



UK Specific Patent Practice

Samuel Giles

UK Specific Patent Practice

The UK is the 6th largest economy in the world. It also has one of the most efficient, highly regarded, and least costly patent systems in the world. It is an ideal jurisdiction for seeking protection.

Moreover, whilst many applicants use the EPO to gain European patent protection it is often cheaper

to apply in both the UK and Germany for national patents. In our experience this also often enables broader protection to be achieved. The majority of patent litigation in Europe is in the UK and Germany so this strategy is often beneficial.

Benefits of the UK System

Low Official Fees

The UKIPO has low official fees on filing. A standard application requesting full search and examination on filing along with payment of the filing fees only has official fees of £310. This is substantially lower than the filing fees for an EP application (circa £2500 with similar magnitude of costs due a year later). In addition to this, the UKIPO conducts search and examination to a very similar standard to the EPO. This allows for valuable patentability insight early in the prosecution cycle at an economic price point. It is often the case that claims deemed allowable in the UK are granted in subsequently filed EP applications.

Divisional Applications

With such low filing fees, applicants are able to freely file divisional applications to more broadly cover different inventive concepts included in the first filing. This is a cost effective way to build a portfolio and provides an incentive to include in the initial filing a series of secondary inventive concepts. This contrasts with Europe where back-dated renewal fee costs make this strategy unappealing.

A divisional application can only be filed while the parent application is still pending and must be

filed at least three months before the end of the compliance period- see below.

Lower UK Corporation Tax

The UK offers the Patent Box tax incentive, which allows companies to apply a reduced corporation tax rate of 10% on profits earned from patented inventions. This is a large reduction on the standard rate of 25%. This scheme aims to encourage innovation and the commercialization of intellectual property within the UK.

Accelerated Prosecution

UK patent applications that reach grant typically do so within two to three years. However, this can be expedited when writing to the UKIPO and providing a valid reason. Valid reasons could include potential infringement proceedings, wanting to gain early commercial certainty or others.

The UKIPO also offers the green channel for expediting prosecution for environmentally focused applications.

Differences in Law with Europe

Compliance Period

UK applications are subject to a compliance period of four and a half years from the priority date of a patent application or one year from the date on which the first substantive examination report is sent to the applicant (whichever period expires later) in which to get an application in order for grant. This means that applications which are not in such order before the end of the compliance period will be deemed to have been refused.

As with many UK deadlines, there are mechanisms for extending the compliance period, for example, an initial two-month extension is available as of right, and further discretionary extensions may also be available.

Software Inventions

The UKIPO and the EPO use different ways to test the eligibility of software inventions.

The EPO uses its “any hardware” approach coupled with the “Comvik” approach which together essentially import the question of excluded matter into the inventive step analysis. EPO practice often has a low bar for eligible subject matter with this approach but a high bar for inventive step.

The UKIPO instead uses its own “Aerotel/Macrossan” test which imports questions of novelty and inventive step when considering excluded matter. UK practice has a higher bar for eligible subject matter but a relatively lower bar for inventive step when compared with EPO practice.

In the UK there are five signposts indicative of inherent patentability of a computer program related invention. If any of these are demonstrated

then this threshold is overcome. These signposts are that:

1. A technical effect is made on a process carried on outside the computer
2. The technical effect is at the level of the architecture of the computer
3. The technical effect enables the computer to operate in a new way
4. The technical effect is that the computer runs more effectively and efficiently as a computer
5. The technical effect is that a technical problem is overcome by the invention as opposed to being circumvented

In theory the two approaches should produce the same result, but these slight differences in legal tests may better suit some inventions to one jurisdiction over the other. This is important to know when entering jurisdictions and gauging prospects for success or to know which jurisdiction to first apply in when seeking a positive outcome to show to potential investors before international filing.

International Treaties after Brexit

The UK remains a member of the EPC even after Brexit. This allows for protection in the UK through European applications filed at the EPO.

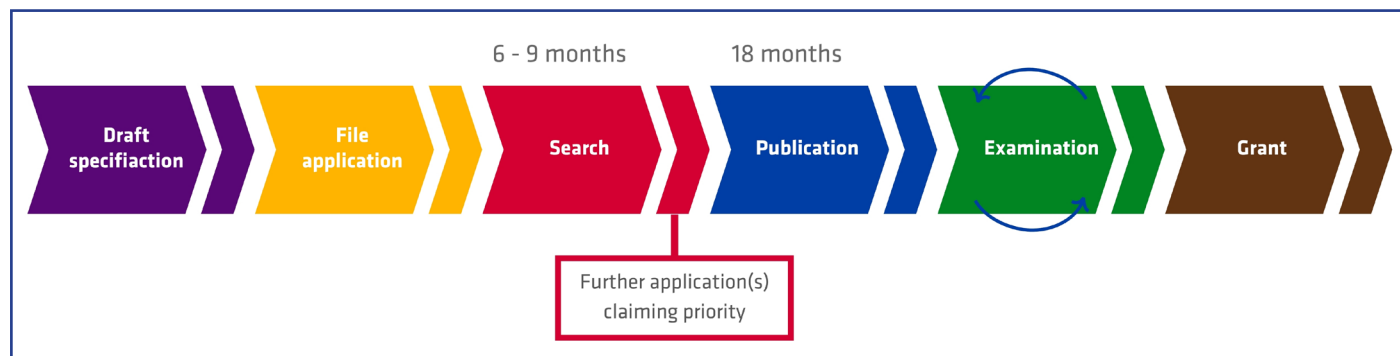
No Opposition Period

An opposition is a cost effective way of challenging a European patent after it grants – within a period of 9 months.

A key point of difference is that there is no opposition period for UK patents. In Europe this period is 9 months. This makes it harder for third parties to challenge granted patents.

Timeline of Prosecution

The below diagram shows a typical UK patent application timeline:



- File GB Application before public disclosure. We normally recommend requesting search and examination on filing (and paying the associated fees) to expedite prosecution and gain earlier commercial certainty.
- The first search report is issued around the 6-9 month mark.
- At 12 months the applicant has the opportunity to file priority claiming applications in other jurisdictions
- Publication takes place at around 18m from priority.
- Request for examination can be requested 6m after publication if not done so on filing.
- Grant *** usually takes place between the 24-36m mark.

*** The UKIPO has two grant dates. An administrative date of grant which terminates all pre grant procedures, i.e. prevents further voluntary amendments being filed or divisional applications.

The second grant date is the mention in the Patents Journal and this marks the point from which rights are enforceable and any post grant procedures may begin.

**MEISSNER BOLTE IS REPRESENTED AT SEVERAL LOCATIONS IN GERMANY
WITH A LOCATION IN GREAT BRITAIN**

HEBDEN BRIDGE

4a Top Land Country Business Park, Cragg Vale, Hebden Bridge HX7 5RW, United Kingdom
T +44 1422 84 45 98 F +44 1422 84 52 89 E mail@meissnerbolte.co.uk