

Global Patent Prosecution

July 2019



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Survey of Foreign Filing Requirements in the United States, China, and Europe

Many governments require approval of technical subject matter described in patent applications in the form of a foreign filing license prior to filing, especially if the patent application is being filed outside the country of invention. The foreign filing license is intended to protect national security and to prevent the filing of patent applications directed to sensitive technologies, such as weapons, explosives, nuclear technology, and atomic energy materials. The July issue of the Global Patent Prosecution Newsletter surveys foreign filing requirements in three jurisdictions: the United States, China, and Europe.

IN THIS ISSUE

[Foreign Filing Requirements in the United States](#)

[Foreign Filing Requirements in China](#)

[Foreign Filing Requirements in Europe](#)

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FOREIGN FILING REQUIREMENTS IN THE UNITED STATES

By: [Yuanfeng Gao](#), Shyam Pandula and [Christian A. Camarce](#)

This article discusses foreign filing requirements in the United States. Assuming the United States is the country of invention, the following questions are explored: (1) who needs to seek permission to file a patent application outside the United States?; (2) what is required to file a patent application outside the United States?; and (3) if any, what remedies are available if permission is not initially sought to file a patent application outside the United States?

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FOREIGN FILING REQUIREMENTS IN CHINA

By: [Yuanfeng Gao](#), Shyam Pandula and [Christian A. Camarce](#)

This article discusses foreign filing requirements in China. Assuming mainland China is the country of invention, the following questions are explored: (1) who needs to seek permission to file a patent application outside China?; (2) what is required to file a patent application outside China?; and (3) if any, what remedies are available if permission is not initially sought to file a patent application outside China?

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By: [Yuanfeng Gao](#), Shyam Pandula and [Christian A. Camarce](#)

This article discusses foreign filing requirements in Europe—in particular, the United Kingdom and Germany. Assuming each is the country of invention, the following questions are explored for each jurisdiction: (1) who needs to seek permission to file a patent application outside the country of invention?; (2) what is required to file a patent application outside the country of invention?; and (3) if any, what remedies are available if permission is not initially sought to file a patent application outside the country of invention?

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This article discusses foreign filing requirements in the United States. Assuming the United States is the country of invention, the following questions are explored: (1) who needs to seek permission to file a patent application outside the United States?; (2) what is required to file a patent application outside the United States?; and (3) if any, what remedies are available if permission is not initially sought to file a patent application outside the United States?

1. Who needs to seek permission to file a patent application outside the United States?

Any applicant who files for a patent application for an invention made in the United States must first seek permission from the U.S. Patent and Trademark Office prior to filing the patent application outside the United States. According to 37 C.F.R. § 5.11, a foreign filing license is required before filing any application for patent in a foreign country, foreign patent office, foreign patent agency, or any international agency, if the invention was made in the United States, and: (1) an application on the invention was filed in the United States less than six months prior to the date on which the foreign application is to be filed; or (2) no application on the invention has been filed in the United States.

2. What is required to file a patent application outside the United States?

There are two ways in which an applicant can file its patent application outside the United States: (1) file a U.S. patent application and wait six months prior to filing the patent application outside the United States; or (2) file a petition for expedited foreign filing license under 37 C.F.R. § 5.12.

According to 35 U.S.C. § 184, “except when authorized by a license obtained from the Commissioner of Patents a person shall not file or cause or authorize to be filed in any foreign country prior to six months after filing in the United States an application for patent or for the registration of a utility model, industrial design, or model in respect of an invention made in this country.” Filing a patent application in the United States is considered to include a petition for license under 35 U.S.C. § 184 for the subject matter of the application. Six months after filing the U.S. patent application, a foreign filing license on that subject matter is no longer needed, provided no secrecy order has been issued by the U.S. government.

Under 37 C.F.R. § 5.12, an expedited foreign filing license within six months of filing a U.S. patent application can be requested by an applicant. A petition for the expedited foreign filing license must include the U.S. patent application number, filing date, inventor information, and title, along with a fee. Alternatively, an expedited foreign filing license can be obtained without filing a U.S. patent application. In this instance, a legible copy of the material upon which the foreign filing license is requested must be included. Generally, within three business days from receipt of the expedited petition, a foreign filing license will be granted if there is no national security concern.

3. If any, what remedies are available if permission is not initially sought to file a patent application outside the United States?

Filing a patent application outside the United States without first obtaining a foreign filing license may result in a loss of U.S. patent rights. However, to remedy the noncompliance, an applicant can submit a petition for retroactive foreign filing license provided the applicant can show that the unlicensed foreign filing occurred through error. According to 37 C.F.R. § 5.25, a petition for retroactive foreign filing license includes: (1) a listing of each of the foreign countries in which the unlicensed patent application material was filed, (2) the dates on which the material was filed in each country, (3) a verified statement (oath or declaration) containing: (i) an averment that the subject matter in question was not under a secrecy order at the time it was filed abroad, and that it is not currently under a secrecy order, (ii) a showing that the license has been diligently sought after discovery of the proscribed foreign filing, and (iii) an explanation of why the material was filed abroad through error without the required license first having been obtained.

Considerations for Patent Applicants

Applicants should carefully consider their patent filing strategies for any inventions made in the United States to preserve their patent rights. For example, the time frame in which applicants seek to file their patent applications outside the United States may guide whether a petition for an expedited foreign filing license should be filed. And, if applicants err in failing to appropriately petition for a foreign filing license, applicants may petition for a retroactive foreign filing license to remedy the error.

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By: [Yuanfeng Gao](#), Shyam Pandula and [Christian A. Camarce](#)

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1. Who needs to seek permission to file a patent application outside of China?

Any applicant who develops the subject matter of its patent application in China must seek permission to file the patent application outside China. Article 20 of the Patent Law of the People's Republic of China (Chinese Patent Law) states that “[w]here any entity or individual intends to file an application for patent abroad for any invention or utility model developed in China, it or he shall request in advance the patent administration department under the State Council for confidentiality examination.” According to Article 8 of the Rules for the Implementation of the Patent Law, “developed in China” means “substantive contents of the technical solution are made within the territory of China.” For the purpose of initially filing a patent application outside China, the Chinese Patent Law does not consider an inventor’s citizenship or residency. Thus, any applicant who intends to file “any invention or utility model developed in China” must apply for a confidentiality examination in China before seeking patent protection on the same subject matter abroad.

2. What is required to file a patent application outside China?

An applicant can request a confidentiality examination with the Chinese Patent Office before filing its patent application outside China. The confidentiality examination is a review of a description of the patent application’s subject matter by an Examiner to determine whether the invention should remain confidential. The request for confidentiality examination can be filed with or without a corresponding Chinese patent application. But, most importantly, the request must be filed prior to the filing of any foreign patent application. For example, an applicant can file a request for confidentiality examination concurrently with or after first filing a Chinese patent application. The applicant can also file such request without filing a Chinese patent application. In this situation, the applicant would need to wait for approval from the Chinese Patent Office before filing its patent application outside China.

To file a request for confidentiality examination, an applicant should submit a “Request for Confidentiality Examination of a Patent Application to be Filed Abroad,” accompanied with a

description of the patent application's subject matter. There are no fees associated with the request and the applicant should expect approximately six months of processing time as there are no expedited procedures.

3. If any, what remedies are available if permission is not initially sought to file a patent application outside China?

Failure to request a confidentiality examination by an applicant may result in a loss of patent rights in China. According to Article 20 of the Chinese Patent Law, “[f]or an invention or utility model, if a patent application has been filed in a foreign country in violation of the provisions of the first paragraph of this Article, it shall not be granted patent right while filing application for patent in China.” Thus, a Chinese patent application can be denied entirely if a foreign patent application on the same subject matter has been filed in violation of the confidentiality examination requirement.

Considerations for Patent Applicants

Applicants should carefully consider their patent filing strategies for any inventions developed in mainland China to preserve their patent rights. Before filing any applications abroad, applicants should conduct a careful analysis of the contents of the invention and inventorship to determine if a request for confidentiality examination is required.

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The United Kingdom

1. Who needs to seek permission to file a patent application outside the United Kingdom?

A UK resident seeking to file its patent application abroad is required to first obtain a foreign filing permit from the UK Intellectual Property Office only if Section 23-(1) Subsection (1A) of the UK Patents Act applies. Subsection (1A) applies if: “(a) the application contains information which relates to military technology or for any other reason publication of the information might be prejudicial to national security; or (b) the application contains information the publication of which might be prejudicial to the safety of the public.” For example, if the subject matter of the patent application was developed with the UK’s Ministry of Defense (or one of its agencies), then a foreign filing permit should be obtained by a patent applicant.

2. What is required to file a patent application outside the United Kingdom?

If Section 23-(1) Subsection (1A) of the UK Patents Act is applicable, an applicant (who is a UK resident) cannot file its patent application outside the United Kingdom unless (1) it has first filed the patent application with the UK Intellectual Property Office at least six weeks prior to the application being filed outside the United Kingdom and (2) either no directions have been issued by the UK government prohibiting disclosure of the information in the patent application or such directions have been revoked.

If Section 23-(1) Subsection (1A) of the UK Patents Act is not applicable, an applicant is free to file its patent application outside the United Kingdom without obtaining a foreign filing permit.

3. If any, what remedies are available if permission is not initially sought to file a patent application outside the United Kingdom?

Filing a patent application outside the United Kingdom, in violation of Section 23 of the UK Patents Act, could result in criminal penalties. There is no provision for retroactively requesting a foreign filing permit to remedy the noncompliance. When in doubt, applicants should seek a foreign filing permit at the UK Patent Office.

Germany

1. Who needs to seek permission to file a patent application outside Germany?

An applicant seeking to file a patent application outside Germany must request a secrecy review if its patent application contains a state secret. According to Section 93 of the German Criminal Code: “State secrets are facts, objects or knowledge which are only accessible to a limited category of persons and must be kept secret from foreign powers in order to avert a danger of serious prejudice to the external security of the Federal Republic of Germany.” Inventions from particular technology fields, such as weapons technology and nuclear technology, may be considered state secrets.

2. What is required to file a patent application outside Germany?

Section 52 of the German Patent Act states that: “a patent application containing a state secret (Section 93 of the Criminal Code) may only be filed, outside the territory to which this Act applies, with the written consent of the competent highest federal authority. Consent may be given subject to conditions.” If the patent application does not contain a state secret, the applicant is free to file outside the Germany without undergoing a secrecy review.

3. If any, what remedies are available if permission is not initially sought to file a patent application outside Germany?

Filing a patent application outside Germany, in violation of Section 52 of the German Patent Act, could result in criminal penalties. There is no provision for retroactively requesting a secrecy review to remedy the noncompliance. If an applicant is in doubt as to whether its patent application contains a state secret, the applicant should consider requesting a secrecy review.

Considerations for Patent Applicants

Applicants should carefully consider their patent filing strategies for any inventions made in the United Kingdom and Germany to avoid criminal penalties. There are no provisions for retroactively authorizing filing abroad to remedy noncompliance in these countries. Hence, if an applicant is in doubt as to whether its patent application contains sensitive information, the applicant should seek the proper review by each country’s patent office.

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