

Creating Tomorrow's Commercial Lawyers

Toolkits

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Patents Explained

Introduction

Inventions can be incredibly valuable. However, an invention that is not protected can be used by others to their own advantage. Therefore, it is worth considering the potential benefits that patenting an invention could have. This toolkit provides an outline of a provision for the protection of an invention: a patent.

What is a patent?

A patent is a right granted by a government to the applicant of a patent application. It gives patent proprietors the power to stop others from making, using, offering for sale, selling, keeping or importing the invention defined in their patent without their consent. In other words, it is an exclusive monopoly right to a given invention. Any patent that is granted by the UK government is limited to UK territory alone i.e. the invention may be replicated in other jurisdictions. In order to protect the invention in multiple jurisdictions, it is therefore necessary to file patent applications in each territory where protection is sought. Furthermore, a patent is also considered a property right, which means it can be used in the same way as any other kind of property – e.g. sold, licensed, used as security for a loan. A patent is only considered a 'negative right' i.e. it stops other people using the invention. It is not a 'positive right' meaning it does not give the inventor rights to do things they would not have been able to do, other than bring legal action against others in respect of the invention.

How long does a patent last?

Patents last up to 20 years from the date of filing the patent application subject to the payment of renewal fees, which in the UK are annual fees payable from the 4th anniversary of the filing date. Much like in the UK, the period of protection for a patent in many other jurisdictions worldwide is 20 years. The costs of submitting an international patent application can be high, for example to do so in Japan you must cover the costs of translating it into Japanese and cover professional and official costs.

What are the benefits of a patent?

- **Benefits for an inventor**

A patent grants a monopoly right to its owner that can prevent others from using the invention defined by the patent, in this sense a patent can be of a great value to its owner. For instance, the owner can have

exclusivity in a given market for a product or service, which can therefore act as a way to differentiate the owner's company from its competition. It also means that rivals will have to approach the patentee to receive a license for the invention if they wish to carry out an act that would be considered an infringement of the patent rights without risking legal action from the patent proprietor.

- **Benefits for society**

By granting legal protection and exclusivity of use to its owner, the patent system is an incentive for innovation and investment. Furthermore, the patent system is based on the principle that a proprietor of a patent will be granted a monopoly right for their invention provided they disclose the invention to world in a manner that will allow others to implement it once the patent rights have expired or lapsed. Hence, the patent system promotes the circulation of the information and technology transfer.

What types of inventions are patentable?

The three step test

For an invention to be patentable it must meet three criteria:

1. **A patent must be novel**

An invention is novel or new if it does not form what is known as the 'state of the art'. In other words, the invention should not have been disclosed (orally or in writing) prior to the filing of the patent application. The UK applies the principle of "absolute novelty", which means that all material made available to the public before an application for a patent is filed, whether in the UK or elsewhere, forms part of the state of the art. Furthermore, it will suffice to destroy novelty if the invention has been made available to the public, regardless of whether somebody has actually seen the disclosure.

Nevertheless, there are two exceptions in which the disclosure is not prejudicial, namely disclosure made in breach of confidence (where there is a confidentiality or non-disclosure agreement) and in the rare case when the invention had been made available to the public in certain types of international exhibitions. In these cases, the inventor has up to 6 months from when invention was disclosed to file a patent application.

2. **A patent must involve inventiveness**

An invention must involve inventiveness ('inventive step'). Inventiveness or non-obviousness is proved if the invention is not obvious to a person who is skilled in the field of the invention in the country concerned based on the available prior art (i.e., disclosures forming part of the state of the art) and the common general knowledge of the skilled person. Nevertheless, simplicity is not a barrier to inventive step. For instance, a baby water cup with a specific valve that stops water from going through when the cup is placed vertically might well be patentable.

3. **Industrial application**

An invention shall only be patented if it is capable of industrial application. This means it must be proved that it can be made or used in any kind of industry, including agriculture.

Exclusions

The following categories are considered to not be patentable inventions under the UK Patents Act and the European Patent Convention:

- Discoveries, scientific theories and mathematical methods;
- Literary, dramatic, musical or artistic works or any other aesthetic creation;
- A scheme, rule or method for performing a mental act, playing a game or doing business, or a program for a computer; and
- The presentation of information

However, the aforementioned categories are only considered not to be inventions to the extent that the patent or the application for a patent relates to those things “as such” on their own. For instance, a computer program operating in a standard way is generally not a patentable invention in the UK. However, in the UK a computer program may be considered an invention if it provides a technical effect or a technical contribution that can be attributed to the computer program when it runs on a piece of hardware.

Patents cannot be granted when the invention:

- If used commercially, would be contrary to public policy or morality (regardless of the laws of a State);
- Is a plant or animal variety or a biological process for the production of plants or animals (however, microbiological processes or the products of microbiological processes may be patentable);
- Consist of a method for treatment of the human or animal body by surgery or therapy and diagnostic methods practiced on the human or animal body (please note that this provision does not apply to an invention consisting of a substance or composition for use in any of these methods).

How to apply for a patent

- **Who can apply for a patent?**

In the UK, anyone can apply for a patent on a given invention, but the patent should only be granted to the rightful owner of the invention. This can be a person or a company. Ownership begins with the inventors, though there are legal provisions that may mean ownership is automatically transferred to an employer. Clauses relating to patent ownership are often included in contracts and agreements, so it is important to check that the application is put into the correct name before it is granted.

- **When to apply for a patent?**

A patent must be novel and inventive in order to be granted. Novelty can be destroyed by disclosure of your idea before the filing of your patent application. Therefore, it is very important to file a patent application before you disclose the invention. However, even if you have disclosed your idea there may still be ways to protect your idea – it is always best to seek advice.

It is possible to discuss an invention with a patent attorney. Communications with a patent attorney are confidential and will not destroy novelty. In addition, a carefully drafted non-disclosure agreement can be used to protect the novelty of an invention when discussing with third parties.

The timing of a patent application is also important. In the UK a patent is granted to the person who files for a patent first. So when two people make the same invention, the patent is granted to the person who first filed the patent application.

- **Where to apply for a patent?**

The UK Intellectual Property Office (“UKIPO”) can grant a UK patent. The European Patent Office (“EPO”) can grant a European patent that is valid in the UK and other European countries, depending on where the applicant wishes to obtain a patent. The patent application at the EPO can also be filed at the UKIPO. In addition, an international application can be made under the Patent Cooperation Treaty. However this application does not grant a patent that is valid worldwide, but gives the applicant time to decide in which countries he wants to apply for a patent. After the priority date (i.e., the date the first patent application relating to a given invention is filed), the applicant has a period of twelve months during which corresponding patent applications may be filed in or in respect of foreign countries. Applications in those countries are then entitled to claim the same priority date as was established by the initial application.

- **How does the procedure work?**

The following outlines the procedure in obtaining a patent:

The applicant applies for a patent, including a detailed description of the invention.



The filing date of the application is confirmed by the Patent Office. On request of the applicant the patent office will conduct a search for other patents and documents that can be relevant for the assessment of the patentability of the invention defined in the application. The Patent Office will also examine if the formal requirements are met.



The patent application is published after 18 months of the earliest priority date of the patent application.



After publication the applicant has up to 6 months to request a detailed examination of the patent application by the patent office.



The patent is granted by the patent office if all requirements are met.

It is important to note that the patent application must describe the invention in sufficient detail to allow a person skilled in the art to recreate it. Furthermore, once an application has been filed the opportunities to amend the application and/or provide further information on the invention are limited.

Conclusion

Protecting an invention by a patent can have great benefits. However, there are many considerations that can influence the decision to patent an invention. Whether a patent is the best protection for an invention, if patentable at all, will depend on the facts at hand. It should be noted that the only way to enforce rights given by the patent is to commence expensive legal proceedings. The patentee is solely responsible for policing the patent not the IPO.

The patenting process is complex and this document provides only a brief overview. Further information can be found at <http://ipfoundry.io/>