

## FILING A FOREIGN PATENT APPLICATION

There are about 200 countries with patent systems around the world. Even the Fortune 500 companies do not try to obtain patents in all of them due to the expense involved. A Canadian and a USA patent will prevent importation of a device infringing inventor's invention into Canada and the USA if it is manufactured in a country outside North America. All that is required is a proper complaint filed with either Canada Boarder Services Agency or the United States International Trade Commission.

### 1. General Costs

Provided that an inventor already filed a patent application in Canada, she should expect to incur the following costs for filing a patent application overseas - filing in all 25 countries of the European Union under the Patent Cooperation Treaty (PCT) will cost approximately \$140,000; filing in Japan will cost at least \$6,000.00 (translation fees alone are at least \$2,000); filing in the USA typically will cost about \$4,000.00; filing in Australia and South Korea will cost about \$4,000.00 for each country. Costs of prosecution of the patent application will be in addition to the above mentioned filing costs.

### 2. Paris Convention vs. Patent Cooperation Treaty (PCT) Filing

A rule of thumb is - inventor should use the Paris Convention if she wants to obtain a patent in two or three foreign countries. Filing under Paris Convention requires filing of a certified copy of the Canadian application and a translation within one year of the Canadian filing date if the inventor wishes to preserve the Canadian filing date. Since it can take a month to get a certified copy, the inventor cannot wait until the last month of the year if she is invoking the Paris Convention. The inventor should use the PCT if she wants to obtain a patent in four or more foreign countries. Filing under PCT delays (but does not eliminate) the expense of filing translations and avoids the need for filing a certified copy.

### 3. Timing

Under either Paris Convention or PCT, the foreign filing should be accomplished within one year of the Canadian filing date to preserve the Canadian filing date. If the inventor misses the one year deadline, she can still file foreign patent application under either treaty if her Canadian patent application has not yet published or issued, however, she will lose the benefit of her Canadian filing date and additional prior art could intervene. If the Canadian patent issues in less than a year from the filing date, the inventor can still file a foreign application but in that situation the one year anniversary of the Canadian filing date is the absolute cut-off date for the foreign filing. Inventors should not waste their money by filing foreign patent application if they have no financial resources for marketing or distributing the invention in countries outside Canada and the United States.

### Common Pitfalls

**Pitfall Number 1** The easiest way to lose all patent rights to an invention is by making a public disclosure of the invention and then waiting for more than one year before filing a patent application disclosing the invention. Under Canadian and USA patent law, all patent rights to an invention are irretrievably lost on the first anniversary of the first public disclosure of the invention ei-

ther in Canada or the USA if no Canadian or USA patent application has been filed by that date. Virtually all other countries have an "absolute novelty" requirement. This means that an inventor must have a pending patent application on file prior to the first public disclosure to preserve patent rights to an invention outside North America.

**Pitfall Number 2** Obtaining patents in countries outside Canada and the USA can be quite expensive. For example, filing a patent application in Japan can cost at least \$6,000.00. Filing a patent application that covers all 25 countries of the European Union can cost \$140,000.00 or more, depending upon the complexity of invention and extent of prosecution difficulties. However, even if an inventor decides against seeking foreign patent protection, the value of a patent application is greatly increased if the right to file foreign patents is preserved. The right to file foreign patent applications is preserved only by filing a patent application in Canada and the USA prior to a public disclosure of the invention in either Canada or the USA.

**Pitfall Number 3** Even if foreign filing rights are preserved by filing a patent application in Canada or the USA prior to public disclosure of the invention, a third pitfall remains. If a public disclosure of the invention is made in Canada or the USA after Canadian or USA patent application has been filed, all foreign patent rights (except the USA) are irretrievably lost if a foreign patent application is not filed by the one year anniversary of the Canadian filing date.

**Pitfall Number 4** If no public disclosure of the invention is made after Canadian filing date, all foreign filing rights are irretrievably lost if no foreign patent application is filed prior to the date of publication of the Canadian patent application for public inspection. In other words, the opportunity to foreign filing is permanently foreclosed on the date the Canadian patent application is published for public inspection.

**Pitfall Number 5** Note the difference between pitfalls 3 and 4. If the invention is not publicly disclosed after the Canadian filing date, foreign applications may be filed more than one year thereafter, as long as they are filed prior to the publication or issue date of the Canadian patent application. A foreign patent application filed within one year of the Canadian filing date (with or without a public disclosure after the Canadian filing date) is entitled to the Canadian filing date. However, a foreign patent application filed more than one year after the Canadian filing date is awarded its actual filing date in that foreign country, not the Canadian filing date. This means that additional prior art (art that arises after the Canadian filing date) can be asserted against the claims of the foreign patent application.

**Pitfall Number 6** Not asking your lawyer to explain these pitfalls in more detail. Every inventor should discuss the specific facts of an invention with a patent lawyer rather than rely upon this summary of pitfalls. For example, it is not always easy to determine what constitutes a "public disclosure".