



Preparing for Partnering Across Borders

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- SAIC - A Nation-wide High Technology Company
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- Army Research Laboratory
- Army Armaments RDEC at Picatinny NJ
- Benet Laboratories, Watervliet NY
- Maryland Dept. of Business and Economic Development
- Naval Air Warfare Center, Lakehurst, NJ and Pax River MD
- Army Aviation and Missile RDEC, Huntsville, AL
- Army Game Project
- TechLink, Montana State University*
- SpringBoard Alaska
- Program Manager Battle Command, Ft. Monmouth NJ
- GSA

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- Was There An Enabling Disclosure?
 - All Foreign Rights Lost
- Is Use Of The Invention Obvious?
 - Will Importation Of Infringing Products Be Obvious?
 - Can Your US Licensee(s) Protect Against Infringers?
- Is The Cost Of International Protection Be Likely To Be Recovered?
 - Will Profits On Sales Pay For Protection Costs
 - Very Expensive Process Over Many Companies
 - 5 Countries And 7 EPO Countries, 4 Patents, Initial Costs = \$200k
 - Global IP Estimator. www.globalip.com
- Will Your Licensee Pay For Costs?
 - Payment By Your Agency Not Likely Beyond PCT Cost
- Who Will Prosecute?
 - Can Your Legal Office Take Responsibility?
- Are You Ready To Market Now?
 - Only 30 Months Available.

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- Is Importation of Foreign Manufactured Product Possible?
 - Significantly effects desirability
 - Products to be Sold in the US Must Be Manufactured in the United States
 - Watch your agencies approach – 37 CFR 404
- Non-US Markets Available?
 - Will US market invention fit into non-US commerce
 - Watch Non-US regulation
 - Watch for reverse, US product solves Foreign Regulatory Problem
- North America – a Navy approach
 - US, Canada, Mexico
- EPO
 - 28 countries, single office, individual registration
- Watch ITAR and Commerce Export Regulations
 - OP Sec issues, ITAR, and Export Regs all apply
 - Not your problem but work with your Licensee

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- Patent Cooperation Treaty Application
 - Requires Separate Application for US Application
- Must be Filed Within 12 Months of US Application to keep US Filing Date as a Priority Date
- Begin Marketing Immediately to Provide Enough Time
 - Expect Multiple Attorneys to Review
- Look for US Firms with International Reach
- Consider Separate Advertisement for US and Foreign Right or Rights.

From Science to Solutions™

- Ask For Help
 - TechLink can provide significant Assistance
 - Identifying potential licensees
 - Assisting in Designing an Evaluation Scheme
- More Than Usual Communication Will Be Required
 - Non-US License is Outside Usual TT Statutory Duties
 - Less Statutory Push for Foreign Licensing
 - Management Sees More Perceived Risk
- Watch Long Term Management Issues
 - Maintenance Fees
 - Royalty Payments
 - Enforcement.

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- Internationalization of Markets Will Continue
 - Foreign Sourcing Now Rampant so Watch Where Parts are Made
- Planning for Foreign Licensing Strengthens your Options
 - More value to your technology
 - Perhaps your licensee will be find Foreign Sub-Licensees
- Look for US Licensees who Might Want Foreign Rights
 - Ease of Administration
 - Less R&D Costs
 - Less Paper
- Pay More Attention to Enabling Disclosures to Avoid Loss of Foreign Rights
- Learn ITAR rules.

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