

Marks&Clerk



A Short Guide

UK Patents

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What is a patent?

A patent grants the right to prevent others from exploiting an invention in a particular country. It is therefore a form of monopoly. In the UK and many other countries, a patent can last for 20 years.

What can be patented?

The patentable invention could be a new product or process, or even a new use of a known product. First and foremost, the invention must be new worldwide. Next, the invention must not be an obvious development of a known product or technology. The invention must also have some practical application.

Even if these criteria are fulfilled, some inventions are nevertheless excluded from patent protection on policy grounds, such as methods of medical treatment.

What rights does a patent give me?

Essentially a UK patent gives you, the owner, the right to stop others from making, using, importing, disposing of, or offering to dispose of a patented product within the UK. Broadly similar provisions apply in respect of patented processes and products arising directly from them. To enforce these rights you may take legal action and seek an injunction, damages and other remedies.

The patent is an item of property and may be assigned (i.e. sold), licensed or mortgaged.

A patent does not give you (or any licensee) the automatic right to exploit the invention. For example, the invention may require use of earlier patented inventions and, in this case, it would be necessary to obtain the permission of the owners of the earlier patents before the invention could be exploited. Cross-licensing is often a solution to this situation.

When should I file an application?

It is vital to file the application before there has been any non-confidential disclosure of the invention and certainly before exploiting it commercially. Making a non-confidential disclosure before filing the application puts the invention in the public domain. This means it is no longer new and therefore no longer patentable. Non-disclosure agreements can be used where necessary.

Is patenting the best option?

As with any commercial tool, you should only consider a patent if it would be commercially useful. With this in mind, there are a number of issues to consider:

- Does the application stand a reasonable chance of being granted? This is important because of the publication of the invention as a necessary part of the application process, quite early on. If the application then fails, you will have handed your previously secret invention to competitors for no advantage in the marketplace. In some cases it is nevertheless commercially advantageous to have a patent application on file even when there is little prospect of useful protection being granted.
- If no patent application is filed, how long realistically could the invention be kept secret? Will the invention be revealed to the public as soon as articles using the invention are sold? How long will it be before key personnel leave and take details of the invention with them? In exceptional cases in which it would be possible to keep the invention (e.g. a recipe or a process step) secret for a long period, commercial secrecy may be preferable to patent protection.

- Even with a patent, how easy will it be for you to determine if a competitor is infringing? This may be very difficult where an invention relates to details of a manufacturing process that a competitor may be able to keep secret.

How do I obtain a UK patent?

The first stage in obtaining a patent is the filing of the application at the Intellectual Property Office. The application must include a 'specification' which gives a full and detailed description of the invention – usually with drawings.

Within 12 months of filing the application, you must also submit a set of statements, known as 'claims', which define the invention in such a way that the Intellectual Property Office (and subsequently a court) can determine the scope of the monopoly sought.

By this stage it is also necessary to file an abstract of the disclosure and submit a request for 'preliminary examination and search' together with the appropriate official fee.

The words used in these claims are critical and will be subject to very close scrutiny by the Intellectual Property Office, and by the court if the patent is litigated. Inappropriate wording could render the eventual patent useless.

The Intellectual Property Office novelty search report indicates whether or not the invention is new and non-obvious over previously published materials. It is then possible to amend the claims in light of the search results if necessary.

Many applicants find it advantageous to submit claims and the request for preliminary examination and search at the same time as filing the application, so as to receive the Intellectual Property Office search report (with some

indication of any licensing issues) early on. This will help them decide whether it is worth pursuing patent protection, particularly if they wish to protect their invention abroad.

Assuming formal requirements are all met, the Intellectual Property Office will then publish the application. The description, abstract, drawings and claims will consequently be made public and will be sent to almost every country in the world. Now that publication has taken place, the applicant has acquired some rights against infringing third parties, although enforcement will depend upon obtaining actual grant of a patent. Although you can take legal action only once you have been granted a patent, any damages can be backdated to the publication date.

Within 6 months of the application being published, it is necessary to submit a request for 'substantive examination' together with the appropriate fee. Following this, and usually within about one year, the Intellectual Property Office will carry out an in-depth examination of the application. If any objections are raised by the Intellectual Property Office then these can be argued and the application can be amended if necessary. Any objections must obviously be overcome before the Intellectual Property Office will grant the patent.

Depending on its complexity, the procedure can take from a few months to several years. It is possible, however, to exploit the invention as soon as a patent application has been filed (provided your invention does not infringe a third party's earlier patent or other rights).

The search and examination processes can be combined in a streamlined application by requesting examination early. This may be combined with a request for early first publication to enable fast grant.

How long does the patent last?

A UK patent lasts for 20 years from the application filing date, provided that the annual government renewal fees are paid. If the renewal fees are not paid at

any time, the patent will lapse and third parties can use the invention without fear of infringement liability.

How do I protect any improvements or modifications to an invention?

This can present problems because it is not possible to add details of any improvements or modifications to a patent application that has already been filed. If, however, the modification has been made within 12 months of the filing date of the first application for the invention, it is possible to file a new patent application based on the details of the original application and claiming the filing date of the original application as its priority date. The first application can then be allowed to lapse since it is no longer needed. For modifications after the 12 month period, it will be necessary to file a completely independent patent application. It is vital, in either case, that the modification is not disclosed before you have filed the new application.

Once I have a UK patent application, how do I obtain foreign protection?

The UK patent will only give protection in the UK and the Isle of Man. Most countries now belong to an international convention on patents, which does make foreign filing easier, provided you have an existing UK application. If you file a subsequent application under the convention within 12 months of a first filing date, then you can claim the first filing date as a priority date for the subsequent application. This means that the invention can be exploited in the 12 month interim period without prejudicing the validity of foreign patents.

When a foreign patent application is made under the convention, it will be dealt with from start to finish in accordance with the patent laws of the country concerned. Since filing foreign applications can be expensive, it is advisable to carry out some form of searching beforehand to determine whether or not it is really worth the cost. Hence the value of the UK official search for example.

In addition, it is also worth bearing in mind that the ease with which a patent is granted will vary from country to

country depending upon how strenuous the examination procedures are. Especially in countries with less rigorous examination procedures, the grant of a patent does not necessarily guarantee that the patent will be valid. The same is true in countries with more rigorous testing although there will of course be a higher presumption of validity. There are two systems to avoid filing in a large number of countries directly: the Patent Co-operation Treaty (PCT), to which a large number of countries are party, and the European Patent Convention (EPC) to which many European countries adhere. Under each system, a single application is submitted, typically within 12 months of filing the first UK application. The procedure under the EPC is much the same as filing for a UK patent. Once granted, the EPC patent becomes a bundle of national patents, each of which is maintained and enforced in its respective country.

The PCT application is searched and may be examined on request (and payment of the required fees), but this examination stage does not result in a granted patent. Instead, it is necessary to convert the application into individual national applications, or a regional European (EPC) application, each of which then proceeds independently. The advantage of the PCT is that it can delay the expense of the national applications by as much as 18 months – which can be crucial if the commercial success of the invention is not immediately clear.

How can Marks & Clerk help?

Marks & Clerk advises on all aspects of intellectual property. For more information and to find out how we can help you with filing and protecting your patents and managing your patent portfolio, contact your usual Marks & Clerk attorney or a member of our patent team at your nearest Marks & Clerk office. Full details are on our website www.marks-clerk.com.

The information within this guide is intended to provide a summary of the subject matter. Readers should not act or rely on information contained in this guide without first obtaining specialist professional advice.

