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Q. My firm's technical director invented a new product a few months ago. Without consulting anyone else, our marketing manager arranged for the publication of an article in the industry press describing the product. We have received several customer enquiries from people who have seen the article. We will soon be launching the product and think it could be a major success, possibly even abroad. How can we protect ourselves from our competitors?

A. Ideally, in order to best protect the product you would be well advised to file one or more patent applications in the UK and any potentially important foreign markets. From what you say, under UK law, the rights to any patent application for the invention would likely belong to your company because of the nature or position of the inventor.

However, the publication of the article in the industry press poses certain problems as regards the validity of any patent applications you might file.

The first thing that needs to be determined is what was actually disclosed in the article. If sufficient details of the product were disclosed, then the article could render any subsequently filed patent application prima facie invalid for lack of novelty.

In this case, however, there is a possibility that the disclosure of the article could be discounted, if your marketing manager acted in breach of confidence in arranging its publication. The circumstances surrounding the publication would need to be established and it would be prudent to check the authority that the marketing manager was afforded by your company.

If the article was published in breach of confidence, then you would be able to validly file a patent application in the UK as long as the application was filed within six months of the publication in the industry press, irrespective of the exact content of the article.

You say that the product will soon be launched. You should be aware that even a single sale of the product anywhere in the world would be prejudicial to the validity of any later filed patent application in the UK. Accordingly, it is imperative that you do not delay in sorting out your patent position. If necessary, you may need to consider delaying the launch of the product.

As regards protecting your invention abroad, similar considerations may apply. For instance, in Europe, the legal situation is essentially the same as in the UK. However, in certain other foreign countries including the USA, there is a so-called grace period, which may enable you to file valid patent applications covering the product, regardless of the circumstances surrounding the article in the industry press.

A qualified patent attorney would be able to advise you.

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