



# Brochure Patents

A patent is a legal document in which the scope of protection of a technical invention or idea is specified. A patent allows you to prohibit third parties, which are not entitled to do so, to use your invention or to make it commercially available. With a patent you will be able to acquire a solid market position, sell licenses or negotiate with manufacturers. A patent application is filed at a governmental filing authority, such as the Dutch patent office, and is subsequently examined on three requirements: the invention should be novel and inventive and susceptible of industrial application.

**IMPORTANT: Confidentiality!**

Until the patent application is a fact, it is important that you make sure that your invention is kept an absolute secret. However tempting it may be: avoid publicity and do not offer your invention to third parties that may be interested.

## How do I apply for a patent?

A patent is a legal document in which the scope of protection of a technical invention or idea is specified. A patent allows you to use your invention and to make it commercially available, while prohibiting others, which are not entitled to do so, to do the same. With a patent you will be able to acquire a solid market position, sell licenses or negotiate with manufacturers. A patent application is filed at a governmental filing authority, such as the Dutch patent office, and is subsequently examined on three requirements: the invention should be novel and inventive and susceptible of industrial application.

The help of the patent attorney is essential in order to draft a patent application that is both technically and legally well-founded. The patent attorney, in consultation with you, is able to delimit what you request protection for from what is already known. The result will be a stronger patent that can be maintained better.

Should you ever be confronted with others copying your invention, meaning infringement of your patent, and you wish to stop the infringer, this will usually have to be effected in court. Of course you would not want a court to declare your invention invalid because it was not formulated properly. This can be avoided with the help of a patent attorney.

**Client - Patent Attorney confidentiality**

It goes without saying, but a patent attorney is obliged to confidentiality. All details regarding your invention that you entrust us with are therefore considered strictly confidential.

## In which countries do I apply for a patent?

For Dutch companies, we usually file a Dutch patent application first. This patent application is search regarding novelty and inventive step and thus provides a test-case for potential foreign applications.

### **Dutch Patents Act**

Since on 1 April 1995 a new Dutch Patents Act became effective, every patent application filed in the Netherlands automatically results in a patent. The Dutch Patent Office does not examine whether the invention complies with the novelty and inventiveness requirement, as used to be the case.

Although the Dutch Patent Office no longer examines the patent application, it goes without saying that a patent that is not novel, or not inventive, cannot in practice be maintained with respect to third parties. Before filing a patent application, it therefore makes sense to carry out a search into possibly already existing prior art in the field of your invention. You can do this yourself (through the internet), but basically this is also a job for an expert.

In case of a Dutch patent application, a request for a novelty search must be filed simultaneously with the application or ultimately within 13 months after filing the application. The Dutch Patent Office will then issue a so-called search report. In this report prior art can be mentioned that comes close to the invention. The Dutch Patent Office then also issues a so-called “written opinion” in which possible objections are elucidated. After studying the prior art references if necessary, in consultation with the patent attorney, the claims can be delimited from what the Dutch Patent Office

considers already known. Again this will result in a stronger patent.

If you think you will only exploit the invention in the Netherlands, such a national search will usually suffice.

If you are of the opinion that the invention will have to be protected worldwide, the so-called international search should be opted for. The international search is carried out by the European Patent Office.

Dutch patent applications can also be filed in English. However in that case a Dutch translation of the claims should be filed a few months after filing the application. When the Dutch application mainly serves to record a date, and there is an intention of filing a European patent application later on, it may be advantageous to file the Dutch application in English. In that way translation costs can be saved on.

The application will be registered on the Register after approximately 18 months. Shortly after that the grant will take place. The registration on the Patent Register will be published and as of the moment of registration anyone can take note of the contents of the application. On special request of the applicant an accelerated registration can take place. As of the third year in the life of a patent a maintenance fee, the so-called annuity, will annually be due on the last day of the month in which the filing date falls. Non-payment of the annuity before or on said date, or – increased by a fine – within six months after that, will result in abandonment of the patent. The maximum life of a patent is 20 years.

### **Building a patent portfolio**

You may have an interest in protecting the invention in other countries besides the Netherlands. For that purpose patent applications can be filed in nearly all countries of the world. In addition to filing national applications there is the possibility for Europe to file a European patent application. Furthermore there is the possibility of filing an international

patent application, the so-called PCT-application. Both options will be discussed below.

A foreign patent application based on an application that was originally filed in the Netherlands only, should preferably be filed within 12 months after filing the Dutch basic application, but in any case before the Dutch patent is registered on the Register: after all, as of that moment the invention is publicly known and no longer patentable in other countries.

When the foreign patent application is filed within 12 months after the filing date of the Dutch application, the so-called priority right can be invoked in nearly all countries: the foreign patent application filed after the Dutch application is then deemed to have been filed on the date of the basic application. This has a very important advantage that you will not need to reckon with any publications in the field of your invention between the date of the Dutch application and that of the foreign corresponding application: such publications cannot anticipate your foreign patent application.

You can wait with filing a foreign patent application until you know what the Dutch Patent Office's opinion is about your basic application. As already stated before, said opinion is given in the search report issued in the Dutch basic application. When the request for a novelty search is filed immediately with the Dutch application, a search will soon be started. As a rule the results of the search can be expected within 10 months.

The search report may of course turn out to be unexpectedly negative. However, as already stated, this should not be in the way of a Dutch patent, although the patent naturally will not become stronger as a result of such a report. A truly negative report will render the chances of a patent being granted on the basis of corresponding foreign patent applications doubtful. At that moment you could decide not to file corresponding applications abroad: due to the search report you save the considerable costs involved in foreign applications.

## **Patent in Europe**

As stated above, there is the possibility of filing a European patent application, either directly, or via a PCT-application, which option will be discussed later.

The costs of the prosecution of the application strongly depend on the relevance of the objections the European Patent Office advances in the form of publications dating from before the filing date of the application. The time involved in –where possible– refuting said objections and with shaping the patent application into a patentable form, will be charged on an hourly rate. In addition during the prosecution you will have to consider the examination fee when filing the request for examination. At that moment a so-called designation fee will have to be paid for each of the countries that are of real importance to you. Irrespective of the number of countries you select, you will never have to pay more than 7 designation fees. You will therefore decide at that moment in which European countries you truly want protection. For the extension countries a separate designation fee will have to be paid.

A European patent application is not by definition cheaper than a national patent application in the various European countries. The turning point is approximately 3 countries.

The road from application to patent will at least take some years. When the patent is granted, it will fall into national patents for the countries designated by you. At that moment the patent has to be validated in all countries that are still of importance to you.

On 1 May 2008, the London Agreement came into force. As a result European patents have become a lot cheaper as in a number of countries translations are no longer required. In most of those countries, however, the claims of the patent will still need to be translated.

The costs for validation in the various European countries will therefore vary, depending on whether or not a country is

party to the London Agreement and naturally also depending on the length of the text to be translated.

If at the moment of granting you find that your interest in protection in certain countries you initially selected has diminished, you will not need to validate the patent in those countries. Consequently the overall costs of validation will become lower of course.

After the patent has been validated in the various countries, annuities for the maintenance of the patent will fall due for each individual country.

It is expected that within a few years, you will have the opportunity to choose for a Unitary patent after grant of your European patent application. This Unitary patent will have a unitary effect for a considerable number of member states of the European Union. As the Unitary patent does not have to be validated per country, its costs after grant can be considerably lower. Because the Unitary patent can only have effect in the countries of the European union, the other member states to the EPC can still be validated via the 'tradiational' European bundle patent. You can also choose for a combination of both.

### **International (PCT-)application**

Still left to discuss is the frequently used possibility of filing an international or PCT-application based on the Dutch application within 12 months. Through such an application it is possible to seek protection in 155 countries. These countries also include those falling under the European patent and for which in due course, through the PCT-application, a bundled European application can be filed.

A PCT-application itself can never result in a patent. The application only serves to retain the right to file patent applications in other countries for a considerably longer time than the usual 12 months after filing the Dutch basic application. By filing a PCT-application, after the regular 12-month term has lapsed, foreign patent applications can still be filed for an additional 18 months claiming the priority

right –meaning the filing date- of the original Dutch basic application.

Filing a PCT-application therefore makes it possible to defer the commercial decision regarding the necessity of patent protection abroad and, not unimportantly, provides simultaneous deferment of paying the considerable costs of patent applications in the countries that are of importance to you.

Assume for instance that you are interested in a European patent application for a great number of countries that can be designated in a European application as well as in an application in the United States of America, Canada, Australia and Japan. This route will provide you with an 18-month deferment. In most countries, the PCT-application namely need only be converted into national patent applications and/or a (regional) European patent application within 30 months after filing the basic application. In this case as well a refund of a part of the costs of the search report is possible, if an earlier international search report (drawn up by the European Patent Office) is submitted.

A PCT-application will also be published 18 months after the filing date or, if applicable, after the filing date of the basic application.

After filing a PCT-application the European Patent Office draws up a search report. The Examiner carrying out the search also gives a first opinion on the patentability. If the applicant does not file a request for carrying out an international preliminary examination (“Demand”), the first opinion is converted into a report, the so-called IPRP (Chapter I). After receipt of the search report the applicant can always amend the claims of the application. If a Demand is filed the applicant can amend both the claims and the description of his application. He can also file a refutation against possible objections in the opinion. The European Patent Office will then draft an IPRP (Chapter II) based on the optionally amended documents. In most countries in which the application can later be converted into a national patent application the IPRP will be considered the starting point. In

case of conversion into a European application a discount will be given on the request for examination for patentability.

Before the 30-month term (12+18) lapses, the application will have to be converted into national applications and/or a regional (European) application. At that moment you will as yet have to pay the above-mentioned costs.

## Services for international clients

### **Formalities**

Patent office Vriesendorp & Gaade has experienced formalities officers providing services to international clients regarding the filing of national applications, the validation of granted European patents and the payment of annuities. The annuity calculation runs from the date of filing of the application. However, there is a three-year annuity-free period. As a consequence, annuities become due in The Netherlands at the end of the third year after filing.

### **First filing in the Netherlands**

Due to a fee reduction (Government subsidy) for the search report and the possibility to file and be granted a patent largely in English, it may become interesting to file first filings in the Netherlands. The applicant will receive a search report plus a written opinion drawn up by the Dutch Patent Office or the European Patent Office within the priority year.

### **English language**

It is possible to file applications in the English language. It is no longer necessary to file a full Dutch translation of the application. A Dutch translation of the claims only will suffice. Our translators have extensive experience in the field of mechanical engineering, chemistry, pharmaceuticals and biomedical.