

THE EXCLUSIVE USE OF



An introduction to Patents

Patents are a form of intellectual property right that protect new concepts and ideas.

A **PATENT** MUST BE FILED BEFORE THE INVENTION IS PUBLICLY DISCLOSED

- REGISTRABLE IP RIGHT
- PROTECTS PRODUCTS AND PROCESS
- NOVEL
- INVENTIVE STEP
- INDUSTRIAL APPLICATION
- PROTECTION LASTS 20 YRS

Patents are a form of intellectual property right that protect new concepts and ideas.

For a valid Patent to be obtained, an invention must be:

- New with respect to anything publicly available anywhere in the world prior to the filing of the Patent Application,
- non-obvious with regard to anything publicly available,
- capable of industrial application.

Consequently, if you wish to protect an invention, a Patent Application must be filed before the invention is publicly disclosed. A non-confidential disclosure of an invention before the filing of a Patent Application (whether by yourself or by others) will result in your invention no longer being 'new' and may prevent you from obtaining a valid Patent.

Once a Patent Application is filed, the invention can be publicly disclosed, even though a Patent may not be granted for some time (typically four or more years). A Patent may only be enforced in a Court after it has been granted.

Under UK and European patent law, certain categories of invention are defined as not being patentable. These categories include:

- Discoveries, scientific theories and mathematical methods,
- aesthetic creations,
- rules and methods for performing mental acts, playing games or doing business, and programs for computers,
- presentations of information,
- varieties of animals or plants and essentially biological processes for the production of animals or plants,
- methods of treatment by surgery or therapy.

The field of non-patentable inventions is a complex and developing area of law and some of these exclusions are not as far reaching as they may first appear. For example, under European patent law it is usually possible to patent a computer implemented invention where the invention provides an inventive 'technical' contribution

to the prior art. We can provide you with specific advice if you believe your invention falls into one of these exclusions.

The owner of the Patent is usually the inventor of the invention. However, where the invention has resulted from an employee's normal duties or where the employee has been specifically assigned to invent (outside of his normal duties), the owner of the Patent is the employer.

A Patent is a territorial right and may only be enforced for activities carried out in the country in which it is granted. For example, a UK Patent may not be used to stop manufacture in China, but may be used to stop a product from being imported to the UK. In most countries, a Patent may be enforced from the date of grant for up to twenty years from the filing date of the Patent. This term is subject to the payment of yearly renewal fees to the Patent Office of the relevant country.



A PATENT IS A TERRITORIAL RIGHT AND MAY ONLY BE ENFORCED FOR ACTIVITIES CARRIED OUT IN THE COUNTRY IN WHICH IT IS GRANTED

It is important to remember that you are not necessarily free to use an invention even if you have Patent protection for the invention. To check your freedom to use an invention, an infringement clearance search should be conducted for the countries of interest. We can provide you with this service if you are concerned that you may be infringing a third parties' Patent.

UK PATENT APPLICATION PROCESS

1 Preparation and filing of a full UK patent application with a request for search – Approximately £2000 to £3000 (excluding VAT).*



2 Approximately 6 months from (1). Receive search results from the UK Intellectual Property Office.



3 12 months from (1). Deadline for filing Patent Applications abroad (Optional). Deadline for re-filing UK Patent Application with new embodiments (Optional).

4 18 months from (1). Publication of Patent Application.



5 2 years from (1). Request examination of the Patent Application. £330 (excluding VAT).



6 3 to 4 years from (1). Respond to Examination Reports issued by the UK Intellectual Property Office. Approximately £500 to £1500 (excluding VAT). Costs may be higher for complex cases.



7 4 years to 20 years from (1). Renewal Fees (payable annually after the fourth year – increase each year). Approximately £150 to £500 per year (excluding VAT).

* Costs may be lower if the filing is a preliminary UK Patent Application (i.e. a Patent Application that does not include claims or a request for a search). Cost may be higher where the Patent Application includes several inventions or where the invention is complex.

INTERNATIONAL PATENT APPLICATION PROCESS

1 Filing of a PCT application based on an existing UK Patent Application filed 12 months before – Approximately £3500 to £6000 (excluding VAT), depending on whether modifications to UK Patent Application Specification are required.



2 Approximately 3 months from (1). Receive search results from the International Searching Authority.



3 7 months from (1). Deadline for filing an optional Request for Examination. Approximately £1600 (excluding VAT)



4 12 months from (1). Respond to Examination Report(s) (if optional Examination is requested). Costs vary according to severity of Examiner's objections.



5 18 months from (1). National/Regional phases**. Initial filing costs are very approximately £1,000 to £4,000 per country or region. There are then further ongoing costs associated with the National or Regional Applications. We can advise further if required.

** International (PCT) Patent Applications allow a single application to cover a number of member countries and regions. For example, an International Patent Application covers the United States of America, Japan, China and the European Patent Organization.

Please note that the International procedure does not proceed right through to grant. At 18 months from filing, it is necessary to file national applications in the countries of interest, and/or regional applications. These national/regional Patent Applications must then be individually prosecuted through to grant.