

*The UK Patenting Process: A Simplified overview.*



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The Patent system in the UK is quite complex and professional advice is highly recommended.

At the moment, there is currently **no** single International system of Patent protection *that grants a single patent right*. Instead, Patent protection regimes that currently exist are jurisdictional in nature, and may cover regions (e.g. European Patents granted under the European Patent Convention, administered by the European Patent Office to cover parts of Europe) or individual countries (UK Patents granted by the UK Intellectual Property Office to cover the UK; United States Patents granted by the USPTO to cover the United States).

The only 'international' system of Patent protection that exist is the Patent Cooperation Treaty, administered by the World Intellectual Property Organisation, which has a membership of some 184 countries, however this effectively gives an inventor a bundle of national/ regional Patent rights, which must be pursued individually. If international protection is sought, the Patents Cooperation Treaty route allows filing of one 'international application', from which various national applications can branch out. The cost of this route depends on which of the PCT countries you desire protection, and is often a cheaper way of obtaining protection in a number of countries. It is not advisable to pursue protection in individual countries separately if you are seeking protection in more than a few jurisdictions as this could be quite costly.

### *To be Patentable, the invention must satisfy a set criteria:*

It must be New [Section 1(1) Patents Act 1977] (It must not have been made available to the public in any form or manner, anywhere in the world before the filing date, thus the crucial importance of confidentiality); It must have Inventive Step (it must not be obvious to a person skilled in the art); It must have Industrial Application; It must not form subject matter that is Excluded [Section 1(2) Patents Act 1977] as such( e.g. Discoveries, Programs for computers, literally, dramatic or artistic works, business methods or presentation of information...etc.), and finally, the commercial exploitation of the invention must not be contrary to public policy or morality[Section 1(3) Patents Act 1977]. This is not an exhaustive list and are are some exceptions.

### *How long does it take for a Patent to be granted?*

The process from filing to registration can take anywhere from 2 years to 3.5 years to complete, although it is possible to request a speeding-up of this process in certain circumstances, thus it is possible for an inventor to get a patent granted in a shorter period of time. In this time the subject matter embodied in the patent is searched by the respective patent office(s) looking for patents and patent applications which are similar to your invention. Once all the official fees are paid, a search report is drawn, followed by an examination report which may cite documents that make your invention not novel or obvious. Our task at this juncture is to submit written arguments rebuffing the examiners comments.

### *How long would a granted Patent last?*

Generally, a Patent gives the proprietor a 20 year exclusive right to stop or prevent anyone from making the invention, performing the method of the invention or importing the invention into the jurisdiction in which the Patent is in force. A patent does not grant you an ability to make or

manufacture an invention. In the UK, annual renewal fees are payable in the 4<sup>th</sup> year, in respect of the 5th year, and thereafter every year up to expiry, to the UK Intellectual Property Office (UK IPO). In Europe they are payable annually (due end of the month of the second anniversary of the *filing date* in respect of the 3<sup>rd</sup> year) at the European Patent Office. Renewal fees increase year by year exponentially.

There are other considerations for Pharmaceuticals and such industries where marketing permission is required, and an inventor may be awarded what is known as a *Supplementary Protection Certificate*.

### *Do I need a Patent Search?*

While we encourage filing a Patent application before approaching a manufacturer / financier, we always strongly recommend performing a Patent Search before drafting and filing a patent specification. This involves screening through various Patent databases around the world, looking for Patents and Patent Applications and other prior art which could be relevant to your application. Such a search sometimes uncovers prior art that is already in the public domain, and that could pose a potential obstacle to your patent application. A search is important because it could prevent you incurring avoidable expenses if someone has already invented your invention, or something closely similar or embodying an essential aspect of it. Furthermore, if an inventor requires more technical information for implementation of a specific technology used in their invention, a search can provide insightful know-how of how others in the industry have done similar things in the past, or how past inventors have overcome certain problems relating to your particular technology. Our Patent Search fees begin at **£125**.

### *Any other important information ?*

Up to 12 months from filing (or priority), an inventor has the option of pursuing international filings in other jurisdictions. This has a number of advantages, especially for individual Inventors/ SME's as it may give them ample time to obtain funding and / or sponsorship for the exploitation of their invention, and also time to assess whether it really is worth pursuing the invention after all. Up to this point, the inventor has the option of filing other national patents (e.g. US, Canada, Australia), or regional patents (e.g. EPO, PCT) 'claiming priority' from the original filing. The advantage of this system is that the rights in the Patent Applications filed in these secondary jurisdictions are backdated to the date of filing in the first jurisdiction, as long as the countries concerned are '*convention countries*', thus there is continuity and no loss of rights in the secondary filings. It is also possible to file directly abroad in a number of jurisdictions at the first instance, although this can be quite costly, mainly because of the combined Patent Attorney fees and translations which may be required in those jurisdictions.

In addition, inventors should pursue the prospects of licensing their technology once a Patent is on file, as this could give them the much needed revenue for the exploitation of their invention, and could lift the burden of them having to exploit the invention solely.

Although the total UK Intellectual Property Office fees up to grant of a UK Patent are only **£200**, other costs that will be incurred include Professional representation fees, costs of commercialising the invention as well as the possible cost of enforcing your patent, thus appropriate business advice

should be sought on the various options available to an inventor. Also, its important to note that, some of these costs are usually spread over a period of time so the overall financial burden to an inventor is often reduced (for example for a UK Application, it is not a requirement to pay the filing fees at filing, this fee being due sometime later in the first year)

### *Typical Fees*

Usually, the total cost of making a patent application depends on a number of factors such as:

- The field of technology / the nature of the invention ( the more complex this is, the higher the costs tend to be)
- Length of the patent specification & the number of Claims
- Hourly rate of the agent or representative and the fees charged by the draughtsman for preparing any drawings forming part of the spec.
- Time taken by the agent/ representative in preparing and prosecuting the patent application
- Number of countries the applicant wants to be covered
- Route used for filing in other jurisdictions
- Translations costs of foreign filings
- Number and nature of objections raised by the patent examiner and whether there are any opposition proceedings or appeals

In the UK the cost of drafting and filing of a UK patent is somewhere in the region of **£1500 - £2500**. This usually includes official fees, professional charges and prosecution fees, search fees and examination fees. Other charges may apply depending on the factors mentioned above.

For Europe, the cost of filing using the European Patent Office is somewhere in the region **£5000 - £7000**.

For the US, typical costs of drafting and filing are in the region of around **£4000- £6000**.

The cost for filing a **PCT** application that has potential to be 'validated' in about 139 countries worldwide is in the region **£4000- £5000**.

Note that for Europe once you select 7 member states of the EPO, you will be awarded all Contracting states. Also note that for a European patent, validation fees in the individual countries, translation fees and renewal fees (3rd and 4th) payable before grant of the Patent can have an effect on the overall total cost.

For the US, there are lower filing fees if you are small company (Small Entity), and although if instructed, we would do the drafting ourselves, the filing is done by a US Attorney, who would charge a fee for their services.

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