



## Liverpool Inventors

Monday 24 April 2006, 16:00 – 17:45

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### **I've got a Great Idea!**

*How not to spoil it*

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*Barrister*

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#### **1. Six Golden Tips**

1. Treat invention promoters with caution
2. Keep your invention under wraps until you have got everything that you need in place
3. Plan ahead and plan thoroughly
4. Base your planning on sound research
5. Spend your money wisely
6. Keep a grip on reality

#### **2. Treat Invention Promoters with Caution**

While not all invention promotion companies are bad there have been enough problems for patent offices around the world to warn inventors against them. The OFT (Office of Fair Trading)<sup>2</sup> has taken steps against the former directors of International Technology Evolution and Exchange Limited of Dublin upon receiving numerous complaints from consumers who had paid thousands of pounds to that company for assistance in marketing their ideas.<sup>3</sup>

People who will give sound assistance include NHS hubs for health service workers, university incubators and business generators. One of the objectives of this club is to construct networks between inventors, professional advisors and potential partners.

Although chartered patent agents no longer have a monopoly of patent agents' work, only those entered on a register kept by the Chartered Institute of Patent Agents can call themselves patent agents. The register is on the Institute's website at [www.cipa.org.uk](http://www.cipa.org.uk).

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<sup>2</sup> Agency responsible for protecting the public against unfair business practices

<sup>3</sup> See "OFT issues warning to former directors of inventions promotion company" Press release 48/06 8 March 2006 at <http://www.of.gov.uk/News/Press+releases/2006/48-06.htm>

### 3. Keep your Invention under Wraps until you have Everything you Need in Place

The law of confidence imposes a duty upon those who receive secret information in confidence (“**confidantes**”) from making use of, or disclosing, that information to a third party.

The usual way to prove that information was disclosed in confidence is to seek a confidentiality undertaking (sometimes called “a non-disclosure agreement”). Contrary to what a lot of people think, a confidentiality agreement is not essential for imposing that obligation. It is, for instance, unnecessary to obtain such an undertaking from a solicitor or patent agent because he or she is already under a duty not to disclose or make use of his or her client’s secrets.

However, such an undertaking is not always sufficient. You have to make sure that the confidante is aware and agrees that the information in question is confidential. You have to record the information disclosed and the date, time and place of disclosure. Above all, you have to take steps to keep the information secret. Keep documents under lock and key. Make sure that files are returned after use. Limit access to sensitive consumer files by passwords etc.

### 4. Plan Ahead and Plan Thoroughly

A study on the cost of patenting in Europe was prepared for the European Patent Office by Roland Berger Market Research. It was published on 21 Dec 2005 and can be downloaded at [www.european-patent-office.org/epo/new/cost\\_analysis\\_2005\\_study\\_en.pdf](http://www.european-patent-office.org/epo/new/cost_analysis_2005_study_en.pdf). The €30,530 cost is a figure for 6 EPO states and covers renewal fees, translations, official charges etc over a 20-year life. National patent applications are less expensive but will still work out at a minimum of several thousand pounds.

Patents and other intellectual property rights are enforced primarily by proceedings in the civil courts. It is not yet an offence deliberately to infringe a patent or design right. According to the government’s Intellectual Property Advisory Committee report “The Enforcement of Patent Rights”<sup>4</sup> published in Nov 2003 it can cost about £1 million to sue in the High Court and £150,000 even in the Central London County Court compared to about €50,000 in France, Germany or the Netherlands. If you want to enforce your IPR in England you must be very rich, have a very rich investor who is prepared to sue on your behalf or take out some sort of indemnity insurance. It may also be possible to sue elsewhere in Europe on a Community design or Community trade mark or a European patent designating a country other than the UK where the patent has also been infringed. It may also be possible to sue in the USA on a corresponding patent where the costs are the same but some lawyers act on the promise of a share of the damages and there is much less risk of paying the other side’s costs.

### 5. Spend your Money Wisely

Websites containing a lot of free information:

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| British Patent Office                                  | <a href="http://www.patent.gov.uk/">www.patent.gov.uk/</a>   | Statutes, rules, Patent Office decisions, leaflets, brochures, announcements, manuals and lots more   |
| European Patent Office                                 | <a href="http://www.european-patent-office.org/">www.european-patent-office.org/</a>   | European Patent Convention, Toolbox for applicants, PatLib libraries, case law, leaflets, brochures and lots of information on European patents |
| OHIM (Office for Harmonization in the Internal Market) | <a href="http://oami.eu.int/">oami.eu.int/</a>   | Community trade marks and design regulations, case law, guidance notes and lots of information on Community trade marks and designs             |
| WIPO (World Intellectual Property Organization)        | <a href="http://www.wipo.int">www.wipo.int</a>   | International conventions, treaties, news, information etc  |
| nipc   | <a href="http://www.ipit-update.com">www.ipit-update.com</a><br><a href="http://www.nipclaw.blogspot.com">www.nipclaw.blogspot.com</a><br><a href="http://www.hip.org.uk">www.hip.org.uk</a> | Hundreds of articles, case notes, presentations, newsletters since 1996.  |

<sup>4</sup> <http://www.intellectual-property.gov.uk/ipac/pdf/enforce.pdf>