

## Questions Exporters Should be Asking About Protecting Their Intellectual Property Abroad

David M. Roccio, MASS DEC Member

July 2022

Businesses looking to expand or solidify their global footprint while maintaining critical intellectual property protections should consider international patent filing as part of their IP strategy. It can be an expensive, complicated, and time-sensitive endeavor, but well-informed decisions made early in the process can positively impact future filings and the trajectory of a business. Companies should take a holistic view of their business operations and consider the global IP landscape when strategizing on how to file abroad.

Below are questions that exporters should be asking when formulating an international IP strategy.

### **My invention has been publicly disclosed or sold. Can I still file for patent protection?**

Most likely not. In most countries, a previous public disclosure or sale (intentional or not) is a *bar*, or barrier, to patentability. However, some countries may allow for a *grace period*, or a set amount of time, from the first public disclosure within which a patent application may still be filed. Any grace period allowed by a jurisdiction will start immediately upon the first public disclosure. Accordingly, it is important to identify such disclosures as soon as possible.

### **How do I know in which foreign jurisdiction(s) to file?**

For a company with unlimited resources looking to expand abroad, filing for patent protection worldwide, in as many jurisdictions as possible, may be an easy way to cover current and future activity; however, this is not typically the reality. Most companies have limited resources and must selectively limit their filings to certain countries/jurisdictions. The decision of where to file is typically a business-based decision, taking into consideration:

- Budget;
- Current and future business locations. Not only your headquarters, but anywhere you are operating;
- Current customers and potential markets; and
- Competitors—real and potential—including anywhere they have manufacturing operations or sales.

It is important for an owner of the invention to perform an analysis of the cost of filing for patent protection versus the benefits of filing in a particular jurisdiction. Another important consideration is the viability of potential enforcement of intellectual property rights in any particular jurisdiction.

One way for a company to buy itself more time to make such important foreign filing decisions is to file a Patent Cooperation Treaty (PCT) application to gain provisional protection in any of the [156 contracting states](#) of the Patent Cooperation Treaty. **Error! Hyperlink reference not valid.** The benefit of a PCT application is that it affords the company time to make more informed decisions about where patent protection is desired before filing in individual jurisdictions/countries.

### **Does every country have their own filing system?**

Yes. Most countries have their own patent and design registration systems, each with their own individual timelines, rules, and laws. The filing process for most countries can be broken down into the following stages:

- Filing/Formalities
- Search & Examination
- Publication
- Grant

### **I know I need/want to file in multiple jurisdictions – where do I file first?**

The answers to these questions will determine where you can file first and whether you need permission to do so:

- Where the inventive activity was performed;
- The citizenship of your inventors at the time of invention;
- The residency of your inventors at the time of invention; and
- The nationality of the applicant.

The first filing rules differ for each country: some countries require first filing in their country and/or permission to file elsewhere, based on residency of the inventors, the citizenship of the inventors, or where the inventive activity was performed.

For example, the United States requires foreign filing permission before an invention made in the United States is filed outside of the United States, regardless of the nationality or citizenship of the inventors. India requires foreign filing permission before an invention made by an Indian resident is filed outside of India, regardless of where the inventive activity occurred.

If your invention was a collaboration by inventors that are citizens or residents of different countries, it may be necessary to request permission from multiple countries and/or file in a specific country first to make sure all requirements are met.

## Why do priority rights matter when filing internationally?

Most countries will grant a patent to the first person who files a patent application for a particular invention. Additionally, most countries will not allow you to patent an invention which has already been disclosed to the public. Therefore, ensuring the filing date of your application has *priority*, or predates, other applications and/or disclosures is important when determining when and where you may be able to file.

## What are the different fees associated with international filing?

Each jurisdiction charges government defined fees for filing an application. Applicants are typically also subject to local agent fees. If you file in a non-English language country, translations of the application will be required. Translation costs will depend on the length of the application and the languages involved.

There are a variety of fees an applicant can expect after filing, such as:

- Periodic annuity fees which can vary depending on the country;
- Local agent and governmental fees for responding to patent office actions; and
- Issue fee payments when the application is ready to grant.

## We have been talking about patents, but are there other intellectual property rights I should be considering?

A key component of a company's IP strategy typically involves the early filing of at least one patent application; however, the early protection of other forms of IP may be beneficial for an exporting company to consider:

**Trademarks:** The early registration of a trademark in desired countries/jurisdictions can prevent future disagreements, and potentially expensive litigation, about first use and territorial rights.

**Trade Secret:** If a company plans to protect certain information or technology as a trade secret, measures must immediately be taken to maintain the secret. Such measures include putting the proper procedures/policies in place within and outside of your company early enough that unwanted disclosure of the material is prevented. Once the material is no longer secret, trade secret protection is not possible.

By taking a well-rounded approach to developing an IP strategy, and considering the items identified above, amongst others, with the help of seasoned IP counsel an exporter can develop a thoughtful strategy that protects their valuable IP rights while avoiding potentially harmful (and costly) legal situations.

David M. Roccio is a partner at Lando & Anastasi, LLP, where he practices intellectual property law for clients across many industries. He has extensive experience and an established practice in counseling foreign-based companies who wish to launch their business in the U.S. market, and U.S.-based companies looking to expand abroad. Dave is a member of the MA DEC and may be reached at [droccio@lalaw.com](mailto:droccio@lalaw.com) or 617-395-7078.