

PATIENCE, PLANNING AND THE WONDERFUL WORLD OF PATENTS

By Leanne Jezercic, Solicitor

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Let's imagine that you work client-side or agency-side on a large multinational brand, and your team comes up with a fantastic idea for a game-changing new smartphone app. It is novel, engaging, and should add considerable value to the brand's marketing mix. The senior brand managers love it, and the tech guys confirm it can be done – maybe they have even done most of the coding.

At this point, so many of our clients who are new to this area make the same critical strategic misstep. While our clients will wisely come to us and ask for trade mark, copyright or perhaps contractual advice about the app, they will also have already set up a launch microsite, issued a PR release, organised media coverage, and rolled through other steps of the marketing plan. In doing so, they may very well have cost themselves the chance to protect their new invention via patent registration, and that could be very costly in the long term.

Below we introduce you to the wonderful world of patents, and the strategies you need to be aware of when inventing new products, whether smartphone apps, wearable devices or anything else.

What exactly is a patent?

Patents are a way of protecting inventions and are a form of intellectual property, like trade marks, copyright works and designs. Essentially, through a patent registration, you obtain the monopolistic right to exploit your invention by excluding others from making, using or selling your invention from the day the patent is filed, and for a maximum period of between 8 or 20 years, depending on the type of patent. Like trade marks and designs, there are registers for patents that can be searched to ensure your invention doesn't already exist, in Australia and throughout the world.

Does your invention qualify for a patent?

Unlike other forms of intellectual property, one of the basic pre-requisites for patentability is that an invention must be **novel** (i.e. new) when filing a patent application. An invention is not considered new if it was known to the public before you filed the patent application, or if it is already registered by someone else. This is why it can be such a huge strategic misstep if you advertise your new app and launch it to the world before considering patentability. Firstly, it may prevent you from obtaining registration, but you may also be infringing on somebody else's patent.

The novelty requirement makes a lot of sense, as it prevents a company today from being granted a patent to a telephone for instance, given that Bell first exhibited a working device in 1876.

Assuming the new app in our example above is novel, the good news is that all is not lost for our creative team that jumped the gun and failed to file a patent application before publically disclosing the invention (at least in several countries). The patent laws of Australia, the United States and Canada for example provide a statutory 12 month "grace period" in which to file a patent application. Under these provisions so long as a patent application is filed within 12 months of the disclosure, that disclosure cannot be used to undermine the novelty of the invention.

Some countries have variations on basic grace period provisions. For example, under Chinese law a grace period may be allowed where it can be shown that the invention was disclosed without the authority of the patent applicant. Otherwise, while the grace period can protect you in those countries that have one, it does not apply in other countries, and this can be a big problem if you have global aspirations for your invention.

The test for novelty is decided against any and all prior disclosures across the world. If you disclose the invention – such as through documents, press coverage, a website, demonstration, or through sale or sample of the product – the invention could fail to be novel and fail to secure a patent on this basis, whether in Australia or in any other countries with similar patent systems.

As a result of all of the above, **it is incredibly important that inventors do not disclose their creations before filing a provisional patent application.** This is where patience and planning comes into play because it is necessary to keep an invention under wraps and protected by appropriate confidentiality obligations until a patent application is filed. This runs counter to the creative and commercial process a lot of the time, so it is a tough fit for the advertising and marketing industries in particular.

A grace period provision should never be relied upon in any patent filing strategy, even just for the reason that many countries have no such provision. The gold standard is to always file a patent application before any public disclosure of an invention. In any event, an experienced patent attorney, like our expert patent agents, with a sound knowledge of Australian and international grace period laws should be consulted to clarify the law in any countries of interest, and to conduct a novelty search before exploitation.

What should you plan for?

We strongly recommend you consider a couple of things that you can do to plan for a patent and safeguard novelty, if you are pitching a new invention or are in the midst of creating one:

1. **Conduct a patent novelty search first:** As stated above, a comprehensive patent search can help identify whether your invention has been done before or whether there is any potentially problematic prior inventions that need to be considered and designed around. Getting the heads up at an early stage in the process means that you can potentially plan or design around existing inventions or technologies that could present an obstacle to registration or alternatively, avoid wasting large amounts of time and money on an invention that has already been 'done' (and consequently avoid a potential patent infringement).
2. **Safeguard against disclosures:** It is important to ensure that you protect your invention from disclosure and ensure that any information relating to it is clearly understood by anyone in contact with the invention, such as employees, partners, investors etc. to be confidential. That means the website, press release and public announcements are off the table until the patent application is filed. Obviously it is going to be necessary to talk about the invention within your team and at times, externally, so non-disclosure does not mean everyone is sworn to silence. Rather, the information about the invention must be kept confidential and not able to 'leave the room', so to speak. Legal advice should be obtained if there are circumstances where you feel you must disclose the invention, or before approaching any external party or the public regarding the invention, as there are some very limited exceptions to the rule and it can be very easy to get this process wrong and inadvertently expose yourself to risk.

Contact us

If you would like further information on patents or confidentiality, please contact one of our experts below. When you are ready to conduct a novelty search or file a patent application,

Anisimoff Legal can manage this process for you with our trusted and highly commercial patent attorneys ready to assist you with comprehensive patent searches and patent applications.

Leanne Montibeler

+61 2 8935 8805

leanne@anisimoff.com.au



www.anisimoff.com.au



<https://www.facebook.com/AnisimoffLegal>

Clint Fillipou

+61 3 9907 4302

clint.fillipou@anisimoff.com.au



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