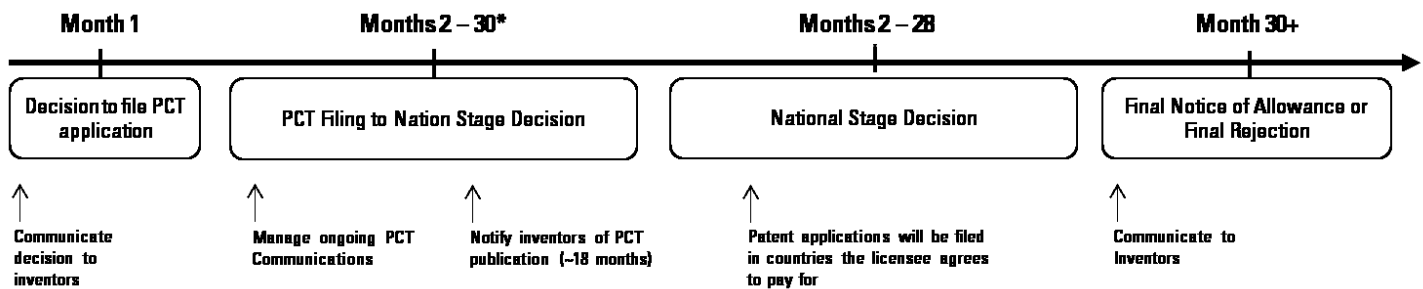




Patent Cooperation Treaty and Foreign Filings – what to expect . . .

U.S. patents are only valid in the United States. In order to have protection in other countries, patents must issue in each country of interest. Patent Cooperation Treaty (PCT) and national stage applications are filed because there is a sufficient licensing opportunity, such as a current or potential licensee who agrees to pay the costs for these filings and it fulfills the requirements for patentability.

ISURF uses the PCT application process as a “place-holder,” preserving the right to file patent applications in foreign countries (“national stage applications”). A PCT application does not itself issue into a patent; national stage applications are examined for patentability and may issue into patents in the particular chosen countries. A PCT application can either be filed as the first application filing, or up to one year after the first application filing. Follow-on national stage applications must be filed within 30 months of the original patent filing.



*The number of months available for a national stage decision and filings may be significantly less than 30 months, depending on previous filings.



ISURF Cost

The cost of a PCT adds approximately \$5,000 to the usual patent application costs. National stage application and prosecution costs vary widely from country to country. PCT applications and national stage filings in the usual group of industrialized countries and regions can cost upwards of \$100,000. Additional costs will include patent prosecution activities after filing and fees charged by countries for maintaining applications and issued patents.

Timeline (Months)



Month 1: Decision to File

- If no provisional or utility application was filed, a patent attorney will be selected and consultations will be held with the contributor(s).
- If a provisional application was filed, the patent attorney and/or ISURF staff will consult with the inventors to gather new information such as new data, new contributors, and new funding.

- Consultations with inventors will continue until the PCT application is filed and may require significant time. The patent attorney provides the legal language and knowledge of patent application drafting requirements and is responsible for the patent application draft and filing. Active cooperation by the inventors is essential in reviewing patent application drafts and providing scientific content such as:
 - A complete written description of the invention. A manuscript is ideal; other publications or descriptions are helpful.
 - Data, examples, ranges, context, parameters, etc.
 - Listing of all contributors and their contribution.
 - An indication of the direction of future research.
 - Any public disclosure/presentation plans.

2-30

Months 2 – 30: From PCT Filing to National Stage Filing

ISURF will:

- Manage ongoing PCT communications, including an Initial Search Report and Written Opinion, which are expected from the PCT filing office and provide an overview of the prior art and possible patentability of the filed invention.
- Notify inventors of the publication of the PCT patent application ~18 months.

Inventors help by:

- Continuing to publicly disclose/present as provided under any funding agreements.
- Continuing to report and update ISURF regarding new data, improvements, advancements, and setbacks.

2-28

Months 2 – 28: National Stage Decision

Inventors will be notified by ISURF:

- Good news – ISURF will continue prosecuting in various countries as selected by ISURF and/or a licensee.
- Not so good news – No national stage filings will occur due to lack of patentability or no commitment from a licensee to pay for patent costs.

30+

Month 30+: National Stage Patents that Issue

- ISURF will pay the issue (nationalization) fees when there is a commitment from a licensee to pay patent costs.
- The patents (or their equivalents) are usually valid for up to 20 years from the filing date of the utility patent application.

Contact Information

In-house Counsel	Donna Johns	djohns@iastate.edu	294-6355
Patent Prosecution Assistant	Leslie Geffre	lgeffre@iastate.edu	294-9407
Life Sciences Senior Commercialization Manager	Dario Valenzuela	dariov@iastate.edu	294-4470
Engineering and Software Commercialization Manager	Jay Bjerke	jbjerke@iastate.edu	294-3621
Chemistry and Materials Senior Commercialization Manager	Craig Forney	ceforney@iastate.edu	294-9513
Technology Marketing Manager	Jack Hartwigsen	jackh1@iastate.edu	294-0693