

# Protect your idea

## Protecting your innovations outside the United States

INTERVIEWED BY SUE OSTROWSKI

If you're considering selling your innovative product or commercializing your novel processes in another country, protecting your innovations with a patent in that country may be key to your success. But trying to navigate the process alone can prove difficult.

"It's surprising how complicated it can be, and there are a lot of places to get tripped up," says Carl Ronald, shareholder at Babst Calland. "While you can try to do it on your own, hiring a patent attorney can make the process much smoother, ensuring you are including all relevant information and complying with all relevant deadlines to protect your invention in the most cost-effective way possible."

*Smart Business* spoke with Ronald about when you might need international protection and how a patent attorney can help you navigate the complex process.

### WHEN SHOULD A COMPANY CONSIDER APPLYING FOR A PATENT OUTSIDE THE U.S.?

A U.S. patent only provides a protectable interest here in the U.S.; you can't stop someone from using what your patent teaches to compete with you in other countries unless you've timely filed in those countries, as well. If you have an international customer base that is purchasing products or services that, in the future, may be produced with, employ, or contain your patented process or device, you should seek protection, at a bare minimum, in those countries where your anticipated market is largest.

Keep in mind the importance of secrecy before filing your application.

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**WEBSITE:** For more information about the international patent filing process, contact Carl or visit [www.babstcalland.com](http://www.babstcalland.com).

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In the U.S., you have one year to file a patent application covering your invention after you disclose it publicly. Other nations are not so lenient and, in many countries, any disclosure of your invention to someone who does not have an obligation of confidentiality will destroy novelty and likely preclude you from ever obtaining a patent in that country.

### WHAT IS THE PROCESS FOR FILING IN A FOREIGN COUNTRY?

In general, the first step for most U.S.-based applicants is to file either a provisional or a nonprovisional patent application (your "priority filing") in the USPTO. Once the application has been reviewed for national security issues that would prohibit you from filing outside the country, a foreign filing license grants permission to file in other countries.

If you want to practice your invention in just one or two other countries, your patent attorney can file directly with those countries, so long as the foreign filing license has been granted and it's less than a year since your original U.S. filing.

However, if you're seeking patents in more than one or two countries, it's likely more cost-effective to file an international application through the Patent Cooperation Treaty (PCT). The

PCT provides a unified procedure for filing a single patent application that will preserve your ability to ultimately seek protection for your invention with each of its participating members, which includes nearly all industrialized countries.

Deadlines are important; you must file a PCT application within one year of the filing date of your priority filing. After your PCT is filed, you have up to an additional 18 months in most countries before you are required to file your application directly in each country where you'd like to have protection.

### HOW CAN A BUSINESS DETERMINE IF IT SHOULD APPLY FOR A PATENT OUTSIDE THE U.S.?

Every business has competition in the marketplace and seeks an edge — something to differentiate it from its competitors. One of the ways to compete is to maximize the value of its products and processes and to ensure others are not unfairly competing with it.

If a particular innovation satisfies a need in the marketplace and obtaining a patent will provide a competitive advantage, patent protection should be strongly considered for any country where the innovation is sold. ●