FAQ'S

Why obtain patent protection?

Patent protection can give you a 20 year monopoly to make, sell, use or otherwise trade in the claimed invention. The obvious benefit behind this is that it gives the patent owner a competitive advantage in the marketplace.

Even in cases where the patent owner is not marketing the invention themselves, patents have commercial importance. A patent is viewed as intangible property that has a value and can be traded. Patent owners can license the invention of the patent to generate an income for themselves, or they can sell the patent and assign their rights to a third party.

A patent is also viewed as an asset that adds value to a business.

Do I need to keep my idea confidential?

It is very important that you keep your invention secret or at least confidential before filing a patent application and even after filing where possible. While there are some exceptions to this rule, you should be prudent and seek advice from an attorney before you disclose your invention to third parties and certainly before you offer your invention for sale to anyone.

When disclosing your invention to others you should make it clear that your disclosure is made in confidence. The best way for you to prove that you have done this is to get the recipient to sign a confidentiality agreement. If you want to sell the invention you should always indicate that you are disclosing it to the recipient so they can "assess the merits of the invention". Do not negotiate until you have a patent in place.

Pipers Tip – We can provide you with confidentiality agreements if you need to disclose your invention to others before filing a patent application. This might occur where you want someone to assess the merits of your invention or provide input on the manufacture or marketing of the invention.

Is my idea suitable for patent protection?

This can be a complex issue and as technology changes, the rules regarding what is patentable change. To add to this complexity is the fact that the rules differ between countries.

Generally speaking, to be patentable an idea must be new which means that it should not have been used or published anywhere in the world. It should also be inventive and useful and fit within the legal definition of an "invention" as defined in legislation and case law for that country.

Currently, in New Zealand it is possible to patent products and processes that are useful. Specifically excluded in New Zealand are: mere discoveries, presentation of information with no mechanical purpose, mathematical formulae, mere schemes or plans, combinations of known things that do not produce a working interrelation or synergism, business methods with no technical solution or technical advantage and methods of medical treatment of humans.

It is best to talk to an attorney to see if your idea is suitable for patent protection or whether there is some other option for protection available to you. For example, trade mark protection is available to those wanting to protect their brand. Design registration is available for aesthetically pleasing articles that are to be made on more of a commercial scale. Copyright can be used to protect artistic works.

When should I apply for a patent?

From a legal point of view, the sooner you apply for a patent the better as this reduces the chances of someone else beating you to it. Many people sit on good ideas and by the time they decide to do something with their idea it is too late. The other advantage in getting a patent application filed is that you can disclose and market your invention more freely without the fear of rendering any subsequent patent registration you have in place invalid on the grounds that you made it public knowledge before you filed a patent application.

However, prudence in filing needs to be balanced with commercial reality. If you file firstly with what is known as a provisional specification you need not know the final version of your invention at the time of filing, but you will need to have a pretty good idea on what the essential integers of your invention are. Once the first application is filed with a provisional specification you set a 12 month deadline in place for finalizing your invention to enable the second step of filing a complete specification to be taken. This means that if you file too soon you may not developed your idea enough to meet this deadline.

We emphasize that you should **always** have a patent application in place before you make your invention known to others. You should contact an attorney during development of your idea and certainly before testing and/or commercialization of your invention. Disclosure of your invention to an attorney is by its nature confidential.

Do I need to file overseas?

It is generally recommended that you at least file applications in countries where you would like to trade. If you are seeking patent protection for the purpose of selling your invention then you might consider extending your coverage further so that you are more likely to cover the territory of interest to any future licencee or purchaser of your patent. It is also possible to file an International PCT application. Please contact an attorney to discuss the options available to you and provide you with price estimates.

How long is the term of a patent?

In most countries the term of a standard patent is 20 years. This term can be extended in the case of pharmaceutical patents in some countries if certain conditions are met. Countries have different types of patents other than a standard patent and these can have different terms. For example, in Australia an innovation patent can be obtain for a term of 8 years

Do I really need an attorney?

Yes. If your invention is worth protecting then it is crucial that the specification describing and claiming be drafted by a skilled attorney. If this step is missed out then you may not obtain a valid patent or you might end up with a patent that is so narrow that it is not worthwhile.

What information do I need to supply my attorney?

We recommend completing one of our **New Client Forms** which outlines all the information we need to best help you.

We need information on the invention which includes details on your preferred embodiment of the invention but also information on what variations that can be made to the invention. If you have information in the form of studies or trials on the invention please supply those. Drawings are also very helpful.

We also need information on who the inventors are. An inventor has to be someone who has made a worthwhile contribution to the invention. The person who came up with the general concept by identifying the need for the invention will be an inventor as well as those who develop the invention from a concept to something more. Those who are merely performing their duties and operating under instruction are less likely to be considered "inventors". However, a person who simply stated the problem is usually not an inventor.

We need to know who the applicant (the owner) will be. The applicant can be a person or a corporate entity but not an unincorporated trust such as a family trust. In such a case, the applicant can be the trustees.

Is it expensive?

The first step in the process will typically involve filing a provisional application and performing an optional (but recommended) search. This important first step can usually be completed without any significant financial burden. However, within twelve months of filing this application you will need to decide on whether you want to continue with the process by completing your application in New Zealand by filing an Complete-After-Provisional Application and/or filing applications overseas. It is at this point that the costs involved get higher.

Accordingly, you might consider obtaining protection for ideas that will have some real financial return when they reach the marketplace.

Many inventors consider obtaining a government grant or look to private industry investors to fund legal fees, R&D and marketing costs. Some inventors elect to sell their IP in the early stages of development if they have an interested party.

What is the procedure for obtaining registration?

The process for obtaining registration generally involves the steps of filing the application, examination of the application by the appropriate government/regional office, then acceptance and registration if the examiner is satisfied that the application meets all of the legal requirements.

However, we recommend conducting a search of the marketplace and of certain patent registers prior to filing and application to assess whether you invention is already known. This reduces the risk of you wasting your time and money pursuing registration. Your application can also be challenged after acceptance and/or registration but this is not common.

Can my patent application or registered patent be challenged?

Yes it can be. Your application can be challenged if an interested party notifies the Patent Office that it wants to oppose your application within three months of the application being published for acceptance.

After the application is accepted it is possible to file a belated opposition within 12 months of the patent being sealed. Oppositions are heard before the Hearings Office at the Intellectual Property Office of New Zealand.

During the term of the patent, a third party can attempt to revoke your patent. This is heard before the High Court of New Zealand.

Opposition and revocation cases are not particularly common. In most disputes some form of settlement occurs before the parties end up in Court.

Can I sell or licence my patent?

Yes you can. You patent rights are a form of property called "intangible property" and can be used or traded with like many other forms of property.

An interested party will normally perform some form of due diligence on the patent so it is important that the patent specification is drafted correctly.

Can I challenge someone else's patent?

Yes you can. You need to be an interested party in a legal sense and have a good reason for challenging it. There are many different grounds you can use to do this. For example you might challenge it on the grounds that it was already publicly known at the time the first application was filed (the priority date).

What should I do if my patent is infringed?

Contact your attorney. You will need to supply them with the details of the alleged infringement. Your attorney can advice whether in their opinion there is a case for infringement and also help get you patent and case in order before you approach the alleged infringer.

Usually a letter is sent out to the alleged infringer making them aware of your patent and requesting information on their activities for the purpose of assessing the level of damages sought. Most cases are negotiated and settled at this earlier stage. Some cases progress to Court where there is a real dispute and the parties are prepared to commit to the expense and stress involved.