



Fact Sheet

Patent Procedures & Costs

United Kingdom



What is a Patent?

A patent is a legal monopoly protecting a technical innovation. A patent gives the owner, or “patentee”, a legal right which can be enforced to stop others making, selling, importing or otherwise commercially exploiting the invention covered by the patent, without the patentee’s permission. Patents are territorial and generally need to be filed on a country by country basis. These notes outline the procedure for obtaining patent protection in the UK. Details of the procedures for overseas patents are available.

What Inventions are Patentable?

To be patentable in the UK, the invention must be “novel” or “new” at the date of filing the application for a UK patent. This means that the invention must not have been disclosed (other than in confidence) either by the inventor or any other party. Therefore, if someone else has already published details of the same invention anywhere in the world, then it will not be possible to obtain a valid patent for your invention, even if you were unaware of this earlier disclosure.

In view of the novelty requirement, it is very important to consider whether patent protection is required in good time before going to market or otherwise releasing details of the invention. If you disclose details of your invention other than in confidence before filing a patent application, then you will miss out on the opportunity to obtain valid patent protection.

In addition to being new, the invention must be more than an obvious development of what is already known. That is, your invention must involve an “inventive step”.

Further inventions in certain areas, such as those which relate solely to business methods or the rules for playing a game, are specifically excluded from patent protection, even if they are new and inventive.

Who Can File a Patent Application?

The inventor of the invention has the right to file a patent application for the invention. However, if the invention was devised as part of the inventor’s employment duties, then the inventor’s employer is likely to own the rights to the invention, rather than the inventor. If more than one person worked on the invention, then the right to file any patent application may be jointly owned.

What is a Patent Specification?

A patent application must include a legal document called a patent “specification”. The patent specification sets out full details of the invention. The specification is split into a number of sections, each having a different role. These sections are the description, which can include drawings, the claims and the abstract.

The description indicates the technical field of the invention, and generally identifies the problems solved and the improvements provided by the invention. This may be done by explaining the disadvantages or shortcomings of current products or methods. The description must also describe how the invention works, and possible variations and modifications to the basic inventive concept. The validity of a patent can be challenged if the description does not provide a sufficiently detailed description of how the

invention works and how it can be made. A detailed description of at least one way of making the invention work is given in the “specific description”, which can refer to figures, flow charts or diagrams shown in accompanying drawings.

The claims define the scope of the invention protected by the patent. The main claim sets out the combination of technical features or method steps, which are essential to the invention. The remaining claims describe additional non-essential, but significant features of the invention. If granted, the claims define exactly what products or processes will be protected by the patent.

The abstract is a summary of the invention, which helps the Patent Office classify the application and assists the searching of patent documents on patent databases.

Patent Application Procedure

The procedure for obtaining a patent in the UK can be broadly divided into five main stages: filing, search, publication, examination and grant.

Filing

The first stage is to file a patent application at the UK Intellectual Property Office. The application must include a description of the invention and any drawings, but the full specification is not required, at first. Filing a patent application in the UK generates a patent application number and a UK filing date, which starts a “priority year”. Further action must be taken within twelve months of the UK filing date, if the UK application is to be kept alive. If patent protection is required abroad, then this would normally be applied for on or before the first anniversary of the UK filing date.

During the priority year, the UK Intellectual Property Office takes no further action until a request for a search is filed (and a search fee is paid) and claims and an abstract are filed. This must be done on or before the first anniversary

of the UK filing date. However, it is often advisable to file the full specification and the search request when initially filing the application.

If there are any improvements or modifications to the invention during the priority year, then these may be included in a second UK patent application. The second UK patent application can claim priority from the first UK patent application so that the second application is entitled to the filing date of the first application for subject matter which is present in both the applications.

Search

After a request for a search has been filed and the search fee paid, a UK Office Examiner conducts a search through patent documents, and a limited range of other literature, to identify documents published before the filing date of the application which may be relevant in assessing “patentability”, i.e., whether to grant a patent for the invention. A search report is sent to the applicant listing the documents found, together with a copy of the documents. Typically, the results of the search are received five to six months after the search request has been filed. The search report may be used to assess the prospect of useful patent rights being granted. If the search report is favourable, indicating that the prospects of having a useful patent granted are good, then you may decide to proceed with the application.

Publication

The patent application and search report are published approximately eighteen months after the UK filing date. This is the first time at which the public will be able to see the details of what you are trying to patent.

Examination

A request for examination of the patent application must be filed, and an examination fee paid, no later than six months after the date of publication of the application. The application

is then allocated to an Examiner who will check whether the application meets the requirements of patent law, and in particular whether the claims define an invention which is new and not obvious based on the 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 examination report is issued explaining the objections to the application. Objections which may arise are that the invention is not new or is merely an obvious combination of things that are already known.

Working closely 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 to the application or a combination of the two. There may be several exchanges of correspondence between us and the Examiner, and this procedure is often referred to as “prosecution” of the application. The costs of prosecution will depend on the time spent by us in dealing with the objections.

It is possible to combine the search and examination stages by filing the search request and the examination request at the same time. This approach can be useful if you need a patent granted earlier than would otherwise be the case.

Grant of the Patent

If the Examiner’s objections are overcome, then patent application is formally accepted. A certificate of grant of the patent is then issued and the specification of the granted UK patent is published. Typically this takes place some three to four years after the initial UK filing date.

Renewal Fees

A UK patent can protect an invention for up to 20 years from its UK filing date, but only if a renewal fee is paid every year to keep the patent in force. The first renewal fee is due on the fourth anniversary of its UK filing date. Renewal fees may be handled by a specialist firm, CPA

Global (CPA), or by ourselves.

Pre-filing Searches

We can also arrange (or assist you with) searches through patent literature prior to filing an application to help assess whether an invention is new and not obvious. Such pre-filing searches can be useful in assessing whether to incur significant future costs, such as those associated with filing foreign patent applications or investing in a new plant. The results of the search may give some reassurance as to the patentability of the invention before significant finances are committed to the project.

What about Patent Protection outside the UK?

The procedure for filing patent applications outside the UK is generally similar to that in the UK, with a separate application being filed in each country where a registration is required. A number of countries can be covered by one of the “collective” systems, such as the European Patent Convention (EPC) or Patents Cooperation Treaty (PCT) (often referred to as the International patent system). Details are available on request and a separate Fact Sheet has been produced to set out some initial procedures and to give an idea of costs.

Costs

The costs involved in the preparation of a UK patent specification for a simple invention (without claims or abstract) are typically from £2500 to £3500. Our charges are generally based on the time we spend and we can provide a more detailed cost estimate once we have discussed the project with you. After filing, it is likely to cost around another £1000 to £3000 to prosecute the application through to grant, including our time charges and the Government fees.

The costs of obtaining a patent can, in certain cases, be subject to tax relief, although you will need to obtain specific advice in this regard.

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.

Urquhart-Dykes & Lord LLP is regulated by The Intellectual Property Regulation Board www.ipreg.org.uk

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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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