

Inventions

Protection and Enforcement of Inventor's Rights

How often have we all dreamed of coming up with "a brilliant idea" like the Tetra Pak or the Post-It Note? Many people do have such ideas judging by the number of patent applications sent to the UK Patent Office each year. If you are one of those people, this Information Sheet may be of interest to you.

Patents can be granted for most industrially applicable processes and devices, subject to certain conditions. They include mechanical devices (mousetraps), methods for doing things (bleaching or colouring fabrics), chemical compounds (drugs) or mixtures of compounds (hand cream). Patents are not available for such things as discoveries, artistic works, computer programs, methods for performing a mental act or method of treatment or diagnosis.

In reality, there is an ongoing debate over whether software and business methods can be the subject of patent protection. An analysis of the arguments is not appropriate here but there is little doubt that the UK is moving slowly towards the US approach where such patents are regularly granted, although there is still a lot of opposition to both within the European Community.

First Steps

Having come up with your idea, it is essential not to tell anyone unless you have a written agreement from them to keep the idea confidential. Once your idea is publicly disclosed, it cannot qualify for patent protection. Public disclosure means, for example, writing an article that describes the concept. Once the idea is public, it can no longer be new, which is one of the requirements for patent protection.

The next step is to decide how to protect your idea. If it is an invention capable of patent protection, this may be an option. There are other possibilities which are mentioned later. Until the application is filed, however, the best protection comes from the law of confidentiality.

This means ensuring that each person to whom the details of the invention are disclosed is bound by an obligation not to disclose the details for exploitation purposes. This can best be achieved by asking each person to whom the invention is disclosed to sign a written confidentiality undertaking. This will have the effect both of underlining the seriousness of the obligation and setting out the scope of that obligation.

The next step is to consider patents. A patent gives the owner a monopoly (subject to being required to

grant a compulsory licence in certain limited situations) over an invention for a period of 20 years. Over that period the inventor has the exclusive right to use and exploit the invention, permit third parties to do so and to take legal action against others who may infringe the patent.

Obtaining a Patent

The Patents Act 1977 provides that to be patentable an invention must:

- be new
- involve an inventive step
- be capable of industrial application
- not fall within a number of statutory exclusions which take inventions outside patent protection.

Applications for a patent need to be submitted to the UK Patent Office. The application procedure is complex and we recommend that an inventor seek the services of an experienced professional before proceeding. An application must be made on an official form and include a specification of the invention.

The specification is the most important document. This document contains a written description of the invention and usually includes drawings for illustration purposes. It may also include one or more claims which define the invention and set out its main technical features. Claims can be filed up to 12 months after the application.

The application will be given a filing date. This is important because the period for protection runs from the filing date and not the date of the grant of the patent.

Once an application is filed, the applicant has up to a year to decide whether to proceed. This period provides an opportunity to assess the technical and commercial potential of the invention, seek finance for production or development, or discuss the invention with potential third party licensees.

If the inventor wishes to proceed with the application, a search fee will have to be paid and claims filed if not filed with the initial application. The Patent Office will then begin the examination and search procedure.

Obtaining a patent is a long process without any short cuts. It does not mean that the inventor has to wait, though. An inventor can start to manufacture or market the invention prior to the patent being granted.

Scope of Patent Protection

Patents are territorial. A patent granted by the Patent Office in the UK will protect the inventor's rights in the UK. If the inventor wishes to obtain international patent protection there are several options which include:

- make individual applications in each country in which patent protection is needed.
- make an application under the European Patent Convention which permits one application to be made to the EPO office in Munich designating the European States in which patent protection is sought.
- make an application under the Patent Cooperation Treaty whereby one application is made to the PCT office designating the worldwide countries in which patent protection is sought.

Community-wide patents may also soon be a possibility. The range of options is complex and again, it is important that appropriate advice is sought.

Exploiting the Invention

Once you have obtained a monopoly right, you will want to start making money.

The owner of a patent can exploit the rights granted by a patent in a number of ways. The inventor can exploit the patent himself, although this may not be financially viable. Other ways include selling or licensing the rights to a third party.

Either way, it is important that the relationship between the patent owner and the third party are properly regulated in a formal agreement that complies with both the UK and an increasing volume of EC law.

Disadvantages of Patents

Obtaining a patent is a lengthy process and can be very expensive. There are also risks involved in submitting an application and going public, only to have the application rejected. By that stage, the invention will have been disclosed to the public.

In certain circumstances it may be more appropriate for an inventor to keep the invention secret and confidential. The inventor could either keep the

invention secret and exploit it himself or, alternatively, licence it to a third party for exploitation, subject to strict obligations of confidentiality.

There is always a danger that third parties may develop an invention which is the same or similar to the secret invention. This is a risk whether or not patent protection is obtained, so it is important to enforce your patent protection, when necessary.

Enforcing the Patent Protection

The rights granted to an inventor by a patent are not enforced automatically. There is no patent police force to ensure that patents are not infringed. It is the responsibility of the inventor to look after his rights and enforce them appropriately.

Infringement can be either primary or secondary - the difference is in the order that a court can make. Infringement includes:

- the making, disposing of, offering to dispose of, use or import a product.
- the use or offer of use of the process in the UK, where the infringer knows, or a reasonable person would know, that use without the consent of the proprietor would be an infringement of a patent .
- disposing or offering to dispose of, use or import any product obtained directly by means of the process .
- supplying or offering to supply in the UK, to a person other than a licensee, any of the means, relating to an essential element of the invention, for putting the invention into effect.

Other Forms of Protection

Patents are not the only form of intellectual property which may exist in a new invention. For example, rights may exist in the invention's name or the invention's design or the invention's "look". The process of identification and protection involves consideration of a wide range of laws relating to trade marks, trade names, tort, copyright and designs. These should all be considered and professional advice sought.

Conclusion

Whether to seek protection or not is a matter for each inventor to consider. Although the process is lengthy and costly, the benefits of a 20 year monopoly are obvious. Copycats will always exist, whether or not an invention is protected by patent but, if you act quickly to obtain an injunction preventing further infringement the damage can be minimised.

This information sheet is intended to highlight some key issues relating to patents. It is for general guidance only and is not a substitute for specific advice. It is based upon our understanding of the legal position as at August 2005 and may be affected by subsequent changes in the law.

Should you require any specific legal advice on the issues covered, please e-mail Nicky Androsov at nicky.androsov@ts-p.co.uk or call on 01892 510000.

The E-Commerce and IP Unit at Thomson Snell & Passmore provides a full range of services in relation to intellectual property, e-commerce, computer and technology law issues.

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