



Patently Strategic Musings

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Foreign Filing - Overview

- Foreign Filing Licenses
- Types of Countries
- Strategy
- Potential Conflicts
- Examples
- Takeaways

Foreign Filing License

Why we care:

- Some countries have foreign filing license requirements before patent applications can be made in other countries
- As stated by WIPO: “In most cases, you are considered to have permission to file with another [patent office] if either you have filed an application for the same invention at the relevant national [patent office] a certain amount of time previously (which varies from [patent office] to [patent office]) and have not received a security notice stating that you should not file elsewhere, or if you have explicitly requested and been granted permission.”

Three Types of Countries

- 1st: Countries without Foreign Filing License requirements
 - Notably: Japan, Hong Kong, Mexico, South Africa, Switzerland, Thailand
- 2nd: Countries with Foreign Filing License requirements based on inventor/applicant Citizenship, Residency, or place of Business
 - Notably: Belgium, India, Israel, Italy, United Kingdom
- 3rd: Countries with Foreign Filing License requirements based on location of inventive activity
 - Notably: China, Germany, Russia, Spain, United States

(Note: Two Subcategories- 2nd and 3rd types plus the added limitation of the invention pertaining to national security, state secrets, and/or military applications)

Practitioner Strategy

- WHO?
- WHERE?
- WHAT?

Who?

Identify:

- Inventor(s) citizenship/residence
- Location of Business if the Business entity is the applicant

Where?

Identify:

Where the inventive activity occurred?

Note: Portions could be in different locations. Increase teleconferences have added recent complexity.

What?

Identify what has been invented:

- Is it a military application?
- Relate to a national security?
- A state secret?

Potential Conflicts

- Two or more inventors/applicants having different citizenship/residence with countries from the 2nd category
- Two or more inventors performing inventive activity in two or more countries from the 3rd category
- Inventor(s) with citizenship/residence in a country from the 2nd category but conceiving the invention or inventive portions within a country from the 3rd category

Example Conflicts and Resolutions

First Example.

- A US company has an in-person workshop at their US based headquarters. As part, two company employees attend. Employee A is a Chinese resident working for a Chinese branch of the company. Employee B works for 5 months of the year in the US and returns to his family in India for 7 months of the year. During the workshop, the two employees invent a manufacturing process that greatly increases the efficiency of the company's manufacturing.

First Example Resolutions

- Chinese FFL Jurisdiction: No
- US FFL Jurisdiction: Yes, inventive activity in the US
- Indian FFL Jurisdiction: Yes, Employee B is a tax resident of India

First Example Resolutions-Continued

- First option: File requisite documents with IPO wait for permission (typically within 3 weeks), then file at USPTO
- Second option: File requisite documents with USPTO wait for permission (typically within 3 days from receipt of expedited petition), then file at IPO

Example Conflict and Resolution

First Example.

- An Israeli inventor and a Canadian inventor, working in the private sector, invent a new mousetrap. The two inventors were working together via teleconference when they conceived of the invention.

Second Example Resolutions

- FFL requirements: None
- Canadian inventor is not a government employee and not subject to Canadian FFL requirement
- Invention is not related to weaponry or ammunition, or subject which is otherwise of military value. Thus, not subject to Israeli FFL requirements.

Key Takeaways as a Practitioner

- Who? Where? What?
- If two or more countries are involved in the FFL process, work from stricter to more lenient
- Best to always refer to an associate from each subject country

Key Takeaways as a Business

- Consider R and D based in foreign countries
- Consider added time to timelines
 - For example, if an FFL is needed in India before filing in the US, add up to three weeks to US filing date