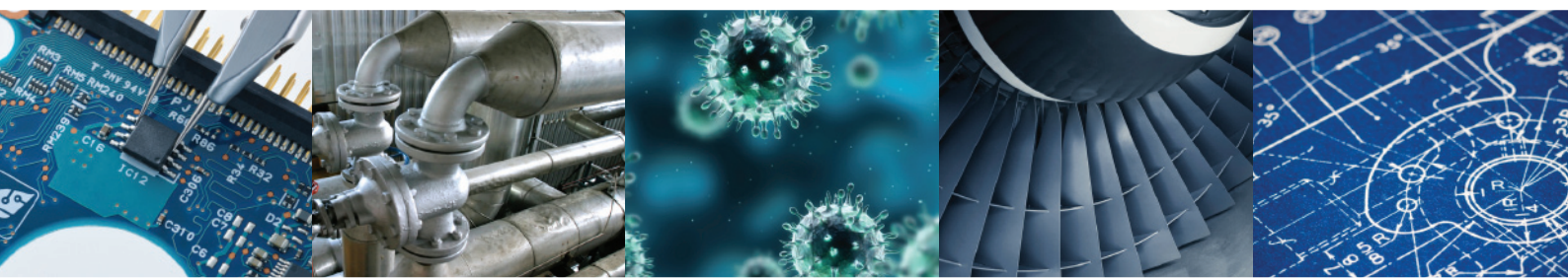


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# Patent Basics

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## 1. The purpose of this document

This document answers some very basic questions that are frequently asked about patents.

## 2. What is a patent?

A patent is a right to stop someone else using an invention. It does not give the owner the right to use the invention himself; for example, if the patent is for a specific modified gear system and a competitor has an earlier patent covering a general class of gear systems, of which the modified gear system is one example, a licence might be required under the competitor's patent.

## 3. How are patents obtained?

By applying to the relevant government agency - for the UK, the relevant agencies are the UK Intellectual Property Office and the European Patent Office. Getting a patent can take a number of years; three to five is typical, although the process can be accelerated in some circumstances.

## 4. Is professional assistance necessary?

No - but it is strongly advised. Applying for a patent is a complex matter to which experience makes all the difference, and that is why the specialist profession of patent attorney exists. You should consult your patent attorney as early as possible; importantly this should be while your invention is still a secret.

## 5. What kinds of thing can you get a patent for?

Patents are available for products of, and the processes used in, all industries, which includes areas such as mechanical devices, electronics, chemicals, pharmaceuticals, food, water, energy and transport. It may also be possible to get a patent for a computer program and even some business methods.

Inventions need not be spectacular to be patentable and commercially useful. For example, a relatively small improvement in a complex production process may give a sufficient edge over competitors to make obtaining a patent worthwhile.

## 6. Where is a patent effective and how are patents obtained abroad?

Patents are generally national. So, a Swiss patent is relevant to activities in Switzerland, and a Russian patent is relevant to activities in Russia. There are some useful international application schemes in which a single application leads to patents in many countries.

Patent protection in the United Kingdom can be obtained via either the United Kingdom or the European Patent Office. However, even a European Patent splits into independent national patents after it is granted. Where an application to a local foreign patent office is required your patent attorney will use the services of a local patent attorney there to make the application.

## 7. Are patents in different countries the same?

No. The definitions given in patents for the same invention in different countries are often a little different. Further, the laws governing patents can vary from country to country. For example, the laws in most European countries are very similar, but the law in the United States is quite different.

## 8. What does a patent look like?

A patent has a document known as a specification which describes examples of the invention and sets out claims, which are definitions of the invention. (The word patent is often used to refer to that document but it is also used to refer to the rights associated with it.)

## 9. What are the main requirements to be granted a patent?

Generally the invention has to be new, inventive, and be applicable to some kind of industry.

## 10. Which aspect of the specification is considered when deciding if these requirements are met?

The invention as defined in the claims is considered. The applicant can include different definitions, i.e. have more than one claim, and these are considered separately. Sometimes a broad general definition of the invention will not be accepted by the patent office, because it finds that as defined the invention is not

patentable, but it will grant a narrower claim because that claim says something further about the invention which is patentable.

## 11. What is meant by “new”?

The law in Europe is that an invention is new, or “novel”, if it has not been disclosed to the public before the application for the patent was made. Anyone’s disclosures, including your own, count against a patent. Any disclosure that is not confidential (whether written, oral, a viewing, a sale or otherwise) of something within the definition of a claim destroys the novelty of that claimed invention, thus making the claim invalid. The standard is strict: e.g. an unread report on a public library shelf counts as a disclosure.

## 12. What is meant by “inventive”?

This is of course a matter of opinion, but naturally the law tries to provide an objective standard. The question is considered taking as a starting point something like the invention that has been previously disclosed and considering if there are any obvious changes to it that a person skilled in the relevant technology would make - if the result is something within the definition of a claim, then that claim will be found not to be inventive. Again, sometimes a broad claim may be found to fail this test, but a narrower one to survive it.

## 13. What happens if there has already been a disclosure of the invention?

Take advice to see if the disclosure was confidential. If not there may still be some aspect of the invention not disclosed that is worth protecting with a patent. Also if the disclosure was recent some countries excuse that; in particular, in the United States disclosures up to one year before the application date are excused.

## 14. What do I do if I find that someone else has disclosed the invention?

Again, take advice: there may be something about your invention which the disclosure does not include.

## 15. What are the stages of a patent application?

This varies from country to country. The general sequence is as follows: preparing the patent specification, filing the application, official search for public disclosures relevant to the issues of novelty and inventive step, publication of the application,

examination of the application, grant of a patent. The procedure is carried out concurrently in every country in which patent protection is sought. Some of that duplication of effort and cost can be reduced or at least delayed by filing an International Patent Application or a regional application such as a European Patent Application.

## 16. How long does a patent last?

As long as renewal fees are paid patents last, in most countries, for 20 years from the date of application.

## 17. What are renewal fees?

To keep patents in force it is necessary to pay regular fees to the patent office, generally annually. In some countries they are payable on applications as well as on granted patents.

## 18. How is a patent enforced?

Infringement of a patent, e.g. making or using something defined in its claims, is pursued by a civil action through the courts for damages and/or an injunction. It is not a criminal offence. Law enforcement agencies do not monitor whether your patent is being infringed nor can they take action against infringers on your behalf.

## 19. Can a patent be challenged?

Yes. It is open to anyone to bring an action in the court for revocation of a patent. Because costs are involved, this is only usually done by those who are already infringing or would like to use the patent but believe it to be invalid. The defendant in an action for patent infringement will nearly always argue, by way of defence, that the patent is invalid. Some patent offices, including the European Patent Office, have a procedure, available for a short period after grant, known as opposition, in which a patent can be challenged.

Patents are usually challenged by arguing that the invention is not new or inventive; this can be done on the basis of the disclosures found by the patent office in the grant procedure but usually the challenger seeks other disclosures and the personal evidence of experts.

The patent office search does not give a final answer on validity of the patent because no search is perfect and because only limited, reasonable, resources are devoted to it. Other grounds of challenge exist, such as that the patent does not properly disclose how the invention is made or carried out or, in some

circumstances, that the person to whom the patent was granted was not the rightful owner.

## 20. Do patent disputes always end in an expensive trial?

Most patent disputes do not make it to trial because the merits of the case become apparent to the parties before then. Most are settled by negotiation but alternative procedures such as arbitration and mediation are available.

## 21. Who has the right to a patent for an invention?

Except for inventions made by employees, the usual rule is that the inventor has the first right to a patent for an invention. In the United Kingdom where the inventor is employed to do something likely to result in an invention, the right initially belongs to their employer. Other countries have different rules on this.

## 22. Why are patents commercially useful?

There are basically three ways to make money out of an invention:

1. You can licence the patent. In effect, you promise not to sue the licensee for patent infringement, and he promises something, usually money, in return.
2. A patent is a piece of property, so you can sell it.
3. You can use it to keep out competitors and therefore increase your market share.

Patents are also useful for attracting investment into a company because of the ways income can be derived from them. Often venture capitalists see patents as essential to their investment. Less commonly, patents can be mortgaged.

Patents can also be used in more complex ways, for example to provide leverage in licensing negotiations. An example would be when your competitor owns a patent covering a product that both you and your competitor want to make but you hold a patent covering the best way of making that product. If you did not have that patent, your competitor could block you out of the market completely; with the patent, you have leverage to negotiate a cross-licence.

## 23. What risks are involved in patents?

Applying for a patent is speculative. Whether a patent will be granted, or the breadth of the granted claims, is uncertain for two main reasons. The first is that the state of the art (all the relevant public disclosures made before the patent application is filed) is not known precisely; a search can be made and taken into account before the patent application is filed, but no search is perfect and the patent office could find more relevant disclosures that limit the protection available. The second is that there is no truly objective test of whether an invention is obvious, so it cannot be said with certainty whether the patent office will accept that a particular claim is inventive. These risks remain after grant: a defendant may find more relevant disclosures and the judges can differ as to whether an invention is inventive.

Another risk not directly related to the patent is, of course, that the product (whether it is your own or a licensee's) will fail commercially. If that happens then all the expenditure related to it, including of course the patent, will probably have been wasted. Products fail for many reasons. The project may not attract investment (although patents can help with attracting investment). The product may prove difficult or expensive to manufacture. The market may not agree that the product is useful or necessary - fashions change and technologies are superseded. The marketing may not get through to the right customers.

## 24. Which patents make money?

The ones for successful products. Picking a winner is, of course, difficult, but a patent often increases the return on the investment made; indeed a premise for the patent system is that a patent will encourage investment when without the patent the copying of the invention by others would have destroyed the possibility of making an adequate return.

## Important Note

Patent law, procedure and strategy have many complexities and subtleties. Therefore this document cannot be taken as the basis for action; you should take advice in any particular case.

**Abel & Imray**  
**October 2011**



23 Windsor Place,  
Cardiff CF10 3BY UK  
t: +44 (0) 29 2034 7030  
f: +44 (0) 29 2066 6637

Westpoint Building,  
James Street West,  
Bath BA1 2DA UK  
t: +44 (0) 1225 469 914  
f: +44 (0) 1225 338 098

abel  
& imray

patent attorneys  
trade mark attorneys

20 Red Lion Street  
London WC1R 4PQ UK  
t: +44 (0) 20 7242 9984  
and + 44 (0) 20 7405 0203  
f: +44 (0) 20 7242 9989

e: [ai@patentable.co.uk](mailto:ai@patentable.co.uk)  
w: [www.patentable.co.uk](http://www.patentable.co.uk)