



HSM IP Patent Client Guide

UNITED KINGDOM

Registration

A patent can be registered in the United Kingdom (UK) pursuant to the *Patents Act 1977* which provides for local patent applications.

The following information and documentation is required:

1. a request for the grant of the patent
2. a description of the invention
3. a set of claims
4. any drawings referred to in the description or any claim
5. an abstract
6. statement of inventorship (if there is more than one inventor or applicant is a company)
7. applicant's name and address
8. certified copy of priority document (if priority is claimed)
9. PCT application if required

It usually takes about six months for the UK Patent Office to process an application for registration. Paris Convention priority can be claimed. Once the registration is complete the Patent Office will issue a Registration Certificate. A European Patent (EP), once granted, will automatically confer on its proprietor the same rights as are conferred by a UK patent grant.

Patent Cooperation Treaty

The UK is signatory to the Patent Cooperation Treaty (PCT) and accordingly national phase filing of a PCT patent is possible. This is encouraged if you are seeking coverage in another domicile. A PCT application can simplify the process of seeking a patent in countries that are party to the Patent Cooperation Treaty.

Searches

Whilst there is no requirement to conduct a search in the UK prior to the filing of an application for registration a search is mandatory during the application process to determine the innovativeness of the patent.

Annual Renewal Fees

Once a patent has been registered in the UK there is an annual renewal fee payable to the UK Government. The first fee is due on the fourth anniversary of the application date. Fees for a PCT issued patent are due on the same date. Fees for an EP are due on the first anniversary of the grant of the patent.

Failure to pay an annual renewal fee will cause the patent to lapse. This will effectively prevent any enforcement action being taken.

A grace period of six months, however, is allowed for the late payment of an annual renewal fee upon payment of a late fee. After that time the patent registration will be open to application by a third party.

Expiry

A patent registration is valid for 20 years. Once the registration has expired it cannot be renewed unless it is a pharmaceutical or plant protection product for which a Supplementary Protection Certificate may be obtained.

Abandonment

Please inform us as soon as possible if you wish to abandon your patent or allow it to lapse so that we can update our records and advise the Patent Office accordingly. This will avoid us sending out unnecessary Reminder Notices.

Restoration

It is possible to make an application to the Patent Office to restore an abandoned patent upon payment of a restoration fee and any unpaid annual renewal fees and penalties within 19 months of the patent having lapsed.

Assignment

Please inform us as soon as possible if the patent has been assigned so that we can file an application to record the assignment in the UK.

To record the assignment of a patent registration the only documentation required is the document evidencing the assignment.

It usually takes two months or less for the Patent Office to process an application to record an assignment. Once the recording is complete the Patent Office will issue a Certificate of Assignment.

Change of Particulars

Please inform us as soon as possible if there is any change to the registration so that we can file an application to record the change in the UK.

To record a change of name and/or address for a patent registration no documentation is required unless requested by the Patent Office after the application is filed.

It usually takes two months or less for the Patent Office to process an application to record a Change of Particulars. Once the recording is complete the Patent Office will issue a Certificate showing the change.

Our Firm

HSM IP Ltd. provides worldwide intellectual property services. Based in the Cayman Islands and independently owned and operated, our experienced team of attorneys and paralegals deliver first class service to a broad client base which includes major Fortune Global 500 brand owners, international law firms and other specialist IP practices. Our broad perspective, practical approach and international experience allow us to offer clients a unique insight into IP issues.

The success and growth of our firm is due to our keen understanding of our clients' needs for a comprehensive "one-stop shop" which encompasses a wide range of services from the initial consultation process to searches, registrations, annuity payments and monitoring and renewals. Our interactive database helps us to proactively manage each client's portfolio efficiently and cost-effectively in an environmentally friendly and substantially paperless workplace. It also allows us to fulfil our clients' specific reporting and invoicing requirements, including multi-currency invoicing and e-billing. We offer a competitive schedule of fixed fees, inclusive of both disbursements and official fees, which means we can provide clients with an accurate estimate of their project costs before embarking on a global filing programme for their portfolio.

As a leader in the field, HSM IP understands the value of long-term business relationships. We have a wealth of knowledge and specialise in the Caribbean, Central and Latin America and other offshore jurisdictions. Our staff regularly contribute to leading IP publications and we also publish a range of country-specific IP Client Guides which are available on our website.

Supported by HSM Chambers, an offshore law firm with experienced attorneys admitted in multiple jurisdictions, we have substantial experience in taking action to address the infringement of trade marks and patents and in the conduct of passing-off actions. We are also able to offer investigative services to identify the source of, and distributors of, infringing goods, working closely with police and customs officials as necessary.

Memberships: INTA, ASIPI, CITMA, MARQUES and IPCA.

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HSM IP Ltd. is a Law Firm recognised under the Legal Practitioners (Incorporated Practice) Regulations, 2006 (as amended).

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