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Ask the Experts: Can I get a patent for my invention?

In the first article in this series, we introduced patent attorneys, and suggested that 'How do I get a patent' may not be the first question to ask a patent attorney. In this article we look at three questions that you may wish to ask first.

Q: Can I get a patent for my invention?

A: Generally, patentable inventions relate to technical solutions to problems. In short, they relate to 'how' something works and not, for example, how it looks. The invention must be new and not obvious in light of what is publicly available information. A patent attorney will discuss with the inventor how their invention differs from existing solutions. Depending on the inventor's knowledge of the field, it might be recommended that a search is carried out to see if someone has got there (or close enough) before you.

However, there are certain things that are not patentable – such as methods of doing business and some types of computer-implemented inventions. The UK patent office deals with many cases where the invention is new and not obvious but falls very close to the boundary between patentable and unpatentable subject matter. This boundary is constantly evolving and being refined by the courts as new technologies emerge, and a patent attorney will be able to advise on the current situation, based on recent cases.

Q: Should I apply for a patent?

A: Patents are potentially extremely valuable assets: for example, a single pharmaceutical patent may give you a legal monopoly for a drug for many years. For many SMEs, a large portion of their assets are in the form of intellectual property. However, depending on your business plan, it is also possible that the value of a patent may be less than the cost of obtaining it. Therefore, it is essential to take into account costs and risks as well as potential benefits: intellectual property rights should be

treated in your business plan with just as much care as other assets, such as machinery, premises, and so on.

Something else to consider is whether the subject matter of your invention is actually made public by selling your product or service. For example, if your invention relates to a more efficient way of manufacturing an existing product, and you can keep that process secret, applying for a patent may not be appropriate.

Q: Is now the right time to apply?

A: Many time limits relating to both national and international processes are determined based on when you file the first application for a patent. For example, the expiry of a patent is determined based on the date of filing the application. In the UK, there is a time limit for getting the patent office to agree to grant the patent. Decisions on filing further applications to get coverage in other territories may have to be made relatively quickly after filing the first application.

The application will be made public 18 months after filing, so your competitors may learn of your technology even if you haven't launched any product or service.

For these reasons, it may be better to keep the invention secret and wait before filing. A delay can also allow you to refine it further, to develop prototypes, or to ensure that the invention (and not some other feature) provides the benefits expected.

A real scenario recently concerned an applicant who had filed an application for their own invention. The patent office raised various objections to the application and concluded that the invention would not actually work, and therefore that no patent could be granted. Although developing a prototype in this case was difficult (the invention related to space travel), more research and consultation with a patent attorney may have avoided the time and expense of filing the application in the first place.

On the other hand, if your business plan includes a product or service launch on a particular date, then it is essential that you have filed an application for a patent before that date. To maximise the probability that you are able to obtain a valuable patent, work on your application should begin well in advance of this date.

In the next article in the series, we'll look at some of the details around applying for a patent.

Written by [David Hole](#)

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