



Want to patent? Be prepared!

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Dear inventor

Filing a patent application can be a challenging process for inventors. Good communication between the inventor and the patent attorney drafting the application is an essential foundation for filing a good patent application. You are the expert in your field and your input is required to make sure that all aspects of the invention are properly covered, thereby ensuring a good protection. In order to help you provide useful input to your attorney, here are some things you should consider.

Patent basics

In order to be patentable, your invention needs to be novel, inventive, and industrially applicable. Briefly, your invention should not have been described anywhere in the world, in any form, prior to the filing of your patent application. The concept of inventive step is less absolute and harder to define. The invention is inventive if a person skilled in the art would not have arrived at the invention merely by combining what was already known – in other words, it should be more than an obvious, straightforward development of already existing techniques. A good patent application not only covers the invention, but also covers aspects which you may have overlooked initially. Sufficient details are needed in order to draft reasonable fallback positions.

Defining the invention

The patent attorney needs to understand the invention – and who can explain it better than you? There are several aspects to consider. First, the concept of the invention needs to be explained in detail. There is no reason to hold back on technical details: your patent attorney has a technical background and can understand complex technologies. It is also important to consider whether essential elements are required for the invention to

work. If you developed a new type of band aid with exceptionally good adherence to the skin, for instance, does it require specific materials, while others just cannot be used? Can cheaper material be employed without compromising the functionality of the invention?

Second, it is important to consider who the potential users of the invention are. This may help identify other applications of the invention. For example, while you have developed a band aid for dealing with small wounds in the everyday life, your invention could be used in hospital settings for bigger wounds, or perhaps even as epilating articles in a beauty parlor or as nicotine patch.

Third, you should explain to your patent attorney why you think your invention is novel. What are the differences between your invention and existing techniques? Any small difference may be of importance. Keep in mind that the novelty of your invention can be challenged by any disclosure you or another of the inventors makes. The term ‘disclosure’ does not only encompass publications in scientific journals; therefore, you need to look back and consider whether the invention was described in a scientific article, or in an oral presentation or a poster or an abstract prepared for a conference. Do you have students who worked on this project and who have defended their thesis or are about to do so? Please note also that applying for funding or registering your clinical trial on clinicaltrials.gov can sometimes result in a project description becoming publicly available; this can also jeopardize the patentability of your invention.

In order to support inventive step, you need to consider which problem(s) your invention solves. Does it provide an alternative to already existing

techniques? Are there particularly interesting advantages, such as lower manufacturing costs, better efficiency, higher sustainability? Was the road to the invention paved with difficulties, that it took a long time to solve?

Finally, although preliminary data can be sufficient for filing a patent application, it is a good idea to consider which data will be needed to support the application. You also need to weigh carefully whether such data can realistically be obtained within a year of filing the application, i.e. before entering the international phase.

Applicant and inventors

An inventor is any person who contributed to the invention at the intellectual level. Inventorship and authorship are different things, and co-authors of an article describing the invention are not necessarily co-inventors. It is crucial to identify the correct inventors: having people listed as inventors when they are not can in some countries be used to invalidate a granted patent. Your patent attorney can help you define the contribution of each person to the invention in order to clarify who is an inventor. Likewise, it is important to identify the applicant for the patent application. Many employers reserve the rights to intellectual property / inventions developed in the context of employment. This needs to be formalized by having the inventors sign a document assigning the rights to the invention to the applicant.

Materials

So, once you have explained the invention and clarified the above formalities, what more do you need to do? Your patent attorney will need you to provide some materials in order to be able to draft a good patent application.

These include an introduction describing previously known techniques or products relevant for the invention – the so-called ‘state of the art’. It corresponds roughly to the introduction of a scientific article, describing the plain, scientific facts, some key references if relevant... and nothing else.

You should also provide your patent attorney with any relevant data. Make sure to describe how the experiments were performed, as you would in a materials and methods section of a scientific article, with enough detail to enable someone other than the inventor to repeat the experiments. Figures presenting the results for each experiment should be provided in black and white in order to meet publication requirements. Each figure should be accompanied by a detailed figure legend and a conclusion. Protein or nucleic acid sequences should

be provided in FASTA format, and the organism which they are derived from should be identified.

Good communication

The process of filing a patent application and obtaining a patent is long and complex. Nothing is more useful than good communication between you and your patent attorney. The better the patent attorney understands your invention, the more robust your patent application will be – thereby leading to good protection of your intellectual property rights.

If you have any questions you are very welcome to contact your patent attorney at HØIBERG A/S.



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[Learn more about Nadine Eckert-Boulet here.](#)