



Software Association
of Oregon

[Home](#)[About SAO](#)[News](#)[Events and Programs](#)[Membership](#)[Sponsorship](#)[Chapters](#)[Oregon Training Network](#)[Techstart Education Foundation](#)[Resource Center](#)

INTERNET STRATEGY FORUM EXECUTIVE SUMMIT

July 19-20, 2007
Co-Sponsored Event

Protecting Your Inventions Internationally



by Ariel Rogson, attorney, Marger Johnson & McCollom

A U.S. patent will not protect your software invention beyond U.S. borders. If you want to protect yourself from competitors that might try to duplicate your software and undercut your pricing in international markets, you must file patent applications and secure rights in those markets. Every country's system and philosophy for patent application, examination and award is unique, so your patent counsel will guide you through the maze. Following are some tips that will help you to be better prepared for the process, as well as for the decisions and actions that will be required of you along the way.

International patent counsel

Just as it is advisable to enlist a patent attorney to prosecute your patent applications in the U.S., international counsel is also a good idea. Depending on your patent volume and your available time, it can be more efficient to allow your U.S. patent counsel to manage the global patenting process by subcontracting to patent counsel in the appropriate countries on an as-needed basis. In this way, you ensure that you have a cohesive global strategy and that the expertise amassed by your U.S. patent counsel is brought to bear on the international applications.

Requirements for patentability

Requirements, definitions and sentiments of each country can vary greatly, so your attorney team will customize your applications appropriately.

- While in the U.S. nearly every invention is considered "useful," other countries scrutinize utility more closely. In addition, countries outside the U.S. often are stricter about requiring what we might consider a single invention to be divided into multiple applications that command separate filing fees.
- Philosophies on the patentability of software inventions vary greatly. While many countries historically have held that software should not be considered "useful," some are relaxing on this. In most countries, as in the U.S., it is worthwhile not only to try patenting but also to seek copyright protection. Although copyrights offer less breadth of protection than patents, they are usually better than no protection.
- When it comes to patent applications, the U.S. grants protection to the "first to invent" but most other countries grant protection to the "first to file" (the patent application). Keep an eye on the pending U.S. Patent Reform Act of 2005, which may change the U.S. system to more closely match the international scene.

Foreign filing license

If you have a pending U.S. application, you must receive a "foreign filing license" from the U.S. Patent and Trademark Office before filing internationally. This is usually granted automatically on your filing receipt. The USPTO could have a variety of reasons (national security, for example) for denying a foreign filing license.

Deadlines

Application filing order, deadlines and options vary depending on your inventors' citizenship and the countries' individual rules, so your attorney team's expertise will be critical.

- If one or more of your inventors holds citizenship in a country other than the U.S., you need to think ahead about the order of your patent filings. Some countries require that you file there first if one of their citizens is an inventor.
- If your inventors are all U.S. citizens, or if your inventors' countries allow you to file in the U.S. first:
 - Most countries have signed the Paris Convention, which allows you to claim protection back to the date of your original U.S. patent application, provided you file your international applications within one year of the U.S. filing date.
 - If, within that first year after filing your U.S. application, you are

SEARCH OUR SITE

SAO EVENT CALENDAR

June 27, 2007
[Applying Technology to Get Above the Sidewalk](#)
CIO/IT Forum

June 28, 2007
[Static v. Dynamic Analysis Tools: Finding the Right Bug Spray](#)
Quality Assurance SIG

July 10, 2007
[Pub Social](#)
Internet Professionals SIG

July 18, 2007
[ITIL Executive Overview](#)
Oregon Training Network

July 19-20, 2007
[Internet Strategy Forum Executive Summit](#)
Co-Sponsored Event

July 23-28, 2007
[ITIL Practitioner Release and Control](#)
Oregon Training Network

July 23-27, 2007
[OSCON 2007 - Open Source Convention](#)
Co-Sponsored Event

[Full Event Calendar](#)



SAO is always looking for new members and volunteers. Check out the [Membership](#) section of our site to see how to become an SAO Member. Or, click [here](#) to see how to become an SAO Volunteer

SAO NEWSLETTER SIGN-UP

[SAO Newsletter Archive](#)

not quite sure in which countries you want to file, or if you do not have the funds to file some or all international applications, consider using the "Patent Cooperation Treaty." PCT applications, which account for more than half of all international filings, are relatively inexpensive and serve as a placeholder for international filings. They allow you as long as 30 additional months to make decisions or raise funds before filing applications.

- Some countries – such as Taiwan, most Arabic countries and most of South America – are not signatories to the PCT, so your attorney will help you pinpoint countries where you still must file international patent applications within one year of your U.S. filing date.
- Also keep in mind that if your application needs to be translated, you need to plan ahead. Translation can take time, and rushing a translation can be expensive.

Process efficiency

In some situations, you can streamline your international patent-filing process by availing yourself of some systems designed for that purpose.

- Although you will typically be required to submit a separate application in each country, in a few cases – such as parts of Europe, Asia and Africa – you can file your application in a "Regional Patent Office."
- Your application would be reviewed just once by the Regional Patent Office and – if granted – would then be sent to each individual country within that region for "perfection." This entails collection of filing fees according to each country's fee structure, and possible translation.

Costs

Costs vary greatly from country to country, depending on filing fees, any translation requirements, and other costs, so this will likely influence your prioritization and budgeting. Certain countries – such as Japan, China and the European Patent Office – typically require the largest total investment.

Although international patent applications require advance planning, logistical care and additional investment, the rewards can be well worth it. U.S. companies that decide to sell, or even assemble, their products overseas without the appropriate patent protection may find the foray is not as lucrative as they had hoped. Instead, if they effectively secure their rights in all countries in which they plan to sell their products, they have both offensive and defensive power to stand up to their competition.

About the Author

Ariel Rogson is an attorney at Marger Johnson & McCollom, PC, a full-service U.S. and international intellectual property law firm headquartered in Portland. A former software developer, he continues to serve clients in software and high tech industries. He can be reached at 503-222-3613 or ariel.rogson@techlaw.com.