

PROTECTING AN INVENTION

Basic Information

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Inventive idea

Before investing time and money in an invention, you should check that nothing of the kind already exists.

Searching on your own

- What is being marketed?
- Has the idea or a similar idea already formed the subject matter of an application for a protective right (patent, utility model)? This can be checked in the Public Library of the German Patent Office, in a Patent Information Center (addresses and telephone numbers in the appendix) or in internet (see appendix), although not exhaustively.
- Have other publications (technical literature) disclosed the idea?

Keeping the invention secret

It is a basic rule not to disclose an invention **before** an application for a patent has been filed. When an invention is made public prior to such an application it will form part of the prior art and will no longer be patentable. Utility model protection is still possible up to half a year following publication by the inventor. However, this can become problematic should someone else manufacture a similar product or file an application therefore during this period and maintain that his efforts were not based on the information provided by the first inventor. This policy is therefore not usually recommendable.

However, persons who have committed themselves to secrecy can at all times be notified, a patent attorney being automatically bound to secrecy by his professional status.

Decisions to be made concerning application

Do you intend to file the application yourself?

Theoretically, you can approach the German Patent Office and file an application for a patent or utility model yourself. **However, drafting the application requires a lot of experience usually only possessed by a patent attorney.** If you would nevertheless like to try this option or if you want to know more before approaching a patent attorney, I would refer you to the brochure issued by the German Patent Office, obtainable from the Information Office stated in the appendix.

A decision to file an application without the assistance of a patent attorney would be the right thing to do when there are initially insufficient funds to finance an application drafted by a patent attorney. Then the first application (not including a request for examination) will serve to establish the date of application, whilst providing the opportunity to find a licensee who can provide the funds for subjecting the matter to thorough elaboration by a patent attorney, who will then file a subsequent application. But in this case, the formulation of your initial application will still be decisive in determining the scope of subsequent protection.

If you intend to draft and file an application yourself, I would advise you to request a search. The costs incurred will then involve a filing fee of 60 € and a search fee of 250 €. About 8 months thereafter you will receive a search report. When you later

commission a patent attorney to file the subsequent application, he will then be in possession of the relevant prior art and will be able to judge whether an application would be feasible and what might be claimed. However, you should approach him before 9 to 10 months have elapsed since the filing date of your application to give him plenty of time prior to the 12 months' deadline, after which **all further chances are lost!!!**

Do you intend to commission a patent attorney?

It is recommended to have the application filed by a patent attorney whenever an invention is to be exploited economically, since **the application documents are of substantial significance in determining the chances of obtaining a grant and the subsequent scope of protection, and the observance of relevant legal factors must be monitored by a patent attorney.** You would surely want a house in which you wish to live permanently and safely to be designed and built by an expert; but not so a summer house, which poses fewer problems.

The present information supplies only a brief outline of the matters to be observed in order to give you an overview of the subject without going into great detail.

The application documents

The invention must be disclosed in its entirety. This not only means that an embodiment must be described in a manner comprehensible to a person skilled in the art but also that additional embodiments must be covered and – of primary importance – that the fundamental idea underlying the invention must be clearly revealed.

An application basically consists of the components described below:

Patent claims

The way the patent claims are formulated defines the scope of the consequent patent. This means that the basic main claim (usually claim 1) must be formulated as broadly as possible so as to cover all possible embodiments but should on the other hand be sufficiently specific to provide a clear definition of the invention that can form the basis for search. This claim 1 can be followed by dependent sub-claims that define the various embodiments. In addition, coordinated claims not dependent on this claim 1 are possible when they are inventive and solve the same problem. The names of structural elements should be followed by reference signs (in brackets) taken from the drawing(s) if the claims are device claims or refer to a process or material which can likewise be illustrated by a drawing.

Description

Starting from a description of the background of the invention and the newest known prior art, a problem based thereon will be described that is solved by the features of claim 1. This is followed by a substantially complete enumeration of the advantages gained by the invention as defined in claim 1 and a description of the embodiments claimed in the sub-claims with their further advantages.

Drawing(s)

If the invention can be illustrated graphically (even if it is a process or a substance), a drawing or drawings will be attached to the application. The drawing(s) may comprise a number of figures, which must be provided with reference signs. These figures will be described following the aforementioned descriptions, in which case the reference signs will be placed after the names of the individual elements. This description should be detailed and complete as regards both the individual elements and the function thereof.

Commissioning a patent attorney

Saving costs with your own preparatory work

It is usually the expense that keeps people from approaching a patent attorney. However, you can reduce this by doing some preparatory work yourself.

Prior art

A first effective step would be for you do research on whether the invented item or similar items already exist. Examine brochures and other publications. You can carry out a search yourself in patent databases (e.g. www.depatistnet.de). This will save you from spending money unnecessarily if your invention should prove not to be novel.

Bring the attorney as much material as possible relating to the pertinent prior art in the form of published German applications (Offenlegungsschriften), patent specifications, utility models, company brochures, professional journals, technical literature, *etc.*.

Drawing(s) and description

The invention should be described and illustrated graphically, if possible, giving coverage of various embodiments. If there is a model, this should also be made available.

Advantages

Make a list of all the advantages gained by the invention, particularly those which distinguish the invention over and above the prior art.

Supplying the attorney with full information to avoid a subsequent application

You should ensure that the patent attorney is fully informed, as only then he can effect complete disclosure. **The disclosure made by an application cannot be altered once the application has been filed at the Patent Office.** Supplementary information can only be filed in the form of a subsequent application involving further expense (see “subsequent application” below).

Search by an expert

It is usually advisable to let an expert carry out a search before drafting an application. The advantage of this is that the chances of obtaining a patent grant can be assessed in advance. This saves unnecessary expenditure in respect of the patent application and also regarding the risk of a third party asserting their protective rights against your product. The search report is available relatively quickly (in from 1 to 3 weeks). The net costs incurred for simple objects are approximately 1.000 to 1.500 €, whilst they are higher for complicated objects or for a search across several technical fields or in foreign patent literature. These costs cover preparatory work on the part of the patent attorney, including the formulation of the object to be searched for, the actual search itself (by a searcher), and the evaluation of the found prior art by the patent attorney, who will then be able to form an opinion on the patentability of the object as well as to draw attention to conflicting prior rights.

Costs

What will an application cost?

This is one of the most frequently asked questions but one that is incapable of being answered by normal calculation. It is comparable to the question: “What does an automobile cost?” to which one might answer: “Automobiles usually cost between 10.000 and 50.000 € depending on size, make, model, possible discounts, the retailer involved, *etc.*” A more precise statement is not possible, as anyone will agree.

Attorney's fees

The same applies to the cost of a patent application, since patent attorneys, although usually demanding fixed sums for the power of attorney and for clearly defined

actions, account their charges for detailed work on the basis of work expenditure. This may vary considerably. In our professional experience the time required to work on an application has ranged, for example, from two hours to two weeks, up to three working days being necessary for most applications. (Our current net hourly rate is 250 €.)

Official fees

The only fixed costs are those officially charged by the German Patent Office:

Application fee for a utility model:	40 €
Application fee for a patent:	
- up to and including 10 claims	60 €
- for each additional claim	30 €
Request for examination of the patent application: (search and examination proceedings)	350 €
Search request (only search without examination)	250 €

Total cost of an application

With respect to the total costs of an application in Germany (not including the granting procedure) it is only possible to give a rough guide, as in the case of an automobile, to the effect that the majority of applications cost from 2.500 to 7.000 €. Applications demanding extremely high effort can, of course, be more expensive, just as there are automobiles that cost more than 50.000 €.

Cost of the granting procedure

For more information on these expenses see our information notes entitled “Costs and Time Line for Obtaining a German Patent” which you can download from our homepage at www.rpws.de.

Should you apply for a patent or a utility model?

The answer depends on the **subject matter of the application** and the **interests of the applicant**. The various official fees are listed above. From the point of view of the patent attorney, there is no grave difference between drafting an application for a patent and formulating an application for a utility model, as far as the work required is concerned.

Differences

The essential differences are to be found in the examination procedure for the application and in the lifetime of the resultant patent or utility model, as set out in the following sections. Another difference is that technical processes can only be protected by a patent and not by a utility model.

Examination

A **utility model is only examined for formal deficiencies** and is then registered. If it is later found, on account of conflicting prior art, that the utility model does not satisfy the conditions for protectability (novelty, inventive step), the utility model protection will be regarded as having been invalid from the outset. **A warning based on such an apparent protective right could then lead to claims for indemnification!**

In the case of a **patent application**, however, a **request for examination** can be filed. This can be done immediately or up to seven years from the filing date of the

application. If this does not happen within said seven year period, the application will be regarded as having been withdrawn. On receiving the request for examination, the Patent Office will start the procedure for granting a patent, during which the application will be examined for novelty and inventiveness.

<i>Lifetime</i>	The maximum lifetimes are as follows: Patent: 20 years Utility model: 10 years.
<i>Publication by the inventor</i>	In the case of publication by the inventor, a utility model application filed up to six months later can still acquire protection, since a six months' period of grace is applicable here.
<i>Inventiveness or inventive step</i>	The inventive step required for a utility model is usually subject to equal demands than the inventiveness forming a prerequisite for a patent.
<i>Economical exploitation</i>	A granted patent is taken much more seriously by competitors as well as by potential licensees than a utility model or an unexamined patent application. Potential licensees often enquire about the state of the granting procedure and the chances of a patent grant.
<i>Costs</i>	Since no granting procedure is carried out for a utility model, the expenses incurred are lower. The total costs usually range from 2.000 to 3.500 €, the reason for this being that utility model applications are usually filed for objects of a simpler nature. No expenses arise for a granting procedure. These can be considerable (see my information notes entitled "Costs and Time Line for Obtaining a German Patent").

Procedure for granting a patent at the German Patent Office

Office Action / Response	An Examiner of the German Patent Office will make a search and issue an Office Action in which he informs the applicant or his representative, the patent attorney, of all facts which are in his opinion interfering with the grant of a patent. It is then left to the applicant or his representative to present counterarguments. The Office Action must be replied to in the form of a Response. At this stage of the procedure it is important that the disclosure of the original application will have afforded adequate demarcation from the cited prior art. Thus an inadequately drafted application can come to a dead end. As with drafting of the application, the experience and thoroughness of a patent attorney will often be a decisive factor during the granting procedure if a protective right is to be granted which provides adequate scope of protection. In order to convince the Examiner, it may be useful or even necessary to present argumentation that includes citation of current jurisdiction.
Grant or rejection	The examination ends with the grant of a patent or the rejection of the application. Further information is available in the notes entitled "Costs and Time Line for Obtaining a German Patent".

Subsequent application

Within the first year it is possible to file a subsequent application claiming the priority of the original application.

When can a subsequent application be filed?

Subsequent applications are possible up to one year from the filing date of the application or from the first priority date claimed for such an application. This is a **deadline**, after which nothing more can be done! If you have as yet not used the services of a patent attorney but now wish to do so for filing a subsequent application, then contact him in good time before this annual deadline.

Filing a subsequent application in Germany

This is usually done for the purpose of including an additional disclosure. But it means that further costs will be involved. The patent attorney must revise the application in order to insert the additional disclosure and the official filing fees will again be charged in full. If you provisionally draft and file an application yourself, it will usually be necessary for the patent attorney to draft a revised version, for which the aforementioned charges will be due.

Filing a subsequent application abroad

This serves the purpose of acquiring patent protection in other countries. The cost of foreign applications is considerable. Thus the only basis for decision when contemplating a foreign application is the economic value of the invention. For each country in which you want to file a subsequent application the ratio of the patenting expenses to the profits to be expected in that country must be good, unless the country is one where a competitor has a production site.

For protection in the most important countries (Europe, USA, Japan, *etc.*) expenses amounting to *ca.* 50.000 € and often considerably more must be expected, this figure being merely indicative of the order of magnitude involved. (See also the information notes about European and PCT applications)

Licensing

Finding a licensee

Basically you should only carry out negotiations and disclose the invention after a patent has been applied for.

In particular, when an invention is utilizable abroad, you should start looking for a licensee immediately after the application has been filed. This is particularly important for inventors working on their own or for inventors whose employers have not sufficient financial standing to enable them to bear the cost of such utilization themselves.

The goal should be to find, before the annual deadline for foreign applications has been reached, a licensee who will carry the cost of the foreign applications.

Commitment to secrecy

Before entering into discussion with potential licensees or if you intend to commission someone to build a prototype before filing the application, it is prudent to ask the persons to whom the invention will be disclosed to sign a confidentially agreement.

License agreement

Licensing stipulations should be laid out in a comprehensive license agreement embracing the following points, for example:

- license conditions
- minimum license fee
- acceptance of the cost of foreign applications
- defense of the protective rights
- denunciation
- *etc.*

When drafting the contract, you should definitely consult a patent attorney or a lawyer who is well informed in such matters.

Foreign application required but economical exploitation not yet decided – what next?

PCT Application

If economical exploitation is still undecided toward the end of the priority year, for example if the extent to which the product can be marketed is uncertain or a licensee has not yet been found, there is the possibility of filing an International Application under the Patent Co-operation Treaty (PCT). This can be filed just before the end of the priority year at the German or European Patent Offices by a German patent attorney submitting translations.

By this it is possible to secure priority for the most important industrial countries of the world for a period of 30 months from the filing date or priority date at a cost of about €6,600 – €13,000. Thereafter fees for the various countries will be due. You purchase a postponement, as it were.

Further information is to be found in my information notes entitled “Why File an International Application under the PCT Agreement? – Costs and Time Line”.

Definitions of technical terms used

Disclosure	Revelation of an invention to the public or description thereof in an application
Filing date of application	Date of reception of the application (per post, personal delivery, or per fax) at a patent office, <i>eg</i> , the German or European Patent Office. The Swiss Patent Office acknowledges the date stamp of a Swiss post office.
Inventiveness or inventive step	The criterion for the protectability of an invention. This holds when the invention is not, in the opinion of a person skilled in the art, an obvious extension of the prior art.
Novelty	A criterion for the protectability of an invention, which must not be disclosed in any → prior art reference in the world. Furthermore, there must not be any prior conflicting application in the country of application.
Patent	A protective right extending over a maximum of 20 years for an invention which has been examined by a patent office for novelty and inventiveness. In some countries, however, no examination procedure is carried out.
Patent claim	Definition of the protection of an invention as provided by a → patent.
Prior art	All knowledge available to the public prior to the filing date of an application for legal protection.
Priority	Period of time which can be claimed for filing a → subsequent application, equal to one year following the filing date of the application for protection of an invention.
Priority date	Date of the original application for legal protection for which its priority has been claimed for a → subsequent application.
Priority, internal	Claiming priority for a → subsequent application in Germany.
Protective claim	Definition of the protection of an invention as provided by a → utility model.
Publishing (Laying open) a German application	(Published or Laid-open application) Supplying the public with information on a patent application 18 months after its → filing date or → priority date. However, if a patent is granted prior to expiry of this term of 18 months, the public information will take the form of a patent specification.
Subsequent application	Supplement to an existing patent application or → utility model application in Germany or an application abroad within one year from the filing date (claiming the priority thereof).
Utility model	An unexamined registered protective right having a lifetime of not more than 10 years.

Addresses

German Patent- and Trademark Office

Zweibrückenstr. 12
80331 München

Information Office

Communicates information and dispatches application forms and information brochures: Tel. +49 (0)89 2195-3402

Searches

Searching is possible in the Public Library of the Patent Office.

Internet

www.dpma.de

European Patent Office

Erhardstr. 27
80469 München

Information Office

Tel.: +49 (0)89 2399-0

Internet

www.epo.org (customer advisory service: www.epo.org/metanav/contact_de.html)

Patent Information Offices in South-West Germany (for searches)

Patent Information Center of the Hessian Regional and Technological Library: Hessische Landes- und Hochschulbibliothek

Schöfferstr. 8
64295 Darmstadt
Tel. (Auskunft): +49 (0)6151 1654-27
Tel. (Recherche): +49 (0) 6151 1655-27
Internet: www.main-piz.de
Interactive support for searches: www.info-lotse.net

Patentinformationszentrum des Regierungspräsidiums Stuttgart

Haus der Wirtschaft
Willi-Bleicher-Str. 19
70174 Stuttgart
Tel.: +49 (0)711 12325-58
Internet: www.patente-stuttgart.de

Support for search in patent and trademark databases

Other addresses

Deutscher Erfinderverband e.V.

Sandstraße 7
90443 Nürnberg
Tel.: +49 (0)911 269811
Internet: www.deutscher-erfinder-verband.de

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