

Develop International Patent Portfolio

Will Chen

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1. How to file – from U.S. application to international applications?
2. Where to file – which country?
3. How to leverage your U.S. patent to obtain patents in other countries?

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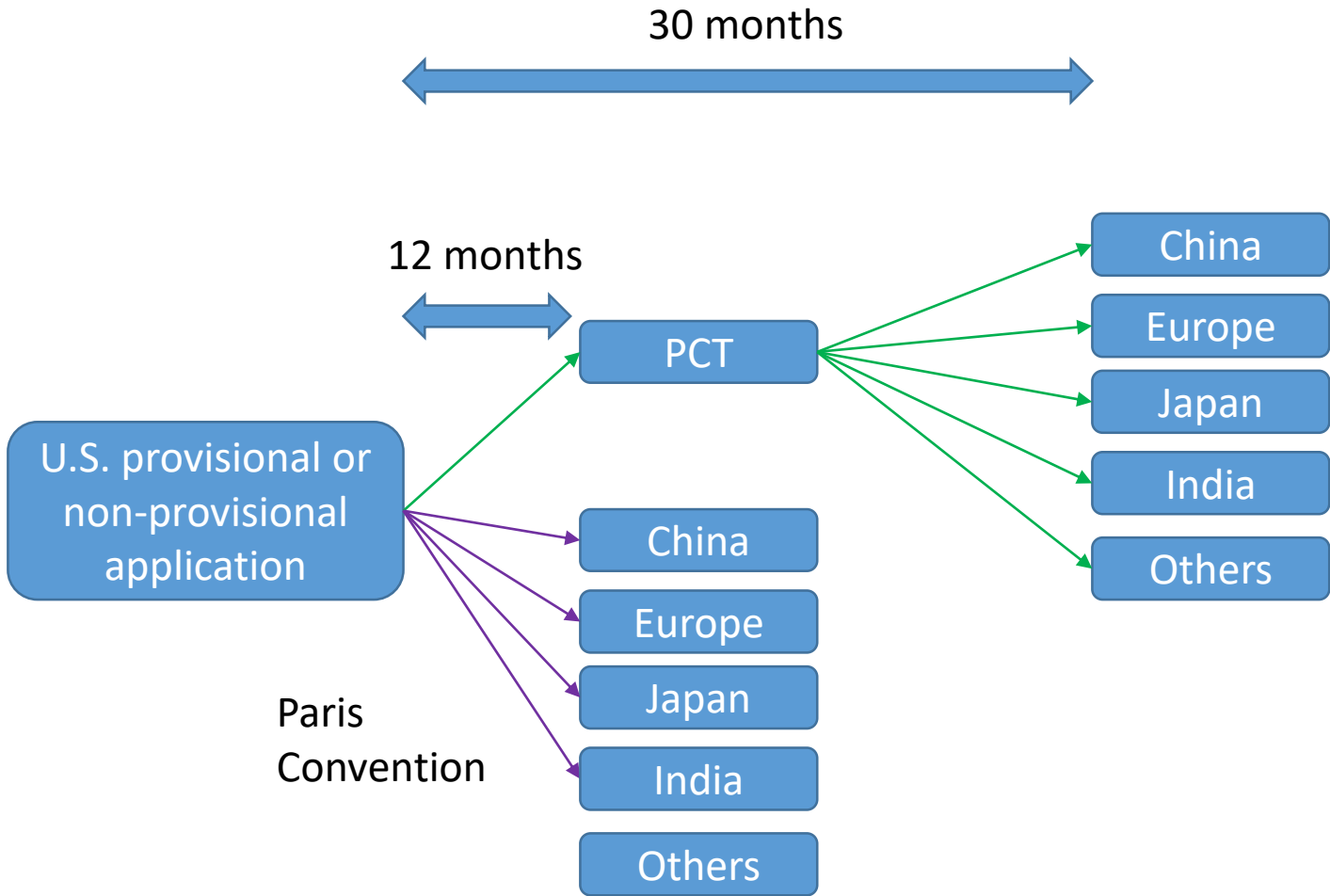
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How to file – from U.S. application to international applications?

From U.S. provisional or non-provisional application filing date, within 12 months, file in foreign countries:

1. Paris Convention – directly enter into other countries
2. PCT – file international application, and then enter into other countries
 - a. Non-PCT members: **Taiwan**, Argentina, ...

How to file – from U.S. application to international applications?



How to file – from U.S. application to international applications?

Paris Convention v. PCT

1. Timing

- a. If you want to get foreign patents asap, use Paris Convention
- b. If you are not concerned with timing, file PCT and wait U.S. examination results

2. Cost

- a. PCT may cost about \$3000-5000
- b. Each country average costs \$3000-5000 (more costs if translation needed)
- c. If less than 3 countries, use Paris Convention
- d. If more than 3 countries, PCT can help delay the cost of multiple countries

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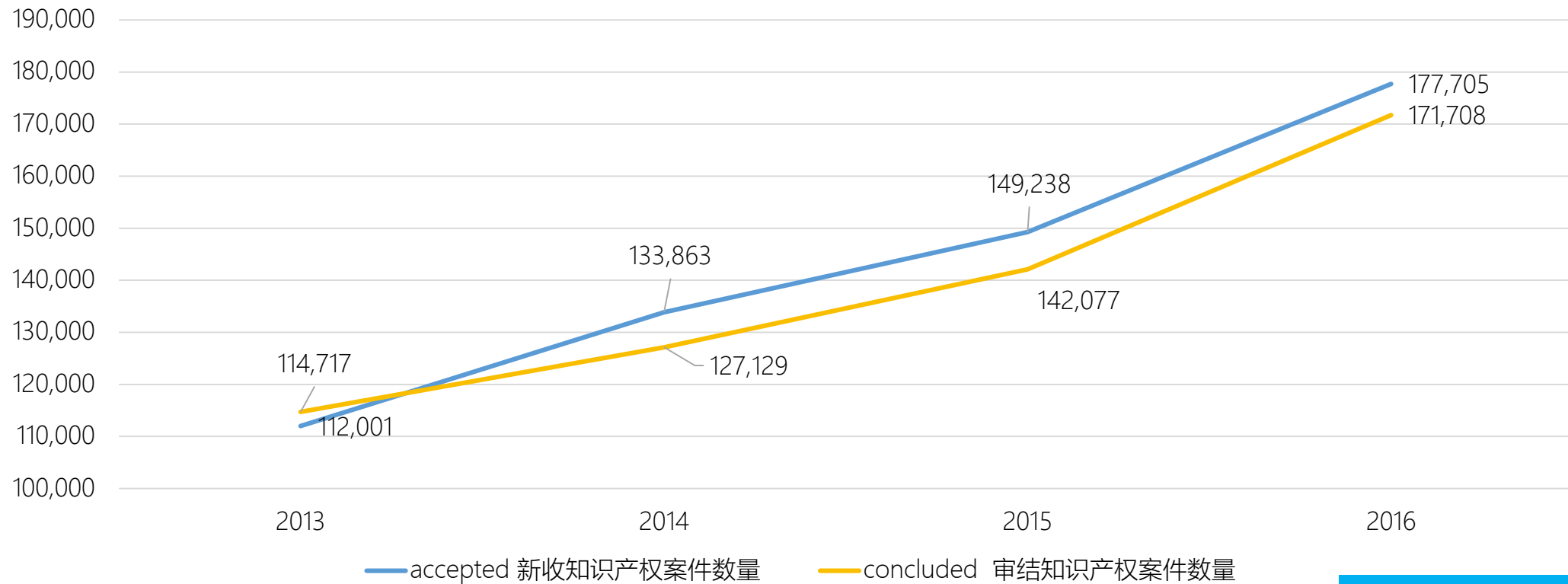
Where to file – which country?

Consider the following factors:

1. **Market – Patent is a tool to control market share**
 - a. Where is your market, now and in the future?
 - b. Where are your competitors' markets, now and in the future?
 - c. Semiconductor: China, Europe, Japan, Korea, Taiwan, India, Brazil...
2. **Manufacture – Patent can stop others from making the products**
 - a. Where is your product manufactured?
 - b. Where are your competitors' products manufactured?
 - c. Semiconductor: China, Europe, Taiwan, Japan, Korea, India, Brazil...
3. **IP Protection Environment – You have to enforce your patents**
 - a. Patent enforcement actions in that country?
 - b. Germany, China, Taiwan, Japan, Korea, India...

Where to file – which country?

China – market [YES] manufacture [YES] enforcement [? – YES]



www.iphouse.cn

Where to file – which country?

China – enforcement [? – YES]

- a. Special IP courts, experienced judges, avoiding local protection
- b. Increase damage amount
- c. Injunction
- d. High winning rate for foreign plaintiffs

Where to file – which country?

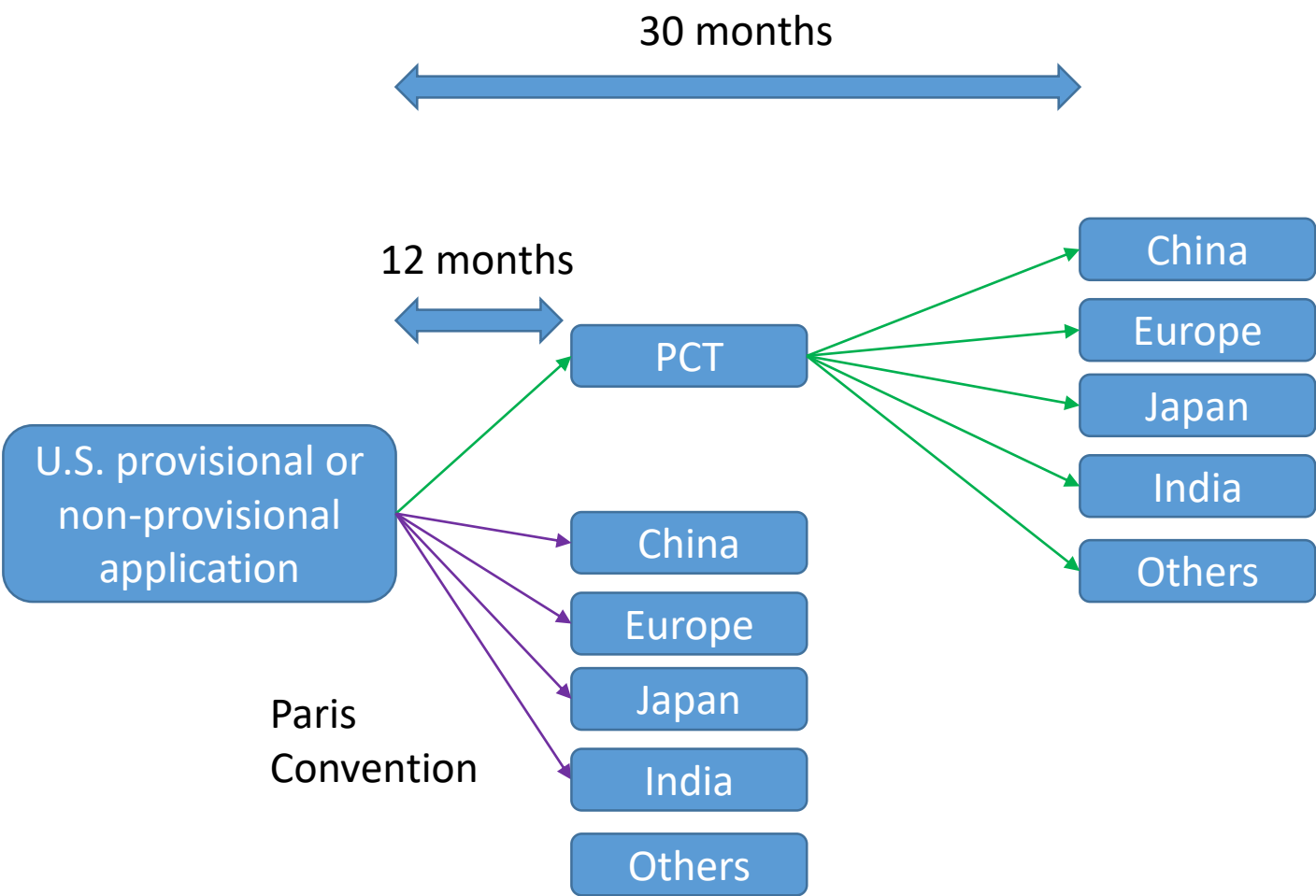
Obtain high quality foreign patents:

- a. Use reputable firms
- b. Be aware of the rules
- c. Make sure translations are correct

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How to leverage your U.S. patent in obtaining patents in other countries?

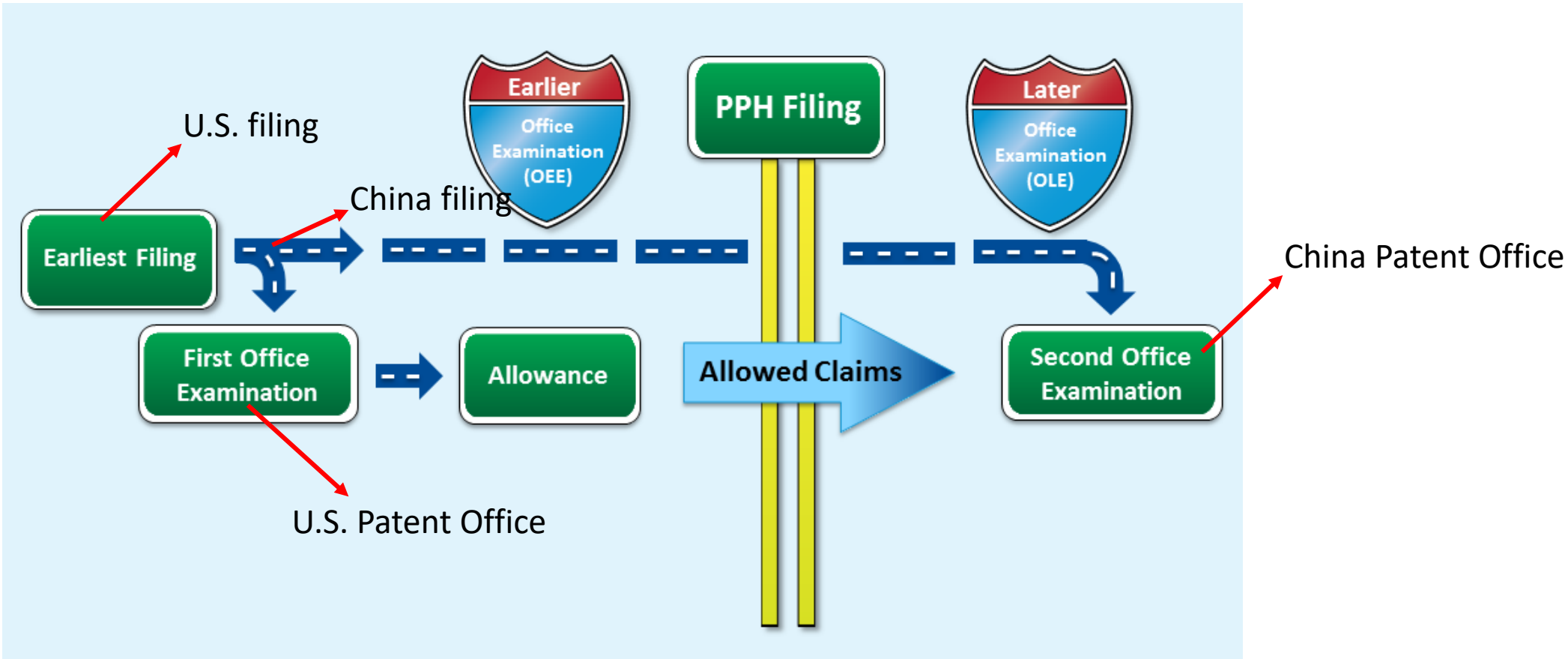


How to leverage your U.S. patent in obtaining patents in other countries?

1. Each country normally independently examine the patent application
2. Some countries accept International Preliminary Report on Patentability, other major countries' examination report
3. Patent Prosecution Highway (PPH)

How to leverage your U.S. patent in obtaining patents in other countries?

Patent Prosecution Highway (PPH)



How to leverage your U.S. patent in obtaining patents in other countries?

Patent Prosecution Highway (PPH) Participants:



How to leverage your U.S. patent in obtaining patents in other countries?

Accelerate your U.S. Examination – USPTO finishes examination within one year!



How to leverage your U.S. patent in obtaining patents in other countries?



1. Petition grant to first Office Action – average 2.1 months
2. First Action allowance rate – 30%
3. Petition grant to allowance – average 5.2 months
4. Requirements - \$4000 for large entity; \$2000 for small entity
5. But ultimately save cost because less Office Actions, higher grant rate

How to leverage your U.S. patent in obtaining patents in other countries?

After U.S. patent is granted, use U.S. examination result to apply PPH or other fast track examinations in other countries

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- Patent preparation and patent litigation for high-tech companies in Silicon Valley and China.
- Sheppard Mullin is a global firm with 800 attorneys and 16 offices worldwide