

Reasons to Maintain UK Parallel Applications

When a UK patent application is first filed in the Intellectual Property Office (UKIPO), it is often followed up a year later by a European patent application or an international patent application under the Patent Co- Operation Treaty (PCT). Eventually, the PCT patent application can mature into a European patent application in the European Patent Office (EPO). When a European patent is granted, that can be made effective in the UK, as a European patent (UK). In the meantime, the first filed UK application may have been maintained.

This is often done when no change of any substance has been made to the patent specification. When there have been significant changes, it might be best to abandon the first UK filing and simply proceed with the PCT and subsequent European applications.

However, after a PCT or European patent application has been filed, there is the option to keep the UK application pending in parallel, and a decision needs to be made whether to do so or not.

Keeping it Going

Firstly, because of a “compliance period” in the UK, and the fact that examination will often start earlier, a UK application is likely to grant much sooner than a patent through the PCT and European routes. Many applicants find it of value to have a granted patent at an early stage, say two or three years after first filing, rather than four or five in the case of the PCT/EP route. For example, a granted UK patent can allow a company to make use of the favourable tax regime called the “Patent Box”. The Patent Box reduces the corporation tax due for profits derived from products covered by a granted UK patent.

A granted UK patent can also be used as a basis for accelerated examination of corresponding applications for the same invention in the US and other countries under a procedure called the “Patent Prosecution Highway”.

Furthermore, the UK application can sometimes be directed towards a specific invention that it is not desirable to maintain protection for in a parallel European application. This also provides a fall-back position if it is decided to allow the parallel application to lapse for any reason.

Finally, the cost of maintaining a UK application is not usually very much, in absolute terms compared with prosecuting and securing grant of the corresponding European patent, since most of the expense is incurred at the initial filing.

Double Patenting

Ultimately, however, maintaining parallel applications might result in a duplicate patents being granted, one by the UKIPO and the corresponding European patent granted by the EPO. So, it should be understood that if a parallel UK patent does grant, and a European application results in a European (UK) patent as well, the UKIPO may want to revoke the patent granted by them in favour of the European if they are of the view that the two patents cover the same invention.

If you are interested in maintaining a parallel UK patent application, then please let your HGF attorney know.