

A Guide to UK Patent Law

1) UK National Application

Provided below is a brief summary of the typical national patent application procedure in the United Kingdom.

Filing

To acquire a UK patent the first stage is filing at the UK Intellectual Property Office (UKIPO). An applicant can initially choose to file a basic application or a complete application.

A **basic application** includes details of the applicant, a request for a patent and a description of the invention. A basic application provides the applicant with an application number and a filing date, however the other parts of the application must be filed within 12 months from the filing date to enable the application to proceed further, otherwise it is withdrawn.

A **complete application** includes a patent specification which has a description of the invention and drawings, claims which define the scope of protection and an abstract. If the application is to claim priority from one or more applications filed in the preceding year the application numbers and filing dates of the earlier applications are given. It is typically recommended to file a complete application from the outset as doing so provides the applicant with a search report as early as possible.

Additional filings fees are due in respect of applications which contain more than 25 claims and/or more than 35 pages for the description.

Preliminary Examination Report

Shortly after filing the UKIPO will conduct a formality review of the filed application. If there are any deficiencies identified as part of this review, they will then issue a preliminary examination report. The deficiencies may relate to one or more of: an objection to one or more of the drawings; the lack of claims or abstract; the lack of an inventor declaration or search request on filing.

Search and Examination

There are two options available for proceeding with search and examination:

- A) Search and Examination are each requested separately; or
- B) Combined Search and Examination is requested on filing.

A) Search and Examination requested separately

Search Request

A search request is typically made on filing, however, the filing can be delayed for up to 12 months after the application has been filed (or at most 12 months from the earliest claimed priority date).

Typically after around 6 months after a search request has been filed, the Patent Office will issue a search report. This lists any documents identified by the Patent Office as relevant to the patentability of the invention, and can be used to assess whether an invention is patentable i.e. is new and not obvious over everything previously known to the public anywhere in the world.

Examination Request

An examination request must be filed by no later than 6 months from the date of publication (i.e. usually around 24 months from the filing date, or the filing date of the earliest application from which priority is claimed).

There is usually a delay of between 6 months and several years from the filing of an examination request before the application is examined. It is possible to file an examination request early, but this does not speed up the examination process.

B) Combined Search and Examination is requested

Combined Search and Examination Request

One way to speed up the application procedure is to request examination at the same time as the original search request. This is called “combined search and examination”. In that case, the application is searched and examined at the same time and a combined search and examination report is issued after about six months. Although a combined search and examination report usually gives a relatively long response deadline it is possible to reply promptly and potentially substantially speed up the application procedure. Disadvantages of combined search and examination include bringing forward costs and potentially also paying examination fees twice if the first application is used as the basis for a priority claim and then abandoned.

Declaration of Inventor

Unless each inventor is also an applicant in a personal capacity, it is necessary to file a declaration of inventor within 16 months of the filing date of the application (or at most 16 months from the filing date of the earlier application from which priority is claimed, if applicable). The declaration of inventor names the inventors and also gives brief information as to how the applicant(s) derive title from the inventor(s), for example, by virtue of a contract of employment.

Publication

A pending application will be published with the search report not earlier than 18 months after the filing date of the initial UK application (or 18 months after the filing date of the earliest application from which priority is claimed, if applicable).

It is possible to request early publication. Publication is sometimes late. However, it is not possible to request that publication is deferred. Publication can only be prevented by withdrawing the application. In order to prevent publication, it is necessary to withdraw the application before the UK Intellectual Property Office (IPO) complete their preparations for publication of the application which is usually a number of weeks before the publication date.

Examination

In due course, the IPO examines the patent application. They may issue a notification of intention to grant straight away, without requiring amendments to the application. However, it is normal to instead receive an examination report which raises objections to the patentability of the invention and sets a response deadline.

The most common objections are that the claims cover subject matter which is not new, or which is obvious, but there are other bases on which objections may be raised. Examination reports include a response deadline. Responses to examination reports include arguments in favour of the patentability of the invention and frequently include amendments to narrow the scope of the claims. It is common to receive multiple examination reports.

Ultimately, there is a deadline by when the IPO must either grant a patent or refuse the application. This deadline ("the compliance period") is initially set at four years and six months from the filing date of the application (or at most four years and six months from the filing date of the earlier application from which priority is claimed, if applicable) although it can be extended, for example if there is a delay in issuing the first examination report.

Notification of Intention to grant

If a patent application is found allowable, the IPO issues a notification of intention to grant. This communication states that the patent application will be sent for grant shortly after a specified date. This notice period provides the applicant with an opportunity to make voluntary amendments or to file a divisional application (if there is still time available). Once the application proceeds to grant, the application procedure is finished and a certificate is issued.

Renewal fees

Once a UK patent has been granted, it is necessary to pay renewal fees annually from the end of the month including the fourth anniversary of the filing date if the patent is to be kept in force. The renewal fees increase annually for the duration of the patent. If a UK renewal fee is not paid in time, it may be paid late within a “grace period” of up to 6 months, on payment of a surcharge which increases with each month.

It is sometimes necessary to pay one or more renewal fees shortly after grant, if the patent application procedure has taken around four years or more and the first one (or more) fees are already due.

Compliance Period

It is necessary to have an application in order for grant in the UK before the end of the compliance period otherwise the application will be refused. The compliance period is 4 years and six months from the filing date or priority date, if claimed, or 12 months from the date of issuance of the first examination report, if this expires later.

It is possible to extend the compliance period by 2 months by requesting an extension and paying a fee in relation.

Divisionals

Divisional Applications in the UK are subject to the same compliance period as the parent application, meaning that no extra time can be gained by filing a divisional application. Divisional Applications should therefore be filed sooner rather than later; however, no later than 3 months before the expiry of the compliance period of the parent application.

An extension of the compliance period also extends the period in which divisional applications can be filed. However, obtaining an extension of the compliance deadline for a parent application does not extend the compliance deadline of any divisional(s) and thus a separate extension request and fee payment has to be made in respect of the divisional application.

2) Obtaining patent protection in the UK from a PCT application

A Patent Cooperation Treaty (PCT) application provides the opportunity to acquire patent protection within a large number of countries including the UK. Looking in particular at the UK in more detail, there are multiple ways to obtain patent protection within the UK from a PCT application.

These include:

1. Entering the European regional phase from the PCT application; or
2. Entering the national phase in the UK directly from the PCT application.

There are a number of advantages and some disadvantages with each of the above approaches which are set out in further detail below.

1) Entering the European regional phase

Deadline

The deadline for European regional phase entry is 31 months from the filing date or, if priority is claimed, from the earliest claimed priority date.

Requirements

The requirements for EP regional phase entry are set out in Rule 159 EPC and include at least the following:

- Specifying the application documents on which the European procedures is to be based;
- Attending to payment of the filing fee;
- Attending to payment of the search fee, where a supplementary search is to be drawn up (such as in cases where the EPO was not the ISA);
- Attending to payment of the designation fee; and
- Requesting examination and attending to payment of the examination fee.

Late Entry

It is possible to enter the European regional phase later than 31 months using “Further Processing” at the EPO. This provides at least an 2 months for entry (at least 33 months from filing/priority), however it considerably adds to the cost as the further processing fee requires payment of each of the fees mentioned above but along with an additional 50% surcharge.

The deadline for using further processing to enter the European regional phase is determined by the notification of loss of rights issued by the EPO after the 31 month deadline has passed. The Applicant has 2 months from the notification of this communication to enter the European regional phase using further processing.

It is also worth mentioning that the notification of loss of rights communication in respect of failing to enter the European regional phase is sent directly to the Applicant named in the PCT application and not to any representatives involved. This can present difficulties if the ownership of the PCT application changed during the international phase but was not timely recorded prior to the end of the 31 month period.

EP regional Phase

Once the requirements of entry are met, the international application enters the European regional phase, is now referred to as a Euro-PCT application, and has the status of a regular European application. It will then undergo examination before the EPO until such time that it proceeds to grant or is refused.

Upon grant, the European patent can be validated in any of the EPC member states including the UK. Once validated in the UK the European patent is treated as the equivalent of a UK national patent. A point to note is that, for a period of 9 months, the European patent is open to opposition from third parties, accordingly the granted European patent could be subjected to revocation or amendment.

Entering the national phase in the UK directly

Deadline

The deadline for UK national phase entry is 31 months from the filing date or, if priority is claimed, from the earliest claimed priority date.

Requirements

Again, there are basic requirements to be fulfilled in order to enter the national phase in the UK as set out at [Section 89A](#) of the UKPA. This includes:

- Specifying the application documents on which the European procedures is to be based;
- Payment of a national phase fee;
- Requesting a search and attending to payment of a search fee; and
- Requesting examination and attending to payment of an examination fee.

The request for a search can be filed within two months of the entry into the national phase. However, it is advisable to file the search request on entry. Similarly the request for substantive examination must be filed 33 months after the priority date, or if later, two months from National Phase entry. Again it is advisable to file the examination request on entry.

Late Entry

The deadline for entry into the UK national phase can be extended by a further 2 months as of right however unlike the EPO, the UKIPO does not communicate that the applicant has failed to observe the conditions of entering the national phase within the prescribed period. The deadline for entering the UK national phase may be extended as of right by 2 months on request, with the payment of the associated fee and the completion of the relevant form.

A further extension of two months is also possible; however the Applicant will have to show that the failure to meet the national phase entry deadline was “unintentional”.

UK National Phase

Upon fulfilment of these requirements, the application enters the UK national phase. Shortly thereafter the application enters the prosecution stage, and like with a European application, the procedure involves a series of communications between Examiner and applicant until a decision is reached as to whether the invention meets the patentability requirements and is in order for grant.

A point of note with UK patent procedure is that a UK patent application has a maximum pendency period of 4 years and 6 months from the filing date or priority date, if there is one claimed, or 12 months from issuance of the first examination report, if this expires later. This is known as the compliance period.

Unlike a European patent, the UK patent does not undergo an opposition period.

Which route to take?

When choosing between entering the EP regional phase and the UK national phase, there are a number of factors to take into consideration. For example, generally a UK patent is granted between 1 to 4 years from the date of national phase entry, whereas a European patent is granted between 2 to 5 years. Further, UK national phase applications tend to incur substantially less cost than Euro-PCT applications in filing and procedure.

However, by entering the European regional phase, upon grant of the European patent, the applicant will have the choice of obtaining patent protection in 37 other countries in addition to the UK. The UK does not however have opposition in a manner similar to the EPO. There is also nothing preventing an applicant from entering both the UK and EP national/regional phases thus potentially allowing for a faster grant in the UK whilst also pursuing the European patent.

In short, there are merits in certain circumstances in filing a European regional phase, or in filing a UK national phase application and the applicant must evaluate which route is the most appropriate for them.

If you have any questions about the UK patent process, please [reach out](#) to us.

UK NATIONAL PATENT APPLICATION TIMELINE (No Priority Claim)

Time (Months)

