

## PATENTS



The advertisement features a background of large, light-colored gears. In the center, there is a smaller inset image showing a globe surrounded by several interlocking gears in shades of blue and green. Below this inset is a larger, semi-transparent globe with the text "Bailey Walsh & Co. LLP" written around its top edge. At the bottom of the advertisement, the text "Cost effective protection for your ideas™" is displayed, followed by a horizontal line of four small blue squares, each containing one of the following terms: PATENTS, TRADE MARKS, DESIGNS, and COPYRIGHT.

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● PATENTS ● TRADE MARKS ● DESIGNS ● COPYRIGHT

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## **PATENTS**

A patent is a legal monopoly which is granted in respect of a patentable invention. It provides the patent owner with the right to stop third parties from manufacturing, selling, importing or otherwise using the invention without permission for up to a maximum of twenty years. To enforce this right, the patent owner may take legal action against the third party, seek an injunction, obtain damages and/or other remedies.

To be patentable, an invention must be new (i.e. it must not have been publicly disclosed anywhere in the world) and involve an inventive step (i.e. it must be more than an obvious development) at the time of filing a patent application. The invention must also not fall within one of a number of possible exclusions from patent protection, such as scientific theories, methods of performing a mental act, method of playing a game, aesthetic creations, mathematical methods, computer programs or business methods.

If there is a reasonable chance that an invention is new and inventive and is likely to have some commercial value, a patent should be applied for.

### **PROCESS FOR OBTAINING A PATENT**

The procedure for obtaining a patent in the United Kingdom can be broadly divided into five stages.

- 1) Filing
- 2) Search
- 3) Publication
- 4) Examination
- 5) Grant

A summary of each of the above five stages are given below:-

### **FILING A PATENT APPLICATION**

The first stage of the application process is to file a patent application at the British Patent Office, including at least a description of the invention and one or more drawings if appropriate. As soon as this application is filed, the invention can be publicly disclosed and exploited.



The application lasts for an initial period of a year (often referred to as the “priority year”) and at the end of this period a decision needs to be made as to whether to continue with the application and, if so, which countries in the World patent protection is required. If foreign patent protection is required then one or more foreign patent applications must be filed within the priority year. If any improvements or modifications are made to the invention after the patent application is filed, such modifications can also be included in the patent application during the priority year.

Before the end of the priority year, a “Request for Search” must be filed at the British Patent Office in respect of the patent application, together with a set of claims and an abstract. The claims define the scope of protection which is being sought by the patent application for the invention. The search and examination are generally undertaken in respect of the subject matter defined in the claims.

### **SEARCH**

The search is a compulsory part of the application process and is undertaken by the British Patent Office in respect of previously published patent applications and granted patents, together with a limited range of other published literature, to ascertain whether the invention is new and involves an inventive step. A search report is then issued in respect of the patent application detailing any relevant prior publications identified. An assessment of these documents determines the likelihood of whether a patent will be granted in respect of the invention.

### **PUBLICATION**

Approximately eighteen months after the first application is filed, the application is published, together with the search report if available. This publication typically marks the first time that potential competitors of the invention can view the patent application. If the applicant wishes to continue with the patent application process, a request for “Substantive Examination” must be made to the British Patent Office within 6 months from the date of publication.



## **EXAMINATION**

The “Substantive Examination” of the application is a compulsory part of the application process and in most cases results in the issuance of an “Official Letter” detailing any objections that the British Patent Office has to the patent application. The main objections raised in this official letter are that, in the Examiner’s view, the invention is not new, or, if new, is merely an obvious departure from what is already known, typically due to one or more of the documents identified in the search report.

In order to continue with the application, these objections need to be overcome by the filing of a response at the British Patent Office. The response details arguments and/or amendments to the application which will allow the application to meet the requirements of UK Patent Law and which will also allow the invention to be distinguished from other inventions described in the previously published documents identified in the search report and examination.

## **GRANT**

On successful completion of the five stages of the application process, the application will be accepted and published again by the British Patent Office, this time as a granted patent. In order to maintain the granted patent, renewal fees are payable to the British Patent Office annually from the fourth anniversary of the patent application through to the nineteenth anniversary or until the patent is no longer required, if earlier.

## **PATENT PROTECTION IN FOREIGN COUNTRIES**

If you require patent protection abroad to protect your export markets or manufacturing interests, this can be done in three different ways:-

- a) filing separate patent applications in each country in which patent protection is required;
- b) filing a European Patent Application designating a large number of European countries;
- c) filing an “International” or PCT Patent Application designating a large number of countries or regions in the world.



No matter which route is chosen, any foreign patent applications must be filed within the “priority year” and are treated effectively as having been filed on the date of filing the original British Patent Application.

A patent is a national right and therefore, if you require patent protection in a particular country, a granted patent must be obtained in that country. Options a) and b) above will both lead to the grant of national patents in the countries of interest. Option c) is different in that it does not lead to the grant of an International Patent but provides an additional 18 month “window” in which national patent applications can be filed.

The filing and prosecution of foreign patent applications typically takes the same route as the filing and prosecution of British Patent Applications. The relevant patent authorities undertake a search and examination on the application, assess whether the invention is novel and inventive and determine whether the application meets the national patent law requirements.

We can advise you more fully on the procedures and costs involved in filing foreign or regional patent applications on request.

### **OUR SERVICE TO YOU**

We offer a free, no-obligation consultation to discuss the above patent application procedure in more detail, to answer any of your queries and to provide you with an initial assessment as to whether your invention is likely to meet the criteria for novelty and inventive step.

We can undertake searching of various patent databases in respect of your invention and provide you with an initial assessment as to whether there are any prior published patents and/or applications for patents which may result in objections being raised against a patent application for your invention, if filed. Such searching can also reveal previously published patents which your invention may infringe if sold, made, imported or otherwise without permission in the United Kingdom or other selected countries.

We can prepare and file the UK Patent Application and one or more foreign patent applications for your invention. We will forward all documentation received from the Patent Office in relation to your patent



application to you, together with an explanation as to meaning of the documentation and details relating to the actions that need to be taken to keep the patent application or patent in force. Reminder letters are also sent in relation to deadlines for which we require your instructions.

We can review and/or discuss any documents with you that are identified by the UK Patent Office as being of potential relevance to your patent application, together with responding to the examination report and submitting any suitable amendments and/or arguments which will allow the application to proceed to grant.

A summary of some of the other services we offer are:

- General Advice on Intellectual Property Matters
- Filing, Prosecution and Management of Intellectual Property Rights
- Management of Intellectual Property Portfolios
- Patent Searching
- Watching Services
- Patent Filing and Prosecution in the UK and Abroad
- Licensing
- Assignments
- Infringement Assessments
- Validity Assessments
- Renewals
- Patent Oppositions and Appeals
- Bring and Defend Actions for the Revocation of Patents
- Advise on Designing Around Patents Owned by Third Parties
- Advise on Entitlement Issues
- Send Letters Before Action

Please do not hesitate to contact one of our advisors if you have any queries relating to our services and/or would like to arrange a meeting or to instruct us to undertake work on your behalf. Further information can also be found on our website at [www.bailey-walsh.com](http://www.bailey-walsh.com)

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