

HINDLES

Patent & Trade Mark Attorneys

INITIAL PATENT APPLICATIONS

The patent system is set up in such a way that you can often file a single initial or 'first' patent application from the outset and delay deciding whether or not you wish to seek protection internationally for up to one year. This year gives the applicant time to further develop the invention and/or investigate its commercial prospects.

In order to obtain granted patent protection in the countries of interest to you, it will eventually be necessary to file patent applications covering each country or region where you wish to receive protection. However, the patent system is set up in such a way that you can often file a single initial patent application at the outset and delay deciding whether or not you wish to seek protection internationally for up to one year. This is because most countries have signed an international agreement (the Paris Convention) which allows patent applications in their country ("later patent applications") to "claim priority" from earlier patent applications in signatory countries.

Provided that certain legal requirements are met, these later patent applications are treated in many ways as if they were filed on the same date as any earlier patent applications from which they claim priority. Accordingly, if there are no unusual circumstances, you should be able to file these later applications within one year of the filing date of your first patent application for the same invention.

The process of claiming priority is an important and very useful part of the patent system, giving you a one year period to further develop your invention and investigate its commercial prospects before deciding whether and to what extent you wish to incur the expense of seeking patent protection abroad.

Filing an initial patent application

We usually file first patent applications with the UK Intellectual Property Office as this is a relatively cheap option. However, there are occasions where it is advisable for first patent applications to be filed at the European Patent Office or, through our US associates, at the US Patent and Trademark Office.

If your first patent application is filed with the UK or European Patent Office, then you have a choice whether or not to have the application put forward for searching (and optionally examination) straight away. We will advise you as to the various options available.

Filing a first patent application obtains a "priority date" for the invention as set out in that application. In assessing the patentability of the first patent application, or any claim of a later patent application which validly claims priority from the first patent application, generally only information made available to the public before the priority date is taken into account. (In some circumstances, the contents of patent applications filed and unpublished before the priority date are also taken into account, but to a limited extent).

Filing a revised patent application

If you make any improvements or amendments to your invention, or think of any new applications of your invention, or come to appreciate the importance of information that is not mentioned in your first patent application, then you should take advice as to whether it is important to file a revised patent application setting out the improvements, amendments and any other relevant information. The filing date of the revised application should become the priority date for the invention as set out in the revised patent application.

Any new information made available to the public by yourself or others before the priority date of the revised patent application will be taken into account in determining the patentability of the invention set out in the revised patent application. It is therefore essential to file a revised patent application before disclosing your improvements, amendments or new applications of your invention. Disclosures made in confidence carry a level of risk and we refer you to our information sheet entitled [Disclosures of Your Invention](#) for further reading.

What happens at the end of the year following the filing of your initial patent application?

If your first patent application was a UK patent application and if you wish to continue further with it, then there will be a deadline of one year from the filing date of that application to file claims and an abstract, and a request for search, if any of these have not already been filed.

If there are no unusual circumstances, then one year from the filing date of your first patent application will also be the deadline for filing any later patent applications in the UK or Paris Convention countries abroad which need to claim priority from your first patent application (and any revised patent applications filed during the intervening year).

As this is the final opportunity which you will have to file patent applications which claim priority from your first patent application, it is important to have made a decision well in advance of this date as to whether and where you will seek international patent protection. The various options at this time are explained in our information sheet: [Patent Protection Around the World](#).

This one year deadline is also the final, convenient opportunity to file revised patent applications which include additional information about your idea and revise the scope of protection which you seek. Again, you should think about whether there have been any important revisions to your idea well

before this date. (Note that any claims to a revision of the invention which are included for the first time in a revised patent application will not be entitled to claim priority from any earlier patent application(s)).

For more information:

- ❖ Visit our website
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