

Intellectual Property Fact Sheet

Patents

This fact sheet addresses some of the issues relating to patents that are frequently encountered by our clients. We cover the following issues:

What is a patent?

How long does patent protection last?

Patents and trade secrets – what are the differences?

I have a patent - can I stop other people from using or exploiting my invention?

I have been accused of infringing someone else's patent – what should I do?

Special issues relating to employees and consultants

Can I grant a license to use my patent, or assign it to someone else?

What is a patent?

Patents protect industrially applicable processes and devices by preventing third parties from making, using, importing, keeping and selling the patent owner's invention. Patents cover products and compounds, the processes for manufacturing those things and also mixtures and methods of doing things. A patent may only be granted for an invention that satisfies the following criteria:

- It is **new**. This means that the invention must not have been made available to the public anywhere in the world before the date when the patent was first filed (the "priority date"). Inventors who fall into the trap of exhibiting prototypes at trade fairs, sending press releases or publishing papers before the priority date can invalidate any subsequently filed patent. Anyone thinking that they might have a patentable invention should be sure to only discuss it with third parties under confidential terms.
- It involves an **inventive step**. This means that the invention is not obvious to a hypothetical person who is "skilled in the art", that is they are skilled in the particular field of the invention. This prevents patenting of small non-inventive variations of known inventions.
- It is capable of **industrial application**. It must be capable of being made or used in any kind of industry. This prevents, for example, patenting of a new chemical without identifying a use for it.
- It does not fall into any of the specifically **excluded categories**. These include scientific theories and mathematical models, aesthetic creations, ways of performing mental acts, playing games or doing business, computer programs and surgical, therapeutic and diagnostic techniques.

Patents do not arise automatically, an application must be filed at the relevant Patent Office. Patents are national rights and only offer protection in the country in which the patent is granted.

How long does patent protection last?

Patents last for 20 years from the date they are filed. It can take a number of years for the patent to be granted and, after grant, renewal fees need to be paid to maintain the registration. Some medicinal and plant protection products are entitled to an additional term of protection, for up to 5 years.

Patents and trade secrets – what are the differences?

An inventor has a choice between patenting an invention or keeping it as a trade secret. The advantage of patenting is that, if the patent is granted and not invalidated, the patent owner has a monopoly over that invention for 20 years. Furthermore, it is no defence for an infringer to show that they developed their infringing product without reference to the patent. The disadvantage of patenting is that after 20 years the monopoly is lost and the invention can be copied.

With a trade secret, there is no limit on how long the monopoly lasts, so long as the owner is able to maintain confidentiality. A trade secret will not however prevent use by someone who can show that they independently developed the same invention, or where they reverse engineered a product available on the open market.

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I have a patent - can I stop other people from using or exploiting my invention?

Yes - the owner or exclusive licensee of a patent can bring infringement proceedings against anyone who, without authorisation, operates within the scope of the patent claims. It is not a defence for that person to show that they developed their own invention wholly independently and without reference to the patent (so long as that use does not pre-date the patent priority date).

Whilst on the face of it, sending a letter to someone who you think is infringing your intellectual property rights seems like a good idea, care needs to be taken not to fall foul of the UK Threats legislation. [Click here](#) to read a more detailed briefing note on this issue.

Suitable disputes can be advanced through the Intellectual Property and Enterprise Court (IPEC), which contains measures for cost capping and a shortened timeframe. This Court is often an attractive route for clients, particularly SMEs, as it allows them to assess their costs exposure at the outset of a dispute. For a more detailed note on this court, [click here](#).

I have been accused of infringing someone else's patent – what should I do?

If you have received a letter, take note of any deadlines. Failure to respond within that deadline might lead to legal action being taken against you or, in a worst case scenario, a judgment being entered against you.

Your lawyer will need to understand the allegedly infringing activities that you were undertaking, as well as any rights that you have to use the invention. They will also want to look at the possibility that the patent that is being enforced against you is not valid, as invalidity would form a defence against an infringement action.

Special issues relating to employees and consultants

If an employee in the UK makes an invention as part of their normal employment, that invention is usually owned by the employer, although the employee may be named as inventor. Conversely, if an employee develops a patentable invention outside the course of their usual employment duties, a patent claiming that invention belongs to the employee.

The position with consultants is rather different. If there are no express contractual provisions providing that rights in the invention vest with the employer, they will belong to the contractor unless the employer can prove to the Court that there should be an implied term in the contract giving them ownership. It is therefore extremely important to deal with this point, in a written contract, before the work is commenced.

Can I grant a license to use my patent, or assign it to someone else?

Patents confer an exclusive right to use the claimed invention. However, you can grant or authorise others to use the invention on either an exclusive or a non-exclusive basis. Such licenses should be worded carefully, and we recommend obtaining legal advice before entering into any license agreement. Patent owners can also assign their rights, if suitable terms are agreed. Any assignment should be in writing and again, we recommend obtaining legal advice prior to any assignment.

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If you have any questions relating to patent law please contact one of our intellectual property law specialists. This fact sheet does not constitute legal advice and the information contained in it is correct as at June 2018. In reading this fact sheet you accept that no reliance may be placed upon it and accept that Debenhams Ottaway LLP excludes any liability arising from reliance upon it.

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