

# FILING FOR PATENT PROTECTION

When is the right time to kick off the patenting process?

By Arnold Ceballos

Thousands of researchers and scientists in Canada work every day to create, develop and ultimately bring to market new and innovative products. These forms of intellectual property are often the most valuable asset owned by a life sciences firm, which may have invested millions of dollars in developing them. In many cases, patent protection is sought in order to protect these valuable assets. However, intellectual property rights vary from country to country and it is vital for those in the life sciences field to understand the processes for obtaining such protection. Among the important considerations one must bear in mind are issues surrounding when to file patent applications.

Patents provide an exclusive time-limited right to make, use and sell inventions. They cover new inventions (which include processes, machines, manufactures, and compositions of matter) as well as useful improvements on existing inventions. In the life sciences area, patentable inventions cover a wide range of fields, from pharmaceutical formulations to agricultural applications to biotechnology. The monopoly granted to the patent owner is thus extremely useful, whether the owner will be producing the invention itself or licensing their rights to others.

For an invention to be patentable in Canada, it must be novel (that is, not publicly disclosed anywhere in the world before the



filing date of the first patent application), non-obvious (there has to be some ingenuity, such that it would not be obvious to a person skilled in that particular art) and useful (it has to have specific utility and be operative). In order to obtain patent protection, an application must be filed which sets out the invention in great detail. The process to the issuance of a patent is usually quite long and involved.

Once a patent is issued, an invention in Canada is protected for a period of 20 years from the filing date. Generally, a patent is granted under the law of each country and the term is governed by each nation's specific law, which for many countries is twenty years from the filing date of the application, like Canada. Generally speaking, patent rights are granted to the first person to file a patent application, assuming they are the inventor or have obtained rights to the invention. Thus, if an inventor can prove that they were the first to have conceived of the invention, they would not be able to obtain a patent if another inventor had filed an earlier application. The United States is a notable exception to this principle, although patent reform being considered in the United States may be changing this in the near future. The United States approach is currently based on granting protection to the first to invent, rather than the first to file. Other jurisdictions, such as Japan and Europe, follow the first to file principle, as does Canada.

Since Canada is a first to file jurisdiction, it is recommended that an application be filed as soon as possible, in order to obtain priority over someone else filing an application for the same invention. In addition, since patent protection will only be granted to an invention that is novel, ie. not previously publicly disclosed, an applicant must consider filing a patent application early, in order to avoid defeating it through prior public disclosure of their own invention. Public disclosure generally includes such things as presenting details of the invention at a conference or publishing it in an academic journal.

In addition to prior public disclosure of the invention by the applicant themselves, the novelty of an invention can be challenged based on any information that is publicly available at the earliest filing date. Thus, from a practical perspective, the later an application is filed, the more information possibly becomes available which can be used to challenge the novelty of the invention.

Canada and the United States do provide a one

year grace period, which permits the applicant to file their patent application within one year of making a public disclosure of their information, without the public disclosure being considered 'prior art' that could defeat the application. For those interested in the Canadian and United States markets, the grace period provided in these two countries does provide a window for the inventor to determine the marketability of their invention before having to spend money on preparing and filing patent applications. However, other jurisdictions such as Europe and Japan do not provide such a grace period, meaning that previous public disclosure can be used against the applicant as prior art.

If protection will be sought in several countries and, since most countries outside Canada and the United States require absolute worldwide novelty, this will affect decisions as to when and where the first application will be filed and when any public disclosure can occur. It is a good idea to seek advice from a patent lawyer with respect to issues such as what constitutes public disclosure, as well as to help develop a strategy regarding which countries to file in.

Patent protection is often most useful for those who wish to obtain a monopoly on products that are easy to copy or reverse engineer. An alternative to patent protection which can also be considered is reliance on trade secrets. These comprise knowledge that provides a company with a competitive advantage as a result of that knowledge being secret. This strategy can be considered for such things as processes that cannot easily be reverse engineered. However, this protection only lasts as long as the secrecy is maintained, and this can be very difficult to do for a long period of time, often leaving patents as the preferred route.

Whether for an established multinational corporation or a start-up, developing a successful corporate strategy that recognizes the importance and value of intellectual property is essential to success. As the National Research Council in the United States noted, the growth of biotechnology in the United States is due largely to the link between industry and academic science, facilitated by the availability of biotechnology patents. And key to this is an appreciation by the inventor as to when they must kick off the patenting process. **BB**

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