STRATEGIES FOR THE INTERNATIONAL PATENT PROTECTION OF AN INVENTION

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With the globalisation of markets, even small and medium size companies now have the opportunity to commercialize their products to clients all over the world. Large scale patent protection of innovations, however, involves significant fees, which often force companies to abandon their property rights in promising markets. This can be avoided by taking full advantage of the possibilities offered by the patent system and international treaties on intellectual property.

A patent confers to its holder the exclusive right to make, sell and use the protected invention. With a limited budget, it is essential to carefully choose the territories where patent protection is to be sought. In practice, the most crucial factor to consider is the importance of the market for the sale of the product that is to be patented in a given country. It may also prove advantageous to consider territories where strategic partners operate, who could be implicated in the commercialization and distribution of the product. As a patent is essentially a defensive tool, one strategy to be considered is protection in territories where competitors have installations for manufacturing similar products; in this manner, a patent in a single country could prevent, at the source, the commercialization of the patented innovation by these competitors.

Choosing the territories in which to protect by patent is an undertaking that is important yet difficult to make early in the process of marketing a product. It is however at this particular moment, before public disclosure and sale of the product even occurs, that patent applications must be filed in each relevant territory so as to reserve rights to the invention. How does one reconcile these seemingly contradictory requirements? Two international treaties can be

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judiciously used to this end: the Paris Convention, and the Patent Cooperation Treaty (PCT).

According to the Paris Convention, to which 169 countries currently adhere, filing a patent application in one of the member countries gives the Applicant a "priority right", under which patent applications for the same invention can be filed in any other member country within twelve months, without loss of rights. In other words, subsequent applications filed under priority will benefit from the same advantages as if they had been filed at the same time as the first application. Capitalizing on this year of priority can be particularly advantageous where the first filed application is a United States provisional application, or a Canadian informal application; in both cases, such an application can be prepared at a lesser cost, as long as it describes all the elements of the invention to be protected and it is replaced within twelve months by complete applications.

The PCT, to which more than one hundred countries are signatories, enables a single patent application to be filed while reserving the rights to the invention in all the member countries. Individual applications must nevertheless eventually be filed in all the territories where protection is sought, but the deadline for these filings is extended to thirty months from the priority date; thus the Applicant benefits from a two and a half year period after the first filing to evaluate the market and establish an appropriate international protection strategy. Moreover, the international phase of the PCT includes a prior art search and an examination of the application by a patent Examiner, which can give an indication as to the chances of obtaining patents for the invention and as to the potential scope of the eventual protection.

An advantageous strategy for keeping all possible doors open for a maximum time period while minimizing initial costs is the initial filing of a provisional or informal patent application, followed within twelve months by the filing of a PCT patent application. Taking the path of the PCT international phase nevertheless has the disadvantage of delaying the issuance of corresponding patents by many months. An attractive alternative could be to file patent applications, in parallel with the PCT path, directly in the countries for which one is certain to want to obtain quick protection. This is often the case with the United States, for example. It is equally important, before expiry of the priority year, to make sure that other countries considered for protection are indeed members of the PCT; if not, patent applications must be filed there directly within twelve months following the first filing.

In conclusion, despite significant fees associated with obtaining patents internationally, informed entrepreneurs can take advantage of the delays

provided by international patent treaties and establish a profitable protection strategy leading to a maximum return on their investment.

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