**First Steps to Getting a Patent**



## Requirements for Patentability

There are many criteria for an invention to be patentable, but the most important of these are:

1. Novelty – an invention is new or novel if it does not form part of the "state of the art". The state of the art includes everything that has been 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

2. Inventiveness – this means that an invention must not be obvious having regard to the state of the art.

## The Golden Rule

**Do not disclose your invention or make it available to the public in any way prior to filing a patent application**

If you make your invention available to the public, whether by selling, advertising, displaying it at a trade show, or discussing it in a non-confidential manner with a third party, you might invalidate any future patent application for that invention.

Patent attorneys are bound by a code of conduct that ensures all client contact is confidential and subject to legal privilege. Therefore, if you do have an invention for which you are considering securing a patent, a patent attorney should be the first person to contact.

We can draft a Non-Disclosure Agreements (NDA) enabling you to discuss your invention with third parties, e.g. companies that may be interested in purchasing or manufacturing your invention. It is almost always better, however, to have an actual patent application on file before you have such discussions as this provides the strongest protection.

## Searching

We strongly advise all potential applicants to search available information to determine if their invention is novel.

A good place to start searching is with a general search engine, for example www.google.com or www.yahoo.com. Results produced using search engines can be of mixed quality, and sometimes are

not greatly helpful, but are generally the easiest way of performing a search. If an invention is well known or is already on the market, it will often turn up here.

From a patent attorney's point of view, a far more important and relevant search can be performed using patent databases. The free-to-access database of the European Patent Office (EPO) – Esp@cenet – contains over 60 million published patent documents from 85 countries, i.e. an enormous amount of information, much of which is not easily available elsewhere.

When searching patent databases, searching for keywords in the "Title and Abstract" field will return each document that contains those words on its front page. However, bear in mind that patent titles and abstracts can be written in vague terms, so try to use general language, or various synonyms in your search. Even then, you may never guess all of the words which might have been used in someone else's patent. For example, what you think of as a "mobile phone" may be called a "personal communications device" or a "cellphone" or a "wireless GSM device". A salt cellar may be described as "an apparatus for dispensing a particulate material").

Possibly the most efficient method of searching patent documents is through their classifications. An International Classification system provides a set of codes which patent examiners use to categorise the technology in every patent application. A patent application relating to methods of manufacturing transformers would carry the code H01F41/00, while one describing golf balls with different types of cores is in class A63B37/00. Fortunately we do not need to memorise these codes.

There are two main ways to use classifications while searching:

- Classification Search – The most direct way to utilise classifications is through the Classification Search in Esp@cenet. You can either browse through the different classifications, or you can search by keyword for the classification. This provides a list of the classes most relevant to the query, which may be expanded for greater detail. Suitable classes can be selected through the adjacent tick-box, to copy the class numbers into the search box below. This can in turn be carried into the "Advanced Search" (by clicking the "Copy" button). You can then proceed to search among the documents contained only in those classes, resulting in a more efficient search.

- Relevant Documents – While with searching keywords or classes in Esp@cenet, a document may stand out as being particularly relevant. In this case, it can be useful to note the classifications listed for that document, before entering them into the classification field in the "Advanced Search". This allows you to search for keywords contained in, or simply browse through, other documents that have been classified in the same area as the particularly relevant document.

The utilisation of classifications while searching for prior art is more efficient, and generally provides the most relevant results. Both Patent Attorneys and Examiners make great use of the classification facility when searching.

Other patent databases to consider when performing a search include the commercial site Delphion or Google Patents.

A word of caution: it is impossible to exhaustively search all prior art material to be certain that an invention is novel. The state of the art includes everything that has been made publicly available, from a trade journal published the day before the patent application is filed, to a 10-year-old sales catalogue from South Africa. However, the more time spent searching patent literature in an efficient manner, the clearer the picture of the available prior art will be.

**I've Searched. Now What?**

If after a search your invention appears to be new, then contact us to discuss your invention. There are a number of things a client can provide to enable us to more easily understand the invention and dispense more accurate advice

- A detailed description of the invention, and how it works. If the invention involves a process or a particular mode of use, a step-by-step guide is always essential.

- Any drawings, blueprints, CAD files, or photographs of the invention.

- If the invention solves a particular problem, it is useful for us to know how the problem might have been addressed previously.

- In order to get an understanding of the field of the invention, it is helpful for us to see the results of your search, i.e.. the most relevant documents you found.

You can send this information to us via email, and we will review the material, and arrange a meeting or a phone call with you in order to progress further.

**The Patent Specification**

In general, patent specifications follow a common layout

- The front page lists the relevant "bibliographic data" e.g.

    - Application
    - Publication
    - Patent numbers
    - Filing and priority dates
    - Inventors and Applicants
    - Classification codes
    - An abstract
    - Sometimes a list of relevant documents cited by a Patent Examiner during prosecution of the application.

- A description, which often makes detailed reference to accompanying drawings or figures, generally makes up the largest part of any patent document, as it explains how specific examples of the invention are implemented, in understandable terms.

- A set of "claims" located at the end of the specification. The claims, which are prepared by the patent attorney, define the legal protection that the patent provides.

While the description section is normally easy to read as long as you are well versed in the technology in question, the patent claims are written in "legalese" and can often be incomprehensible to the layperson. Patent Attorneys specialise in drafting the most suitable and broadest claims for an invention – the broader the claims, the greater the protection conferred by the patent, and consequently the greater the value of the patent.

**Patent Procedure**

**Preparing**

Once a client has consulted with a Patent Attorney and decided to proceed with a patent, the Patent Attorney prepares a draft patent specification based on the information available. This is sent to the client for approval. It is very important that the client reviews the draft specification in detail, as additional material can only be included later in the patent application in certain very limited circumstances, and at additional cost. As soon as the client approves the draft specification, possibly with the inclusion of any additional comments, the patent application is ready to be filed.

**Filing**

In general, most applicants choose to first file in their own country. Then, under the Paris Convention, within one year, an applicant can file in any another member country and "claim priority" or date all such foreign applications back to the first filing date. For this reason the first filing date is often called the "priority date" and the initial 12 month period the "priority year".

Simply put, by first filing in Ireland or the UK, an applicant has up to 12 months to apply for a patent in another country. In practical terms, this gives an applicant 7-8 months after filing for researching the potential market for the invention, e.g. approaching potential clients, advertising and selling the product, openly making preparations to manufacture the invention etc. It is important to note that no substantive examination of the application is performed by the Patent Office during the 12 month period.

At the 12 month stage, there are several different routes for obtaining patent protection in different countries, from individual national filings, to regional filings, such as a European Patent Application, or an International Application (PCT Application), and we provide advice on the options available and costs involved at that time.

However, it is at this 12 month stage that patent costs begin to become more substantial and so it is critical that as much development and commercialisation of the invention as possible is carried out in the 7 or 8 months after filing so that you can make the best informed decision in relation to the invention.

**Prosecution**

Generally, patent applications filed during the priority year are substantively examined by a Patent Examiner over the course of the next few years. The Examiner is a trained specialist in the particular area of technology of the invention, and will perform a search of all information (particularly patent documents) relevant to the invention. Because the claims define the invention, the Examiner will focus on documents that are relevant to the wording of the claims. If the Examiner is satisfied that no cited documents directly anticipate the invention as defined in the claims, or render the invention obvious, the application will be allowed and can proceed to grant as a patent.

If (as is more usually the case) the Examiner wishes to object, the Applicant is provided with an Examination Report, setting out the objections, although possibly indicating certain claims or combinations of claims, that could be allowable. The Applicant is entitled to reply, whether by presenting arguments in favour of the current claims, or by amending the claims to limit the scope of the patent.

The exchange of arguments may sometimes go back and forth several times before both parties can arrive at a version of the application acceptable to both the Applicant and the Examiner. Again, if agreement is reached, a patent is granted. Otherwise, the application will be rejected by the Examiner. The cost to grant will depend on how easy or difficult the examination process is, and will vary from country to country.

**Please Note**

While this guide has covered several topics, it is intended as a very basic introduction to Patents, and certain procedures surrounding them, and 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.