



Patent Factsheets: Filing Abroad

A granted UK patent can stop others making, selling or using your invention in the UK, but has no influence elsewhere. Consequently you may feel that you need to apply for patent protection in one or more countries abroad so that you can prevent others from making, selling or using your invention in those countries. This factsheet explains some of the options open to you once an application for a UK patent has been made.

This factsheet should be treated as an introduction to the topic of foreign filing and not a comprehensive guide.

Filing Abroad

Essential Advice

Because of the additional difficulties associated with obtaining patent protection abroad, you should consider seeking advice from a patent attorney or other professional adviser

When to file

You have **12 months** from the earliest date* of your UK application in which to file a foreign application which claims priority from it. You may still file abroad after this date, but there would be a significant risk that publication of your UK application would then invalidate your foreign or international application.

* the earliest of your filing date or priority date(s).

Where to File

Once you've decided, on a commercial basis, in which countries you wish to gain patent protection, you then have the following options:

- 1: Filing a patent application separately in each country where protection is required.
- 2: Filing a single European patent application (EP) giving protection in a number of countries in the European Patent Convention (EPC).
- 3: Filing a single application under the Patent Cooperation Treaty (PCT) for patent protection in a number of countries throughout the world.

The table overleaf provides a comparison of these options.

How to file

- 1: Independent applications -

Each country has its own fee system and rules governing the patent process. Contact details for other national patent offices are available from our Information Centre on 0300 300 2000.

- 2: European application -

Your EP application may be filed at the European Patent Office or via the UK office. Further information is available from our EPC Unit on: 01633 813550/4885.

- 3: International application -

Your PCT application may be filed at the UK office. Further information and forms are available from our International Unit on: 01633 814586 and from the World Intellectual Property Office (WIPO) website www.wipo.int.

Important: If you decide to file abroad without first applying for a patent at the Intellectual Property Office, you would need to obtain security clearance from us if you are resident in the UK and your application contains information which relates to military technology or would be prejudicial to national security or the safety of the public (as required by section 23 of the Patents Act 1977). If you think you need security clearance, please contact our security section on 01633 813558.

Filing Abroad: The Options

	Applications filed separately in individual countries.	European Patent designating (choosing) which member countries you wish to include.	Patent Cooperation Treaty application designating which countries you wish to include.
Fees	Every country has its own fees.	(For up to date information on fees, please refer to the European Patent Office website: www.epo.org .)	Typically £1764 up to the search stage, and then examination fees in each country for the national phase as of 1 June 2007 £1727.
Language of application	Language of each individual country.	English	English
Verified Translations	The expense of translations may be required at a very early stage.	Translations of claims only required into French and German just before grant.	Translations required by many countries during the national phase.
Address for Service	In general you will need to supply an address for service within each country to which you apply.	In general, an address for service in the UK is sufficient for obtaining a European Patent.	In general you will need to supply an address for service within each country you designate in the national phase.
Advantages	Greatest flexibility regarding where to apply for patent protection.	With a single application you can obtain, at grant, patent protection in all the countries of the EPC you have designated.	A single search suffices for all PCT countries designated giving the opportunity for evaluation of the search report and amendment of the claims prior to further commitment.
Disadvantages	You will need to pay official fees in each country.	If your EP application is turned down, or successfully opposed, you will fail to gain protection in any of the states designated.	There is no single substantive examination, so the PCT application must then be pursued through the national offices of each designated country separately (national phase) with fees and translations where necessary.

All fees are approximate and are intended only to be illustrative of the relative costs. Before filing an EP or PCT application please ensure that you have confirmation of the current fees.

Enquiries: You can contact the Intellectual Property Office on: 0300 300 2000 (local call rate) or Minicom for the hard of hearing: 0300 0200 015. Alternatively visit our website at www.ipo.gov.uk

We are keen to help all our customers as much as possible, but regret that we cannot assist with the commercial exploitation of your invention. This factsheet is not intended to be a comprehensive guide and necessarily omits details which may be relevant in particular circumstances.