

## IP RIGHTS IN 30 DAYS

Filing a patent application in Geneva can quickly solve an IP emergency in the U.S. —By Joe Berghammer

**W**e all know what miracles a Swiss bank account can accomplish, but how about a Swiss patent application? It can give an American company patent rights in 30 days.

Consider this scenario: A U.S. cereal company has a ton of new cereal sitting in a warehouse waiting to be shipped to retail locations across America. This cereal includes flakes that are low in carbohydrates, but high in protein—a novel combination that could make the company millions of dollars. But since the average U.S. patent application can take two to three years to issue, the cereal might be copied the minute it hits grocery store shelves. Competing products galore would sit beside it within days.

It's a challenge that many U.S. companies regularly face. When time is of the essence, how do they take a new product to market while ensuring that it is protected from copycats? The answer for many companies lies in filing a patent application in Switzerland.

A few years ago legislation was passed allowing U.S. patent applications to be published. Once the application is published, a company can warn potential infringers that they're liable, upon the patent's issuance, for damages from the day the warning is received.

However, publication can sometimes take too long. U.S. applications generally publish in about 18 months. With a request for early publication, the time frame can be reduced to about four to six months. That's still enough time for competitors to gain a foothold among consumers, and millions of dollars in infringing sales.

This is where the Patent Cooperation Treaty comes in. Patent applications published under the treaty through any international receiving office (including the office in Geneva) benefit from U.S. laws regarding publication. Many receiv-

ing offices are more efficient at publication of applications than the U.S. Patent and Trademark Office, and the fastest is in Switzerland. Companies knowledgeable of this difference can use it to their competitive advantage.

By following the seemingly odd route of filing an international patent application in Geneva, our cereal company, and hundreds of other companies facing similar dilemmas, can get things turned around in 30 days.

After filing in Geneva, patent lawyers need to monitor the patent application's progression. Know-how and attention to details are essential, but so is a little tender loving care. Intellectual property lawyers must practice a "follow-up and follow-up again" philosophy when work-

ences and expectations: The Swiss Receiving Office, for example, has a predilection for electronic communications.

In one instance, a client of ours, a consumer display company, became aware that a competitor had copied its new displays and was preparing a large shipment of the knock-off goods in six to eight weeks. We filed a patent application for the displays in Switzerland, and secured publication of the application in 29 days. We then notified the competitor of the application's publication. This put them on the hook for damages for the entirety of their imminent shipment.

Intellectual property attorneys are always challenged to find new ways to solve old problems, and companies today

When **time** is of the essence, how does a U.S. company take a **product** to market while **ensuring** that it is protected from copycats? The answer for many **lies** in Switzerland.

ing with international patent offices.

The standard publication time frame for international receiving offices is 18 months. However, knowing the internal procedures of the particular international office, and diligently following up, can reduce that time frame. Understanding what parts of the procedure can slow the application is vital. For example, filing a Petition to Make Special, a practice that can generally speed prosecution of the application, can actually delay its publication. Moreover, applicants should be willing to ask questions, such as how publication procedures are followed internally by particular receiving office officials, and whether additional information would speed publication. And they should be open to cultural differ-

are demanding more creative thought in addressing patent issues. The next time a demanding client needs a solution in protecting their invention quickly, don't overlook seeking help outside of the United States.

---

*Joe Berghammer is a partner at the Chicago office of Banner and Witcoff. Partner Scott Burow and associate Paul Rivard contributed to this article.*

Reprinted with permission from the September 2004 edition of IP LAW & BUSINESS. © 2004 ALM Properties, Inc. All rights reserved. Further duplication without permission is prohibited. For information, contact American Lawyer Media, Reprint Department at 800-888-8300 x6111. #025-10-04-0001