

Featured Professionals

Ryan M. Spanheimer

Related Services

International

Being Strategic About Foreign Patent Filing

Legal Update

09.18.2017

By Ryan M. Spanheimer

While a U.S. patent provides the right to exclude others from taking actions related to an invention in the U.S., it generally does not exclude others from taking these same actions in foreign countries. A patent needs to be obtained in each foreign country where this is desired. However, costs associated with foreign patent protection can be significant. Being strategic about where to pursue foreign patent protection can go a long way in efficiently using available resources while still acquiring meaningful protection for an invention. Here are some considerations for assessing where to pursue foreign patent protection.

The Expected Market for the Invention

In general, there should be a business justification for choosing to pursue patent protection in a foreign country. Considering the expected market for an invention is a key factor in determining whether a sufficient business opportunity exists. Evaluating potential future business growth is particularly important since it can take several years for a foreign patent to issue and, once issued, the patent term will last for a significant time.

A good starting point is to determine what problem the invention solves and where this problem exists. Other significant considerations include profitability and cultural appeal of a product.

Competitors

Failing to obtain patent protection in a country will allow anyone in that country to make, use and sell the invention. However, those who are most likely to exploit this on a large scale are competitors. Accordingly, it can be helpful to consider where competitors are located. Are there countries where a competitor has established itself as a market leader? Are there countries where new competitors are expected to emerge? If so, patent protection in these markets may be worth the investment.

Market Favorable for Manufacturing

Whether it is due to cost, skill, resources or some other advantage, for certain inventions, there may be particular countries that are advantageous for manufacturing. Pursuing patent protection in these places can be an effective way to prevent others from efficiently making the invention. This should be a consideration independent of whether there is an expectation of significant sales in these markets.

Enforcement Practice

While obtaining patent protection in a foreign country is a necessary step in excluding others, the ultimate ability to see this through hinges on the existence of effective enforcement procedures. If it will be exceedingly difficult to enforce a patent in a given country, then the cost of obtaining the patent may not be justified. It is worth noting, however, that as a particular market develops, patent enforcement procedures may evolve along with it. Because the term of a patent can last for a relatively long time, it is worthwhile to consider whether enforcement practices in a given country may become more favorable in the future.

Subject Matter Eligibility

Each country has its own laws pertaining to the types of inventions that are eligible for patent protection. Even if a certain invention is new, useful and nonobvious, it may fall within a subject matter category that cannot be patented. Therefore, it is important to consider at the outset whether the invention is eligible for patent protection in a given country and, if not, whether patent protection for related, eligible features would be useful.

For instance, methods related to treatment of the human body, such as surgical and diagnostic methods, are eligible for patent protection in the U.S. However, such methods cannot be patented in a number of significant markets, including Europe, Japan and China. But, it is generally possible to obtain patent protection in those same markets for systems and devices that are intended to be used in treatments of the human body. Consequently, in this context, it is important to consider whether a patent for an underlying system or device, in lieu of the related method, is valuable.