



German IP Information

Patent filing strategy – a brief outline

There are usually several different routes to achieve international protection for a given invention, and it may be useful to review the patent filing strategy from time to time. The following brief overview may help:

1. In general – which routes to international patent protection?

There are “European” (EP) and even “global” (PCT) patent applications, but the resulting protection from granted patents is (still) a purely national matter. Only the application, search and examination procedures can be carried out, at least in part, for several countries at once. It is, however, also possible to file individual national patent applications, and thus to pursue the respective application and examination procedures before the individual patent offices.

There is no general rule for deciding whether an EP or a PCT application is more advantageous compared to corresponding individual applications before the national patent offices. Each filing strategy has its advantages and disadvantages in terms of cost and time implications.

2. First filings

For a first filing, priority-founding application, it is usually crucial to obtain a comprehensive search as quickly and cost-effectively as possible so as to obtain a good overview of the state of the art and the chances of a patent grant before deciding whether to file subsequent applications for the same invention.

2.1 Germany

A first filing with the German Patent and Trademark Office (“Deutsches Patent- und Markenamt”, DPMA) has the advantage of relatively low filing and search fees (40 €* filing fee for an application submitted online with up to 10 patent claims, 300 € search fee or 350 € search and examination fee). For first filings, the DPMA prepares a search report or an initial examination report within 8 months after the date of filing, so that the applicant has sufficient time before the end of the priority year to evaluate the state of the art determined by the examiner. In general, the DPMA is known for a high quality of its searches, and an application can also be submitted to the DPMA in languages other than German where the German translation may then be filed at a later date. In particular, filing in English may be advantageous in view of subsequent international applications, as first filings in English are searched by the DPMA immediately (even prior to submission of a German translation), and, for an application filed in English, the term for filing a German translation increases to 12 months after the filing date (see §35a (2) Patent Law).

Furthermore, a German application offers the possibility of suspending the examination procedure almost indefinitely, so that, for example, it is possible to wait for the result of the examination procedure of a parallel EP application until deciding whether the German application is to be continued or whether it is to be dropped in favour of the German portion of the parallel EP patent.

*: as of December 2017

2.2 UK

As an alternative to the DPMA, the British Patent Office (UK Intellectual Property Office, UKIPO) is particularly suitable for English language first filings. The applicant is usually given an initial assessment with a comprehensive search result after 6 months from the date of filing and the fees are on a similar scale as the DPMA fees (filing fee 20 £* immediately or 30 £* for later payment, search fee for online application 130 £*, Examination fee for online application 80 £*). A special feature of the examination procedure before the UKIPO, however, is that UK Patent Law specifies a compliance period of four years and six months from the date of filing or priority, within which a patent application is to be either granted or refused. Thus, unlike an examination procedure before the DPMA, the UKIPO examination procedure cannot be delayed by several years upon request of the applicant.

2.3 European Patent Office

For the sake of completeness, it should also be mentioned that initial applications can, of course, also be submitted as EP or PCT applications, or before other national patent offices.

An EP application as a first filing is recommended especially for cases wherein patent protection is required only in European Patent Convention countries (see map below).



Map showing the member states (red), extension states (grey) and validation states (blue) of the European Patent Convention (Tunisia since 1.12.17)

Then, an EP patent can be obtained with a single filing and examination process before a single patent office, which can be validated in the desired countries after being granted.

However, an EP application as a first filing has the disadvantage of relatively high official fees (online filing fee 120 €* for applications with up to 15 patent applications and up to 35 pages, designation fee 585 €*, search fee 1300 €*, examination fee 1635 €*). If, after the receipt of the search report, it is determined that the chances for achieving a grant are very low in view of the state of the art, the applicant has thus taken a higher financial risk than with a national first filing.

3. Subsequent applications - national or EP / PCT?

Within 12 months after the filing date of the first application, subsequent applications may be filed which claim the priority date of the first application:

3.1 International (PCT) application

As a subsequent application, a PCT application may be filed, from which national or regional applications can then be derived, after a search and an optional preliminary examination procedure. In the national/ regional phases, a further search and examination is generally carried out by the respective national/ regional patent offices, as shown in the upper section of the diagram above. The main advantage of a PCT application is the fact that the applicant has not only 12 months, but a total of 30 or 31 months from the priority filing date until they need to decide on countries or regions in which patent protection is desired. This can be particularly useful if, for a given innovation, the requirements for international patent protection cannot be foreseen within the 12 month priority period.

The PCT application route also serves to delay the official fees payable at individual national patent offices, since these fees become due only when the respective national / regional phases are entered after 30 or 31 months. In total, the PCT route usually entails higher overall official fees than individual direct national filings. However, this can be partly offset by the fact that, in the case of a positive result of the search or the international preliminary examination of the PCT application, the subsequent examination procedures before the individual national / regional patent offices may be accelerated.

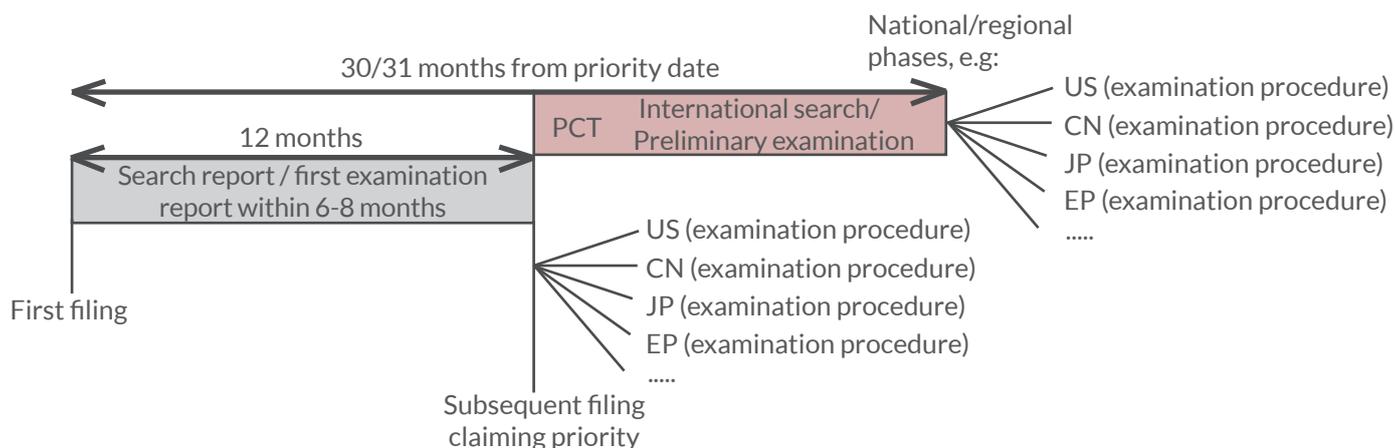
3.2 National Applications

Alternatively, as shown in the lower part of the diagram above, individual national applications may be filed within the priority period.

Thus, instead of a single PCT application, multiple national applications may be filed, e.g. in the USA, Japan and/or China (the filing and examination fees of the corresponding patent offices are listed in the overview table below). If patent protection is required in only a few countries, this approach can reduce the total amount of official fees which are payable until grant of the respective patents. The examination procedures before the individual patent offices then run in parallel. However, it may be possible to use the Patent Prosecution Highway scheme, wherein the European Patent Office (EPO), the German Patent-

and Trademark Office (GPTO), the Japanese Patent Office (JPO), the Korean Intellectual Property Office (KIPO), the State Intellectual Property Office of the People's Republic of China (SIPO) and the United States Patent and Trademark Office (USPTO) have agreed to accelerate the examination before the other patent offices as soon as one of these patent offices has assessed a claim as patentable.

If patent protection is desired in several European Convention countries, an EP application is recommended as a subsequent application.



With an EP patent granted by the EPO, patent protection is achieved in all countries in which the EP patent is subsequently validated. An EP application can also be initiated as a regional phase of a PCT application after 31 months from the priority date of the PCT application.

4. Overview table: Filing, search and examination fees

The following table lists only the fees that are payable upon filing and upon requesting a search or examination procedure. The table does not include any excess claim fees, no annual fees and no fees which are due at grant.

	DPMA	UKIPO	USPTO	JPO	SIPO	EP	PCT
Filing fee	40€*	20£*	280\$*	14000¥*	950 RMB*	120€*	1349€*
Search / Examination	300 oder 350€*	130 + 80£*	150 + 720\$*	118000¥ + 4000¥* per claim	2500 RMB*	1300 + 1635€*	1875€*
Other fees	Reduced examination fee if search has been requested (150€)*		Lower fees for small entities			Designation fee 585€*	(fees for PCT application filed at EPO)



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