

WIPO-WASME Special Program on Practical
Intellectual Property Rights Issues for Entrepreneurs,
Economists, Bankers, Lawyers and Accountants
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Patents

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Inventor's interest / Competitor's interest

- n Strong monopoly
- n Keep the invention secret
- n Long duration
- n I invented, so I should be protected!
- n Ideas of others should be free to use
- n All the ideas should be available to the public
- n Short duration
- n Minimum protection

Where is the balance?

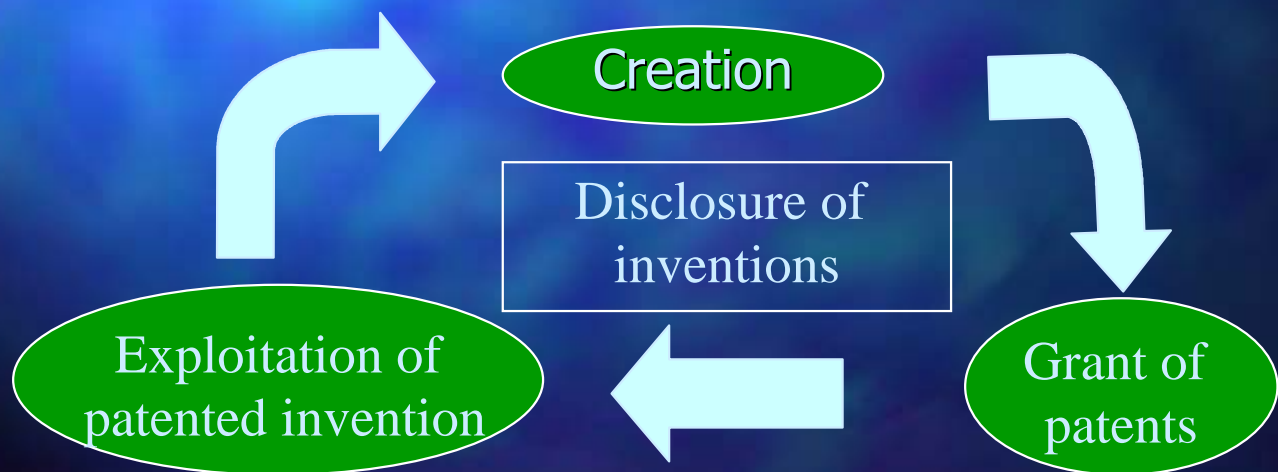
What is a patent?

- n Right granted to protect inventions
- n Right to exclude others from using a patented invention without patentee's consent --- licensing
- n Duty of disclosure
- n Limited term of protection (20 years)
- n Conditions of patentability

Balance between patentee's rights and public interest

Advantages for the business

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



Conditions of patentability

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

Patentable subject matter

- n In general, an “invention” means a solution to a specific problem in a field of technology.
- n An invention may relate to a product or process.
- n General Exceptions
 - basic theories (scientific theories, math. methods...)
 - abstract ideas (mental acts, methods of playing games or doing business...)
 - public concerns (morality, plants and animals, methods for the treatment...)
 - subject matter protected by other IPR titles (aesthetic creations, plant varieties...)

Novelty

n An invention is new if it is not anticipated by prior art.

n Prior art

Knowledge made available to the public before the filing date (priority date)

- by written publication anywhere in the world
- by oral disclosure, use or in other way [anywhere in the world][in the country concerned]

n Examples

Inventive step

- n Having regard to the prior art, an invention may not be obvious to a person skilled in the art on the filing date (priority date).
- n Examples

Industrial applicability

- n An invention can be made or used in any kind of industry.
- n Examples

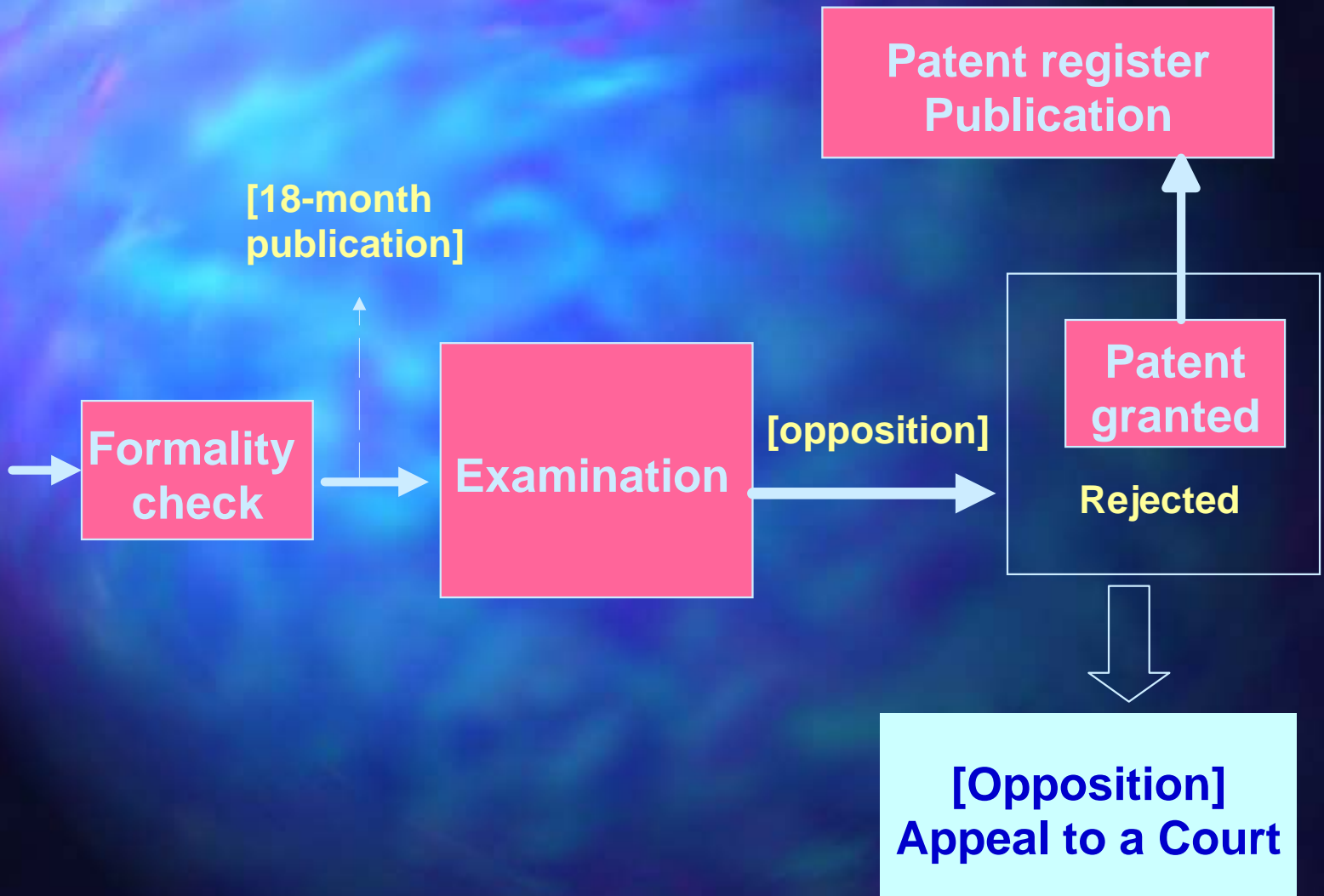
Who has the right to a patent?

- n Inventor(s) or his successor in title
- n If two or more persons have made the same invention independently, the person whose application has the **earliest filing date** (or the earliest priority date) shall have the right to a patent.
- n Employee's inventions

Patent application

- n Request (name and address of the applicant, inventor, agent (if any); title of the invention)
- n Claim(s) = define the subject matter for which protection is sought
- n Description (background art, operative embodiments or examples, advantages)
- n Drawings, if needed
- n Abstract = technical information only

+ statements, power of attorney...



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.

- n Protection against infringement

- n Possibility of assigning and licensing the right

Limitation of owner's rights

In general...

- n The patent rights extend only to acts done for industrial and commercial purposes.
- n The patent rights don't extend to acts done for scientific research.
- n Prior user's right
- n Compulsory licenses

Enforcement of rights

- n A patent is not just a "paper".
- n Patent owner <----> Alleged infringer

- n Options available
 - find a knowledgeable lawyer
 - send a "cease and desist letter"
 - negotiate
 - possibility of arbitration and mediation
 - go to court (injunctions, damages...)

A defendant may claim...

- n The scope of the patented claim does not cover the alleged infringement.
- n The patent is null and void.
 - Entitlement, novelty, inventive-step, sufficient disclosure...
- n The patent right does not extend to acts by the defendant.
 - Scientific research, prior use...
- n May negotiate licensing, cross-licensing

How to get a patent abroad?

Why do we need a patent abroad?

Territoriality (Grant and enforcement of patents in its jurisdiction)

- n Filing a patent application with national or regional offices* claiming the right of priority under the Paris Convention
- n Filing an international patent application under the Patent Cooperation Treaty (PCT)

* **European Patent Office (EPO), Eurasian Patent Office (EAPO), Organisation africaine de la propriété intellectuelle (OAPI), African Regional Industrial Property Organization (ARIPO)**

Claiming priority



- n 12 months to decide:
 - commercial value
 - costs (translations, fees, attorneys...)

Alternatives to patent protection

n Utility models

- less stringent requirements
- cheaper
- simpler procedure
- shorter term of protection
- may be limited to products or certain fields of technology

n Trade secrets

Pros and cons



Thank you!

<http://www.wipo.int>