

PATENTS, WHAT THEY MEAN AND HOW TO MANAGE THEM

The following are general guidelines. Each case is unique and professional advice from a patent attorney should be sought to ensure effective management of rights.

- A government may grant a fix-term monopoly (or patent) to the inventor(s) following a patent specification disclosure to the public. The patent provides the patentee with exclusive exploitation rights to the invention in the country of grant. The usual patent term in most countries is 20 years (from filing date), and requires annuity fees to maintain the patent valid. Once the monopoly period expires, the specification enters the public domain, and is free to use by anyone.
- Any ‘publication’ or disclosure of an invention or use for a commercial purpose prior to the filing of a patent application with the appropriate Patent Office can invalidate the patent, and therefore, should be avoided. The invention must be fully and adequately defined in broad terms in the specification accompanying the patent application.
- Eighteen months after the priority date (date of initial filing), each government’s Patent Office publishes the applications. It is usually commercially objectionable to publish during this period.
- Before applying for patent protection, a search for prior art should be carried out. Free patent keyword searching through the Internet is provided by the Patent Offices of various countries.
- By publishing early, the invention is disclosed to competitors, possibly allowing rapid advances in their own products, and may be critical if when the publication occurs at the pre-commercial (development) stage. In order to minimise risk of early competition and increase protection, the information must be kept confidential.
- Additionally, by publishing early the applicant may be prevented from the option of re-filing or abandoning the application, which despite setting a new (more recent) priority date, re-starts the procedure. Significant international and foreign expenses (usually due 12 months from the priority date) could be deferred. Re-filing should only be considered if there has been no commercial use or publication.
- Applications need to be lodged in each country where patent protection is sought – there is no ‘world’ patent. Priority dates can be claimed in most foreign countries from an application lodged in Australia through an international convention agreement, providing that the foreign Patent Office procedures allow deferment of foreign filing costs for up to 30 months from the priority date (31 months in Europe, Australia, and New Zealand).
- Foreign patent protection is expensive, especially in the major international jurisdictions. To obtain patent protection overseas, the costs may include translations (for non-English speaking countries), filing fees, examination, registration and annuity fees. Although dependent on the jurisdiction and the complexity of the invention, the costs for securing a patent overseas can be \$10,000 and sometimes considerably higher.
- The decision for maintenance of patent protection at each stage of commercialisation should be carried out through a continuous monitoring process of market trends. In addition, further patent protection may be required on any improvements to the invention; patent attorneys should be consulted at the time of conception of the improvements to make this determination.

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