



Fact Sheet

Patent Procedures & Costs

International



Procedure

The procedure for securing grant of a foreign patent is generally similar to that for UK patents and can be broadly divided into five stages - filing, search, publication, examination and grant. There are three routes for filing an application following on from the filing of a UK patent application:

National Applications - filing separate national patent applications in each country in which protection is required;

PCT Patent Application - filing an International or “PCT” application designating one or more countries or regions worldwide where protection is required; or

European Patent Application - filing a European patent application designating one or more European countries where protection is required.

These are each discussed briefly below. Filing a first patent application in the UK generates a “priority date”. The priority date marks the beginning of a “priority year”. An application for a foreign patent, by whichever route, must be filed before the end of the priority year to claim the benefit of the UK filing date.

National Patent Applications

A national patent application will need to be filed locally at the national Patent Office of each foreign country in which protection is required and in the local language. Therefore, assuming that the patent specification has been prepared in English, enough time needs to be allowed for the specification to be translated.

After filing, the national Patent Office typically conducts a search through previously published patent specifications (and possibly a limited range of other literature) to identify published documents that may be relevant to assessing whether a patent should be granted for the invention. You may be required to disclose details of earlier patent documents that you know are relevant to the invention. The application is then examined on the basis of the search results. In most cases an “official letter” will issue detailing any objections to the application. Typical objections

are that the invention is not new or is merely an obvious combination of what is already known. In many jurisdictions, the search and examination are conducted in a single stage.

Working with you, and with your input on technical issues, we will prepare and file a response to overcome the objections, which may include arguments, amendments or a combination. There may be several exchanges of correspondence with the examiner and this procedure is often referred to as prosecution. The costs of prosecution will depend on the time spent by us in dealing with the objections.

Once 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 you.

After grant, renewal fees will become payable each year to keep the patent in force. In some countries,

renewal fees are also payable while the application is pending before grant. Renewals may be handled by Computer Patent Annuities Limited (CPA), a company which specialises in renewal matters, or by ourselves.

You should bear in mind that in applying for patent protection in a foreign country, we must appoint a local patent attorney in that country to handle the application on your behalf. For this purpose, we have an established network of local firms. Further details are available on request.

International (PCT) Patent Applications

An International Patent application may be filed in English either at the UK or European Patent Office, and may designate any of over 150 countries or regions (including the UK). The most up-to-date list can be found on the World Intellectual Property Organization (WIPO) website at www.wipo.int. Most major industrialised countries are members of the organization.

Once the International application has been filed, an examiner from the European Patent Office is appointed, on behalf of WIPO, to conduct a search through previously published patent specifications and a limited range of other literature to identify published documents which may be relevant in assessing whether to grant a patent for the invention. A report is collated, which includes the results of the search and the examiner's preliminary opinion on the patentability. The International Search Report is sent to the applicant, together with a copy of the documents identified and the preliminary opinion.

The International Patent application is published at around 18 months from the priority date. You can then decide whether or not to request a more detailed examination of the application. This may be appropriate if you consider that amendment to the application, or the submission of arguments, may assist to reverse a negative preliminary opinion accompanying the International Search Report.

By a specified date, which varies from country to country, but which is usually 30 or 31 months from the priority date, the International application must be split into separate patent applications in each country or region in which patent protection is

required. Various formalities must be fulfilled in each country or region, which may include the filing of a local language translation at the local Patent Office.

Once the application has been split into separate patent applications in the countries or regions of interest, the International phase of the application is complete. The separate national or regional patent applications continue to be examined in the usual way by local patent office examiners.

The filing of an international patent application effectively "buys" time (up to 31 months) that maintains the option of patent protection in a large number of countries. This enables the high cost of filing patent applications in multiple countries to be deferred until the commercial viability of the invention has been tested in the marketplace.

European Patent Applications

A European patent application may be filed in English at the European Patent Office (EPO) and can designate any of 31 states which are parties to the European Patent Convention (EPC), and protection can be extended to five other countries. Protection via the EPC is currently available in: Albania, Austria, Belgium, Bulgaria, Bosnia, Croatia, Cyprus, Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Iceland, Ireland, Italy, Latvia, Lithuania, Luxembourg, Macedonia, Malta, Monaco, Netherlands, Portugal, Poland, Romania, Serbia, Slovak Republic, Slovenia, Spain, Sweden, Switzerland (including Liechtenstein), Turkey and the UK.

Some four to five months after filing a European patent application, an Examiner at the EPO conducts a search through previously published patent specifications, and a limited range of other literature, to identify published documents which may be relevant in assessing whether to grant a patent for the invention. A search report listing these documents is sent to you, together with a copy of the documents identified. The search report may be used to assess the prospect of commercially useful patent rights being granted.

The application is published approximately 18 months after the priority date of the application. If the search results are available at this time, then these will be published with the application. Otherwise,

they will be published separately. If the search report is favourable, and the prospects of having a commercially useful Patent granted seem good, then you may decide to proceed with examination. If so, it is necessary to file an examination request and pay an examination fee no later than six months from the publication of the search report. By the same date, it is also necessary to pay a “designation fee” for each EPC country in which patent protection will be required

The application is allocated to an examiner who will review the application in light of the “prior art” documents identified in the search. If the examiner does not consider that the invention defined in the claims is patentable, or if there are other objections to the application, then an official letter will be sent to you detailing the objections to the application. Typical objections are that the invention is not new or is merely an obvious combination of what is already known.

With your input on technical issues, we will prepare and file a response to overcome the objections that may include arguments, amendments to the application or a combination. There may be several exchanges of correspondence between us and the examiner, and this procedure is often referred to as prosecution. The costs of prosecution will depend on the time spent by us in dealing with the objections.

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

The EPO then issues the formal “Decision to Grant”. Steps must be taken at the local Patent Office of each designated European country where patent protection is required. A local language translation of the text of the patent may need to be prepared and filed at the relevant local Patent Office by an appointed local Attorney. The cumulative costs of these steps depends on the number of countries and the length of the text to be translated.

After grant, the European patent must be maintained in each country by paying annual renewal fees to the local Patent Office. Renewals may be handled by Computer Patent Annuities (CPA), a company which specializes in renewal matters or by ourselves.

Costs

National Patent Applications

- Preparation and filing of a patent application in an English language country - variable from £1200 to £2500
- Preparation and filing of a patent application in a non-English language country - variable from £1800 to £3500
- Prosecution - variable, but typically £400 to £3000

NB. Prosecution costs in the USA can be unusually high, and if the application is accepted, a substantial issue fee has to be paid before the patent is granted.

Costs in some non-English language countries, such as Japan, can be higher than the guide figures given above, in view of the cost of translating documents, once the application has been filed.

International Patent Application (PCT)

- Filing the PCT application - £3000 to £3500
- Reporting the results of the search - £125 to £350
- Reporting publication - £75
- Requesting International Preliminary Examination - £1800
- National/regional phase entry:
UK - £800
EPO - variable, around £2500
Other countries - from £1250 per country

European Patent Application

- Filing the European application, variable but typically - £2500
- Reporting the results of the search - £125 to 250
- Reporting publication - £75
- Requesting examination and confirming designated states - £2000
- Prosecution - variable, typically around £1000 to £3000
- Grant formalities - variable, typically around £1600 to £2000
- Validation - variable, typically around £1000 to £2000 per country

All amounts indicated are in Pounds Sterling and

include any official fees payable. The amounts are exclusive of VAT, which is usually recoverable if you are VAT registered. Costs are approximate, and will vary depending upon the complexity of the case.

Our Services

Services are provided to you by Urquhart-Dykes & Lord LLP, and the contract under which those services are provided is with Urquhart-Dykes & Lord LLP and not with any individual member, employee or agent of Urquhart-Dykes & Lord LLP. Acceptance of our commencement of the provision of services to you shall be deemed to be acceptance of our Terms of Engagement (a copy of which can be provided on request, or can be viewed on our website at www.udl.co.uk).

During our work for you we may need to instruct third parties (for example, patent and trade mark attorneys in other countries, or searchers) to act on your behalf. We might instruct such parties directly on your behalf. Alternatively you might need to sign a power of attorney or similar appointment to engage such third party. Any such party is not part of Urquhart-Dykes & Lord LLP. While we shall endeavour to select third parties of appropriate good standing, we shall not be responsible for any default or negligence by such third parties.

Our charges are based principally on the amount of our professional time spent on the matter. Our hourly rates are determined with reference to the seniority and experience of the professional staff involved. These rates are reviewed periodically. Charges are calculated at hourly rates which apply when the work is carried out. There may be additional charges where a matter is complex or urgent or is one for which highly specialised knowledge is required. We might apply tariff charges to specific tasks such as the filing of a patent or trade mark application.

In appointing us to act on your behalf, you are also authorising us to incur such expenses as we consider necessary to carry out your instructions properly and agreeing that you will reimburse us in respect of those expenses. Examples of such expenses are Patent Office fees, fees of Counsel and other experts, Court fees, and the costs of third parties (for example patent attorneys in other countries, experts, searchers and translators) who we instruct

on your behalf. They might also include such items as photocopying costs, courier charges, travel, accommodation and meeting expenses, telephone and fax charges. While our fixed charges and hourly rates are predictable, you should appreciate that many expenses are outside our control since they might be changed without notice and (in the case of foreign matters) vary with exchange rate fluctuations.

Any estimate of likely costs we provide (whether included in this sheet or in response to a request) is given only as a guide to assist you in budgeting, and should not be regarded as a firm quotation or a fixed or capped fee unless otherwise agreed in writing. Any costs given by us are net of VAT which will be charged as applicable on our fees and those expenses that are liable for VAT.

These notes are provided for guidance only, and do not deal with specific problems. For further information, please visit our website at www.udl.co.uk or contact one of our offices :

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