

Filing Foreign Patent Applications Under the Patent Cooperation Treaty

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With the globalization of commerce, U.S. companies, now more than ever, are seeking international patent protection for their proprietary technologies. Obtaining foreign patent rights, however, can be a lengthy and expensive endeavor. An applicant may spend \$30,000 or more in each desired country with no guarantee that a patent will ever be granted. But, with careful strategic planning, foreign patent protection can be obtained, enabling their holders to reap international rewards.

A common vehicle used to obtain international patent rights is the Patent Cooperation Treaty (PCT). The PCT is a worldwide international treaty that enables citizens of member countries to file one application, "an international PCT application," in their home patent offices and have the effective filing date of that application acknowledged as a filing date in as many member countries that the applicant designates. By allowing the applicant to file a single international application, the PCT allows the applicant to defer national filing costs for multiple foreign applications while obtaining an early filing date in multiple countries. Another benefit of filing a PCT application is the international patentability search that is conducted which allows the applicant to further assess the invention prior to filing multiple foreign applications. *can*

Since an "international patent" does not issue from a PCT application, a national application based on the PCT application must be filed with the patent office of each desired country within 20 months of the effective filing date of the PCT application, or 30 months, if an international preliminary examination is requested. After such national applications are filed, whether any national patent rights are ultimately granted will depend on the laws and procedures of each country.

The effective filing date of the PCT application is either the actual filing date of the application or the filing date of an earlier application for the same invention if a "right of foreign priority" is claimed. For example, a PCT application designating multiple foreign member countries will enjoy the benefit of the filing date of a prior-filed U.S. application for the same invention, if filed within 12 months of the U.S. filing date.

Obtaining an early filing date is extremely important and is often determinative of whether patent rights are ultimately granted. In many foreign countries, if the invention is commercialized or publicly disclosed, anywhere in the world, before an application for patent is filed, patent rights for that invention are forever precluded in those countries. In the United States, there is a one-year grace period beginning from either the date of first commercialization or public disclosure of an invention, whichever occurs first, during which time the applicant must file a patent application. Failure to meet these deadlines will result in a permanent bar to obtaining patent rights. Thus, it is often critical to obtain an early effective filing date to obtain either domestic or international patent protection and the right to foreign priority can often save the day. *Smooth out & shorten*

In summary, filing a PCT application provides many advantages: an early filing date in multiple countries without actually submitting formal documents in each national patent office; an international search to judge the level of the relevant prior art before having to expend resources in each desired country; a delay in the expenditure of fees; an optional preliminary examination report as to patentability; and additional time to raise funds and evaluate financial, commercial and other considerations.

About the author: Richard Kim is an associate in the San Diego office of Morrison & Foerster, specializing in patent and trademark prosecution, licensing and litigation. Mr. Kim has represented high-technology companies regarding their patent matters in the following fields: computers (hardware and software), telecommunications, and biotechnology. *sd-58913*

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