

INTERNATIONAL PATENT PROTECTION: AN OVERVIEW FOR THE UNITED STATES APPLICANT

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Introduction

The owner of a patented invention wants to achieve optimum protection in all relevant countries at minimum cost. Because of the complexities of international protection and patent procedures, a comprehensive strategy is necessary to exploit the potential of a patent and to meet the goals of its owner or licensor. Such strategy is influenced by the marketability of the invention, licensing possibilities, export of the products of the invention, time periods of protection and registration, and financial limitations. One fundamental element of a strategy should be the method the applicant adopts for obtaining foreign protection.

The Nature of a Patent

A United States patent provides its owner with exclusionary rights for the exploitation of the patent for its term. Thus, a United States patent owner can preclude others from making using or selling the claimed invention in the United States and its territories. But the United States patent does not grant rights outside the United States, nor does it curtail “infringing” activity abroad.

The Uruguay Round of the General Agreement on Tariffs and Trade (GATT) produced a comprehensive international treaty entered by the United States and GATT member signatories which expands patent protection in scope and time by expanding the definition of infringement to include the offering of the patented invention for sale and the importation of a product made by a patented process.

Protection of the invention outside the United States requires the applicant to file a written description of the invention, relevant drawings, support documents, and required fees with the patent office in the foreign jurisdiction where protection is sought. Filing can be done directly with a national patent office or under the Patent Cooperation Treaty (PCT). If protection is sought only in Europe, one application can be filed before the European Patent Office (EPO).

In order to safeguard potential international patent rights, care must be taken at an early stage to insure that the foreign filing deadline is met and to establish an effective filing date prior to disclosing the invention. An attorney qualified to practice before each respective national patent office must be engaged to represent the United States applicant during the foreign prosecution period and all formal filing requirements must be timely met.

Foreign Filing Convention Deadline and Claim to Priority

Whether the foreign application is filed directly with a national patent office or under the PCT, it is imperative to have the foreign counterpart application on file within 12 months of the United States filing date. By making a timely filing and claiming priority to the earlier application date, the filing date of the parent application becomes the effective filing date of the subsequent foreign application. This filing is critically important in countries where the “first-to-file” rule is the basis for patent entitlement. Most notably, the “first-to-file” rule is followed in all major industrialized nations except the United States where the patent system operates on a “first-to-invent” rule.

Even if the filing deadline is missed, it is still possible to file an application in most foreign countries for an invention that has not yet been publicly disclosed through printed publication, sale, or use. However, missing such deadline precludes claiming a date priority originating from the parent application.

Establishing an Effective Filing Date Before Public Disclosure

An effective filing date must be established prior to public disclosure of the claimed invention if the applicant is interested in foreign patent protection. Unlike the United States, which allows one year after public disclosure in which to file an application, most industrialized foreign countries require “absolute novelty” of the invention at the time of filing. Thus, it is critical that any public disclosure take place only after the first application has been filed.

For example, if prior to getting an application on file with the United States Patent and Trade Office (USPTO), a paper disclosing the invention were presented at an academic convention, the United States applicant generally has one year in which to file for protection in the United States, but has already forfeited any international rights that may have been afforded through international filings. Alternatively, if a United States application were filed January, 1999, and a paper disclosing the invention were presented January 10 or later, the United States applicant has until January 9, 2000, to file international applications and claim priority to the parent application thus receiving benefit of the earlier United States filing date for the foreign file application.

Where to File

The globalization of markets and trade creates a need to file for protection in an increasing number of countries. The cost of such applications continues to grow.

The majority of United States applicants seeking patent protection abroad have already filed in the United States. In determining countries for additional filings, considerations include the nature of the technology of the invention, countries in which the product can be manufactured and marketed, the political climate of countries of consumption, the locations of the competitors and the financial resources of the applicant.

The Filing Route

If filing applications is appropriate in three or less foreign countries, it is generally advantageous to file an application directly with each national patent office. However, this route requires meeting national requirements in each country as well as the deadline for PCT registration in signatory countries. The foreign attorney in each country can arrange for required translations but the expense of official fees, service fees and translations is incurred at the time of filing.

When filings are to be made in four or more foreign countries, it is usually cost-effective to file the application under the PCT or directly with the EPO if the applicant seeks protection only in Europe.

Combinations of these options are also possible allowing a variety of alternatives in meeting specific filing objectives.

The Patent Cooperation Treaty (PCT)

The PCT is a multilateral treaty administered by the International Bureau of the World Intellectual Property Organization (WIPO), an agency of the United Nations located in Geneva. The treaty exists to facilitate the patent procurement process by providing a uniform system of regulations to which all member states adhere. (As of February, 2000, there are 106 member states.) The PCT does not grant patents but serves as a vehicle to standardize international requirements in order to facilitate prosecution before the national patent offices of member countries.

Patent applications filed with the PCT undergo a formalities review, an international search, and an optional international preliminary examination during the “international phase” of prosecution. These procedures postpone the “national phase” of prosecution before the countries designated at the time of filing, thereby offering a particular advantage to technologies that do not have a short life cycle. Filing with the PCT enables the applicant to maintain an established filing date while postponing significant expense and allowing time to refine the invention and evaluate the foreign market.

If the optional preliminary examination is not requested, national processing is deferred by eight months over the direct route. However, if preliminary examination is requested, national entry is deferred another ten months, for a total of 18 months. Both choices postpone payment of the official national entry fees, foreign associate fees, and translation costs in the designated countries. The extended time allowed by the PCT procedures, together with the Search Report and Examination Report (although non-binding in the national phase), provide a sound basis for deciding in which countries to pursue patent protection.

Under the PCT, the United States applicant files only one application, in one language and pays one initial set of fees. This is especially beneficial for the United States applicant with limited time in which to file prior to the end of the “convention year” which is deemed to be 12 months from the priority date. Filing near the end of the convention year also allows a United States applicant time for having filed additional applications to expand and improve the underlying application. All revisions and improvements can be included in the international application by claim to priority to the earlier filing date. It should be noted that the PCT application can also be the first filed application in which the United States is a designated country.

The international filing has the effect of a national filing in each designated country with the international filing date becoming the effective filing date of the national applications. The patent term of 20 years is measured from the PCT filing date.

Attention to the goals of the United States inventor, marketing and licensing considerations, production possibilities and available financial resources, and a sound strategy for seeking international patent protection should be devised and implemented to gain maximum financial benefit for the United States inventor. Such activities require consultation with duly licensed and qualified intellectual property and patent attorneys.