

General Procedure for a UK Patent Application

What is a Patent?

A Patent is a legal monopoly giving an inventor (or his employer) the right to prevent others making, selling, importing or otherwise using his invention for a maximum of 20 years. Patents are territorial and the present document relates only to the UK.

What is patentable in the UK?

To be patentable in the UK (although this applies in most countries), an invention must be new at the date of filing the first patent application describing the invention. This means that the invention must not have been made available to the public by the inventor or any other party before the date of application for a patent. It is therefore essential to consider whether a UK patent application should be filed before going to market or otherwise publicising the invention.

The invention must also be sufficiently different to what is already known so as to be more than an obvious development – it must have an “inventive step”.

Patent protection is only applicable to technical matters. Some ideas or inventions do not qualify. These include the mere discovery of a new use or property, a written or artistic or musical work (they fall under copyright, not patent protection), rules of playing a game, a scheme of doing business, a manner of presenting information, or a computer program (but many computer programs are protected through patents, so please seek full advice if an invention involves a computer program).

Our role as Patent Attorneys

Typically, we prepare the description and claims for you (called a specification) and after obtaining your approval and making any adjustments we attend to all the paperwork for submitting an application to the UK Patent Office. We keep a detailed diary for your application and seek your instructions in good time before various deadlines and significant-cost-incurring matters arise. We deal with all the formalities and correspondence with the UK Patent Office, keep you informed and seek your comments as required at each stage. We can also advise on many related matters (see below).

Generally we will charge for all our professional time on an hourly basis, although some fees are fixed amounts, e.g. the service charge for the examination fee, and for renewal fees.

Procedure

The procedure for obtaining grant of a Patent in the UK can be broadly divided into four stages – filing, search, publication and examination.

1. Filing

The first stage is to file a patent application at the UK Intellectual Property Office (UKIPO, formerly called the 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 so that priority can be claimed from the UK application. That is, the application filed abroad is treated as if it was filed on the date of filing of the first UK application, provided it is for the same invention.

During the priority year, the UKIPO makes no examination of the application until a search fee is paid and patent claims are filed. This is usually done at the time of filing the application but must be done on or before the first anniversary of the UK filing date.

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 application claims priority from the first application and is entitled to the UK filing date of the first application for subject matter which is common to both applications.

2. Search

After the search fee has been paid, an Examiner at the UKIPO 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 novelty or obviousness of the invention. A search report listing these documents is sent to the applicant about four months after the search fee has been paid. The search report may be used to assess the prospect of the patent application being granted.

3. Publication

Approximately eighteen months after the first 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 the

detailed examination stage. If the search report was unfavourable and the application is withdrawn within about 15 months of the first UK filing date, publication can be prevented.

4. Examination

Within six months of the date of publication of the application, an examination fee must be paid. The application is then allocated to a UKIPO Examiner who will issue an Examination Report 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. There may also be editorial objections.

The applicant has a time limit (usually six months) to file a response to the objections by argument that the objections are wrong or misplaced, or by amending the application to overcome the objections. There may be several exchanges of correspondence and this procedure is referred to as “prosecution of the application”.

It is possible to combine the search and examination stages by paying the search and examination fees 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 examination 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 are payable to keep the granted UK patent in force.

Protection in other countries

If patents are required to protect export markets or manufacturing interests abroad, there are three options available to obtain foreign protection:

- a) filing foreign national patent applications in each foreign country where protection is required,
- b) filing a European patent application designating one or more European countries where protection is required, and
- c) filing an International patent application under the Patent Co-operation Treaty (a “PCT application”) designating one or more countries or regions worldwide where protection is required.

Virtually all countries are party to the PCT, and to the convention which provides that an application for a foreign patent, filed on or before the first anniversary of the UK filing date, by any of options (a), (b) or (c), is treated as having effectively been filed on the UK filing date.

We can advise you more fully of the procedures and costs involved in seeking patent protection abroad.

Pre-filing Searches

We can also arrange pre-filing novelty searches through patent literature to assess whether an invention is new. Such pre-filing searches may be particularly worthwhile when a number of foreign 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.

Such a novelty search is wide-ranging, but is not targeted precisely – it uses a shot-gun approach. It is to be expected that, in such a search, any patent that might represent an infringement risk will probably be found. But no search can ever guarantee that all relevant patents have been identified. Consequently, if more certainty is required that taking certain specified commercial steps will not infringe a patent already existing, then an infringement clearance search is required. We can arrange this kind of search also.

Litigation and Insurance

The cost of patent litigation in the UK is 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.

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April 2014

Costs

Our bills comprise three components:

- a) a charge based on our professional time spent on the matter;
- b) a service charge, being a flat rate administrative charge specific to the particular job done and covering mainly clerical matters, and
- c) disbursements (e.g. UKIPO fees, draughtsman's charges, foreign attorneys' charges, telephone, copying, fax and travel costs).

Professional time 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.