

Patent Strategy 4

Where to file a first non-provisional patent application, as mentioned in
Patent Strategy 3?

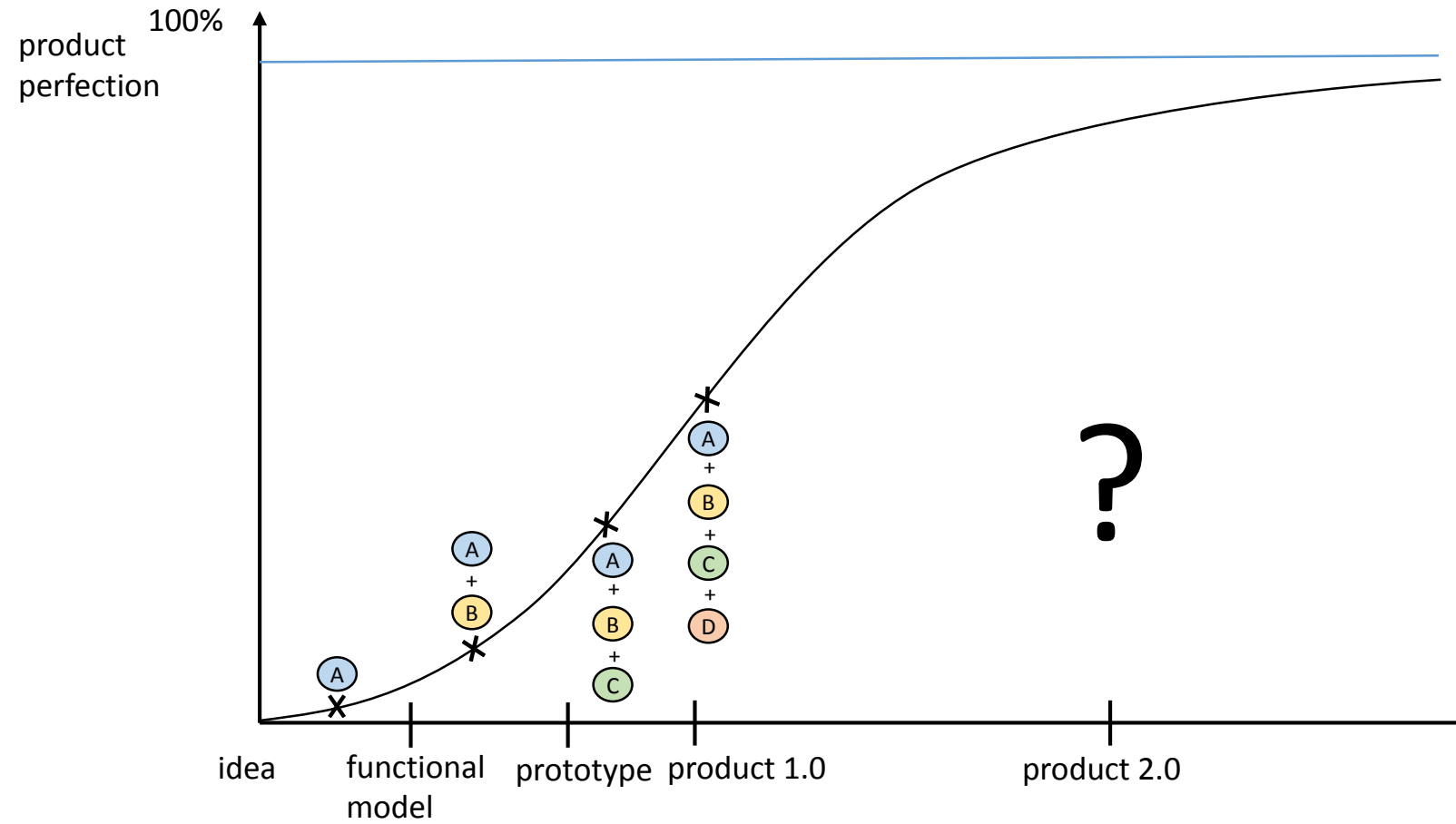
(as of February 2017)

Again The Starting Point

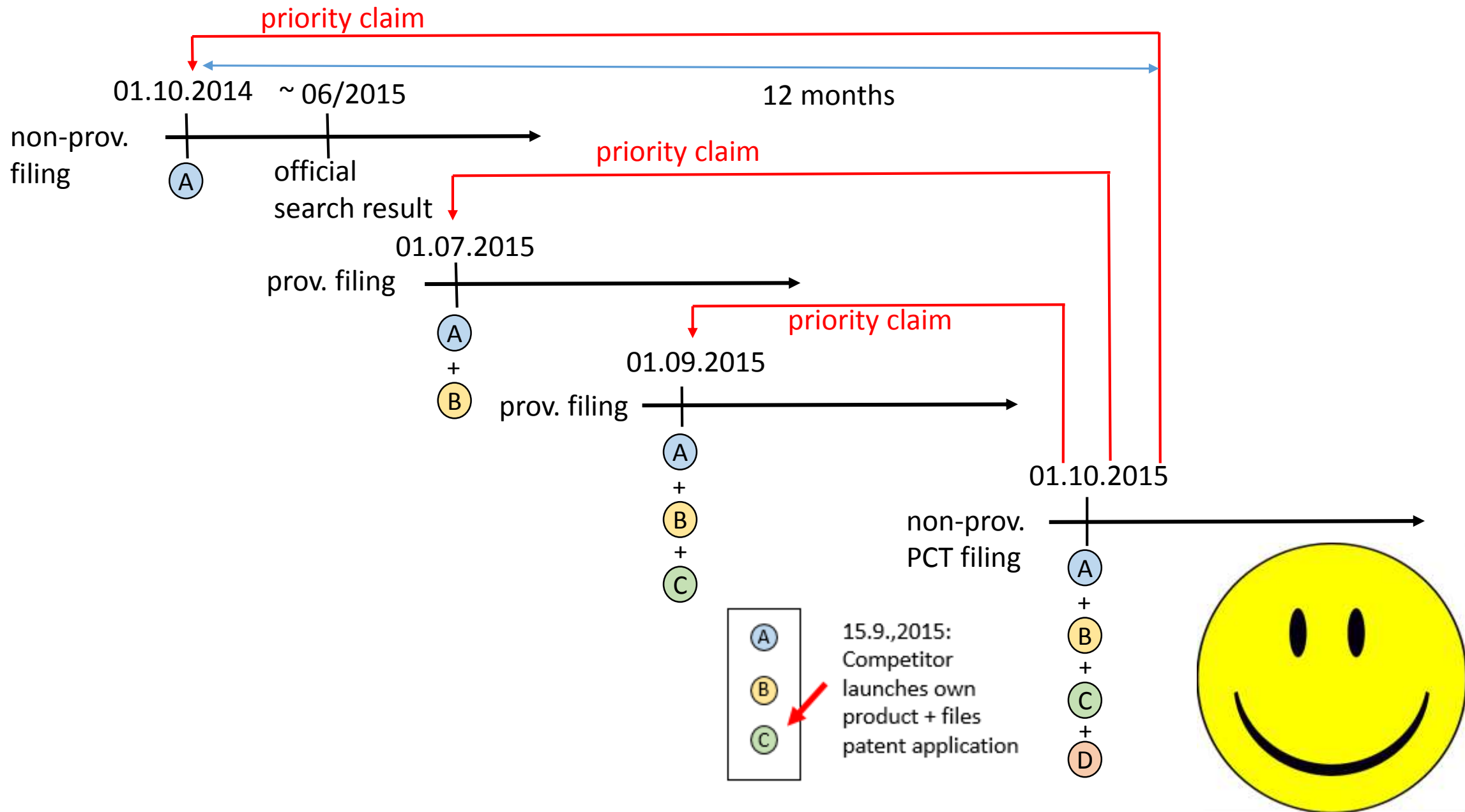
We have a typical product development circle:

- Idea
- Functional Model
- Prototype
- Product 1.0

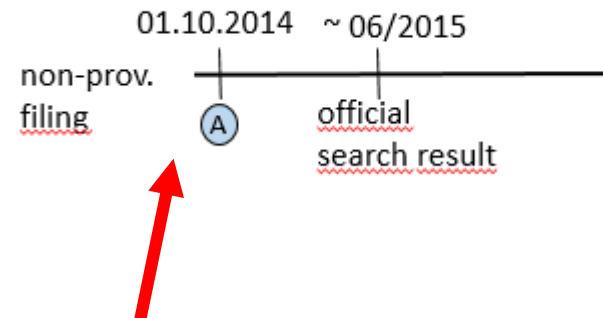
How to use a priority claim for adding subject matter to a patent application



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Let's get specific.



Where to file this first non-provisional patent application ?

Which Patent Office do we chose?

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- **Filing language** - which language are patent applications accepted, for least for carrying out a first official prior art search?
- **Simplicity of filing** – can I do electronic filing online without a chip card and with a filing receipt being issued immediately or do I need to send in a paper patent application via expensive snail mail, which would result in a filing receipt being issued only months after having sent this letter?

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- **Simplicity of obtaining and price of providing a priority document** for later non-provisional filings that claim the respective priority

These were the hard criteria that are related to the patent office.

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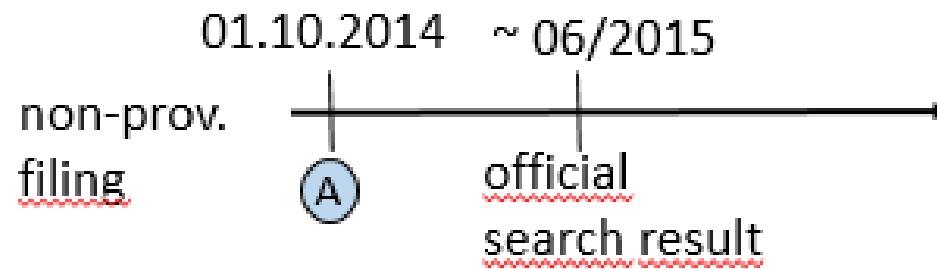
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In practice, it is sometimes better to file a national patent application and to swallow disadvantages such as higher filing fees, just in order to avoid requesting a foreign filing license.

Show down.

Here come my favorite patent offices for a non-provisional first patent application with a search request.



#1: the UK Patent Office

- Language: English only
- Remote filing: very easy e-filing online and payment with credit card
- Advantages:
 - relatively fast & cheap, £ 150
 - the UK IPO is part of the WIPO Digital Access Service (DAS) group, so one just needs to provide the DAS code for retrieving the priority docs when filing at the second patent office, claiming the priority, if the second patent office also participates in DAS (notable offices today: US, CN, KR, JP, WIPO/IB and UK)
- Remark:
 - local representative needed if applicant not a resident in the EU

#2: German Patent and Trademark Office

- Languages: English, German, and French
- Remote filing: Filing via Fax and pay via international money transfer
- Advantages:
 - relatively fast & cheap, EUR 360 for patent applications with not more than 10 patent claims
- Remarks:
 - if filed in English or French language needs a German translation after 12 months if further prosecution is wanted beyond 12 months from the filing date
 - e-filing only with signature card, but paper filing is not a big disadvantage: there are only small discounts for e-filing
 - local DE representative needed if applicant not DE resident

#3: Intellectual Property Office of Singapore

- Language: English only
- Remote filing: relatively easy e-filing online and payment with money transfer from local bank account (but not as straight forward as at the UKIPO)
- Advantage:
 - very fast and good search result (in 2017) but not cheap, S\$ 1,810.00
- Remark:
 - local SG representative needed if applicant not SG resident

#4: European Patent Office

- Languages: English, German, and French
- Remote filing: Filing via Fax and pay via international money transfer
- Advantages:
 - very fast and excellent quality, but not cheap, EUR 1,510.00

Remarks:

- e-filing only with signature card, but paper filing is not a big disadvantage: there are only small discounts for e-filing,
- EP representative needed if applicant not resident in one of the EP countries

What about the other Patent Offices?

- The above is based on what we need on a daily basis for our clients in Germany and Singapore.
- You might need a different Patent Office for first filings, based on your individual requirements, if you run your business elsewhere.

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Therefore:

While the above mentioned criteria for selecting a first filing office do not change, Patent Offices may change over time.

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The above selection is made as of February 2017.
It may change anytime.
