GOWLING WLG

PATENT FAQS FOR CANADIAN SMES

FROM IDEA TO PATENT: Frequently asked questions among Canadian SMEs looking to protect their inventions.

A patent is a right of exclusivity for an invention granted in exchange for a public description of how to make and use the invention. A patent is a "right of exclusivity" because it grants the patentee the right to stop others from making, using or selling the patented invention.

To obtain a patent, a patent examiner needs to be convinced that an invention is new, non-obvious, useful, and in keeping with eligible subject matter.

- "New" means no one else has done the exact same thing.
- "Inventive" means that even if no one else has done the exact same thing, the difference between the invention and what everyone else has done is large enough to justify being awarded a patent.
- "Useful" just means that the invention does what the description outlines; it does not mean the invention has to be commercially useful.
- "Eligible subject matter" means that regardless of whether an invention satisfies the above requirements, it needs to be the right kind of innovation to even qualify for patent protection. Typically this is an issue only for certain types of inventions, such as computer-implemented inventions.

1 PATENTS VS COPYRIGHT VS TRADE SECRET – WHY ARE PATENTS NECESSARY?

Patents, copyright, and trade secret law are all different legal rights and they provide different types of protection.

Neither copyright nor trade secret law would provide protection if a competitor were to independently recreate the same invention and then start using it.

If an invention (when commercialized) could be reverse engineered by a competitor, as a general rule copyright and trade secret law would permit that competitor to reverse engineer the invention and then use it.

Patents can apply even if a competitor independently recreates an invention, and even if a competitor is able to reverse engineer an invention. In other words, patents, copyright, and trade secret law represent different rights that can be "stacked" to protect the same underlying technology in different ways.

2 WHAT IS A PROVISIONAL APPLICATION VS A NON-PROVISIONAL PATENT APPLICATION?

A provisional patent application is not examined by a patent examiner. Consequently, it will never grant as a patent. A non-provisional patent application eventually gets examined and, generally speaking, may consequently grant as a patent.

Because a provisional application is never examined, it is cheaper to file and, in some cases, to draft than a non-provisional application.

This is important because in order to receive a patent, an examiner needs to be convinced that the invention is new and non-obvious relative to everything that came before it. The natural question to ask, then, is new and non-obvious relative to when? The answer is relative to the filing date of the patent application. A provisional patent application is therefore a relatively inexpensive way to secure a filing date. After filing a provisional application, as a general rule, SMEs have one year to decide whether they want to convert it into a non-provisional application, which will eventually get examined.

3 WHY IS IT NECESSARY TO INCLUDE TECHNICAL DETAIL WHEN DESCRIBING AN INVENTION TO A PATENT PROFESSIONAL?

Technical detail is important for three reasons:

1. A patent needs to describe the invention in enough detail to let a typical person in the field make and use the invention after reading the patent. This is often referred to as providing an "enabling disclosure." Including technical detail helps satisfy this requirement.

2. An invention needs to be directed at eligible subject matter. Including technical detail can help satisfy this requirement, too.

3. An invention has to be non-obvious relative to everything that came before it. Including technical detail can help when trying to convince a patent examiner that the invention in fact is non-obvious, and may serve as basis for an amendment to the application to overcome an obviousness rejection.

4 WHO SHOULD BE NAMED AS AN INVENTOR?

Inventorship is defined as any person who helped conceive of the invention. It is not someone who only helped test the invention in response to someone's instructions to see if it works.

While an SME may have in mind a list of inventors at the time they contact us for help that would only be a draft list. Once a patent application is drafted, and once a patent actually is allowed, the list of inventors should be reviewed to ensure it remains accurate in view of how the application is eventually drafted or how it may be amended after filing.

5 IS THERE ANY HARM TO PUBLICLY DISCLOSING AN INVENTION AFTER AN SME FILES A PATENT APPLICATION FOR IT?

Potentially, yes. This is because even after a patent application is filed, it typically remains confidential for 18 months and is still protected by trade secret law. In other words, trade secret law and patent law provide concurrent protection for the invention during this period. By publicly disclosing the invention, even if an SME is not prejudicing the patent rights, they might be forfeiting the protection offered by trade secret law.

6 WHAT PROTECTION DOES "PATENT PENDING" OFFER?

A lawsuit for patent infringement can be started only after a patent grants. Consequently, labelling a product "patent pending" does not offer any legal protection. However, it may be practically useful to dissuade competitors from copying the invention because they will be aware that a patent may issue for it.

7 WHAT ARE THE DIFFERENT STAGES OF A PATENT APPLICATION?

Once a non-provisional patent application is filed, it will eventually be examined. Examination almost always results in one or more rejections from a patent examiner, with each rejection being informally called an "Office Action." In response to each Office Action, an SME has the opportunity to argue the examiner's rejection is wrong and/or amend the application to overcome the rejection, so long as the amendments do not add anything new to the patent application. For any patent application, there may be several Office Actions, and consequently several rounds of back and forth with the examiner.

If the examiner cannot be persuaded to grant the patent, SMEs typically have two choices: abandon the application, or appeal the examiner's rejections. Appeals happen in a minority of cases.

Eventually, if the examiner is persuaded by the Office Action responses, or if on appeal an examiner's rejections are overturned, the patent office will issue a notice of allowance. In response, an SME pays a grant fee and the patent grants.

8 WHAT ARE THE NEXT STEPS IN THE PATENT PROCESS AFTER THE APPLICATION IS FILED?

If an SME starts with filing a provisional patent application, within a year they will need to decide whether to convert the provisional application into a non-provisional application. If an SME chooses to proceed, we will ask whether there is any new subject matter to be added to the provisional patent application (e.g., improvements or test results) before converting it into a non-provisional patent application. If there is new matter to be added, typically we would ask an SME to provide that new subject matter in written form, and to review the updated application once it's ready.

After the non-provisional application is filed, it will eventually be examined. During examination, a patent examiner usually advances technical arguments as to why the invention isn't new or non-obvious in view of publications dated before the filing date, such as earlier filed patent applications or journal articles (these publications are known as "prior art"). We may ask for help in interpreting the prior art, and sharing whether any amendments that might overcome the rejection make commercial sense.

And if an SME becomes aware of any prior art that may be relevant to the patentability of the invention at any time after the application is filed and before it grants, they need to tell us as there is a requirement in the U.S. to disclose a list of that prior art to the patent office.

ABOUT GOWLING WLG'S IP GROUP

For more than century, SMEs around the world have looked to Gowling WLG to maximize and protect their treasured intangible assets. As the global economy grows ever more knowledge-driven, clients continue to count on our broad experience to help them navigate an increasingly perilous intellectual property landscape.

Our patent professionals can help SMEs protect their inventions by

- advising on which innovations to patent, and what kind of patent applications to file to help those SMEs achieve their business goals;
- drafting and filing patent applications around the world;
- liaising with patent examiners around the world to get those patent applications granted as patents;
- providing advice and documents to help turn patents into money, such as through licensing or during a round of financing.

GOWLING WLG PATENT TOOLKIT

Gowling WLG has prepared a step-by-step guide designed to help Canadian SMEs understand the patent process. Download our Patent Toolkit today here.