

# Patents

A Patent gives the owner of an invention the right to prevent others using it for a period of time, generally a maximum of twenty years. In return, the person seeking the Patent has to provide full details of the invention and allow these to be published by the Patent Office. A Patent can be used to give you a competitive advantage while exploiting the invention yourself, or it can provide a legal basis for licensing someone else to make use of the invention.

## **To be patentable, an invention must meet three requirements:**

1. It must be capable of industrial application and not, for example, a scientific theorem or an artistic creation.
2. It must be new.
3. It must have an "inventive step", that is, it must improve on what was previously known in some manner which is more than merely an obvious modification.

Each of these criteria can present difficulties of judgment and if you are in any doubt please consult us rather than assuming that Patent protection is ruled out.

There may be grants available in certain areas which would assist you in obtaining funding towards the filing of a Patent Application and/or drafting of licensing or other legal documentation associated with the exploitation of the invention. If you would like some further information on these grants, we recommend that you contact your local Enterprise Company.

## **Procedure for Obtaining a Patent**

The normal course in patenting in the United Kingdom is to file initially at the Patent Office an Procedure For Obtaining A Patent informal or Provisional Patent Application. This must be done before there is any public disclosure of the invention, and provides a twelve month period during which time the technical and commercial viability of the invention can be assessed before a full Patent Application is made. During this period, the legend "Patent Applied For" or "Patent Pending" may be used, which can be of considerable deterrent value.

The filing of a Provisional Application also gives a twelve month period in which to decide about Patent

protection abroad. Any foreign Patent Applications filed within this period are treated, in effect, as if they were filed on the same date (termed the priority date) as the original UK Application.

To allow us to prepare and file the Provisional Application, we require enough information to allow us to understand the nature and advantages of the invention and how it relates to what was used previously, either by arranging a meeting to discuss the invention or by your providing us with descriptive notes and sketches. We normally require one to three weeks to prepare the documents and file them at the Patent Office, but it is possible to proceed much more quickly in cases of urgency.

We would emphasize that it is essential to have an Application actually on file at the Patent Office before you make any disclosure of the invention (apart from disclosures in circumstances of confidentiality).

Within the twelve month period, the preparation and filing of a Complete Specification, Claims and Abstract must be undertaken, and Formal Drawings must be filed as required by the Patent Office. Once the complete papers have been filed, the Patent Office will carry out a search through earlier Patents and will issue a search report which gives an indication of the novelty of the invention.

The Application will then proceed to publication, this publication marking the start of a six month period during which substantive examination of the Application has to be requested. Once the request for substantive examination has been filed, the Examiner considers the invention in the light of any specifications located in the search report and makes observations as to patentability. Some expense may be incurred in overcoming any objection the Examiner might raise, and the extent of this expense will be determined by the standpoint taken by the Examiner.

Once the Examiner is satisfied that the invention is patentable, the Patent is granted and lasts for a term of twenty years from the date of the Complete Application, subject to payment of annual renewal fees.

It is possible to have the Patent Office carry out these procedures very much more quickly, at the Applicant's request. This may be desirable for example if infringement occurs, or to support a licence agreement. It is also possible to pursue a rapid UK Application of this type while proceeding also with a European or International Application.

So far as other countries are concerned, as noted above, the filing of a UK Application in effect gives you a twelve-month option period for filing Patent Applications elsewhere. Patents operate mainly on a national basis, with a Patent in a particular country giving the Patent owner the right to prevent others using the invention in that country and to prevent others making or selling in, or importing into, that country articles incorporating the invention. There are a number of international arrangements,

especially the European Patent Office which provides a route by which a single Application procedure leads to grant of a Patent effective in up to thirty-eight (38) European states and a number of extension states which are:

### **Contracting EPO States**

Albania, Austria, Belgium, Bulgaria, Croatia, Cyprus, Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Iceland, Ireland, Italy, Latvia, Liechtenstein, Lithuania, Luxembourg, Macedonia, Malta, Monaco, Netherlands, Norway, Poland, Portugal, Romania, San Marino, Serbia, Slovakia, Slovenia, Spain, Sweden, Switzerland, Turkey, and the United Kingdom

### **Extension States**

Bosnia and Herzegovina, and Montenegro

Similar arrangements to that under the European Patent Convention allow for centralised filing and prosecution of applications in several African countries as well as Eurasia (consisting of Russia and some other former CIS states).

Filing and initial examination procedure may also be simplified under the Patent Cooperation Treaty (PCT) by way of an international patent application (generally filed at the 12 month stage) which can be exploited to delay the significant cost of several separate applications and provide an early indication of the likelihood of obtaining granted protection. A PCT application preserves an applicant's right to file said separate applications in over 140 countries worldwide until 30/31 months from the priority date of the PCT application (the time limit depends on national/regional laws).

Patent applications can be pursued in almost every territory of commercial relevance. However, please contact us if you wish to discuss an international filing strategy as we are extremely well placed to coordinate multi-jurisdictional filing and prosecution strategies on behalf of our clients.