

## Section 3

### “How It Works: Rights and Infringement”

#### Chapter 17

#### Foreign Patent Rights

Any initial foreign filing **MUST** be completed within twelve months of any prior U.S patent application from which the claimant would like the benefit of the same filing date.

More simply put, the twelve months starts from the U.S. application date. Now, this does not just reach back to the non-provisional date, this reaches back to the provisional date. If a provisional was filed, let's say in March 2016, which means that by March 2017 the inventor must file an international patent application to claim the benefits of the provisional that was filed back in March 2016.

This works the same way with a non-provisional. If a non-provisional application was filed in March 2016, by March 2017, within twelve months, is the longest time period possible to make reference back to that earlier March 2016 date. Still, if this same application was filed as a provisional before being filed as a non-provisional that international application could not make the claim of benefit to anything earlier than March 2016. In most countries,

the initial filing is accomplished with a single international application, called patent cooperation treaty (or PCT) application.

International protection from the PCT serves primarily to preserve an inventor's filing right in countries that have signed this cooperation treaty, but also provides a preliminary examination that can be used to address any issues that relate to patentability prior to filing in any of the individual countries.

This means that if, sticking with the above application example, a PCT application is filed BEFORE March 2017 that makes reference to that March 2016 original filing date. Filing by March 2017 allows the inventor to (with PCT countries) claim priority internationally all the way back to a U.S filing in March 2016.

The PCT application preserves the right to enter into the marketplaces of commercially viable international countries such as Germany, France, Korea and Japan, to name a few. Many different countries require that inventors file within a twelve month deadline in the same sense that the United States requires for a non-provisional from a provisional.

In effect, the PCT gives the inventor more time to think about which individual countries they'd like to file in. If he or she wishes to obtain patent protection in countries that have not signed the

PCT, such as Taiwan, they must file applications directly with the patent officers of those countries, usually within twelve months from their U.S filing date.

Then, patent-seekers must file national applications in their chosen countries **30 months** after the original U.S filing date. That gives the applicant another 18 months after filing with the PCT to submit an application in the foreign country of their choosing.<sup>14</sup>

In addition to the expense of submitting an application in the U.S., filing for foreign patent protection is relatively quite expensive. That said, one should hardly base their decision to file or not on anything related to international eligibility.

In my experience, most individuals or entities with limited resources are probably better off spending funds and work hours on marketing, sales, and commercializing the invention than on international patent rights. For the most part, filers choose to extend their rights beyond the American market to a specific country for a specific reason. One easy way to explain this is that many countries are home to different cultures, of course, which means different marketplaces with different demands for certain products.

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<sup>14</sup> Applications in the European patent office can be filed 31 months after your original U.S filing date, so they allow one more extra month.

Therefore, some patents have more immediate usefulness in a particular geographic location and lend themselves to qualifying specifically for patent rights in countries outside the U.S.