

Patenting research outputs – filing strategies

Before making the leap into patent law as part of WP Thompson’s chemical and life sciences team, Dr Ian Wilson worked and studied in academia for over a decade. In our continuing series, Ian investigates the key considerations for researchers in deciding where and when to file a patent application for their invention.

First Filing

There are nearly 200 states in the world, many of which have their own unique patent application requirements. Here, we consider only the most common strategies for UK-based applicants, who may be able to file at home or abroad. Indeed, anybody can file a patent application at the UK Intellectual Property Office, regardless of nationality or residency status (except where the invention concerns national security or defence). Other countries, however, may require the invention to be developed in that country (e.g., China), or for the application to be filed by a national or resident of that country (e.g., Belgium). So, if your research team is considering filing an initial patent application outside of the UK, please consult a patent attorney to ensure you meet all national requirements before proceeding.

Claiming Priority

As you might expect, the simplest, and often cheapest, way of seeking protection is to target a single country, which would incur a single set of fees for every stage of the process. However, applicants often want to file in many countries, or at least keep their options open. Fortunately, there are systems in place to make this easier and more cost-effective, such as the Paris Convention, of which the UK is one of 179 members. The Paris Convention sets a 12-month period in which applicants can file one or more subsequent applications based upon the initial “priority” application, retaining the filing date of that priority application. As those subsequent applications share a filing date, they cannot destroy novelty in one another, allowing applicants to pursue multiple applications simultaneously, be they in individual countries or regions, or via the World Intellectual Property Office (WIPO).

WIPO and PCT

WIPO implements the Patent Cooperation Treaty (PCT). This grants a minimum 30-month window from the priority filing date in which to enter a patent application for prosecution in any of the 156 contracting states. A preliminary report on patentability is generated during that period, allowing applicants to assess the likelihood of success in the various

countries of interest to inform their decision. The PCT route not only affords inventors time to consider their options; it also postpones payment of national fees, which may be of use to the budget-conscious as research and development progresses. Of course, if an applicant knows exactly where they want to attain protection for their invention, they may wish to skip straight to national or regional filing.

National or Regional Filing

Commonly, European applicants seek protection in multiple European countries, perhaps in addition to other nations. They can claim priority from an initial filing and seek protection for multiple individual applications. However, this runs the risk of, say, five countries demanding five different claim sets (potentially translated into five different languages), resulting in varied levels of protection, and five sets of fees. Instead, applicants often choose to prosecute at the regional European Patent Office (EPO), which provides a centralised system whereby a single application, in a single language (which can be English), subject to a single set of fees, leads to a single set of claims. Upon grant, this single patent can then be validated - that is, accepted - by the individual EPO member states of interest, becoming a series of independent national patents.

Changing Times

This is where current developments complicate proceedings in Europe. The EPO currently prescribes a set time period in which to select countries of interest before the patent lapses in those states. The more countries an applicant selects, and the longer they uphold the national patents, the more expensive maintenance of a patent family becomes. In view of this, a new Unitary Patent will be introduced in late 2022/early 2023, which will be automatically enforceable as a single patent in all 17 (to date) participating states. However, much uncertainty surrounds this new system, and we will investigate this next time as this seismic shift in European patent law edges ever closer.

To find out more, including how IP could benefit your work, please visit <https://www.wpt.co.uk> or contact Stuart Forrest at sfo@wpt.co.uk