

IIPP PATENT QUESTION TEMPLATE

FILING

ENTITLEMENT / OWNERSHIP

Entitlement

- Any person may apply for a patent – either alone or jointly
- Patent may be granted to:
 - inventor / joint inventor
 - any person entitled to the invention by law or agreement
 - successor in title to the above

Check all inventors are UK based?

- If USA, will need to file in US first or obtain foreign filing clearance
- If all UK, no foreign filing clearance required (unless security related app'n)

Check no other inventors involved

- Were inventors employees? – invention may belong to employer (normal duties)
- Were inventors consultants?
- Will assignment be needed?

Ownership

- Sole ownership is preferable to joint ownership
- Secondment
 - Contract between host and employer? Ask to see
 - Seconded employee duties? Was work discussed with host (disclosure)?
 - Are host interested at all in the app'n?
- Statement of inventorship required if applicant is not the inventor
- Employment contacts or grant/funding agreements (PhD students)

PATENTABILITY

Requirements

- Novel, inventive, industrially applicable, not excluded (CITE STATUTES, ALL JURIS.)

Computer software

- Computer program with tech effect is patentable
- Protect with copyright instead? i.e. computer code

DISCLOSURE

Confidentiality

- Disclosed outside of duty of confidence?
- If ambiguous, discuss both options
 - If disclosure was/wasn't in confidence then...
- One year grace period with designs = last resort

Advise client not to disclose until application is filed

- If unexpected disclosure, can file on the date
- Ask to review copies of any disclosure

FILING STRATEGY

Extent of protection

- Broader protection by claiming individual elements?
- Better to file one application or two?

Initial filing in UK

- To get a search report and set priority date (required: request, contact, description)
- Cheap – only filing (£60) and search (£150) due initially
- Don't pay any other fees on filing, not in a hurry
- Search is useful at end of priority year
- Claims and abstract can be filed up to 1 year later
- EP fees are higher for first filing, UK is more effective to set priority date

Initial filing in EP

- If interested in EP-wide launch, recommend file there instead of UK
- Filing (€120) and search (€1300) fees due on filing
- Longer to file a divisional app'n

Disclosure after filing

- Advise client that can now only disclose what is in application (risk = insufficiency)
- Any new developments need a new application filing before disclosure

Expansion after priority year

- At end of Paris Convention priority year, file EP / PCT application
- Amend spec to take account of any citations and/or further development by client
- PCT or direct, if only interested in limited no. countries?
 - US direct filing – use a US attorney to amend claims for best protection
 - Generally not worth doing any EP countries direct – more expensive
- Late priority claim (UK) – up to 16 months w. £40 fee

UK national phase entry

31 months (2m EOT)

- File English translation
- File NP1 and pay processing fee (£30)

33 months

- File request for search and pay search fee
- File request for examination and pay examination fee

EP national phase entry

31 months (2m FP)

- Form 1200
- Filing, search, examination and designation fees all due on filing
- Examination fee varies based on ISA

GRANT & POST-GRANT

EP validation requirements

- GB/FR/DE translations required of claims
- London Agreement countries
 - Only need address for service and ensure renewals are monitored

EPO Opposition period = 9 months

- No extension available
- Grounds, Art. 100 EPC
- Deadline, Art. 99 EPC
- Anyone can file opposition
- Form 2300, €785 fee

Other possible protections

- Copyright (computer software)
- Trade secrets (encrypted software)
- Design protection if not patentable – determine from search results

INFRINGEMENT

Who can bring proceedings?

- Proprietor of patent
- Check client actually owns the rights
- Check app'n is in state to be asserted

Check if alleged infringer has any published applications / IP rights

- Don't just take client's word for this + do own search

Check details of what product the alleged infringer is making

- What is it?
- When was it made available? i.e. predates filing date / invalidity issues
- Obtain copy of rival product
- Are acts actually infringing?

Does infringing product read onto claims of client's patent / patent application?

- Possibly amend application during prosecution to fully cover infringing product
- Mention potential issues with added matter / sufficiency

if EPO

Request accelerated prosecution of client's application at EPO

- Waive invitation under R.70(2) – wish to proceed + E&D fees early
- Waive further R.71(3)
- Request PACE program, Form 1005
- Request early publication

if UK IPO

Request accelerated prosecution at UKIPO

- Combined search and examination (CSE)
On request, file both requests at same time (PF 9A + PF 10)
- Accelerated publication
Request in writing
- Accelerated search and/or examination
Only if adequate reason provided
e.g. potential infringer, secure investment
Request in writing

if PCT

Request accelerated national entry of PCT app'n

- File explicit request to start processing (different to PACE request)
- Waive communication under R.161 / R.162 – amendment and claims fees
- PPH – Europe, China, Korea, Japan, USA

Divisional strategies

- File divisional for wider claims, and narrow the claims of the parent
- Quicker than waiting for divi. to grant

Write to alleged infringer informing of existence

- Beware threats provisions
- Intellectual Property (Unjustified Threats) Act 2017
- Will have backdated rights from publication

Complete grant formalities as soon as granted in desired countries

Attempt to negotiate initially

- Mention possibility of license agreement with infringer (or as licensee)
- Cheaper / quicker than court proceedings

UK IPO opinions on infringement

- Quick and cheap option
- Non-binding, won't affect later court actions
- Patents Form 17 + £200 fee

Prot. Art. 69 applies to UK too

Litigation as a last resort

Separate advice from local attorney

Remedies available

- Injunction
- Delivery up / destruction
- Damages or account of profits (mutually exclusive)
- Declaration of validity / infringement

Risks

- Competitor designs around – mitigate with divis.
- 3rd party oppositions / observations
- Go after priority date

UK DEADLINES

Priority	0	
Form 1	filing priority + 12m	
Filing fee (Form AF1)	filing + 12m*	£60 (if on filing) £75 (if filing + 12m)
Claims Abstract	priority + 12m* or filing + 2m*	
Form 9A	priority + 12m* filing + 2m*	£150
Form 7	priority + 16m*	
Late dec. priority	priority + 16m*	
Publication	priority + 18m	
Search rep.	form 9A + 6m (aim)	
Form 10	publication + 6m*	£100
Compliance	priority + 4½y* exam rep. + 1y*	
Divisional	compliance - 3m	
*Extension	expiry + 2m	£135 + form 52

EPO DEADLINES

Priority	0	
Form 1001	filing priority + 12m	
Filing fee	filing + 1m	€120
Search fee	filing + 1m	€1300
Form 1002	priority + 16m	
Publication	priority + 18m	
Designation fee	publication + 6m	€585
Examination fee	publication + 6m	€1635
Resp. to search rep.	publication + 6m	
Renewal fees (3y+)	priority + 36m	
Resp. to exam rep.	exam rep. + 4m	
Resp. 71(3)	71(3) + 4m	
Grant fee	71(3) + 4m	€925

LACK OF UNITY (ART. 82 EPC)

OPTION 1

- Argue against objection
- Normally deadline of 4 months, can be extended to 6 months
- Option of FP (and fee) to extend further (extra 2 months)

OPTION 2

- Restrict claims to one invention only (searched invention)
- Move other claims to divi (if interested)
 - Can be done any time until grant
 - Pay filing fee, search fee, exam fee, all renewals
- Delaying divi as late as possible, in case other issues during prosecution

PCT FEES

can be paid within 1 month filing + 50% late fee

Transmittal	€130	paid to RO
Search	€1775	paid to ISA
International Filing	€1163	paid to IB
Prelim. Examination	€1830	paid to IPEA

LONDON AGREEMENT

LONDON AGREEMENT STATES

No translation required

France, Germany, Ireland, Liechtenstein, Luxembourg, Monaco, Switzerland, UK

Translation of claims only

Albania, Belgium*, Croatia, Denmark, Finland, Macedonia, Hungary, Iceland, Latvia, Lithuania, Netherlands, Norway, Slovenia, Sweden

NON-LONDON AGREEMENT STATES

Austria, Bulgaria, Cyprus, Czech Republic, Estonia, Greece, Italy, Malta, Poland, Portugal, Romania, San Marino, Serbia, Slovakia, Spain, Turkey