



Intellectual Property Law

Q Should I File My Patent Outside the United States?

A An essential part of the strategy for protecting your invention should include considering obtaining patents outside the United States. Once you file your U.S. application, you have 12 months to file for these patents without detriment to your foreign protection. During this period it is critical to create a strategy that will significantly enhance the value of your patent portfolio both here and abroad.

There are many factors to consider when deciding whether to file and where to file outside the United States. Important factors include: in which countries you plan to sell your product; what countries have potential competitors; the length of your product cycle; the ability to enforce patents in the legal systems of the selected countries; and of course, your patent budget. Even if you do not plan to sell your product in certain countries, you should consider

filing in those countries if significant competitors are located there. It is generally easier to stop competitors at home than to stop them piecemeal in all the countries where they market. It is not unusual to wait up to five years after your initial U.S. patent filing date for grant of a foreign patent. Thus, patent filings for products having a life cycle in this range may not be worthwhile. Finally, the

total cost of filing outside the U.S. can include both initial and recurring

government fees that arise even while the patent is pending. Other costs such as translations and foreign representation fees make the total investment in a foreign patent substantial.

By careful consideration of these factors and close collaboration with experienced legal counsel, you can create a strategy for foreign filing which will minimize your costs and maximize the value of your patent portfolio.

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