

The right resulting from a patent

The owner of a patent has the exclusive right of making, constructing, using and selling the invention in the country where the patent is granted. This right however does not allow infringing the rights that others may have. The term of a patent is generally 20 years. When the patent expires, the exclusive right ceases and the invention becomes part of the public domain.

The form of a patent

A patent takes the form of a document which fully discloses the invention and defines its essential elements, scope and limits, in compliance with the laws, regulations and other requirements varying from country to country. All information to implement and operate the invention must be disclosed.

Patentability criteria

An idea, a mere concept or a discovery is not patentable. Patentability of an invention involves issues of subject matter, utility, novelty and non-obviousness. Some subject matter are generally excluded, such as scientific principles, medical treatment methods, professional skills, mathematical computations and higher life forms. Utility often means that an invention is functional and reproducible. Novelty and non-obviousness apply on a worldwide scale and depend on the law and case law of each country.

Ownership

Only the inventors of an invention or their rightful owner(s) may legitimately obtain patents for the invention.

Steps

Patents are issued by national or regional patent Offices. Obtaining patents in different countries involves drafting patent applications satisfying the requirements of form, language and content typical to each country, filing the patent applications at the respective patent Offices for the elected countries, and prosecuting the applications until issuance of the patents.

Before initiating those steps, a preliminary patentability search is recommended. Such a search allows finding potentially relevant prior art documents which may impact the patentability of the invention. It may also help drafting a better patent application.

Prosecuting an application means that once the application is filed, an examiner eventually checks if it satisfies the applicable formal requirements and that the claimed invention is patentable. If the examiner considers

that the application contains formal defects or that the claimed invention is not patentable, then an office action reporting each ground of objections or rejections is issued. The applicant then has a limited time period for preparing and filing a written response addressing all objections and rejections raised by the examiner. Legally allowed modifications (in the form of an amendment) to the application may be made, and arguments in rebuttal to the examiner's objections or rejections may be submitted. The application is deemed to be abandoned if no response is filed in time. Subsequent to a response, the examiner may issue a new office action if the application is still deemed to be unallowable. Such a new office action may be made final, which means that special steps must be taken for further examination of the application or appeal to a board or a court. If the application is allowed, an official fee must be paid for issuance of the patent.

Filing strategies

In many countries, a patent application must be filed prior to public disclosure of the invention. Canada, USA and some other countries grant a one-year grace period once an invention is publicly disclosed to file an application. Some patent Conventions and Treaties provide strategic options for filing and obtaining patents when multiple countries are targeted. The Paris Convention allows an applicant to file a first patent application in a signatory country and provides 12 months thereafter to file patent applications relating to the same invention in other signatory countries under priority of the first application. The Patent Cooperation Treaty (PCT) allows an applicant to file a single application before a national patent Office which is a member of the PCT. Such a so-called "international" application has the same effect as if applications had been filed in all the designated states or countries which are members of the PCT. At the end of the PCT procedures, national or regional steps must be taken wherever the invention is to be patented.

Costs and time to get a patent

The steps to obtain a patent involves costs for our services (service fees), possible foreign agent costs, and official fees to be paid.

Carrying out a patentability search and providing an opinion may take around 4 weeks, and costs of 3 500 \$ or more are to be expected for this step, depending on the field of the invention and the number of potentially relevant documents to be analyzed.

Drafting a patent application may take around 2 months (or more especially if done by iterations and additional information regarding the invention is provided in the meantime). Costs from 8 000 to 15 000 \$ are to be expected depending on the invention, the number of figures required to illustrate it, the extent of the text to

describe it, and the number of claims to be drawn up to appropriately protect it. Costs may be higher for a highly technical or complex invention, .

The costs for filing patent applications fairly vary from country to country. In Canada, the minimum costs to be expected for the filing of an application are around 1 500 \$ while the costs amount to around 4 000 \$ or more for a US or a PCT application. Translation costs also apply for countries where the application as drafted is not in an accepted language.

The costs to be expected for prosecution of the applications also fairly vary from country to country, in particular depending on the work required to respond to office actions which are almost always issued, until the applications are allowed and the official fees are paid for issuance of the patents. The costs per office action, for preparing and filing an appropriate response, may amount to 2 000 \$ in Canada, and 5 000 \$ in the United States. Extra costs should be expected in many countries where the number of claims in an application is taken into account.

Prosecution of a patent application may spread out over several years, and a patent is rarely obtained in less than two years and without having to work hard to get it.

Costs for maintaining the applications and patents in force must also be considered. These costs and when they are due vary from country to country, and generally increase through time, sometimes a lot.

All of the above-mentioned deadlines and costs may be lower or higher depending on the case. In any cases, we do not act without your informed consent.

Infringement

A patentee can sue infringers and claim damages from the time the patent is issued. The patentee may also claim reasonable compensation for acts of infringement that may have been committed while the application was pending and published (usually 18 months from the filing or priority date).

Informal or provisional applications

Some countries, such as Canada and the United States, allow the filing of a first patent application without having to satisfy all the requirements of form and content of a regular application. It may be tempting for some inventors to proceed on their own or with the assistance of unaccredited individuals or organizations to file such an application. It is important to note that the risks of losing the right to patent the invention with this type of application are high, and that the subsequent steps, when possible, are likely to entail high costs.

Advices

If you are not already initiated into the world of patents or if you are not already one of our clients, a first consultation with us is essential. We can then answer your questions and provide you with useful information before going any further. Consultation costs are to be expected.

Thereafter, whatever the steps to be carried out, responding to us as quickly as possible and providing us with the information requested and your instructions to proceed will allow us to offer you optimal services at optimal costs.

Notice

The foregoing information is of a general nature and is provided for informational purposes only. The information does not constitute legal advice and may not be applicable in certain situations and jurisdictions. Do not hesitate to consult us for more information in this matter.