



A short guide to
Patents

What can be patented?

A patentable invention could be a new product or process, or a new use of a known product. In most jurisdictions, the invention must be new worldwide. It must not be an obvious development of a known product or technology and must have practical application.

Some inventions are nevertheless excluded from patent protection on policy grounds (eg methods of medical treatment) in some jurisdictions.

What rights does a patent give me?

Essentially, a patent gives you, the owner, the right to stop others from making, using, importing, or disposing or offering to dispose of a patented product within the jurisdiction where your patent is in force. Similar protection applies to patented processes and products arising directly from them. To enforce these rights, which vary slightly from jurisdiction to jurisdiction, you may take legal action in

the jurisdiction concerned and seek an injunction, damages and other remedies. The patent is an item of property and may be assigned (ie sold), licensed or mortgaged.

A patent does not give you (or any licensee) the automatic right to exploit the invention in question. An invention may, for instance, require use of earlier patented inventions. 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.



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:

If no patent application is filed, can 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 may be possible to keep the invention secret for a long period (eg a recipe or a process step), 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.

Does the application stand a reasonable chance of being granted?

The application containing details of your invention is published quite early on as part of the patenting process. 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 commercially advantageous to have a patent application on file even when there is little prospect of useful protection being granted.

Will the patent help bring about other benefits?

In some jurisdictions, very advantageous tax rates may apply to at least an element of the profit derived from sales of patented products or products with patented components, subject to specific local requirements, and on licence fees achieved from licensing the patent to others.



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 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 absolutely new and therefore no longer patentable in most jurisdictions. Non-disclosure agreements can be used where necessary.

How do I obtain a patent?

The first stage in obtaining a patent is the filing of the application at the relevant patent granting authority (also known as 'patent offices', eg the UK Intellectual Property Office). Applications must include a 'specification' which gives a full and detailed description of the invention, often with drawings.

Normally, although not always, applications as filed comprise a set of statements, known as 'claims', which define the invention precisely. The words used in these claims are critical and will be subject to very close scrutiny by patent offices, and by the court if the patent is litigated. Inappropriate wording could render the eventual patent useless.

Most jurisdictions will, on payment of a fee, run a search to try to indicate 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. Initial search reports can be helpful in deciding whether it is worth pursuing patent protection, both in the jurisdiction in which a patent application is initially filed as well as in others.

Assuming formal requirements are all met, the entire content of the application will almost always be published. Publication generally confers the applicant with some rights against infringing third parties, although enforcement is only possible by obtaining actual grant of a patent.

Most jurisdictions also require the filing of a request for substantive examination, together with the appropriate fee. The patent offices will carry out an examination of the substance of the application. Any objections can be argued against and the application amended if necessary. Once objections are overcome, the patent office will grant a patent.

The entire procedure, known as 'prosecution', 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).



How long does the patent last?

Most patents last for 20 years from their filing dates, subject to payment of renewal fees. If the renewal fees are not paid on time, a patent will lapse and third parties can use the invention without fear of liability for infringement.

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

It is not possible to add details of any improvements or modifications to a patent application that has already been filed. If a modification has been made within 12 months of the filing date of the first application for the invention, it is possible to file an updated patent application based on the details of the original application and claiming the filing date of the original application as its 'priority date' (see immediately below). 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.

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How do I obtain protection in other jurisdictions?

A patent will generally only give protection in one jurisdiction. However, the vast majority of countries now belong to an international convention on patents. If you have an application in a country which is a member of the convention and 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. The invention can be exploited in the 12 month interim period without prejudicing the validity of foreign patents.

When further patent applications are made under the convention, they will be processed in accordance with the patent laws of the jurisdictions concerned. Since filing additional 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 a search report on the first application, for example.

How do I obtain appropriate European protection?

The three possible routes to obtaining patent protection in a number of European jurisdictions are:

1. individual national patent applications
2. a European patent application
3. an international patent application (PCT) followed by either or both of these routes.

The most appropriate option for you will depend on individual circumstances.



How can the European Patent Convention (EPC) help me?

The EPC allows a single European patent application to be filed at the European Patent Office (EPO), and to obtain patent protection across a large number of European countries (now nearly 40), including the UK, France and Germany, as well as a small number of non-European countries. Some of the generated rights may be enforceable at national courts whilst others may be enforceable at the Unified Patent Court (UPC).

The EPC is a non-EU convention, and so the UK's June 2016 decision to leave the EU has no effect on its status as an EPC-contracting state. European patents will continue to cover the UK and Patent Attorneys in our UK offices will continue to be able to represent clients in all matters before the EPO.

Filing a European application can keep down the filing and examination costs. Alternatively, you may prefer filing individual national applications to guard against the loss of patent protection in all countries at once in the event of the European application being unsuccessful.

What does the European application involve?

European applications are subject to search and examination and will be published approximately 18 months after filing or after the priority date if claimed. If the examination process is successfully concluded, translations of the claims into the other two official languages of the EPO ie French and German must be filed and a grant fee paid. The patent will then be granted and published again by the EPO.

The granted patent may then be validated in your chosen EPC countries and/or as a Unitary Patent (UP). Some countries require the full text of the granted European patent to be translated into a national language, and most require a local patent attorney to be appointed as national representative, as well as a national validation fee to be paid. Thereafter it is necessary to pay annual renewal fees to each national patent office to maintain the patent in force. A Unitary Patent (UP) requires the full text of the granted European patent to be translated into a second EU language.

Within a period of nine months after grant, anyone may oppose a European patent centrally by lodging an opposition at the EPO. If successful, an opposition results in cancellation or amendment of the patent. All patents are subject to cancellation at any time, before national courts (see our short guide on Oppositions at the EPO for more details) or via the UPC.

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What is a Unitary Patent (UP) and how is it enforced?

As already noted, a UP is a single validation of a European Patent that extends patent protection to most but not all EU states. A UP validation may be selected in preference to individual national validations in those EU states that are a party to the UP. Only a single renewal fee is payable on a UP which is likely to represent a significant saving as compared to paying renewal fees on individual national EU validations.

The UK is of course not a party to the UP. UPs are enforceable via a centralised Unitary Patent Courts (UPC) system. It should be noted that national validations in individual EU states that are a party to the UP/UPC may also fall under the jurisdiction of the UPC if these are not explicitly opted out.

How does the Patent Cooperation Treaty (PCT) help me?

An international application, also known as a PCT application, allows a single patent application to provide initial patent protection in a very large number of signatory jurisdictions, including the EPC countries, China, Japan and the USA. There is, however, no such thing as an international patent: an international application must eventually be followed by the filing of national/regional (eg EPC) applications covering selected jurisdictions.

What are the advantages of filing a PCT application?

The main advantage is to start the process of obtaining patent protection in a large number of jurisdictions by means of a single application in English, without having to file a separate patent application in each jurisdiction or region. An international application enables a large number of jurisdictions around the world to be covered for an initial period before patent applications have to be pursued in each jurisdiction. It is particularly suitable where deferral of the costs of individual national patent applications (typically for 18 months) is advantageous for the applicant.



What does a PCT application involve?

PCT applications are subject to search and will be published approximately 18 months after the priority date. The search report is accompanied by an opinion on whether the invention is considered to be new and inventive. The option exists to respond to the search opinion by payment of an official fee and filing arguments and amendments to try to convince the examiner to issue a more favourable examination report. Although not binding, this may be influential in securing national and European patents.

For almost all designated jurisdictions the next stage is the national/regional phase entry 30/31 months after the priority date.

At the national/regional phase, applicants must decide which jurisdictions of the PCT are still of interest for patent protection and complete the required formalities at the appropriate national or regional patent offices, such as the EPO.

Are national applications resulting from PCT applications treated the same as if they had originally been filed nationally?

Yes, provided the formalities required by the jurisdictions are completed. Where required, the application must be translated into the relevant national language. Each application proceeds in a substantially similar manner to any national application filed directly at the relevant patent office. Each patent office may raise new objections additional to those raised in the international search. Different amendments may be required to obtain different national (and European) patents. Each national patent is then renewable and enforceable in precisely the same way as any other patent granted in the jurisdiction.

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Short guides on other areas of IP are also available.