

Getting a patent – the initial steps

Are you interested in seeking patent protection? Are you unsure whether patent protection is right for your business? Or are you looking for more information on the mechanics of the process? Perhaps you already know a bit about the patent process but need an **invention summary form**.

This booklet is for you.

Included is guidance that will help you take sensible and cost-effective initial steps towards obtaining patent protection for your business.

Whether or not you have been down the patent route before, successfully or otherwise, we can help you use Intellectual Property to achieve your goals in an efficient and cost-effective way.

Step 1 – read the FAQs section

FAQs answered:

- What is a patent?
- How do I get a patent?
- What are the requirements for patent protection?
- Do I need to keep my invention secret? [This is critically important.](#)
- How long does it take to get a granted patent?
- How much will it cost to obtain patent protection?
- Who owns the invention?

We recommend you read our answers to these questions carefully. They will help you form an initial understanding of the patenting process, the timescales, and the associated costs. With a patent attorney, you will be able to decide whether seeking patent protection can support your business.

Step 2 – complete your invention summary form

Before your patent attorney can prepare a patent application for your invention, they need a full understanding of that invention. To minimise cost, you should complete your **invention summary form** before discussing your invention with a patent attorney.

Your **invention summary form** is provided in two parts, which can be obtained using the following links:

- Invention summary form – [Part 1: Text](#)
- Invention summary form – [Part 2: Drawings](#)

Your **invention summary form** is designed to assist you in gathering the relevant details of your invention. With a completed **invention summary form**, interactions with your patent attorney will be cost efficient. Your patent attorney understands your invention and uses your **invention summary form** to prepare your patent application.

While the primary purpose of your **invention summary form** is to enable preparation of a patent application, do not feel so limited. You are free to use your **invention summary forms** internally to record inventions and potential inventions, or even earlier stage ideas for future development. This is good practice. Completing **invention summary forms** incurs no patent attorney costs; building your library of **invention summary forms** could be a relatively low-cost exercise.

Your **invention summary form**, once completed, should be kept confidential. If it is not kept confidential until a patent application has been filed at a patent office, obtaining valid patent protection for your invention may be impossible.

Step 3 – discuss your invention with a patent attorney

Once you have completed your **invention summary form**, please send it through to mail@mewburn.com or to your regular Mewburn Ellis contact. A patent attorney with an appropriate technical background will get in touch to discuss next steps, such as:

- Whether your invention is eligible for patent protection.
- Whether patent protection is suitable for your business
- How much it might cost to prepare a patent application for your invention

Patent attorneys are bound by professional confidentiality rules of conduct. Any materials you send to mail@mewburn.com or to any of our staff are treated as confidential.

Top Tip: Try giving your **invention summary form** system a catchy name. Give it an acronym. Refer regularly to your invention summary system and the need to complete the forms. Ensure a template is readily available to all technical staff. You will be surprised how prolific an **invention summary form** system can be when it is culturally embedded in a business.

FAQs

What is a patent?

- A patent is a monopoly right which can be granted in return for disclosing an invention (a new and non-obvious technical development) to the public. The right lasts for up to 20 years from filing the patent application. A patent protects how the invention works, or how it is configured, beyond its mere appearance (if you want to look at protecting only the appearance of a product, then we suggest you consider registered design protection).
- A patent is not a right to use the invention; it is a right to prevent others from making, using or selling the invention commercially.
- Patents are territorial, meaning that a patent application will need to be filed in each country of interest (e.g. where you plan to manufacture/sell your product)

How do I get a patent?

- To obtain a patent for a new invention, a patent application is filed at a patent office. A patent application must set out in detail what the invention is, and what protection is sought. A patent application is an important legal document, and therefore we strongly recommend that a patent application is prepared by a patent attorney. A patent attorney is an individual who has relevant legal qualifications, a strong technical background (typically a degree in a scientific or technical subject), and practical experience dealing with the patent application procedure.
- Once a patent application has been filed, it will be examined by a patent office. The patent office may raise objections against the wording of the patent application, e.g. if they believe the requirements for patent protection are not met (see below). To overcome such objections, it is usually necessary to argue against the objections, often with amendments being made to the wording of the patent application. This back and forth between applicant / attorney and the patent office is sometimes referred to as patent "prosecution". In order to maximise the prospects for overcoming objections and obtaining useful patent protection, we strongly recommend that these arguments and amendments are made by a patent attorney.

"I think this booklet will be a really useful resource for any companies or private individuals who are thinking about what initial steps to take in order to protect a new invention"

James Leach
Partner, Patent Attorney
Manchester



What are the requirements for patent protection?

- In order to obtain a patent protection for an invention, we must persuade a patent office that the invention is:
 - Technical – meaning that the invention lies in a field of technology (a patent cannot protect, for example, a new business method or artistic work).
 - Novel – meaning that before the date of filing the patent application the invention has not been made available to the public in any way, including (for example):
 - written description;
 - oral description;
 - use of the invention in a public place.
 - Inventive – meaning that the invention is not an obvious development of something that is already known.
 - Industrially applicable – meaning that it is capable of being made or used in any kind of industry, including agriculture.
- It is often not possible to know whether all these requirements are met at the time of filing a patent application. However, once you have completed an **invention summary form**, we will have a better idea of the prospects for meeting these requirements.

Do I need to keep my invention secret?

- **Yes, until a patent application has been filed for that invention.** Any public disclosure of your invention (even to one member of the public) before your patent application is filed can potentially invalidate patent protection for your invention.
- Disclosures made under a non-disclosure agreement (“NDA”) do not usually count as a public disclosure, but care is needed if relying on non-disclosure agreements, see e.g. our information sheet [here](#).
- Once a patent application has been filed, a later public disclosure will not count against that application for assessment of novelty or inventive step. However, if you are planning to file a later patent application containing new information relating to the same invention, then a public disclosure of the invention could affect that later patent application. See more information [here](#).

“I have seen first-hand the valuable patent portfolios that a well-used invention capture system can create and sustain. Technology businesses of all sizes could benefit greatly from these systems. Use your invention summary form to build an IP portfolio – big, small or in between – that supports your business strategy. Along the way, create your own internal records of technology developments, which could go otherwise overlooked.”



Dan Thornton
Partner, Patent Attorney
Manchester

How long does it take to get a granted patent?

- A patent cannot be enforced against an alleged infringer until it has been granted, which typically takes 2-5 years (sometimes longer). We can take steps to accelerate the process.
- While a patent cannot be enforced until grant, a published patent application provides some provisional protection. Once the patent has granted, infringement actions can be backdated to include the period between the publication and grant (provided the infringement falls within the scope of both the granted claims and the published claims).
- Once a patent application has been filed, you can mark a product as being the subject of a patent application, which may alert third parties to your pending application. Care is needed if doing this, see e.g. our information sheet [here](#).

How much will it cost to obtain patent protection?

- This is a complex question. Obtaining patent protection for an invention is a multi-step process, with each step having an associated cost which is difficult to predict with accuracy, because so many different factors are involved. Your patent attorney will be able to give an idea of costs in your particular circumstances.
- Roughly speaking, the steps involved in obtaining patent protection can be understood as:
 - i. Preparing a patent application describing the invention in detail
 - ii. Filing patent applications in relevant territories of interest;
 - iii. Prosecuting the patent applications in each territory, in order to persuade the relevant patent office(s) that the invention meets the requirements for patent protection in that territory;
 - iv. Paying renewal fees to keep the patent in force in each territory.
- Step (i), the cost of having one of our patent attorneys prepare a patent application for your invention will typically be in the range £5k-10k+VAT, depending on the technical complexity of the invention.

- Step (ii), many UK applicants will file a UK patent application first, in order to get an initial filing date for their invention. The cost of filing an initial UK patent application is usually ~£1k+VAT (including the official fees and our standard service charge). You can find out more about UK patent applications [here](#).
- If patent protection is wanted in territories outside of the UK, then one or more additional patent applications will need to be filed within 12 months of the initial UK filing, which normally means additional cost at around 12 months from the initial UK filing. In many cases, protection outside of the UK is sought by filing an International patent application ("PCT application") at or before 12 months from the initial UK filing. The cost of filing an International patent application is typically ~£4k-5k+VAT. You can find out more about International patent applications [here](#).
- Step (iii) and (iv) are strongly dependent on a number of different factors (including the territories in which protection is sought, how technically complex the invention is, whether the patent office(s) find documents that come close to disclosing your invention). But the costs of both steps (iii) and (iv) can both be significant, e.g. at least as large as the costs associated with steps (i) and (ii). We can provide cost estimates as these stages approach.
- As a ballpark cost, for a technically simple invention where protection is sought only in the UK a budget of £10k-15k+VAT, across a period of 3-4 years, is likely to be required to get through steps (i)-(iii). If protection is wanted in additional countries, then the costs will be higher.

Who owns the invention?

- By default in the UK, the inventor is the first owner of an invention.
- Where the inventor is employed in the UK, and their invention arises from their normal employment duties (or duties which have been specially assigned to them), ownership of the invention normally passes automatically to their employer.
- More details regarding inventorship/ownership may be found [here](#).

Contact Us

For more information on Mewburn Ellis LLP and other intellectual property matters, please visit our website at www.mewburn.com; email firstname.lastname@mewburn.com or mail@mewburn.com