

EIP

Beyond Borders: A Backpacker's Take on Why Your Patent Strategy Needs a Global Mindset

A well-planned global patent strategy can protect your innovations, maximise commercial value, and reduce costly surprises down the line. Yet, amid the big-picture planning, it's often the small details—the formalities—that make or break your protection. It's a bit like discovering a typo in your name on a visa application just as you're about to cross into a new country: a minor oversight can quickly become a major obstacle. These procedural requirements may seem minor, but overlooking them can derail filings, delay grants, or even result in lost rights. This article explores why these formalities matter and how to manage them effectively in a global context.

Stage 1: From Invention to Initial Filing—Know Your Inventors

Before initiating any patent filing, it is essential to pause and consider your inventors—not just their technical contributions, but their **citizenship and residency**. You should also consider **where your invention was devised**. These factors can significantly influence your filing strategy and, if overlooked, may lead to serious complications.

Evaluating this information is extremely important when considering where to file your application first, whether a foreign filing license should be required, and if so, from which

patent office. Getting this wrong could cause any application subsequently filed in a jurisdiction whose foreign filing rules were not complied with to be held invalid.

In most cases, patent applicants have flexibility in choosing where to file first. However, when an invention's origin intersects with national legislation, that flexibility can vanish. You may even find yourself compelled to file in a jurisdiction that holds no commercial interest, simply to comply with local law.

Let's illustrate this with the example of Greece. Under Greek law, if an invention involves a Greek national as an inventor, the first patent application must be filed in Greece—regardless of where the invention was made or the nationality of the applicant. This isn't a procedural preference; it is a legal obligation. Failing to comply could invalidate subsequent foreign filings and even trigger criminal sanctions.

Several other countries also have their own restrictions, and a helpful summary is available via the [WIPO website](#). If there's any uncertainty, seeking advice from a locally qualified representative is strongly recommended to ensure your filing strategy aligns with all relevant national laws.

This is why a global mindset is not just beneficial—it is essential. Understanding the legal landscape across jurisdictions helps avoid missteps that could derail your patent strategy before it begins. A simple check of inventor nationality and residency should be standard practice when preparing any first filing.

Getting the first filing right is only the beginning. Much like an experienced globe-trotter double-checking their travel documents before crossing a border, the next critical step is to confirm you have all the right ownership paperwork in place before venturing further on your patent journey.

Stage 2: Bulletproof Your Ownership—Don't Assume It's Automatic

Securing patent rights isn't just about filing the application—it's about **ensuring you actually own what you're trying to protect**. While many businesses assume that inventions created by employees automatically belong to the employer, this is not

universally true. **Ownership rules vary significantly between jurisdictions**, and relying on assumptions can leave dangerous gaps in your portfolio.

In some countries, rights transfer to the employer under statute, by virtue of employment, provided the invention was made in the course of what the inventor, as employee, is paid to invent by their employer. In others, explicit written agreements are required to assign rights from the inventor to the company. Even where statutory provisions exist, they may not cover every scenario—such as contractors, consultants, or employees working outside their home jurisdiction. For instance, a British inventor seconded to Japan might be considered an employee under UK law, where rights default to the employer, but still retain initial ownership under Japanese law unless clear contractual assignment and compensation provisions are in place.

Failing to address these points early can lead to disputes, delays, or even loss of rights. For example, if an inventor refuses to sign an assignment after filing, you may find yourself unable to enforce the patent in certain countries and/or sell the patent. In India, for instance, the patent office will not proceed with examination until clear ownership is established through a written assignment from the inventor to the employer. It is worth noting that these rules are not set in stone. Just as a backpacker must keep up to date with the latest entry requirements to avoid being turned away at the border, it is essential to regularly review and update your IP agreements and processes to ensure your patent rights remain secure and enforceable wherever your innovation journey takes you. Laws and practices evolve, and what is sufficient in one jurisdiction today may change tomorrow.

The safest approach? Check your agreements before you file. Ensure employment contracts and consultancy agreements include robust IP clauses that take into account the laws of all relevant jurisdictions. Where necessary, execute separate assignment documents at the time of filing. This proactive step can save you from costly headaches later and keep your global strategy watertight.

With your essentials secured, it's time to plan your route. A seasoned traveller knows that choosing the right path—whether it is a direct flight or a scenic detour—can save time, money, and a lot of unnecessary hassle.

Stage 3: Filing Strategy—Centralise Where You Can

When it comes to expanding your protection beyond the country of first filing, the route you choose can make a big difference in cost, timing, and complexity, notably with regards to formalities. For many applicants, the **Patent Cooperation Treaty (PCT)** offers a smart solution. It allows you to file a single international application and defer filings in individual countries (such as China) or regions (such as the European Patent Office) for up to at least 30 months from the date you filed your initial patent application.

The PCT route also helps **centralise certain formalities**. For example, if there's a change in ownership or inventorship, you can record it with the World Intellectual Property Organization (WIPO)—the United Nations agency that administers the PCT—during the international phase. This avoids having to repeat the process in every national office—provided those offices recognise changes recorded with WIPO. This approach can be both more efficient and more cost-effective, reducing legal fees, translation costs, and the risk of inconsistent records across jurisdictions.

Even the best-planned itinerary can unravel if you lose track of your tickets or miss a connection. Likewise, as your patent portfolio grows, keeping every detail organised is what keeps your journey on track. From signatures and notarisation requirements to tracking deadlines and coordinating local agents, the administrative load can quickly become overwhelming—especially for large portfolios.

Stage 4: Portfolio Expansion—Master the Formalities

As your portfolio grows, so does the **complexity of keeping every detail of the formal requirements (formalities) aligned**. Each jurisdiction has its own rules, forms, and timelines—and the differences can be subtle but critical. Missing a signature, using the wrong form, or overlooking a local notarisation requirement can derail an application or

even result in lost rights. Add to that the challenge of tracking annuity deadlines, coordinating national phase entries, and ensuring ownership and inventorship records remain consistent, and the administrative burden quickly multiplies.

This is where **experienced, detail-oriented paralegals prove invaluable**. They not only manage internal processes but also act as the hub between multiple local agents, gathering the necessary documents, signatures, and confirmations to keep everything on track. Their ability to coordinate across jurisdictions ensures that local requirements are met efficiently and accurately.

When your backpack starts to fill up, every extra item counts. Staying organised and making smart choices about what to carry can make the difference between a smooth trip and an exhausting trek. When formalities are managed proactively, organisations not only reduce the risk of lost rights or costly errors, but also gain the ability to respond quickly to market opportunities and allocate resources more effectively. In this way, efficient portfolio management becomes a genuine competitive advantage, helping businesses protect their innovations when and where they need to, enabling them to operate with confidence, and stay ahead in a fast-moving global landscape.

From Cost Challenges to Strategic Solutions: EIP's Role in Global Patent Strategy Success

Building and maintaining a global patent portfolio is a significant investment, with costs arising from filings, translations, agent fees, and ongoing annuities. Yet, **with careful planning and a strategic approach, many costs can be minimised**. Centralised filings, careful checks to ensure alignment with local legal requirements, and coordinated assignments help prevent duplication and procedural errors, while strategic use of the PCT can defer expenses and provide valuable flexibility.

Think of our paralegals as the expert guides who know every shortcut, local custom, and hidden pitfall—making sure your journey is as smooth as possible, no matter how complex the route. Their expertise in managing intricate formalities, coordinating with local agents, and ensuring consistency across borders is vital to keeping costs down and portfolios secure. They proactively identify potential issues, manage deadlines, and

facilitate smooth communication between all parties, ensuring that every detail is handled with precision.

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At EIP, we combine strategic insight with hands-on expertise to help clients navigate the financial and procedural complexities of patenting all over the world. Our collaborative approach ensures your portfolio is protected and managed in a way that maximises both value and cost-effectiveness.

By Lucie Jones, Head of Client Services at EIP and seasoned backpacker