

The logo for Osprey IP is displayed on a dark blue rectangular background. The text "Osprey IP" is written in a white, serif font. To the right of the text is a white icon of an osprey's talon, which is a curved, claw-like shape with several dark stripes along its length, enclosed within a thin white circular outline.

Osprey IP

Going Global: How to File Your US Patent Application for Overseas Markets

You've come up with an innovative idea and you're ready to turn it into reality. However, there are copycats everywhere, and it's crucial to take steps to protect your inventions. In addition to filing a domestic patent in the United States, you can file an international patent application that grants protection in many other nations.

Benefits of International Patents

Filing an international patent allows you to enjoy a number of benefits. Perhaps the most obvious reason is the protection a patent offers your inventions in other countries. With a valid patent, you can take legal action against anyone who uses your patent.

Your patent also allows you to operate your business internationally. By filing a Patent Cooperation Treaty application, you can apply for a patent that's valid in multiple countries. This gives you freedom to expand your business into a variety of markets.

If you plan on distributing your products across the United States, patent protection is crucial. It protects your business interests abroad and prevents knockoff manufacturers from undercutting you and stifling your success.

Limitations of International Patents

Before beginning the PCT application process, you should know about the limitations of the PCT application and plan accordingly. PCT applications are only valid in 151 countries; if you want coverage in countries that are not part of the treaty, you must file individually in each of those countries. Furthermore, a PCT application is only valid for utility patents. Individuals interested in patenting their designs are required to file directly with each country in which they do business.

Mistakes to Avoid

Navigating the international patent process requires careful planning and attention to detail. Ensure that you have a domestic patent before you file your PCT application; a patent filed with the USPTO protects your inventions from unauthorized domestic usage.

You should also verify which countries are part of the Patent Cooperation Treaty and ensure that the countries in which you need protection are included. If you want to do business in any excluded countries, make plans ahead of time to file separately in those countries.

Make sure you don't wait too long to file your international patent application. Intellectual property laws vary between nations, and in some countries, you have to file a patent before your invention becomes public knowledge. Waiting until your U.S. patent becomes public may invalidate your patent in other countries.

You also have to meet a stringent deadline. You must file your PCT application no later than 12 months after filing your patent application with the USPTO.

There are many pitfalls that can affect your patent application. Working with an intellectual property attorney with extensive experience in international markets is one way to avoid costly errors.

Application Process

After you retain your intellectual property attorney, you can start working on the PCT application process. The PCT is the Patent Cooperation Treaty, and it includes all countries in the Paris Convention for the Protection of Industrial Property. It takes much less time than filing a patent application with each country and offers more extensive protection. If you file a patent in one PCT country one day and file in another country within the next 12 months, the protection is the same as it would be if you filed both at the same time. After your initial application is filed, you can then take your time to research each country and decide where you want to file an individual patent application.

You'll need to follow these steps to complete and submit your PCT application.

- 1. Prepare the paperwork for your PCT application.** You'll need a list of prior art, a filled out disclosure, and claims to back up the validity of your PCT application.
- 2. File your PCT application.** Do your research before beginning the filing process. You have to submit your paperwork to the correct receiving office or the International Bureau. Once your application has been received, it will be researched by the International Searching Authority. Wait for an International Search Report and Written Opinion of the International Searching Authority.
- 3. Do your research.** There is a window of time in which your intellectual property is protected in PCT countries. Before this window closes—typically between 18 and 30 months—you must file your patent in each individual country. If you do not meet a specific country's deadline, your patent may expire and you'll likely lose your rights to it.

4. **Choose the countries in which you want patent protection.** After you have received your WOISA (Written Opinion of the International Searching Authority) that verifies the patentability of your invention, you'll submit your PCT application to each country. You may need a local attorney in every country; if you are working with an intellectual property attorney, they can help you explore your options and find cost-effective solutions.
5. **Pay all necessary fees.** A number of fees are required during PCT application and nationalization process. Be prepared to pay an initial filing fee and a fee in each country where you file your application.
6. **Enforce your patent.** Failing to protect your patent can lead to you losing it. Actually protecting your patent can be difficult, as you must follow the legal route in each country where the violation takes place. This is one reason that it's important to have a local patent lawyer working on your behalf. They can maintain lines of communication with your lawyers in each country and take action if your patent is violated.
7. **Maintain your patent.** As is the case in the United States, you have to renew your patent periodically to maintain your rights. Your patent attorney can help you keep up with each nation's schedule and deadlines to protect you from an unintentional lapse.

Filing a Patent Cooperation Treaty application is one of the best ways to protect your hard work from the threat of intellectual property theft. However, you must meet strict deadlines and meet very specific requirements. That's why working with an attorney is recommended; you avoid the risk of losing your intellectual property rights in a country in which you hope to do business and stay up-to-date on changing requirements, deadlines, and laws.

OspreyIP has the tools and knowledge needed to help you protect your intellectual property. I'm just one call away—contact me today at 615.377.0768 to schedule your consultation.