Provisional patents essential for robust IP

Janusz Luterek, a director of Pretoria-based Intellectual Property Practitioners, Hahn+Hahn, talks about the importance of seeking a provisional patent for an innovation before undertaking any research into its market potential.

"While large businesses tend to have their own lawyers or retained law firms to secure and protect the intellectual property they create, small businesses and private individuals can seldom afford this. They are therefore at a disadvantage as their inventors may not understand how the patenting process works at a deeper level," begins Luterek.

While developing a new product or concept, inventors like to establish if it will be commercially successful or not and if it is financially worthwhile to pursue development. "From a patent law perspective, however, talking about an idea before a patent has been applied for is a mistake," he warns.

In terms of international patent laws, Luterek says a patent application for an idea must have been submitted before market research or discussions can begin to establish future potential. "Going to see like-minded people to garner support and advice about the viability of a development and its patentworthiness can ultimately invalidate the patent. In principle, an idea cannot be made freely available to people before a patent application has been filed," he explains.

"This is the big 'chicken or egg' problem with product development. Large companies have budgets for the costs of filing for a number of patents every year, but smaller companies do not and cannot afford to spend money on inventions that may ultimately be without merit. So commercial testing and waiting for traction may seem to be the safest option as it would limit wasted expenditure on patents which may not come to fruition. But if a patent is only filed once commercial success has been established, any party involved in pre-patent testing or a potential customer may be later called upon to testify to the fact, which could well invalidate the patent," Luterek tells *MechChem Africa*.

An exception to this principle is known as a 'reasonable technical trial'. "This allows developers to conduct technical trials before applying for a provisional patent. But it is important that this is not marketing or sales related. If a new traffic light is technically tested in a single location for a few weeks to establish its safety and technical functionality, then it is unlikely to invalidate the patent. As soon as trial is finished, a patent application must be filed before any marketing commences or sales are made.

"But if the trial is to convince the roads agency to adopt and purchase the new solution, then a provisional patent must be filed before the trial. This avoids the danger of people copying the idea and using 'prior-knowledge' of the patent to invalidate the holders patent," he says.

Luterek sees this often on mining sites, where service providers will develop a solution and pursue a trial with mine management involvement. "When deals start to be done based on the results of tests and sales deals being negotiated before filing for a patent, then the patent validity is at risk.

"If nobody knows, then the patent may well be granted, but as soon as a dispute arises, the history is going to be investigated and anyone who can testify to what actually happened at the time may be called to testify. If pre-patent marketing is found to be credible, the patent will be revoked," argues Luterek.

"Nobody copies an unsuccessful product, but any chinks in an IP's armour are likely to be exploited by opportunists to gain the legal rights to manufacture and sell copycat products. It is always difficult to defend patents after multi-party trials such as these have taken place," he adds.

Luterek's advice is to begin the patenting process much sooner in the development process. "As soon as you believe a product may have merit, we suggest filing a provisional patent application. This is a relatively low-cost starting point that secures the rights at an early stage, while also enabling development work and marketing to begin. It allows the market to be explored and the product to be tested by potential clients without risk to the patent validity,' he adds.

"Provisional patents do not require extensive and formal technical details of a full patent, either. A description of the invention with drawings and an explanation as to why it is different to what preceded it is sufficient," Luterek continues.

As the least expensive IP protection option, provisional patents give a developer a further 12-months to do further technical development, generate cash flows and explore market opportunities," he says. "But it is imperative to file for the final local and international patent rights before the expiry of the 12 month period, as this time is not extendible for international patent rights," Luterek advises.

"Research and the development of local IP has a vital role to play in the economy and it is important that the effort and resources put into R&D do not get appropriated by someone else, who can build copies at lower net costs with no recourse from the IP originator because of improper attention to patenting laws.

"We in South Africa file many mining patents, for safety equipment such as mine props and for more efficient explosives and detonation technology, for example. Consumable items such as these are highly likely to attract copycats.

"Having proper IP protection in place is the only way to counter this trend and I urge anyone with questions about how best to protect their IP to consult me or any of our other technically trained patent attorneys at Hahn+Hahn," he concludes. ❑

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