



IP ESSENTIALS

A Toolkit for Entrepreneurs,
Innovators, and Business Owners

INTERNATIONAL FILING



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International patent filing is an option for businesses looking to expand or solidify their global footprint while maintaining critical intellectual property protections. However, it can be an expensive, complicated, and time sensitive endeavor. Decisions that are made early in the patent filing process can impact future filings and the trajectory of your business.

Companies should take a holistic view of their business operations and consider the global IP landscape when strategizing on how to file abroad.

Q Does every country have their own filing system?

A Yes. Most countries have their own patent and design registration systems with 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

Q Do any countries work together?

A Yes. International treaties such as the Patent Cooperation Treaty (PCT) and the Hague System for the International Registration of Industrial Designs (Hague), have been established to streamline some aspects of filing across jurisdictions.

Please see our Q&A on the [Patent Cooperation Treaty \(PCT\)](#) to learn more about that process.

Q *I know I need to file in multiple jurisdictions—where do I file first?*

A 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, China requires foreign filing permission before an invention made in China is filed outside of China, 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.

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

A *The decision of where to file is a business decision, taking into consideration:*

- *Budget*
- *Business location—not only your headquarters, but anywhere you are operating*
- *Current customers and potential markets*
- *Competitors, real and potential, including anywhere they have manufacturing operations or sales*

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

Q *Why do priority rights matter when filing internationally?*

A 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.

Q *My invention has been publicly disclosed. Can I still file?*

A Most likely not. In most countries, a previous public disclosure (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 disclosure. Accordingly, it is important to identify such disclosures as soon as possible.

Q *What are the different fees associated with international filing?*

A 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
- Issue fee payments when the application is ready to grant.

This IP Essentials Topic is one of a series:

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