



Patents

By Briffa, the intellectual property lawyers
and affiliated partner for Own It. (www.briffa.com)

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

Frequently Asked Questions

What is a patent?

A patent is a monopoly right granted by the government to an inventor, who has used her/his skill to invent something new. For a limited period, the inventor can stop others from making, using or selling the invention where her/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 available to the public. 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.

How long does the patent last?

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 disclosed in your patent. In exchange for this monopoly, you consent to publication of full details of the invention and its workability.

What are the benefits of a patent?

A patent entitles the patent owner 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 someone who is better able to take commercial advantage of the patent.

Alternatively, you may license the patent. This is a flexible way of exploiting your invention, as you can determine the way in which someone else can use your invention.

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 a 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.

What types of things are patentable?

Products or processes that contain or possess new functional or technical aspects can be patented. 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.

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 making, selling or importing the patented product into the UK.

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 these are useful in describing the invention, as well as a full written description of your invention. The description should be as comprehensive as possible, since changes cannot be made to after your written specification is filed.

In addition to the specification, you will 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. The address for the Patent Office can be found on the Directory section of the Own It website at www.own-it.org

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 and market potential of the invention before launching into a costly foreign application.

There are various paths to securing a patent abroad. 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, which are listed below.
- 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 pay a fee for each country that you include on this application but

this will still 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 Cooperation 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 of 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 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.

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. For this reason, it is useful to keep a detailed log book of each person's contribution to the invention, which can help avoid future dispute.

Patent applicants may be an individual or a company. Applicants can make joint applications in which both parties will have rights once the patent is granted.

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

What is infringement?

The term 'infringement' in this context means that a person makes use of your patent (i.e. your invention, or specific intellectual property also protected within your application) without your permission.

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

Direct infringement includes:

- 1) Making, disposing of, offering to dispose of, using, importing or keeping the product;
- 2) Doing the same thing in relation to a product derived from a patented process;
- 3) 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 a person, without the consent of the patent owner, helps another person by providing them with material which is essential to the invention for the purpose of putting the patented invention into effect.

What should I do if I think I have come up with an invention?

Prior to filing a patent it is useful to consider the following questions:

- Whose idea was 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? You should undertake searches using at www.patent.gov.uk and www.uspto.gov
- What is the quality or feature of the invention which sets it apart from other similar products/processes?
- What problems are there with existing inventions and how does your invention solve these problems?
- What new things does your invention do?
- The patent agent requires the full name and address of the applicant(s) and inventor(s) as well as summary of the relationship between these individuals.

Do the rights extend worldwide?

In order to gain patent protection the invention must be:

- 1) **New.** The invention cannot have been disclosed to the public anywhere in the world before the patent application date.
- 2) **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. If your invention can be examined and found to be genuinely ‘inventive’ by someone with a good knowledge and experience of the subject matter of the invention, then you can claim that your invention offers an ‘inventive step’.
- 3) **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 also extends to agriculture.
- 4) **Not** within the following categories:
 - A discovery of a natural process;
 - 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 program;
- A new animal or plant variety;
- A method or treatment of the human or animal body by surgery or therapy;
- A method of diagnosis.

Can I disclose my invention prior to filing an application?

As seen in the above paragraph, 'In order to gain patent protection the invention must be', the invention must be new. Therefore, if you are considering to applying for a patent it is vital that you do not publicly disclose the invention before filing the application. Any type of disclosure could prevent you from succeeding with the application. It is important that any disclosures made are under strictest confidence and under the terms of a confidentiality agreement. See the Own It website at www.own-it.org for information about confidentiality agreements.

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