



Establishing a product's patent-ial

Innovate Product Design's **Clio Davies** analyses inventors most common misconceptions surrounding intellectual property

Picture: Innovate Product Design's designers

The fast-moving world of new technology and innovation seems a million miles away from many people's everyday lives, but with current media platforms such as *Dragons' Den*, *The Apprentice* and *American Inventor* championing the everyman inventor and entrepreneur, new opportunities are arising for 'ordinary' people to enter into this pioneering environment.

With a lack of teaching on the subject of intellectual property within educational institutions, very little is known about the steps involved in bringing a new product idea to fruition. As an established UK-based product design consultancy specialising in intellectual property and product commercialisation, Innovate Product Design Ltd see a number of ideas come through the door on a daily basis, the majority of which are from people who have no experience of the innovation industry and what steps they should or should not be taking. Due to a lack of knowledge or misconstrued advice, for some, unfortunately, it can be too late, as they come seeking protection for a product they already have on the market. It is patenting, in particular, where most misconceptions lie and this can potentially jeopardise the future of the product, as disclosure prior to applying for a patent can prevent it ever being granted.

However, for some, patenting is not as relevant as they might think. With the topic becoming increasingly more prevalent in the media, as viewers watch inventors get grilled by *Dragons Den* investors as to their patent status, inventors are left thinking that everything must be patented. The reality is that, in the UK, a patent only applies to an invention with a new or improved functionality and/or application and is not applicable to websites, names, works of art, literature, music, or business models. In many cases, even though the product is novel, there are other forms of protection that are equally weighted, if not more relevant, such as registering the design to protect the external appearance of a product, design or pattern.

However, although a concept may not be patentable in the UK, it could potentially be patented in the US; this is the case, for example, with some business models. Establishing the relevant form of protection overseas for UK applicants, can in itself cause confusion, particularly in the US, and other countries, where the design patent is implemented

rather than the registered design in Europe. However, protecting a design through both processes can sometimes be of more importance than the traditional UK patent, known as a utility patent in the US.

In fact, other forms of protection, such as trademarking, are often overlooked by new inventors. In some instances, neither a patent nor registered design are relevant, but flooding the market whilst operating under a strong trademark and establishing a brand can equally help to gain monopoly. Trademarks, if established correctly, can often inherit global recognition as the mark, colour, symbol, word, font etc, becomes synonymous with the brand.

But even established companies are sometimes oblivious to the intellectual property rights afforded to them. As well as having several registerable rights (ie, patents, registered designs), there are also unregistrable rights that are automatically awarded to certain creations such as unregistered design rights, unregistered trademarks and copyright. In some instances, it is equally beneficial, if not more cost effective, to rely upon unregistered rights for a period of time. This is particularly applicable to unregistered trademarks, as there is no obligation of non-disclosure, therefore a company can operate under an unregistered mark indefinitely, before deciding whether it is commercially beneficial to officially register. People remain unaware that operating under the TM symbol is legally applicable to unregistered trademarks. (It is not until the trademark is registered that the © symbol would be applied.) However, it is important that due diligence is still undertaken, even if not officially filing, to make sure a company or product name is not infringing on any other operating within the same industry; this includes both names or marks filed, as well as those relying upon unregistered rights.

It is due diligence where inventors often fall short. The importance of understanding how their product, design or mark fits with existing similar items is paramount to the success of a project. Where most inventors are preoccupied with protecting their product, it is equally important to ascertain it is not infringing on any other granted application. This is never more important than in relation to patents, where an application must be seen to claim novelty over any existing

prior art globally. Inventors will extensively search the internet and companies' product portfolios to prove that their product is original, but this merely seeks to ascertain that their product is not on the market. Without conducting a comprehensive worldwide patent search there is no way of asserting originality, as prior art not only includes products already on the market but all patent applications ever filed and published globally, whether granted, lapsed or rejected, as well as any discussions on the concept cited in journals, academic works or other.

From conducting or commissioning a search to assessing the results brings in itself new challenges. It is easy to skim through patent application drawings and abstracts looking specifically for the idea, but

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actually assessing the implications of each individual set of claims and establishing what can still be claimed as novel, or as an improvement, is very different. Understanding the depth and complexity of patent applications is demanding, even the sentence structure and jargon can be challenging. Difficulties tend to arise when understanding exactly what can be claimed as novel and how their own application may sit, in line with cited material. Although a patent can be granted as an improvement over existing prior art, this does not include being cheaper, looking different or adding a redundant function for the sake of differentiation, arguments that are so often proposed. Similarly, discovering an identical product or patent in another country does not mean that the product can be re-patented in an applicant's own country, but for those without prior knowledge of intellectual property, interpreting the results of a novelty, patentability or freedom to operate search is not often achievable without obtaining expert advice.

It can also be difficult to establish when to file an application. Filing without having conducted the necessary research and development can be detrimental to the application itself and may involve re-filing. Often, filing an incomplete or incorrect patent application could jeopardise the chances of grant, as the initial application can be cited against subsequent applications, if published. It is important to have designed and developed the product, prior to filing, so that the application can be written in relation to the function of the product rather than having to design around something already written. If elements of the product change through the development post-filing, this may mean that the application itself could need to be re-filed, as the original application is now no longer accurate. This could result in an original filing date being lost; therefore applications filed in the interim by others may be cited against the new application. However, developing the product pre-filing may also help to identify further intellectual property and claims of novelty, thus strengthening the application itself.

With the patent search results clearly defined and the product's novel claims identified through development, often an inventor's natural instinct is to protect the product globally by filing a 'worldwide patent'. Although ideal, a worldwide patent is yet to be established and possibly unfeasible to implement, due to the variations in patent law from country to country. Although unitary systems are in place to allow 'mass filing', including the PCT (Patent Cooperation Treaty) allowing an applicant to file in 142 countries, the UK patent filing system allows an inventor to file, without incurring any costs, for a 12-month period. This allows the

applicant to carry out additional research and development and even approach market, in order to establish the demand. It also allows 12 months in which to submit subsequent patent applications overseas, whilst still claiming the priority filing date of the initial application. With global market research, it can often be ascertained that applying for patent protection in every country is of little benefit, and by selecting those countries in which seeking monopoly carries the most rewards, an inventor can save unnecessary future costs being incurred.

However, it is equally important to make sure that an application has been filed in the countries in which protection is sought, even though once filed anywhere, no one globally can file the same application and it be granted, it does not mean that they cannot still produce the product, unless the applicant has granted protection in that country. By not filing in time, or understanding the importance of filing international applications, inventors can sacrifice future international success. Due to fees involved with filing in each country, it is exceptionally important to identify only the countries of relevance.

Hearsay surrounding the cost of obtaining intellectual property rights is often one of the greatest deterrents that prevents inventors from successfully securing the right form of protection at the right time. Although inevitably there are costs, these do not need to start until 12 months after filing, at which point an inventor could have licensed out the product to a company, who may cover future intellectual property costs, have an investor onboard, or could already be generating profits. It is widely misconstrued that the intellectual property application must be granted before the product can be marketed, but with a UK patent application taking 18 months - 4 ½ years to reach this point, and longer in other countries, this could equate to a number of lost sales, if it were the case. The moment the filing receipt is received, an inventor can begin their approach to industry.

However, even with a granted application of any form of intellectual property, it is still solely dependent upon the applicant to police their own protection. Therefore, an inventor must be vigilant in maintaining their rights and identifying infringement. Maintaining intellectual property rights can be just as important as obtaining them. This can often deter inventors from obtaining intellectual property rights because of the costs of upkeep and potential disputes; however, applicants need to be aware of intellectual property insurance policies and the possibility of licensing their project with the legal costs being covered by the licensee. After all, the potential profits and monopoly to be gained from protecting intellectual property may far out way any litigation fees.

When it comes to protecting potentially profitable ideas, it is imperative that inventors seek out the right advice. With internet resources often providing conflicting information, it is important that an applicant knows the intellectual property laws that apply to their country of filing and the rules surrounding prior disclosure. However, with the differing forms of protection available, it is necessary to identify early on which is the most relevant and, in particular, whether patent protection is applicable; as this could either be an important first step or unnecessary expenditure. Therefore, one of the first questions an inventor must consider when embarking on their project is: 'Does my idea have patent-ial?'

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