

Foreign Patent Applications and PCT Treaty Filing Deadlines, Costs and Procedures

U.S. Patent Laws provide that whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or improvement thereof may obtain a patent. Once a valid patent is issued by the U.S. Patent Office, the patent owner has the right (during the term of the patent) to exclude others from making, using, offering to sell, and selling the patented invention within the United States, as well as importing the patented invention into the United States. A U.S. Patent, however, provides little, if any, recourse with respect to a competitor that makes, uses, or sells the patented invention outside the United States.

Most foreign countries require that a patent application be on file before any public disclosure, use, or sale of the invention. Luckily, a number of treaties exist that will allow you to delay your foreign filing, provided you have already filed your application in the U.S. prior to any public disclosure. The filing delay is calculated from the earliest filed U.S. application. So, if you have chosen to file a provisional application, your deadline for foreign filing is calculated from your provisional filing date. Your provisional application must be converted into a full utility application with claims prior to foreign filing.

Under the Paris Convention, the filing of an application in the U.S. can preserve your right to file in certain foreign countries and regions for one year. If within 1 year of your U.S. filing date, you are ready to file foreign, we will assist you in coordinating your filing in each individual foreign country or region using foreign agents. Not all countries are members of the Paris Convention, most notably Taiwan.

The estimated cost to file each foreign patent application is \$3500 - \$10,000 per country. If language translations are required, costs can reach \$15,000 or more per country. There are regional filings available, such as the European Patent Office, which will run about \$10,000 for the initial filing. The estimate cost to prosecute a foreign patent application to issue and attend to annual maintenance fees can vary between \$4,000 and \$15,000 per country. Regional EPO filings will require validation in each country of the region after grant for about \$4,000-5,000 per country. Of course, these costs are only estimates and are subject to change and currency fluctuations.

There is also a treaty called the Patent Cooperation Treaty (PCT), which allows an international PCT application to be filed one year after filing in the U.S. that will thereafter preserve your right to file in certain foreign countries for an additional 18 months from your PCT filing date (giving you a total of 30 months from your original U.S. filing date to foreign file). Not all countries are members of the PCT (e.g., Taiwan). The PCT filing procedure usually costs around \$7,000, including the international examination report, or about \$4,000 if you forego the examination report. A PCT application does not mature into a patent. After the PCT process is exhausted 30 months from your U.S. filing date, national filing in each selected foreign country (around \$3500 - \$10,000 per country) and prosecution fees will be incurred, as noted above.

Because we must work through foreign patent agents in each country, and often must forward fees on short notice, we require that all foreign application filing fees be paid in advance. We also require an ongoing retainer, and we will request additional advances as prosecution proceeds. Generally, we require a minimum \$5,000 retainer for each individual foreign country (or more for countries requiring translations) and a \$12,000 retainer for regionally filing in the EPO. Additionally, ongoing retainers anywhere from \$1000 - \$2500 per country/region must be maintained in trust after the initial filing to ensure that foreign prosecution and annual maintenance fees/annuities are promptly paid.

The estimates provided herein generally do not include direct out-of-pocket costs incurred on behalf of clients. Clients are responsible for out-of-pocket expenses, such as postage or other express carrier costs, certification fees, bank fees, telephone fees, copying, draftsman's fees, etc., in addition to the costs/fees listed above. Fees are subject to change. Also, exchange rates will differ between the time of the estimate and the time the bill is paid. We cannot insure against unfavorable shifts in exchange rate. More detailed information regarding foreign and international treaty filings is available upon request. However, we consider it the client's responsibility to comply with any and all foreign filing deadlines.