

Overseas Patent Protection

A patent is a national right. If the proprietor of a United Kingdom patent wishes to obtain protection outside the United Kingdom, then it is necessary to file further patent applications overseas. This briefing note is an introduction to that process.

Patents overseas

Almost all countries have systems in place allowing people to apply for and be granted patents, although local requirements vary from country to country.

The Paris Convention

Over 160 countries (including the United Kingdom) have signed up to the Paris Convention, which is the major international convention covering intellectual property (patents, trademarks and so on). States which have signed up cannot impose requirements concerning the nationality of an applicant, and so any national of a Paris Convention state can apply for a patent in any other Paris Convention state.

Normally, an application must be filed in each country where protection is desired; however, given the number of countries, and the fact that overseas firms of patent lawyers will need to be instructed and translations prepared in many cases, obtaining protection worldwide can be very laborious, and very expensive. The cost of renewal fees, which normally must be paid each year on each patent or application to keep them in force, must also be taken into account.

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Thus, unless an applicant has limitless funds, it is important to consider whether it is worthwhile spending money in order to obtain a patent in any particular country.

Priority

Paris Convention states also allow an applicant who has already filed a patent application to take advantage of their “right to priority”. The effect of this is that further patent applications can be filed in any other Paris Convention state up to one year after the date of filing the original application, and will be treated as if they had been filed on the same day as the original patent application. This means that any disclosures made by the applicant during this “priority year” will be disregarded; normally, making a disclosure of an invention before an application is filed will prevent an applicant from obtaining a valid patent.

Regional agreements and the EPO

Thankfully, it is not necessary to file a separate application in each country. There are a number of regional agreements between countries that allow a single application to cover all of the countries in the agreement. The most commonly used, at least for applicants based in the United Kingdom, is the European Patent Convention (EPC), administered by the European Patent Office (EPO).

All member states of the European Union have signed up to the European Patent Convention, and so can be covered by a single application filed at the EPO. In addition, some other European countries (most notably Switzerland and Turkey) have signed up, and can also be covered in the same application.

Obtaining patent protection in this way is expensive, and an applicant should expect overall costs of at least £10,000. Significant costs are incurred when the application has been granted when it is necessary to validate the application in each selected state. In some countries a translation of the granted text must be filed at the patent office in order for the patent to be brought into force.

Consequently, an applicant will have a good idea at the grant stage of where continued expenditure is worthwhile.

Besides the European Patent Convention, there are regional agreements covering several states of the former Soviet Union (the Eurasian Patent Convention), and a number of English and French-speaking states in Africa (ARIPO and OAPI).

The Patent Co-operation Treaty

Around 100 countries have signed up to the Patent Co-operation Treaty (PCT). Under this treaty, a single application is filed which can cover any or all of the PCT member states. The application will be searched and published, in the same way as any patent application, and an examination can also be carried out (see our briefing note “What is a patent?” for more details about this). The search and examination allow an applicant to get some idea of whether grant of the application is likely.

After the search or examination, the application must be divided up into a series of national (or regional) applications. The costs at this stage are comparable to those involved in filing national applications, as overseas lawyers must be instructed and translations prepared; however, as a search and examination has already been carried out, the applicant has a better idea of whether these costs will be money well spent. In addition, the PCT allows these costs to be deferred for up to two-and-a-half years from the original date of filing, compared to one year after the original date of filing if national applications are filed.

Further advice

If you would like any further advice in relation to overseas patent protection, please contact us using the details below.



Contact Dehns

T: +44 (0)20 7632 7200

E: mail@dehns.com

W: www.dehns.com

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