

## MUELLER LAW, LLC

### FOREIGN PATENT FILING INFORMATION

If you are interested in foreign filing, there are two routes available. First, an application may be filed directly in each country for which patent protection is desired. Countries that do not include English as an official language require translation of the application into an official language. Government filing fees and legal fees will be incurred at the time the applicant files the application. The costs will vary per country, ranging from as little as \$2,000 to as much as \$10,000 or more, with the most expensive being those that require a translation.

Second, a centralized filing system known as the Patent Cooperation Treaty (PCT) is available. Most industrialized nations (Taiwan being a notable exception) are members of the PCT. Using this system, an applicant can file a single application, which secures the earlier US filing date in all member countries. The cost to file a PCT application varies depending on the size of the application (e.g., length of specification, number of claims, number of sheets of drawings, etc.), but generally will be between \$3,600 and \$5,000. If only a provisional application is on file, there may be additional legal fees for preparation of a full utility application for PCT filing. A PCT Receiving Office will conduct an international search and issue a written opinion as to whether the invention meets the PCT requirements for patentability. 30 months after an applicant files a PCT application, the applicant may confirm the PCT application in one or more of the member countries where patent protection is desired. At this stage, countries that do not include English as an official language will require translation of the application into an official language. Government filing fees and legal fees will be incurred at this time. As noted above, the cost varies per country, ranging from as little as \$2,000 to as much as \$10,000 or more. If no countries are confirmed, then the PCT application expires.

Filing a PCT application delays the payment of individual country filing fees and may reduce the cost of prosecution in the individual countries. A PCT application also secures an early filing date, while enabling an applicant to defer the selection of individual countries. This procedure provides valuable time to develop strategic partnerships and test the market in individual countries. Finally, a favorable patentability report entitles the applicant to a rebate on the European search fee, if the PCT application is confirmed in Europe.

Whether to utilize the PCT system will depend on the applicant's specific situation. When an applicant desires or may ultimately desire patent protection in a number of countries, the PCT system generally provides the most economical and efficient approach. On the other end of the spectrum, if an applicant is certain that they only desire patent protection in one or two English speaking countries, such as Canada or Australia, then direct filing may be more advantageous for the applicant.

If an applicant chooses to file an application directly in one or more foreign countries, these applications must be filed within one year of an earlier filed US application in order to claim the benefit of that US filing date overseas. Similarly, a PCT application must be filed within one year of a US application in order to claim the benefit of that earlier filing date overseas.