

Patents of addition

What are they?

Patents of addition are granted for novel improvements or modifications to an invention which is already covered by a granted standard patent of invention (known as the “parent patent”).

Why use them?

Patents of addition are useful for protecting non-inventive improvements to technologies that are already protected by a patent. They can be a useful tool to “ring fence” areas of technology. However, if the improvement is inventive in its own right we recommend filing a standard patent of invention to maximise the protection for that improvement.

What are the requirements?

A patent of addition:

- Can only be filed by the same person or company which owns the parent patent;
- Must have at least one inventor in common with the inventors named in the parent patent;
- Cannot be filed before the filing date of the parent patent; and
- Cannot be granted until the parent patent has been granted.

An application for a patent of addition must include a complete specification. Once filed, the complete specification undergoes examination, publication and grant in the usual manner.

What are the advantages?

The main advantages of a patent of addition are:

- They cannot be revoked or challenged for lack of fair basis or inventive step;
- No renewal fees are payable (unless the parent patent is revoked); and
- They can be converted to a standard patent if the improvement or modification is inventive in its own right if the parent patent is withdrawn or revoked.

What are the disadvantages?

The main disadvantages of a patent of addition are:

- Their term is limited to the unexpired term of the parent patent; and
- The improvement or modification be fairly based on the subject matter of the parent patent (i.e. they cannot protect improvements or modifications unrelated to the parent patent and/or undisclosed in the parent patent).

Can I get a patent of addition in other countries?

If a standard patent of invention has already been granted overseas then the novel improvement or modification can also be protected in *some* overseas countries (e.g.

Australia and India). We can provide further information on specific countries on request.

In the US, the closest equivalent to a patent of addition is a continuation-in-part (CIP) application. A CIP can be filed for improvements to an existing patent application while it is still pending. The same criteria for fair basis in the parent specification (sufficient to support at least one claim in the CIP), common owner and at least one inventor in common with the parent patent apply.

It is always important to discuss your specific requirements with your IP advisor to ensure maximum protection can be taken from your intellectual property.

Disclaimer

The above is provided for general information purposes only and does not take the place of specific legal advice. For more specific advice on all aspects of intellectual property law please contact us.