A basic guide to patents
## Patents

### What are they?

- A patent is a published which describes an invention and provides the inventor with a monopoly right to exploit that invention for a specified period.

- The patent system aims to provide inventors with sufficient protection to recoup their expenditure on successful (and unsuccessful) inventions. At the same time, it aims to improve the general body of technical understanding and facilitate research and development by others.

### What can be patented?

- In order to be patented, an invention must:
  - **Be new;**
  - **have an inventive step;**
  - **be capable of industrial application;** and,
  - **not be otherwise excluded.**

  - **New**: to be new, the invention must not form part of the “state of the art” (i.e. all materials made available to the public anywhere in the world).

  - **Inventive step**: the invention must not be obvious to an unimaginative person (i.e. someone lacking an inventive spark) skilled in the particular field in question.

  - **Industrial application**: the invention must be capable of being made or used in any kind of industry.

  - **Exclusions**: a patent cannot be obtained in respect of:
    - Natural phenomena: discovery, scientific theory or mathematical method;
    - Aesthetic creations: literary, dramatic, musical or artistic works, etc. – these are protected by copyright; or,
    - Mental acts: scheme, rule or method for performing a mental act, playing a game or doing business.

  - The requirement of novelty means that any invention should be kept secret. A disclosure which enables someone to make the invention or work the process will result in the invention becoming part of the “state of the art” and it will not be patentable.

  - **Practical tip - it is vital for the inventor to enter into a non-disclosure agreement with any 3rd party to whom he intends to disclose the invention.**

### Procedure for protection

- To obtain a patent, the inventor must make an application to the UK Intellectual Property Office.

- The inventor will request that a patent be granted and set out the specification of the invention. The specification includes a description of the invention and the inventor’s claims.

  - **Description**: this must be in sufficient detail for it to be performed by a person skilled in the relevant field.

  - **Claims**: these define the scope of the monopoly sought by the inventor. If granted, they will define the scope of the protection.
| Ownership          | • The inventor is the first person entitled to the invention.  
|                   | • However, the patent will belong to the employer if the patent is made by an employee in the course of his normal duties, provided that an invention might reasonably be expected to result from his duties. |
| Owner's rights     | • The patent owner has the exclusive right to work the patent, i.e. to make, sell, and offer to sell, use or import the invention. |
| Duration           | • Patents are initially granted for a period of 5 years and can be renewed on an annual basis for up to a maximum of 20 years. |
| Infringement       | • Infringement occurs where a person that does any of the acts which are the exclusive right of the patent owner without his consent. |
| Remedies           | • If a 3rd party infringes a patent, it may be possible to obtain the following remedies:  
|                   | 1. An injunction to prevent future infringement.  
|                   | 2. Compensation for the infringing activity:  
|                   | a. damages for loss of earnings – such damages are usually based upon a reasonable royalty for the use of the patent made by the infringer, i.e. what would a reasonable licence fee have been for the use that has been made; or,  
|                   | b. an account of the profits made by the infringer arising from the infringing use; and/or,  
|                   | 3. delivery up or destruction of the infringing articles. |
| Exploiting a patent| • A patent is a valuable commercial asset. The owner can assign (i.e. transfer) its rights to a 3rd party, or grant a licence to a 3rd party to do any of the above acts.  
|                   | o Assignments must be recorded in writing and signed by or on behalf of the person assigning the right in order to be effective.  
|                   | o A licence may be granted formally, informally or may arise by implication. A formal licence agreement provides the parties with certainty. |
| Patent protection internationally | • Patents are registered on a territorial basis.  
|                   | • It is possible to make a single application to the European Patent Office where a single application can be made to some or all of the 38 contracting States. If granted, the effect is a bundle of national patents in each of the designated States. A unitary patent will soon be available which will be a single patent applicable in 25 EU countries.  
|                   | • This Patent Co-operation Treaty currently has 148 signatory States (including the UK). The Treaty introduced a simplified patent application filing system. It is possible to file an ‘international application’ in 1 or more of the 148 contracting States. If granted, the effect is a bundle of national patents in each of the designated States.  
|                   | • The Paris Convention currently has 175 signatory States (including the UK). The Convention provides an applicant in 1 of the signatory States with a 1 year priority period to make subsequent applications in 1 or more of the other 174 signatory States. Any such applications will take priority over those of others filed in the relevant State(s) in respect of the same invention. |