

Marks&Clerk



A Short Guide

European & International Patents

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What is the European patent system?

The European patent system operates a procedure by which a single patent application is filed at the European Patent Office (EPO) under the European Patent Convention (EPC) to obtain patents in an increasing number of European countries (now nearly 40), e.g. UK, France and Germany.

This procedure results in a number of individual national patents, each enforceable before the appropriate national court (rather than a single European patent enforceable centrally).

When should I file a European patent application?

Usually (but not always) a European patent application is filed within a year of filing a UK patent application for the same invention. A UK application is normally filed first as this is convenient and enables an assessment of the patentability and commercial viability of the invention before a European application is filed. The European application must be filed within a year of the UK application if it is to claim priority from the UK application. If no such priority is claimed, the application must be filed before the invention is publicly disclosed.

What are the advantages of filing a European application?

The main advantage is to obtain good quality patent protection in a number of countries by means of a single application procedure, without having to file a separate national patent application in each country.

How do I obtain appropriate European protection?

The three possible routes to obtaining patent protection in a number of European countries are:

1 individual national patent applications

2 a European patent application
3 an international patent application followed by either or both of the other routes.

The most appropriate option for you will depend on your individual circumstances. An international application enables a large number of countries around the world to be covered for an initial assessment period before patent applications have to be pursued in each country. It is therefore particularly suitable for more speculative applications or to defer the costs of European or individual national patent applications.

You may prefer a European application over individual national applications to keep down the filing and prosecution costs. On the other hand, you may prefer filing individual national applications over a European application for speed or to guard against the possibility of patent protection in all countries being lost in the event of the European application being unsuccessful.

What are the steps involved in prosecuting a European application?

The initial stages of a European patent application are similar to those of a UK patent application. After the application has been filed, the EPO carries out a search through previously published documents for those relevant to the invention claimed. The search report includes an opinion on whether the invention is new and inventive. The application as filed is published approximately 18 months after the priority date.

Provided that the examination fee is paid within 6 months of the date on which the search results are published, the application is then subjected to an in-depth examination. If any official objections are raised, these may be dealt

with by argument or amendment.

If the examination process is successfully concluded, translations of the claims into the other two official languages of the EPO i.e. French and German must be filed and a grant fee paid. The patent will then be granted and published again by the EPO.

However, one procedural difference between the European and UK patent systems is that anyone may oppose a European patent centrally by lodging opposition within a 9 month period after grant. An opposition, if successful, leads to cancellation or amendment of the patent. All patents are subject to cancellation at any time, before national courts.

How is the granted European patent validated in the countries you select?

Some countries require the full text of the granted European patent to be translated into their national language, and most require a local patent attorney to be appointed as national representative, as well as a national fee to be paid. Thereafter it will be necessary to pay annual renewal fees to each national patent office to maintain the patent in force.

Can I obtain a single patent covering all these European countries?

Not yet. However, there is the possibility of the introduction of a so-called European Union Patent system by which a single unitary patent can be obtained for the EU which will be renewable and enforceable centrally.

What is the international patent system?

The international patent system was established under the Patent Cooperation Treaty (PCT) and allows a single patent application to provide initial patent protection in a large number of signatory countries, the most important of which are the EPC countries, China, Japan and the USA. However, it is important to note that there is no such thing as an international patent, and that an international application must eventually be followed by the filing of national/regional applications covering selected countries. This is referred to as the national/regional phase.

When should I file an international patent application?

Usually an international patent application is filed within a year of filing a UK patent application for the same invention (instead of filing separate European and foreign national applications at this stage). As with a European application, the international application must be filed within a year of the UK application if it is to claim priority from the UK application. If no such priority is claimed, the international application must be filed before the invention is publicly disclosed.

What are the advantages of filing an international application?

The main advantage is to start the process of obtaining patent protection in a large number of countries by means of a single application in English, without having to file a separate patent application in each country or region. Thus an international application enables a large number of countries to be covered for an initial assessment period before individual national or regional patent applications have to be filed. It is therefore particularly suitable for more speculative inventions where wide territorial protection is required for minimum initial cost, or

to defer cost for as long as possible (by typically 18 months).

How long does an international application remain in force?

An international application remains in force for only a limited period of time, after which it is necessary to continue by filing national applications (and/or a European regional application) covering the countries of interest. This period in most cases is 30/31 months from the filing date or the priority date (whichever is earlier).

What are the steps involved in prosecuting an international application?

The initial stages are similar to those of a UK or European application. After the application has been filed, the EPO as International Searching Authority carries out a search through previously published documents for those relevant to the invention claimed. The search report includes an opinion on whether the invention is new and inventive. The application as filed is published approximately 18 months after the priority date. Within 22 months from the priority date an International Preliminary Examination can be requested. This is a non-binding examination carried out by an examiner at the EPO that gives a fuller opinion on the allowability of the international application. During this procedure you can submit arguments and amendments to convince the examiner to issue a favourable examination report, which may then be influential in securing national and European patents.

For almost all designated countries the next stage is the national/regional phase entry at 30/31 months after the priority date.

At the national/regional phase you must decide which countries of the PCT are still of interest to you for patent protection and complete the required formalities at the appropriate national or regional patent offices, such as the EPO.

Are the national applications resulting from an international application equivalent to national applications filed in those countries in the first instance?

Yes, if the formalities required by the countries are completed. Where appropriate the application must be translated into the national language. Each application proceeds in a substantially similar manner to any national or European application filed directly at the relevant patent office. Although the results of the international search and any international examination are taken into account during examination in the national processing, each national patent office may also raise new objections. Different amendments may therefore be required to obtain different national and European patents. Each national patent is then renewable and enforceable in precisely the same way as any other patent granted in the country.

How can Marks & Clerk help?

Marks & Clerk advises on all aspects of intellectual property. For more information and to find out how we can help you with filing and protecting your patents and managing your patent portfolio, contact your usual Marks & Clerk attorney or a member of our patent team at your nearest Marks & Clerk office. Full details are on our website www.marks-clerk.com.

The information within this guide is intended to provide a summary of the subject matter. Readers should not act or rely on information contained in this guide without first obtaining specialist professional advice.

