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Intellectual Property: Top Tips for Entrepreneurs and Inventors

Leading UK, German and European Intellectual Property Specialists



Foreword

Obtaining patent protection for your invention could lead to significant commercial success and consequently profit on your innovative product or service. It gives you exclusive rights to sell it for up to 20 years in the countries in which you have obtained patent protection, preventing others from copying.

If your invention is new and novel; is not an obvious next step and is capable of industrial application, this guide is for you.

Our **Top Tips**

01. What can be patented?	4
02. Can I discuss my idea or invention with colleagues or potential investors?	4
03. How do I file a patent application in the UK?	5
04. What happens after I file a patent application in the UK?	6
05. How do I protect my invention in other countries?	7
06. My patent application has been granted – is that the end of the costs?	8
07. What can I do with my patent?	8
08. Aside from patents, is there other IP protection I should consider?	9
09. Professional regulation and scams	10
10. Choose the right IP advisory firm for your needs	11

01

What can be **patented**?

Almost all inventions can be patented, but to be eligible, your invention needs to be both new and inventive.

Searching on the internet for a description of your invention will help you to find out whether it is genuinely new, or whether someone else has already thought of it. Any search engine or Espacenet is useful for this.

Whether your invention is inventive or not is a complex question of law. A patent attorney can advise you on whether it is worth filing a patent application or not, taking into account these considerations.

There are certain things that cannot be patented. For example, inventions that relate to a method of doing business or playing a game. Also, methods of treatment and diagnosis are excluded, but the associated devices and diagnostic kits are patentable. Presentations of information and some computer programs may also be excluded. Seeking advice from a patent attorney is definitely worthwhile when considering patenting in these areas.

02

Can I discuss my **idea or invention** with colleagues or **potential investors**?

You should not tell anyone about your idea or invention except with a clear understanding that the disclosure is confidential.

Any public disclosure of your invention could prevent you from obtaining a granted patent in the future (e.g. giving a demonstration, advertising your invention, discussing your invention in public).

If you need to discuss your idea/invention before seeking professional advice, for example to raise investment funds, always mark your documents 'CONFIDENTIAL' and ask the other party to acknowledge that they are confidential. A non-disclosure or confidentiality agreement may be needed.

If you don't take the necessary precautions, there is a chance that the party with whom you had discussions may apply for a patent on your invention before you. You do not want to be in a position of having to argue ownership of your invention. Possession is nine-tenths of the law - so file your patent application first.

03

How do I file a **patent application** in the UK?

Seek professional advice.

You do not need to be represented by a patent agent in the UK in order to file a patent application at the UK Patent Office (UKIPO), but we strongly recommend you seek professional advice. UKIPO statistics indicate that only 1 in 20 applicants gets a patent without professional help. Moreover, once an application is filed, you

are locked in to the scope of the invention as originally set out - so it is very important to get it right first time. When seeking advice, make sure your representative is regulated by IPReg. There are many purported invention advisers out there who are unregulated.

A patent application comprises:

A description of your invention (how it works and can be made)

One or more claims (statements that detail the features of your invention – these are used to determine infringement if the patent application is granted)

An abstract (summary of your invention)

Any drawings of your invention. Fees for preparing a patent application vary depending on the complexity of the invention. A rough estimate for a basic mechanical invention is around £3,000 + VAT.

Additionally you will need to pay the UKIPO fees. These are relatively low cost. Currently the official fees for applying and requesting examination of a patent application are around £300. This is very good value by comparison with some other jurisdictions such as the USA and Europe.

04

What happens after I file a **patent application** in the UK?

The UK Patent Office (UKIPO) will search and examine your invention to see if they consider it new and inventive.

You can expect a search report from the UKIPO within a few months. This will give you a much clearer indication of your chances of success. After 18 months from the filing date, the UKIPO will publish your patent application.

In the course of this process, you will receive an examination report from the UKIPO. This will usually indicate if your invention is deemed novel and/or inventive over any documents found by the patent examiner. Don't be put off if at first glance it appears negative. You may need to amend the claims in order to distinguish your invention from any documents found by the UKIPO.

If you are successful, and the UKIPO believe your invention is new and inventive, the patent grant process can take up to 4½ years but is often quicker. For example, there is a fast track process for green or sustainable technology.

05

How do I **protect my invention** in other countries?

There is no 'worldwide' patent; generally speaking, each country has its own patent laws that must be satisfied.

After filing your first patent application, you have 12 months (the priority period) to file in other countries or jurisdictions of your choosing. Jurisdictions other than the UK tend to be much more expensive to file and prosecute patent applications in. It is imperative to appoint a professional representative in the jurisdiction you want to file who can help. Common jurisdictions include the USA, Europe and China.

Alternatively, it is possible to file an international patent application under the Patent Cooperation Treaty (PCT). This application covers a large number of countries including the USA and countries covered by the EPO. This is the closest thing to a 'worldwide patent application'. A PCT application allows you 18 months to decide

which jurisdictions you want to apply for, e.g. the USA, EPO and Japan. This is the time when costs increase significantly.

Many people view the PCT application as a way of deferring costs. It allows you to delay the decision on which national jurisdictions to enter, and to delay the associated costs. In the meantime, the value and merits of the invention become clearer and investors can be approached to fund the next stages.



Maucher Jenkins sets itself apart through its focus on UK and European cross-border work...the group is skilled in assisting start-ups, SMEs and major international players.

Legal 500, Trade Mark Attorneys

06

My patent application has been granted – is that the end of the costs?

No. Typically, each jurisdiction requires payment of an annual renewal fee to keep the patent in force in that jurisdiction

Generally, these fees increase each year. In some cases they have to be paid on a pending application too. Once your patent has been granted, you may find that you have to prosecute potential infringers of your invention. This is generally expensive (especially if you are asserting your rights in the USA for example). Many inventors ask “what is the point of filing a patent application if I cannot afford to enforce my rights?”

There are many stories, good and bad, of entrepreneurs battling through the courts; but for each such case, there are hundreds of patents that are quietly licensed for royalties or other business benefit. Patents are valuable assets that change hands for large sums, and there are intermediaries who can help. Do not forgo your patent rights for want of trying.

07

What can I do with my patent?

When your patent has been granted you can use it for any of the following:

- Assist with obtaining funding to take your invention to market (underpinning investor support)
- Use it to stop competitors from making or using your invention
- Sell someone a license to make or use your invention
- Mortgage it to release funds (rare in Europe, less so in the USA)
- Sell it to a potential investor
- Include it in Patent Box regime (reduced corporation tax for net profits attributed to patents)

08

Aside from patents, is there other IP protection I should consider?

There are other forms of IP protection, such as Trade Marks and Registered Designs which you could consider for your business or product.

Trade Marks

A trade mark serves to distinguish your particular product or service from those of other commercial actors. It means consumers can identify the origin of the goods or services they are purchasing and establishes good will and reputation which can be extremely valuable.

A trade mark can be one or more of a word, letters or numbers, a logo, a slogan, colours, a shape, an advertising jingle or any other sign that distinguishes your goods or services from those of others. The very use of a trade mark gives you rights in that mark but you should not rely on unregistered trade marks as it may be difficult to stop others copying your mark. Where possible you should always register your trade mark.

In order to obtain a registered trade mark, it is necessary to file a trade mark application for the mark covering a particular country (e.g. UK or USA) or region (e.g. the European Union). While there is no requirement to have official legal representation for registering a trade mark, it is strongly recommended that you do seek legal advice for this process.

Our trade mark attorneys and lawyers offer legal support and advice to brand owners to develop, protect and exploit their brands on every level.

Registered Designs

Design rights protect the appearance of a product or its packaging. This protection is distinct from patent protection, which protects the functioning of a product, and trade mark protection, which protects a company's brand selling a product.

It is not necessary to register design rights in order to enforce them if someone infringes your work. However, having a registered design gives you a significant advantage when enforcing your rights.

If someone infringes your unregistered design right, you would need to prove that you previously owned the design and that it has been copied. By registering a design, you are afforded full protection for up to 25 years. This presents an advantage when compared with just 10 years of protection for an unregistered design in the UK and 3 years in the European Union.

By engaging a design attorney, you will be sure that your registration does not risk infringing on an existing design. Our attorneys perform searches to check for similar designs and provide advice in case someone attempts to register a design that could infringe your design right. Our attorneys will also ensure that your design's specifications are thoroughly and correctly expressed in the registration.

Our attorneys are registered patent and trade mark attorneys as well as registered design attorneys. This means they can ensure your registered designs are fully integrated into your IP strategy to provide the best protection for your ideas.

09

Professional regulation and scams

The IP profession in the UK has been largely deregulated.

This means that effectively anyone can offer advice on IP related matters. However we suggest that you only seek advice from a Chartered or European patent or trade mark attorney regulated by IPReg to ensure you receive accurate and professional advice.

Recently there has been a surge in companies purporting to be related to the UKIPO and other patent offices, requesting funds for paying renewal fees. Many of these are scams. We advise that any correspondence related to this should be sent to your professional representative for validation prior to payment.



At Maucher Jenkins, queries are answered promptly, knowledgeably and insightfully, always with an eye on the commercial elements that clients value so highly.

Legal 500, Patent Attorneys

10

Choose the right **IP advisory firm** for your needs

The UK patent and trade mark profession includes everything from sole agents right up to large firms of patent and trade mark attorneys.

At Maucher Jenkins, we have offices in the UK, Germany, Switzerland and China, together with a network of associates in many other countries. We are recommended by leading legal directories, Chambers & Partners and

Legal 500. Our attorneys have experience of working with creative people and businesses from an early stage, to help them turn their innovative products into commercial success.



Leading UK, German and European Intellectual Property Specialists

London

7th Fl, Artillery House
11-19 Artillery Row
London,
SW1P 1RT
T: +44 (0)20 7931 7141
F: +44 (0)20 7222 4660
london@maucherjenkins.com

Farnham

Broadmede House
Weydon Lane Business Park
Farnham,
GU9 8QT
T: +44 (0)1252 711149
F: +44 (0)20 7222 4660
farnham@maucherjenkins.com

Offices also in Edinburgh
and Cambridge

Munich

Liebigstr. 39
D-80538 Munich,
Germany
T: +49 (0)89 340 77 26-0
F: +49 (0)89 340 77 26-11
muc@maucherjenkins.com

Freiburg

Urachstrasse 23
79102 Freiburg,
Germany
T: +49 (0)761 79 174-0
F: +49 (0)761 79 174-30
freiburg@maucherjenkins.com

Basel

Aeschengraben 29
CH-4051 Basel
Switzerland
+41 (0)61 225 44 90
+41 (0)61 225 44 89
basel@maucherjenkins.com

Beijing

A-909, Huibin Building
No. 8 Beichendong Street,
Chaoyang District
Beijing 100101,
China
T: +86 (0)10 8498 9052
F: +44 (0)20 7222 4660
china@maucherjenkins.com

Shenzhen

7F-B09, Building B
Aerospace Science & Technology Square
No. 1288 Haide 3rd Avenue
Nanshan District,
Shenzhen 518053,
China
T: +86 (0) 755 2184 6822
F: +44 (0)20 7222 4660
china@maucherjenkins.com