



GUIDE TO PATENT PROTECTION

**BROOKE-
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PROTECTING THE TECHNICAL FUNCTION OF SOMETHING

Patents are used to protect **inventions** which are new ideas or concepts that have a technical function or a technical element. The idea or concept does not need to be a giant departure from anything that has previously existed and an invention may be an entirely new functional product, or part of a product, a method of doing something or a new use of something.

A patent is obtained through an **application procedure** and it is important that the invention is **confidential** at the time that a patent is applied for. The function or element must be **new** over everything that has been made public before the patent is applied for and critically must **not be an obvious** adaptation or improvement.

Developments in some areas are generally excluded from

patent protection, including software, business methods and game-play methods, but you should seek advice in such cases as the exclusions do not always apply.

Geographical Coverage

To obtain a patent in a particular country a patent application must be filed in that country. Most individual countries operate a procedure for the grant of a patent which involves filing an application with the appropriate organisation. There are a number of application procedures that cover multiple countries. For example, the European patent application procedure and the International (PCT) patent application procedure can simplify matters and reduce costs in some cases, by allowing a single application to be made, which, if successful, will give rise to national patents in the countries required.

THE PATENT PROCEDURE

A. Preparation

We typically recommend that a search is performed before seeking protection to look for previous patents or applications that may be relevant to the patentability of your invention.

The initial stage in the application process is the preparation of a patent specification. A patent specification is a complex document that must fulfil specific legal requirements if it is to be acceptable. Since it is not possible to add information to a patent specification that has been filed, it is important to get the content right at the beginning to avoid unnecessary fees and disappointment.

There are a number of fundamental parts to a patent specification: a full description of what the invention is, how it works, how it is made (if a product) or executed (if a method); at least one claim that defines the scope of the invention; and abstract to provide a helpful summary.

The full expenditure of drafting a patent specification may be delayed by preparing a "provisional" specification without the claims and an abstract. We would recommend preparing and filing a provisional specification to establish an initial date of filing if there is a good chance that there will be technical developments to follow later, in which case a new adapted specification might supersede your first specification at a later date (Step B).

B. Filing a Patent Application (0 months)

The additional documents that form a patent application along with the patent specification are prepared and filed at a Patent Office. The patent application is given a filing date and a filing number and it is then possible to disclose the invention if you wish.

We typically recommend that the patent application is first filed in the UK for cost and flexibility reasons.

In a number of countries, the filing date starts the clock for the 12 month deadline in Step C.

C. Completion and Foreign Protection (12 months)

To proceed with the filed application it is necessary to 'complete' the application with claims and an abstract (if provisional), make a request for a search and pay application and search fees. If any improvements have been made since the first filing, we can prepare an amended patent specification and re-file it at this point (it will be given a different filing number), so as to retain the benefit of the first filing date from Step B (referred to as 'claiming priority').

The same 12 month deadline is the last opportunity to file foreign patent applications for the same invention whilst benefiting from being treated as having been filed on the same day as the earlier patent application (claiming priority). If you require protection abroad, we can advise you of the best filing strategy, arrange for the applications to be filed in the geographical locations of your choice and manage the portfolio and further deadlines for you.

It is possible to 'complete' the application before the 12 month deadline to advance the procedure to Step D (receipt of the search report) at an earlier date (without affecting the foreign deadline). An early search report can be advantageous for taking a view on whether it might be worth pursuing protection or filing patent applications abroad before the 12 month deadline.

We will remind you of this important date well in advance and prepare any necessary documentation on your instruction.

D. Receipt of the Search Report(s) (14 to 16 months)

We will receive search reports from each country where applications have been filed. The search report will list any documents that the Examiners in those offices think are relevant to the patentability of your invention.

The search report will allow us to form a view of the likely scope of protection of your eventual patent and will enable us to prepare a strategy for pursuing the patent(s) depending on

your commercial considerations at the time. We may decide to tweak the scope of protection (the claims) at this stage, using features that are discussed in the filed specification. Please note amendments at this stage cannot involve the addition of features that are not in the application on file.

E. Publication (16 months)

The patent application will usually be published with the search report. The publication date usually starts the clock for a 6 month deadline by which time it is necessary to file a request for substantive examination, but this is dependent upon the procedure in each country.

F. The Request for Examination (22 months)

The request for substantive examination along with payment of the examination fee must be requested in each country. This will trigger the start of the examination procedure in each country when the merits of the invention are assessed.

In some countries the request for examination can be delayed for some years.

G. Receipt of Examination Reports(s) (2 ½ years to 6 years)

In each country, usually at least one examination report is issued setting out any objections that the Examiner has to the scope of the invention and/or the patent specification as a

whole. We are given a deadline by which to respond with changes, particularly to the claims, and any arguments to achieve an acceptable scope of invention. Please note that any changes made at this stage cannot involve the addition of features that are not in the application on file.

There may be multiple examination reports in each country and multiple examination responses as a result. This will have an impact on the length of the examination stage of the procedure.

During this time, third parties may also be able to file observations to try and prevent grant or limit the scope of protection by telling the Examiner about information relevant to the patentability of your invention.

H. Grant (4 ½ years to 8 years)

Once an acceptable scope of protection has been agreed with the Examiner and the specification has been tidied up, the application will be granted. In the UK, grant is usually achieved between 3 ½ and 5 years, but grant is more likely to be between 5 and 8 years in other countries.

Please refer to our timelines over the page for more information about the stages and costs.

Renewal Fees (annually from 2 years up to 20 years)

Renewal fees are payable on every granted patent in every country up to a maximum term of 20 years from the filing date. In most countries the renewal fees are paid annually on the anniversary of the filing date and the fees usually increase over the 20 year period. They may become payable whilst the application is still pending, for example, from 2 years onwards, or from grant depending upon the country.

Enforcement & Exploitation

The right to enforce a patent begins once the patent has been granted: It is not possible to sue for infringement until it has been granted, although it is sometimes possible to back-date compensation for infringement to the date of publication of the application.

It is possible to exploit an invention during the patent application process by granting licences or otherwise commercially using the invention.

Using the Multiple-Country Procedures to Obtain Foreign Protection

Patent Co-operation Treaty (PCT)

The Patent Co-operation Treaty (PCT) enables a single International patent application to be filed for foreign protection. The application will not be granted as an international patent, but the system provides an easy way to file and process foreign patent applications for most countries of the world at a time-critical stage (Step C). Therefore, the international procedure delays the outlay of individual country costs until later in the procedure. It also allows applicants to keep their options open as to WHICH COUNTRIES they want to seek protection in until 2 ½ years from the start of the patent process. The alternative is to file

individual applications in each country at Step C, which is costly at such an early stage.

The International procedure includes a search (Step D) and an optional early examination stage (Step F), but the bulk of the examination stages and onwards are performed on the individual national patent applications before their respective Patent Offices after 2 ½ years.

European Patent Convention (EPC)

The European Patent Convention (EPC) enables a single European patent application to be filed. Unlike the International system, the whole application procedure is based at the European Patent Office and if successful, results in a European Patent. The European Patent is then recorded as a bundle of separate national patents in the European countries selected by the applicant in a "validation" procedure. Validation may include translations depending upon the countries chosen, but the extent of translation varies from country-to-country, which in turn varies the cost in each country. We can usually provide cost estimates for each country to help you to select the countries.

The European procedure is a cost effective way to seek patent protection in a number of European countries. Advantageously, the European procedure can be used following the International procedure.

Post-grant Procedures

A patent can be challenged at any time on the basis that it is not 'valid', i.e. should not have been granted. This typically involves National Courts. However, a number of Patent Offices provide an opportunity to file an opposition to a Patent, for example the European Patent Office.

STEP A

