



Preparing grant and publication

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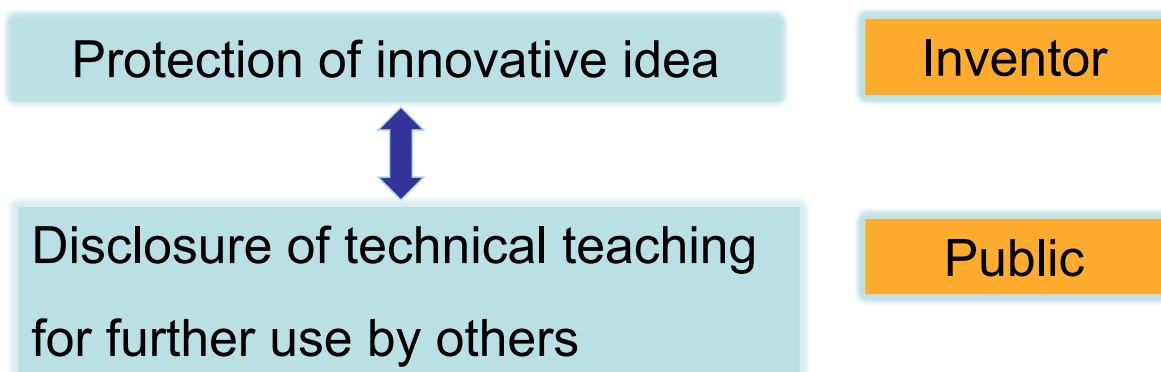
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Overview

- Patent information in general
- Items to be checked for publication

Role of patents

- ▶ Historically two competing interests of two stakeholders:



Role of patent information

Publication of patent information serves two purposes:

- ▶ Informing of existing **protection** rights
what? where? when?
- ▶ **Disclosure** and dissemination of technical teaching

What is **published** over life cycle ?

- Varies strongly from country to country
- Minimum: notification of grants or other events in Gazettes
 - if so: further information only retrievable through file inspection
- Often but not always:
 - full specification of granted patents
 - applications
 - usually 18 month after filing
 - many countries (DCs) don't (PCT NPE)
 - search reports, corrections, amendments, translations
 - legal status

What is published over life cycle ?

Conclusion:

- In (many)(some) countries the public life of an application only starts after granting
- In (many)(some) countries only file inspection discloses technical teaching and scope of protection
- That violates the basic concept of the patent system to grant protection in exchange of disclosure
- It also prevents early information on possible infringement of potential patent rights.

Checking before grant

- i.e. after agreement on acceptable claims
- Publication of grant has to comply with certain additional requirements beyond novelty, etc
- These requirements are usually defined in separate regulations, and may vary from country to country
- Only what is defined in regulations can be enforced, e.g. by rejection
- The following gives only some general guidance

Components of a patent document to be checked for grant

- ▶ Bibliographic data (frontpage)
- Title, abstract, applicant(s), inventor(s), priorities,
..
- ▶ Description part
- Problem to be solved, prior art,
inventive idea, embodiments
- ▶ Drawings
- ▶ Claims
- ▶ (State of art search report)



Checking

- Nothing added to initial disclosure, in
 - Claims
 - Description
 - Drawings
- Sufficient disclosure of inventions in a patent application
- Title not too general
- Abstract referring to solution not only problem or general background

Checking

- Drawings:
 - Reference numerals included
 - Quality
- Description
 - Inclusion of relevant state of the art (e.g. in case of two part claims)
 - Check that no additional “beneficial” features of invention are introduced in this way
 - Problem to be solved should be mentioned & solution (e.g. amended wording of claims)
 - No derogative or promotional statements

Thank you

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