

THE PCT E-PATENT: VIRTUAL DESTINATION BELIZE

By: Alhaji Tejan-Cole, Deputy Registrar, BELIPO (www.belipo.bz)

INTRODUCTION

This article examines the electronic filing of Patent Cooperation Treaty (PCT) applications designating Belize. This examination is done against the backdrop of an overview of the PCT System, and the procedures involved in the international and national phases of the PCT.

THE PCT SYSTEM

The PCT is a World Intellectual Property Organization (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 INTERNATIONAL PHASE

The first stage is the general stage known as the international phase. The first step in the international phase is 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 (Designated Offices).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 international application includes the request,⁷ the description, one or more claims, the abstract and the drawings (where applicable). A Belizean national or resident is required to pay the transmittal fee (BZ\$220) and the international filing fee (US\$1,134). There is also a 12 Swiss francs fee per sheet over 30. The full lists of PCT forms and fees can be found on www.wipo.int/pct/en/access/filing.htm.

An applicant can file an international application using WIPO's electronic filing software PCT-SAFE (Secure Applications Filed Electronically). This electronic filing can be done either through a secure on-line transmission or through physical media such as CD-R or diskette. The PCT-SAFE Client software validates the electronic data entered by the applicant through a 'traffic light' system that notifies the applicant of incorrectly or inconsistently completed parts. The applicant can use the PCT-SAFE Editor to prepare the description, claims, abstract, and drawings in XML (extensible markup language) format. Depending on the requirements of the selected Receiving Office, the application text and drawings can also be attached in PDF or TIFF format.⁸

The applicant can sign the electronic application by using a digital certificate that can be obtained free-of-charge from <http://www.wipo.int/pct-safe/en/certificates.htm>.⁹ A number of basic and enhanced electronic signature types are allowed for international application document exchange. Examples of basic electronic signatures include facsimile signature, text string signature and click wrap signature.¹⁰

The PCT-SAFE Client and PCT-SAFE Editor software are free and the software may be downloaded from <http://www.wipo.int/pct-safe/en/support/index.htm>. Also, a free-of-charge CD installation may be ordered through www.wipo.int or from the Help Desk at pctsafe.help@wipo.int. The software can be directly installed as a stand-alone application onto the hard drive of a PC with MS Windows NT, 2000 or XP. WIPO will be releasing an enterprise version of the software for use in a multi-user environment in 2005.¹¹

The use of the PCT-SAFE system entitles the applicant to several benefits. First, the PCT-SAFE Client software helps to create documents that conform to the requirements of the PCT. Second, the applicant is entitled to a 300 Swiss francs (or equivalent) fee reduction. Third, the use of the XML format enables the documents to be fully searchable. Fourth, electronic filing results in savings related to printing, copying and mailing. Fifth, electronic filing expedites the patent filing process and also results in the immediate confirmation of the receipt of the application.¹²

After filing the international application, the applicant has to go through three other steps in the international phase. The second step is the international search; the third step is the international publication; and the fourth step is the international preliminary examination.¹³ The competent International Searching Authority for Belize is the European Patent Office (EPO). The search fee charged by the EPO is 1615 Euros. The EPO is also the competent International

Preliminary Examining Authority for Belize, and it charges a preliminary examination fee of 1530 Euros and a handling fee of 129 Euros. The applicant also has to file a demand for international preliminary examination.¹⁴ The full lists of PCT forms and fees can be found on www.wipo.int/pct/en/access/filing.htm.

THE NATIONAL PHASE

Upon completing the international phase, the applicant then enters the national phase. The Belize Intellectual Property Office (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.¹⁵

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.¹⁶ 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.¹⁷ The application can be filed through any patent attorney or patent agent. The appointment of an agent shall be formalized by the filing of a Power of Attorney with BELIPO.¹⁸

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).¹⁹ 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.²⁰

It is worth noting that the International Bureau of WIPO usually submits, to BELIPO, the description, the claims, the drawings (if necessary), and the abstract of an international application designating Belize.²¹ **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.**²² These documents 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),²³ application for an address for service and power of attorney.²⁴ The electronic forms may be signed by using any combination of letters, numbers, spaces or punctuation marks placed between two forward slash (‘/’) symbols (text string signature).²⁵ Examples of acceptable text string signatures for electronic application forms include */ramses/*, */drl/*, and */577-34567/*.²⁶ The electronic forms may also be signed by printing, completing and faxing or emailing the Facsimile Signature Form.²⁷ An applicant must notify the Office of his particular method of electronic signature.²⁸

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.²⁹ The use of the QUICKPAT System entitles the applicant to several benefits. First, the applicant can file his or her application within the priority and entry into national phase time limits.³⁰ Second, the applicant receives an electronic acknowledgement of receipt of his or her application. Third, the applicant can make savings relating to courier postage costs.

An applicant can pay the patent application fees by filing the statement of applicant (fee for application) form and by posting a cheque to BELIPO endorsed in the name of the Government of Belize.

The duration of the protection of a patent is 20 years after the filing date of the application.³¹ This term of protection is derived from Article 33 of the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS).³² 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.³³ The annual fees are listed in Schedule I to the Patents Regulations.³⁴

CONCLUSION

Professor W.R. Cornish has described the PCT as a “one-stop” procedure that enables patent applicants to ‘initiate international patent applications in a

number of countries throughout the world’.³⁵ The emergence of patent e-filing systems such as PCT-SAFE and QUICKPAT demonstrate that this ‘one-stop’ procedure has now become an important bus stop on the global information superhighway.

¹ Patents FAQs, available at www.belipo.bz/e_library.html, 4.

² Section 2 of Patents Act, available at www.belipo.bz/e_library.html.

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.

⁶ Article 9 of the PCT, 1970, (as modified), available at www.belipo.bz/e_library.html.

⁷ PCT/RO/101.

⁸ World Intellectual Property Organization, *What is PCT-SAFE*, 1.

⁹ *Ibid*, 2.

¹⁰ World Intellectual Property Organization, *PCT/AI/ANF/I*, available at www.wipo.int, 18 and 19.

¹¹ World Intellectual Property Organization, op cit note 8 at 3.

¹² *Ibid*, 2.

¹³ Patents FAQs, op cit note 1 at 4.

¹⁴ PCT/IPEA/401.

¹⁵ Sections 55 (8) and (9) of the Patents Act.

¹⁶ Section 55(3), *ibid*.

¹⁷ 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.....’.

¹⁸ Form No. 2B of Schedule II to the Patents (General Procedures) Administrative Instructions, 2005, available at www.belipo.bz/e_library.html.

¹⁹ Section 55 (11) of the Patents Act, read with Schedule I to the Patents Regulations, available at www.belipo.bz/e_library.html.

²⁰ Section 55 (12), *ibid*.

²¹ A.I. No. 2 of 2004, Articles 20, 36 and Rule 47 of the PCT.

²² *Ibid*.

²³ Form No. 1 of Schedule II to the Patents Regulations.

²⁴ Forms No. 2A and No. 2B of Schedule II to the Patents (General Procedures) Administrative Instructions, 2005.

²⁵ Section 9 of the Electronic Transactions Act (CAP. 290:01) read with Paragraph 3 of A.I. No. 4 of 2005.

²⁶ Paragraph 3 (3) of A.I. No. 4 of 2005.

²⁷ Form No. 15 of the Schedule to the Patents (Electronic Filing) Administrative Instructions, 2006, available at www.belipo.bz/e_library.html.

²⁸ Paragraph 3 (4), *ibid*.

²⁹ See A.I. No. 2 of 2004, and Articles 20, 36 and Rule 47 of the PCT.

³⁰ Article 4C(1) of the Paris Convention states that the priority claim must be made within 12 months of the filing date of the earlier application (priority date). Articles 22 and 39 of the PCT state that the time limit for entry into national phase is 30 months from the priority date.

³¹ Section 28 (1) of the Patents Act.

³² 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.’.

³³ Section 28 (2) of the Patents Act.

³⁴ See Patents Regulations.

³⁵ W.R. Cornish, op cit note 9 at 109.