

It is generally cheaper to use the PCT route if you know you will want protection in more than five countries.

When one patent application results in several patents in many different countries, all of the patents and applications associated with the original patent application are called the *patent family*. However, exactly what is covered by the final granted patent in each country may vary, for example due to changes made during examination at the different offices.

There are a few regional patent offices which can grant patents for member states of that region. Examples are the African Regional Intellectual Property Organisation (ARIPO) and the European Patent Office (EPO). The EPO is able to search, examine and grant patents in a single procedure for the 38 states which have signed the European Patent Convention. These include some non-European Union states such as Switzerland. There may soon be a new type of patent in Europe called a Unitary Patent which will be obtained via the EPO for most European Union countries. The idea is that once your European patent application is granted you will be able to choose whether the patent becomes a series of individual national patents in the EPO member countries you select; a Unitary Patent where a single patent covers most European Union (EU) countries; or a Unitary Patent with individual patents for any European Patent Convention countries which do not participate in the new system. It may be cheaper and simpler to choose to have one Unitary Patent rather than many national patents. However, at time of writing, the 2016 referendum in the UK to leave the EU has made the future of the Unitary Patent system uncertain.

Some countries have laws which prevent you from filing the first application for a patent family abroad. The restrictions aim to protect national security, but even with a patent relating to chocolate it can be important to file in the correct country (or get the appropriate permission). It can be complicated knowing what is considered “abroad”; as the chocolate industry becomes more international, even medium-sized manufacturers may be based in one country, perform research in a second country, and have inventors who are resident in a third country. If in doubt, seek professional advice.

29.2.3 The life of a patent family

As was described earlier, in order to be granted a patent your invention must be novel. This makes the date of filing important as, when determining novelty, the invention in your patent will be judged against anything published before that date. Fortunately, after you file a patent application in one country you can file applications for the same invention in other countries up to twelve months later and they will be treated as if they were all filed on the original date. An international treaty dating from 1883 called the Paris Convention governs this. The date of filing the first application is called the “priority date”.

There are many different permutations in the way you can file the individual patents in a patent family. A typical sequence for a UK company is shown in

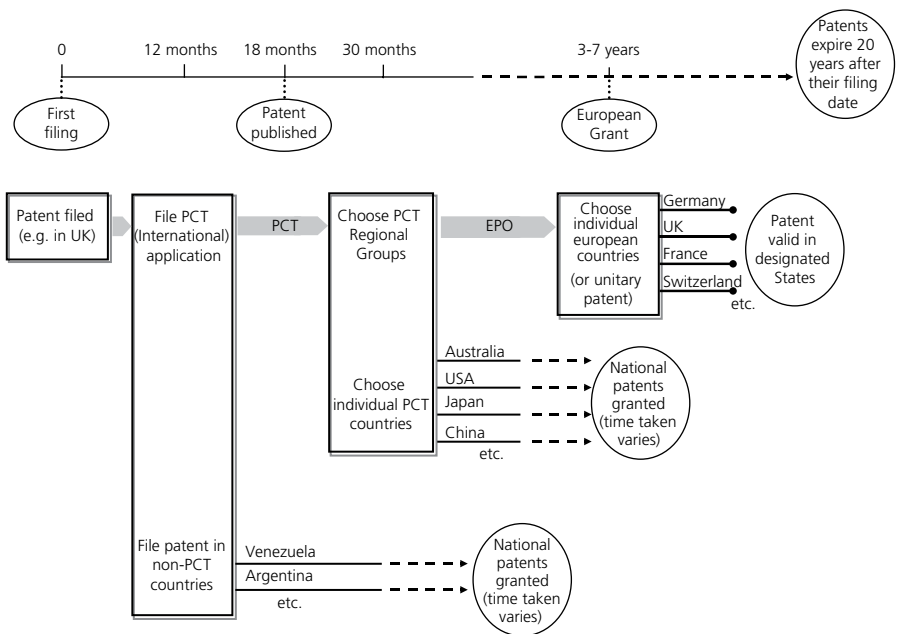


Figure 29.1 Typical timetable for patenting an invention in a number of countries using the PCT system.

Figure 29.1 but a legal advisor such as a patent attorney (see Section 29.10) will be able to advise you on the best approach for your particular situation and the exact timings. For example you might suspect that competitors are likely to copy your invention in a certain country and so you want to be in a position to take action against them as soon as possible (see Section 29.9) by establishing rights in that country.

Obtaining the grant of a patent takes time. Patent offices around the world are under pressure to examine patents more quickly, but it is likely to take several years for a patent to be granted. The patent office examiners enter into a dialogue about whether the invention is patentable, and changes may be required before they agree to grant the patent (or decide to refuse it). You will need to employ local representatives (patent agents) to deal with the different patent offices. Information on the admitted representatives may be obtained directly from the national IP offices. The patent attorney you employ to draft and file your application will usually be able to arrange and manage agents to act on your behalf in the different countries.

Patent applications are sometimes divided, the original application becoming two different applications covering different inventions. The patent office may require this, for example if they consider that your application contains multiple inventions which are not technically related, or the applicant may do this through choice. There are a number of reasons why an applicant might want to