

PATENTS

A patent is a legal monopoly giving the inventor of a new device or process (or his/her company) the right to stop third parties exploiting the invention without permission. It does not guarantee that the patent owner has the right to use the invention: someone else in turn might have a more general patent to prevent this.

To be patentable an invention must be new and must not be obvious at the time when the patent application is filed. This means that the invention must not have been disclosed to the public anywhere in the world, even by the inventor, before the filing of the application. Disclosure to a single person who is not under a duty of confidence can count as disclosure to the public. It is therefore essential to consider whether a patent application should be filed before marketing or otherwise making public the invention.

Certain types of invention are excluded from patent protection, e.g. inventions that cannot be applied in industry; methods of medical treatment; and non-technical inventions such as ways of doing business, carrying out mental acts or presenting information.

Filing

The first stage in obtaining a UK patent is to file at the UK Intellectual Property Office an application comprising a description of the invention, drawings if appropriate and optionally claims and an abstract. The Office allocates an application number and a filing date. Disclosure of the invention to the public after this filing date does not prejudice your patent rights.

The filing date marks the start of a so-called "priority year". Within this year only, subsequent UK patent applications can be filed which keep the benefit of the initial filing date for matter in common with the initial application. Such applications can be used to cover modifications or improvements made to the original invention. Consequently, if you make any significant changes to the invention please discuss them with us before you make them public so that we can consider whether an additional application might be necessary.

After the end of the priority year you cannot incorporate any new information about your invention into your application.

Also within the priority year it is possible to file foreign applications which maintain the benefit of the initial UK filing date. If the invention has been disclosed to the public after filing, such priority-claiming applications are the only way to obtain valid patent protection abroad, so it is most important that foreign patent protection is considered within the priority year. We remind you of this towards the end of the year.

Search

Before the end of the priority year, a search must be requested, a search fee paid and claims and an abstract filed (if they are not already on file). An examiner at the UK Intellectual Property Office then conducts a search through previously published patent specifications and a limited range of other documents to form an initial view on whether or not the invention is new and not obvious. Around three months after the filing of the search request, the examiner issues a report detailing any relevant publications found. We send this report to you and advise on the consequences of the documents found.

It is usually only once we have seen this search report that it is possible for us to advise on the scope of patent protection that you are likely to be able to obtain. Consequently, if you are considering any foreign patenting, we advise that a search request be filed early in the priority year so that you have this additional information when you are considering the expensive foreign patenting options.

Approximately eighteen months after the initial filing date, the patent application is published, together with the search report if available.

Examination

Within six months of publication, examination must be requested and an examination fee paid. The application then goes back to an examiner, who issues a report detailing any objections to the application. We send the examination report to you with our comments and, following correspondence with you, prepare and file a response dealing with the objections. Once a successful response has been filed, the application is accepted and published again, this time as a granted patent.

Renewal Fees

Once the patent is four years old, annual renewal fees become payable to maintain the patent in force. The maximum life of the patent is twenty years from the initial filing date.

Accelerated Prosecution

Obtaining a UK patent usually takes three to four years from filing. However, it is possible to shorten the process very significantly. This may be helpful if, for example, a competitor is proposing to market a product falling within the claims of the patent application.

We can request combined search and examination by paying the search and examination fees together on initial filing and the UK Intellectual Property Office aims to complete the procedure within twelve weeks of the request. Early publication of the application may also be requested. Using this procedure, it should be possible to obtain the grant of a patent within twelve months of filing.

If a potential infringement becomes apparent later in the prosecution of the application, it is usually possible to accelerate the remaining procedures by writing to the UK Intellectual Property Office to explain the situation.

Enforcement of Patents

After your patent has been granted, you can take action against infringers in either the High Court or the Patents County Court. Remedies include an injunction to prevent further infringement, damages and recovery of a proportion of your costs. Such action can be very expensive and you may wish to consider taking out legal expenses insurance to ensure that your patent can be enforced if necessary.

A UK patent only gives rights in this country. To protect your invention in other countries requires foreign patent applications and we have a separate set of notes on that subject.

We hope that you will find this general information helpful but this is a complex area of law and we strongly recommend that you seek our advice in relation to any particular case.