



Dehns

Dehns Guide to
Intellectual Property

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A guide through the maze

Welcome to your Guide to Intellectual Property. In this guide you will find information on patents, trade marks, designs, copyright and enforcement of your legal rights.

Although the subject matter can sometimes be complex and involved, our aim has been to write this guide in plain English for ease of understanding. We have included a Glossary for some important words and phrases.

Intellectual Property is a broad term describing the fruits of mental creativity. Some of these can be protected by one or more Intellectual Property Rights, (IPRs) which include patents, trade marks, designs and copyright. The form of protection available depends upon the type of right involved and this is summarised in the relevant section of this guide.

Some of these rights arise automatically whereas others can only be granted by official bodies. Even where rights arise automatically it is important to be aware of what protection you get and when it might be useful.

IPRs can be one of a business's most valuable assets, although this is often not fully appreciated until too late. It is hoped that by reading this guide you will have a better appreciation of how these assets can be protected and made to work for you.

The information in this guide is necessarily of a general nature and is given by way of guidance only. The information in this guide relates mainly to the position in the UK and Europe. Although the position is similar in most countries, the details may vary. Specific legal advice should be sought on any particular matter. Neither the producers nor distributors of this guide can accept any responsibility whatsoever for any action taken or not taken on the basis of the information contained herein.

Dehns is one of the leading firms of Patent & Trade Mark Attorneys in the UK. Our services include obtaining patent, trade mark and design protection around the world. Clients include small businesses and private inventors as well as multinational firms.

Our specialist practice groups serve clients in the full range of technical fields, including chemistry and biotechnology, engineering and electronics. We also act for clients in relation to trade marks and designs. We are dedicated to providing high quality, creative solutions to our clients' intellectual property needs.

The firm's combination of experience, commercial awareness and continuing development of technical expertise in many fields enables it to offer clients an exceptional service in the fields of patents, trade marks and designs.

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Patents

A microscopic image of cells, showing various sized cells with prominent nuclei and cell membranes. The image is in grayscale and occupies the background of the slide. A large, light blue curved shape is on the right side of the slide.

Patents

- Keep secret until filed
- New and non-obvious
- Monopoly right
- Last up to 20 years

What is a patent?

A patent for an invention is granted by the government to the applicant, giving the applicant the right for a limited period to stop others from making, using or selling the invention without the permission of the applicant. Patents are territorial rights; a UK patent will only give the holder rights within the United Kingdom and rights to stop others from importing the patented products into the United Kingdom.

For what are patents granted?

Patents are granted for inventions and are generally intended to cover products or processes that possess or contain new functional or technical aspects. The vast majority of patents are granted for incremental improvements in known technology.

How do I know if my invention is patentable?

To be patentable your invention must be new and involve an inventive step. Thus, the invention must never have been made public in any way, anywhere in the world, before the date on which an application for a patent is filed. So, if you are thinking of applying for a patent you should not publicly disclose your invention before you file an application, because this could be counted as prior publication of your invention.

An inventive step is present if, when compared with what is already known, your invention would not be obvious to someone with a good knowledge and experience of the field in question. It can be difficult to assess whether an invention possesses the necessary inventive step, but a Patent Attorney can advise you on this issue.

What rights does a patent give?

A patent lasts up to 20 years from its filing date and gives the right to take legal action against others who might be infringing the patent to claim damages and to stop them using it in the future. It is not possible, however, to guarantee that a granted patent is valid. Anyone can apply for revocation of a patent on a variety of grounds.

Also, patents are negative rights; that is, the right extends to stopping anyone else from making, using or selling an invention. It does not automatically confer on the patent owner the right to carry out his invention. Therefore anyone who is thinking of manufacturing a product or putting a process into operation should first check whether they could be stopped from so doing by an existing patent that is still legally enforceable.

How do I file a patent application?

The basis of a UK patent application is a legal document called a specification. Its contents determine whether a patent can be granted. You would be well advised to employ the services of a qualified Patent Attorney, who will have the necessary technical and legal skills to prepare the specification.

The specification will contain a full description of the invention. It is absolutely vital that you put all the necessary information about the invention in the description. The application would also normally comprise claims. These set out exactly what is to be covered by the patent and must be carefully drafted to maximise protection for an invention. Finally, the application may contain drawings to illustrate the invention. Once the application text has been prepared, this is filed at the Intellectual Property Office (IPO).

What happens next?

The IPO then conducts a search of the claims of the application to determine whether the invention is new. An examiner considers whether the subject matter is inventive and whether it is patentable (i.e. not excluded). There are often negotiations between the IPO and the Applicant (or more usually his Patent Attorney) at this stage. The claims may need to be narrowed to ensure that they do not cover something already known. However, assuming that a novel and inventive claim set can be found, a patent will be issued. It will last for 20 years from the date on which it was filed, if all annual fees are paid.

Enforcing a patent

Should a patent owner want to enforce his patent against another party, an application can be made to the court for an injunction against the party and damages sought for any losses sustained. Patent litigation can be very costly and many cases settle before substantive court proceedings occur. It would be normal for a party who is being sued to counter-claim that the patent is not valid and not infringed. This can make litigation a complex and potentially lengthy procedure. Trials take many months to come to court and, with the likelihood of an Appeal, complicated cases can drag on for years. However for simpler cases enforcement is a realistic option – see the Enforcement section later in this guide.

Getting patents abroad

Under a system called the Paris Convention, if you want to apply for patents outside the UK this can be put off for up to 12 months after your UK application is first filed. This gives a breathing space for testing the commercial potential of the invention and/or developing it further. A patent application can be filed in virtually any chosen country. Although the countries can be chosen straightaway, many applicants opt to file an application under the Patent Cooperation Treaty (PCT). The PCT allows the choice and expense of selecting countries to be postponed. For countries in Europe a single patent can be obtained which is then brought into force in the European countries where it is wanted.

Overseas protection can be very costly, so it is important to choose countries wisely. A good guide is to decide where the main markets are likely to be. It may also be worth identifying main centres of production. The choice is important, however, as countries cannot be added to the list later.

"A patent application can be filed in virtually any chosen country. Although the countries can be chosen straightaway, many applicants opt to file an application under the Patent Cooperation Treaty."

Trade Marks

A large, white wind turbine stands on a dark, grassy hill. The background features a range of mountains under a sky with soft, orange and pink hues from a setting or rising sun. The entire scene is framed by a large, curved, semi-transparent pink shape on the right side of the image.

Registered Trade Marks

- Protect against unauthorised trade use
- Monopoly right
- Renewable indefinitely
- EU protection available

What is a trade mark?

A trade mark is a sign that distinguishes the goods or services of one trader from those of another. It is an essential element in creating and developing a brand. Usually trade marks are words, numerals, graphic designs, or a combination of any of these. However, any sign capable of graphical representation can function as a trade mark. Thus, the shape of goods, their packaging, colours and musical sounds can also be trade marks.

Can I register my trade mark?

Whatever its nature, to register a trade mark it must be distinctive rather than descriptive. For example, it is usually difficult to register complimentary words, significant geographical names or single colours, unless it can be demonstrated that they have become distinctive for the goods/services through use. Your Trade Mark Attorney can advise you whether any particular mark is likely to be sufficiently distinctive for registration.

Why should I register my trade mark?

To some extent, unregistered trade marks may be protected by other laws. However, businesses should register their trade marks wherever possible, since registered rights are easier to enforce. In general, a trade mark registration is infringed when someone makes unauthorised trade use of the mark (or a similar one). The infringing use is usually in relation to goods or services which are identical or similar to those for which the mark is registered, although this need not be so if the registered mark has an established reputation. A valid registration is a monopoly right, so reproduction of the mark is unlawful even when it does not result from copying.

How should I protect my trade mark?

To seek registration of a trade mark in the UK, an application is filed at the IPO. The mark is examined to assess whether it meets the necessary legal requirements, in particular whether it is sufficiently distinctive. A search for possible conflicts with any earlier trade mark registrations or applications in the UK is also carried out. If the application passes the examination (or the applicant is able to overcome any objections raised), the mark is advertised. Objectors have two months to come forward, and in the absence of any objections, the mark is registered.

It is conventional to identify trade marks by using the TM symbol, indicating simply that the user believes he has (or may have) exclusive rights. If a trade mark is registered, use of the ® symbol is recommended. These symbols alert others to the owner's legal rights.

A UK trade mark registration only covers activities on UK territory. Similar systems apply in other countries, although the details can vary widely. There are several cost-effective international systems whereby trade marks can be protected in a number of countries at once, notably the European Community Trade Mark (CTM) and Madrid Protocol systems.

How long do trade mark registrations last?

Unlike other intellectual property rights, trade mark registrations can be kept in force indefinitely, subject to the payment of renewal fees. In the UK and most other countries, registrations last for 10 years initially, and are renewable every 10 years thereafter. If a mark is not used for a certain length of time (usually five years), it is at risk of removal from the register. Trade mark owners should therefore keep careful records of the use of their trade marks, so that genuine use thereof can be demonstrated if required.

Designs

Registered Designs

- Protect visual appearance
- Lasts up to 25 years
- EU protection available

Unregistered Design Right

- Protects visual appearance
- Lasts up to 10 years
- Anti-copying right
- EU protection available

Designs can protect the fruits of cutting-edge product design, but are also very useful for more everyday things. Both registered and unregistered rights exist. For innovations with an important visual element they can be a very cost-effective way of enjoying protection.

Registered Designs

These can be used to protect a wide variety of products and also more abstract images such as computer icons. A design may be registered for part of a product even if the product itself is not new.

Registered Designs primarily protect the visual appearance of a product. They cannot be used to stop another company from using the idea behind a product, if the resulting appearance is different. A Registered Design can last up to 25 years if the renewal fees are paid. The owner of a Registered Design can prevent the same design being used by others, even if the design was arrived at independently. In other words, registration gives a monopoly right.

Although each country has its own national registration system, it is also possible to get a single registration covering the whole of the EU.

Unregistered Design Right

As the name suggests, this right arises automatically and so does not have to be registered. However it is more limited than the registered form.

Firstly, it protects only shape, not decoration – the shape of a teacup could be protected, but not the pattern on it.

Secondly, it only lasts up to 10 years and in the last five years the owner can be compelled to grant licences at a reasonable royalty rate to anyone who applies for one.

Thirdly, Unregistered Design Right can only be used to prevent actual copying and so does not cover anything produced independently.

A similar right is available across the EU, but lasts only three years.

Copyright



Copyright

- Automatically in place
- Expression, not idea
- Protects against copying

What is copyright?

Copyright is a familiar word, but its function is not always precisely understood. It is essentially the right to prevent others from copying an original work you have produced.

What can it protect?

There are many types of works that are protected, such as documents, pictures, photographs, music, sounds and computer software. The requirement to be original simply means that it is generated afresh rather than copied from elsewhere. Copyright does not protect mere ideas; only particular expressions of ideas are protected. For example, if you write a business plan you can stop others taking and reusing the text and figures – these are the expression of the plan. However you can't prevent other companies operating according to a similar plan – that is the idea behind the plan. Technical ideas can sometimes be protected by a patent.

How do I get copyright?

Once an original work is created, copyright comes into force automatically. It is always advisable to include a © symbol along with the name of the author and year it was created. This acts as a warning to others and is recognised as a form of record. However, if copyright is infringed, it is the owner's responsibility to take action.

Infringement

Copyright is only infringed if the work is actually copied. If what appears to be a copy was actually produced independently, there is no infringement. Courts will however take into account the degree of similarity and access to the original in deciding whether actual copying is likely to have taken place.

Enforcement

In the vast majority of cases the existence of intellectual property is a powerful deterrent to others who might otherwise have copied an invention, brand, design, etc. However, inevitably cases arise where a company finds that its rights are being infringed – either deliberately or inadvertently.

My rights are being infringed – what can I do?

Ultimately, intellectual property rights can be enforced through the courts. However this should be considered a last resort as it can be costly and time-consuming. It is usually far better to reach an amicable resolution.

You should seek the advice of a qualified Patent

Attorney or Trade Mark Attorney at an early stage – before approaching the alleged infringer. He or she will be able to advise you not only on how strong a case you might have but also on how best to make an approach. This is important as there are some legal sanctions against making threats in the wrong way.

I could never afford to go to court

As mentioned previously, the majority of disputes do not end up in court, as it is usually in the interests of both parties to reach a settlement. However, there have been several changes in recent years aimed at improving access to justice for IPR holders. For instance there are streamlined procedures that can be used in simple cases which tend to make litigation much cheaper and quicker. Also some cases can be handled by Patent and Trade Mark Attorneys directly (i.e. without the need to involve specialist solicitors), which minimises cost.

Help, I've received a warning letter!

This is not necessarily reason to panic, but it should be taken seriously. Getting a Patent or Trade Mark Attorney involved as soon as possible will allow you to understand the likely implications; and he or she will be able to advise you as to how best to respond and what happens next.

Can I get insurance?

Insurance to cover some or all of the cost of IP litigation is available but tends to be very expensive. For example, in some cases the premium could be up to 30-40% of the amount insured. It is less costly to take out cover before any particular issue comes to light, although this is not essential.

Glossary of terms

Copyright

An intellectual property right allowing the holder to prevent copying of a work

CTM

Community Trade Mark - a trade mark registration covering the whole of the EU

Design

The visual appearance of an object, logo or icon

Design right

Sometimes called unregistered design right; an automatically arising right to prevent the copying of certain features of items

Distinctive

A characteristic of a trade mark needed to obtain registration - distinctiveness may be inherent, or it may arise as the result of prolonged use

Intellectual property

A generic term for a number of different rights, including patents, trade marks, designs and copyright

IP/IPR

Common abbreviation for intellectual property or intellectual property right

Monopoly right

A right which allows the owner to stop infringements regardless of whether the infringer copied deliberately

Original work

A document, drawing, photo, piece of music, etc. which is not itself copied from elsewhere and which can be protected by copyright

Patent

An intellectual property right giving a monopoly in a technical invention for up to 20 years

PCT

Patent Cooperation Treaty - an international system which allows centralised initial processing of a patent application before it is divided into separate countries

Registered design

An intellectual property right giving a monopoly in a design for up to 25 years

Specification

In patents this is a document describing the invention and the protection given by the patent; in trade marks it is a list of the goods/services for which a trade mark is registered

Trade mark

An intellectual property right giving the holder a monopoly in a sign that serves to distinguish his goods or services from those of other traders

Work

From copyright – a document, drawing, photo, piece of music, software, etc

Useful contacts

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Please contact us with any queries you may have either arising from this guide or more generally.

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UK Intellectual Property Office

For Patents, Trade Marks and Designs
www.ipo.gov.uk

Espacenet

Free patent database; keyword searching of abstracts
worldwide.espacenet.com

US Patent Office

Free database and full-text searching of US patents
www.uspto.gov/patft/index.html

World Intellectual Property Organisation

Information on International IP Treaties
www.wipo.int

European Patent Office

www.epo.org

Small Business Service

Government agency offering advice and assistance to small businesses
www.sbs.gov.uk

Chartered Institute of Patent Attorneys

The professional body for UK Patent Attorneys
www.cipa.org.uk

Chartered Institute of Trade Mark Attorneys

The professional body for UK Trade Mark Attorneys
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