



## UK PATENTS (Part I)

### What is a Patent?

A Patent is a legal, territorial monopoly giving an inventor (or his employer) the exclusive right to make, sell, import or otherwise use his invention in the territory in question.

### What conditions does an invention have to satisfy to be patentable in the UK?

To be patentable in the UK, the invention must be new at the date of filing a UK Patent application. This means that the invention must not have been made available to the public by the inventor or any other party. It is therefore important to consider whether a UK patent application should be filed before going to market or otherwise publishing the invention. The invention must also be sufficiently different to what is already known so as to be more than an obvious development.

### Procedure

The procedure for securing grant of a Patent in the UK can be broadly divided into four stages -filing, search, publication and prosecution.

#### 1) Filing

The first stage is to file a Patent application at the UK Patent Office consisting of at least a description of the invention and drawings (if appropriate). Filing a Patent application in the UK generates a "UK filing date" from which runs a "priority year". On or before the first anniversary of the UK filing date, further action must be taken to keep the application alive. If Patent protection abroad is required, this would normally be applied for on or before the first anniversary of the UK filing date and further details are given on our procedures section entitled "Foreign Patents".

During the priority year, the UK Patent Office makes no examination of the application until such time as a "Search Request" is filed (and a search fee paid) together with Patent Claims and an Abstract. This may be done at the time of filing the application but must be done on or before the first anniversary of the UK filing date. In some cases, it is advisable to file the Search Request on filing the application. If there are any improvements or modifications to the invention during the priority year, these may be included in a second UK Patent application. The second UK Patent application claims priority from the first UK Patent application and is entitled to the UK filing date of the first UK Patent application for subject matter which is common to both applications.

#### 2) Search

After a Search Request has been filed and the search fee paid, a Search Examiner at the UK Patent Office conducts a search through previously published Patent specifications and a limited range of other literature to identify published documents which may be relevant to the patentability of the invention. A search report listing these documents is sent to the applicant (together with a copy of the documents) about three months after the Search Request has been filed. The search report may be used to assess the prospect of the Patent application being granted.



### **3) Publication**

Approximately eighteen months after the UK filing date, the Patent application is published together with the search report. If the search report was favourable and the prospect of securing a granted Patent seems good, the applicant may decide to proceed to "prosecution".

### **4) Prosecution**

Within six months of the date of publication of the application, an "Examination Request" must be filed and an examination fee paid.

The application is allocated to a UK Patent Office Examiner who will in most cases issue an "Official Letter" detailing any objections to the application. Objections which may arise are that the invention is not new or is merely an obvious departure from what is already known. Working closely with his Patent Attorney, the applicant may choose to instruct his Patent Attorney, to prepare and file a response to the objections or amend the application to overcome the objections. There may be several exchanges of correspondence between the Examiner and the applicant's Patent Attorney, and this procedure is often referred to as prosecution. The costs of prosecution will depend on the time spent by the Patent Attorney. It is possible to combine the search and examination stages by filing the Search Request and the Examination Request at the same time. This variation of normal procedure may be useful if the applicant requires a Patent to be granted earlier than would otherwise be the case.

### **Grant of the Patent**

On successful completion of the prosecution stage, the UK Patent application is formally accepted and the application in its accepted form is published as a granted UK Patent. Typically this takes place some three to four years after the UK filing date.

### **Renewal Fees**

On the fourth and each subsequent anniversary of its UK filing date, renewal fees become payable annually to maintain the granted UK Patent in force.



## **UK PATENTS (Part II)**

### **Pre-Filing Searches**

We can also arrange (or assist you with) pre-filing searches through Patent literature to assess whether an invention is new. Such pre-filing searches may be worthwhile when a number of Foreign Patent applications are contemplated or substantial investment in a new plant is planned.

The results may give some reassurance as to the patentability of the invention before significant finances are committed to the project.

### **Litigation and Insurance**

The costs of Patent litigation in the UK are high. Whilst the vast majority of UK Patents are never involved in litigation, the inventor or small company with limited funds may wish to insure against the costs of Patent litigation. Insurance is available to assist with the legal costs of instigating a Patent action or of defending a Patent action. We can supply further details on request.

### **Costs Relating to the Filing and Prosecution of a UK Patent Application**

Your bill is calculated from disbursements (e.g., Patent Office fees, draughtsman's charges, foreign correspondents' charges, telephone, copying, fax and travel costs), service charges (a flat rate administrative charge specific to the particular job done and covering mainly clerical matters) and a charge for the professional time spent on the matter. With regard to the latter, this is calculated by recording all time spent (whether on the telephone, in meetings, preparing documents or otherwise dealing with your file). Thus, most of our charges can only be estimated as they depend largely on the time spent.

Granted Patents are subject to payment of annual renewal fees to maintain the Patent in force -details of specific renewal costs can be obtained on request.

We estimate typical cost ranges for matters of average complexity. Occasionally a case may involve considerably more work on our part than average, and the costs may in such a case exceed the upper limit stated.



## PATENTS OUTSIDE THE UK (GENERAL)

### Procedure

The procedure for securing grant of a non-UK Patent can be broadly divided into four stages -filing, search, publication and prosecution. There are three routes available for filing an application:

- (I) filing separate national Patent applications in each foreign country where protection is desired;
- (II) filing a European Patent application designating one or more European countries where protection is desired; or
- (III) filing an International (PCT) Patent application designating one or more countries or regions worldwide where protection is desired.

Filing a first Patent application in the UK generates a "UK filing date" from which runs a "priority year" (see procedures sheet entitled "UK Patents"). An application for a foreign Patent by whichever route should be filed on or before the first anniversary of the UK filing date to claim the benefit of the UK filing date.

Each route is discussed briefly below.

Most foreign Patent Offices require payment of periodic (usually annual) renewal fees to maintain the granted foreign Patent in force. In addition, some countries or regions (notably the European Patent Office) require payment of annual renewal fees on pending Patent applications.

No renewal fees are payable on a PCT patent application.





## NATIONAL PATENTS (NON-UK)

A national Patent application may be filed at the local Patent Office of a foreign country in the local language.

After filing, a local Patent Office searcher may conduct a search through previously published patent specifications (and possibly a limited range of other literature) to identify published documents which may be relevant to the patentability of the invention. A search report listing these documents is normally sent to the applicant (together with a copy of the documents).

In most foreign countries, the application is published shortly after the search report has been completed. If the search report was favourable and the prospect of securing a granted Patent seems good, the applicant may decide to proceed to examination. In some countries, it is necessary to file an "Examination Request" (and pay an examination fee) within a specified period. Provided these requirements are fulfilled, the application will be allocated to a local Patent Office examiner for examination.

The local Patent Office examiner will in most cases issue an "Official Letter" detailing any objections to the application. Objections which may arise are that the invention is not new or is merely an obvious departure from what is already known.

Working closely with his Patent Attorney, the applicant may choose to instruct his Patent Attorney to prepare and file a response to the objections or amend the application to overcome the objections. There may be several exchanges of correspondence between the examiner and the Patent Attorney and this procedure is often referred to as prosecution. The costs of prosecution will depend on the time spent by the Patent Attorney.

Once examination has concluded and the examiner's objections have been overcome, the local Patent Office will formally accept the application and subject to payment of various fees (such as grant and/or printing fees), the Patent will be granted and a certificate of grant (the "Letters Patent") will be sent to the applicant. After grant, annual renewal fees will become payable. In some countries, renewal fees become due before grant.

It should be borne in mind that in seeking to secure grant of a national Patent application in a foreign country, it will be necessary to appoint a local attorney to be responsible for the procedure in their country. For this purpose, we have an established network of local attorneys to assist us in carrying out our clients' instructions in foreign countries. Further details are available on request.



## EUROPEAN PATENTS

A European Patent application may be filed at the European Patent Office in English and can designate any of thirty-eight states which are party to the European Patent system, or which recognise European Patents. These are currently:

Albania, Austria, Belgium, Bosnia & Herzegovina, Bulgaria, Croatia, Cyprus, Czech Republic, Denmark, Estonia, Finland, France, FYR Macedonia, Germany, Great Britain, Greece, Hungary, Iceland, Ireland, Italy, Latvia, Liechtenstein, Lithuania, Luxembourg, Monaco, Malta, Netherlands, Norway, Poland, Portugal, Romania, Serbia, Slovakia, Slovenia, Spain, Sweden, Switzerland, and Turkey.

Approximately three months after filing a European Patent application, a European Patent Office searcher conducts a search through previously published patent specifications and a limited range of other literature to identify published documents which may be relevant to the patentability of the invention. A search report listing these documents is sent to the applicant (together with a copy of the documents). The application is published normally after the search report has been completed.

If the search report was favourable and the prospect of securing a granted Patent seems good, the applicant may decide to proceed to examination. For this purpose, it is necessary to file an "Examination Request" and pay an examination fee no later than six months after publication of the search report. By the same date, it is also necessary to pay a "Designation Fee" for each designated European country in which Patent protection is desired (although there is no fee for the eighth and each subsequent designated country).

The application is allocated to a European Patent Office examiner who will in most cases issue an "Official Letter" detailing any objections to the application. Objections which may arise are that the invention is not new or is merely an obvious departure from what is already known.

Working closely with his Patent Attorney, the applicant may choose to instruct his Patent Attorney to prepare and file a response to the objections or amend the application to overcome the objections. There may be several exchanges of correspondence between the examiner and the Patent Attorney over a number of years and this procedure is often referred to as prosecution. The costs of prosecution will depend on the time spent by the Patent Attorney.

Provided that all objections are eventually overcome, the European Patent Office will issue a formal notification of acceptance. The application will proceed to grant, subject to payment of various fees and filing of translations of the accepted claims into French and German.



Shortly after the European Patent Office issues the formal "Decision to Grant", various steps must be taken at the local Patent Office of each designated European country in which the applicant desires the European Patent to take effect. For this purpose, a local language translation (if appropriate) of the accepted text must be prepared and filed at the relevant local Patent Office by an appointed local Attorney. The cumulative costs will reflect the number of countries and the length of the accepted text to be translated. Each separate national phase patent must then be maintained by paying annual renewal fees.

On balance, where Patent protection is desired in three or more European countries, a European Patent application is generally more cost effective than three separate national foreign Patent applications.





## INTERNATIONAL (PCT) PATENT APPLICATIONS

An International Patent application may be filed in English at the UK or European Patent Office and automatically designates over one hundred and thirty countries, as well as a number of regional treaty organisations (including the European Patent Organisation).

Shortly after filing the International Patent application, a European Patent Office examiner is appointed to conduct a search through previously published patent specifications and a limited range of other literature to identify published documents which may be relevant to the patentability of the invention. The International Search Report listing these documents is sent to the applicant together with a copy of the documents and a non-binding Opinion on the patentability of the invention.

The International Patent application is published and by a specified date the applicant must decide whether or not to proceed with the optional procedure of International Preliminary Examination, and payment of the International Preliminary Examination fee.

By a specified date which varies from country to country, but usually 30 months from the priority date, the International Patent application must be split into separate Patent applications in each country or region in which Patent protection is desired. Various formalities must be fulfilled in each country or region and may include the requirement for a local language translation to be filed at the local Patent Office.

Having split the application into separate Patent applications in the countries or regions of interest, the International Patent application ceases to exist. The separate national or regional Patent applications continue in the manner described above for national or European Patent applications.

The most up-to-date list of PCT Contracting States can be found on the World Intellectual Property Organisation (WIPO) website. Most major industrialised countries are members. The filing of an international patent application very effectively "buys" time and the option of continuing patent prosecution in a large number of countries. This enables the high cost of international filing to be delayed, e.g., until the commercial viability of the product has been tested in the marketplace.



## **PATENT COSTS OUTSIDE THE UK**

Your bill is calculated from disbursements (e.g., Patent Office fees, draughtsman's charges, foreign attorney's charges, telephone, copying, fax and travel costs), service charges (a flat rate administrative charge specific to the particular job done and covering mainly clerical matters) and a charge for the professional time spent on the matter. With regard to the latter, this is calculated by recording all time spent (whether on the telephone, in meetings, preparing documents or otherwise dealing with your file). Thus, most of our charges can only be estimated as they depend largely on the time spent.

Granted patents (and in some cases pending applications) are subject to payment of annual renewal fees to maintain the patent in force - details of specific renewal costs can be obtained on request.

