Patents: Some Facts

When most people hear the term "intellectual property", the first word that often comes to mind is the word "Patent", although other forms of intellectual property (design right, copyright, database right, trademarks) also exist. A patent can be relied on to stop other parties from commercial activities involving an invention which has been protected in this way. This right is granted in return for providing sufficient information to enable a skilled person to understand how to make the invention work. Patent rights last for 20 years in most countries, subject to payment of annual renewal fees (although some pharmaceutical products may be granted a 5 year extension due to the amount of time it can take for such a product to go through all the trials required to bring it to market) and are territorial (there are no such things as "worldwide patents"); patents are granted in respect of individual countries and can only be enforced in those countries (i.e. UK patents are not valid outside the UK). Efforts have been repeatedly made for the EU to adopt a single patent enforcement system, but to date these have been unsuccessful. There are however mechanisms to streamline the granting procedure when protection is required in several countries, through international and European patent applications.

To qualify for patent protection in the UK, and other countries in Europe, an invention should be:

- **Novel:** The invention should be completely new with no disclosure to any third parties having taken place prior to the patent being filed unless they understood that details had to be kept confidential. This includes not presenting any details of an invention at meetings (whether in talks or on posters), on websites, or in publications prior to a patent application being filed.

- **Non-obvious:** The invention should involve an inventive step, so that the invention would not be seen as obvious to someone who is skilled in the area.

- **Capable of Industrial Application:** The invention should have some use in an industrial setting; e.g. a piece of machinery, a novel chemical compound,

- **Not excluded:** Certain types of invention are "excluded" from being patentable. These include musical, artistic and literary works, scientific theories, methods of doing business and computer software (more information about software patents can be found in the "Software Patents and Database Right" fact sheet available from Medipex). It is also not possible for patents to be taken out on methods that involve contact with a human or animal body such as treatment regimes or surgery. Methods of diagnosis are only patentable if they take place away from the body, e.g. on blood samples in a laboratory.

The date a patent is filed is called the priority date (this date is important because it is the date against which an invention is compared with what already exists to assess whether it is patentable). It can then take several years from this date for a patent to be granted. Patents in the UK are granted on a "first to file" basis, meaning that if two individuals come up with the same invention, the party which applies for the patent first will be more likely to be granted the patent. This is different from the system which operates in the USA where the party that comes up with an invention first is more likely to be granted the patent for it, regardless of who files for a patent first. This system is referred to as "first to invent".

Patent infringement can have serious consequences for the party that has carried out the infringement as it is likely they will have to stop the sale of any products which infringe the patent and potentially pay damages. When Medipex is assessing an idea for possible commercial value, one of the first stages in the assessment is to assess the risk of infringement of patents owned by other parties, and to advise on the options for minimising those risks. Once granted, patents exist as a tangible right which can be treated as corporate assets which can be bought, sold, licensed and which can be valued on a company's balance sheet. Note that rights in an invention (including patent and other intellectual property rights) which you generate during the course of your employment will generally be owned by your employer.

Useful Websites:

The UK Intellectual Property Office (http://www.ipo.gov.uk)
World Intellectual Property Organisation (http://www.wipo.int)
UK Intellectual Property Online (http://www.intellectual-property.gov.uk)

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Patents: Some FAQS

I have developed a piece of software for use in GU medicine. Can I patent it?

As a general rule, software can only patented if it involves a “technical effect” (identifying an appropriate technical effect can sometimes be a significant challenge, although the requirements can be less onerous in the US). Software is however protected in the UK and many other countries by copyright laws. More information about software patents can be found in Medipex’s “Software and Database Protection” fact sheet. If you should want to pursue patenting your software in the USA then you should contact Medipex for specific advice.

I have recently submitted a paper for publication but think that there may be some intellectual property rights in my work. Would I still be able to patent my invention?

If you have disclosed all the information about your invention in the paper you have submitted, then in the UK and Europe it may not be possible to patent your invention because you have disclosed your ideas to another party (even if a paper has only been submitted then it may count as disclosure because it gets sent out to reviewers who may not keep the information in your manuscript confidential). However, in the USA there is a 12 month grace period in which patents can still be filed after a non-confidential disclosure, so it may still be possible to obtain a patent in that market. You should contact Medipex for specific advice.

I have devised a new diagnostic technique. Is it patentable?

Whether or not your diagnostic technique is patentable will depend on whether or not the method is practised on or in the human body. If the diagnostic technique is carried out in a laboratory on a fluid or tissue sample (i.e. away from the patient) then it may well be patentable. However, if the diagnostic method is practised on a human body then it is unlikely to be patentable because surgical, diagnostic and therapeutic techniques/methods which are performed on or in a human body are not patentable (they are “excluded”). Materials, instruments and compositions for use in surgical, diagnostic and therapeutic procedures can however be protected.

I am currently developing a medical device but need to use some technology for which the patent belongs to another party. I am not carrying out this development for commercial purposes, so can I use the technology freely or do I need to seek permission from the patent holder to use it in my device?

A patent can be relied on to prevent activities which involve the manufacture, sale, import and use of a patented product. A licence agreement can eliminate liability for infringement. There can also be other defences which can apply in special situations, including use for private and non-commercial purposes or for experimental purposes. However, these defences require careful review to assess their applicability. Contact Medipex for more information.

Seven months ago I filed for a patent on an invention that I came up with during the course of my research a couple of years ago. Last week, another group in the UK published a paper which describes how they have come up with the same invention and all the details of how it works. They have not to my knowledge submitted a patent on their work. How does this affect my patent application?

It is possible that the other group has filed a patent application and that the application has not yet been published (patent applications are not published until 18 months after the initial priority date). If both parties have filed patent applications, then the invention in the latter application will only be patentable in view of what is disclosed in the earlier application. However, if the paper was submitted after your priority date, and you were the first party to file for the patent, then it is likely that your patent should be granted, although you should make your patent agent aware of the situation. In situations where you have developed an invention which you think might be patentable, you should contact Medipex as soon as possible.

Further Information or Advice:

Please contact Medipex on the contact details given below

This fact sheet has been produced in conjunction with Urquhart-Dykes & Lord, Patent Attorneys (Tel: 0113 245 2388; e-mail: email@udl.co.uk).
It is provided for the purposes of information only and is not intended as a comprehensive guide to patents.
In any cases where you have concerns or require advice regarding intellectual property matters, you should get in touch with your IP lead or Medipex.

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