

## **So you want to patent your invention**

The process of seeking to patent, and potentially exploit, an invention, can be a complex one. This article explains, in layman's terms, the considerations and steps involved.

### **Three requirements**

Many inventions are improvements on existing items and/or the combining of multiple known elements in an inventive way. Simplicity is not a barrier to invention. There are a few essential requirements when seeking a patent:

- (1) what you have devised must be new as far as you know, anywhere in the world and, in particular, must not have been exposed to the public; and
- (2) it must demonstrate an "inventive step", or in other words "something that is non-obvious to those skilled in the art."

### **Patent pending**

When a patent application has been drafted for your invention and filed with the Patents Office, you may attach "Patent Pending" to the invention. This may dissuade others from copying your invention, for fear of infringing your patent. You can then launch your product under a brand name that you have registered as a trade mark. Potential rivals will not know the details of your invention, since, for at least 18 months the patent application can be held in secret in the Patents Office. (See the specifics on [www.patentsoffice.ie](http://www.patentsoffice.ie)) This allows sufficient time for you to establish your product on the marketplace and have the public become familiar with your trade mark. The trade mark can endure forever!

### **10/20 years**

The life of a patent is usually 20 years. In Ireland there is also a short term 10 year version, for which the level of ingenuity required of the invention is lower than what is required for a 20 year patent. Patents are territorial which means the exclusivity is restricted to the country in which the patent has been granted. Therefore, if a patent is granted in, say, 10 countries, those markets are ring-fenced for the lifetime of the patent and a third party cannot legally manufacture, or sell, an infringing product in those countries.

### **Subject matter search**

Before seeking to patent your invention it is possible to institute what's known as a subject matter search. This is to try and determine if anything similar to your invention is out there already. You can figure out if you have been pre-empted by someone else. A simple and inexpensive way of starting the process is to search on [www.google.com](http://www.google.com). If you get a direct hit then perhaps that might stop you in your tracks. However, you may find nothing that conflicts with your invention and be inspired to continue with your quest.

### **Patent search**

It is then advisable to search some of the patent office sites such as [www.uspto.gov](http://www.uspto.gov) and [www.espacnet.com](http://www.espacnet.com) which relate to patents in the USA and Europe. You may discover

that the way is clear or that some patents *might* be along the same lines as yours but you are not sure. In such an instance you would need to study the relevant patent(s) specifications and try to assess if you would be infringing an existing patent or if yours is sufficiently novel to deserve a patent in its own right.

This can be a problematic exercise. Patents contain “patenteze” terminology which is difficult to understand. Some of the patents may be in a foreign language that needs to be translated. Having done all of the above spade work yourself you are at a stage where it is prudent to enlist the services of an experienced patent attorney.

### **Filing for a patent**

In the first instance, do not disclose your invention to anyone, except in confidence. Discuss the details only with an experienced European Patent Attorney who will be able to assist you in assessing whether the concept could be suitable for patent protection. If this proves to be the case, then a detailed specification can be drawn up (along with appropriate drawings of the invention) and made ready to be filed in the Patent Office. A ballpark figure for this part of the exercise might be €2,000. The actual cost is determined by the complexity of the invention. However, the patent attorney will advise on this during or following the initial consultation, based on an estimate of all that will be involved in drafting the patent specification.

### **Prototype**

There is no need to have a prototype or working model of your invention. If you can demonstrate in words, doodles or drawings, how the invention will work, to the satisfaction of the patent attorney, then he/she can go about drafting all that is needed for submission. The attorney schedules the drafting process which may take 3 or 4 weeks. When this has been completed it will be shown to you for final approval.

### **Priority date**

When the patent application is filed at the Patents Office you will be given an application number and a filing date for the application. This first filing date is also known as a Priority Date. You then have 12 months to file a more complete application for the invention. During this time, you can amend some details of the invention, decide in which countries to file and arrange the necessary finance. In the meantime you are free to disclose the invention virtually world-wide with impunity.

### **12 months deadline**

If the commercial reaction is positive and you decide to proceed, you will select all the countries where you feel the invention will enjoy success. Then, before the initial 12 months have elapsed, you will file in those countries (that’s when the big expense is incurred) claiming the benefit of the Priority Date. So, it’s as though you did all that on day one even though you have had almost a year to “suck it and see!”

This second stage embraces a number of serious considerations. Firstly, and of vital importance, ***do not miss this 12 month deadline***. If you do, you may lose forever the

right to patent your invention! Secondly, make a final decision as to in which countries you wish to file.

### **PCT**

There is an alternative to the above whereby you can postpone finally nominating the countries in which you wish to file. You can opt for a PCT (Patent Cooperation Treaty) filing. This covers some 130 countries and postpones the need to actually nominate each country at the 12 month juncture. In the long-term, it is a more costly procedure. However, it does buy you time (at a price) before you are called on to nominate each country and pay the appropriate fee. This latter nomination period can be over a 30-month period.

### **Alternative approach**

On the other hand if you consider approaching a third party with your invention, before filing and getting that all-important Priority Date, you could ask that they sign a Confidentiality/Non-Disclosure Agreement. Some may agree to this but a more likely response, from major players, is to decline to do this for a number of logical reasons.

### **Conflicting situations**

Here is their rational. They would be signing up to something blindly. It may be tying their hands and inhibiting them from progressing something they have already thought of, are working on, or are about to file a patent application themselves. They may have already received an approach from another inventor with something similar to yours and cannot compromise that either. They will not want to you disclose your invention to them, get their refusal and have you complain later that they stole your idea. This could be the scenario if they had independently come up with the invention themselves or partnered with another inventor. For these reasons many blue chip companies will only meet with inventors who have filed for a patent.

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