

The Basics

A patent is a legal right granted by the UK Intellectual Property Office for a new invention. It allows the owner of the patent (the patentee) to take legal action against others who use his invention without his permission. The right has a maximum life-time of 20 years in most countries, from the date of the patent application. What a patent does not do is give the owner an automatic right to use the invention. He still needs to take care to avoid infringing other people's rights.

HOW DO I GET A PATENT?

To obtain a UK patent you normally need to apply to the UK Intellectual Property Office.

If they decide your invention is patentable, the patent will be granted usually about four years after you made the application, but sometimes sooner than this. See below for the procedure.

Do I need a patent to use my invention?

No. Whether or not you have a patent, you are free to exploit your invention, although **only if** no one else already has patent rights to it.

However, if you do not have a patent, it can be very hard to stop other people copying your invention.

Note, as we have said before, that even if you **do** have a patent, that does not automatically give you the right to use your invention because others may own rights which prevent or restrict your use.

Who owns the patent?

A patent belongs to the inventor, unless he has given the rights to someone else.

Normally, if the inventor is an employee and he makes the invention in the course of his work, the rights belong to the employer.

The owner of the patent may license it, allowing others to use his invention. Alternatively, he can sell it to someone else.

What can I patent?

To be patentable, your invention must meet the following conditions:

- It must be **new**. That is, the invention must never have been made public **IN ANY WAY** before you apply to the UK Intellectual Property Office.

- This means that your invention must not have been published by someone else before you.
- It also means that if you want a patent, you **MUST NOT** tell anyone about your invention, except in confidence, until your application is filed with the UK Intellectual Property Office.
- It must involve **an inventive step**. This means that the invention must not simply be an obvious development of something that is already known.
- It must be **capable of being made or used** in any kind of industry, including agriculture. Most inventions satisfy this requirement.

An invention is typically an apparatus, a product, a manufacturing process etc.

Your invention must not fall into an **excluded category**. This includes works of art, scientific theories, mathematical methods and the presentation of information. We can give you advice about this.

How do I apply for a patent?

An application for a UK patent can be made directly by you, or you can authorise a patent agent to act on your behalf. Chartered patent agents are professionally qualified people who are experienced in dealing with the UK Intellectual Property Office and the application procedure.

Making a UK patent application

An application for a UK patent must be made at the UK Intellectual Property Office. Your application must contain:

- your name and address;
- a request for a patent;
- a description of the invention - preferably with drawings.

On receipt of the application the UK Intellectual Property Office gives the application a **filing date** and a number and sends you a receipt.

Once you have filed your application at the UK Intellectual Property Office you are free to make use of your invention without jeopardising your chances of obtaining a patent, subject to any other people's rights (see page 1).

Anything in the public domain before your application's filing date can be used to show that your idea is not new. This includes talks and published documents. Therefore it is important to apply for a patent and obtain a filing date as soon as possible. Other patent applications with an earlier filing date can also affect your application.

After filing you have a year in which to develop your idea and investigate its commercial possibilities before you have to do anything more.

What happens next?

Within a year from the filing date you have to file:

- **Claims** defining the protection you are seeking. You should get advice on drawing up the claims as they are very important. A competitor can only be sued if he does, or produces, what is described in the claims.
- An **abstract** giving a brief summary of the invention.
- A request for a **search** with a fee.

The UK Intellectual Property Office will search for documents showing inventions similar to yours and then issue a **search report** which lists any relevant documents from around the world that they have found in reference books, scientific journals or other patents. This search gives you an early indication of how likely you are to obtain a patent.

Eighteen months after the patent application was filed it is automatically published and is available for anyone to look at. This is **not** a granted patent and you cannot sue anyone yet for using your invention.

Within six months of publication you must pay a further fee and request **examination**. During this detailed examination, the UK Intellectual Property Office may write to you giving reasons why the invention is not new or is obvious. You have a time limit to reply to the UK Intellectual Property Office's letters and to persuade them that the invention is worthy of a patent. This often involves changing the description of the invention or the claims before agreement is reached, and this can take time.

When the UK Intellectual Property Office agrees that your invention is new and inventive, your patent will be granted. This fact will be published in the UK Intellectual Property Office's Official Journal and you will be sent a certificate.

The process for obtaining a UK granted patent usually takes about four years from the date of the application.

However, if you pay some fees early and reply promptly to letters from the UK Intellectual Property Office, it may be possible to reduce this time to as little as 18 months, if your invention is not a complex one.

After four years from the filing date, once granted, annual renewal fees need to be paid to keep the patent in force. These fees increase as the patent gets older.

How do I enforce my patent?

The fact that you own a patent will often deter competitors from using your invention. It helps to refer to it in your product literature once your patent has been granted. However, if your invention is being used by someone without your consent (**infringement**) you can obtain an injunction to stop them and claim damages (compensation). This can be done at the High Court, the Patents County Court or the UK Intellectual Property Office.

You cannot sue for infringement until your patent is granted. However, once your patent is granted, you may be able to claim damages in retrospect from the date your patent application was published.

Which countries are covered by my patent?

A patent granted by the UK Intellectual Property Office only covers the UK.

If you want protection in countries other than the UK, you need to file further applications. Several options are available.

There is no such thing as a “world patent”. However, applications for patent protection in several countries at once may be made using the European Patent Convention (EPC) or the Patent Cooperation Treaty (PCT).

The EPC allows you to apply for a patent in up to 32 European countries by filing a single application. A patent is then granted in each of the chosen countries.

The PCT is the nearest system to an international patent, covering most of the industrialised world. One application is filed to cover a number of countries, but the application eventually splits up and proceeds in each country separately.

We can explain these systems to you in more detail, and discuss their relative merits, at a later date. However, for countries which do not belong to either the EPC or the PCT you have to file a separate patent application.

Do I have to file all these applications at once?

No. Filing your first application, usually at the UK Intellectual Property Office, establishes your place in the “queue” in most other countries. You have to decide within twelve months to file applications in other countries and these further applications will be treated as if they were filed on the same date as the first one, provided they relate to the same invention. This is called claiming **priority** from your first application.

This is useful since it gives you a year to work out whether your invention is commercially viable before spending large amounts of money on patents in other countries.

A few countries will not give you this one year breathing space. If you need patent protection in such countries, you will have to apply at the same time as you make your first (normally UK) application.

What can we do for you?

A patent attorney can handle all aspects of obtaining a patent, from writing the **specification** of the invention - the **description** and the **claims** - to arguing the merits of the invention with the UK Intellectual Property Office. It is possible to do this yourself without employing a patent attorney.

However, a patent specification is a legal document which can determine the strength of the patent you get and which has to be able to stand up against legal attack.

Employing a patent attorney may increase your costs in the short term, but it is likely to give you a more secure patent.

Patent attorneys are bound by rules of conduct which prevent us from telling anyone about your invention without your consent.

We can advise you on other aspects of intellectual property, such as Trade Marks, Copyright and Designs.

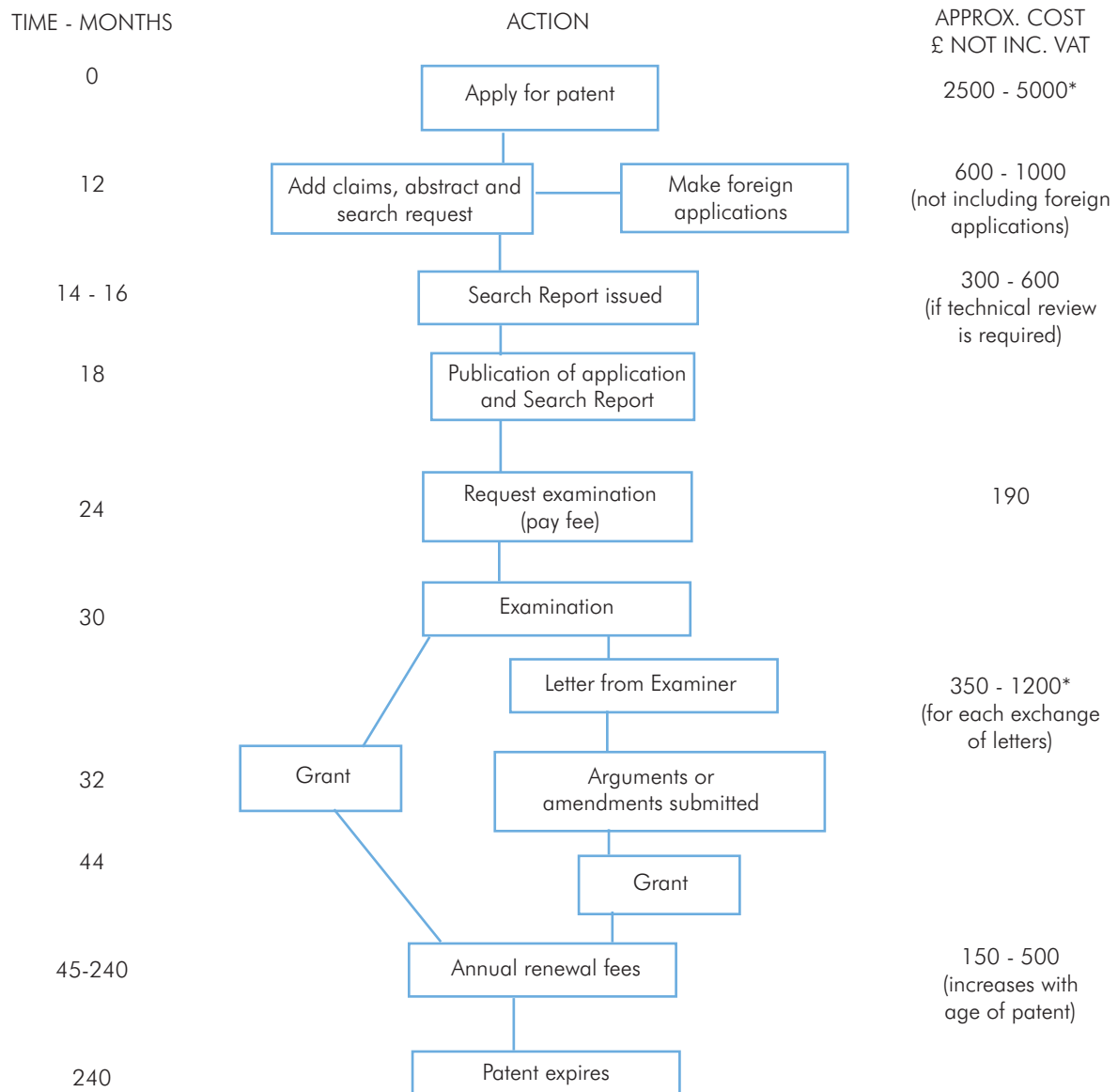
What do we need from you?

If you want us to write your patent specification, we need detailed information from you about the invention:

- the products/processes known before your invention;
- what problems, if any, you were addressing when you made your invention and what are the disadvantages of previously known products/processes;
- the advantages of your invention and the features giving rise to them;
- at least one way, in detail, to implement your invention;
- how it could be used/applied;
- modifications and variations which could be made;
- drawings of mechanical inventions are also very useful.

We also need your address and phone number so that we can contact you.

The times and costs given below are estimates for a typical simple invention. The costs include our charges assuming we had dealt with the application from the beginning. The total cost for a typical application to be granted is in the range £4,000 - £9,000 + VAT spread over several years. This does not include the subsequent cost of keeping the granted patent in force by paying renewal fees.



*These costs are typical for cases involving relatively simple technology and straightforward legal issues. Costs for cases in more complex fields, such as software, biotechnology or electronic hardware, are likely to be higher due to the more complicated subject matter and a more difficult legal environment.

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