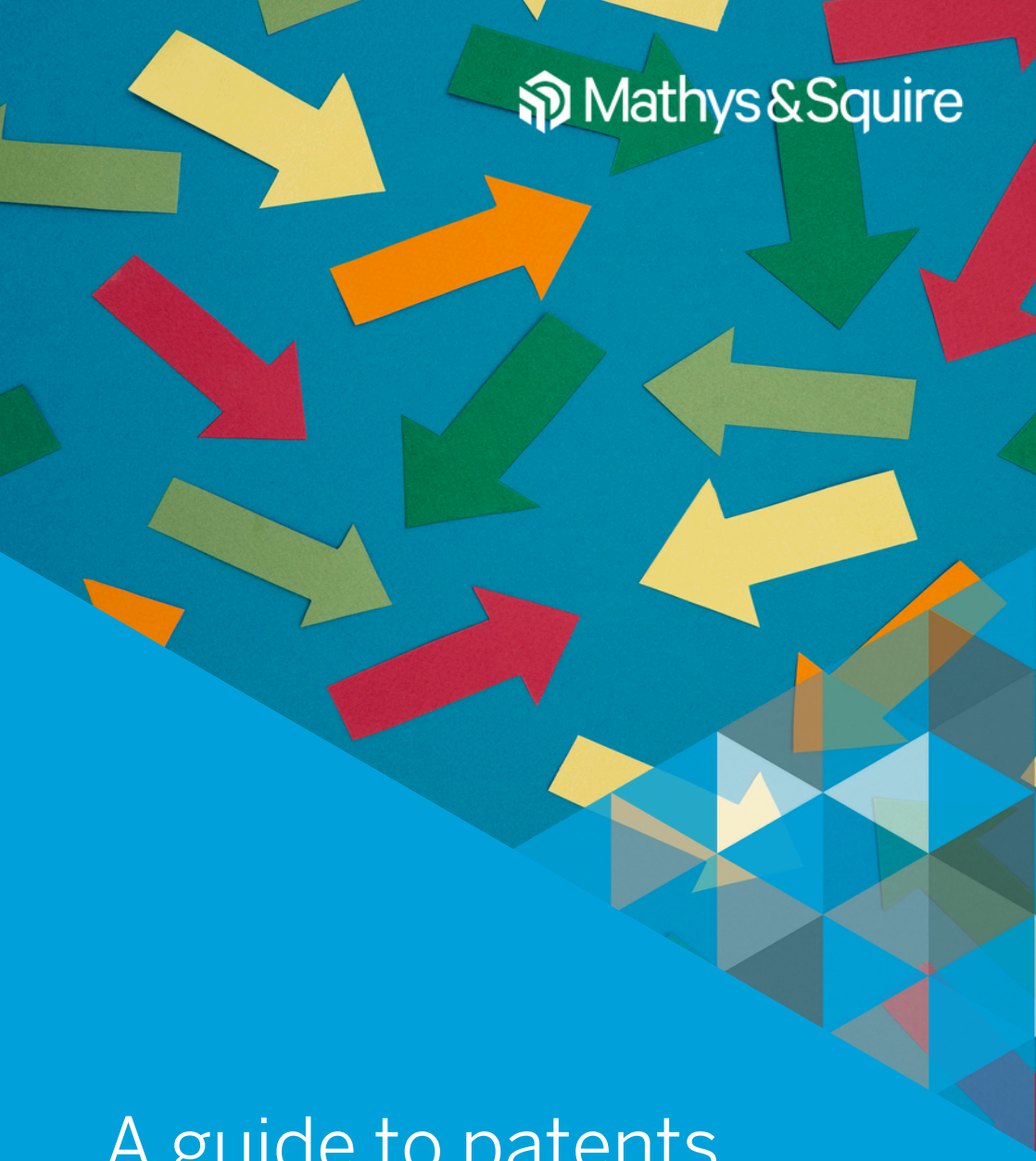


A guide to patents

About Mathys & Squire

Dedicated to protecting and defending your future.

Mathys & Squire is an intellectual property (IP) powerhouse that puts its specialist knowledge to work for clients, to strengthen and secure what most modern businesses today treat as one of their most valuable strategic assets - intellectual property.

The firm's agile teams of attorneys, scientists and strategists are steeped in experience, working with IP-rich and high-growth industries to leverage complex technologies and sophisticated commercial models across a broad range of industry sectors.

A full-service IP firm, Mathys & Squire has unrivalled expertise in patents, trade marks, design protection and litigation. Highly ranked in leading legal and IP directories, and leading the field with insight, innovation and quality, Mathys & Squire celebrated its 115th Anniversary in 2025, testament to its proven track record in the protection and commercialisation of IP rights.

The firm has a broad spread of clients, ranging from start-ups to major UK and global corporations, many of which are household names. Clients of the firm value its commitment to professional excellence and technical expertise.

Mathys & Squire has over 100 attorneys (both training and qualified) and a dedicated IP consulting team across offices in London, Birmingham, Cambridge, Manchester, Newcastle, Oxford, Luxembourg, Munich and Paris, as well as teams based in China and Japan. The firm's attorneys and trainees have a mix of scientific degrees extending from chemistry, biochemistry, pharmacology, genetics, microbiology, plant sciences and zoology through to physics, electronics, telecommunications and engineering.

We are passionate about creating and delivering innovative, high-quality, client-focused services and building close and longstanding relationships with clients in order to establish defensive and offensive IP portfolios that generate commercial value. We are proactive when working with clients and valued for our integrity, honesty and collegiate approach.

We protect, so that you can invent the future.

About this guide

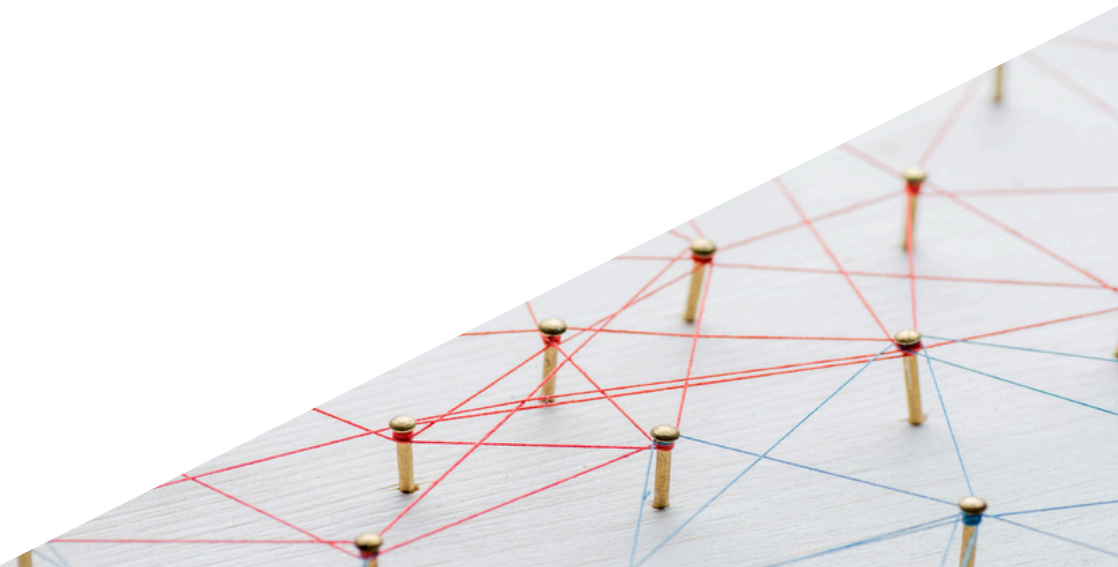
This document is an informal guide to the process of obtaining patent protection. It explains some jargon and addresses many 'frequently asked questions (FAQs)' to guide you along and to help make the process of instructing us simpler.

This guide is directed to the patent process. If you require advice on the process of obtaining trade mark or registered design protection please let us know.

We provide bespoke advice. In any given set of circumstances the correct approach depends on the detail of those circumstances, so if you need legal advice ask us so we can give you advice tailored to fit those circumstances.

"Mathys & Squire LLP's 'absolutely first class team' is 'proactive with advice, but responsive to clients' needs and requirements'. The group is 'very knowledgeable, both from a scientific as well as a business point of view' and 'proactively safeguards clients' interests'."

The Legal 500



Contents

Working with Mathys & Squire 1

A brief overview of Mathys & Squire, the services we provide, and the way in which we work with our clients.

Frequently asked questions (FAQs) 2

Frequently asked questions regarding patent basics, including: what can be patented, timings and costs, and keeping your invention confidential.

Ownership of inventions 12

An overview of the issues relating to the ownership of inventions, including: inventors, employee inventions, and transferring ownership of patents.

The patenting process 15

A description of the process of obtaining a patent, including: drafting and filing a patent, the patent office search and examination, and grant and enforcement, as well as the input we would need from you.

What happens next? 22

Things to bear in mind after your patent application has been filed, and the next steps in the process, including search and examination in more detail, and protecting your invention internationally.

Patent timeline & seeking international protection 25

This timeline illustrates the patent process in the UK and some of the options for seeking patent protection Internationally.

Working with Mathys & Squire

Who we are

We are an international firm of expert European intellectual property (IP) attorneys. We have offices in the UK, Germany, and France, as well as teams based in China and Japan. Our team includes European, British, French and German patent attorneys, trade mark attorneys and design attorneys. Worldwide, we can also help you in any jurisdiction using our well-established network of trusted advisers overseas. These handpicked firms provide our clients with access to the best IP attorneys throughout the world.

What we do

We guide our clients in all aspects of intellectual property including patents, trade marks, designs, and unregistered rights, as well as rights in confidential information such as trade secrets. We work with our clients to secure IP and to build and manage their IP portfolios. We act for our clients at patent offices to obtain and to defend IP rights to protect their businesses and to oppose patents held by others which present a risk.

We represent our clients at the UK Intellectual Property Office (UKIPO), the German Patent Office, the French Patent Office, the Austrian Patent Office and at the European Patent Office (EPO). For trade marks, and for design registrations, we will represent our clients at the UKIPO, the German Patent Office, the Austrian Patent Office, the French Patent Office, and at the EU Intellectual Property Office.

We advise on and negotiate technology partnerships, including confidentiality agreements (NDAs), R&D and IP agreements, IP licences, and contract terms relating to the joint development and licensing of IP. We control risk to protect our clients from the distraction and expense of legal dispute over IP but, when it is needed, we litigate to enforce our clients' rights against infringers.

How we work

We pride ourselves on giving practical, actionable, and business-focused advice, built on commercial and technical understanding of your business. In many situations, there are different options and different possible approaches, and whilst we may discuss options with you, it is sometimes not efficient to discuss with you every possible option at each stage of the process. We will give a clear view of what we see as the best choices based on our understanding of your situation at that time. The more we understand your circumstances, the better we can tailor our advice. As we continue to work together, it is important for you to keep us updated on your commercial situation, any developments in your technology, and your aims for your IP.

Frequently asked questions (FAQs)



What is a patent?

A patent is a national monopoly right, which can be used to prevent third parties exploiting an invention. It can be maintained for 20 years. In return for this monopoly right, the patent applicant reveals the invention to the public in a published patent application in sufficient detail for it to be put into effect.

How long does it take to obtain a patent?

The examination process can be accelerated, and the UK can be particularly fast, but for most jurisdictions typically it would take between one and five years to obtain a granted patent.

How much will it cost?

Initial costs are incurred for drafting and filing the patent specification, for any searching done prior to filing and, potentially, for requesting a search of the application by the patent office. The actual costs vary depending on factors such as the complexity of the invention, how much material you can provide that we can incorporate into the patent application, and how much (if any) searching we need to do prior to filing the application. We can advise on these initial costs in an introductory meeting to discuss your needs and, to some extent, the costs can be tailored to your requirements.

In most projects we can work within a fixed budget, but if the initial brief is incomplete and more information needs to be added later, it is reasonable to expect costs to change too. If you wish to control costs, the best approach is to provide a clear, complete brief up front and stick to it as far as possible.

When the patent office begins to search and examine the application, there are then ongoing costs for liaising with you to report and advise on documents and objections raised by the examiner and to prepare arguments and amendments as necessary to respond to his objections.

Annual official renewal fees are also payable in most countries after the patent is granted and, in some countries, in particular at the EPO, fees are also due while the application is pending.

While some steps of the process may have a fixed cost associated with them, the costs at other stages of the process are highly variable and will depend on a large number of factors. While we will advise you of upcoming deadlines and can give you an idea of the associated costs, it is difficult to agree fixed costs on everything beforehand, particularly before the issuance of a communication from the patent office.

The timing of some of the costs also depends on when examiners at the various patent offices take action, for example to issue an examination report, and this is highly variable and unpredictable.

The cost of responding to an examination report depends on factors such as:

- the objections raised by the examiner; your desired approach – often we have the option of conceding to some of the examiner's
- objections or taking a more aggressive approach of arguing against the objections; and
- the number and relevance of documents cited against the application.

Our advice on how to respond, and therefore the associated costs, is based not only on the examination report, but is also based on our understanding of your commercial aims and situation – please continue to update us as these change.

While we will advise you of upcoming actions that will incur significant costs, minor ongoing costs may be incurred without your specific instructions, particularly where we have instructed attorneys overseas on your behalf. For example, there may be minor costs for reporting a search or examination report to you. Therefore, if you are no longer interested in pursuing IP protection, or if the budget becomes tight, please inform us as soon as possible so that we can minimise ongoing costs.

What are patents for?

Patents provide a right to prevent others from using your invention. They can be licensed, assigned, or used as security for a loan. They can thus be a valuable commercial asset, for example patents can:

- provide exclusivity in a market; demonstrate ownership of particular technologies for collaborations (e.g. joint R&D); provide licensing revenue from markets which a business is not able to exploit itself; be used in cross licensing deals if (or when!) it turns out that competitors hold patents
- covering useful technology; and
- give investors confidence that an enterprise owns and can defend the technology upon which
- its business depends.

What type of technology should I protect with a patent?

You should protect the things which are important to your business. It does not matter whether an idea is simple or complex, if it is of commercial value, talk to us to see whether there is a way it might be protected.

Patents for apparently simple ideas can cover products which are of enormous value. Patent protection may not be available in some instances, but there may be other options to protect your IP. The right approach to each technology, and to each business, depends on the circumstances – there is no one-size-fits-all approach to IP.

I have a patent so does that mean I have 'freedom to operate'?

No. A patent does not provide any positive right to use an invention, it is a negative right to prevent a third party from using the invention. This means that even though you have your own patent or patent application covering a technology, you still need to pay attention to patents held by others in case they are also relevant to that technology.

What can be patented?

Other than in some excluded fields of technology, any technology can be patented provided that it is new and that it meets the legal standard of inventiveness. This legal standard of inventiveness is often very different from what an inventor or engineer might assume to be the case.

In most jurisdictions, to be patentable an invention must be:

- novel (it should not have been publicly disclosed by anyone, for instance, orally, in writing, by use, or otherwise);
- inventive; and
- not belong to an excluded category.

Novelty

Novelty is an objective matter in the sense that it is not a matter of opinion, and it is normally straightforward to assess. If the invention is not novel, i.e. it has been completely made public then it cannot be validly patented in most jurisdictions. Thus, it is vital that you keep your invention strictly confidential until your patent application has actually been filed.

Contact us immediately if your invention has been disclosed but:

- it has only been public for less than 12 months, because patent protection may still be available in the USA; or
- it was made public by a breach of confidence, because it may still be
- possible to obtain patent protection if the breach was less than six months ago.

Inventive step

Inventiveness is a subjective matter, and each jurisdiction has its own criteria for assessment of inventiveness. Frequently we find that inventors believe something cannot be patented because they see it as being obvious. However, the legal standard for inventiveness is not whether an invention is obvious to an imaginative and creative inventor. Instead, the question is whether the invention is obvious to someone who is completely unimaginative. Therefore inventions which might seem simple to an inventor can often still be protected.

Exclusions from patentability

The exclusions from patentability relate primarily to methods of medical treatment and to things which are non-technical or abstract, such as mathematical theories, mental acts, rules for playing a game, business methods, and non-technical software.

Very often even where some aspects of an idea might be excluded from patentability, the practical implementations of that idea might be protectable. Many types of software are patentable, as are techniques based on mathematical methods, such as image processing, video compression, and the control of manufacturing processes amongst many other things.

Often whether something is excluded from patentability or not will depend on how the patent application is written. For example, it would not be possible to patent an equation which predicted how long rubber would take to cure in a mould, but software which used that equation to control a rubber moulding process should not be excluded from patentability.

What is a patent claim?

The claims of a patent application define the scope of the technology for which protection is sought. If the application is granted, the claims will define the extent of the monopoly conferred by the patent. Thus, the claims must not encompass anything which is known or obvious, whilst also encompassing all commercially acceptable implementations of or substitutes for the invention (so-called "work-arounds").

The broadest type of claim is a so-called independent claim, which does not refer back to any other claim. The aim of independent claims is to claim the core inventive concept(s) of the invention as opposed to one specific embodiment of it so as to provide a broad scope of protection.

The dependent claims, which refer back to other claims, provide optional further refinements of the independent claims. Their main purpose is to provide fallback options in the event that the independent claim is found to be invalid for some reason (e.g. if it is found to encompass something which is in the prior art).

When reviewing draft claims, what should I look for?

When we draft a patent application for you, we will ask you to agree the claims with us.

When reviewing these claims you should first satisfy yourself that the features in the independent claims are those which are of the greatest commercial significance and provide the relevant advantage(s) which make the invention useful. Secondly, please ensure that none of the language used in the independent claims is unduly "narrow" and so would leave a commercially sensible work-around outside the scope of the claim.

Thirdly, you should make sure that all of the optional refinements of those features, which might have some advantage, are mentioned in the dependent claims and if not, that we are at least aware of them so they can be included elsewhere in the patent application.

Do I need to tell the patent office about the prior art?

In the UK, there is no enforceable obligation to notify the patent office of prior art. However, we should certainly satisfy ourselves that the claims of your patent application are novel and at least arguably inventive over all of the prior art of which we are aware.

If you file a US patent application, then you must notify the USPTO of all prior art which is material to patentability of the invention. Failure to do so can cause the patent to be unenforceable. If you become aware of any prior art which is relevant to a US patent application of yours, let us know immediately.

Why has the patent office objected to my patent application?

This is entirely normal, and your budget should include provision for dealing with objections raised by the patent office.

We usually start by seeking the broadest possible protection and so drafting the claims in very general terms. If the patent office finds relevant prior art or objects to the claims on other grounds, we often narrow down the scope of the claims to resolve the objection.

Whilst it is possible to start out by drafting very narrow claims to avoid objections and to save cost, this might result in a patent which defines the invention in unnecessarily specific terms, which can make it easier for would-be infringers to design around the patent.

When we draft a patent application with you, we will consult with you to agree the scope of the claims. The likelihood of there being relevant prior art is one of the considerations which you should have in mind when agreeing the claims with us. If there is prior art of which you are aware of, you should let us know before the application is filed.

Do I need to keep everything confidential until I have filed a patent application?

Yes. Any public disclosure at all of an invention before the filing of a patent application is highly prejudicial to the chances of obtaining valid patent protection in most jurisdictions. If you do need to discuss your invention with someone other than a patent attorney before a patent application has been filed then you can use a non-disclosure agreement (NDA) to provide some confidentiality, but filing a patent application first is a far better option.

What is an NDA? What do I need to know about them?

A non-disclosure agreement (or NDA) is used formally to record an obligation of confidence between parties who wish to discuss an idea in secrecy. Often this is done with a view to the parties embarking on a business venture together or one providing investment in the other.

Frequently, inventors and innovator companies use NDAs to protect discussions but there are important caveats:

- If the other party breaches an NDA, that will prevent you from obtaining patent protection unless you act within a strict time limit. However, it is very unlikely that a third party under an NDA would tell you about a breach, so you may not find out about any breach until it is too late.
- If an invention is to be discussed under an NDA, it is important to have a verifiable record of your invention which demonstrates what your ideas were present before that discussion took place. If modifications to your idea are suggested during discussions with another party, they may claim that they contributed to your invention and so they should have a share of your patent application. However, if a patent application is on file before any discussion takes place, then any such dispute is easier to handle. It is very difficult for someone to claim that they contributed to a patent application filed before you met them!

My patent application has been filed. Do I still need to keep my invention secret?

Once a patent application has been filed, telling people about the invention will not invalidate that particular patent application. However, the patent application will not be publicly available for a further 18 months after filing and there may still be disadvantages in disclosing too much detail about how the invention works.

For example, such detail may render obvious improvements to the invention, which could otherwise have been protected in further patent applications. Such details may also provide a 'springboard' to allow others to make inventions or file patent applications which they would not otherwise have been able to do.

Therefore, even after filing, please whenever practicable, consult with us before disclosing the invention and certainly do not disclose anything which is not described and claimed in the application without checking with us first.

I think someone has breached an NDA or improperly gained access to details of my invention. What should I do?

If this has happened, you must let us know immediately.

If a patent application is filed sufficiently quickly, it may still be valid in view of a disclosure made in breach of confidence.

Even if you have already disclosed your invention yourself, it may still be possible to obtain valid patent protection in some jurisdictions (in particular the US) but only if action is taken quickly.

Ownership of inventions



Who owns an invention?

An invention made in the UK is normally owned by the inventor, but if the inventor is employed it is likely that his or her employer will own the invention. For example, if the employee is employed to invent or if the employee is in a senior position (e.g. an employed director) then the employer will normally own the invention.

The circumstances for inventions made by non-employed directors of a company are slightly different, but while legal title in the invention might stay with the inventor, such inventions may well be deemed to be held on trust for the benefit of the company.

If you are in any doubt about the ownership of a patent application, ask us. It is usually simple to resolve with an assignment, and the sooner this is done the better.

Inventions made by non-employees such as consultants or other contractors

Unless the contract says otherwise, an invention made by a contractor will be owned by the contractor. Very often, contracts and consultancy agreements will deal with the ownership of IP, but it may still be worthwhile also to obtain specific assignment of a patent application from a contractor after it has been filed.

Can patents and patent applications be sold or transferred?

Yes. This can be done simply, but a proper patent assignment should be used. Although assignments are a relatively simple matter, there are some pitfalls which can put at risk the ownership and even future validity of the transferred patent rights if things are not handled properly. We can help you by drafting an appropriate assignment and, if necessary, also an agreement to deal with issues related to the transfer of ownership.

Who can file a patent application, and who owns a patent if one is granted?

In the UK, anyone can file a patent application but only the owner of the invention, or his successor in title, will have the right to any eventual patent granted from that application. Thus, if the applicant has not properly secured the ownership of the invention, the true owner of an invention may be able to challenge their entitlement to the invention.

Entitlement challenges in the UK can lead to loss of ownership and/or control of a patent or patent application. A successful challenge to entitlement can also result in a patent being revoked.

It is thus extremely important to ensure that ownership of an invention is clearly understood and documented.

Can I own a patent jointly with somebody else?

Yes, but there are some complications and disadvantages to joint ownership. If you must hold a patent or patent application in joint names then at the earliest possible opportunity, the joint owners should agree the details of how the patent or patent application is going to be managed. We can help you by drafting an agreement to deal with these issues.

Mathys & Squire is the strongest partner we have in Europe. Their work is of the highest quality, is very thorough and sets a benchmark for international collaboration on sophisticated patent issues. They layout options in terms of success rates which is invaluable in helping me make commercial decisions on how to proceed.

Adventip

An overview of the patenting process

Drafting
The first step in the patenting process is to prepare a patent application. The application includes a patent specification, which contains claims which define the scope of the patent monopoly sought and which also describes the invention in sufficient detail for it to be put into effect.

Filing
The application is then filed with a patent office. Usually, we recommend filing applications first with the UK Patent Office before filing them elsewhere later. The choice of patent office depends on a number of factors and we can discuss these with you.

Search and examination
Once a patent application has been filed and the official fees have been paid, the patent office will examine it to determine whether the application can be granted. In particular, the patent office will search for prior art (e.g. earlier publications) and use these to judge whether the invention defined in the application is new and inventive when compared to the prior art that they have found.

We then respond to this examination report, and present counter arguments and/or make amendments to the application to clarify the differences between the invention and the prior art. The process of search & examination is often referred to as the "prosecution" of the patent application.

The application can only be granted once the patent office is satisfied that the application meets all the necessary legal standards. In a small proportion of cases, the application cannot be granted at all and/or a hearing at the patent office may be required to enable us to present oral arguments in support of the application to patent office representatives.

Publication
All patent applications are published before they can be granted. Normally this takes place around 18 months after the application's priority date. If for any reason you decide that you may wish to prevent it from being published, then you must notify us in writing no later than 16 months after the application's priority date.

Enforcement
A patent cannot be enforced until it has been granted. Some provisional legal rights arise upon publication, but these cannot be enforced until the patent has been granted. For example, in the UK, it is possible once a patent has been granted to sue somebody who infringes a patent for acts which took place before grant of the patent but after publication of the application. If you become aware of possible infringement, consult us before approaching any possible infringer. It is possible for a patent proprietor to fall foul of the law by threatening infringement proceedings, even indirectly.

Grant and maintenance
Once the patent has been granted, it is necessary to deal with certain formalities. The extent and complexity of these formalities differs between jurisdictions, as does cost. In the UK, the process is simple and relatively inexpensive. In some other jurisdictions, official fees, attorney fees, and translations are necessary.

To keep a patent in force, it is necessary to pay renewal fees to the patent office in the country in which the patent has been granted. In a few jurisdictions, most notably at the EPO, it is also necessary to pay renewal fees prior to grant.

Preparing a patent application

Pre-filing searches

Your invention may not be new, and if so, it is best to find this out quickly. Preliminary searching, before filing a patent application, can be worthwhile but often official searches by patent office examiners will find more relevant prior art. This is one of the problems with searching. Not finding something in a search does not mean that there is not anything out there to be found.

Often the person who knows the prior art best is the inventor. If the inventor is unsure about the prior art, it is possible to do some searches using standard internet search engines. There are also free publicly available databases that can be used to search the patent literature. One popular patent database is worldwide.espacenet.com.

If you wish, we can do some pre-filing searches for you. The aim of most pre-filing searches will be a quick check that there is no immediately evident reason not to go ahead. Such searches are generally not a comprehensive survey of the prior art, because professional searching costs money, and in most technical fields a comprehensive survey of the prior art would generally cost many times more than the cost of drafting and filing a patent application.

A balance must therefore be struck. On one hand, the drafting attorney needs enough understanding of the prior art to draft a sensible claim which will draw a reasonable search from the patent office. On the other hand, the time and money spent on searching should not go beyond what is reasonable in the circumstances. In practice we often find that the point at which money spent on searching would be better invested in preparing a patent application can be reached quite quickly.

Drafting a patent application

The input we need

We would typically meet with at least one of the inventors in person or virtually to discuss an invention before preparing a patent specification. Such a meeting need not be very long - perhaps an hour or two depending on the invention. This may be followed by a shorter telephone discussion, or an email with additional questions. Typically we would also ask at least one of the inventors to review any patent specification before filing.

In addition to a meeting, or discussing the invention on the telephone, we would appreciate any technical documentation you might have relating to the invention (although this is not essential). This can often form the basis of the description of the patent application. We are also interested in any possible variants of the invention, either already developed or envisaged, and in what the inventors consider to be different or advantageous about their invention, compared to what is known in the technical field.

When preparing to discuss the invention with us, it may be helpful to consider the following questions:

1. What does the invention relate to: a component, a compound or composition, a circuit, a device, a system, software, a manufacturing method, etc.?
2. What is the problem solved by the invention?
3. Has the requirement existed before and how was it solved?
4. What are the advantages of the new invention?
5. Describe how your invention operates. Instead of focusing on what it does, focus on how it does it.
6. How does the invention overcome the disadvantages outlined in (5.) above?
7. What are the advantages and disadvantages associated with the existing solution(s)?
8. In addition to the advantages mentioned in (7.) above, does the invention offer any further benefits?
9. Has the invention been made public (i.e. published, used in a current product, or disclosed to the public by some other means), or is it planned to be revealed in the near future?
10. Can the invention be implemented in more than one way? Are there different examples of how it might be put into effect? If so, tell us but also describe and highlight the best one.
11. Are there any pre-requisites, which have not already been mentioned, necessary for the use of the invention?

The use of AI tools for your application

While generative AI tools are understandably popular, patent law is a complex area and there are a number of risks that the use of AI can present in respect to patents. This is relevant not only to the drafting process, but also to the prosecution of patents that have already been filed.

Confidentiality breaches

Many AI service providers include a notice in their terms of service, stating that any input provided to their AI may be used for training data. As a result, providing confidential information to such models, such as trade secrets or subject matter that has not yet been filed in a patent application, can make them public domain. This could potentially invalidate any future patent applications that may be filed.

This can apply to both paid and free services. It is not always enough to only use models for which you have a paid subscription.

Hidden inaccuracies

Large Language Models are prone to hallucinations. Inaccuracies in technical description can lead to technical disclosures that may be incorrect or create potential sufficiency issues which cannot be rectified after filing. Such discrepancies may not become apparent until years later during enforcement or litigation.

Patentability failures

Generative AI outputs can produce documents that appear to be plausible and like something that could be filed at a patent office. However, patent claims drafted by generative AI may not accurately capture your invention nor align with commercial objections. Furthermore, failure to properly describe the invention in a way that correctly satisfies the requirements set out in law (e.g. clear and sufficiently disclosed) can lead to the application being invalid. If an application is not appropriately structured, it can become impossible to appropriately amend the application to overcome any objections.

Human inventorship requirements

Patents require a named human inventor to appear on the application. Over-reliance on AI can make it difficult to identify human contributions. This can risk future enforcement, but also impact the sufficiency of disclosure if we cannot effectively discuss with inventors, not just what an invention is doing, but how it is doing it.

Evolving legal landscape

The area of generative AI is still in its infancy but developing at an incredibly fast pace. New regulations may apply retrospectively to applications filed today, creating unforeseen complications.

In addition, evolving case law in the UK and abroad has indicated that the use of non-confidential AI for legal advice, or providing the advice of a legal professional to such AI models can waive legal privilege. As a result, during litigation, all such advice may become disclosable to other parties.

Data training risks

Your confidential information may be used to train future AI models, which may then be accessed by competitors. This may give them advantages in improving on your idea or how to design around any IP you may have.

In addition, models trained on copyrighted materials may generate a corresponding output.

Miscommunication with legal representatives

It is part of a patent attorney's role to provide you with advice and discuss legal strategy so that you can make an informed decision on how you wish to proceed. Ultimately, we act on the instruction you provide. If you have used AI to generate your instructions, or review the work a legal representative provides, it can either (a) cause us to act on instructions of which you may not fully appreciate the ramifications until it is too late and (b) increase costs to you in order to fix such problems and ensure everything is legally sound and aligns with your commercial objectives.



What happens next?



After your patent application has been filed

Keep us up to date

Let us know immediately if you make improvements to your invention after filing. If the improvements are important, we can either include them in a follow up patent application claiming priority from the existing patent application (if still within 12 months from the filing date of the initial patent application) or file an entirely new patent application directed to the improvements.

The patent office will search for prior art and raise objections

Once a patent application has been filed and the official fees have been paid, the patent office will examine it to whether the application can be granted. In particular, the patent office will compare the claims of the patent application with any prior art (e.g. earlier publications) and use this to judge whether the invention defined in the application is new and inventive and they will raise objections if they believe there are problems with the application.

Often examination reports look very negative and discouraging. This is normal. Just because objections have been raised does not mean that the objections are correct, and often objections can be overcome quite easily. The cost of responding to an examination report depends on factors such as:

- the nature and complexity of the objections raised by the examiner;
- the number, length and relevance of any prior art documents cited against the application; and
- your desired approach – often we have the option of conceding to some of the examiner's objections or taking a more aggressive approach of arguing against the objections.

Please note: in the UK, there is a strict deadline (called the compliance deadline) by which your application must be deemed in order for grant. If it is not in order by that deadline, it will be finally refused. The deadline is the later of four years and six months after the priority date (or one year after the first examination report). When working with us on UK patent applications, you must bear this deadline in mind.

Foreign filing

There are a number of options for obtaining protection for your idea outside the UK and we will discuss with you which route is most appropriate. The first year after filing your application allows you time to gather information about the market for your invention and the prospects for obtaining a granted patent, so you can judge whether

the expenditure on foreign applications would be justified. Ideally, you should be in a position to make a decision about whether you wish to pursue protection abroad around 11 months after filing, so it is a good idea to act quickly.

International patent applications under the PCT

One route to overseas protection is to file an international patent application within 12 months of filing the first patent application for an invention. The international application is given an effective filing date which is the same as that of the first patent application (the priority date).

The international application does not result in an 'international' patent, but must be converted into one or more individual national or regional patent applications around 30 months from the filing date of the first patent application. Translations of the application into local languages may be required when the application is converted into national and regional applications.

The filing of an international patent application enables the costs of filing individual national patent applications to be deferred for up to around 30 months from the priority date. It also enables any decision as to where to file patent applications to be delayed and provides additional breathing space while you build a market for your product and, if appropriate, bring partners or investors on board to share the cost of national applications.

There is a procedure for international examination, and this must be begun within 19 months of the priority date. It is often not efficient to use this procedure unless the application is to be filed in a very large number of jurisdictions. Therefore we will not prompt you about this deadline unless you ask us to.

European patent applications

A European patent application is a single patent application which can cover multiple European countries which are members of the European Patent Convention (there are currently some 35 members, including nearly all Western European Countries). The European Patent Convention is independent of the European Union (EU) and a European patent can cover countries both inside and outside the EU. A European patent application is examined centrally by the EPO (in English), but upon grant must be converted into a bundle of national patents in those countries where protection is required. Some translations of the patent may be required at this stage.

A European patent application can be filed directly at the European patent office within 12 months from priority, or it can be filed later via an international application as explained above.

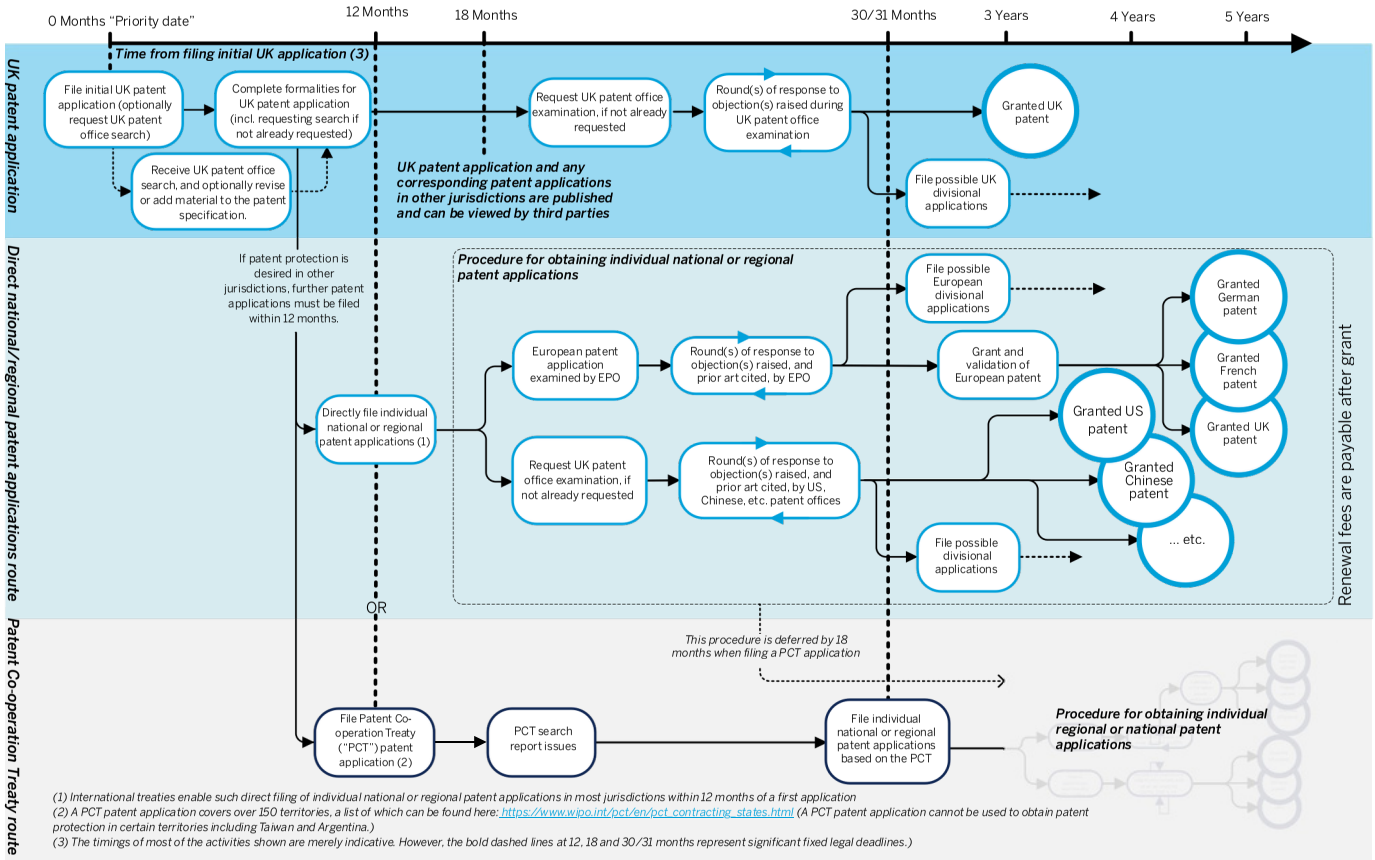
Patent timeline and seeking international patent protection

The following timeline illustrates the usual patent application process (as shown in the top band) for a typical UK patent application from filing through to grant. This timeline also shows two routes by which this UK patent application could be extended to other jurisdictions if patent protection outside of the UK is desired.

The first route for seeking patent protection in other jurisdictions (as shown in the middle band) involves directly filing individual national or regional patent applications in each desired territory (e.g. Europe, US, China, etc.) within 12 months of filing the UK patent application. These individual patent applications will then be examined by the relevant patent offices in each of those territories and the objections raised by those patent offices will need to be overcome to progress the patent applications towards grant.

The second route for seeking patent protection in other jurisdictions (as shown in the bottom band) involves filing a single Patent Co-operation Treaty ("PCT") patent application within 12 months of filing the UK patent application. This PCT patent application effectively reserves the option to file a patent application in over 150 territories.

Filing a PCT patent application at the 12 month stage also defers the decisions and costs associated with seeking patent protection in other jurisdictions for around 18 months compared to the first route, after which the procedure before the relevant national patent offices is substantially the same as with the first route.



(1) International treaties enable such direct filing of individual national or regional patent applications in most jurisdictions within 12 months of a first application
(2) A PCT patent application covers over 150 territories, a list of which can be found here: https://www.wipo.int/pct/en/pct_contracting_states.html (A PCT patent application cannot be used to obtain patent protection in certain territories including Taiwan and Argentina.)
(3) The timings of most of the activities shown are merely indicative. However, the bold dashed lines at 12, 18 and 30/31 months represent significant fixed legal deadlines.)

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