

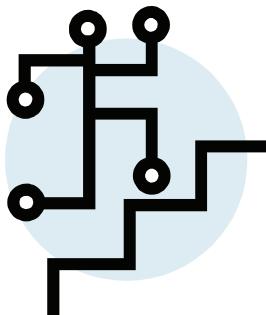


AMERICAN CHEMICAL SOCIETY

## FOREIGN FILING LICENSE

[See page 15 of third edition]

For "an invention made in this country," U.S. laws require that a "foreign filing license" be obtained from the PTO before a patent application is filed in another country for that invention, or the applicant must wait six months after filing a U.S. patent application for that invention before filing a counterpart foreign application. A failure to abide by this rule will bar issuance of a U.S. patent for the invention, or in the case a U.S. patent has already issued, will invalidate the issued patent. Under certain circumstances, the failure to obtain a foreign filing license may be remedied by petition. See 35 U.S.C. §§184, 185.



This is best illustrated with an example. Research carried out in the U.S. is funded by a company in Germany. A patent application may not be filed in Germany (or in the European Patent Office) without obtaining a foreign filing license from the U.S. PTO. In the alternative, a U.S. patent application must be filed, and then a patent application may be filed in Germany (or in the European Patent Office) six months after the filing of the U.S. application. In this example, the citizenship of the researchers is irrelevant. The determining factor is that the research was conducted in the U.S. (i.e., the invention was "made" in the U.S.)

## DOCUMENT DISCLOSURE PROGRAM OF THE PTO

[See page 12 of third edition]

The PTO's document disclosure program is of limited utility now that an inventor can file a provisional patent application. It is expected that the program will be eliminated as proposed by the PTO in May 2006.

## UPDATE OF RESOURCES

[See pages 20-21 of third edition]

If you need information about patents, designs or trademarks from any country in the world, you can check the following gateway websites for links to other websites:

IP Menu - <http://www.ipmenu.com/>

A comprehensive directory of sites on all aspects on intellectual property, including official government sites from most countries, produced by IP organizers, a part of Phillips, Ormonde & Fitzpatrick, an Australian law firm.

The British Library patent links page - <http://www.bl.uk/collections/patents/othlinks.html>  
A large collection of links to IP sites of all kind.

In addition, the American Chemical Society's Chemical Abstracts Service covers patents from patent offices worldwide - <http://www.cas.org/EO/caspats.html>

## DISCLAIMER

The purpose of this pamphlet is to provide you with a brief overview of patents. It is for information only and is not meant to replace legal advice; we recommend that you direct legal questions to a patent attorney or patent agent on the register of the U.S. Patent and Trademark Office.



COMMITTEE ON PATENTS  
AND RELATED MATTERS

AMERICAN CHEMICAL SOCIETY  
1155 SIXTEENTH STREET, NW  
WASHINGTON, DC 20036

202-872-4510

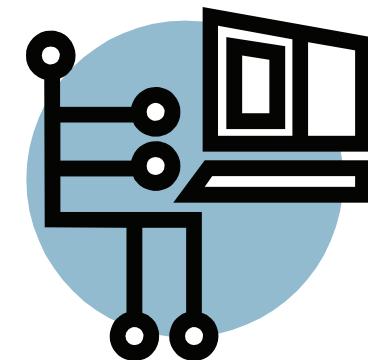
<http://membership.acs.org/C/CPRM/>

Committee on Patents and Related Matters

2006 Supplement

# What Every Chemist Should Know About Patents

3rd Edition, 2002



<http://membership.acs.org/C/CPRM/>

# What Every Chemist Should Know About Patents

3rd Edition 2002

Since the publication of the third edition of *What Every Chemist Should Know About Patents* in early 2002 (<http://membership.acs.org/C/CPRM/>) patent law reform and associated proposals have been widely discussed. However, very few changes actually have been adopted. The information in the third edition of *What Every Chemist Should*

*Know About Patents* requires updating in two specific areas:

- Changes in the deadlines for an international patent application filed under the Patent Cooperation Treaty (PCT); and
- Advances in the electronic aspects of patent application processing and patent information.

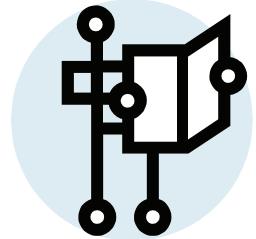
Another change, although of minor impact, is that the U.S. Patent and Trademark office (PTO) proposed in May 2006 to eliminate its "disclosure document" program.

Also, the Committee on Patents and Related Matters is repeating with new emphasis a warning against the filing of a patent application in a foreign country for an invention "made in the USA" without first obtaining a "foreign filing license" from the U.S. Patent and Trademark Office (see below).

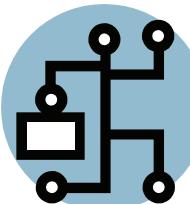
## PCT REFORM

[See pages 14-15 of third edition]

As indicated in the third edition, the Patent Cooperation Treaty (PCT) system was in the midst of a transition from a 20-month deadline to a 30-month deadline for the "entry into the national stage" to be completed for an international patent



application under Chapter I of the PCT in each country (or regional patent office) chosen by the patent applicant. (The 30 months are counted from the filing date of the national patent application in the case where an international patent application claims the earlier filing date of such national application. If no national application was filed, or the applicant chooses not to claim priority based on such national application, then the 30 months are counted from the date of filing of the international patent application.)



The details, as described above, are somewhat complex, but the key issue (and benefit) for inventors is that they may now wait an additional ten months before they must pay certain fees to protect their invention. Where funds may be tight, and the inventor needs additional time to demonstrate that the invention has commercial utility, the change offers a significant advantage.

The transition to a 30-month deadline under PCT Chapter I is now complete, with all but five of the 130 countries now in the PCT system applying the 30-month deadline. The exceptions are Switzerland, Sweden, Luxembourg, Tanzania, and Uganda which still apply the 20-month deadline. In those countries, the patent applicant has to file at the 19th month a Demand for Examination under PCT Chapter II in order to delay national stage entry until the 30-month deadline. In practice, however, this 20-month deadline can still be avoided. For Switzerland, Sweden and Luxembourg, a 30-month deadline is still available under PCT Chapter I by proceeding through the European Patent Office (EPO) which applies a 30-month deadline. Similarly, for Tanzania and Uganda, the 30-month deadline is available by proceeding via the African Regional Industrial Property Organization (ARIPO) which applies a 30-month deadline.

## ELECTRONIC ASPECT

[See pages 8 and 10 of third edition]

The PTO as well as other major patent application processing bodies, in particular the European Patent Office, the World Intellectual Property Organization and the Japanese Patent Office, continue to make available through the Internet more and more documents from the examination file for a patent application once an application has been published. These documents, which include the rejections made by examiners and the arguments and amendments presented by applicants, are usually available in pdf image format, with the exception of documents available from the PTO which are in tiff image format. Thus the entire patent examination process for an application gradually becomes much more transparent to third parties, once a patent application has been published and all transactions for the application are no longer maintained in secrecy.

Worldwide, patent application processing bodies increasingly provide for electronic filing of patent applications, as well as e-filing of other documents in the examination of patent applications. In the U.S., the experience with the first generations of software provided by the PTO for writing and filing patent applications had been so painful that the PTO had fallen far short of the target of having 80% of all patent applications filed electronically by 2006. A new Web-based e-filing system based on the filing of documents in PDF format was released by the PTO early this year. It promises to be eventually much more user-friendly although it is apparently not entirely trouble free at this point.