

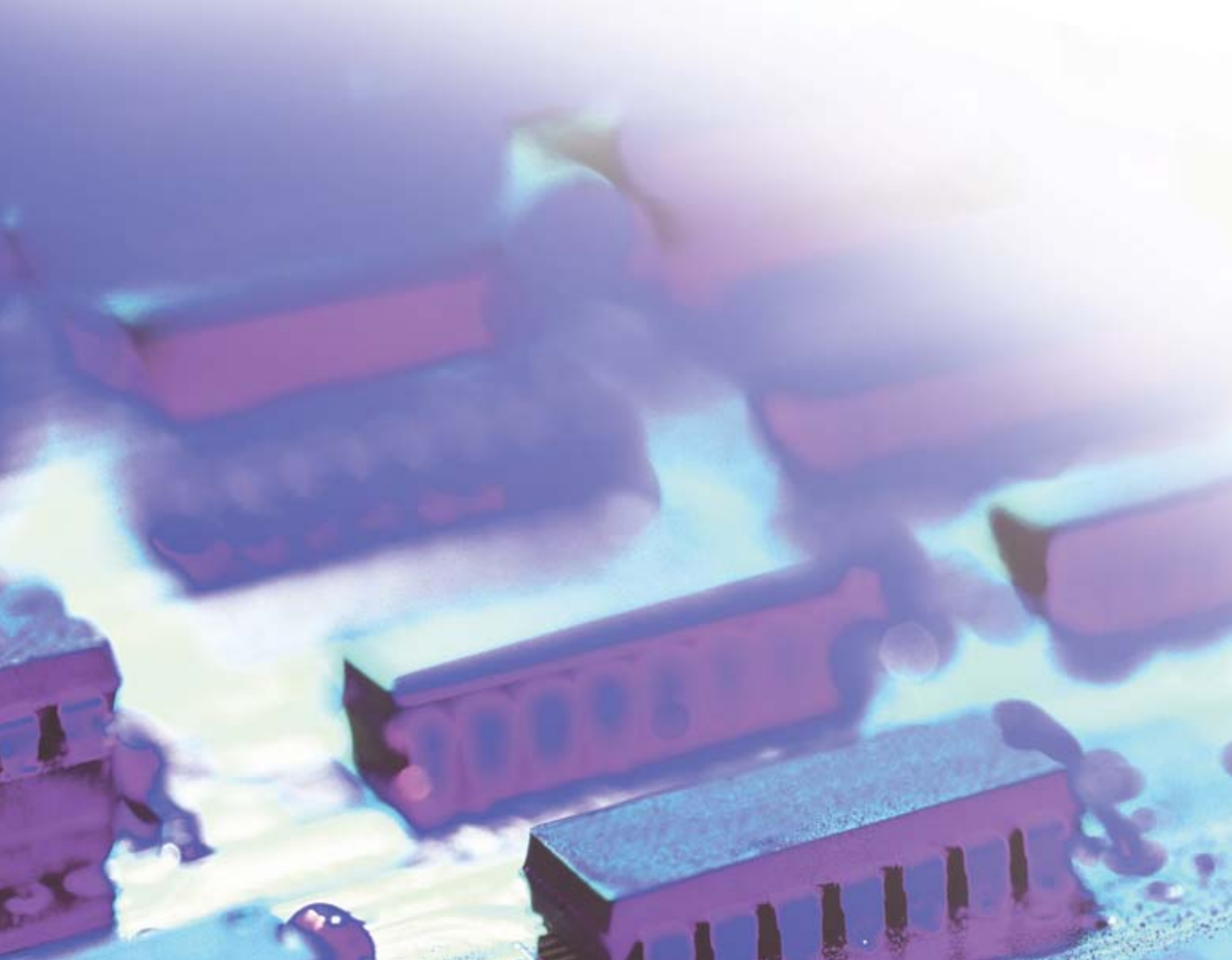
MARKS & CLERK

Intellectual Property

Patents

United Kingdom

a short guide





UK Patents - a short guide

What is a Patent?

A patent grants the right to prevent others from exploiting something in a particular jurisdiction. It is therefore a form of monopoly. In the UK and many other countries, a patent can last for twenty years.

What can be patented?

In most countries, a patent protects an invention. This could be a product, a process or a method. But not all inventions are patentable. First and foremost, the invention must be new – essentially this means not known to the public prior to the date of filing the patent application. Next, the invention must not be an obvious development of known technology. The invention must also provide some functional advance.

Even if these criteria are fulfilled, some types of invention are nevertheless excluded from patent protection; these include: scientific theories, mathematical methods, aesthetic creations, computer programs, methods of medical treatment and rules/schemes/methods for performing a mental act, playing a game or doing business. Whether a specific invention can be patented depends very much upon the extent to which it includes and depends upon excluded subject matter and the law can be complex. This means that inventions involving excluded subject matter are still frequently patented, where they provide a technical advance – this is particularly the case for many computer programs.

What rights would a patent give?

Amongst other things, a UK patent gives the owner the right to stop others from making, using, importing, disposing of, or offering to dispose of a patented product within the UK. Broadly similar provisions apply in respect of patented processes and products arising directly from them. To enforce these rights, the patent owner may take legal action and seek an injunction, damages and other remedies.

The patent is an item of property and may be assigned (i.e. sold) or mortgaged. The patent owner may agree not to block exploitation of the invention by granting a licence.

It is important to understand that a patent does not give the patent owner (or any licensee) the automatic right to exploit the invention. This is because the invention may be a development of an earlier patented invention and, in this case, it would be necessary to obtain the permission of the owner of the earlier patent before the invention could be exploited.

When should an application be filed?

It is vital to file the application before there has been any non-confidential disclosure of the invention and certainly before exploiting it commercially. Making a non-confidential disclosure before filing the application is considered to put the invention in the public domain, with the effect that it is no longer new and therefore no longer patentable.

Is patenting the best option?

As with any commercial tool, a patent should only be used if the circumstances suggest that it would be commercially useful. With this in mind, there are a number of issues to consider:

- [Does the application stand a reasonable chance of being granted?](#)

This is important because one of the earlier stages of a patent application involves the publication of the invention. If the application then fails, the applicant will have handed their previously secret invention to their competitors for no advantage in the marketplace. In some cases it is nevertheless commercially advantageous to have a patent application on file even when there is little prospect of useful protection being granted.

- [If no patent application is filed, how long could the invention be kept secret? Will the invention be revealed to the public as soon](#)

[as articles encompassing the invention are sold? How long will it be before key personnel leave and take details of my invention with them?](#)

In exceptional cases in which it would be possible to keep your invention (e.g. a process step) secret for a long period, commercial secrecy may be preferable to patent protection.

- [Even with a patent, how easy will it be for the patent owner 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.

How do you obtain a UK patent?

The procedure can be both complicated and long. It can take over four years between filing an application and a patent being granted. However it is possible to exploit the invention as soon as a patent application has been filed.

The first stage in obtaining a patent is the filing of the application papers at the Patent Office. The application papers must include a specification comprised of a full and detailed description of the invention - usually with drawings.

Within 12 months of filing the application, the applicant must also submit a set of statements (known as 'claims'), which define the nature of the invention in such a way that the Patent Office (and subsequently a court) can determine the scope of the monopoly sought. The words used in these claims are critical and not only will they be subject to very close scrutiny by the Patent Office or court, but inappropriate wording could render the eventual patent useless. By this stage it is also necessary to file an abstract of the disclosure and submit a request for 'Preliminary Examination and Search' together with the appropriate official fee.



The Patent Office will then conduct a search to establish whether or not the invention is new and non-obvious bearing in mind previously published materials. The results of the search will be published in a report and it is then possible to amend the claims in light of the search results if necessary.

Many applicants find it advantageous to submit the 'Request for Preliminary Examination' at the same time as filing the application, so as to receive the Patent Office search early on. This will enable them to decide whether it is worth continuing with the application, particularly if they wish to protect their invention abroad.

Assuming all is well, the Patent Office will then publish the application. The description, abstract, drawings and claims will consequently be made public and will be sent to almost every country in the world. Now that publication has taken place, the applicant has acquired some rights against infringing third parties, although this will depend upon their obtaining a successful patent at the end of the day. Although the applicant can only take legal action once they have been granted a patent, any damages can be backdated to the publication date.

Within six months of the application being published, it is necessary to submit a request for 'Substantive Examination' together with the appropriate fee. Following this, and usually within about one year, the Patent Office will carry out an in-depth examination of the application. If any objections are raised by the Patent Office then these can be argued and the application can be amended if necessary. Any objections must obviously be overcome before the Patent Office will grant the patent.

How long will the patent last?

A UK Patent will last for 20 years from the application filing date, provided that the annual government renewal fees are paid. If the renewal fees are not paid at any time, the patent

will lapse with the result that third parties can use the invention without fear of infringement.

How do you protect any improvements or modifications to a patented invention?

This can present problems because it is not possible to add details of any improvements or modifications to a patent application that has already been filed. If, however, the modification has been made within 12 months of the initial patent application filing date, it is possible to file a new patent application based on the details of the original application and claiming the filing date of the original application. The first application can then be allowed to lapse since it is no longer needed. If however the modification has been made after the 12 month period, it will be necessary to file a completely new patent application. It is of course vital that the modification is not disclosed before the applicant has filed the new application.

Once you have a UK patent, how do you obtain foreign protection?

The UK patent will only give protection in the UK and the Isle of Man. Most of the countries in the world now belong to an international convention on patents, which does make foreign filing easier, provided the applicant has an existing UK application. If the applicant files a subsequent application under the convention within 12 months of a first filing date, then they can claim the first filing date for the subsequent application.

When a foreign patent application is made under the convention, it will be dealt with from start to finish in accordance with the patent laws of the country concerned. Since filing foreign 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.

In addition, it is also worth bearing in mind that the ease with which a patent is granted will vary from country to country depending upon how strenuous the examination procedures are. In countries with less rigorous examination procedures, the grant of a patent does not necessarily guarantee that a patent will be valid. The same is true in countries with more rigorous testing although there will of course be a higher presumption of validity.

There are two other systems that can be used: the Patent Co-operation Treaty (PCT), to which a large number of countries in the world are party, and the European Patent Convention (EPC) to which many European Countries adhere. Under each system, a single application is submitted, typically within 12 months of filing the first application, and the countries in which the applicant is interested in obtaining protection are designated. The procedure under the EPC is much the same as filing for a UK patent. Once granted, the EPC patent becomes a bundle of national patents, each of which is maintained and enforced in its respective country.

The PCT application is searched and may be examined on request (and payment of the required fees), but this examination stage does not result in a granted patent. Instead, it is necessary to convert the application into individual national applications, each of which then proceeds independently. The advantage of the PCT is that it can delay the expense of the national applications by as much as 18 months – which can be crucial if the commercial success of the invention is not immediately clear.

How can Marks & Clerk help?

With over fifty partners and 300 staff, we serve a client base ranging from private individuals to the largest multi-national corporations. Voted the UK's No. 1 firm of both trade mark and patent attorneys* for 6 years in succession, we have the experience and expertise to assist you in obtaining, maintaining and exploiting your patents.

* *Managing Intellectual Property* magazine surveys over 3000 intellectual property professionals worldwide.

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For a free no obligation discussion about how we can help, please contact us at one of our offices: -

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