

DRAFTING A COMMERCIALY RELEVANT PATENT



PATENTS

Q. What is a Patent?

1. A Patent is grant issued by the Government through the Intellectual Property Office.
2. It is an exclusive right granted for a product, process or an improvement of a product or process which is **new, involves an inventive step** and is **industrially applicable**.
3. This exclusive right gives the inventor the right to exclude others from making, selling or using the product or process of the invention without his permission during the life of the patent granted in the country or countries where it was filed.
4. In return the patent owner must share the full description of his invention.
5. This information on the patent is available to the public through the patent database in the patent office of different States and thru the Internet.

PATENTS

- 1. TECHNICAL DOCUMENT**
- 2. LEGAL DOCUMENT**
- 3. SWORD**
- 4. SHIELD**

PATENTS

Q. What rights does a patent owner have?

Rights of the patent owner:

- may decide who may or may not use the patented invention for the period in which the invention is protected
- may give permission to, or license others to use the invention on agreed terms
- may sell the right to the patent to others
- may prevent others from making, using or selling the product of his invention during the life of the patent

Q. What is the term of a patent?

- the term of the patent protection is twenty (20) years from the date of filing with annuity payments to maintain the patent

PATENTS

Q. Why are Patents necessary?

1. Provides incentives to individuals recognition and material rewards.
2. Assures the continuous enhancement of the quality of life.
3. Can be utilized for as basis for future research and will in turn promote further creativity, innovation and technological development.

PATENTABLE INVENTIONS

ANY TECHNICAL SOLUTION OF A PROBLEM IN ANY FIELD OF HUMAN ACTIVITY WHICH IS NEW, INVOLVES AN INVENTIVE STEP AND IS INDUSTRIALLY APPLICABLE SHALL BE PATENTABLE.

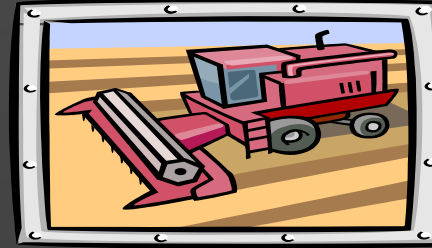
STATUTORY CLASSES of PATENTABLE INVENTIONS

1. A product
2. A Process
3. Microorganism
4. Non-biological or microbiological processes
5. Computer-Related Inventions
6. Any improvement of any of the foregoing.

Examples of Patentable Inventions

- A useful machine

e.g. biogas digester
threshing machine



- A product

e.g. pharmaceutical product (vaccine for bovine coronavirus; chemical substance/composition)

- A process or method

e.g. Method for Treating Hoof Infection



- Non-biological process

e.g. A method of treating a plant characterized by the application of growth- stimulating substance or radiation.

- Microbiological process

e.g. A process of isolating the bacteria from the soil....



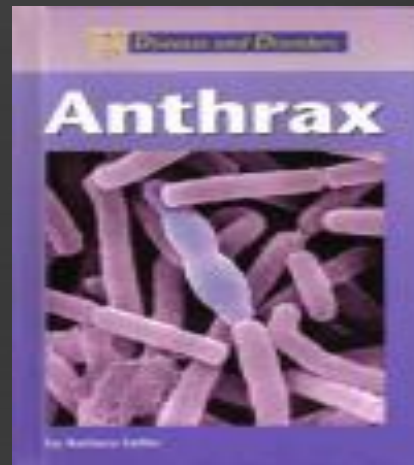
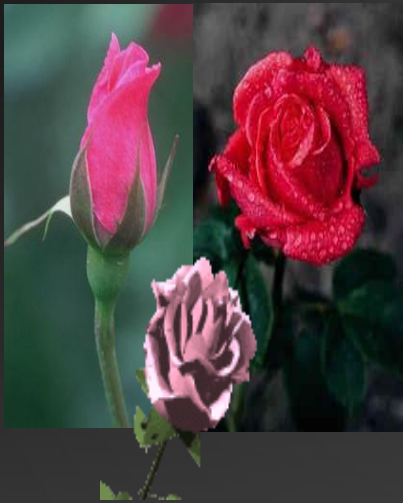
NON-PATENTABLE INVENTIONS

1. Discoveries
2. Scientific theories
3. Mathematical methods
4. Schemes, rules and methods of
 - performing mental acts
 - playing games
 - doing business
 - programs for computers
5. Methods for treatment of the human or animal body by surgery or therapy & diagnostic methods practised on the human & animal body



NON-PATENTABLE INVENTIONS

6. Plant varieties or animal breeds or essentially biological processes for the production of plants and animals
7. Aesthetic creations
8. Contrary to public order or morality



RIGHT TO A PATENT

The right to a patent belongs to the inventor, his heirs, or assigns. When two (2) or more persons have jointly made an invention, the right to a patent shall belong to them jointly.

WHO MAY FILE A PATENT

1. NATURAL PERSON/s

2. JURIDICAL PERSON/s

FIRST-TO-FILE RULE

The Right to a Patent shall belong to:

- 1. Person/s who filed an application**
- 2. Person/s who has the earliest Filing Date or Priority Date**

RIGHT OF PRIORITY DATE

Patent Application **"A"** was filed on **August 3, 2022** in home country, e.g. INDIA

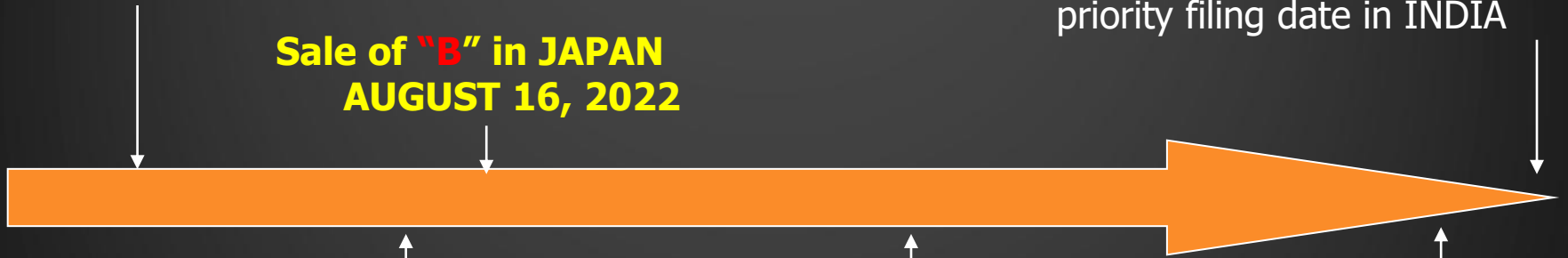
"A" Must be filed in JAPAN on or before **August 3, 2023** to avail of the effect of the priority filing date in INDIA

**Sale of "B" in JAPAN
AUGUST 16, 2022**

"B" Filed same application in JAPAN **AUGUST 9, 2022**

"C" Filed same application in JAPAN **AUGUST 30, 2022**

"A" Filed in JAPAN **AUGUST 1, 2023**



NON-PREJUDICIAL DISCLOSURE

Not Prejudicial to the filing of an Application:

- Disclosure by the inventor must be filed within one (1) year from the time of disclosure in the Philippines
- Other countries have different grace periods

NON-PREJUDICIAL DISCLOSURE

Country	General grace period for any sort of public disclosure	Grace period for utility models
US	1 yr	The US does not register utility models
Canada	1 yr	
Japan	1 yr	
Russia	6 months	
Korea	12 months	.
Singapore	12 months	
Germany	6 months	
Portugal	6 months	
China	6 months	

EXAMINATION OF PATENT APPLICATION

- 1. FILING OF THE APPLICATION AND ASSSIGNMENT TO THE EXAMINER**
- 2. FORMALITY EXAMINATION**
- 3. FIRST PUBLICATION after 18 months from fiing (With Search Report)**
- 4. REQUEST FOR SUBSTANTIVE EXAMINATION**
- 5. SUBMISSION OF 3rd PARTY OBSERVATION (if any)**
- 6. SUBSTANTIVE EXAMINATION (Ex-Parte Proceedings)**
- 7. GRANT [OR FINAL REFUSAL which is Appealable)]**
- 8. SECOND PUBLICATION OF THE PATENT GRANT**
- 9. ISSUANCE OF LETTERS PATENT CERTIFICATE**

PROVISIONAL PATENT APPLICATION

Provisional Patent Application (PPA) is a document issued by the U.S. Patent and Trademark Office (USPTO) that **helps protect a new invention from being copied during the 12-month period before a formal patent application is filed.**

PROVISIONAL PATENT APPLICATION

The provisional patent application will provide you with one full year in which you can make your invention better before officially patenting it. During the one year period, **you will be able to legally claim the “patent pending status”**.

PROVISIONAL PATENT APPLICATION

Provisional patent applications are **not published** since they are not examined and they are only pending at the U.S. Patent Office for 12-months. After 12-months, a provisional patent application automatically becomes abandoned and therefore will never be published.

PATENTABILITY REQUIREMENTS

1.NOVELTY

2.INVENTIVE STEP

3.INDUSTRIAL APPLICABILITY

NOVELTY

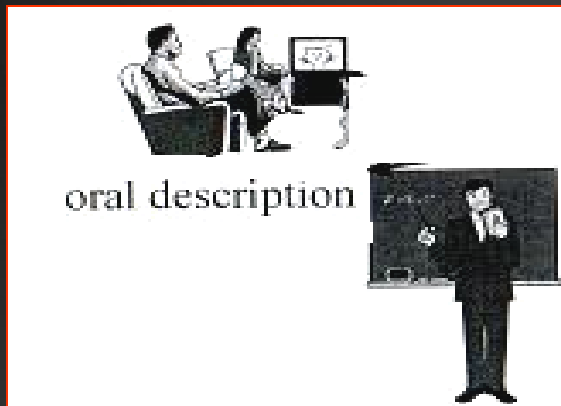
“An invention shall not be considered new if it forms part of Prior Art.”

Prior Art :

1. Everything which is made available to the public anywhere in the world, before the filing date or the priority date of the application.

- patents & registered utility models and industrial designs
- printed publications (printed and published)
- prior knowledge
- prior use and sale

PRIOR ART - Everything made available to the public
anywhere in the world by means of:



Or in any other way
.... Before the FILING DATE
of the Patent or Utility Model Application

INVENTIVE STEP

An invention involves an inventive step if, having regard to prior art, it is **NOT OBVIOUS** to a person skilled in the art at the time of the filing date or priority date of the application claiming the invention.

Inventive Step/Obvious

1. Not beyond normal progress of Technology
2. Follows plainly or logically from Prior Art
3. Does not require skill or ability beyond that to be expected of the person skilled in the art

Person Skilled in the Art

- 1. Ordinary practitioner (fictional person)**
- 2. Has access and understanding to all the prior art**
- 3. Aware of common general knowledge in the specific art**
- 4. Observes developments in the related technical field**
- 5. Could be a team**
- 6. No inventive ability**

Industrial Applicability

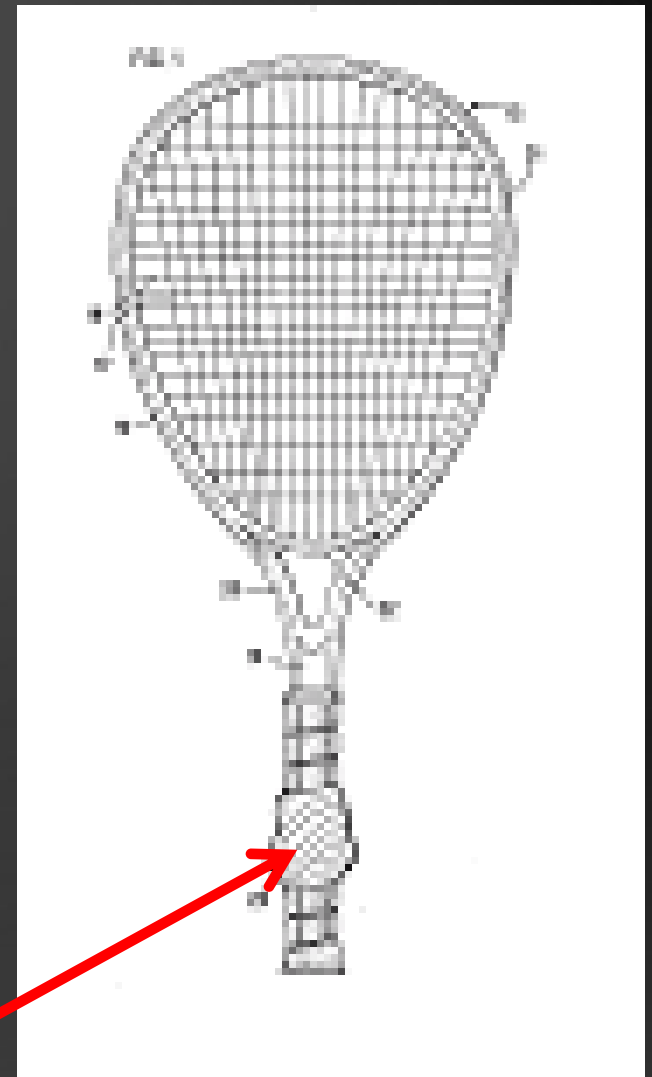
An invention that can be produced and used in any industry shall be industrially applicable.

EXAMPLE

Problem: Gripping problems with regards to handles of sports rackets such as tennis rackets greatly affects the performance of the player.

Solution: A gripping contour is provided on the handle of the racket to allow a firm grip thereon.

GRIPPING CONTOUR



CLAIMS

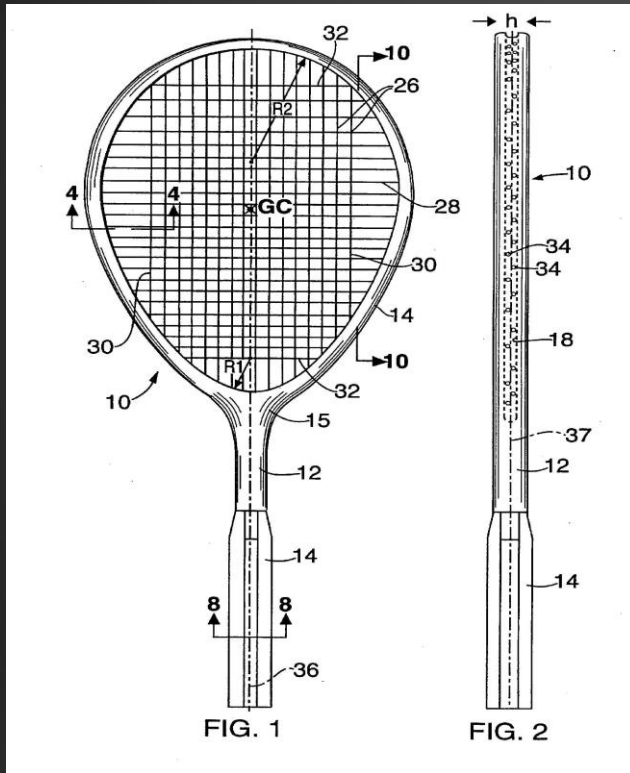
1. A sports racket comprising a body having a head portion provided with strings, a shaft and a handle extending from said shaft, characterized in that, said handle being provided with a gripping contour.

2. A sport racket in accordance with claim 1, characterized in that, said gripping contour being defined by a protuberance disposed substantially at the intermediate portion of said handle.

CLAIMS

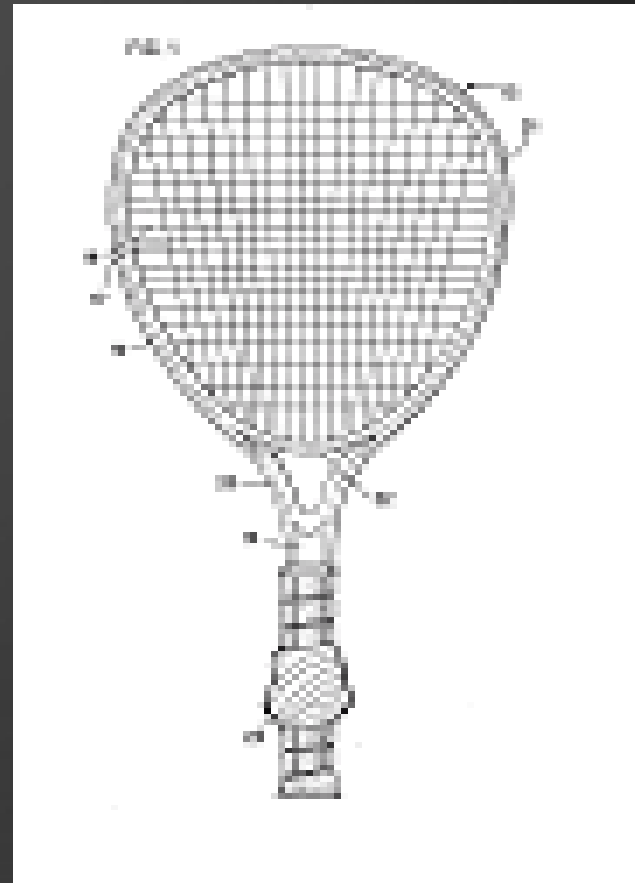
3. A sports racket according to claims 1 or 2, characterized in that, said protuberance having a hand grip pattern on the surface thereof.

NOVELTY ISSUE:



Prior Art A

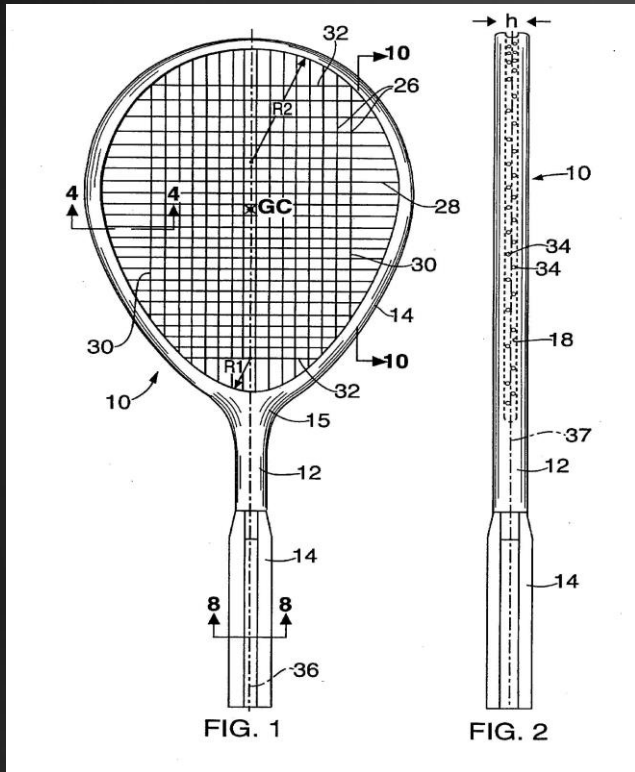
Teaches a tennis racket



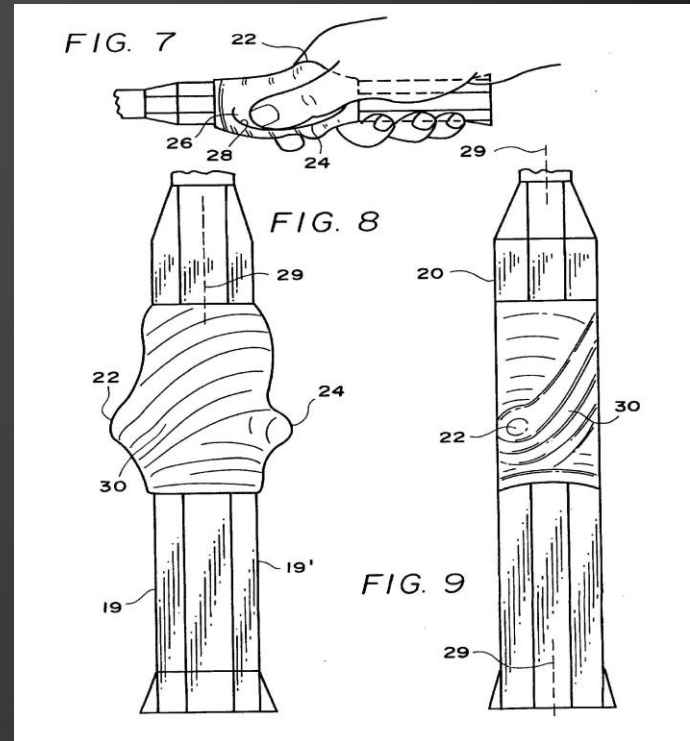
INVENTION

Tennis Racket with Gripping Contour

INVENTIVE STEP ISSUE:



+



Prior Art A

Teaches a tennis racket

Prior Art B

Teaches a gripping contour on the handle of a sports racket

EXAMPLE

GOLF BALL CASE

(Selection of known material based on its suitability for the intended use)

1. **Problem**

- Abrasion Resistance

2. Solution to the Problem

- Applying *rigid polyurethane* material to the surface of the golf ball

3. **No Inventive Step**

- *Rigid polyurethane* is known to be highly abrasion resistant
- Applying the substance to solve the abrasion problems in golf balls would be an obvious matter to a person skilled in art

4. **Might be Inventive, IF**

- There is an improved and unexpected result by significantly increasing the flight of the ball (strong evidence of the presence of invention)

THE PCT

Q. What is the Patent Cooperation Treaty (PCT)?

BENEFITS FROM PCT:

1. Facilitates obtaining protection for inventions in any or all PCT contracting States.
2. It provides for the filing of **one patent application (the international application)**, with effect in several States, instead of filing several separate national and/or regional patent applications.
3. Gives the applicant more time and a better basis for deciding whether and in what countries to further pursue the patent application.
4. Means for evaluating chances of obtaining a patent.
5. Enables assessment of economic value of the invention.

The PCT Procedure

➤ International Phase

- ✓ Filing
- ✓ International Search & Written Opinion
- ✓ International Publication
- ✓ International Preliminary Examination

➤ National Phase

UTILITY MODELS

- Short-Term Patents
- Utility Innovations or Innovation Patents
- Small **improvements** to, and **adaptations** of, existing products or that have a **short commercial life**.
- Utility Model systems are often used by local inventors.

UTILITY MODELS

- **Only Formality Examination (Philippines)**
- **No Substantive Examination**
- **Seven (7) years protection from filing date without renewal**
- **Requires a Registrability Report for Enforcement (Infringement Cancellation Cases)**

REQUIREMENTS FOR FILING A PATENT or UTILITY MODEL APPLICATION

1. Application Form
2. Specification and Claims
3. Drawings, if any
4. Payment of Fees (Filing fee, fees for excess claims, Deed of Assignment, etc.)
5. Other Documents (if needed):
 - a. Certified copy of corresponding foreign application (if priority date is claimed)
 - b. Deed of Assignment
 - c. Power of Attorney

CONTENTS OF THE SPECIFICATION

1. Abstract of the Disclosure
2. Title of the Invention
3. Technical Field
4. Background of the Invention
5. Summary of the Invention
6. Brief Description of the Drawings
7. Detailed Description
8. CLAIMS/s

CONTENTS OF THE SPECIFICATION

1. Abstract of the Disclosure

- a. Concise summary of the disclosure of the invention
- b. Preferably not more than 150 words
- c. It must allow clear understanding of the following:
 - i. the technical problem
 - ii. the gist of the solution of the problem through the invention, and
 - iii. the principal use of the invention

CONTENTS OF THE SPECIFICATION

2. Title of the Invention

- a. Short and specific as possible
- b. Fancy names are not permissible in the title
- c. Heading in the first page of the specification

3. Technical Field

- a. Statement of the field of the art to which the invention/utility model pertains
- b. Statement should be directed to the subject matter of the invention/utility model

CONTENTS OF THE SPECIFICATION

4. Background of the Invention

a. Related prior art or state of the art

- specific prior art documents
- practices, methods, devices, etc.

b. Specific Problems in the technology of the prior art to be solved by the proposed invention/utility model

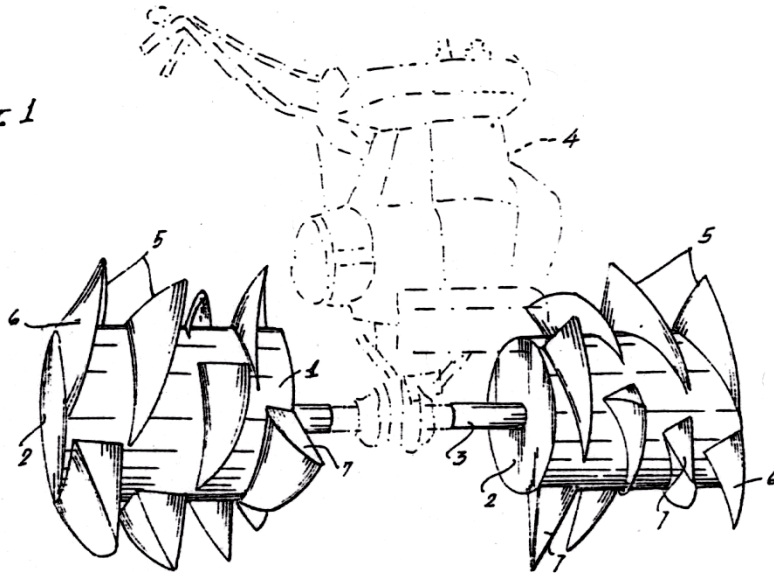
CONTENTS OF THE SPECIFICATION

5. Summary of the Invention

- a. Brief Summary of the Invention
 - b. Technical Solution to the problem/s of the technology
 - c. Advantages of proposed invention/utility model
- For each item/s point out why the invention/utility model is better

EXAMPLE

Fig. 1

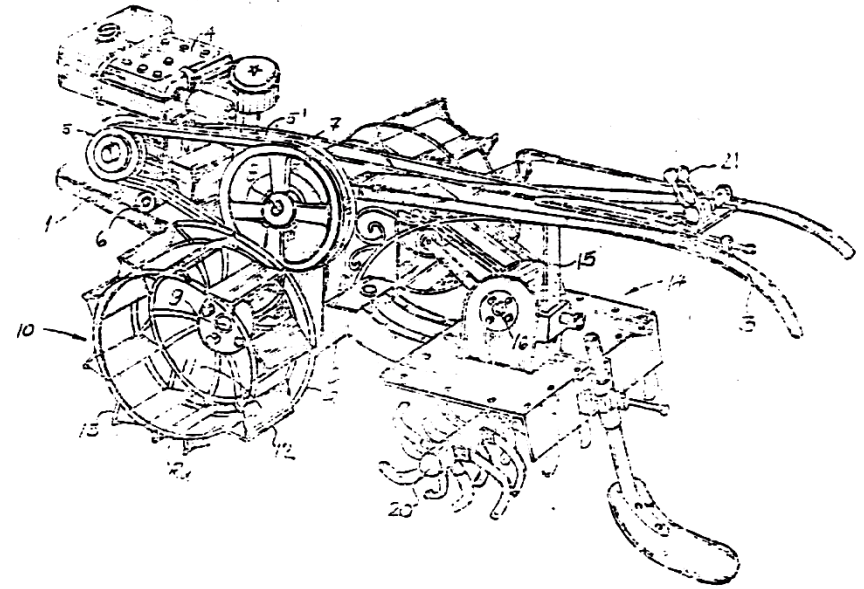


Proposed Invention

- a. Multiple tillage operation
- b. Soil is sliced, scooped, thrown rearwardly and inwardly
- c. More efficient tillage

“paddy wheels”

Fig. 1



Prior Art

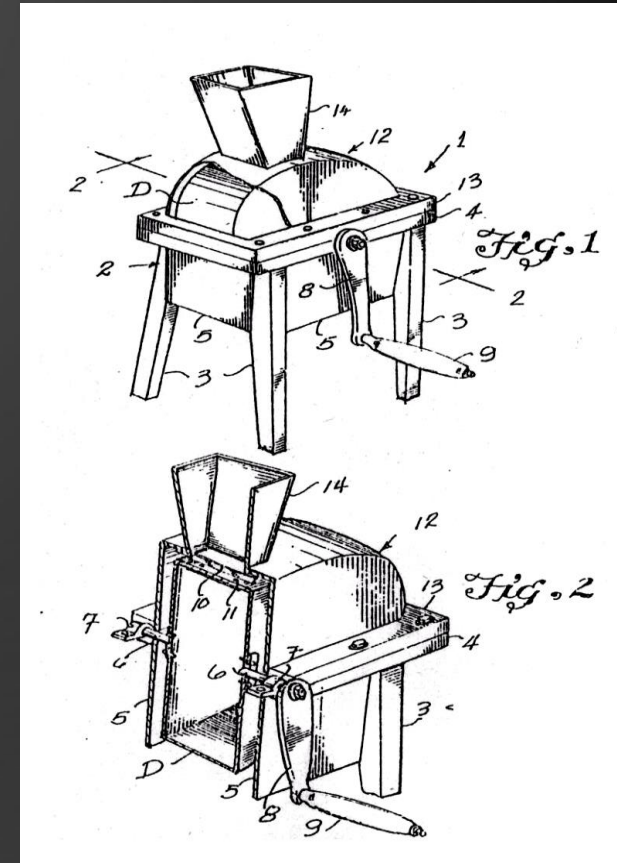
- a. Tillage operation is limited
- b. Soil is only sliced

CONTENTS OF THE SPECIFICATION

6. Brief Description of the Drawings

Figure 1 is a perspective view of the present invention for a root crop chipper; and

Figure 2 is a sectional view taken along line 2-2 of figure 1.



CONTENTS OF THE SPECIFICATION

7. Detailed Description of the Invention

- a. Complete Description of the manner of making constructing, compounding and using the invention/utility model
- b. Description must:
 - Be in such full, clear, concise and in exact terms
 - Enable person skilled in the art of science to make, construct, compound and use the invention/utility model
- c. Best Mode of Carrying-Out the Invention

CONTENTS OF THE SPECIFICATION

8. CLAIM/S

- a. Defines the “meets” and “bounds” of the invention
- b. It must point out and distinctly claim the part, improvement or combination which the applicant regards as his invention/utility model
- c. Clear, concise and fully supported by the description
- d. One Sentence Form

CONTENTS OF THE SPECIFICATION

PARTS OF A CLAIM

1. The PREAMBLE provides the name of the subject matter, or prior art environment associated with the subject matter.
2. The BODY contains
 - a. The recital of elements (structures, steps or parts) which define the invention
 - b. The recitation of the manner in which the elements cooperate or co-act together
3. The TRANSITION
 - a. Links the preamble and body of the claim
 - b. Generally take's the form "comprising" or "which comprises"
 - c. A "colon" (:) is inserted after the transition

CLAIMS

1. A sports racket comprising a body having a head portion provided with strings, a shaft and a handle extending from said shaft, characterized in that, said handle being provided with a gripping contour.

2. A sport racket in accordance with claim 1, characterized in that, said gripping contour being defined by a protuberance disposed substantially at the intermediate portion of said handle.

Basic Differences between Patent, Utility Model and Industrial Design

Categories	Patent (Invention)	Utility Model	Industrial Design
Subject Matter of Protection	Apparatus (Product) & Method (Process)	Apparatus (Product) & Method (Process)	Article of manufacture (Over-all aesthetic and pleasing appearance of the article of manufacture.)
Novelty	YES	YES	YES
Inventive Step	YES	NO	NO
Industrial Applicability	YES	YES	YES
Claim	More than one (1) generic claim is allowed and dependent claims	Only one (1) generic claim is allowed. No limit on the number of dependent claims.	Omnibus type of claim
Ornamental Features of shape, configuration, form, or a combination thereof	NO	NO	YES
Term of Protection	Twenty (20) years from the date of filing with payment of annuities	Seven (7) years from the date of filing without renewal	Five (5) years from the date of filing with 2 five year term renewals upon payment of fees

End of Presentation

