

J A • K E M P

INTRODUCTION TO PATENTS AND TRADE MARKS

PATENT ATTORNEYS • TRADE MARK ATTORNEYS



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PATENTS

WHAT IS A PATENT?

A patent is a legal monopoly granted by a government in return for public disclosure of an invention. A granted patent gives the proprietor the right to prevent others using the invention in the territory to which the patent applies. A patent does not, however, give a positive right to use an invention. There may be earlier patents for other inventions that an inventor may need to license to exploit his own invention.

HOW LONG DOES PATENT PROTECTION LAST?

In most countries a patent can last for twenty years from the date of application. However this is usually dependent upon the payment of annual renewal fees to keep the patent in force.

WHAT CAN I OBTAIN A PATENT FOR?

Patents can be obtained for inventions that, in general, are new and useful products and methods. Patentable inventions must involve an 'inventive step', which means that the invention must be distinguished from what was known previously (the 'prior art') by more than a trivial or obvious feature. A patentable invention could relate, for example, to an entirely new product, a new part for a more complex overall product, a new method of making a product or a new method of using a product.

ARE THERE RESTRICTIONS ON WHAT CAN BE PATENTED?

Yes. In Europe, certain categories of invention are excluded from patentability. Some of these categories are considered to be insufficiently technical to be appropriate for patent protection. Examples include scientific discoveries, mathematical methods, methods of doing business, presentations of information and aesthetic creations. In other cases, such as certain medical methods, there are exclusions for policy reasons. However in practice there are often ways to avoid the exclusions. For example, a scientific discovery may not be patentable, but an application of that discovery in a product may be patentable, or a medical method may not be patentable but a new product for use in the method may be patentable. It should not, therefore, be assumed that an invention cannot be patented before talking to a patent attorney. Exclusions also vary from country to country. Historically, the USA was more willing to grant patents for subject-matter that would have been excluded in Europe as relating to unallowable business methods of computer programs. However, in more recent years, the USA has become more strict about that type of subject-matter too.

CAN I TELL PEOPLE ABOUT MY INVENTION BEFORE I FILE A PATENT?

In general, an invention must be kept secret until a patent application is filed. This is because an invention must be unknown to the public before the filing date of the application, in order for a patent to be obtained. Therefore any public disclosure of the invention before the application is filed could prevent the application from being granted.

WHAT IF MY INVENTION HAS ALREADY BEEN PUBLICLY DISCLOSED?

Certain disclosures can be disregarded - such as those arising from a breach of confidence or displaying the invention at certain international exhibitions - if an application is filed quickly enough after the disclosure. In addition, some countries offer 'grace' periods to disregard disclosures that have originated from the inventor and/or proprietor. If a disclosure has occurred, we recommend you discuss it with a patent attorney as soon as possible to determine if it is still possible to file a patent application.

WHAT CAN I DO WITH A PATENT?

A patent allows the proprietor to exploit his or her invention free of competition from others. They can choose to work the patent themselves, for example by manufacturing the patented product, or they can choose to license other people to use the invention. If anyone uses the patented invention without a licence, they can be sued by the proprietor. If an infringer is successfully prosecuted, they can be stopped and ordered to pay damages and costs.

HOW DO I OBTAIN A PATENT?

A patent is obtained by filing an application with the appropriate Patent Office. Most countries have a national patent system run by a national Patent Office. There are also some regional Patent Offices, such as the European Patent Office, that offer the opportunity to file a single application to obtain protection in many countries.

WHAT DOES A PATENT APPLICATION CONTAIN?

A patent application has two main parts: the description of the invention and the claims. The description is a disclosure of how the invention works. The claims define the protection sought by the applicant.

"Commentators praise J A Kemp's partners for their 'intelligence, creativity and ingenuity' and are delighted with the consistently high quality of their work."



WHAT ARE THE BASIC REQUIREMENTS FOR THE DESCRIPTION?

The description must be clear and sufficient to enable another person to reproduce the invention and its advantages. It is intended to be read by other practitioners in the relevant technological field, and so reasonable knowledge of the relevant technology is assumed.

WHAT ARE THE BASIC REQUIREMENTS FOR THE CLAIMS?

The claims must be clear and relate to the invention described in the description. The claims must define an invention that is different from anything already known (the "prior art"). However the claims must also be drafted with care so that the protection obtained for the invention is not unnecessarily reduced. This is where the services of a patent attorney can be particularly important.

WHAT COSTS ARE THERE ASSOCIATED WITH OBTAINING A PATENT?

Obtaining patents can be expensive, especially if protection is desired in many countries and translation of the patent application is required. The initial costs relate to drafting and filing the application. After that, there are costs associated with responding to any objections being raised by the Patent Office, and there are often additional fees to be paid before a patent is granted.

ARE THERE ANY COSTS AFTER A PATENT HAS BEEN GRANTED?

Most countries charge renewal fees which must be paid after the patent is granted. Sometimes renewal fees must be paid while the application is pending, before the patent is granted. Payment of renewal fees keeps the application or patent from being considered withdrawn. The renewal cost generally increases during the term of a patent and varies by country. If the proprietor wishes to enforce the patent there will be legal costs associated with suing the infringer, which can be very significant.

IS IT NECESSARY TO SEEK PATENT PROTECTION IN ALL COUNTRIES AT THE SAME TIME?

When a patent application is filed in one country, equivalent cases directed to the same invention can be filed in other countries within one year and claim the "priority date" of the initial filing. This means that they are regarded as having been filed when the first case was filed. Thus the applicant has at least this year long period from filing an initial application in their own country to decide whether to spend money filing applications abroad.

WHEN CAN I ENFORCE MY PATENT?

While a patent application is pending, the proprietor's rights are very limited. A patent cannot usually be enforced until it has been granted.



TRADE MARKS

WHAT IS A TRADE MARK?

A trade mark, often known as a brand, is a sign (whether it is a word, logo or something else capable of graphic representation) which identifies your goods or services from those of another. It is the badge by which customers find your product or services in the marketplace, and know how to find it again. Following use, a trade mark becomes a symbol with which your reputation and goodwill are associated. It is therefore likely to be one of your most important assets, deserving the best possible protection.

HOW CAN YOU PROTECT IT?

In 'common law' countries such as the UK, a measure of protection is achieved following use of a brand and the acquisition of a reputation associated with it. However these so-called 'common law' rights are often weak, can be difficult to prove, and are even harder to enforce. They are also not available in many countries of the world. As a result, the law provides a system, in almost all countries, whereby traders can register a trade mark for particular goods or services of interest, and gain exclusive rights to use it for those goods or services, whilst protection can extend to related goods or services when certain criteria are fulfilled.

WHAT CAN BE PROTECTED?

With a few exceptions, anything can be registered as a trade mark so long as it is capable of identifying one trader's goods or services from those of another. Signs that fall foul of these requirements are ones that cannot perform this function for one reason or another, usually because:

- They lack any distinctive or identifying feature which enables the public to recognise the sign as a trade mark, and/or
- They describe a characteristic of the goods or services or the sign is the generic name for, or the shape or other characteristic of, the goods.

A trade mark attorney can advise you on whether or not your chosen brand can be protected. An attorney can also represent you in trying to overcome objections from the authorities or third parties who may challenge your application or registration

WHERE CAN IT BE PROTECTED?

Most countries in the world offer a trade mark registration system, though the protection is territorial and will be limited to that territory once registration is achieved. Trade is usually international and there are some 'supranational' systems (the EU has one) that reflect this. The World Intellectual Property Office offers a system which can assist in protecting a trade mark on a multi-regional basis in a cost effective manner. A trade mark attorney can advise you on how to protect your mark in as wide or narrow an area as you require, devising and prosecuting a trade mark filing strategy that will give you the protection that you need.

HOW LONG DOES THE PROTECTION LAST?

Unlike a patent or design registration, in theory the monopoly in a trade mark registration is open ended, so long as the registration is renewed at the required time (usually every 10 years). You also need to use your trade mark in the jurisdiction of registration, or that registration can become unenforceable against third party infringement, and open to challenge on the basis of this non-use. A trade mark attorney in conjunction with a renewals agency will ensure that you are reminded when a particular registration is due for renewal. Should the need arise, an attorney will also advise on questions of use of a trade mark and defend against applications to cancel a registration.

WHAT SHOULD I DO WHEN I AM CHOOSING A TRADE MARK?

A trade mark, unlike a patent or design, does not need to be original to be protected. However you cannot just choose any name or logo for your new product, because someone else may already have registered it or something similar. A trade mark attorney's service includes searching existing brands on the register and/or in the market, and assessing the possible risks associated with the planned use and registration of your chosen trade mark. You need this information to decide whether or not to proceed

WHAT IF SOMEONE ELSE ADOPTS A TRADE MARK THE SAME AS OR SIMILAR TO MY OWN?

It is a fact of life that the more successful a brand becomes, the more others try to imitate it. Where those imitations are identical to an earlier trade mark, are likely to cause confusion with it, take unfair advantage of it or have the potential to damage its reputation, a trade mark registration can be used to prevent the imitation. A trade mark attorney can advise you on action to prevent third party infringements of your rights, as well as action to prevent third parties trying to register trade marks that are too close to your own. An attorney can also advise you on how to defend against a third party's objection, in relation to either your use of the trade mark or your application to register it.

HOW CAN I CHECK TO SEE IF OTHERS ARE ADOPTING TRADE MARKS SIMILAR TO MY OWN?

The benefits of trade mark registration mean that most companies who use or intend to use a trade mark will apply to register it as well. A trade mark attorney's service includes watching the trade mark registers around the world and notifying you of potentially conflicting trade mark applications filed by a third party, so that you can decide to object to that application if you wish. An attorney can also watch company name registrations, domain name registrations, and use of a trade mark in a particular market.

WHAT ABOUT MY OTHER REGISTERED NAMES, SUCH AS DOMAIN NAMES OR COMPANY NAMES?

Unlike a trade mark registration, the registration of a company or domain name does not give you an exclusive right to that name. All it does is prevent others from registering that exact name themselves. A trade mark registration can be used to prevent third party registration of similar company or domain names. A trade mark attorney can act on your behalf in actions to stop registrations that could be a threat to your business.

HOW SHOULD I USE MY TRADE MARK?

It is a good idea to notify to third parties that you consider your brand is a trade mark. This can be done by using the ™ symbol next to the mark, or, once registration is achieved (not before), the ® symbol. A trade mark should not be used as a substitute for the common name of the relevant goods or services. Ideally, you should use your trade mark as if it were an adjective, followed by the name of the goods or services it is used in relation to. It should also always be differentiated from surrounding text. It is also a good idea to indicate on product literature that the trade mark belongs to you.



ABOUT THE FIRM

We are one of the largest UK and European Patent and Trade Mark Attorney firms, with offices in London, Paris, Oxford, Cambridge, and Munich.

The firm is known for the breadth and depth of its technical knowledge relevant to patents. There are over 80 science and technology graduates in J A Kemp, including over 45 PhDs, and no area of science or technology is outside its scope.

Our trade marks team is led by senior professionals with backgrounds in major international law firms. The team has the expertise and resources to handle any trade marks matter.

J A Kemp provides support for contentious intellectual property matters in the High Court of England and Wales, the Intellectual Property Enterprise Court, the UK Intellectual Property Office, the European Patent Office and European Union Intellectual Property Office (EUIPO), plus their

respective appeal courts. The IP Litigation and Dispute Resolution Support Group combines in-depth knowledge of patents, trade marks and designs. The Group consists of qualified solicitors, patent and trade mark attorney litigators who provide support services in order to achieve successful outcomes for the firm's clients.

We handle all aspects of design protection in the UK, Europe and worldwide, and we can advise you in other specialised areas such as plant variety rights.

We work for a large variety of clients, from startups, spinouts and SMEs through to some of the largest corporations and most prestigious academic institutions in the world.

WHAT WE ARE KNOWN FOR

We commissioned a market research firm to ask 50 of our clients and professional contacts what they thought of J A Kemp. The firm was described as:

"Highly regarded and respected as a leading player in its field"

"Known for quality, reliability, technical excellence and professionalism"

"Considered to be responsive, trusted, friendly and approachable"

"Known for its particular expertise in complex work"

"A firm with a reputation for timeliness and efficiency"

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