

International Patent Applications: Changes to Eligibility and Fees in Russia and Europe

PUBLISHED ON
June 6, 2022

U.S. inventors and corporations seeking to preserve potential patent rights internationally will now find prioritizing Europe to be less expensive. In contrast, avenues to obtain patent protection in Russia continue to dwindle.

The United States Patent and Trademark Office (USPTO) recently announced changes to the fees of the European Patent Office (EPO) and the eligibility of the Russian Federal Service for Intellectual Property (Rospatent) as searching authorities for patent applications filed under the Patent Cooperation Treaty (PCT). The PCT, one avenue for pursuing patent protection abroad, follows an original domestic application and allows an applicant to file a single international application preserving potential patent rights worldwide. A U.S. applicant, for example, could file a U.S. patent application and, deciding to preserve intentional protection, could then file the PCT within one year of the original U.S. application.

Unlike most patent applications, the PCT application cannot mature into a patent that confers patent rights to the applicant; filing in individual foreign jurisdictions is still required to obtain such rights. However, the PCT approach offers other significant benefits. A PCT application delays the decision on which specific foreign jurisdictions to enter, allowing the applicant to assess the business value of the invention more thoroughly. Further, and perhaps even more valuably, the PCT provides an additional search for pre-existing technology that may uncover obstacles to obtaining valuable patent rights.

The applicant selects the foreign patent office that performs the additional PCT search. We typically advise clients to choose the jurisdiction in which they are most likely to pursue foreign protection, as examiners from this selected patent office will perform the search, essentially providing a preview of how the pursuit of patent rights would fare in that office. The USPTO currently allows U.S. applicants to select one of seven other offices in addition to the USPTO itself; the three most popular aside from the USPTO, in order of filing volume in 2021, were the EPO, Korea, and Rospatent.

However, the USPTO announced on June 1 that Rospatent will no longer be selectable as the PCT searching authority effective December 1, 2022, and had cautioned against selecting Rospatent. Rospatent had reached its level of popularity as a PCT searching authority selection primarily due to the low relative cost of the search performed by the Russian patent office. Although Russia currently remains a member of the World Intellectual Property Organization (WIPO) that governs the PCT, the USPTO continues to sever intellectual property ties with Russia after previously announcing ends to other patent cooperation and programs.

Conversely, the recently announced changes include an approximately 6 percent discount on the fee required to select the EPO as the PCT searching authority. This reduction eases the cost burden in obtaining additional insight on European patentability, a valuable and popular strategic choice while protecting rights via the PCT.

International patent rights and optimal strategies for U.S. applicants continue to shift due to the global political climate and in light of a long-term movement toward unifying patent rights across jurisdictions. If you have any questions about navigating the PCT or other options for foreign patent protection, please contact [Kevin Myhre](#) or any member of the [Intellectual Property Practice Group](#).

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