

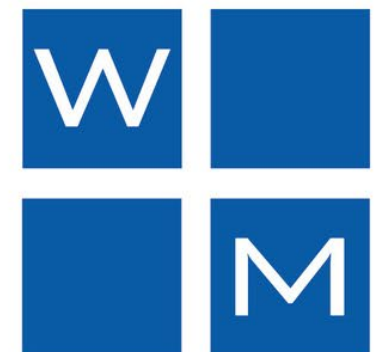
International IP Portfolio Strategies

Dan Pierron



International Filing Options

- **Patent Cooperation Treaty (PCT) Application**
- Paris Convention Application



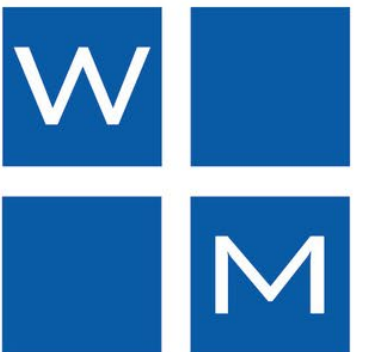
PCT Application

- Intermediate International Application
- Facilitates Filing Applications in 157 Signatory States
- Two Stages:
 - International Stage
 - National Stage



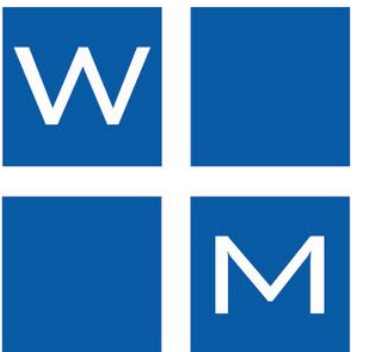
PCT Application - International Stage

- Filed within 12 Months of Priority Application
- Select National Patent Office as Search Agent
 - Search of International Prior Art
- Non-Binding Opinion on Patentability
 - Industrial Application – Is this something that is generally patentable
 - Novelty – Has this exact invention already been invented?
 - Inventive Step – Can this invention be cobbled together?



PCT Application - National Stage

- File National Stage Applications Before 30–32 Month Deadline
 - Deadline Depends on Country
- Binding Substantive Examination at National Stage
 - International Search and Opinion is Influential, but Non-Binding
- Each Country/Region Prosecuted Independently



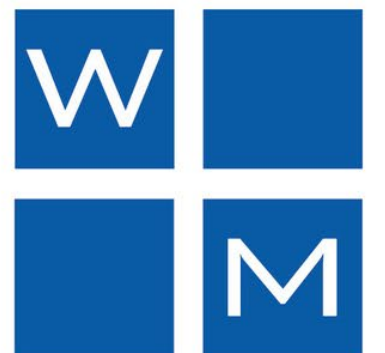
PCT Application - National Stage

Pros:

- Simplified, Streamlined Foreign Filing
- Professional Search and Opinion Before Filing in Multiple Countries
- Delays Costs for Filing in Multiple Countries
- Improves Quality of Resulting Patents

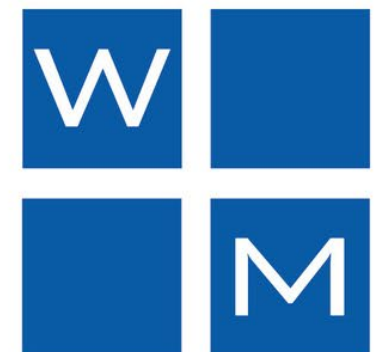
Cons:

- Increases Total Cost
- Additional Cost Usually Requires 3+ Jurisdictions for Justification
- Limited Strategic Value if Committed to Filing National Stage Applications
- Taking Full Advantage of Timing Reduces Period of Enforcement of Resulting Patent(s)



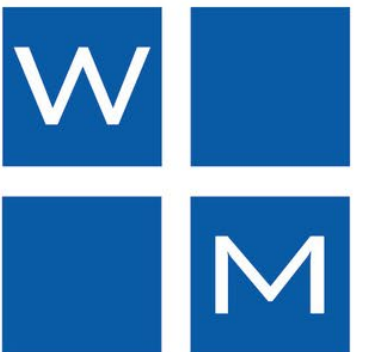
International Filing Options

- Patent Cooperation Treaty (PCT) Application
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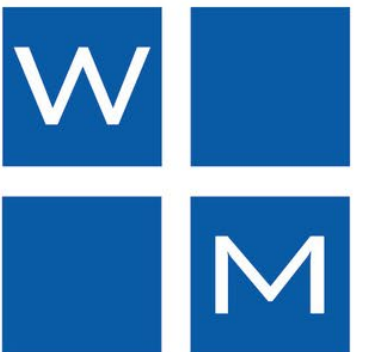
Paris Convention

- Filed Directly into Foreign Country – No Intermediate Application
- File Paris Convention Applications within 12 Months of Priority Application



National Phase U.S. Patent Applications

- 30-month Deadline for PCT applications
 - If missed, can file Petition to Revive the Application in the U.S.
- Claims can be amended
 - Usually are to conform to U.S. claim conventions
- Written Description can be Supplemented
 - Bypass Continuation



National Phase

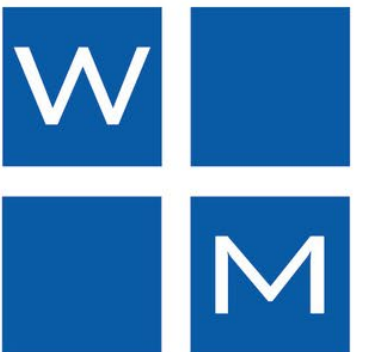
U.S. Patent Applications – Cont.

- Evaluated for Patentability:
 - Patentable Subject Matter (§ 101)
 - Similar to Industrial Applicability
 - Novelty (§ 102)
 - Non-obviousness (§ 103)
 - Similar to Inventive Step)



Provisional Application

- Stopgap Application
- Establishes Priority Date
- Not Substantively Evaluated, Cannot Result in a Patent
- Non-Provisional Application must be filed within 12 months



THANK YOU



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