

## Filing restrictions: Where you file matters

When filing a patent application for an invention, some countries impose restrictions on where and how the first application for the invention can be filed. These “first filing” restrictions often dictate the country in which the first filing of the patent application should be made, and allow intellectual property offices to check whether they are happy with the information included in a patent application being circulated to the public.

A country may impose restrictions on the first filing of an application depending on one or more of:

- whether the application is to be filed by a national of that country;
- whether the application is to be filed by a resident of that country; and
- whether the invention claimed in the application was made in that country.

For example, if a resident of the UK was planning on filing a patent application for an invention which was deemed to have been made in the US, then the US code requires the patent application for said invention to be first filed in the US before filing a corresponding application in any other country.

Given their limiting nature, many countries offer ways in which an applicant can alleviate themselves of first filing restrictions. For example, an applicant may be able to apply for a “foreign filing license”. Foreign filing licenses for a particular jurisdiction allow applicants to bypass the first filing restrictions of that jurisdiction, and first file their application in a different jurisdiction.

Understanding first filing restrictions, and the possible ways in which exemptions may be obtained, can be critical in planning an effective filing strategy, especially when an invention involves contributions from multiple inventors and/or applicants having different residences or nationalities. Be aware that violating first filing restrictions can have serious consequences for the applicant and their application. Indeed, failure to abide by first filing restrictions can result in a patent application being refused, and can even result in fines or criminal proceedings.

### **First Filing Restrictions in the UK**

In the UK, first filing restrictions are in place for applications that contain:

- information which relates to military technology, or
- information which might be prejudicial to national security or public safety.

A UK resident must obtain permission from the UKIPO to first file, or cause the first filing of, an application outside of the UK which contains any of the information mentioned above. In other words, a UK resident must first file an application

containing the above-mentioned information in the UK, and/or obtain permission to file the application in other countries.

Note that these restrictions apply to any person who may “cause the filing of” an application, and thus can apply to an agent responsible for preparing a patent application. Moreover, in the case of joint applicants, the restrictions apply if just one of the joint applicants is a UK resident.

At HLK, we can assist you with determining whether UK filing restrictions apply to your invention and, if necessary, obtaining foreign filing permissions.

### **When do the restrictions apply?**

Unless otherwise informed by the UKIPO, the above filing restrictions on applications for an invention no longer apply once a patent application for the same invention has been filed at the UKIPO for longer than six weeks. In other words, unless told otherwise, an applicant is free to file a foreign patent application for their invention provided at least six weeks has passed since first filing a UK patent application for the same invention.

### Consequences of contravening the restrictions

A person found to have knowingly broken the rules regarding first filing restrictions in the UK, or any person who has been “reckless” in breaking said rules, can be fined up to £1000, or imprisoned for up to two years.

The UK is just one of many countries which impose first filing restrictions - see the World Intellectual Property Office’s list of known filing restrictions [here](#). If you would like to discuss potential first filing restrictions on patent applications for your invention, please contact the email below.