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Patents, Trademarks, Copyrights.

## **INTERNATIONAL PATENT STRATEGIES**

As a patent attorney, many people often ask me, “Should I seek international patent protection?” The short answer is that it depends on a business’s goals, overall business strategy and budget. This article will answer some of the questions frequently raised when deciding on whether to file for foreign patent protection.

### **What Does A U.S. Patent Protect?**

A U.S. patent is a legal document that provides a monopoly and allows the patent owner to exclude others from making, using or selling an invention in the United States. A United States patent will not protect an invention outside of the United States. If a patent owner intends to protect an invention outside of the United States, then the patent owner will have to acquire patent rights for the invention in each country in which the patent owner wants the invention protected.

### **In Which Countries Should I Seek Patent Protection?**

To answer this question, you should consider in which countries you: (1) intend to sell your invention; or, (2) are willing to enforce your patent rights. Many large businesses, for example pharmaceutical companies, will seek patent protection in almost every country in the world because those businesses have the resources to sell their products and enforce their patent rights worldwide. On the other hand, smaller businesses may only seek international patent protection in one or two countries because those businesses have less resources. In many cases, the decision of determining in which countries to seek patent protection can only be made after a product has been market validated and a business

understands the potential for sales in certain countries. Typically, a business will need time to properly validate and market test a product.

### **What is A PCT Patent Application?**

One strategy for delaying the decision of determining in which countries to seek patent protection is to file a PCT patent application. A PCT patent application is a patent application filed under the Patent Cooperation Treaty. The Patent Cooperation Treaty is an international law treaty that provides a procedure for filing patent applications in multiple countries. The PCT patent application allows an applicant to simultaneously seek patent protection for an invention in over 140 countries throughout the world.

After filing a PCT patent application, an applicant will eventually have to choose the countries in which the applicant desires to seek patent protection. This next step of the PCT patent application process is known as the “National Phase”. An applicant must enter into the National Phase within 30 - 31 months after the earliest priority date of a PCT patent application. This means that by initially filing a PCT patent application an applicant could essentially provide a business with up to 30 – 31 months of time in order to investigate which countries the applicant should sell its product.

### **When should I NOT file a PCT application?**

Many times the answer to this question will depend on how certain you are as to the amount of foreign countries in which you intend to seek international patent protection. In the National Phase of a PCT application, an applicant is required to pay additional fees for every country that an applicant has chosen to seek patent protection. If an applicant is very certain that he or she will only choose to seek patent protection in one or two foreign countries, then it is more economical not to file a PCT application. In such a case, a business should probably file in each foreign country directly. This strategy will reduce the overall patent filing costs for an applicant.

Additionally, a PCT application should NOT be filed if a public disclosure or attempted sale of an invention is made before the first filing of a patent application. Public disclosure of information about an invention for up to a year prior to filing a U.S. patent application is permitted in the United States. However, disclosures can invalidate an applicant’s right to patent protection in many foreign jurisdictions. Given that filing a PCT patent application can be an expensive process, I recommend seeking advice from a patent attorney familiar with foreign patent filings before deciding on whether to file a PCT patent application.

The PCT patent attorneys at The Plus IP Firm help businesses and inventors protect their ideas, concepts and creations with patents, trademarks and copyrights. The patent attorneys at The Plus IP Firm have helped numerous businesses file patents and trademarks in numerous foreign countries. To discuss your options, click [here](#) to schedule a free

telephone conference with one of our experienced patent attorneys. To learn more information about patents, click [here](#).

*"Derek and his firm have been amazing. They are very proactive, and our company feels very secure with our numerous trademarks in Derek and his company's hands. Thanks for your excellent work!"* - Sumair Mitroo, satisfied CEO of Larasan Pharmaceutical Corporation



*"Derek has been a great asset to us while navigating the trademark process. He's responsive and takes the time necessary to explain every step along the way. Our experience has been great."* - Nikki Blews, satisfied business partner at Scuttlebutt Social Marketing, LLC

Derek Fahey is a registered patent attorney. The Plus IP Firm, PLLC, is an intellectual property law firm dedicated to serving the South Florida area. We help companies and individuals protect their ideas and creations using patents, trademarks and copyrights.