FRKELLY
EUROPEAN PATENT AND TRADE MARK ATTORNEYS

Patent FAQs

What is a Patent?

A patent is a legal right given to the patentee by the State to exclude all others from making, using or selling the invention for a certain period of time, usually 20 years. In return, the inventor must disclose the invention so that it is free for all others to use when the patent expires.

A patent does not give the inventor any right to sell the invention. Your product may infringe earlier rights, in which case you may need permission from others to sell your product.

A patent is also not a guarantee of commercial success – it is a tool which allows the patent owner or patentee to prevent others from making, using or selling the same invention, but a great deal of effort is normally required to bring a successful product to market, whether or not a patent has been granted.

Why are Patents given?

The purpose of the temporary monopoly given by a patent is:

- To encourage research and invention.
- To enable the inventor to recoup the costs of invention, development, production and marketing of product.
- To encourage dissemination of technology and know how, by inducing the inventor to disclose details of the invention through publication of patents.
- To provide an incentive for investing in research.

For most industries, patents are the only practical means of securing enforceable long-term protection. A patent confers on the proprietor the exclusive right to manufacture, sell or use the technology covered by the patent. Thus, a patent may be infringed by manufacture, sale or use of a product or process.

Why do I need a Patent?

- **Commercial Potential**
  Patents are the only means of securing a monopoly for a technical invention. Patent notice on product acts as a deterrent to competitors and patented products may also command premium prices.

- **Get a Patent before your Competitors**
  It is essential to secure patent rights without delay otherwise, if you are pre-empted, you may not be able to use that which you have already created. It is not unusual for competing companies to arrive at similar inventions within months of each other, and in such cases, the first to file usually ends up with the patent rights, except in America where the first-to-invent may prevail.

- **Royalties**
  Patent may be licensed to third parties to provide an income stream without having to engage in manufacturing and marketing oneself. Even if your invention is on the market in some countries, foreign patents allow the invention to be licensed for sale in other countries.

- **Added Value**

Patents add value to companies seeking investor funds or stock exchange listings. Intellectual Property (IP), particularly trade marks and patents, is becoming more important to the bottom line of large and small companies and is often their most valuable financial asset.

Every business, particularly those which create new technologies or improve on existing technologies should, as a matter of urgency, have a review of work in progress with a patent attorney. This will help determine what steps need to be taken to protect and capitalise on potential future developments and earnings. Failure to do so can be irreparable.

What is Patentable?

For a valid patent, an invention must be-

1. novel
2. involve an inventive step
3. be capable of industrial application.

Novelty
An invention is new if it does not form part of the state of the art. The state of the art comprises everything made available to the public, anywhere in the world, by means of a written or oral description, by use, or in any other way, before the date of filing of the patent application.

Inventive Step
An invention is regarded as involving an inventive step if it is not obvious to a skilled person having regard to the state of the art.

Industrial Application
The invention must be capable of being used in some kind of industry, including agriculture.

What is not Patentable?

Certain matters are regarded as not being proper subjects for protection by patents and these include:

- discoveries
- scientific theories or mathematical methods
- aesthetic creations
- schemes, rules and methods for performing mental acts
- schemes, rules and methods for playing a game
- schemes, rules and methods for doing business
- programs for computers per se (but note many software-related inventions are patentable)
- presentations of information
- therapeutic or surgical methods for treating the human or animal body or in vivo diagnostic methods
- plant and animal varieties or essentially biological processes for their production
- inventions which are contrary to public order or morality.

Most of these exceptions are interpreted narrowly, and it is often possible to formulate a strong patent application which affords protection in these areas, or in related areas which are not disqualified, and the advice of a patent attorney should be sought.

What's the difference between a Patent and a Registered Design?

Patents relate to technical inventions (how things are made and how they work). Registered designs protect the appearance of products. A registered design provides an exclusive right to prevent third parties from using the design.

What's the difference between a Patent and Copyright?

Unlike patents and designs there is no provision for registration of copyright - it simply subsists. Copyright protects the expression of ideas, but not the ideas themselves. Copyright works can include

- artistic works (drawings, paintings, photographs etc.)
- literary works (including computer program code)
- musical works
- dramatic works
- films, sound recordings and broadcasts
- typographical arrangements of published editions.

The originality requirement is that the author has expended some skill and labour in the creation of the work. Copyright is not an exclusive right - it only protects against direct copying. A third party who independently expresses an idea without having copied an earlier work, in the same or similar way, is also entitled to copyright despite the earlier work.

Many real-world creations incorporate a multitude of copyright works. For example a website will typically have many graphical elements such as drawings and photos, each of which may be protected against unauthorised copying, and in addition, the text and underlying code of the website will equally be protected.

Copyright also has a number of related rights, the most important of which are moral rights – the right to have one's work attributed (so that a photographer or writer can insist on their name being acknowledged when the work is distributed, for instance), or the right to object to derogatory treatment of a work.

What's the difference between a Patent and a Trade Mark?

A trade mark is defined as any sign capable of being represented graphically which is capable of distinguishing the goods or services of one undertaking from those of others.

A trade mark may be-

- a word e.g. Coca-Cola
- logo e.g. McDonalds golden arches
- device e.g. MSN's butterfly
- musical jingle e.g. Intel inside
- a colour e.g. purple for Cadburys
- a smell e.g. smell of freshly cut grass for tennis balls

Registration of a trade mark is very important as it can be very difficult to enforce rights in one's brand otherwise. A good trade mark is potentially very valuable as unlike a patent, design, or copyright, it may be renewed perpetually.

The Golden Rule of Patents

No disclosure of an invention should occur prior to the filing date of a patent application. Any disclosure which does occur, if provable, could be used to invalidate any patent subsequently granted. Do not disclose your invention to anyone, except under a written confidentiality agreement. It is absolutely imperative that a patent application be filed before a company discloses a product in the marketplace or offers the product for sale.

How do I ensure Confidentiality?

Awareness of Innovation
Companies should establish procedures to ensure that all product development is referred to a senior official within the company. A useful way of doing so is to make an invention disclosure form available to employees and to ensure that any potential inventions within an offering are considered for patentability prior to release.

Innovation and Confidentiality
Controls must be in place to ensure that any innovation is maintained confidential until an application has been filed. Employees should be made aware not to disclose or misuse innovation. There should be a sense of awareness amongst employees, and innovation should be restricted on a need to know basis. Companies should take care in releasing details of innovation outside of the company. The company should keep detailed records of the development of new products or technology.

Who can apply for a Patent?

- The inventor or his/her successor in title.
- Where an employee makes an invention in the course of his/her duties, the right to the patent usually belongs to the employer.
- Where there are a number of individuals involved in devising an invention, the application may be filed in all of their names.
- Instead of applying in one's own name as inventor, the invention may be assigned to a company (or another person) and that new owner may apply for the patent.

How do I get a Patent?

An application for a patent must be made to the Patents Office accompanied by a patent specification.

A patent specification must contain-

- a description of the invention.
- one or more claims.
- any drawings which are referred to in the description to illustrate the invention.

Why do I need a Patent Attorney?

The drafting of a patent specification is a complex task and the contents of the specification determine whether a patent can be granted as well as the scope and validity of the granted patent.

Communications between an applicant and a patent agent are confidential and protected by privilege. Patent agents/attorneys undergo specialised training and must be entered on the register of patent agents and/or qualified to practice as European patent attorneys. Patent agents/attorneys provide a wide range of services in addition to the preparation of patent specifications, including prosecution, infringement opinions, defending oppositions, patent licensing etc

What is a Short-Term Patent?

In Ireland, a short-term patent differs from a regular patent in the following ways-

- It is granted quickly.
- It has a maximum life of 10 years as opposed to 20 years.
- The level of invention may be less than that required for a regular Patent.
- Novelty may be established after grant but it must be established before enforcement against a third party in court.

How do I get Patent Protection abroad?

Under a treaty known as the **Paris Convention**, which has been ratified by all countries in which an applicant is likely to be interested, an applicant can seek patent protection in another member country and claim priority back to the date on which the first application was filed, provided protection is sought within one year of the date of filing of the first application for a patent in a member country. This means that any disclosure made by an applicant after the filing of his/her patent application is potentially protected throughout the world on condition that within 12 months, a counterpart application is filed in the countries in which the applicant desires protection.

Is there a single International Patent available?

No. However, one can apply for a single patent throughout Europe under the European Patent Convention (EPC), and one can make a single filing to potentially cover about 140 countries using the Patent Cooperation Treaty (PCT).

What is the European Patent Convention?

This is a treaty ratified by all of the countries of the European Union (and some others like Switzerland and Turkey) which harmonises national patent laws and enables patents granted by the European Patent Office to be recognised in all member States.

A single application is filed at the European Patent Office. The application is subject to a novelty search and formal examination by the European Patent Office. On grant, the European application becomes a bundle of national patents which come into force in the States designated upon the completion of certain formalities. These patents are deemed to be national patents for all intents and purposes, but may have to be translated into the national language of the country in question to remain in force.

What is the Patent Cooperation Treaty?

This Treaty (often referred to as the PCT) effectively provides an applicant with a way of establishing a potential filing date in all 140 or so member countries and to keep open the option of pursuing applications in any of these countries until after having received a search report and an opinion on patentability.

Without the PCT, one would have to file in each country of interest after 12 months from the first filing date. Using the PCT the decision is deferred by a further 18 months, so its main advantage is that it buys the applicant time to make what can be a very expensive decision.

On filing an international application, the applicant designates all 140 countries. After receipt of a search report and opinion on patentability, the applicant may optionally request more detailed examination, but normally, simply can assess the implications of the search and wait until close to the deadline of 30 months (two and a half years from first filing) to file in the actual countries of interest.

Are Patent Royalties Tax Free?

Under existing tax law provisions, an Irish resident for tax purposes may receive patent royalties free of income tax. Where the patentee and the licensee are connected, the situation is more complicated. It is strongly recommended that a tax advisor's advice be taken in this area.

What are Renewal/Maintenance fees?

The majority of Patent Offices throughout the world charge annual maintenance fees on applications and renewal fees after the patent is granted, and must be paid to keep the patent in force throughout the life of the patent.

Please Note

While this guide has covered several topics, it is intended as a very basic introduction to Patents and is a simplified summary of complex legal provisions and procedures. As such, it is no substitute for consulting with a qualified patent attorney.

If you have any further questions, or if you have covered the information in this guide and wish to proceed with the filing of a patent application, please contact us.

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