

Committee on Development and Intellectual Property (CDIP)

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OVERVIEW OF THE GUIDE ON IDENTIFYING INVENTIONS IN THE PUBLIC DOMAIN: A GUIDE FOR INVENTORS AND ENTREPRENEURS

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1. The Annex to this document contains an Overview of the Guide on Identifying Inventions in the Public Domain: a Guide for Inventors and Entrepreneurs, developed in the context of the project on Use of Information in the Public Domain for Economic Development (document CDIP/16/4 Rev.). The Overview of the Guide describes the purpose and basic concepts used in the Guide and describes the training approach and tools to effectively use it.

2. *The CDIP is invited to take note of the information contained in the Annex to this document.*

[Annex follows]

GUIDE ON IDENTIFYING INVENTIONS IN THE PUBLIC DOMAIN: A GUIDE FOR INVENTORS AND ENTREPRENEURS¹

OVERVIEW OF THE GUIDE

The purpose of the guide is to help determine whether specific inventions appear to be protected by enforceable patents, or may be in the public domain. The guide teaches the steps involved in making this determination, and provides training and tools for each step.

Because patent rights are national in scope and have a limited duration, the guide teaches how to carry out these steps using a complete technical description of a specific invention in combination with information about the countries where the invention might be used and the time frame for use. The guide also educates about limits and risks associated with each step.

Basic concepts used in the guide

The guide defines inventions, patents and public domain (Module I) as follows:

Invention: A product or process that provides a new approach to doing something, or offers a new technical solution to a problem. An invention has one or more features that contribute to producing a technical effect that provides the new approach or technical solution.

Patented invention: A patent grants rights in a patented invention. These rights are:

- defined by the claims of the patent;
- effective in the country that granted the patent;
- enforceable for a limited time.

A patent grants the patent owner the right to stop or prevent others from practicing the patented invention without the patent owner's consent in the country that granted the patent, at any time when the patent is in force.

An invention may be covered by multiple patents. For example, a previous patent may cover a single feature of the invention, or multiple features of the invention. An invention may be covered by multiple patents, each of which covers a different feature or a collection of features found in the invention.

Public domain invention: A public domain invention is:

- a publicly disclosed invention;
- not covered by any enforceable patent rights;

in a specific country, at a defined time, such that anyone may freely use that invention in that country at that time, without liability for patent infringement.

Because an invention may be covered by multiple patents, determining whether an invention may be a public domain invention requires searching and analyzing published patent documents to determine whether there are *any* enforceable patents with claims that might cover the invention as a whole, or might cover *any* feature of the invention, in a specific country during a defined time frame.

¹ The full Guide will be available at: https://www.wipo.int/ip-development/en/agenda/work_undertaken.html

Using this conceptual framework, the guide teaches a three-stage process for searching and analyzing published patent documents using the tools of freedom to operate (FTO) determination.

DESCRIBE (Module II)

- Gather information about the invention:
 - What is the invention and what does the inventor plan to do with it?
 - Where does the inventor plan to use the invention?
 - When does the inventor plan to use the invention?
- Describe the invention and its planned use.

SEARCH (Module III)

- Break down the invention into parts and identify features to search.
- Choose search parameters and resources: keywords; patent classification symbols; databases; countries; year(s); language(s).
- Search for patent documents with claims that might cover the invention or one of its essential features, and identify potentially relevant documents to analyze.

ANALYZE (Module IV)

- Analyze each potentially relevant patent document:
 - Analyze claims to determine the scope of patent rights. Could a claim be interpreted in such a way that it might be found to cover the invention or one of its essential features?
 - Determine the legal status of each analyzed patent. Is it still in force? If so, where is it enforceable and for how long? If not, is it expired, abandoned, invalidated, disclaimed or revoked? Is the legal status ambiguous or unsettled?

Possible outcomes of carrying out informal FTO analysis using the tools taught in the guide include:

- Enforceable patents are found with claims that could be interpreted in a way that they might be found to cover the invention or one of its essential features, in a specific country and during the time frame of planned use.
- No enforceable patents are found with claims that might be found to cover the invention or any of its features, in a specific country during the defined time frame.
- No final determination can be made.

Module V reviews limits and risks associated with the FTO determination process and suggests risk management strategies to minimize risks at each stage in the process.

Using the guide: Skills, training, tools and strategies

Skills: The guide assumes readers already have a sound knowledge of intellectual property (IP), patent databases and patent information search skills, including: basic working knowledge of IP and IP rights; basic knowledge of patents and patent systems, including the process for filing and prosecuting patent applications, the function and purpose of patent claims, basic knowledge of national and international patent systems; and basic knowledge of patent searching including the use of keywords, patent classification systems, and search operators, the ability to evaluate and select patent databases based on search needs, and the collection and organization of search results.

Training: Each module begins with a list of learning points that summarizes the knowledge and skills readers should have acquired after completing the module. The guide provides detailed explanations of the principles and process of each step, and teaching examples that illustrate how to carry out these steps. This training is intended to provide readers with useful professional skills to carry out their own projects using the tools of FTO determination, contributing to enhancing their patent search and analysis skills. The guide also provides

valuable training to help understand the potential limitations, errors and risks associated with this process, and to take steps to manage these risks, and helps address common misconceptions about patent rights and the public domain.

Tools: The guide contains a number of practical tools (Annexes) to use the guide effectively, including comprehensive checklists for Module II (gathering information), Module III (FTO searching), and Module IV (FTO analysis); templates for reports and claim charts to provide structure and guidance for carrying out specific actions and generating work products for each stage of the process; and a list of additional tools and resources that may be useful, such as WIPO publications, online tools and training materials.

Strategies: Readers can choose how to approach the guide according to their own skills, needs and interests. Because of the large amount of detailed information presented in the guide, the guide suggests strategies for becoming familiar with its content and for using it to carry out a project.

[End of Annex and of document]