

# Patents

## Introduction

Windsurfers, corkscrews, lighting systems and medicinal drugs can all benefit from patent protection. Read on to find out whether your product or process could benefit too.

### 1. What is a Patent?

A patent is a monopoly right granted by the government to an inventor, who has used his skill to invent something new. For a limited period, the inventor can stop others from making, using or selling the invention where his permission has not been obtained.

The government grants patents since there are clear benefits to society from doing so. The trade off between a patent owner and the government is that the patent owner discloses knowledge, which is then publicly available. In the short term, the public gain knowledge of technological developments and in the long term they will be able to freely use this information once the patent ceases.

### 2. How long does the patent last?

20 years. For 20 years you will have a monopoly right over the product or processes claimed. For these purposes, monopoly means that without permission, nobody else can manufacture or sell the product or use the process. In exchange for this monopoly, the applicant consents to publication of full details of the invention and its workability.

### 3. What are the benefits of a patent?

A patent entitles you to a monopoly over the use of the invention. This means that as a patent owner you can take legal action against others who use your invention without permission and you can also claim damages.

A patent is an item of property. Like any form of property or business asset, the patent can be bought, sold or licensed. As a patent owner, you can sell it to another who is better able to take commercial advantage of the patent. Alternatively, you may license the patent, the advantage of which is that of flexibility, as you can determine the way in which someone else can use your invention.

### 4. How can a patent help my business?

As mentioned, the patent confers a monopoly right to the owner. This is invaluable to your business as it gives you the competitive edge over others. You alone will have the exclusive right of use of the patent. In this way you can legally create a monopoly in the market in which you operate.

### 5. What types of things are patentable?

Products or processes that contain or possess new functional or technical aspects. A patent may extend to entirely new products, enhancements to existing products or to a new or improved process for performing an activity. An example of a famous patent is the Dyson vacuum cleaner.

## 6. Do the rights extend worldwide?

No. However, you can make an application for countries around the world (this is discussed in more detail below). Patents are territorial rights, so a UK patent will give you rights within the UK only. This means that you will have the right to stop others from importing the patented product into the UK.

## 7. How do I apply for a patent in the UK?

You can make an application for a UK patent based on a document called a “specification” to the Patent Office.

The specification should include drawings if they are useful in describing the invention, as well as a full description of your invention. Since changes cannot later be made to the specification, the description should be as comprehensive as possible.

In addition to the specification, you need to complete a patent form including basic details such as descriptions and any drawings of the patent. Once both of these items are complete, they should be sent to the Patent Office.

## 8. Can I apply for a patent in several countries simultaneously?

Yes. However, it is normal practice to file a UK patent first. After this you have 12 months during which you must file any foreign, European or world patent applications. The advantage of filing an application in the UK first is that the UK application is a good way of assessing the success of the invention before launching into the costly foreign application.

There are various avenues to securing a patent abroad and these are as follows:

1. You can make separate applications in each foreign country in which you require protection. There are, however, two other easier routes.
2. You can make a single application to countries, which are members of the European Patent Convention. You can obtain a patent (if each country decides to grant one) in all of the countries listed in the application. You have to include a fee for each country that you include on this application but this will be cheaper than applying to each country individually. This type of application can be made either to the UK Patent Office or to the European Patent Office.
3. The UK is a member of an international treaty called the Patent Co-operation Treaty (PCT). This route is similar to the European route in that you can obtain a patent (subject to each country granting it) in all of the countries listed in the international application. You can make an application in any country that is a member to the PCT. This saves you the trouble of making applications in accordance with national rules of each country concerned. This application can be made to the Patent Office in the UK. If the patent is granted in all countries contained in the international application, the patent becomes subject to the national law of each such country.

The advantages of obtaining a patent abroad include the opportunity and flexibility to expand into other countries. Even if you don't want to expand abroad, the patent acts as a shield against unauthorised use of your invention in the country in which protection is gained.

## 9. Who may be granted a patent?

It is presumed that the inventor has the right to be granted the patent. However this is not always the case. If a number of people have been involved in developing the invention or supporting the process, then the invention is the result of more than one person's work. It can be difficult to identify which of those people actually made the inventive step or process. To avoid conflict and confusion, it is useful to keep a detailed logbook of each person's contribution to the invention.

Examples of whom the applicant may include an individual or corporate body. Applicants can make joint applications whereby both will have rights once the patent is granted.

Generally, if a patent is made by a person during the course of his employment and as a part of his duties then the invention will belong to the employer.

## 10. What kind of acts amount to infringement and when can such an action be brought against the alleged infringer?

First it is useful to define infringement. This simply means that someone acts such that they break the law and in this case it means that a person uses your patent without your permission.

There are two types of infringement: direct and indirect infringement.

Direct infringement includes:

- a) Making, disposing of, offering to dispose of, using, importing or keeping the product;
- b) Doing the same thing in relation to a product derived from a patented process;
- c) Using the process or offering it for use in the UK, when the person concerned does so knowingly, or where in the circumstances it would be obvious to a reasonable person, that such use would be without the consent of the proprietor and would be an infringement of the patent.

Indirect infringement occurs where, while a patent is in force and without the consent of the owner, someone supplies or offers to supply any means relating to an essential element of the invention for putting the invention into effect.

## 11. How we can help?

Briffa works closely with firms who specialise in filing patent applications. In order to provide a fixed fee quote please let us have the following information.

- Whose idea is the invention and who is the inventor?
- Are there joint inventors?
- Was a research team involved in making the invention? If yes, how many people were involved and what was each of their input?
- How did the idea come about? For instance, what circumstances prompted and provoked the invention?
- Who is the owner of the patent? Is this person different from the inventor?
- What current inventions are you aware of that are similar to your invention? Please search at [www.patent.gov.uk](http://www.patent.gov.uk) and [www.uspto.gov.uk](http://www.uspto.gov.uk)
- What is the quality or feature of the invention, which sets it apart from other similar products/processes?
- What problems are there with the current inventions?

- What new things does your invention do?
- The patent agent requires the full name and address of both the applicant(s) and inventor(s) as well as summary of the relationship between these individuals.

## 12. In order to gain patent protection the invention must be:

- a) **New.** The invention cannot have been disclosed to the public anywhere in the world before the patent application date.
- b) **Involve an inventive step.** This requirement is fulfilled, if when the invention is compared with what is already known, the invention would not be obvious to someone with good knowledge and experience of the subject matter of the invention.
- c) **Be capable of industrial application.** The invention should be capable of being embodied in technical applications so that it can be made or used in some kind of industry. Therefore the invention must take the practical form of an apparatus or device. "Industry" is meant in the broadest possible sense and extends to agriculture.
- d) **Not be "excluded".** The exclusions are as follows:-
  - A discovery;
  - A scientific theory or mathematical method;
  - An aesthetic creation such as a literary, dramatic or artistic work;
  - A scheme or method for performing a mental act, playing a game or doing business;
  - The presentation of information;
  - A computer programme;
  - A new animal or plant variety;
  - A method or treatment of the human or animal body by surgery or therapy
  - A method of diagnosis.

## 13. What should I do if I am thinking about applying for a patent?

As seen above at "*In order to gain patent protection the invention must be*", the invention must be new. Therefore if you would like to apply for a patent it is vital that you do not publicly disclose the invention before filing the application. It is stressed that any type of disclosure could prevent you from succeeding with the application. It is important that any disclosures made are under strictest confidence. You can order a standard confidentiality agreement from the web-shop on Briffa's Internet website ([www.briffa.com](http://www.briffa.com)). An explanatory note for your convenience accompanies the confidentiality agreement.

The drafting of the initial application typically takes 10 working days. We then forward it to you for checking. Finally it is then sent to our attorneys who will file it making any amendments where necessary. Therefore please allow 4 weeks from your first instruction to the filing of your application. Please note that without the application fees on account we cannot commence work for you. Therefore it is extremely important that you send us the application fees as soon as you are able, once we have given you the fixed fee.

Having read this leaflet, if you think that you have a product or process that would benefit from patent protection, or you have any questions in relation to patents specific to your circumstances, you may contact us on:

- 00 44 (0) 20 7288 6003; or
- email Margaret Briffa ([margaret@briffa.com](mailto:margaret@briffa.com))