JOHNSON LEGAL PLLC

FAQ FOR FOREIGN PATENT APPLICATIONS

Q. **What is the Patent Cooperation Treaty and how does it work?**

A. The Patent Cooperation Treaty allows a patent applicant in any signatory country (such as the United States) to reserve its patent rights in the other 151 signatory countries by filing a single "international patent application." Prior to the PCT, a U.S. inventor wishing to preserve patent rights in foreign countries was required to file a patent application in each foreign country within 12 months of filing a U.S. patent application. Under the PCT, once a single international application has been filed within 12 months, patent rights are preserved in all of the signatory countries for up to 30 months from the priority date. To pursue patent protection in individual national jurisdictions, the applicant must file local "national stage" applications in each country within the 30-month period. The PCT allows patent applicants to delay the significant expense of filing and prosecuting patent applications in national patent offices for an additional 18 months. This gives the applicant time to analyze the value of the invention to weigh the costs and benefits of filing patent applications.

Q. ***I have filed a regular US Patent Application and want to get patents in other countries. What's my deadline?***

A. Most foreign countries are members of an international treaty called the Patent Cooperation Treaty (PCT) that gives applicants the legal benefits of an earlier filing date IF the foreign application is filed within one year from the date of the earliest filing date for an application covering the invention. That said, you have three options for filing foreign applications.

The first is a foreign application within one year filed in the country of interest. The second is an international application filed within the one year anniversary that "designates" the country or countries of interest. Either application will allow you to claim the legal benefits of the earlier filing date which may be needed to establish a filing date before a public disclosure or sale in those countries that do not allow a grace period between disclosure and filing but, instead, require absolute novelty for any patentable invention. The third is for either outside the one year period or in a country that has not signed the PCT. The benefits of an earlier filing date are not available so special inquiries may be needed into public disclosures or sales before the filing date for these applications.

Q. ***How much do foreign applications cost?***

A. The actual cost will vary depending on the country, length of the application, number of claims, the need for a translation, possible opposition from competitors, and changes in annuity fees. A reasonable estimate is $5000 per country to get the application on file and a total of $15,000 per country to prosecute the application to grant. Oppositions can be like a trial on validity and increase the costs substantially, i.e., $200,000 and up.

Q. ***How long does it take to get a foreign application?***

A. On average without opposition or significant prior art impediment, many foreign application will issue in 7-10 years after the US filing date. Applications in the US generally take 3-5 years to issue, on average.

Q. ***When is the latest that I can give you my decision about foreign filing?***

A. We need one month to be able to guarantee that your application will be received and properly filed by our network of associates. We cannot guarantee a filing date if we receive your instructions any later than that although we will make every reasonable effort to assure that the application is filed.

Q. ***Can I pick which law firm or lawyer you use for my foreign application?***

A. Of course. We have a network of lawyers and law firms throughout the world. We can readily accommodate your preferences.

Q. ***How do I figure out where I should file my application?***

A. The decision of where to receive a patent grant should be a business-generated decision, but the specific decision in a specific case is too dependent on the facts to be able to make a universally suitable recommendation. We generally recommend that patent protection should be considered where (a) your company does business, (b) imminently plans to do business, or (c) has a licensee or opportunity in place to commercialize the invention and where sales are likely to be enough to justify the $2.5-4.5 million for the costs of bringing a lawsuit to stop infringement. For some companies, we recommend that they seek patents on all inventions. For others, patents may not be a suitable form of protection.