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conseils en propriété intellectuelle

# Patent - FAQs

Issued by the competent authority, the patent is an official title which protects an invention.

## ➢ What is the object of the protection?

Protection relates to inventions. The subject matter of these inventions concerns both entirely novel objects (process, device, apparatus, method, compound, material, formulation, etc.) and non-obvious improvements to existing inventions.

## ➢ What are the criteria for patentability?

To be patentable, an invention must satisfy **three basic criteria**[1]:

- ✓ **Novelty:** An invention is considered to be novel when it has never been made publicly available in any form (written, public conference, radio broadcast, internet, etc.), irrespective of the language, anywhere in the world.

  *! **To preserve potential patentability of your invention:** never disclose the invention non-confidentially prior to filing your patent application*

- ✓ **Inventive step:** An invention is considered as involving an inventive step if, for a person skilled in the art, it does not derive from the known prior art in an obvious manner.

- ✓ **Industrial application:** An invention must be able to be used, executed and reproduced industrially.

[1] *The above criteria of patentability reflect the legal provisions of many countries. However, there are national differences in these legal provisions and in their application. Some intellectual property offices (such as the Swiss Institute) do not verify, during examination of the patent application, whether these criteria are fulfilled.*

## ➢ What are the effect and extent of protection?

**The owner of a patent has the right to prohibit all third parties from exploiting his invention** (e.g. making, sale, offer for sale, import, use) in a country where a patent has been granted for said invention, throughout the duration of the patent.

The extent of protection is defined by the claims of the patent as granted.

**Principle of territoriality:** A patent has an effect only in the country in which it is registered and in force: outside this territory, anyone can freely exploit the invention.

## ➢ What is the duration of protection?

**Maximum 20 years** (+ a possible extension of up to 5 years for drugs and phytosanitary products depending on the date of granting of the patent and the first date of marketing approval).



reuteler & cie SA | Chemin de la Vuarpillière 29 | CH-1260 Nyon | Switzerland
Tel +41 22 363 79 40 | Fax +41 22 363 79 49 | mail@reuteler.net

## ➢ Why protect an invention?

Utility of a patent:

- ✓ Allows "exclusivity" on the technology employed in products or commercialised processes (differentiation of the products relative to those of competitors)
- ✓ Provides a marketing tool - provides visibility and image associated with innovation
- ✓ Provides a tool for negotiation in collaborative projects with outside partners or with respect to trading partners (distributors, suppliers, manufacturers)
- ✓ Converts technology into an intangible property right forming part of the assets of the company (increases company value)
- ✓ Provides an element for evaluating the innovative character of the R&D function of a company
- ✓ Facilitates fund-raising, especially for "start-ups"
- ✓ Is a potential source of revenue (assignment, licenses)

## ➢ What is the difference between a patent and a patent application?

The procedure for obtaining a patent starts with filing a **patent application** with the Intellectual Property Office of the country where protection is sought. This application will then be examined by the Office which will decide on the opportunity for **granting a patent** for the concerned invention.

The claims of the **granted patent** determine the scope of patent protection.

***! A patent application does not necessarily result in a granted patent with a scope identical to the original patent application.***

The owner of a patent can initiate an infringement procedure of his patent with the competent Court only after the patent is granted.

## ➢ Which marking is possible for the articles covered by a patent?

In the majority of countries, patent law does not require that patented articles are marked as "patented". However, it is recommended to mark the objects as "**Patent pending**" or "**Patent application filed**" or "**Pat. Pend.**" followed by the number of the corresponding patent application, or marked as "**patented**" followed by the number of the corresponding granted patent, to inform the public.

However, any attempt to identify, in a country, an article as being patented, while this is not the case, is punishable by law.

## ➢ How to file a first patent application?

A **first patent application relating to an invention** (known as "basic" or "priority" application) is filed with an Intellectual Property Office.



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The choice of the Office for this first filing will depend on numerous criteria such as potential economic impact, the need for rapid evaluation of patentability by an official entity, the language chosen for filing, the country of residence or nationality of the inventors[2], the country where the invention has been made[2], the budget of the inventor during the first year, etc.

In exchange of the exclusive rights to the invention conferred to the owner of the patent, the law requires that the applicant provides **a sufficiently detailed description of the invention** at filing of the patent application to allow third parties to execute the invention, with the aim of allowing progress in science and economy via public dissemination of technological knowledge.

***! Consequently, technical aspects which are crucial to the operability of the invention should not be omitted from the description of the invention.***

A **Patent Attorney** will help you with these steps of drafting and filing a patent application (see heading "What is the role of the patent attorney?").

*[2] In some countries, for example the United States, the law sets an obligation to file the first patent application relating to an invention with their national Office of intellectual Property for an invention made in their country, or as long as one of the inventors is a national or resident of their country.*

### ➢ How to protect an invention in other countries?

Prior to the expiry of a one-year period from the date of the first filing (known as "priority year"), the owner has the **possibility of extending the geographical scope of the protection of the invention** by filing one or more national/regional patent applications or an international application covering the countries where protection of the invention is sought.

Various routes of protection are possible and some (non-exhaustive) examples are illustrated in the **attached diagrams**.

For example:

- ✓ **First filing** with the Swiss, European (including Switzerland) or US Patent Office;
- ✓ **"Extension" filing within the priority year** by filing one or more national/regional applications (e.g. Europe, United States, etc.) and/or International application (covering 146 States on 07.09.2012).

The choice of the protection route will depend on many criteria such as the countries where the applicant (or possible licensees or assignees) and competitors are active (current or potential activity), the potential economic impact of the invention, the budget of the applicant, etc.

### ➢ What is the format of a patent application?

A patent application is structured as illustrated in the **attached diagram**.

Since patentability of the invention depends on the known prior art, a **preliminary search to determine the closest prior art** can be preferable (see file "Prior art search").



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## ➢ When should a patent application be filed?

**Concrete realisation of an invention is not an absolute prerequisite for filing a patent application**. However, the description of the invention in the patent application must provide credible and substantial support for ascertaining that the criteria for patentability are properly fulfilled. It is the "workable" character of the invention which will be examined by the patent office on the basis of the information supplied by the inventor within the text of the patent application.

The choice of the appropriate moment for filing is important in working out a protection strategy. The following considerations are important:

- ✓ **avoiding that competitors file on the same subject matter**, or avoiding disclosure of the invention prior to filing of the patent application, which would deprive the invention of novelty and, hence, patentability;

BUT also

- ✓ **taking into account the impact of a premature filing,** which would risk a rejection due to insufficient description, or which could lead to a limited scope of protection.

Due to the complexity of the procedures and the various possible routes of protection, it is recommended to consult a Patent Attorney, already starting from the initial phases of the project so as to put a solid protection strategy in place.

## ➢ What is the role of the Patent Attorney?

**His profile:**

- ✓ Scientific/technical and legal training (qualification exam)
- ✓ Internal (Industry)/External (Private practice)
- ✓ Interacts with a network of national attorneys all over the world and with lawyers

**His role:**

- ✓ Informs and advises on Intellectual Property rights
- ✓ Guides clients to an appropriate protection (patent, trademark, design, etc.) and advises on a protection strategy
- ✓ Analyses the patentability of the invention, the state of the art and rights of third parties (freedom to operate)
- ✓ Drafts and files patent applications, as well as applications for registration of trademarks and designs, etc.
- ✓ Represents and advises the applicant on steps to take to obtain, defend and/or attack an Intellectual Property right (interaction with the competent Offices, foreign agents, and lawyers in case of litigation)



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- ✓ Is in charge of the administrative management of the portfolio of filed/granted rights
- ✓ Play a part with assignments, licenses, due diligence, infringement, etc.

**reuteler & cie SA**

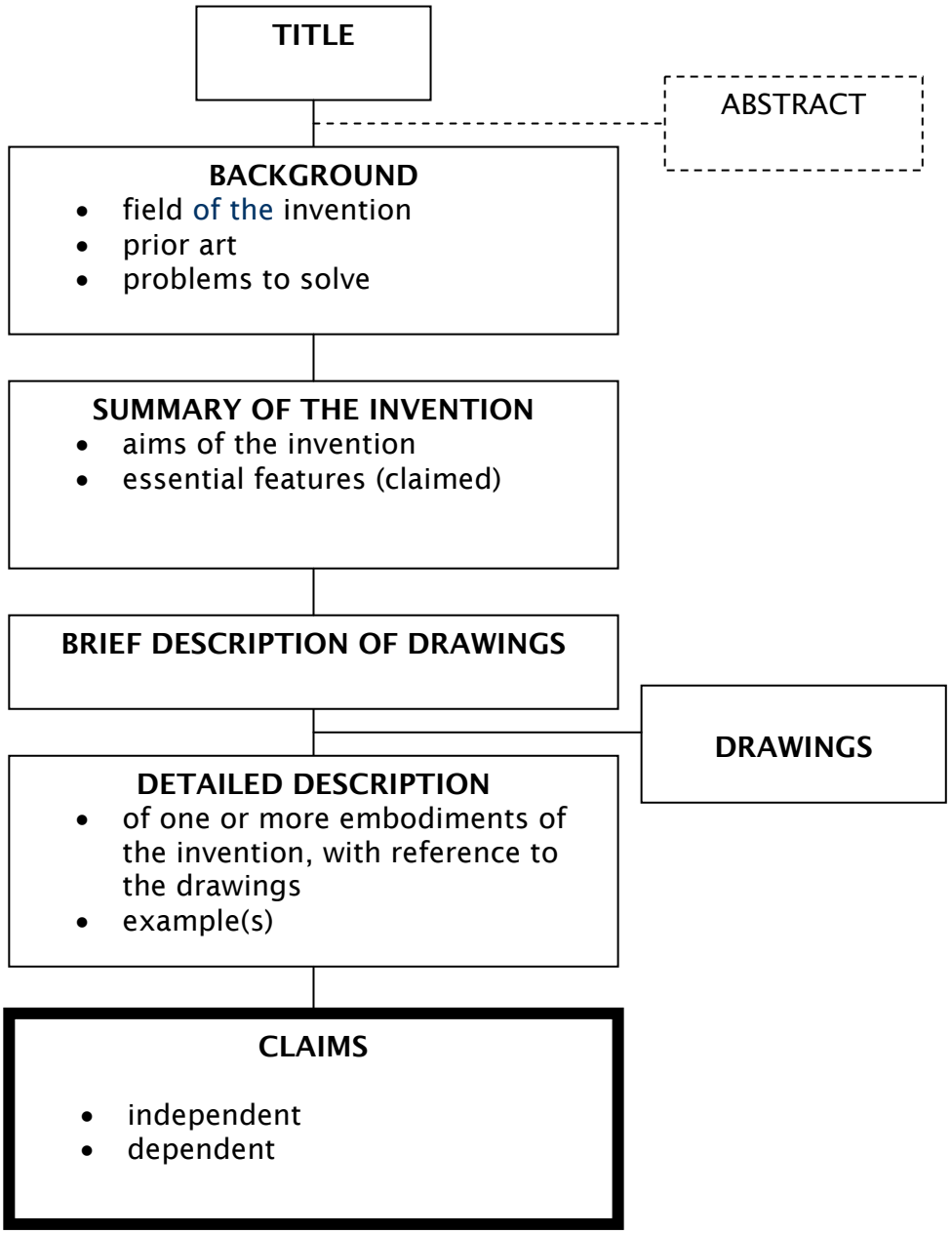
**Patent and Trademark Attorneys**

**www.reuteler.net**



reuteler & cie SA| Chemin de la Vuarpillière 29|CH-1260 Nyon|Switzerland
Tel +41 22 363 79 40|Fax +41 22 363 79 49|mail@reuteler.net

# Format of a patent application



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