

Patent application

What you need to know to file a patent application

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Filing a patent application can be a challenging process. Good communication between the inventor and the patent attorney drafting the application is an essential foundation for filing a good patent application. You as inventor 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. Here are some things you as an inventor can consider so you can provide useful input to your attorney – the better your patent attorney understands your invention, the more robust your patent application will be. thereby leading to good protection of your intellectual property rights.

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 – and is bound to confidentiality. Essential features should be identified: which elements are required for the invention to work? Do alternatives exist?

Next, you should explain to your patent attorney why you think your invention is novel. What are the differences between your invention and existing techniques? Keep in mind that the novelty of your invention can be challenged by any disclosure made by you, any other inventor, or even your colleague in a different group. 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? Have you applied for funding or registered your clinical trial on clinicaltrials.gov?

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 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.

Materials

Your patent attorney will need you to provide some materials in order to be able to draft a good patent application. Data are obviously particularly important, and you should provide your patent attorney with any relevant data. Make sure to describe how the experiments were performed with enough detail to enable someone other than the inventor to repeat the experiments. Figures presenting the results together with a detailed figure legend and a conclusion are also very useful. Protein or nucleic acid sequences and the organism from which they are derived should be provided. Your patent attorney will then translate all those elements in a patent application.

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 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.

Need to know more?

If you wish to know more about how to file a patent application, feel free to contact our expert Nadine Eckert-Boulet Bravo.



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