



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”. A separate Fact Sheet sets out the procedures and costs for filing and obtaining a UK patent. 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 be issued 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 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 CPA Global (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 European state which is party to the European Patent Convention (EPC). The most up-to-date list can be found on the EPO website at www.epo.org. The EPC is separate from the European Union (EU) and its membership is different.

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 combined with a country “designation fee” no later than six months from the publication of the search report.

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 claims or of the full 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.

The patent can be opposed by any interested party after grant, under certain grounds. Relatively few granted patents are opposed, but you should be aware of the possibility. An opposition proceeding can lead to revocation of the patent or a limitation to the scope of the claims, but often the patent is maintained and the opposition refused.

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 CPA Global (CPA), a company which specializes in renewal matters or by ourselves.

Costs

For an idea of the costs involved in the initial drafting of a patent application, see our separate Fact Sheet on the procedures and costs for filing and obtaining a UK patent.

The costs of national patent applications depend on local fees and translation requirements, but will generally begin at about £3000 to cover costs up to grant, inclusive of official fees.

An International Patent Application (PCT) is, as discussed, a useful way of buying time. The costs prior to national and regional phase entry will be in the region of £4000, inclusive of official fees.

The cost of a European patent can be split into the pre-grant and the post-grant phases. Pre-grant costs will vary depending on professional time spent, but will begin at about £5000 inclusive of official fees. Post-grant costs depend on the translation requirements. If no translation is required, the cost for that country will be about £400. A long specification entered into a country requiring a full translation, e.g. Spain, could cost many thousands of pounds.

Costs are approximate and will vary depending on the complexity of the case.

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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.

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Contact Us

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:

Cardiff

7th Floor
Churchill House
Churchill Way
Cardiff
CF10 2HH

Tel: +44 (0) 2920 642150
Fax: +44 (0) 29 2034 0600
Email: cardiff@udl.co.uk

London

30 Welbeck Street
London
W1G 8ER

Tel: +44 (0) 20 7487 1550
Fax: +44 (0) 20 7487 1599
Email: london@udl.co.uk

Leeds

Tower North Central
Merrion Way
Leeds
LS2 8PA

Tel: +44 (0) 113 245 2388
Fax: +44 (0) 113 243 0446
Email: leeds@udl.co.uk

Milton Keynes

Midsummer House
413 Midsummer Boulevard
Milton Keynes
MK9 3BN

Tel: +44 (0) 1908 666645
Fax: +44 (0) 1908 351155
Email: milton_keynes@udl.co.uk

Newcastle

Cale Cross House
156 Pilgrim Street
Newcastle-Upon-Tyne
NE1 6SU

Tel: +44 (0) 191 261 8573
Fax: +44 (0) 191 222 1604
Email: newcastle@udl.co.uk

Peterborough

New Priestgate House
57 Priestgate
Peterborough
PE1 1JX

Tel: +44 (0) 1733 340011
Fax: +44 (0) 1733 566387
Email: peterborough@udl.co.uk

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