

# BRIEFING: “Keep off the grass” patent strategies

In many situations, businesses have great ideas with huge commercial potential. However, not all ideas can be protected using patents, in particular, ideas relating to certain types of digital or creative technology, certain web-based technology, or ideas relating to new ways of doing business. Even though such ideas may be inherently patentable, there may, nevertheless, be good reasons for applying for patent protection, to deter would-be competitors and to create uncertainty.

UK and European patent law bars inventions that relate, at their core, to abstract ideas, such as business methods, games, software, mental acts, artistic creations, etc. It should be noted, however, that the patentability bars differ from country to country, so whilst an idea may be unpatentable in the UK or Europe, this does not necessarily rule-out obtaining a patent in other countries, most notably, the US and Japan. In addition, whilst the UKIPO and EPO have very similar patentability requirements, the *implementation* of the UK Patents Act is somewhat different to the corresponding European Patent Convention, making it possible, in certain circumstances, for an application to be refused in the UK, but for an *identical* European application to be allowable: a European patent being legally enforceable in the UK in exactly the same way as a “direct” UK patent. As such, even though the grant of a UK or European patent may be precluded, there may be scope for obtaining patents that are legally enforceable in other countries or via different routes.

As such, it is sometimes possible that an invention may be inherently unpatentable, in other words, the prospects of prosecuting the application to grant in a commercially useful form, are slim. So, what should the Applicant do if/when such a situation arises?

The first thing to note is the fact that when a patent application has been filed, the applicant is able, and indeed recommended, to market the product to which the application relates as a “patent pending” product. This alone can provide a useful commercial advantage because it may deter would-be copiers from copying the technology concerned for fear that the application may grant, and their activities could be deemed to infringe.

Once filed, it is possible to keep a UK patent application pending for up to 4 ½ years from its filing date, provided all the necessary steps are taken to keep the application “alive”, that is to say, the Examination fees are paid, responses are timely filed, and so forth. As such a UK patent application can remain “pending” until it reaches the 4 ½ year cut-off.

Whilst a merely pending patent application does not confer any right on the Applicant to sue for infringement, the publication of an application confers “provisional protection” as of its publication date. The provisional protection effectively allows patentees to make a backdated claim for damages should the patent eventually grant, and be infringed. As a competitor wishing to copy a “patent pending” technology, this muddies the waters considerably because until such time as the application is either granted or refused, its scope is uncertain (the Applicant is allowed to amend the scope of his claims, within the ambit of the application as filed, until such time as it is granted or refused), which prevents the competitor from obtaining any degree of certainty about his/her potential liability for infringement. Indeed, it is a well-known strategy to keep at least one patent

application pending precisely so that it can be amended to cover what competitors are doing. This is often achieved by obtaining a granted patent of a certain scope, but filing an identical, "divisional" application that is kept pending for as long as possible.

If you put yourself in the shoes of a competitor wanting to go to market with a potentially infringing product, you quickly realise the value of an "uncertain" patent application. At the very least, the competitor will need to spend a significant amount of money seeking a patent attorney's and/or counsel's opinion on the likelihood of 1) a patent ever granting in a valid and enforceable state, and 2) infringement should the application ever mature into a granted patent. Even so, the competitor will have no way to be *certain* whether what he/she plans to do may land him/her in hot water at a later date!

With that in mind, you can easily see the benefit of keeping a patent application pending for as long as possible. A good way to extend the period of uncertainty is to file an international patent application under the Patent Cooperation Treaty (PCT). A PCT application is essentially a single patent application that is equivalent to a bundle of national applications in over 140 countries. By default, the PCT application "buys time" because it remains pending for 30+ months (depending on the countries concerned). At the 30-month stage, one has the option to convert the PCT application into a bundle of national/regional applications, which can themselves also be kept "pending" for several years.

The prosecution of a European patents can be quite slow, sometimes taking from 4-10 years to mature into a granted patent. As such, by entering the European regional phase of the PCT at the 31-month stage, you can effectively "buy" patent pending status for a number of additional years (see illustration, right).

All the time that there is a pending application in place, the Applicant can create uncertainty in the marketplace, which may be all that is needed to gain a competitive edge by being first-to-market. Moreover, it may be possible to obtain a granted patent in certain countries thereby securing legally enforceable rights.

This briefing paper is for information only and is intended to provide a basic overview of some of the procedures and options available. It is not legal advice, and should not be relied upon as such because the facts of each specific case will determine what is possible and where. For more information, please contact us.

