

PATENTS

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As a firm of Chartered and European Patent Attorneys and Trade Mark Attorneys, we act in all professional matters relating to patents, designs and trade marks. This note provides a brief explanation of the topic of patents. Separate notes are available regarding designs and copyright, and regarding trade marks.

This note is provided free of charge for information purposes only. The information given is only of a general nature and there are many exceptions to these general rules. It is not intended to provide or be a substitute for advice in respect of any matter. Professional advice should be sought for any specific matter.

Patents provide protection for patentable inventions, and in particular provide a right to prevent third parties making, using, selling, etc., the invention which is defined by the claims of the patent. It is difficult to give a simple and clear cut definition of what is a patentable invention, but generally most articles that function in a new way, machines, methods, processes, compounds and compositions are patentable provided that they are new and unobvious at the date of application for the patent. Patents are not granted in respect of shapes or patterns of articles where the shape or pattern is intended to appeal visually; such shapes and

patterns may be protected by design registration. Furthermore, patents are not granted in respect of trade names, marks, logos, etc., which may be protected by trade mark registration.

United Kingdom – Initial Procedure

An initial patent application is filed with a specification, which is intended as a document of record to establish a priority date for the invention for which a patent is sought. The specification includes a description of the invention and drawings, and it is our recommendation to include claims, which define the scope of protection

being sought by way of the patent. Any patent granted in pursuance of the application will not be invalidated by a subsequent disclosure of the subject matter disclosed in the specification. The applicant is therefore free to take whatever steps are necessary to assess the commercial viability of the invention, including approaching potential customers, manufacturers, investors or the like, as soon as an application has been filed. In contrast, such steps taken before the application has been filed often result in the application being invalid. Care should nevertheless be taken not to disclose anything of importance beyond what is disclosed in the specification because aspects not described may not be protected.

In most cases we would advise filing a first application in the UK due to the low costs; however, for clients wishing to obtain patent protection in the United States there may be advantages in filing first in the US.

Within one year of making the initial UK application, a decision must be made as to the future of the application. In order to proceed to the next stage we often recommend that a new patent application be filed, accompanied by a final specification, and that this final patent application claim priority from the first application. This has the

advantage that there can be included a description of any improvements and modifications made to the invention since the first patent application was filed. Where there is no need to describe improvements or modifications, and where there has been no change in emphasis in the invention, it is possible merely to "finalise" the first application. This reduces the cost, but means that the opportunity is lost to revise and enlarge upon the original description.

United Kingdom –

Prosecution

Within the same one year period from the filing of the first patent application, a request for a search must be filed in the Patent Office and the relevant official fee paid. The official search is carried out by the Patent Office to determine whether the invention is new and unobvious, and the results are normally available within one to three months from the date on which the search request is filed.

At a date approximately eighteen months after the filing date of the first patent application, the final specification as filed is published by the Patent Office. A request for substantive examination has to be filed and the relevant official fee paid within six months of publication. The applicant therefore has a period of

six months to determine whether to continue with the application having seen the result of the official search.

The next stage is that the specification is examined in detail by an examiner in the Patent Office, who will assess the novelty and inventiveness of the invention and will raise any relevant objections to the application. When all such objections have been overcome by negotiation with the examiner, the patent is granted and the specification is published in its final, accepted form.

The maximum term of the patent is twenty years from the filing date of the final specification if priority is claimed from an earlier patent application, or from the filing date of the first specification if no priority is claimed. Annual renewal fees are payable to the Patent Office in respect of the fifth and subsequent years of the term. Non-payment of a renewal fee will result in the patent ceasing to be in force after the date on which the relevant fee was due.

Protection Overseas

Under various international agreements, a United Kingdom patent application automatically

provides a basis for claiming priority in practically all the countries in the world. This means that foreign applications in respect of the invention can effectively have the same date as the initial United Kingdom application provided that those foreign applications are filed within twelve months of the first United Kingdom application date.

Choice of route

There are at present three main routes whereby patent protection can be obtained overseas but not all three routes are available in each country. The routes are (1) an individual national application in any country required, (2) a European application at the European Patent Office in respect of those countries that are parties to the European Patent Convention, and (3) an International application under the Patent Cooperation Treaty in respect of those countries that are parties to that Treaty.

(1) National Patent Application

In the case of route (1) a national patent application is filed at the respective Patent Office of each of the countries concerned. Each Patent Office thereafter conducts its own processing of the application and, if successful, a national patent is granted. The cost of prosecuting the

application to the grant of a patent and the length of time of prosecution vary enormously from country to country and from application to application. In countries such as South Africa there are virtually no prosecution costs whereas in other countries, for example Japan or USA, prosecution costs can be significant. In many countries there are additional fees upon grant.

(2) European Patent Application

In the case of route (2), a single application can be filed at the European Patent Office. The European patent application is prosecuted before the European Patent Office and, if successful, results in the grant of a European patent which is subsequently registered in some or all of the originally designated countries. The registration is a mere formality and there is no further examination by the national Patent Offices.

A search report is issued after the European patent application is filed, and then published, and six months after that examination and designation fees must be paid. Maintenance fees must be paid during the pendency of the application. There will also be prosecution costs for negotiating with the examiner in the same way

as for a UK application; again, these costs vary from case to case depending on the work required, and are not mentioned below. Finally, there is a significant cost involved in the actual grant and subsequent national registrations of the patent. The applicant is not required to register in all those countries initially designated; a selection can be made at the end of the prosecution. National renewal fees will be payable in each country selected in order to maintain the national patent in force.

There is likely to be a cost saving in following the European route rather than the national route if you wish to obtain protection in three or more countries of the European Patent Convention. A particular advantage is that the registration and translation costs in the national Patent Offices do not have to be incurred until after the applicant has succeeded in obtaining acceptance of the application by the European Patent Office.

(3) International Patent Application

Route (3) involves initially filing a single international application under the Patent Cooperation Treaty.

The application is subjected to a search and the search report is issued about four to six months after filing. It

is then possible, though not essential, to request international preliminary examination, which provides an applicant with a non-binding view on the patentability of the invention, and the opportunity to engage in a dialogue with an examiner and/or to amend the claims of the application.

It is then necessary to file a national or regional application at each national or regional Patent Office concerned, claiming the same filing date and priority date as the international application. The action at each national Patent Office normally has to be taken within thirty months from the priority date.

There are two major advantages of the Patent Cooperation Treaty. First, the result of the search conducted in connection with the international application is available before a decision has to be made concerning the filing at the national or regional Patent Offices. If an unfavourable search report is received, then the cost of the national filings can be avoided. The second advantage is that there is a delay of, for most countries, eighteen months in incurring the costs involved in making the national or regional filings. This means that it is relatively inexpensive to keep open the option of filing the application in countries for which no final decision has yet been made as to whether to seek patent protection.

Thus, to summarise, an overseas filing programme carried out through the European Patent Office will normally be cheaper than a filing programme through individual national Patent Offices where three or more countries are involved. A foreign filing programme carried out through the Patent Cooperation Treaty will normally be slightly more expensive overall than the same programme carried out by filing initially in individual countries, but much of the cost will be deferred by a period of approximately eighteen months for most countries. In the cases of the countries that are not parties to the European Patent Convention or the Patent Cooperation Treaty, there will be no choice other than to follow route (1) above.

Searching

A search can be conducted to assess the novelty of an invention and the risk of infringing subsisting patents. The cost involved varies according to the extent of the search and the nature of the invention. There is in general no need to have a search conducted unless you intend to manufacture or sell the invention yourself, in which case an infringement search may be advisable. A novelty search does, however, reduce the risk of filing a patent application that eventually proves unsuccessful.

We would normally also recommend a search be carried out about halfway through the priority year if it is intended to file applications overseas. A search can be carried out by the European Patent Office on a private basis, and this will provide a good indication of the prior art likely to be found in searches carried out in the national Patent Offices during examination.

We shall be pleased to discuss with you in a telephone conversation, or at a meeting, any questions which you might have relating to any of the above matters.

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