

Protect Your Invention in Foreign Countries

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Once you file your patent application in the United States, you have started a clock running that when it runs out will prevent you from getting a patent in a foreign country if you don't take timely action. That clock runs for one year.

Your alternatives are to file in the foreign countries (or country groups) of your choice within the year or file a [Patent Cooperation Treaty](#) (PCT) application to extend the deadline for filing to at least two-and-one-half years.

As of the date of this article, 136 countries are member states that abide by the PCT. This includes nearly all countries in the World, and those that aren't members are unlikely to have significant markets that require patent protection.

When you timely file in foreign countries or file a PCT application, you preserve your U.S. filing date as the priority date for use in those foreign countries. The priority date is important because other countries award inventions to the first to file the application, rather than the first to invent as in the United States. Thus, others cannot later come in and be awarded patents on applications filed after your priority date. Further, your priority date may be important to negate the effect of references (publications and patents) that are later than your priority date, and thus those cannot be used to reject your application.

For most countries, the ultimate limit through the PCT process is 30 months. If your application is not filed by that deadline in those countries, you will no longer be able to obtain patent protection in those countries in which you have not filed a national phase application. Filing in Europe via the European Patent Office has an alternate deadline of 31 months and Canada has a deadline of 42 months, although surcharges for late filing may apply.

The member countries of the European Patent Organization that may be included under a European Patent are currently Austria, Belgium, Bulgaria, Cyprus, Czech Republic, Denmark, Estonia, Finland, France, Germany, Hellenic Republic, Iceland, Ireland, Italy, Latvia, Liechtenstein, Lithuania, Luxembourg, Monaco, Netherlands, Poland, Portugal, Romania, Slovakia, Slovenia, Spain, Sweden, Switzerland, Turkey, and the United Kingdom.

There are other patent organizations servicing major areas of the world, such as Africa, South America, Asia, etc.; however, at present only Africa (two separated organizations having different country members) and a Eurasian group that consists of some of the former countries of the Soviet Union have collective patents to cover their constituent counties.

As with the U.S., most countries require that practitioners before their patent offices must be registered with their country. Your [registered U.S. patent attorney](#) can assist with foreign filing by working with associate attorneys in foreign countries who are authorized to prosecute patent applications in their countries. One should keep in mind that different countries have different laws and those who practice in those countries will likely be the most skilled in fully understanding their country's laws.

Unlike the United States, many foreign countries have maintenance fees that must be paid during the application process. Thus, the initial costs of foreign filing and the subsequent prosecution will be increased by such fees. Accordingly, it is all the more desirable in foreign venues to prosecute your application with all due speed.

When considering foreign filing, one should keep in mind that your U.S. patent will allow prevention of anyone from making, using, offering for sale, selling or importing your device in or into the United States. Thus, with only a U.S. patent, while your device could be made in, say, China, and sold to, say, Mexico, neither China or Mexico could send your device into the United States.

Lastly, one word of caution: While the United States allows an inventor to file for a patent application within one year after a first public disclosure, sale or offer for sale, such actions could potentially defeat your priority for the purposes of filing in some foreign countries. Thus, it is prudent to get your U.S. patent application on file before introducing your product.

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