



Introduction to 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 use of a known drug 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, for example. 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.

What are the basic requirements for the description?

The description must be clear and sufficient to enable another person to reproduce the invention and achieve 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.

It is also possible to file an international patent application if you are looking for patent protection in multiple countries. An international application does not lead to an international patent covering multiple territories - rather it must be converted into separate applications in the countries of interest. This conversion does not need to be done until 30 months after the initial “priority” filing, so it can be a useful way to gain further time to decide whether or not to spend money on filing abroad. An international patent application can be used to gain protection in most countries in the world, though there are a few exceptions.

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.

For more information, please contact:

Lucy Barnes – lbarnes@jakemp.com

James Cracknell – jcracknell@jakemp.com

Joseph Simon-Brown – jsimon-brown@jakemp.com

Vicki Allen – vallen@jakemp.com