

WHAT IS A PATENT AND WHAT DOES IT PROTECT?

A patent is a monopoly granted by the government for an invention that works or functions differently from other inventions. It is necessary for the invention to be 'new' and 'inventive' compared to what has been done before. This means your invention must have novel features which contribute to its working.

A patent will protect the intellectual property you have created in making the invention. It can be considered as an incentive to be inventive and conduct research and development. By obtaining patent protection for your invention, you can have a monopoly to exploit your invention for up to 20 years.

WHY DO I NEED A PATENT?

Put simply, because it grants you a statutory monopoly to exploit your invention in Australia and around the world. A patent will enable you to prevent others from making your invention or from importing your invention to Australia and around the world.

WHEN SHOULD I APPLY FOR A PATENT?

You must apply for a patent before disclosing your invention to anyone. If you disclose the invention or sell it prior to filing a patent application, you will probably invalidate a subsequent application.

WHAT ARE THE STEPS IN OBTAINING A PATENT?

The first step in obtaining a patent is the lodgement of a provisional specification at the Patent Office. The provisional specification contains a general description of your invention and sketches to show the parts which enable it to work. The provisional application gives you an initial 12 months protection during which you may sell, disclose and generally get the invention into the market place.

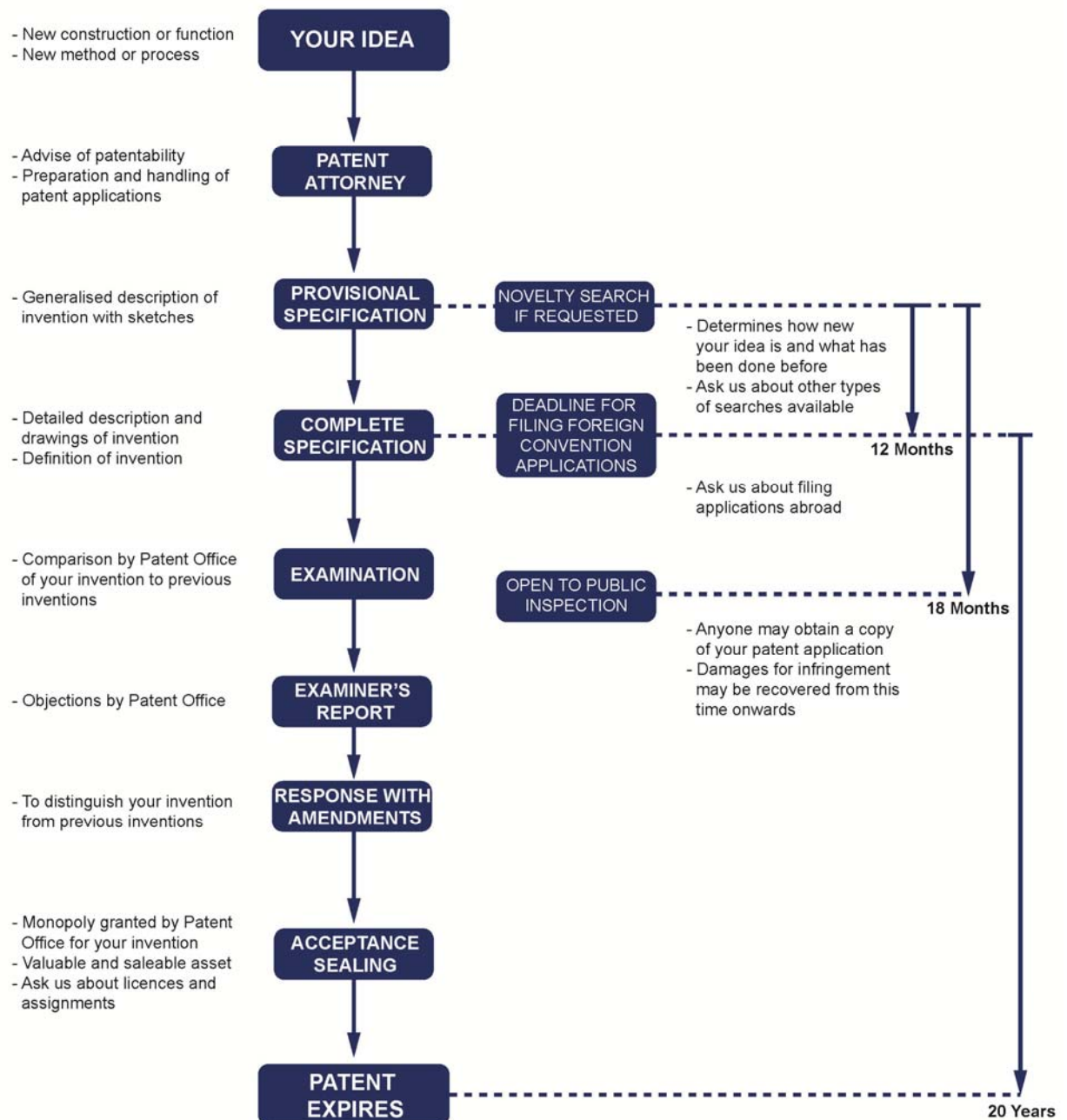
If you are considering overseas applications we suggest that a novelty search be done. Filing overseas is considerably more expensive than in Australia and it is best to get an early indication of the prospects of patent protection.

Before the end of the 12 months, it is necessary to lodge a second document called a complete specification. Generally the complete specification would take into account any changes made to the invention over the course of the 12 months. The complete specification would often also contain a more detailed description and drawings of your invention. It also contains a series of statements, called claims, which define the monopoly you are seeking. At this stage, any corresponding overseas applications should also be made.

Later on, generally after one to two years, there is an examination phase. The patent office will compare your invention to previously known inventions. The examiner will often say that

your invention is similar to some previous inventions. Depending on the degree of similarity, it may still be possible to obtain patent protection.

A patent is like a piece of property; it can be sold and traded (or even licensed) at any stage, even while it is pending.



WHY CONDUCT A SEARCH?

Intellectual property searches are most commonly conducted for the following reasons:

- To determine whether your ideas have been previously documented (a prior art search for patents and/or designs) and therefore provide an indication of whether your invention must satisfy in order for an application for patent protection or design protection to be successful
- To assess whether you are likely to infringe the rights of another party (an infringement search)

Searches in relation to the prior art can provide an indication as to where the novelty in your invention lies and therefore streamline the prosecution of the application. Searches in relation to infringement can provide information to allow you to make informed commercial decisions and avoid the unenviable position of infringing another's rights. Ultimately, the ability to make informed decisions can save you money.

Searches can be conducted in relation to patent, trademark or design matters and are highly recommended.

PRIOR ART SEARCHES FOR INVENTIONS OR DESIGNS

Prior art searches are usually conducted to determine whether an invention or design is new, or whether something similar has been invented and documented. As a patent or design application is assessed against prior art on a worldwide basis, it is not possible to provide a search that guarantees novelty. Nonetheless, various searches are available to provide an indication of novelty, as detailed below:

INTERNET SEARCHES

Several patent databases are available for online searching. Both the coverage of the databases and the ease of use vary considerably. The most popular sites include:

- The European Patent Office: www.ep.espacenet.com
- The United States Patent 7 Trade Mark Office: www.uspto.gov
- The Chemical Abstract Services search facility: www.cas.org

Links to other patent databases can be found through our website www.formdesigns.com.au

WORLDWIDE PATENT DATABASE SEARCH

A patent attorney will be able to conduct this on your behalf.

INTERNATIONAL TYPE SEARCH BY IP AUSTRALIA

Following the lodgement of a provisional patent application, the Australian Patent Office offers the service of a search of available international records. This search is similar to the search the Patent Office conducts as part of the examination of complete patent

applications. It may be of significant advantage to have an indication of the novelty of an invention before investing in international patent applications.

INFRINGEMENT SEARCHES FOR INVENTIONS AND DESIGNS

An infringement search for a new product or method assists in determining whether you would infringe someone else's patent or design rights by importing, manufacturing, using or selling a product or process. As rights to an invention or design generally only exist in those countries where the inventor or author has applied for protection, it is necessary to search only in each country that you intend to exploit the product or process. Having an infringement search conducted prior to commercialisation can avoid expensive legal proceedings at a later date.

TRADE MARK AVAILABILITY SEARCH

This search is used to indicate both the probable success of a proposed trade mark application and also the chance of infringing a prior registered mark. We strongly recommend a trademark availability search be conducted prior to the adoption of any new trademark or business name, regardless of whether you wish to obtain registration of your new trademark or not.

OTHER SEARCHES

Other types of Intellectual Property searches can be conducted for various purposes. Some of the more common type of searches are listed below:

NAME SEARCH

A name search is used to find any applications belonging to an individual or company. This type of search may be conducted for the purpose of either reviewing prior art or infringement issues or simply to keep track of the activities of a particular person or company.

PATENT FAMILY SEARCH

A patent family search can determine the degree of international protection afforded to a particular invention. Where details of a single patent are known, these details can be used as a basis to determine the existence of other patents around the world which correspond to the known patent.

STATUS CHECK

A status check is used to reveal the current status of an application or registration. Where the progress of an application is of particular importance, a patent attorneys' watching service may be appropriate. A watching service comprises regular status checks, alerting you of any change in the status of the watched application.

WHY MAKE OVERSEAS APPLICATIONS?

Put simply, because Australian applications are limited in scope to covering Australia. If you have overseas interests or are looking to expand your activities overseas, you will need protection for your intellectual property outside of Australia.

THE CONCEPT OF A PRIORITY DATE

When an application (be it patent, trademark or design) is examined, it is compared with documents in existence at the priority date. For your first application in relation to a particular matter, the priority date is the date of filing the application.

Australia is a member of various conventions which allow you to make an application in Australia and, at a later date, make applications in other member countries whilst retaining the priority date of the Australian application. This is called claiming priority. Claiming priority is an important part of making overseas applications since without it, your Australian application may prevent you from obtaining protection overseas at a later date.

PATENTS

Australia is a member of more than one convention in relation to patents. There are countries which are not members of either of these conventions, and two notable ones are Thailand and Taiwan. This means that to obtain protection in these countries it may be necessary to make applications in these countries at the time of making your first Australian application.

THE PARIS CONVENTION

The Paris Convention enables you to lodge patent applications in other member countries up to 12 months after your first Australian application and still claim priority from the Australian application. Over 100 countries are members of the Paris Convention. Claiming priority is of vital importance in overseas patent applications.

Most countries require an invention to be new compared with disclosures (both documents and usage) anywhere in the world. Filing overseas applications after the 12 month period provided by the Paris Convention may mean that your Australian application or your use in Australia will prevent you from patenting your invention overseas. This is especially true if your Australian application has been published.

THE PATENT COOPERATION TREATY (PCT)

Since overseas applications are relatively expensive, the 12 months delay provided by the Paris Convention may be enough to decide which other countries you will ultimately desire protection in.

While it is still necessary to ultimately make individual applications in the countries designated in the PCT application, the additional time can be advantageous. For example, it gives you an opportunity to decide which countries you actually want to file applications in,

whether that decision is the result of market research or negotiations. It also allows you more time to secure financial backing for your invention, whether in Australia or overseas.

The PCT allows you to defer the decision of which countries to ultimately make applications in until up to 30 months from your first Australian application. Instead of making numerous individual applications in overseas countries at the 12 month date, it is possible to make a single PCT application. The PCT application can designate any number of over 75 member countries. The effect of designating a country is to reserve the right to file application in that country at either 20 months or 30 months from your first Australian application. There are other benefits to making a PCT application. This search report can allow you to judge both your prospects of patent protection and the relative strength of the application. Further, if International Preliminary Examination is requested, your PCT application will be examined before you make national applications.

This can be a cost saving mechanism since it may prevent each national Patent Office raising the same objection later. Additionally, requesting International Preliminary Examination extends the deadline to make national application from 20 months to 30 months from the priority date.

TRADEMARKS

As with patents, priority applications for trademarks in other countries are governed by the Paris Convention. Paris Convention allows you to claim priority from your Australian trademark application up to 6 months after filing your Australian application.

Since it is possible to make trademark applications after using the mark, filing overseas applications after the 6 month period will not entirely eliminate a possibility of obtaining trademark protection. However, it will expose you to certain risks. A significant number of countries use on a first to file system where the application with the earliest priority date for a trademark application is entitled to have the trademark registered. In these countries, it is especially important to keep your priority date to minimise your chances of losing your right to obtain protection. If you haven't made an Australian trademark application, you should make an overseas application before commencing trading in that country.

DESIGNS

Australia is a party to the Paris Convention, as are over 100 countries. Under the terms of this Convention, it is possible to claim priority from your Australian design application up to 6 months after filing your Australian application.

If you have questions about any of the above matters, or you would like more information, please do not hesitate to contact us.