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International Patent Protection

A guide for Chinese companies seeking patent protection in the UK and overseas

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Many international systems exist for obtaining cost effective patent protection in territories of commercial importance around the world. In fact the international protection system is not very complex and this fact sheet contains the basic information that Chinese businesses require in order to work out how to obtain the best patent protection globally for their inventions.

International Patent Systems

Businesses should seek patent protection for their inventions if they want to prevent other people copying them, or if they want to obtain a licence from people using them. Patents can also add to value of a business in any sale negotiations and can be extremely important if your business is involved in any international standards organisations. However there is no such thing as a “global patent”. Instead businesses need to select which countries are commercially important to them and ensure that they have patent protection there. The checklist below suggests some ways of deciding which countries are important.

Usually a business will start by protecting an invention in their own country by filing a patent application in that country and then obtaining grant from their national patent office (e.g. SIPO in China). If the company does not obtain protection overseas then people can copy in other territories but not in the company’s own

country. There are two main ways of obtaining overseas protection:

1. **Paris Convention:** Within one year of filing the patent application in your own country you can file patent applications in other countries “claiming priority” from the original patent application. Those patent applications will be examined by the local patent offices in each country in a process that can last months or years but eventually, if you have a patentable invention, you will then have patent protection in multiple countries and be able to sue or licence to third parties who are copying. This option can be preferable if you only intend to file applications in a limited number of countries.
2. **Patent Cooperation Treaty:** In order to defer the cost beyond one year, an alternative option is to use the PCT (Patent Cooperation Treaty). This is also sometimes called an “International Patent Application”. The international patent application covers over 140 countries and the full list can be viewed on the website of the [World Intellectual Property Organization](#) (WIPO). An international patent application must also be filed within twelve months of the original patent application, “claiming priority” from it. It maintains “patent pending” status in all of those countries for an additional 18

International Patenting: Checklist

- 1) Do you have an invention that you would not want other people to copy, or would want to obtain a royalty for?
- 2) If so what countries are important to you, commercially?
 - Probably your home territory, China is important to you.
 - Additionally you might consider other countries where your product would sell successfully.
 - You might also consider countries where your competitors are based.
 - You might also consider countries where there is a similar technology base so that they wouldn't be able to copy your products there.
 - If you only want to protect in your own country then you should contact your patent attorney in China.
- 3) If you want overseas protection then you should consider using the PCT system (option 2 above) to defer costs as far as possible. Your patent attorney will be able to file a PCT application 12 months after the Chinese patent application.
- 4) At the end of the PCT process you should make a final decision about which countries are important to you and ensure that the PCT application is converted into patent applications in those countries. For example if you want to obtain protection in multiple European countries you should consider a European patent application and a list of the UK attorneys who can handle European patent applications is available from <http://www.cipa.org.uk/pages/contact>.
- 5) Alternatively, if you only want to obtain protection in a small number of countries, you may wish to directly file national applications in those countries (option 1 above).
- 6) You should find out the costs involved at every stage and make sure that they fit with the value of your invention. You should also check whether there are any local or central government financial support policies that can help with overseas filing.

months. Only at the end of that period do you need to convert the international patent application into national patent applications in whatever countries you require after which, once again, it will go through an examination process through to grant in each country. This means that the cost of pursuing your patent application in multiple countries is advantageously deferred for up to two and half years. After that you will have to incur the cost of obtaining the patent per country however. Another advantage of filing an international application is that you have a longer period of time in which to decide where you wish to seek protection.

3. **Multi-country systems:** For example in Europe, it is possible to apply for a single "European patent". This is examined at a single patent office, the European Patent Office. Once the patent is granted it is then converted into national patent applications in the European countries of interest. Soon

it will be possible to obtain a single EU patent covering a large part of the European Union through this route although this has not yet been put into place. A European patent application can be filed either at 12 months from the original Chinese filing (using option 1 above) or can be converted from a PCT application (option 2 above). For more information on protecting IP in the UK and Europe please see this [business factsheet](#).

Most global businesses who protect their inventions will file in multiple territories in order to obtain the best commercial position.

What do you need to obtain patents overseas?

It is always advisable to use a patent attorney. In China there are many excellent patent attorney firms who will help you write your patent application and file a Chinese patent application. They will also be able to file a PCT application for you after 12 months (option 2

above). They will also be able to send your patent application to attorneys in other countries to obtain protection there either at 12 months claiming priority (option 1 above) or at the end of the PCT additional 18 months (option 2 above). In Europe, patent attorneys from most European countries can represent your patent application before the European Patent Office. UK patent attorneys, for example, are very high quality and good value for money, and are subject to some of the most rigorous

training in Europe. A list of UK patent attorneys who can handle European patent applications can be obtained from the UK Chartered Institute of Patent Attorneys (CIPA) via our [website](#) or the email address mail@cipa.org.uk.

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