

WIPO-MOST Intermediate Training Course on
Practical Intellectual Property Issues in Business
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Patents

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What is a patent?

Right granted to protect inventions

Balance between patentee's rights
and public interest

Conditions of patentability

- n Patents shall be available for inventions that are new, involve an inventive step (are non-obvious) and are industrially applicable (useful).
 - What is an “invention”?
 - What is “new” (novelty)?
 - What is an “inventive step (non-obvious)”?
 - What is “industrially applicable (useful)”?

Duty of disclosure

- n An invention shall be described in the application in a way that a person skilled in the art can carry out the claimed invention.
- n Publication of applications/patents

Limited term of protection

- n 20 years from the filing date
- n A patentee may withdraw his patent.

Exclusive rights conferred by a patent

- n A patentee can prevent others without his consent from:
 - (a) making, importing, using, offering for sale or selling the patented product;
 - (b) using the patented process and doing any acts in paragraph (a) in respect of a product obtained directly by such process,for commercial purposes.
(Pat. Law, Article 11(1))

- n Protection against infringement

- n Possibility of assigning and licensing the right

Limitation of owner's rights

- n Acts solely for the purposes of scientific research and experimentation.
- n Prior user's right
- n Temporal presence in the territory (Paris Convention, Article 5^{ter})
- n Exhaustion
 - after the sale of a patented product, or of a product that was directly obtained by a patented process, made or imported by the patentee (or with the authorization of the patentee)

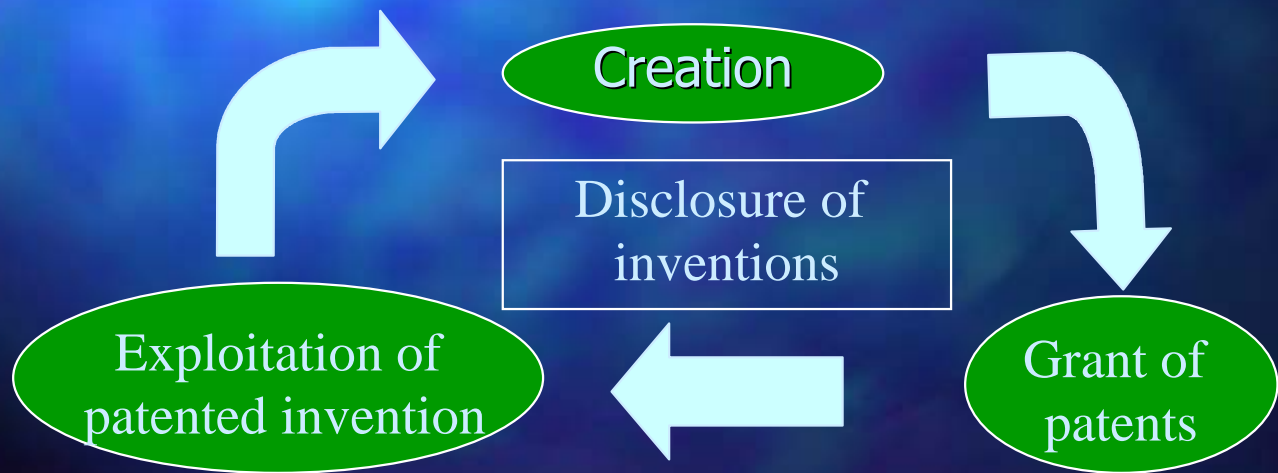
(Pat. Law, Article 63)

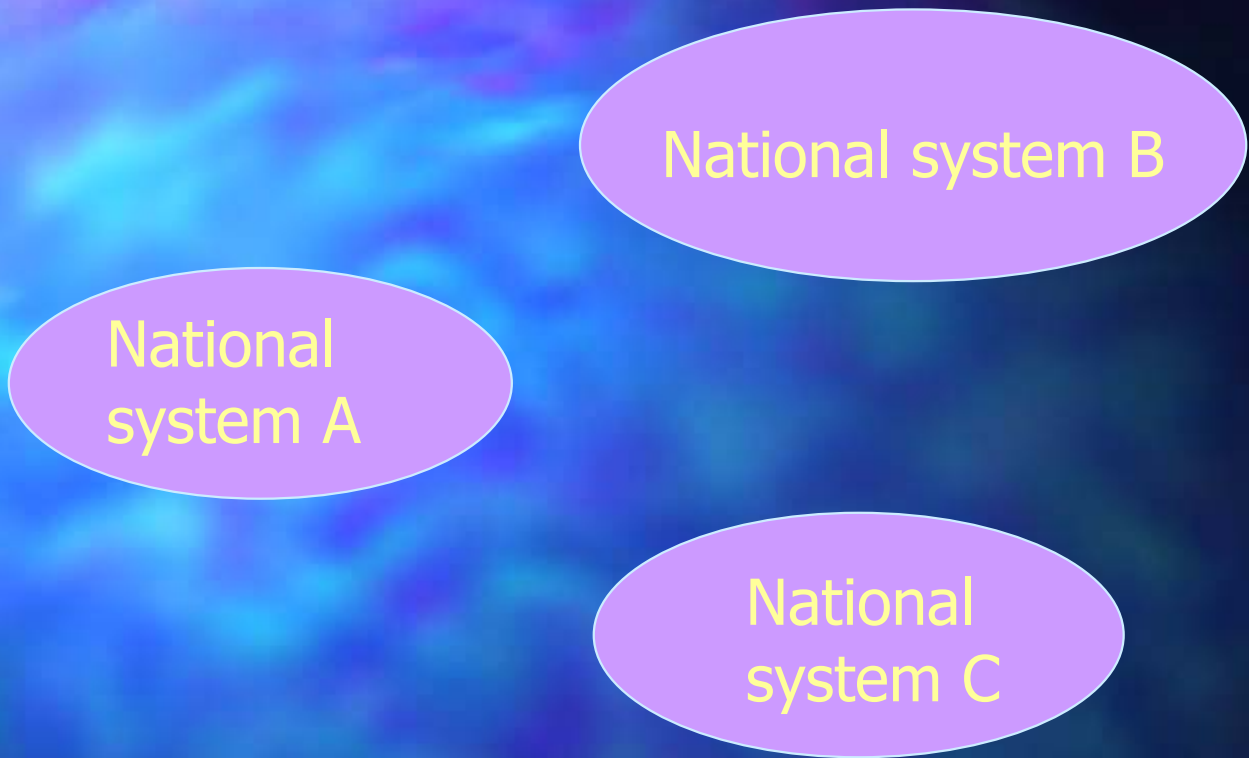
Possibility of appeal

- n Opportunities to challenge decisions made by the patent Office
 - Boards of appeal
 - Courts

Advantages for society

- Stronger market position
- Returns on investments
- Vehicle to market inventions
- Increase in negotiation power
- Source of technological knowledge





Territoriality

Grant and enforcement of patents in its jurisdiction

File a patent application abroad

- n Equal treatments
 - National treatment (Paris Convention, Articles 3 & 4)
 - Most-favoured-nation (MFN) treatment (TRIPS, Article 4)
- n Costs (translations, fees, attorneys...)
- n Potential commercial value

Claiming priority (Paris Convention, Article 4)

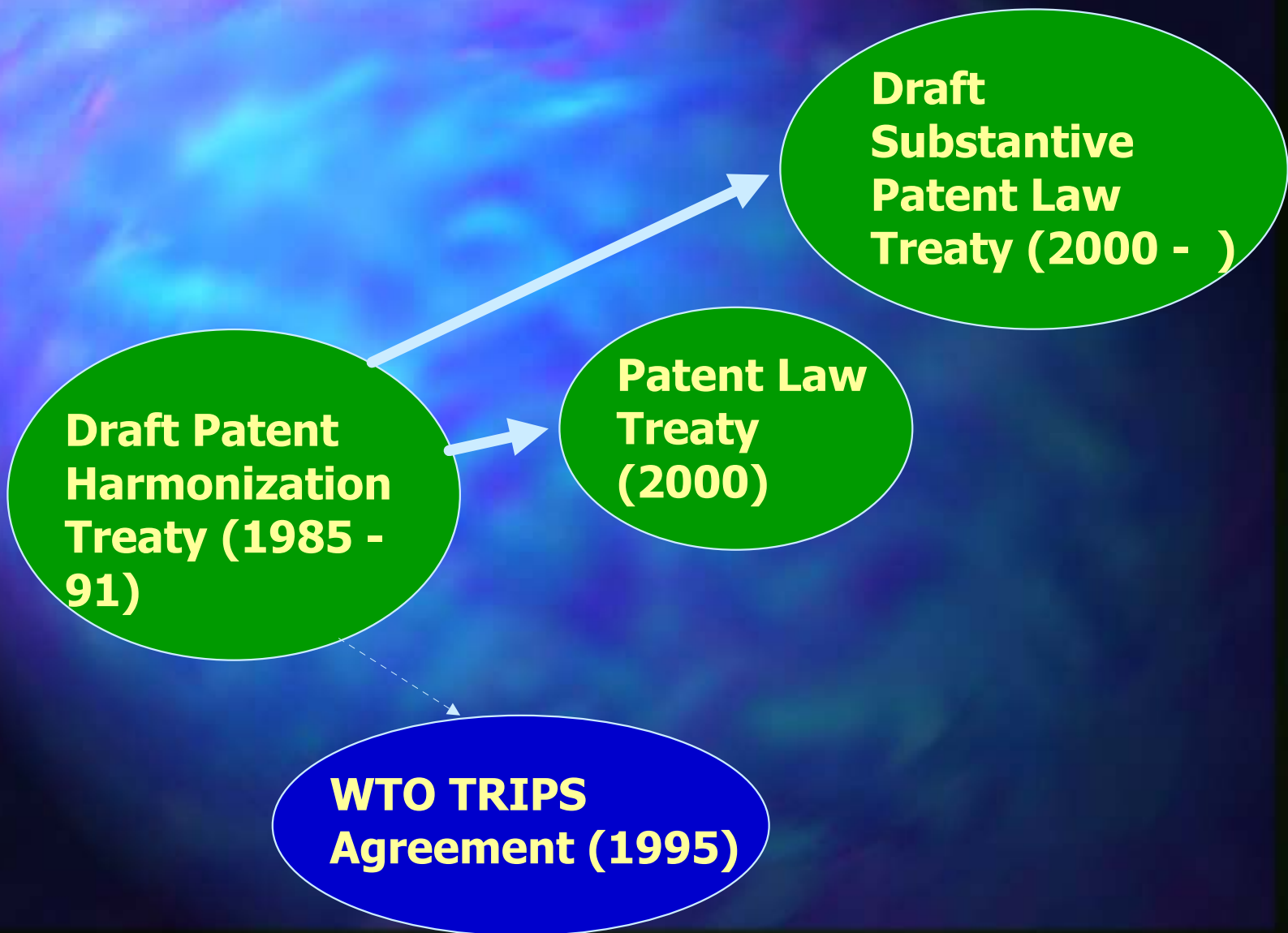


n 164 Member States

Patent Cooperation Treaty (1970)



123 Member States



Challenges

- n Access to patent protection abroad
 - simpler procedure and reduction of costs
 - Patent Law Treaty (PLT)
 - PCT Reform
- n Toward international cooperation re. search and examination - managing workload
 - Draft Substantive Patent Law Treaty (SPLT)
- n Synergy with other areas of public policy
 - (TK, access to GR)
 - Activities under the Intergovernmental Committee (IGC), IPC reform

Patent Law Treaty (PLT)

- n Concluded June 1, 2000
- n Harmonizes and simplifies formal requirements for national and regional applications and patents. Excludes expressly substantive requirements of patentability
- n Entry into force requires accession or ratifications by 10 States. 7 ratifications at this stage (Estonia, Kyrgyzstan, Nigeria, Republic of Moldova, Slovakia, Slovenia, Ukraine).

Advantages of the PLT

Applicants and representatives

- n Predictable, uniform and simple procedures for national/regional/international applications
- n Reduced risk of error or revocation, and opportunity to correct errors
- n Reduction of cost and loss of rights, and enhanced legal certainty

Offices

- n Enhanced efficiency in operation

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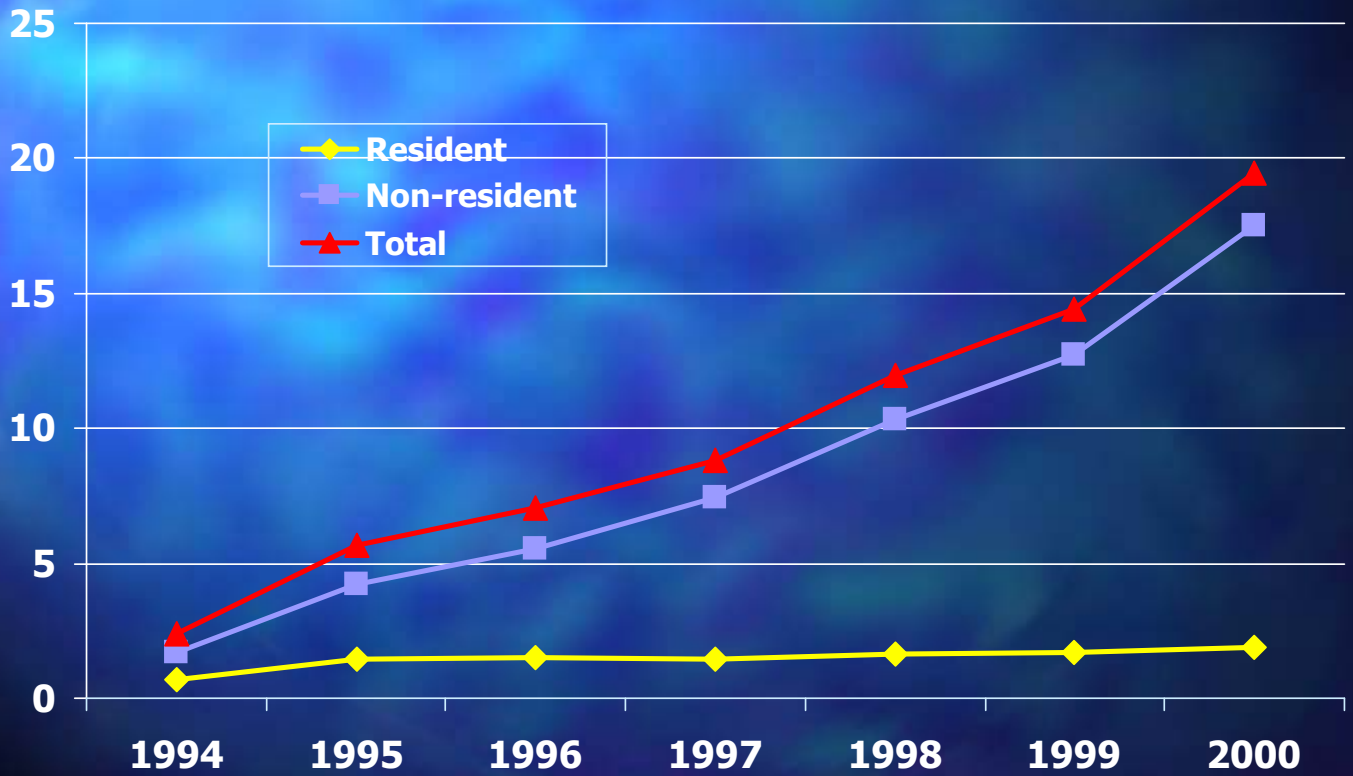
Halfway to paradise

All you need to know about the Patent Law Treaty

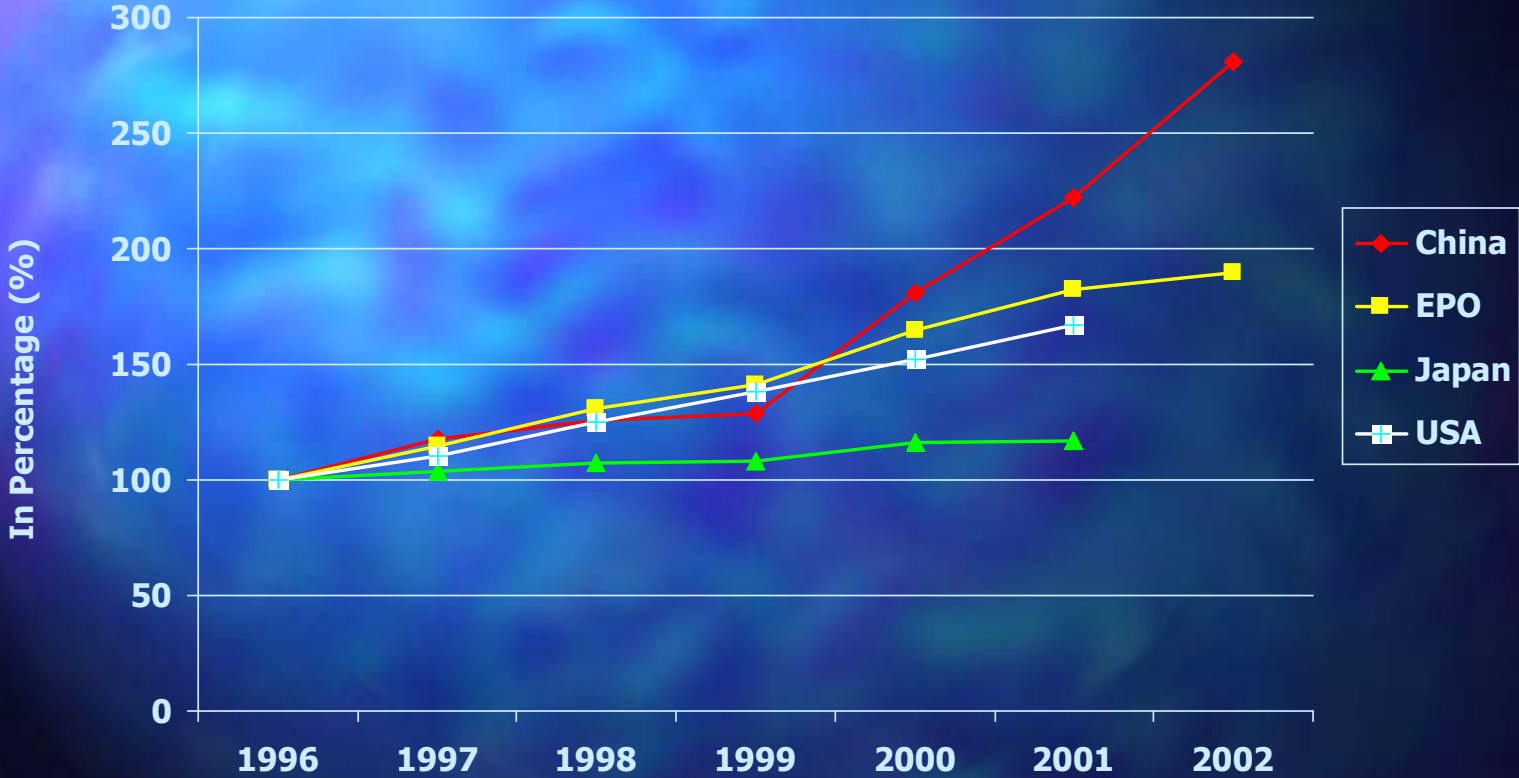
PATENT APPLICATIONS (1994-2000)

Including PCT
designations

Million



INCREASE OF PATENT APPLICATIONS SINCE 1996



Draft Substantive Patent Law Treaty (SPLT)

- n “Deep” harmonization including both law and practice
- n Covers a number of legal principles relevant for the preparation of patent applications and the grant and validity of patents: definition of prior art, novelty, inventive step/non-obviousness and industrial applicability/utility, sufficient disclosure, drafting and interpretation of claims

Why harmonization on grant and validity of patents?

n For States

- Enhanced utility of search and examination report prepared elsewhere
- Basis for work sharing and workload reduction
- Ensure high quality of search and examination

n For applicants

- Single set of substantive requirements
- Enhanced legal certainty and predictability
- Reduction of costs

Multilateral harmonization: Challenges

- n Understand differences
- n Common grounds and flexibility
 - one size does not fit all
 - fear of “TRIPS-plus” standards
- n Depends on political will for real progress

Where is our “paradise”?



**National
System**

**Regional and
International
Arrangements**



Thank you!

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