

## DOES YOUR INVENTION NEED A PASSPORT?

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Your patent is filed in the United States Patent and Trademark Office (or the office of your local country) then you remember your attorney saying something about patents being jurisdictional, whatever that means...

Once you have filed your initial patent application, sometimes referred to as the “priority” application, you have 12 months to take additional steps to protect your invention in other countries or regions. Patents issued by a particular government are only enforceable in that country. In other words, you can only prevent others from making, using, selling, offering for sale, importing, or exporting of the invention in that country/jurisdiction. If your competitor makes and sells the product in the neighboring country, there is nothing you can do about it unless you also have a patent there.

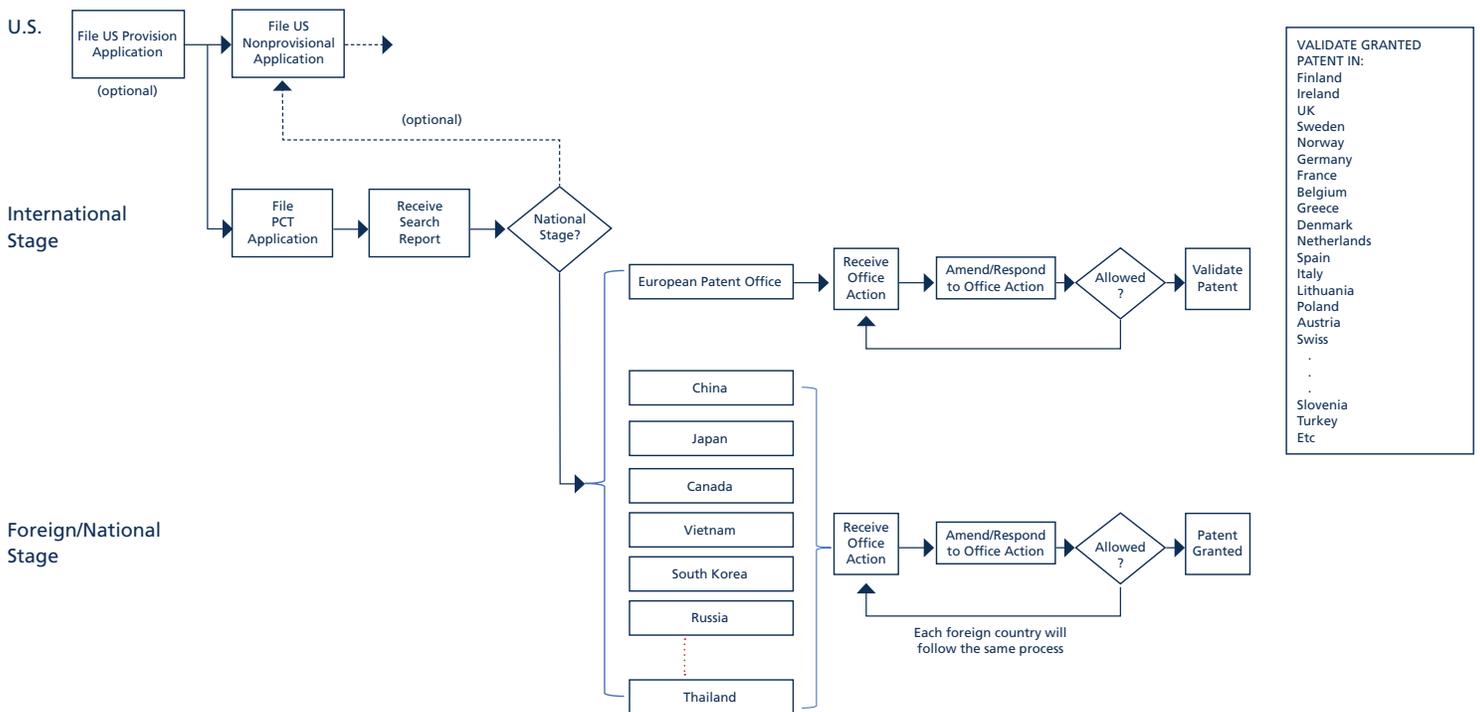
There are a number of ways to protect your invention outside of the country of your initial filing (sometimes referred to as a “priority” filing). These options were originally enabled by a treaty signed in 1883 called the Paris Convention on Industrial Property. Basically, the Paris Convention enables you to file additional patent applications in other countries after your initial filing, but have the same effective filing date as your priority application. Why is this important? If this were not the case, you would have to file all of your patent applications everywhere in the world on the same day. It would be a logistical nightmare and the costs would be prohibitive. In addition to the Paris Convention, inventors may also seek protection under the Patent Cooperation Treaty (PCT).

Decision making at the international stage of this process is very important as the costs can add up quickly. The basic filing fee in the United States is relatively modest, but some countries charge many multiples of what you pay in the U.S. Further, depending on the countries that are chosen, there may be fees for translations and for attorneys that perform the application filing in foreign countries.

One item we should note is that you will sometimes see a reference to a “country/regional” patent office. What is a “regional” patent office? In some places, groups of countries have joined together to prosecute patent applications in a single location for all of the countries in the “region.” The best example of this is the European Patent Office (EPO), which allows for a single prosecution for 38

member states. Other regional patent systems include the African Regional Intellectual Property Office (ARIPO), and the Eurasian Patent Organization (eight former countries of the Soviet Union). Note, the Gulf Cooperation Council (Middle East) ceased accepting new applications in January 2021.

Choosing which countries to file in can get very complicated, and in the legal field complicated means costly. A high-level chart of this process looks like this:



As you can see, the process can take many branches depending on the choices that are made. Because these decisions are highly dependent on your (or your company's) circumstances, it is worthwhile talking with a patent professional to achieve your goals without breaking the bank.

For the moment we will briefly discuss the first two options: 1) filing directly with the respective patent office of each country/region where you want protection (under the Paris Convention), or 2) filing a patent application with the World Intellectual Property Organization (WIPO) under the Patent

Cooperation Treaty (PCT). The strategy chosen will depend on your goals and budget.

- Filing Direct – This option is typically recommended when the number of countries where protection is desired is relatively small, when the client knows exactly which countries they want protection, or when a large budget is available for filing.
- PCT Application – The PCT Application allows you postpone the direct filing of the national applications (referred to as national stage

applications) until 30 months from your earliest filing date. It is important to note that a PCT application does not result in a patent. During the PCT phase, the PCT examiner performs a search and provides a preliminary assessment of the patentability of the claims. There is an optional second stage where an examination is performed, referred to as Chapter II. There are many reasons for filing a PCT application, some of which include:

- o The client needs more time to decide in which countries to seek protection.
- o The client wants to review the PCT search report before investing in foreign applications.
- o The decision to file foreign applications was made too close to the due date and there isn't sufficient time to transmit the necessary documents (or obtain translations) in each of the desired countries.

One caveat on the PCT Application: as of this writing, there are 155 countries that are members of the PCT (called contracting states); however, there are 178 countries that are members of the

Paris Convention. Further complicating matters, some regional patent systems are also members of the PCT (e.g. African Regional Intellectual Property Office, ARIPO), but not all of their respective countries are a PCT contracting state. As a result, you may initially strategize to file a PCT and then a national stage in ARIPO, but then find that Eswatini is not a member. If Eswatini is a country you care about, an application will need to be filed there 12 months from the filing of the priority application. Note, one major industrial country that is not part of the PCT is Taiwan.

Depending on your needs, foreign filing of utility patents can be a complicated subject. In the next article we will discuss the considerations of which countries to file in outside of your home country.

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