
Turning Foreign-Filed Patent Applications into Strong U.S. Patents: Key Strategies and Considerations

By Lin Li and Matthew Grady

A strong U.S. patent requires more than a simple translation of a foreign-filed patent application. Successfully converting a foreign-filed patent application into a strong U.S. patent requires meticulous drafting, strategic claim adaptation, planning for, and compliance with U.S. patent laws. The following key considerations can help enhance the quality of U.S. applications converted from foreign-filed patent application.

Decision to File Abroad First

When deciding where to file the first patent application of an invention, an applicant needs to balance various business considerations and legal restraints. Business considerations include ease of communication for the inventors who usually have other priorities such as research and product development and for the in-house team who usually manages multiple projects simultaneously.

Understanding any requirements for a foreign-filing license cannot be missed. The consequences include invalidity and even criminal penalties. Many countries require the grant of a foreign-filing license before the filing of international applications with other Offices for reasons of national security where:

- (i) Applications are filed by its nationals;
- (ii) Applications are filed by its residents; and/or
- (iii) The invention was made in the country.¹

Generally, the United States, China, and Japan require foreign-filing licenses for inventions made in the country; United Kingdom, Republic of

Korea, and several Southeast Asia countries (India, Singapore, Malaysia, and Vietnam) require foreign-filing licenses for Applications by residents; and Germany requires foreign-filing licenses for Applications containing state secrets.² Failure to obtain foreign-filing licenses can lead to invalidation of a domestic patent, and other penalties (e.g., fines, imprisonment), and in some countries, it may not be possible to remedy a violation.

While an applicant may file a first patent application of an invention abroad, they often want to secure strong U.S. patent(s) based on the foreign-filed patent application for both defensive and offensive purposes. For example, an applicant sells products or provides service in the United States will want to protect their market share and defend against potential disputes from competitors. An applicant may also want strong U.S. patent(s) that can support potential assertions that leverage the robust U.S. court system or support licensing opportunities.

Adapting the Specification to U.S. Standards

A patent application with a well-written specification leads to strong U.S. patent(s). Converting a foreign-filed application requires careful consideration of U.S. standards to ensure strong U.S. protection and compliance.

Providing a Clear Context and Narrative Around the Invention

It is imperative for a U.S. application to include a narrative that establishes the technical context, technical problem solved, and inventive contribution. Describing not only the invention but also the reasons behind its development and the problems it solves can be instrumental in both the prosecution phase and post-grant defense. Care should be taken to not overly limit your disclosure, while balancing the need for these invention story elements.

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One key advantage of a narrative is its role in addressing obviousness and eligibility rejections. It can help differentiate the invention by highlighting its unique technical contributions and practical applications. This approach is particularly important when responding to Office Action rejections and can increase the likelihood of a successful outcome. Additionally, it strengthens the enforceability of a granted patent, making it more resilient against invalidity challenges.

This is especially critical for inventions in fields like software and artificial intelligence (AI), where patents are more susceptible to eligibility challenges. Emphasizing specific practical applications and technical improvements – rather than broad theoretical concepts – can enhance the patentability, enforceability, and commercial value of an invention in the U.S. market.

Avoiding Added Matter Issues

U.S. patent law does not allow adding new matter post-filing. This restriction underscores the importance of drafting the original application with sufficient detail to provide flexibility for later prosecution. When filing a U.S. application based on a foreign priority application, ensure that the original filing contains comprehensive descriptions, alternative embodiments, and fallback positions that can be utilized if amendments become necessary. This approach provides room to maneuver during prosecution without risking rejection due to lack of written description and strengthens the resulting patent's enforceability.

Avoiding Unintentional Claim Narrowing

One common pitfall is the use of limiting language, such as phrases like “the present invention” or “it is an objective of the present invention to . . .” These expressions can inadvertently restrict the scope of the claims by implying that the invention is limited to specific embodiments. Instead, a more flexible approach is to describe the invention in broader terms, allowing for a range of potential variations and applications.

Another key consideration is the drafting of the background section. Under U.S. patent law, statements made in the background may be treated as admitted prior art. To avoid unintentionally limiting the invention's scope, applicants should avoid

explaining the shortcomings of conventional approaches or detailing the inventors' specific problem-solving path in the background section. Instead, the background should be drafted in a neutral manner, providing general industry context without making concessions that could be used to challenge patentability and validity of the resulting patent.

Avoiding Issues from Literal Translations

Literal translations from non-English patent filings can introduce ambiguity or improper terminology, which may weaken the U.S. application. Differences in legal and technical terminology between jurisdictions can result in unintended limitations or unclear claim language, potentially affecting the scope and enforceability of the patent.³

Working closely with U.S. patent attorney to refine the language mitigates these risks while maintaining priority rights. A careful review and adaptation of the application ensures that key technical terms align with U.S. patent standards while preserving the original invention's intent. Proactively addressing translation-related pitfalls can enhance clarity, strengthen claims, and avoid unnecessary prosecution hurdles.

Collaborative Drafting for Key Applications

For high-value patent applications, those with potential for assertion or licensing, a collaborative drafting approach may help ensure a strong and adaptable filing. Working closely with both U.S. and foreign patent attorneys helps create a robust application that aligns with the legal requirements and strategic considerations of multiple jurisdictions. This collaboration ensures that the patent not only secures broad protection but also remains enforceable and defensible across different legal systems.

Involving attorneys from key markets early in the drafting process can proactively address jurisdictional differences in patentability standards, claim scope interpretation, and enforcement strategies. A well-coordinated effort allows for claims and descriptions to be structured in a way that maximizes coverage while minimizing risks of rejection or future invalidity challenges. This approach ensures the application is both legally sound and strategically positioned for global protection, especially for patents that are expected to be commercialized, licensed, or enforced.

Careful Claim Drafting for U.S. Protection

Claims define the scope of an invention's protection, and each jurisdiction applies different rules to their interpretation and fees. For instance, some jurisdictions may charge based on claim quantity, while others, including the United States, permit a certain number of claims without imposing excess claim fees. Additionally, whereas certain jurisdictions count multiple dependent claims as a single claim for fee purposes, the United States counts each dependency separately. Another key distinction lies in disclosure requirements – while some jurisdictions mandate literal support in the specification, the United States applies a more flexible “reasonable support” standard.⁴ Understanding these differences is essential for effective claim drafting and securing robust protection in the United States.

Drafting Diverse Claims

A diverse set of claims varies in scope and format. The U.S. allows three independent claims and twenty claims in total without charging any excess claim fees. Applicants should utilize both independent claims and dependent claims to focus on different inventive aspects of the technology, using varied claim language to capture broader protection. This approach strengthens a patent portfolio by making it more resilient to invalidation and better suited for enforcement.

Different claim types include apparatus, method, and system claims, and each type is used to protect the technology from multiple angles to increase the chances of detecting and preventing potential infringement. For example, method claims may be useful when targeting infringing activities performed as part of a software-based process, whereas system or apparatus claims can be beneficial for asserting rights over hardware implementations. Tailoring claim sets to various aspects of the invention and considering the perspectives of various potential infringers including detectability can build a more robust patent strategy.

Patentable Subject Matter Differences Across Jurisdictions

Patentability requirements for certain types of inventions vary across jurisdictions, particularly for software, business methods, and biotechnology. In some regions, such as Europe and China, patent

offices impose stricter limitations on these categories. As a result, applicants may need to narrow claims in foreign filings to meet local legal standards.

However, U.S. patent law applies different requirements, which may be considered more flexible in some respects, allowing broader claims in certain technology areas. If foreign claims were restricted due to jurisdictional constraints, applicants should consider expanding claim scope in the U.S. application, provided there is adequate support in the original disclosure. This strategic adjustment can maximize the strength of the protection in key markets.

Crafting a Prosecution Strategy for the USPTO

A well-planned prosecution strategy is key to successfully navigating the U.S. patent system. Unlike some foreign jurisdictions, the U.S. Patent and Trademark Office (USPTO) offers unique procedural tools, such as examiner interviews and continuation applications. Leveraging these options effectively can streamline prosecution while ensuring optimal protection in the United States.

Leveraging Examiner Interviews and Specific Information Available on U.S. Examiners

One of the most valuable tools in U.S. prosecution is the ability to conduct examiner interviews, a practice not always available in foreign patent offices. These interviews provide a direct opportunity to engage with the examiner, clarify any misunderstandings, and address potential rejections more efficiently. By discussing claim language, prior art concerns, or technical details upfront, applicants can often resolve issues that might otherwise lead to prolonged written exchanges. This proactive approach can significantly expedite prosecution and improve the chances of securing commercially valuable claims. Statistics are available for U.S. Examiners and should be used to plan targeted strategies.

Avoiding Undesirable Narrowing of Claim Scope

During prosecution, applicants should be strategic with their arguments and amendments to avoid unintentionally narrowing claim scope. Any statements made on the record can later be used to limit

claim interpretation, potentially reducing enforcement strength. Instead of making unnecessary concessions, applicants should focus on emphasizing the technical advantages and distinguishing features of their invention. Thoughtful claim drafting and precise responses can help secure enforceable claims.

Utilizing the Continuation Practice

Continuation practice is an often-overlooked tool by some foreign applicants, particularly those from China, where patent law typically allows only a single divisional application. However, in the United States, continuation applications offer significant flexibility, enabling applicants to refine or expand claim coverage over time. By keeping a continuation application pending, applicants can adapt their patent strategy to evolving market conditions, competitor activities, or enforcement needs. This approach ensures that valuable aspects of the invention remain protected and that future claim

adjustments remain possible without losing the original filing date.

Conclusion

The transition from foreign-filed patent applications to strong U.S. patents requires more than just translation – it involves strategic adaptation, legal compliance, and a well-planned prosecution approach. To maximize enforceability and commercial value, it is recommended to consult a patent attorney who can provide guidance on drafting strategies, patent quality, and U.S.-specific legal nuances.

Notes

1. https://www.wipo.int/pct/en/texts/nat_sec.html.
2. *Id.*
3. *IBSA Institut Biochimique, S.A. v. Teva Pharm. USA, Inc.*, 966 F.3d 1374 (Fed. Cir. 2020).
4. *Ariad Pharmaceuticals, Inc. v. Eli Lilly & Co.*, 598 F.3d 1336 (Fed. Cir. 2010) (en banc).

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