

International Patenting

Outlining the Process & Costs



Clients are often interested in extending patent protection beyond the U.S. While a single “international patent” is not available, there are several options for obtaining patent protection in countries or regions worldwide. This article outlines some of the more common options for patent protection outside the U.S. and highlights important considerations, including the costs, that a patent owner should consider as they decide whether and how to pursue foreign patent protection.

Contrary to what many believe, no “international patent” exists that will protect an invention worldwide. In general, patent rights are granted and enforceable on a country-by-country basis. Separate patent applications must be filed in each country where a patent owner would like patent protection.

Direct Filing

In many countries, a patent application may be filed with that country’s patent office. Alternatively, the application may be filed in a regional patent office servicing that country. These are both considered “direct” patent filings. However, in certain countries, patent applications cannot be filed directly with that country, and a regional application is the only path for securing patent protection. For example, the only way to obtain patent protection in France is to file a regional patent application with the European Patent Office.

Coordinating simultaneous direct filings can be a difficult, time-consuming, and expensive process. Among other things, this process could require the applicant to obtain translations of the patent application in various languages to ensure the patent application conforms to the different foreign countries’ laws and to coordinate their ultimate filing by patent practitioners in specific foreign countries.

For this reason, many industrialized countries have entered into agreements to simplify the international patent application filing process. These agreements provide patent applicants with additional time to finalize their patent filing strategies, including whether to file, where to file, how to file, and when to file a patent application for a particular invention.

Paris Convention

The International Convention for the Protection of Industrial Property (Paris Convention) was first signed in Paris in 1883 and was ratified the following year by an initial group of 11 contracting states. As of the date of this article, there are 179 contracting states to the Paris Convention, including the U.S.

Under the Paris Convention, after filing a first, nonprovisional patent application in one of the contracting states, the applicant may file corresponding patent applications for the same invention in any of the other contracting states with a “priority” claim. If these subsequent applications are filed within 12 months of the first application filing date, they will be treated as if they had been filed on the same day as that first application. One of the significant practical advantages of filing via the Paris Convention route is that applicants seeking patent protection in several countries are not required to file all of their applications at the same time. Instead, applicants have up to 12 months to decide where they would like to file foreign patent applications.

Patent Cooperation Treaty

The Patent Cooperation Treaty (PCT) is an international patent treaty with 157 contracting states, which includes the U.S. and most other industrialized nations. Under the PCT, a patent applicant follows a two-phase process beginning with an initial “international phase” followed by a “national phase,” which could result in patents being granted in multiple countries or regions for the same invention.

International Phase

In the international phase, the patent applicant files a single international patent application with a national patent office (e.g., the U.S. Patent & Trademark Office) or a regional patent office (e.g., the European Patent Office) in a single language accompanied by a single filing fee. At the time of filing, the patent applicant selects an “International Searching Authority” (ISA). An ISA is a patent office chosen by the patent applicant to search for patent documents and other technical literature (prior art) relevant to the invention’s patentability. The ISA then prepares a written opinion called an International Search Report (ISR) that details the results of the search and explains how the prior art identified compares to the claimed invention. Although the ISA conducts a search and issues an opinion related to the claimed invention, no patent is granted during the international phase. The determination of whether to grant a patent under the PCT process remains under the exclusive control of the national or regional patent offices and is made during the national phase of the PCT process.

National Phase

At any time during the international phase (and, in most cases, within 30 months from the filing date of the earliest application from which the PCT application claims priority), the patent applicant can begin the national phase of the two-part PCT process by designating countries or regions where the application should be examined. When making this designation, the applicant must pay fees to each selected patent office and it may also be required to obtain a translation of the PCT application. After making this designation, the application will again be examined by the designated patent offices and is treated very much like a direct patent filing in those territories. The ISR produced earlier may be persuasive during this subsequent examination, but it is not binding on those national or regional patent offices as they consider the patent application. If the conditions for patentability are met, the patent application will be approved and a patent may be granted in that territory.

European Validation

In some cases, if a regional patent application is approved, it can automatically become an enforceable patent in each country of that region. For example, in the case of an application filed in Africa with the Organisation Africaine de la Propriété Intellectuelle or “OAPI” (in English: African Intellectual Property Organization), approved applications are automatically enforceable in each of the member states of the OAPI.

On the other hand, a granted European patent application can be enforced in each European Patent Convention member country, but it is not automatically enforceable in those countries. A granted European patent amounts to a “bundle” of individual, national patents that are independent of one another and that must be “validated” in each country where coverage is sought. Each country in the European region has its own validation process that must be completed within a limited amount of time (within three months from the publication of the granted patent) to make a European patent enforceable in that country. Generally, the validation process requires the payment of certain fees (e.g., issue fees) and may further require filing a translation of all or part of the approved patent application, submitting a power of attorney, designating a local address for service, etc.

Costs of International Patent Protection

The process of obtaining and maintaining international patent protection in multiple countries can be complicated, and the cost can be substantial. However, the PCT route can simplify the process. Filing a PCT application requires paying a single filing fee to a single patent office rather than paying several filing fees to multiple patent offices at the same time. Nonetheless, the PCT filing fee is high when compared to the filing fees for filing a direct patent application. Typically, if a patent applicant desires patent protection in fewer than four countries, it may be more economical to pursue protection via direct national filings instead of via the PCT route. Of course, other considerations could make the PCT route the more attractive option, even if the patent applicant desires patent protection in a limited number of territories. For example, one of the major advantages of the PCT route is the additional time it provides the patent applicant to decide whether and where to pursue patent protection. Additionally, the PCT route delays the costs of prosecuting patent applications and extends “patent pending” status.

In addition to the filing fees described above, ongoing fees are sometimes required to maintain a pending patent application or an issued patent. The timing and amounts of these fees depend on the stage of the patenting process (e.g., international phase vs. national phase of PCT application) and vary by country or region. In many cases, fees are due annually, and the failure to pay the fees would cause the application to abandon or the issued patent to lapse (i.e., become unenforceable).

International Phase

Once the filing fees have been paid for a PCT application, no other fees are required until entry into the national phase. The fees paid upon entering the national phase are the most significant pre-grant cost. These fees can include national or regional office filing fees, translation fees, and fees paid to local patent practitioners to assist in the national phase filing.

Annuities

In many countries, annual maintenance fees must be paid in order to keep a pending patent application active. The U.S. is a notable exception because only the initial filing fee is required to maintain the application. A PCT national phase patent application may be pending for 1-3 years (or more) before the examination process begins, and maintenance fees may be required in each of those years, even though no action has been taken by the patent office. Similarly, the patent examination process can last for multiple years, and further annual maintenance fees may be required in order to keep the application active.

Issue and Maintenance Fees

Upon approval of a patent application, an issue fee must often be paid to convert the pending application into an issued patent. Additionally, fees are required during the validation process (e.g., filing and translation fees) for patent applications approved by certain regional patent offices, such as the EPO. Furthermore, to maintain the patent, maintenance fees must be paid throughout its term. These fees are typically paid to each national patent office in which the patent has been validated. Again, the U.S. is a notable exception because only three maintenance fees are required to be paid over the life of the patent (i.e., at 3.5 years, 7.5 years, and 11.5 years after issuance).

Takeaways

In summary, no “international patent” exists that will protect an invention worldwide; rather, patent rights are granted and enforced on a country-by-country basis. In general, a separate patent application must be filed in each country where a patent owner would like patent protection. There are several filing options that can assist in this process but each has advantages and disadvantages that should be carefully considered.

Article Written By:



Stephen Adams

Shareholder, IP Chair

423.757.0211

sadams@chamblisslaw.com

This constitutes Advertising Material. No representation is made that the quality of the legal services to be performed is greater than the quality of legal services performed by other lawyers. This material is informational, does not provide legal advice, and does not create an attorney-client relationship.

© 2023 Chambliss, Bahner & Stophel, P.C. All Rights Reserved.

Chambliss, Bahner & Stophel, P.C.

605 Chestnut Street | Suite 1700 | Chattanooga, TN 37450 | 423.756.3000 | chamblisslaw.com

