

# Make protecting your inventions globally a priority

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You've just had a meeting with your R&D team and, although your latest product design is not quite ready for production, there is some excitement surrounding this new invention. It is likely to be profitable in the United States and may also create opportunities for you to expand your company's sales into international markets.

While you are familiar with protecting your patent rights in this country, you don't have any experience in protecting your invention in international markets.

Here's where to begin.

U.S. patents protect any new process, machine, manufacture, composition of matter or any new improvement thereof. Patent holders may prevent others from making, using, selling or importing into the United States products covered by the patent. However, U.S. patents have no extraterritorial effect. If protection in other countries is desired, such as those in which you or your competitors might manufacture or sell the invention, patent applications must be filed in each country of interest.

In the U.S., an applicant is prohibited from obtaining a patent on an invention that has been publicly disclosed, sold or offered for sale more than one year before the patent application's filing date. In effect, the U.S. patent laws provide a one-year grace period for applicants to evaluate market interest prior to committing resources to pursue U.S. patent protection.

Unfortunately, most other countries do not afford such an opportunity. In fact, when considering foreign patent protection, one of the most important things to keep in mind is that most foreign countries do not allow for any public disclosure of an invention before the filing of a patent application. What constitutes public disclosure varies, so the best strategy is to file patent applications early, before any public disclosure of the invention.

Filing patent applications in several countries, however, can be expensive. But many countries in which you will be interested in protecting your invention are parties to international treaties that enable an applicant to secure a filing date by filing a patent application (the "priority application") in another country. Related patent applications filed in other countries receive an effective filing date identical to the priority application's filing date, so long as the related applications are filed within one year of the priority application.

For those interested in filing in a few different countries, for example, the United States, Canada and Mexico, the best strategy may be to file a U.S. patent application as a priority application prior to any public disclosure of the invention.

Applications in Canada and Mexico can then be filed within a year, claiming the benefit of the priority application's filing date. As a result, any public disclosure of the invention made after the filing of the U.S. application will not defeat the patentability of the invention in Canada or Mexico.

This strategy also allows the costs associated with filing in Canada and Mexico to be delayed up to 12 months from the U.S. filing date.

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For those interested in filing in a larger number of countries, there is better news. Most industrial countries are members of the Patent Cooperation Treaty (PCT). This enables an applicant to file a single PCT patent application to secure a filing date in each of the PCT countries. Under the treaty, an applicant may postpone the costs of filing numerous individual foreign applications for as long as 31 months from the priority application's filing date. Ideally, this delay enables the applicant to determine the marketability of the invention in each of the PCT countries.

Because the priority application usually has undergone at least some examination within that time, an applicant is also in a better position to assess the strength of patent protection likely to be obtained.

Where do you begin when pursuing international patent protection? By filing a priority application before making any public disclosure of the invention. The priority application may then be followed by filing any number of related applications in selected countries, or by filing a PCT application, within one year of the priority application's filing date.

Following this plan allows you to avoid the perils of negating available patent protection by prematurely disclosing your invention and at the same time allows you to postpone the costs of filing internationally and gives you time to make better informed business decisions regarding protecting your intellectual property.

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