing that Belize has now become a well-regulated outlet of this one-stop global patent shop.

¹ Patents FAQs, (www.belipo.bz (E-Library link)), 4.

² Section 2 of Patents Act (www.belipo.bz (E-Library link)).

³ Coenraad Visser and Tana Pistorius, Essential Patent Law, University of South Africa/WIPO Worldwide Academy, 1.3.2./1.3.3.

⁴ Patents FAQs, op cit note 1 at 4.

⁵ Coenraad Visser and Tana Pistorius, op cit note 3 at 1.3.3.

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- ⁶ Article 9 of the PCT, 1970, (as modified).
- ⁷ Patents FAQs, op cit note 1 at 4.
- ⁸ The PCT System for Worldwide Filing of Patent Applications, Document prepared by the International Bureau of WIPO, 80.
- ⁹ W.R. Cornish, Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights, Fifth Edition, Sweet and Maxwell, 120.
- ¹⁰ Ibid, 121.
- ¹¹ Sections 55 (8) and (9) of the Patents Act.
- ¹² Section 55(3), *ibid*.
- ¹³ Section 55 (5), *ibid*. According to Article 11 (1) of the PCT – “The Receiving Office shall accord as the international filing date the date of receipt of the international application.....”.
- ¹⁴ Form No. 2B of Schedule II to the Patents (General Procedures) Administrative Instructions, 2005, (www.belipo.bz (E-Library link)).
- ¹⁵ Section 55 (11) of the Patents Act, read with Schedule I to the Patents Regulations (www.belipo.bz (E-Library link)).
- ¹⁶ Section 55 (12), *ibid*.
- ¹⁷ A.I. No. 2 of 2004, Articles 20, 36 and Rule 47 of the PCT, 1970 (as modified).
- ¹⁸ *Ibid*.
- ¹⁹ Form No. 1 of Schedule II to the Patents Regulations.
- ²⁰ Forms No. 2A and No. 2B of Schedule II to the Patents (General Procedures) Administrative Instructions, 2005.
- ²¹ Section 9 of the Electronic Transactions Act (CAP. 290:01) read with Paragraph 3 of A.I. No. 4 of 2005.
- ²² Paragraph 3 (3) of A.I. No. 4 of 2005.
- ²³ Form No. 25 of the Schedule to the Trade Marks (Electronic Filing) Administrative Instructions, 2006, available at www.belipo.bz/e_library.html.
- ²⁴ Paragraph 3 (4), *ibid*.
- ²⁵ See A.I. No. 2 of 2004, and Articles 20, 36 and Rule 47 of the PCT.
- ²⁶ Section 19 of the Patents Act.
- ²⁷ Articles 28 (1) and 41 (1) of the PCT.
- ²⁸ Section 19 of the Patents Act.
- ²⁹ Section 21 (1), *ibid*.
- ³⁰ Article 4C (1) of the Paris Convention, 1967.
- ³¹ Section 21 (2) of the Patents Act.
- ³² Section 21 (3), *ibid*.
- ³³ Section 21 (5), *ibid*.
- ³⁴ Section 26, *ibid*.
- ³⁵ Section 27 (1), *ibid*.
- ³⁶ Section 27 (4), *ibid*.
- ³⁷ Section 27 (5) (a), *ibid*.
- ³⁸ Section 27 (5) (b) and (c), *ibid*.
- ³⁹ Section 27 (7), *ibid*.
- ⁴⁰ *Ibid*.
- ⁴¹ Section 28 (1), *ibid*.
- ⁴² According to Article 33 of the TRIPS Agreement – “The term of protection available shall not end before the expiration of a period of twenty years counted from the filing date.”.
- ⁴³ Section 28 (2) of the Patents Act.
- ⁴⁴ See Patents Regulations.
- ⁴⁵ Section 28 (3) of the Patents Act.
- ⁴⁶ Section 28 (4) of the Patents Act read with Schedule I to the Patents Regulations.
- ⁴⁷ Section 28 (6) of the Patents Act.
- ⁴⁸ W.R. Cornish, op cit note 9 at 109.