SWINDELL & PEARSON LTD
Patent & Trade Mark Attorneys since 1878

INTELLECTUAL PROPERTY PROTECTION

Intellectual Property

Intellectual property (IP) refers to intangible assets of your business such as your patents, trade marks and designs. We help you protect these assets.

Patents

Patents are used to protect technical innovations that have the potential to give your company a commercial advantage.

A patent is a legal document that precisely defines a monopoly granted to the owner of the patent for an innovation. Such a monopoly could be used to prevent a competitor using the innovation even if they develop it independently without copying.

Patents are obtained through a registration system that starts with filing a patent application at a patent office. The patent office will typically perform a novelty search to discover earlier documents which might describe the invention, then they publish the application and then they examine the application in order to determine whether the invention is patentable. A patent will be obtained if the legal objections raised by the patent office during examination are overcome. We can prepare a patent application for you and our detailed knowledge of law and procedure helps in obtaining a patent. It is normal to file an initial patent application in the UK but this is not mandatory.

Once a patent is obtained, the monopoly defined by the patent can be enforced by taking civil action in the Courts against past and on-going infringements of the monopoly. We can advise you should you wish to take such action.

If a monopoly is required in a specific country then a patent application is required in that country. We can prepare patent applications that are suitable for foreign countries and our knowledge of foreign law and procedure helps in obtaining patents.

A World Trade Organisation (WTO) agreement allows us to delay filing patent applications in many overseas countries for up to twelve months from the date of filing the initial UK patent application. However, in this situation, it is important that the initial UK patent application is carefully drafted taking into account the terms of the WTO agreement.

Instead of filing a national patent at twelve months from the date of filing the initial UK patent application, we can file a special type of patent application, an International (PCT) application, which will delay the filing of patent applications in most important industrialised countries to thirty months from the filing date of the initial UK patent application.

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In most countries, for a valid patent to be obtained, the invention defined by the patent application must be both new and non-obvious. Novelty and obviousness are judged at either the date of filing the patent application or, if proper procedures are followed, at the filing date of the initial UK patent application. Novelty and obviousness are assessed by comparison to all publicly available information at that date. This information may originate from you or anyone else and can be available anywhere in the world. The initial UK patent application should therefore be filed before the invention is publicly disclosed. Once the patent application is filed, the invention can be publicly disclosed without prejudicing the novelty of that patent application.

It is important to note that novelty and obviousness are judged at the (earlier) filing date of the initial UK patent application only if proper procedures are followed. We are of course very experienced in following these procedures so that you obtain the earliest possible date for judging novelty.

In most countries, for a valid patent to be obtained, the patent application must describe in sufficient detail how to make and work the invention defined in the patent application. This information will become publicly available when the patent office publishes the patent application which is normally eighteen months after the filing date of the initial UK patent application.

In some countries, particular types of inventions are not patentable. For example, business methods and methods of diagnosis or treatment of a human or animal are not patentable in the UK. This is a complex and rapidly changing area of law. We are able to sidestep some exclusions in some jurisdictions by careful drafting of the patent application but some exclusions are absolute.

It is also important to note that information cannot be added to a patent application after it is filed. It can therefore be impossible to rectify significant deficiencies present on filing the patent application. We are of course very experienced in preparing patent applications that do not have such deficiencies.

Most countries require that a renewal fee is paid to keep a patent in force. Some countries also require renewal fees for applications.

If you are concerned about competitors' patents, we can perform a search to identify such patents and we can set up a watch that will inform you should they have new patent applications published.

In order to prepare a patent application for you, we require full details of the invention, with drawings if appropriate. The drawings do not necessarily need to be to scale or to be engineering drawings. They are intended only to assist in the understanding of the invention. We shall send the patent specification to you for approval before we file it at the patent office. Once the application is on file, you can publicly disclose the invention without prejudicing the eventual patent, provided that appropriate steps are taken in due time to progress the patent application.

Please do not disclose your invention before we have filed your patent application. If a disclosure must be made, for example, in the course of business discussions, please contact us for a suitable form of non-disclosure agreement.

Trade Marks

Registered trade marks are used to protect signs such as words, logos, slogans, or potentially even the likes of sounds and smells, that act in the course of trade to designate the origin of the goods and services for which a mark is registered.

Registered trade marks are obtained through a registration system that starts with filing an

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application to register a trade mark. It is very important that the application is carefully prepared to ensure that the most effective and valuable protection is secured.

We specialise in the preparation of trade mark applications and in guiding our clients and their applications through to registration.

A registered trade mark is a monopoly right granted to the owner and which can be used to prevent a competitor from using the same or similar trade mark.

Once a trade mark is registered, the monopoly rights it presents can be enforced against infringing parties by way of civil action in the Courts, or in certain cases through law enforcement agencies such as Trading Standards and Customs.

Registered trade mark rights are territorial. It is therefore very important that your trade marks are registered in those countries that are important to your business. When considering what territories are important, a principal criteria is of course those countries in which you have a direct market for your goods and/or services. Also, consideration should be given to those territories where your products are manufactured and where counterfeits are most likely to be created. China, India and other parts of Asia are currently the source of most of the world's counterfeit products. The absence of a registered trade mark in these countries means that challenging such activities is extremely difficult. On the other hand, if you have your trade mark registered locally in these countries, enforcement can be effected through the use of local law enforcement agencies, which often provide very swift and effective action against counterfeiters obviating the need for you to initiate expensive and complex civil actions in the Courts.

We specialise in preparing trade mark applications around the globe.

Before you commit to using a trade mark in a particular jurisdiction, we strongly recommend that appropriate searches are carried out to ensure that your use will not cause you difficulties through the infringement of another party's trade mark rights. We specialise in performing such searches, in advising in this complex area, and where appropriate we work with our clients to mitigate any risks identified by such searches. Failure to identify and mitigate potential trade mark infringement risks can have very damaging consequences. Our advice can help you avoid having to change your trade mark, withdraw your products from the market, re-educate your customers to your replacement trade mark and pay damages for any infringements that arise. Appropriate searches to clear a trade mark for use are therefore strongly recommended.

Designs

Registered Designs are used to protect the appearance of a product rather than its function.

A registered design is a legal document that defines a monopoly granted to the owner of the registered design. Such a monopoly could be used to prevent a competitor using the same or similar designs whether or not they have copied your design.

We can prepare a design application for you and help guide the application through to registration. It is normal to file an initial design application in either the UK or the European Union (EU). A single application can cover a number of different designs, providing a cost saving over separate applications.

Once a design is registered, the monopoly defined by the registered design can be enforced by taking civil action in the Courts or, in some circumstances, via Customs.

If a monopoly is required in a specific country then a design application is required in that country.

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It is possible to obtain design protection covering the whole of the EU with a single design application. In addition, an International Agreement allows design applications in many overseas countries to be delayed for up to six months from the date of an initial UK or EU filing. We can prepare design applications that are suitable for foreign countries and our knowledge of foreign law and procedure helps in obtaining registration.

Finally, although a design that is unregistered may provide some protection via unregistered design right, a registered design is easier to enforce and provides different, additional protection. As an example, an unregistered design right may only be used in relation to copying of the design whereas a registered design is a monopoly right that can be used whether or not copying has occurred. Also UK unregistered design right does not provide protection for two dimensional designs such as surface decoration.

Copyright

Copyright subsists automatically in any original artistic or literary work and can be used to prevent that work being copied. Drawings of any type are protected by copyright, as are text and computer program listings. In the UK there is no requirement for copyright to be registered. However, registration is necessary or advisable in some countries. The term of copyright varies depending on the type of work involved but in some cases can run for up to 70 years after the death of the author. In all cases it is strongly recommended that detailed and reliable records be kept identifying: any work which may enjoy copyright, the author, the date of original creation and the date and nature of any subsequent amendments. These will need to be relied upon in the event of dispute.

Ownership

Different types of Intellectual Property (IP) have different provisions concerning ownership. The owner may, in some circumstances, be the creative individual. In other circumstances, the owner may be the person who employs that individual or the person who has commissioned work from that individual. It is important that care is taken concerning ownership of IP when commissioning any work that may create IP. It is also worthwhile making sure any contracts of employment have specific IP clauses. Please contact us for more information.