

## **Filing Foreign Patent Applications? Beware of Bar Dates\***

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For those companies who wish to file patent applications in the United States, the U.S. patent laws provide a grace period of one year to file the application from the time of an actual sale of, or offer to sell, the invention, or from a public disclosure of the invention, such as at a trade show or in a printed publication, including another's patent. Oftentimes, a company will think of sales and trade shows first, and patenting later, but usually it will shortly thereafter engage the services of a patent attorney, who will prepare and file a patent application in the United States before the one year bar date. However, in such a situation, the company may have inadvertently jeopardized its right to file foreign patent applications.

Excluding the United States, most countries of the world have an "absolute novelty" requirement. That is, if the invention is publicly disclosed anywhere in the world, this constitutes a bar to filing a patent application in most foreign countries. "Anywhere" should be emphasized here: Even if the disclosure occurs in the United States (irrespective of the grace period), it will constitute a bar in Europe and many other countries.

Before publicly disclosing an invention, decide whether you will seek patent protection and where. If foreign rights are sought, then a patent application should be filed in the United States before the invention is publicly disclosed. By treaty, the U.S. application may then be used as a basis for filing in most foreign countries within one year from the U.S. filing date. The foreign applications will then be accorded the same filing date as the U.S. application, despite any public disclosure.

### **FOREIGN FILING OPTIONS**

There are several ways to file foreign applications. First, a company may file a single patent application per country. Each country will then conduct its own examination and issue its own patent, which will have no effect outside that country. Under the Paris Convention, foreign applications in most countries are accorded the filing date of the U.S. application. This "priority" is important, as explained earlier.

Regional patents are another option. For example, a European patent provides coverage in 31 European countries; a Eurasian patent covers nine former Soviet countries. Since a regional patent application entails only one filing fee and one examination, the expenses can be lower than those for filing individual national applications.

Another avenue for foreign filing is a Patent Cooperation Treaty (PCT) application. This document may be conveniently filed in the United States Patent and Trademark Office (as the receiving office) and, if filed within 12 months of the corresponding U.S. application, the PCT application will be accorded the filing date of the U.S. application. Four regional patent applications and about 120 individual

countries may be designated for a minimal fee. The PCT application preserves your right to file foreign applications in individual countries or to apply for regional patents for up to 30 months from the U.S. filing date. Therefore, a company may defer the major expenses associated with foreign filing while it seeks financing; better defines where it should market its products (and obtain patent protection); or learns what problems it may encounter abroad based on the earlier examination of the U.S. application.

The key is to take it one step at a time so as not to inadvertently jeopardize your rights to file foreign patent applications. Otherwise, you risk losing your stake in your prized invention and unintentionally sharing any rewards with a world of opportunists.

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