



## Where to File Your Patent Applications

When seeking patent protection, most companies start with a single national patent application but may then wish to seek protection in other countries. This briefing outlines points to consider in selecting the countries to cover, the international schemes available and the timing of the decisions to be taken.

There are several advantages to filing a UK application first, even if you are not UK based. The UK Intellectual Property Office carries out searches quickly and cheaply; this can give you an indication of the patentability of your invention before you incur the costs of filing in other countries. UK applications must be filed in English (or Welsh); if your initial application is drafted in English, this can save on translation costs later on and help to avoid problems caused by poor translations when filing an international application.

Once you have filed a UK patent application, you then have a 12 month period in which to decide whether to file corresponding patent applications in other countries and, if so, which countries you wish to cover.

In most countries, an invention must have 'absolute novelty' at its filing date in order to be valid so any non-confidential disclosures, including your own, anywhere in the world prior to filing can invalidate the patent. However, most countries are part of an international convention which, in effect, enables you to back date a foreign application to your initial UK filing date if the foreign application is filed within 12 months of your UK filing date. This is a very important deadline (which cannot be extended) so you need to start thinking about the countries you want to cover in good time before this and to ensure there is time to get the applications on file before this deadline.

### Selecting Countries for Patent Protection

It should be remembered that patents provide a 'negative right', i.e. they enable you to prevent others from doing certain things in relation to the invention, e.g. manufacturing, importing, exporting or using the invention in the relevant country. So you need to decide where such rights would be useful to support your business strategy.

Filing in all possible countries would be extremely costly, so you need to consider how to optimise your geographical protection within the budget available. It may be possible to achieve a broad geographical effect by filing in just a small number of key countries. You might, for example, only need to file patent applications to the extent necessary to keep the competition from competing effectively with you.

In many cases, a good starting point is to look for protection in your main markets (or prospective markets), i.e. where you expect the majority of your revenue to be generated, and/or countries in which your main competitors are based or where they

have manufacturing facilities. If you are considering licensing the patent rights, you might also look at the main markets for licensees and where your licensees (or potential licensees) are located.

Having prepared a 'wish list' of countries, you can then seek an estimate from your patent attorney for the filing costs in those countries and advice on the most cost-effective way of covering them using the various international procedures available (see below).

You may also want to consider the scope of protection you hope to achieve from the patent and whether it relates to core technology or just an improvement. If you have any search results, e.g. from the UKIPO search on your UK patent application, these can be very helpful in deciding whether foreign applications are likely to be worth pursuing.

You can then make a commercial decision as to where patent protection should be sought, based on the cost, the likely strength of the patent case, the expected value of the business to be protected and the location of the competition.

For many businesses, the top priority is to seek protection in Europe, the USA and possibly in Japan. In some cases the BRIC countries (Brazil, Russia, India and China) may be next on the list but every case is different so you need to plan your coverage carefully in line with your business model and business strategy.

### Obtaining Protection Directly in Relevant Countries

At the end of the priority year, you can file applications directly in each country of interest and these applications will, as mentioned, claim priority from your original UK filing date (although any new material you add at this stage may only have priority from the date it is filed).

Unless you only wish to file in only two or three countries, such direct filing is rarely used as it also tends to be the most expensive option (although it can provide the quickest route to granted patents in many countries).

### PCT and EPC

There are two major international agreements that unify, to some extent, the procedure for applying for patents in a range of countries. The Patent Cooperation Treaty (PCT) unifies the initial application procedure and covers most countries in the world.

The European Patent Convention (EPC) is independent of the EU and unifies the application, examination and grant procedure for most European countries. In both systems a single application is filed claiming priority from your original UK application. Filing a PCT application enables you to defer the decision as to which countries you wish to cover until 30 months after your original UK priority date (or 31 months in some countries such as Europe). It

also defers the bulk of the national costs (including translations) to that stage. The PCT system is thus widely used as it provides more time for the commercial situation to develop so you are in a better position to decide which countries you wish to seek protection. It also defers the costs associated with national filings for an additional 18 months.

During the international stage of a PCT application it undergoes an initial search and examination procedure (for UK applicants this is usually carried out by the EPO on behalf of the PCT) and the results of this are sent to the national patent offices of the countries covered. After you enter the 'national phase' of the PCT procedure at the 30 month stage, the national offices will carry out their own searches and/or examination under their national procedures. The result of the international search and examination may assist them with this (although they are not bound by these).

A European patent application can be filed at the 12 month stage (claiming priority from your UK application) or it may be included within a PCT application (so deferred to the 31 month stage). A European application can designate all countries within the EPC and the decision (and, where applicable, the translation costs) as to which countries you wish to cover can be deferred until after the patent has been granted. The application may then become a bundle of national patents in those countries in which you choose to 'validate' the European patent. Alternatively, the patent may be validated as a unitary patent (and in some instances a unitary

patent and national validation in states that are not part of the unitary patent system may be desired). For more information on the unitary patent please see [here](#). This means that the national costs, in particular for translations, are deferred, for several years after entering the European system and not incurred until you know the patent has been granted and the level of protection it provides.

The European Patent Office will carry out an examination of the application but if the application was filed via the PCT system, this is a continuation of the examination carried out in the International stage of the PCT application (and often by the same examiner).

#### Key Decision Points

- Filing a UK patent application before any non-confidential disclosure of the invention to third parties
- Within 12 months of the UK filing date, decide whether to incur the costs of foreign applications, e.g. by filing a PCT application to keep your options open in a wide range of countries.
- Within 30 months of your UK filing date, decide which of the countries covered by the PCT application you wish to pursue further
- When a European patent has been granted, decide in which European countries you wish to validate

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