

## Intellectual Property Services

This note summarises for the benefit of new and prospective clients the general kinds of legal protection which are available in the United Kingdom for their ideas and the services we can provide. It is intended as an introduction to intellectual property protection, rather than an authoritative definition of the law, and specific advice should be sought on any particular matter. The estimates of typical costs, which include official fees but not VAT, should be regarded as approximate.

### Who we are

Patent and Trade Mark Attorneys are private legal representatives and are not in any way connected with official Government bodies such as the United Kingdom Intellectual Property Office (UK-IPO). We are organised as a private firm in the same way as, for example, solicitors, and represent clients in a specialised branch of the law. There is no legal requirement for anyone to employ a Patent or Trade Mark Attorney to represent him or her, although where the protection of valuable intellectual property is concerned it is obviously sensible that the legal work should be carried out by suitably qualified and experienced people.

Patent Attorneys are graduate scientists who receive further legal training for typically four years before qualifying to practise by examination. Trade Mark Attorneys are either graduates who receive further legal training before qualifying to practise by examination, or Patent Attorneys who are also qualified by experience to practise in trade marks.

Our work covers four main subjects: patents, trade marks, designs and copyright, and associated matters such as searching for the existence of rights, advising on the infringement and validity of rights, dealing with the transfer of rights by assignment or licence and handling associated litigation. We handle these intellectual property matters in most countries of the world, through overseas associates where necessary.

### What is a patent?

Patents are officially-granted legal monopolies which are intended to protect new technical inventions. In return for publishing the new invention in the patent, the patentee is given the right to prevent others from using the invention commercially for up to 20 years in the country covered by the patent. The grant of a patent by the UK-IPO does not guarantee the inventor any financial return for his ideas nor is there any official enforcement of patents. It is up to the patentee to enforce his or her rights through the Courts if necessary. The value of a patent is in the ability to exclude competition while an invention is developed into a successful commercial product.

In most countries of the world, a patent will only be granted if the invention is absolutely new. This means that the invention must not be disclosed publicly before a patent application is filed. Non-confidential disclosures of an invention to family, friends, suppliers, customers or anybody else must not be made before an application is filed. Anybody to whom an invention is disclosed must agree in advance that it is confidential and that the information will not be used by them or passed on. A premature disclosure of the invention may preclude obtaining valid protection.

### Patenting procedure

#### Preparing an application

To enable us to prepare and file a patent application we need to be provided with full technical details of the invention together with an indication of what the purpose or advantage of the invention is and what earlier proposals have been made.



We then draft a patent specification usually including broad statements of the invention and a detailed description of the invention. After the specification has been approved by the client it is filed at the UK-IPO who then issue the application number. At that stage the application is pending but the rights in the application are not enforceable until the patent is granted. Our charge for preparing and filing a patent application depends on the time involved in drafting the specification. As a guide, the cost is typically between £1,500 and £7,500 depending upon complexity and subject matter.

All of the subsequent steps in the patenting procedure will rely upon this original UK patent application, and it is crucial that the invention is adequately described and its essential features identified in that application. Corresponding patents in other countries will claim priority from the original UK filing date and if that priority is lost the patents may be invalidated by intervening activities. Those could be the inventor's activities, such as seeking to promote the invention, or the activities of other people. If the overall expense of obtaining patents is not to be wasted, it is important to invest sufficiently in a first patent application that is able to support a whole patent portfolio for the next 20 years.

### **Searching**

Within a year of filing the application it is necessary to complete the application by filing a set of claims and an abstract and paying the official fee for the novelty search. The cost at this stage is typically £500 to £600 in simple cases. It is possible to file the claims and pay the search fee at the initial filing stage and this will usually result in the search being carried out sooner. This may be useful if an extensive foreign patent filing programme is contemplated as it will give a better idea of the likelihood of being able to obtain useful patent protection. On the other hand, it may be desirable to delay the payment of fees as long as possible to enable the commercial exploitation of the invention to be established.

It is also possible to carry out a search to ascertain the novelty of an invention before a patent application is filed and while this may be appropriate in some cases it is usually time-consuming and correspondingly expensive to search for the prior publication of any particular idea. Where resources are limited, therefore, it may be preferable to concentrate them on having an application prepared. A number of patent databases are available free on the Internet, for example at <http://gb.espacenet.com/> or <http://www.uspto.gov/>, which you can use to search for prior disclosure of your idea.

Once an official search has been requested, the UK-IPO will issue a search report listing the documents that they think are relevant to the application. This usually takes between three and nine months depending upon the subject matter. We then obtain copies of the documents and if appropriate advise as to their relevance. The cost at this stage will depend upon the number and complexity of the documents cited in the report but can be expected to start at about £500 unless the results are very straightforward.

### **Applications in other countries**

As well as needing to complete the British application, it is also necessary within a year of filing to file any foreign patent applications, which may be effectively backdated to the date of filing the original British application. There are various options for doing this and we can advise on the best option and the cost involved at the appropriate time. A route commonly adopted at this stage is to file an International (PCT) application, provisionally designating over 100 countries, at a cost of about £2,500 to £4,000. The advantage of a PCT application is that the cost of any necessary translations is deferred for a further eighteen months. It should be noted, however, that filing applications in other countries is expensive and use should therefore be made as far as possible of the first year after filing for establishing the commercial viability of an invention.



### **Procedure to grant in the UK**

About eighteen months from the original application date, the UK-IPO print and publish the specification and it is from the publication date that damages for infringement may be claimed if the patent is eventually granted. In view of the developing commercial exploitation of the invention and the documents cited in the search report it is desired to proceed with the patent application, it is necessary to pay the fee for the full examination within six months of publication. The cost of this is about £250. After typically six months, the Examiner's report issues possibly raising objections to the application. We report this to the client with our advice and then deal with the objections in accordance with the client's instructions. The cost of this work again depends on the time involved. Assuming the Examiner's objections are overcome, the patent is eventually granted and may be kept in force for a maximum of twenty years from the filing date by paying annual renewal fees first due four years from the filing date. There is a small further charge for reporting grant, forwarding the letters patent document and remaining as address for service.

### **Summary**

The procedure for obtaining a patent can be lengthy and costly and should only be embarked upon if there is a reasonable prospect of financial return from the invention. The return may be realised in several ways, for example:

by manufacturing and selling the invention and using the patent to prevent others from exploiting the invention; by selling the invention and patent rights to an interested company; or by licensing a third party to exploit the invention in return for royalties.

### **Trade marks**

A Trade Mark is a sign, such as a logo or brand name, which serves to distinguish the goods or services of one trader from those of another. Registering a trade mark gives the owner the exclusive right to use the mark in relation to specified goods or services. To some extent, unregistered trade marks may be protected by the law of passing off but this is only effective if people are likely to be deceived by use of the mark. It is usually difficult and costly to prove this. The registration of a trade mark by its first user, however, gives an absolute monopoly in the use of the mark. Again it is up to the proprietor of the registered trade mark to enforce their rights.

To be registrable, a trade mark must generally speaking be distinctive and not descriptive of the goods or services it is to protect. In particular, common geographical names and surnames (unless very rare) are difficult to register until such time as the applicant can show that they have become distinctive of his goods or services through use.

The cost of preparing and filing an application to register a trade mark in one class is just under £500 plus a charge in respect of any additional work, such as advice. All goods and services are classified into 45 classes. If more than one class is required for an application there is an additional charge for each extra class.

Trade mark applications are examined by the UK-IPO to assess whether the mark is capable of functioning as a trade mark, i.e. whether it is sufficiently distinctive. The UK-IPO will also conduct a search for earlier conflicting marks protected in the UK, although it will not raise formal objections based on any such marks. If appropriate, an Examination Report will issue, setting out any objections and detailing any earlier marks which it regards as conflicting with the application. The cost of analysing, reporting and responding to the Examination Report will depend on the amount of work involved and we may, in some cases, have to attend a hearing in the UK-IPO at which to argue for the allowance of the application.



When the application is accepted it is advertised and others may oppose the application. An opposition may involve protracted legal work. If there are no oppositions or any opposition is successfully overcome, the trade mark is registered. There is a small charge for attending to the formalities at the registration stage. The total cost of obtaining registration may be £800 to £1,000 or more. The registration initially lasts for ten years and is renewable then and every subsequent ten years on payment of a renewal fee.

### Copyright and design right

Copyright exists automatically in, amongst other things, written works, including computer programs, and images. It may therefore be important where trade literature, images or computer software are copied. To take action successfully against an infringer, however, it is necessary to establish that the allegedly infringing item was actually copied from the original work rather than having been independently created. Furthermore it is important to appreciate that copyright will only protect the expression of, say, a computer program rather than an underlying concept.

Unregistered design right offers protection in the UK for certain designs. The period of protection is normally ten years from first marketing, although the proprietor may be obliged to grant licences in the last five years. Design right, like copyright, does not require any formal registration and is infringed if a third party makes a product copying either an article made to the new design or the original design document. It is necessary therefore to prove both ownership and copying of the design.

It is good practice to sign and date and to preserve all drawings and prototypes in case it turns out that the design or drawing is later copied.

A separate right, akin to copyright, also exists to protect the contents of databases in which effort has been expended in compiling them. This right potentially applies to all databases, not just those held on computer.

### Registered designs

Registered designs are intended to protect the appearance of the whole or part of an article, or abstract designs such as icons. Pictures (either drawings or photographs) of the design are actually registered and the registration is infringed if the design or one of sufficiently similar appearance is applied to any article.

The cost of preparing and filing a registered design application is just over £300 plus the cost of preparing the drawings or photographs and a charge for any additional work, such as advice. Design registration applications are normally granted within a few months; sometimes there are objections on the grounds of informality but these are not usually difficult to overcome. There is a further charge for reporting registration, forwarding the certificate and remaining as address for service. The registration remains in force for five years but may be renewed for up to a further twenty years on payment of renewal fees.

You should always aim to file design applications prior to disclosing the design, but if the design has already been disclosed it may still be possible to get valid protection in some countries, including the UK.

### Taking things further

If you wish to take your idea further, please write to us with full details of your proposal as set out above. We will then consider these and give you our preliminary advice. You will appreciate that we will not be able to tell you for certain whether you will be able to obtain a granted patent, as this depends on what is already in the entire public domain.



Since patent advice, and particularly preparing a patent application, requires a significant amount of our professional time, it is our normal practice to request from new clients an advance of our estimated fees on account. The estimated costs will be indicated when we give you our preliminary advice.

### Further advice

If you would like any further advice please contact us at Dehns using the details below.

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