

Foreign Patent Filing and PCT Applications

I. Why to Foreign File?

Many people think that there is an all encompassing international patent; unfortunately, there really is not. Your U.S. filed patent application is only good in the United States. Thus, in order to obtain foreign patent rights, you must file separately in each foreign country because the patent laws of each country are different. With that understood, Patent Cooperation Treaty applications (PCT) can be filed designating multiple foreign countries. This is discussed in further detail in section II below.

So why even file a foreign patent application? Obviously, you will want protection in the foreign countries you do business in or plan to do business in. Foreign countries are very particular in regards to the timing of filing patents, so if you fail to file within the prescribed times in foreign countries, you may lose all rights in the foreign country you wish to seek coverage.

From a strategic standpoint, foreign patents are extremely important, particularly for defensive reasons in the countries you do business in. However, foreign patents can also bestow political significance, especially if you are dealing with governments. Also, you may want to file patents offensively in your competitor's countries to prevent him from encroaching on your product.

II. How to Foreign File?

A. Direct National Filing in the Foreign Country

If you only want to file in one or two foreign countries, and you know which ones they are, then filing directly in those foreign countries makes sense. However, if you are filing in multiple countries, and are not sure which countries you want to commit to yet, direct filing will be very expensive and time consuming. The costs for foreign patents are extremely high due to the official fees, translation costs, fees for local agents or patent attorneys.

B. P.C.T. (Patent Cooperation Treaty)

Instead of filing separately in each individual country, the PCT was developed to streamline the foreign filing process. Filing a single PCT application within one year of the U.S. application will give you the earlier priority date of the U.S. application for every PCT member country you designate. For example, if you want patent protection in 6 European countries, you can file a single PCT application designating each country rather than filing individually in each country. The effect will be that each country will gain priority of the earlier filed U.S. patent application date. You then have a total of 30 months from the U.S. filing date to file a National Stage application in each country individually. The main benefit here is that you are able to defer time, while you decide

which countries you wish to pursue patent protection in. This is a huge benefit, because if you do not currently have the budget to file in multiple foreign countries, one PCT application can secure your right for 30 months while you decide what countries are actually worth pursuing.

III. When to Foreign File?

This is probably the most important issue. Generally, you should foreign file (or PCT application) **within one year** from the date of the original U.S. filing date. If you do so, under the Paris Convention, your foreign application or PCT application will gain benefit of the earlier U.S. filing date, i.e., your foreign application will have the same filing date as the U.S. filing date. So what effect does this have on U.S. provisional applications? The foreign application must be filed within one year of the provisional application, if a provisional application was first filed.

If you have filed the PCT application just prior to the one year anniversary of your utility application (or provisional patent application) filing date, you then have an additional **18 months** to file a National Stage application in each particular country you designated in the PCT application.

Although there is more than one way to foreign file, the classical method is as follows:

- 1) File US utility patent application (nonprovisional);
- 2) File PCT within one year; then
- 3) Follow up the National Stage filings prior to 30 months from the first US utility filing date.

The most important thing to remember from this article is that you must file the PCT application no later than one year from the original US filing date.

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