
Our patent and trade mark attorneys are here to help you protect and profit from your ideas, making sure they're working every bit as hard as you do.

Our people work with everyone from multi-nationals to start-ups, delivering jargon-free advice that tells our clients exactly where they stand. From day-to-day filing through to advising on IP strategy and due diligence, we offer a complete patent and trade mark service.

Whether you'd like a quick chat about what we do or you have a specific IP project to discuss, please get in touch.

PCT and foreign patent applications

A UK patent can be enforced only in relation to commercial activities which take place in the UK. If you wish your invention to be protected overseas, then it is necessary to file patent applications abroad.

In many cases overseas patent applications are filed at the end of a “priority year” which starts with the filing of your UK or European patent application. Under an international convention to which virtually all industrialised countries subscribe, any foreign patent applications filed within the priority year are treated as having effectively been filed on the original UK or European filing date.

There are three main routes to overseas protection:

1. Filing separate foreign national patent applications in each country where protection is required.
2. Filing an “International” PCT Patent Application designating a number of countries, including Europe.
3. Filing a European Patent Application designating several European countries (please see our information sheet on “European patent applications”).

Foreign national patent applications

A national patent application may be filed in the local language at the national Patent Office of a foreign country.

If you wish to file a national Patent application in a foreign country, it will be necessary for us to appoint a local Patent Attorney to be responsible for the patent application procedure in that country. For this purpose, we have established a network of fully qualified and trusted overseas Attorneys to assist us with filing and prosecuting foreign national patent applications. You will not need to interact with them directly, since we will act as a single point of contact for all of your patent applications.

What happens after the Application is filed?

The procedure following the filing of a foreign national patent differs substantially from country to country. However, this can generally be divided into three stages - search and examination, publication, and grant. A summary of these stages is given below:-

1) Search and Examination

After filing, an examiner at the foreign national Patent Office may conduct a search through previously published patent specifications (and possibly a limited range of other literature) to identify published documents which may be relevant to the patentability of the invention. The examiner will also conduct an examination process to consider whether the invention is patentable, according to the local national patent law.

In some countries the search and examination phases are conducted separately, while in others these phases are conducted together. In some countries it is necessary to file an “Examination Request” (and pay an examination fee) within a specified period before the application will be examined by the Patent Office. A search report listing these documents is normally issued (together with a copy of the documents), and we report this to you.

In most cases, the national Patent Office Examiner will issue a search report and/or an “Examination Report” (sometimes referred to as an “Official Letter” or an “Office Action”) detailing any objections to the application. These objections generally relate to the Examiner’s opinion regarding the patentability of the invention. We then report the Examination Report to you and provide you with copies of any documents cited against your application. Following discussion with you, we prepare instructions for our local Attorney to prepare and file a response which deals with the objections.

2) Publication

In most foreign countries, the application is published by the national Patent Office approximately eighteen months from the filing date (or the priority date if priority is claimed from an earlier application).

3) Grant

Once the Examination stage has been concluded, and the Examiner's objections have been overcome, the foreign national Patent Office will formally accept the application and, subject to payment of various official fees, the foreign national Patent will be granted and a certificate of grant will be issued.

Renewal Fees

Following the grant of a patent, renewal fees will become payable. In some countries, renewal fees are also payable before grant.

International "PCT" patent applications

Rather than filing national patent applications directly, a Patent Cooperation Treaty (PCT) application can be filed, which is effectively a bundle of national and regional patent applications that enables you to delay your decision as to which countries you ultimately wish to protect your invention in. A PCT application can be used to obtain patents in most of the major industrial countries of the world.

What is a PCT patent application?

It is important to note that the PCT system does not grant patents - it simply allows you to file an application under its treaty covering a large number of countries whilst you make your decision as to which countries you ultimately wish to protect your invention in. Its main advantage is as a delaying tactic.

By filing a single PCT application the decision (and cost) of filing individual foreign national applications can be delayed by up to 30 months from your original UK or European priority filing date. It is important to note that the PCT system only offers a delay in the foreign filing decision. At the 30 month point the PCT application must then enter those countries of interest.

This delay provides you with more time to identify which jurisdictions are commercially important, places third parties in a difficult position

of being unsure where you will obtain protection for your invention for an extended period, and delays substantial costs if you wish to pursue patent protection in a large number of countries.

The PCT system offers the advantage of providing you with a search report on your patent application. It is also possible to obtain an international examination report on your application, which provides you with a better idea of the chances of obtaining a patent in the foreign countries of interest before you need to make a final decision as to which countries you wish to pursue national applications in.

What happens after the PCT Patent Application is filed?

A few months after filing the application an International Search and Written Opinion will be received. This may cite a number of previously published documents considered to be relevant to your invention, and give a preliminary opinion as to the patentability of your invention. Shortly after this is received, the application is published as an International application. Then, 22 months from the priority date, (approximately 10 months after filing the PCT application in most cases), a decision between proceeding via Chapter I or via Chapter II of the PCT has to be made.

Chapter I

Under Chapter I, the application proceeds directly to the so called “national phase” whereby separate national patent applications have to be filed in each of the originally designated countries where a patent is required. In respect of most countries this must be done within 30 months from the priority date.

Chapter II

To proceed via Chapter II, a “Request for International Preliminary Examination and Election of States” must be filed by 22 months from the priority date.

Once International Preliminary Examination is requested, the European Patent Office carries out a thorough examination of the application and a report giving an opinion on the patentability of the invention is issued. Before this, we are given an opportunity to amend the claims of your

application and explain why your invention is patentable, hopefully resulting in the issuance of a favourable report from the European Patent Office. Although the opinion of the European Patent Office is not binding on any of the national Patent Offices which will subsequently carry out their own examination during the national phase, it does give an early indication of the chances of the invention being patented in the different countries, and can be persuasive to the local Patent Offices of some countries.

Note: A shorter deadline of 20 or 21 months from the priority date for entering the national phase under Chapter 1 applies to a small number of countries (currently Luxembourg, Tanzania and Uganda). For these countries the “Request for International Preliminary Examination and Election of States” must be filed by 19 months from the priority date, in order to proceed via Chapter II. By proceeding via Chapter II, the deadline for entering the national phase then becomes 30 or 31 months from the priority date. However, each of these States is covered by a regional patent system (European Patent or African Patent) which has a 31 month PCT Chapter 1 National Phase entry deadline. As a result, applicants can delay National Phase entry in these States by filing regional patent applications designating them.

National Phase

At 30 or 31 months from the priority date, the PCT Patent Application leaves the “international” phase and in fact then ceases to exist, having been superseded by separate national patent applications. At this stage translations have to be prepared and filed as with directly filed national patents.