

# PATENT LAW

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CLASS 14

Part 1

**International Prosecution**

## International Prosecution

- How are patents obtained in other countries?
- What treaties enable foreign counterpart patent applications?
- What parts of US Patent Laws affect?
- What issues exist relative to priority?
- How do we use treaty procedures?



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## International Prosecution

### "Foreign Patents"

International Patent Procedures  
International Patent Treaties  
European Patent Procedures  
International Problems & Solutions  
Questions of Priority  
Comparisons with US Law



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## Why are foreign patents sought?

- US enterprises wish to sell or export or license in selected other countries or that do or wish to do business globally.
- Entities in foreign countries seek US patents for the same reasons.
- We are all increasingly part of global economy - and so we file "foreigns" to improve our position in global economy.



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## What is meant by filing "foreigns?"

- What is meant by filing "foreigns" is initiating (filing) analogous patent applications in countries or treaty region
- foreign to USA according to the patent laws and procedures in that country or countries or treaty region
- for purposes of obtaining patent protection there.



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## In what countries or treaty regions do we seek patents?

- In those countries where there are, might be, or will be prospects for commercial activities, such as distribution, sale or licensing by patent owner or licensee.
- Where it is practical and affordable to do so.
- Can afford costs: foreign atty. services & govt. fees for filing, prosecution, annuities, grant fees, & translations to/from other languages.



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## "Uncle Sam" may I?

- May you simply take your invention to a patent attorney in another country, and ask that a patent country be filed?
- Must not export w/o an export license. To do so, filing would run afoul of the export laws and export rules administered by US Commerce Department.



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### If patent application filed w/o permission?

- Violation of such laws is federal offense. So . . .
- Before sending a patent application to another country you will need an EXPORT LICENSE, which takes the form of a FOREIGN FILING LICENSE.
- How is it obtained?



### If no U.S. patent application is on file

- If no corresponding national or international patent application has been filed, must petition USPTO Trademark Office for a foreign filing license. Difficult?
- Not difficult. Requires that . . .



### If no U.S. patent application is on file

- Patent lawyer submits petition together with legible copy of material upon which a license is desired; then:
- When export license is granted (weeks or months), copy of material submitted represents scope of the information which can be the subject of a foreign patent application.



### But If U.S. patent application already is on file

- US patent application is used as a basis for filing for corresponding patent rights in a foreign country, because:
- US patent application is treated as a petition for the granting of a foreign filing license, which is usually granted. And...
- International treaty application filing in USRO of USPTO also possible.



### When U.S. patent application already is on file

US provisional or non-provisional (utility) patent application is used as a basis for filing for corresponding patent rights in a foreign country, priority can be obtained under the Paris Convention (dating from 1883) which accords to the US applicant priority of the US application for one year (6 mo. for design appls.)



### Modern treaties for international filing

In addition to The Paris Convention over last few decades, international treaties have streamlined and made more economical procedures for seeking protection in many parts of the world. USA has signed, acceded to, or ratified many treaties



## Some international treaties

- The Paris Convention
- Patent Cooperation Treaty (PCT)
- European Patent Convention (EPC)
- Others treaties for regional patent rights
- TRIPS Agreement on Trade-Related Aspects of Intellectual Property Rights patent term 20 yrs. from filing everywhere
- WIPO



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## Paris Convention

- Effect is one of giving priority.
- Allows applicant(s) to file in U.S. or other home country signatory to treaty.
- Provides a priority effect of 12 months (6 mo. for designs) in which to file corresponding application elsewhere equivalent to national filing.
- Based on whole content of application.



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## Paris Convention Article 4, Section A

1. Any person who has duly filed an application for a patent, or for the registration of a utility model, or of an industrial design, or of a trademark, in one of the countries of the Union, or his successor in title, shall enjoy, for the purpose of filing in the other countries, a right of priority during the periods hereinafter fixed.



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## Paris Convention Article 4, Section A

2. Any filing that is equivalent to a regular national filing under the domestic legislation of any country of the Union or under bilateral or multilateral treaties concluded between countries of the Union shall be recognized as giving rise to the right of priority.



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## Paris Convention Article 4, Section B

. . . [A]ny subsequent filing in any of the other countries of the Union before the expiration of the [above] periods shall not be invalidated by reason of any action accomplished in the interval, in particular, another filing, the publication or exploitation of the invention, the putting on sales of copies . . .



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## Paris Convention Article 4, Section C

- C.-
  - (1) The periods of priority referred to above shall be twelve months for patents and utility models, and six months for industrial designs and trademarks.
  - (2) . . . periods . . . start from the date of filing [the] first application; the day of filing [is] not included...



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## Paris Convention Article 4, Section C

### C.-

(3) If the last day of the period is an official holiday, or a day when the Office is not open for the filing of applications in the country where protection is claimed, the period shall be extended until the first following working day.



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## Paris Convention Article 4, Section C

### C.-

(4) A subsequent application concerning the same subject as a previous first application . . . filed in the same country of the Union shall be considered as the first application, of which the filing date shall be the starting point of the period of priority, . [cont'd]



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## Paris Convention Article 4, Section C

### C. (4)[cont'd]

**if**, at the time of filing the subsequent application, the said previous application has been withdrawn, abandoned, or refused, without having been laid open to public inspection and without leaving any rights outstanding, and if it has not yet served as a basis for claiming a right of priority. The previous application may not thereafter serve as a basis for claiming a right of priority.



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## Using the Paris Convention

- To illustrate practically how and to what extent patent application can have the priority of a foreign patent application consider
  - IN RE GOSTELI
- United States Court of Appeals, Federal Circuit, 1989. 872 F.2d 1008, 10 U.S.P.Q. 1914



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## Modern treaties

### Treaties signed by USA specifically related to patents:

- Patent Cooperation Treaty (PCT)
- European Patent Convention (EPC)
- Other treaties relating to regional rights
- TRIPS (WTO's Agreement on Trade-Related Aspects of Intellectual Property Rights)
- WIPO



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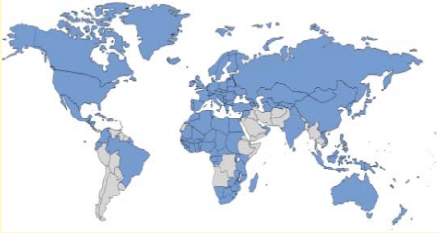
## Patent Cooperation Treaty

- Basics:
  - One application for 137 countries
  - Compliance with form in PCT is a valid filing in all 137 countries
  - Own language – delay translation fee
  - Optional Search Report – decide if and where to apply for patent



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## PCT Countries



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## PCT Countries

- AE United Arab Emirates
- AG Antigua and Barbuda
- AL Albania
- AM Armenia (EA)
- AT Austria (EP)
- AU Australia
- AZ Azerbaijan (EA)
- BA Bosnia and Herzegovina<sup>1</sup>
- BB Barbados
- BE Belgium (EP)
- BF Burkina Faso (OA)
- BG Bulgaria (EP)
- BH Bahrain
- BJ Benin (OA)
- BR Brazil
- BW Botswana (AP)
- BY Belarus (EA)
- BZ Belize
- CA Canada
- CF Central African Republic (OA)
- CG Congo (OA)
- CH Switzerland (EP)
- CI Cote d'Ivoire (OA)
- CN China
- CO Colombia
- CR Costa Rica
- CU Cuba
- CY Cyprus (EP)
- CZ Czech Republic (EP)
- DE Germany (EP)
- DK Denmark (EP)
- DM Dominica
- DZ Algeria
- EE Estonia (EP)
- EG Egypt
- FI Finland (EP)
- FR France (EP)
- GA Gabon (OA)
- GB United Kingdom (EP)
- GD Grenada
- GE Georgia
- GH Ghana (AP)
- GM Gambia (AP)
- GN Guinea (OA)
- GQ Equatorial Guinea (OA)
- GR Greece (EP)
- GT Guatemala
- GW Guinea-Bissau (OA)
- HN Honduras
- HR Croatia<sup>1</sup>
- HU Hungary (EP)
- ID Indonesia
- IL Israel (EP)
- IN India
- IS Iceland (EP)
- IT Italy (EP)
- JP Japan
- KE Kenya (AP)
- KG Kyrgyzstan (EA)
- KM Comoros
- KR South Korea and North Korea
- KP Democratic People's Republic of Korea
- KR Republic of Korea
- KZ Kazakhstan (EA)
- LA Lao People's Democratic Republic
- LC Saint Lucia
- LI Liechtenstein (EP)
- LK Sri Lanka
- LR Liberia
- LS Lesotho (AP)
- LT Lithuania (EP)
- LU Luxembourg (EP)
- LV Latvia (EP)
- LY Libyan Arab Jamahiriya
- MA Morocco
- MC Monaco (EP)
- MD Moldova (EA)
- ME Montenegro

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## PCT Countries

- MK The former Yugoslav Republic of Macedonia<sup>1</sup>
- ML Mali (OA)
- MN Mongolia
- MR Mauritania (OA)
- MT Malta (EP)
- MX Mexico
- MY Malaysia
- MZ Mozambique (AP)
- NA Namibia (AP)
- NE Niger (OA)
- NG Nigeria
- NI Nicaragua
- NL Netherlands (EP)
- NZ New Zealand
- NO Norway
- PG Papua New Guinea
- OM Oman
- PH Philippines
- PL Poland (EP)
- PT Portugal (EP)
- RO Romania (EP)
- RS Serbia<sup>1</sup>
- RU Russian Federation (EA)
- SC Seychelles
- SD Sudan (AP)
- SE Sweden (EP)
- SG Singapore
- SI Slovenia (EP)
- SK Slovakia (EP)
- SL Sierra Leone (AP)
- SM San Marino
- SN Senegal (OA)
- SV El Salvador
- SY Syrian Arab Republic
- SZ Swaziland (AP)
- TD Chad (OA)
- TG Togo (OA)
- TJ Tajikistan (EA)
- TM Turkmenistan (EA)
- TN Tunisia
- TR Turkey (EP)
- TT Trinidad and Tobago
- TZ United Republic of Tanzania (AP)
- UA Ukraine
- UG Uganda (AP)
- US United States of America
- UZ Uzbekistan
- VC Saint Vincent and the Grenadines
- VN Viet Nam
- ZA South Africa
- ZM Zambia (AP)
- ZW Zimbabwe (AP)

• 1 Extension of European patent possible.  
 • 2 May only be designated for a regional patent (the "national route" via the PCT has been chosen).  
 • Where a State can be designated for a regional patent, the two-letter code for the regional patent concerned is indicated in parentheses.  
 • (AP = ARIPO patent; EA = Eurasian patent; EP = European patent; OA = OAPI patent).

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## Some Non-PCT Countries

- Angola
- Afghanistan
- Argentina
- Bangladesh
- Bolivia
- Burma
- Cambodia
- Chile
- Djibouti
- **DO Dominican Republic (joining 28 May 2007)**
- Ethiopia
- Eritrea
- Guyana
- Iran
- Laos
- Oman
- Pakistan
- Paraguay
- Peru
- Saudi Arabia
- Suriname
- Somalia
- Taiwan (wants to join)
- Uruguay
- Yemen
- Venezuela

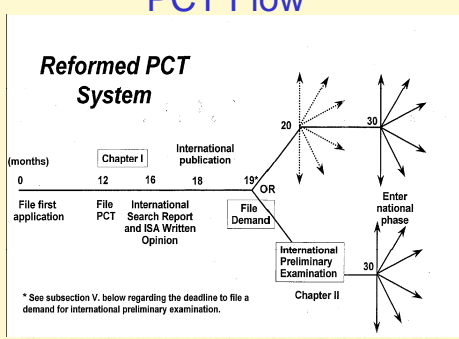
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## PCT Costs

- If your client/company needs an estimate of costs, an estimate may be generated using the Global IP Estimator

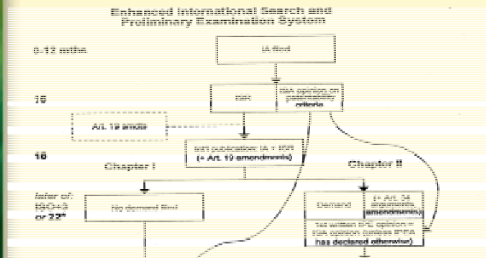
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## PCT Flow



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## PCT Flow Redux



## PCT Flow Redux (bis)

## Priority under PCT

- Priority under the PCT is governed by the Paris Convention
- Same rights in that country if filed within 12 months of priority application
- [http://www.uspto.gov/web/offices/pac/mpep/documents/appxp\\_4.htm#parart4](http://www.uspto.gov/web/offices/pac/mpep/documents/appxp_4.htm#parart4)

## File PCT – Receiving Office

- - the national Office of any Contracting State willing to assume this responsibility
- - the regional Office acting for one or more Contracting States, with their consent
- the International Bureau (IB)
- For us = USPTO or IB
- Determined by anyone of the applicants' nationalities or residence (No US applicant/inventor, then can NOT file with USPTO as receiving office)

## Receiving Office Duties

1. Specifies the international authority competent to carry out search and examination
2. Checks:
  - whether it is competent
  - the filing papers and application
  - whether fees are paid
  - whether certain time limits are complied with
- receives and directs correspondence from the applicant to offices and authorities
- collects fees and transfers some of them to the ISA and the International Bureau (IB)

## Receiving Office

- App must include:
  1. Indication that app is international app
  2. Request of designation of countries
  3. Name of Applicant
  4. Description
  5. Claim
- App need not include:
  1. Fees
  2. Translation
  3. Applicant's signature
  4. Title
  5. Abstract
  6. Drawings

## Receiving Office

- Failure to comply with formal requirements will result in request by receiving office to correct, e.g., informal drawings. Any reply must be filed with receiving office (USPTO – Mail Stop PCT or IB – in Geneva)



## Receiving Office

- Filed with wrong RO?
- RO will forward to International Bureau
  - - meet priority deadline?
  - - timely paid fees?
- wrong RO keeps transmittal fee
- USPTO refunds the other fees
- Must pay fees to IB within one month (Rule 16*bis*)



## International Search Authority

- USA applicants can choose:
- USPTO \$1,000\* (\$300 if prior US search)
- EPO \$2,059
- Korea Patent Office \$232



## Claims

- Added Subject Matter Problems
- Include multiple dependent claims
- Include a “means” claim
- term “means” is broadest protection in Europe
- Two part form not required



## Specification

- Consider removing US boilerplate to reduce excess page fees and translation costs
- Incorporate by reference priority document or co-pending US application with boilerplate if you believe you may nationalize the PCT application back into the US
- OK to incorporate by reference if you are doing so for the US ONLY. No effect for other countries



## Article 19 Amendments

- What? Claim Amendment(s) Only; No Argument or Comment
- When? Within 16 months from priority date or 2 months after mailing of International Search Report/ Written Opinion\*
- How? File claim amendments with the International Bureau as substitute pages with statement describing the change to each claim
- Why? Publish with better claims for damages. Claims in better form for national stages.





## Demand

- Countries that still require demand (June 2006):
- Luxembourg,
- Sweden,
- Switzerland,
- Uganda,
- United Republic of Tanzania



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## Demand/Article 34 Amendments

- What? Your Chance to respond to the International Search Report/Written Opinion
- When? Later of three months from the date of the international search report and the written opinion or 22 months from the priority date
- How? File directly with International Preliminary Examining Authority (IPEA) – USPTO or EPO
- Why? Applicant's chance to refute the rejection of the claims by the International Search Authority



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## PCT also allows designation of regional procedures

- European (EPC) Patent  
<http://www.european-patent-office.org/>
- Eurasian Patent  
<http://www.piperpat.co.nz/europe/ea.html>
- ARIPO Patent (African Regional Industrial Property Association)  
<http://www.aripo.wipo.net/>
- OAPI Patent  
(Organisation Africaine de la Propriété Intellectuelle)  
<http://www.gpa.co.za/english/africa/oapi.htm>



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## PCT - national stage

- Ultimately, every PCT Application must proceed to "National Phase" prosecution in designated countries desired by procedures initiated by the end of 20 months (30 months in some countries)
- from filing date of priority application,
- such as U.S. provisional or non-provisional patent application.



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## PCT - national stage

- National stage prosecution is necessary for perfection of patent rights in the respective designated state.
- Applicant must be careful in choosing countries for national stage.
- Highly variable in complexity and cost. s
- Legal services and governmental fees and translations can be costly.



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## Modern treaties for international filing

### Treaties signed by USA specifically related to patents:

- Patent Cooperation Treaty (PCT)
- European Patent Convention (EPC)
- Other treaties relating to regional rights
- TRIPs
- WIPO



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## EPC - European Patent Convention

- The European patent system was established by the European Patent Convention (EPC)
- European Patent Office (EPO) administers EPC procedures
- Provides patent protection in 25 European countries on the basis of a single patent application and a single grant procedure. "All eggs in 1 basket."



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## EPC - European Patent Convention

- The European patent system established by European Patent Convention (EPC)  
<http://www.european-patent-office.org/>  
[http://www.european-patent-office.org/epo\\_general.htm#organ](http://www.european-patent-office.org/epo_general.htm#organ)
- The European Patent Office (EPO) administers the EPC procedures  
[http://www.european-patent-office.org/epo/pubs/brochure/general/e/epo\\_general.htm](http://www.european-patent-office.org/epo/pubs/brochure/general/e/epo_general.htm)



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## EPC - European Patent Convention

- European patent gives its holder the same rights in the designated contracting states as a national patent
- Valid for 20 years
- Effective only in those countries in which EP proceeds to grant (translation & fees)



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## EPC - European Patent Convention

What are the rights granted?

- European patent is a legal title granting its holder exclusive right to make use of an invention for a limited area and time by stopping others from making, using or selling it without authorization
- analogous to exclusion principles in US law



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## EPC - European Patent Convention

- Patentability requirements under the EPC not substantially different from US
- (1) Industrial Applicability
- (2) Novelty (an invention considered new if it does not form part of the state of the art), and
- (3) Inventive Step (not obvious to a skilled person having regard to the state of the art; like unobviousness in US)



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## EPC - European Patent Convention

- European patent grant procedure takes on average just over four years for a patent to be granted.
- EPC patent grant procedure lays down time limits to facilitate communication between applicants and the Office.



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## EPC - European Patent Convention Signatory States

Member states of the European Patent Convention: Austria, Belgium, Bulgaria, Cyprus, Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Ireland, Italy, Liechtenstein, Luxembourg, Monaco, Netherlands, Poland, Portugal, Rumania, Slovenia, Spain, Sweden, Switzerland, and the United Kingdom



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## EPC - European Patent Convention Extension States

- Rights of a European Patent are likely to be (but as of July 1, 2000 were not yet) extended into so-called **extension states**, which are Albania, Lithuania, Latvia, and former Yugoslav Republic of Macedonia
- Get the latest definitive listing at: <http://www.european-patent-office.org/epo/members.htm>



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## EPC - method of initiating

### How?

- PCT application can be used to designate EPC when filing PCT. Recommended to do so.
- EPC alternative is to file EPC as a regional filing based on pending US patent application under Paris Convention within 1 year from priority date.



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## EPC - or national filings?

### What are trade-offs?

- High costs of EPC procedure including translations and annuities.
- EPC from filing to grant: 4 yr. average
- Where only protection desired in limited number of European states (e.g., Germany, UK, Netherlands), will be more cost-effective to file nationally. BUT: France and Italy have no national patent applications apart from EPC.



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## EPC - patentability exceptions

BUSINESS METHODS & COMPUTER PROGRAMS NOT PATENTABLE

- EPC Article 52(2)(c): --schemes, rules and methods to perform mental acts, playing games or doing business, and programs for computers, are not regarded as inventions for which European Patents can be granted.
- *Even so, application can be filed in EPO*



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## EPC - patentability exceptions

### So, how are these exceptions handled?

- EPO over last few years carries out limited processing of appls. for business methods, pending clarification of law
- Applications for bus. meths. (& computer programs) are not searched
- Law may be changed or interpreted more favorably to applicants
- Many EPC applications in limbo, awaiting clarification of law



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## EPC - patentability exceptions

### Work-around for these exceptions?

- If a business method uses a certain hardware or system, industrial nature of hardware/system overrides “business method” use if hardware/system itself novel
- *Example:* Computerized hand-held device uses software but device itself is specially configured in novel way



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## EPC - patentability exceptions

### Still more . . .

- Methods for treatment of the human or animal body and
- Diagnostic methods on humans or animals
- Expressly excluded by EPC Art. 52(4) although Art. 52(1) enables protection to all inventions having industrial application (**81 countries exclude**)



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## EP - advantage in UK

European patents with validity in Great Britain (as designated state) may be extended to a number of UK countries:

Anguilla, Belize, Virgin Islands (British), Falkland Islands, Gibraltar, Cayman Islands, Jersey, St. Vincent, Turks and Caicos, Tuvalu, Bahrain, Bermuda, Botswana, Brunei, Fiji, Gambia, Ghana, Grenada, Yemen, Solomon Islands, St. Lucia, Singapore, Swaziland, Trinidad and Tobago, Vanuatu, Western Samoa, St. Christopher (St. Kitts) Nevis, Sierra Leone, Tanganyika, Tanzania, Zanzibar, Uganda, Cyprus (Nicósia), Guyana, Kiribati, and Seychelles



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## Some international priority problems

- What happens if applicant loses original priority year? E.g., lack of money for foreign filing or lack appreciation of importance of invention at the time, may cause an applicant to miss the 12-month deadline.
- If the invention has been published, then this ordinarily creates a fatal bar to European and Japanese rights. ABSOLUTE NOVELTY?
- So is there any solution to this problem?



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## Some international work-arounds?

- Failure to file under Paris Convention deadline is fatal only if a third party has filed a patent application in the interval, or if the invention has been published
- If only patent filing was in the United States, and the patent has not yet been issued or published (recall typ. 18 mo. in USA), is it possible that there has so far been no publication of the invention anywhere in the world?



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## Some international solutions

Where patent not yet issued, patent application not yet published, and no publication or commercial sale of invention anywhere in the world, could

- File national patent application in country of interest if permitted; OR
- File PCT application designating all countries and regions (ultimately selecting national phase only in those designated countries of interest)



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## Challenges in foreign filing

### Types:

#### *Opposition proceedings possible*

- Proceeds in Patent Office of a country
- Depends upon patent laws of country
- EPC allows them also
- *Inter partes* (between parties) proceeding
- Parties may present evidence and expert testimony



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## Challenges in foreign filing

### Types:

#### *Nullity proceedings also possible*

- Seek to nullify patent
- Typically held before special Patent Court or other tribunal
- *Inter partes* proceeding
- Depend upon patent laws of country
- May occur at any time during patent life



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## Challenges in foreign filing

- Fees
  - Translations
  - Excessive claim fees
- Timing for Filing
  - Divisional/Continuation Type Applications



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## Further thoughts about PCT

### **Possible Benefits--**

- A PCT international application can put off the major expenses of dealing with individual countries' patent offices for up to 30 months from original US filing date.
- May allow time for the international business to develop or
- May allow time for licensing or mfg. conditions to improve



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## Further thoughts about EPC

### **Possible Benefits--**

- EPC "all eggs in one basket" approach makes economic and logical sense if enough EU countries of interest (or where EP desired in France or Italy)
- EP can open protection to all of Europe, and even the extension states mentioned
- EP in UK opens other UK counties



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## National patent applications not using PCT or EPC

### **Possible Benefits--**

- Paris Convention filing of national patent appls. in selected countries could be preferable or economical
- Examples: Canada, Japan, Germany, UK, Korea, Australia
- National filing especially where time is pressing & countries of interest are few
- Only way into "Non-PCT countries"



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## Some thoughts about selecting countries for foreign filing whether or not using PCT or EPC

### **Important Questions--**

- Country includes a market for technology of invention?
- Is there a manufacturing base to produce or export from country?
- Are patents effective in country?
- Can profits/license fees flow out?
- Is inventive subject matter barred?



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## Some other country thoughts

### **Weigh Against Possible Benefits--**

- Paris Convention national patent application or PCT filing in Germany and Japan also gives the advantage that examination of patent application may be deferred for years



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## A key treaty organization: WIPO

- WIPO - World International Property Organization ("WYE-Poe" or "WEE-Poe")
  - WIPO administers 23 treaties and jointly administers PCT & EPC



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## More about WIPO "The International Bureau"

**Principal international authority**  
<http://www.wipo.org/>

**administers** handling of international patent applications under PCT - the Patent Cooperation Treaty - for 179 member states

- **provides** int'l clearing house, in effect
- **handles** these through the INTERNATIONAL BUREAU of WIPO  
<http://www.wipo.org/about-wipo/en/members/index.html>



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## Is there an international patent?

- There are only international patent applications. They open the way to patents in individual countries, although a European patent under EPC comes close to being an "international patent."
- So no, there is no "international patent." BUT--



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## Is there an "international patent application?"

- For convenience, we use the term "international patent application" to mean either a PCT application or else an EPC application.
- An international application typically uses the same specification and drawings and format of the U.S. application but claims appropriate to European and international procedures.



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## And so, when preparing U.S. patent application

### Recommendations:

- Plan for possibility of foreign filing
- Discuss that with patent counsel
- Budget for at least a PCT application
- Prepare application in international format so specification and drawings are acceptable for USPTO, for either PCT or EPC filing
- Claims in "US" or "European" format



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## International procedures in a nutshell

Why not seek corresponding patents in every country--or most countries?

- Foreign patents are complicated
- Relatively expensive to file & prosecute
- Very expensive to maintain for life of a patent (annuities: sliding scale upward)
- Translations will be required (Japan, China and Korea are expensive)



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## International procedures - how big a nut to crack?

- Like asking the question: "How deep a hole do you wish to dig?"
- You do not have enough money for patents in all the world's countries.
- A business interested in patents in other countries must choose carefully; must consider what, where and why.
- Contrast with successful pharmaceutical drug



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## Program Completed



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