

FOREIGN PATENTS

Timing

Foreign patents must be applied for within twelve months of the filing date of your UK patent application, i.e. within the so-called "priority year". Because it may be necessary to obtain translations or instruct foreign associates, it is necessary to consider the issues well in advance of this deadline.

There are three possible ways of obtaining patent protection abroad, which may be used separately or in combination:

- (a) filing separate national patent applications in each country where protection is desired;
- (b) filing a regional patent application designating several countries: the European patent system is the most common but there are others elsewhere; and
- (c) filing an international patent application designating a number of countries or regions.

National Patent Applications

Applications are filed in each country before the end of the priority year. It is necessary to appoint an associate (a local patent attorney) in each country to take care of the filing of the application and usually to arrange for translation of the application into the local language before filing. Once on file, the applications usually go through a search and examination procedure. The strictness of the examination and the times taken for the various stages vary from country to country.

The costs involved vary considerably depending on the ease of passage of the various applications through the national patent offices. In general, however, there are high initial costs associated with this option because of the need to appoint associates and obtain translations at an early stage.

European Patent Applications

By using the regional system based at the European Patent Office in Munich, a single application may be filed in English and may designate up to 34 European countries, including all of the current EU member countries, subject to the payment of designation fees.

The application undergoes search and examination. Assuming all objections are eventually overcome, the European Patent Office indicates that it intends to allow the application, subject to the payment of a grant fee and the filing of translations of the claims in the French and German languages. This is typically at least three or four years from filing.

After grant, the European patent has to be brought into force in each of the originally designated countries where patent protection is desired. This entails instructing foreign associates to prepare and file translations of the granted patent and attend to other formalities in each country. Consequently, the costs can be high if many countries are involved, particularly if the specification is long. However, by this time it is usually clear which countries are of genuine interest. A European patent is generally cheaper to obtain than separate national patents if protection is required in three or more countries.

International Patent Applications

A single international patent application under the Patent Cooperation Treaty (PCT) is made in English and can designate a very large number of countries and regions, including Europe via the European Patent Office. The application is searched and may optionally be examined but it does not directly result in a granted patent. Instead, it must eventually be converted into separate applications for patents to be granted by the national or regional offices. The procedure is complex and is explained in more detail in a separate information sheet.

The main advantage of a PCT application is that the expense of filing the national or regional applications can be deferred for up to thirty months from the original UK filing date. A wide range of countries can therefore be maintained in the application and only trimmed down at a late stage.

We hope that you will find this general information helpful but this is a complex area of law and we strongly recommend that you seek our advice in relation to any particular case.

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