

INFORMATION SHEET

Obtaining patent protection

The following is a general discussion on patents and the procedure for obtaining one. Although the specific procedure may vary from country to country, it usually follows the steps outlined below.

General discussion of patentability. For an invention to be patentable in a country, it must fall within the categories of patentable subject matter defined in the patent laws of the country. Categories of patentable subject matter typically include apparatus, methods, manufacture and compositions of matter. Certain types of subject matter, namely, methods of medical treatment, business methods, and computer software may not be available for patent in some countries. Additionally, generally a patent is only available for an invention that is novel, not obvious, and is useful.

Novelty. If the invention has been disclosed to the public prior to your filing of a patent application, it will not be possible to obtain a valid patent in some countries. Other countries, such as Canada, provide a one year grace period for filing if it was the applicant that made the invention available to the public.

Obviousness. Generally, an invention is said to be obvious where the invention (as defined by the claims) would have been obvious to one of ordinary skill in the art in view of the literature available and the common general knowledge at the date the first application for the invention was filed. However, an application in a country is only entitled to the benefit of the filing date of the first filed application for the invention (the "priority application") if the country belongs to the international treaty that provides for this and if the application is filed within one year of the priority application. This treaty, known as the Paris Convention, is adhered to by most countries of the world, including Canada and the United States.

Prior art. Because of the novelty and non-obviousness requirements, it is advisable that a search be conducted of the prior art in an attempt to locate references that show the state of the art in which the invention resides, or show that another party has already disclosed the same invention. You may engage us to conduct a search, or you may rely on a search you have conducted.

If the inventors are aware of any relevant prior references, such as published articles that they or others have written, copies should be provided to us if you are seeking a patent to help us judge the state of the art and the scope of protection that might be available. Further, as explained herein, if a patent is sought in the U.S., there is a duty to disclose this known relevant prior art.

Understanding the invention. Normally, it is preferable for us to meet with the inventors to discuss the differences between their invention and the devices or methods disclosed in the prior art. In general, it is important to understand the advantages of the invention over what is disclosed in the prior art and the structure, physical or chemical properties, or specific method steps which result in the advantages. In order to fully understand the advantages and nature of the invention, a written description, and drawings, wherever possible, is requested. Reference to this description is made while conducting searches and when preparing a patent application.

Inventorship. Legally, an inventor is someone who contributed to the invention as defined in the claims of the patent specification. Thus, if one or more claims could not have been written without the contribution of a given person, then that person is properly named as an inventor. It might not be possible to settle upon the proper inventorship for a patent application until the claims of the specification have been finalised.

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Date of invention. Where two inventors independently invent the same invention and apply for a U.S. patent, the U.S. currently awards the patent to the inventor with the earlier invention date. For this reason, if possible, the date on which the invention was first conceived should be documented, as well as the date on which the invention was reduced to practice by making a working prototype or by specifying the invention in enough detail that it could readily be made. If the invention has not been described in writing, this should be done as soon as possible, and a supervisor or someone else who can understand the invention should sign the description as having read and understood it. If a full and complete description already exists, please ensure it has been witnessed and dated as described above.

The U.S. is changing its laws so that it will award a patent to the first inventor to file for a patent on an invention rather than to the inventor who first invented the invention. However, this new law will only apply to applications filed after March 16, 2013.

Sufficiency of description. A patent application includes a patent specification, a set of drawings (if required) and a number of formal documents. A patent specification has two main portions: the description and the claims. The description explains how to make and use the invention, while the claims define the scope of the invention to be protected. Generally, the patent laws in most countries require that the description describe the invention in such clear and concise terms as to enable one of ordinary skill in the art to which the invention pertains to both make and practice the invention, without undue experimentation. In other words, if one fails to disclose some important features of the invention, then the specification could be found to be lacking in sufficient detail or ambiguous, which could result in the patent application being refused. New material cannot be added after the application has been filed, so it is important that the application as filed contains all the required information.

Best mode. United States and, to some extent, Canadian patent laws require that the specification disclose the best known mode of

practising the invention at the time the application is filed. Therefore, we must be kept informed of any changes to the manner in which you plan to implement the invention up to the date a patent application is filed.

Drafts of specification. Normally, we will work up and present you with a draft of the specification and request your comments. After receiving comments, the specification is amended appropriately, to ensure it properly describes and defines the invention over the known prior art. Once the specification is finalised, a patent application may be prepared for filing in the countries of your choice. Often, we file first in the U.S., and this involves the signing of certain forms by the inventors and by the intended owner of the application.

Confirmation of filing. Once we receive confirmation that the application has been filed, the confirmation is reported to you. An official filing receipt is normally issued within one to three months of filing an application. A filing receipt typically lists the application number, the filing date, the inventors and other application data used to identify the application in the Patent Office.

Information Disclosure Statement. In the United States, until a patent issues from an application, an applicant has an obligation to apprise the U.S. Patent Office of any prior art of which they are aware that may have a material effect upon the United States Patent Examiner's view of the invention's patentability. This prior art may be a publication (such as a magazine article or a published patent application) or even a product seen in public. The prior art may be submitted in the form of an Information Disclosure Statement ("IDS").

Prior art should be brought to the attention of the U.S. Patent Office within three months of filing or, for prior art discovered after filing, within three months of its discovery. If the art is not submitted within this period, it may be possible to submit it later, but the U.S. Patent Office may impose a penalty fee. In some circumstances, an application may need to be withdrawn and refiled in order to have prior art considered.

Request for examination. In Canada and many other countries, a specific request for examination must be filed within a pre-defined time limit calculated from the filing date of the application. In Canada, this time limit is five years. In the United States, examination of the application occurs automatically, without filing a specific request.

Examination of the application. During examination of the application, the Patent Examiner usually first reviews the application to determine whether it meets formal requirements. If the Examiner considers that the specification claims more than one invention, the first Official Action issued by the Examiner will often require the applicant to select which of the inventions is to be examined.

In most countries, after preliminary requirements are met, the Examiner conducts a search to locate references related to the invention and may issue a substantive Official Action that includes the Examiner's analysis of the patentability of the invention with regard to novelty and obviousness. The applicant may respond to the action by making claim amendments and/or arguments. The response may be followed by a further action, if the Examiner is not convinced of the allowability of the application.

Allowance. If the Examiner accepts the application, it will be "allowed" and the Patent Office will request payment of an issue fee. After the issue fee has been paid, and any other outstanding matters completed, the application usually issues to patent within three to five months. The total time between filing a patent application and issuance of the patent itself depends on the field of the invention and, in

countries where examination must be requested, when the examination request is made. If a patent is granted and infringed, the patent owner may claim for relief, including an injunction, damages or possibly an accounting of profits, and delivery up or destruction of infringing goods.

Filing in other countries. If the invention was secret at the time the first application was filed but made public thereafter, corresponding patent applications may still be filed in countries that belong to the Paris Convention, provided they are filed within one year of the first filing date. According to the Paris Convention, if you first file in one member country (such as the U.S. or Canada), you may later file in any other member country within the year following and claim, as the effective filing date for the later applications, the filing date of the first application. Most countries of the world belong to the Paris Convention.

Instead of filing individual applications in other countries, optionally, you could file an international application under the Patent Cooperation Treaty ("PCT"). The PCT allows the filing of a single patent application designating over 140 countries. Please contact us if you wish to receive more information on this procedure.

The procedure for obtaining a patent is complex and, if not handled properly, can result in an ineffective or invalid patent.

At Smart & Biggar/Fetherstonhaugh, we have the depth of experience and technical expertise to handle all of your patent and other intellectual property needs. For more information on how we can assist you, please contact any of our offices across Canada.