

■ **Topic 3: Filing a Patent Application – Who, When, Where [What] and Why**

Harare
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Roadmap

1. The Patent bargain
2. Why do people file patent applications?
3. Who has the right to a patent?
4. When to file? As early as possible?
5. Territoriality: Selection of territories
6. Filing routes for filing abroad
7. Is filing a patent application always the best way to exploit an invention?

Why?

Why should a patent application be filed?

A patent is an exclusive right that allows its proprietor to **exclude others from practicing the protected invention without the proprietor's consent.**

The patent owner can decide who may use the protected invention

- Use by oneself
- Use by others
- Sell

May be more powerful than tangible property

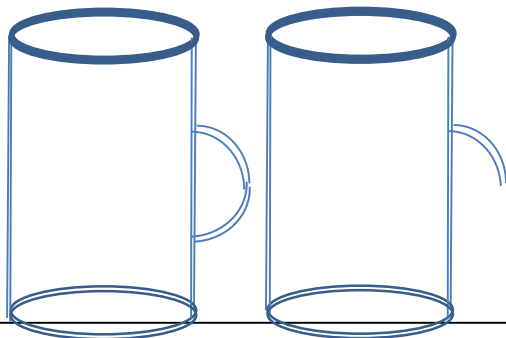


The Patent Bargain

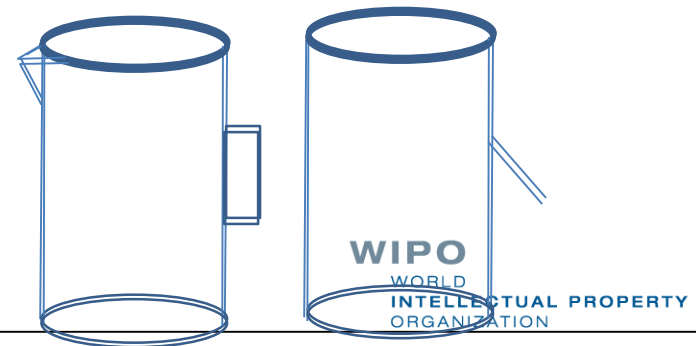
- **Society** gives:
 - A 20 year exclusive right in a defined area around an innovative new invention with industrial application
- In return, a **patentee** gives:
 - Full disclosure of the invention

Competitors may design around / use unpatented (or patent expired) technology

**Claim 1 =
Drinking vessel+ crescent-shaped handle**



Design-around



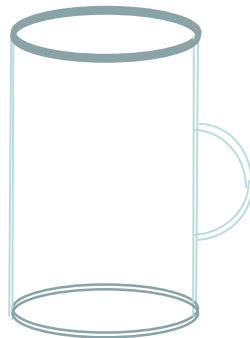
Licensing a patent

- **license**, other parties to use the invention on **mutually agreed** terms.
- **sell the right to the invention to someone** else, who will then become the new owner of the patent.

Licenses

- *Source of income*
- *No need to practice the invention yourself*
- *Choice of exclusive licensee or multiple licensees*

Claim 1 = Drinking vessel+ handle



Licensee:



WIPO
WORLD
INTELLECTUAL PROPERTY
ORGANIZATION

Reasons for filing patent applications

A. For control:

- i. To protect investment in R&D
- ii. To get leverage against competitors
- iii. To control suppliers

B. For financial and business reasons:

- i. To support a licensing-out program
- ii. To minimise licensing-in royalties
- iii. Cross-licensing
- iv. To increase company “book value”; create tradable assets

C. For prestige:

- i. To gain reputation for innovation
- ii. To motivate researchers

Who?

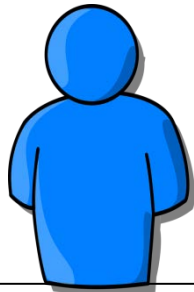
Who is entitled to a patent?

- The right to a patent in most jurisdictions belongs to the **inventor or his successor in title**.
 - **Natural person(s)** who conceived the claimed invention
 - Can be more than one person (joint inventors)

Who is entitled to a patent?

- The right to a patent can be **transferred from the inventor(s) to** a third party (ex. **the applicant**)
 - **Natural or legal** person(s)
 - Joint applicants possible
 - Inventor of the invention and the applicant of the patent application need not to be the same person(s).

Invention by employees/researchers of public universities and institutions



- Statutory law
- Employment contract
- Freelancer contract
- Individual agreement



When?

When?

- **First to file** principle
- Any **third party** might publicly disclose the same invention/file a patent application containing the same invention.

Any publicly disclosed information = Prior art

- Patent **filing before any public disclosure** of the subject matter to be protected.
- A “grace period” in some countries avoids rejection of an application due to inventors own disclosure prior to patent filing.

Attention: Different rules among the countries

When?

■ Enablement: The application shall disclose the invention in a manner **sufficiently clear and complete** for it to be **carried out by a person skilled in the art**.

→ No need to wait for the final product

■ **No new matter** may be added in a patent application after the filing date.

→ All essential elements should be included in the application as filed.

Where?

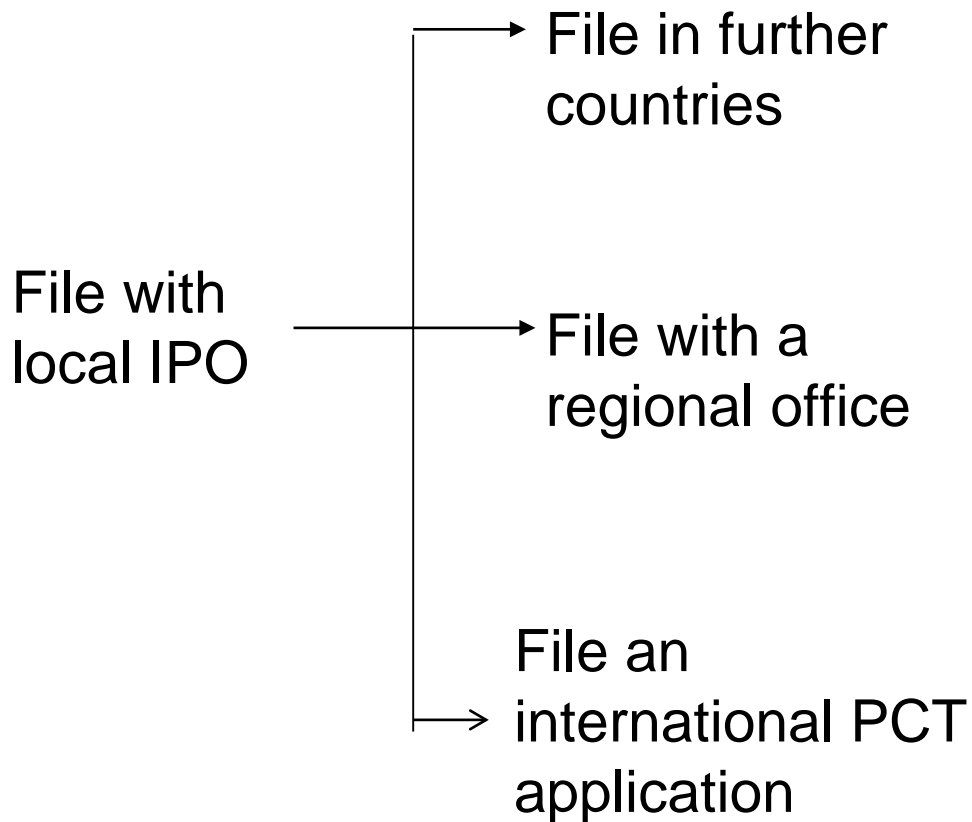
Where to file first?

- Usually easiest to file with an IPO closest to you
 - Less expensive; Use local language

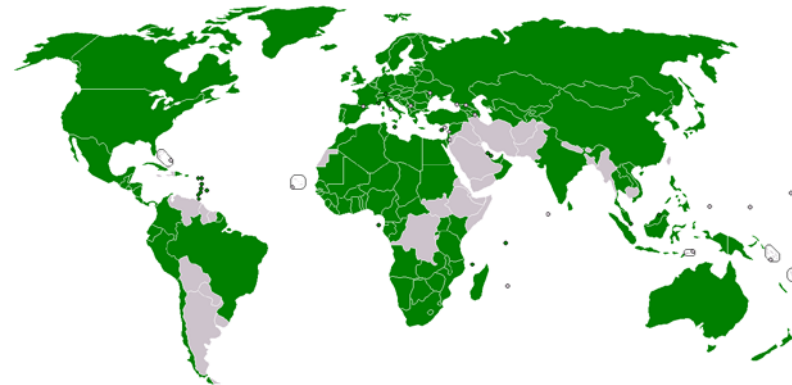
- It depends on applicant's strategy and resources.
 - Applicant's resources
 - Availability of an early search report

Where to file subsequently? - Filing routes

- Often: File with a local office first, subsequent filing within the 12 months priority period



EAPO, EPO, ARIPO,
OAPI, GCC Patent Office



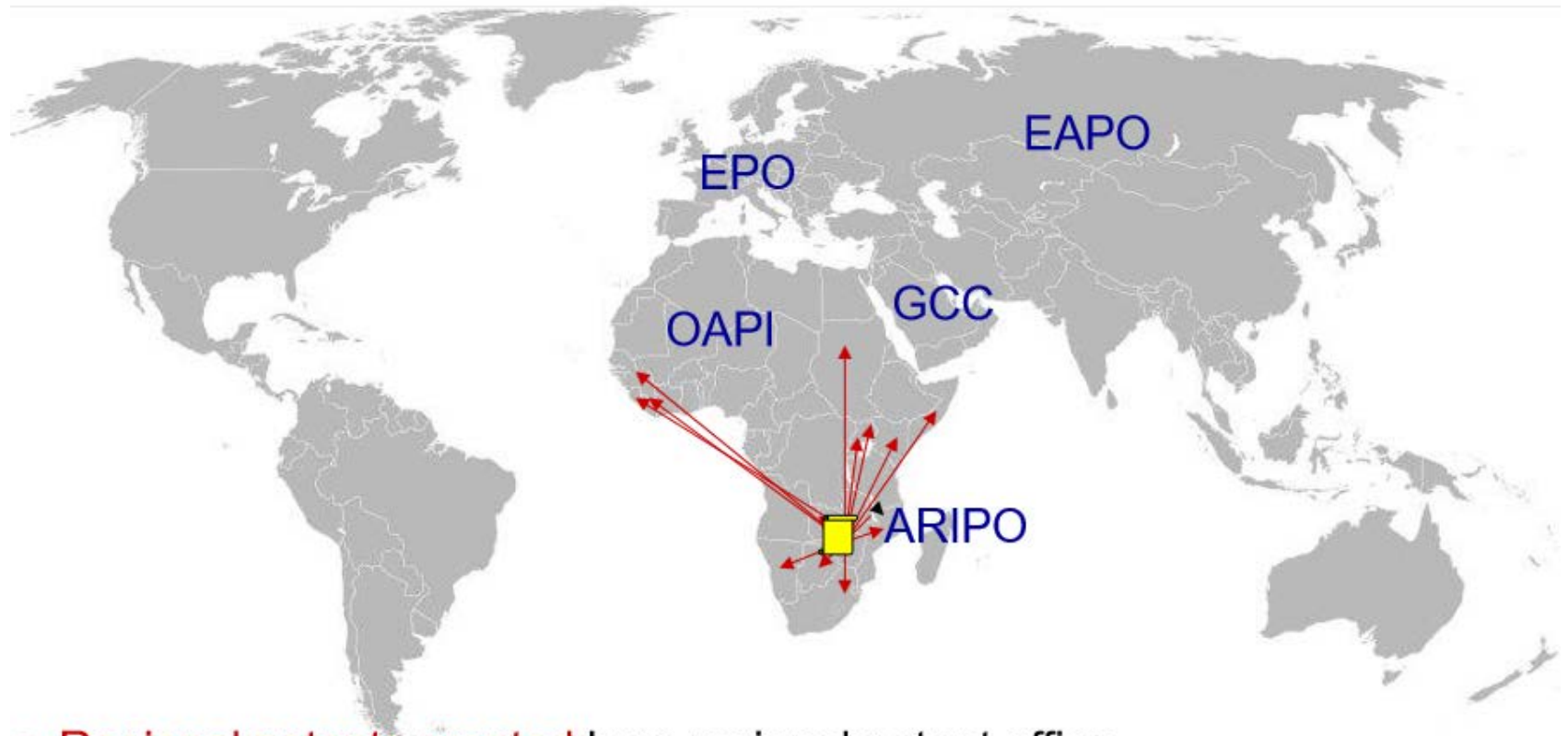
Where to file subsequently?

Choice of countries is a key element in cost and value.

Based on:

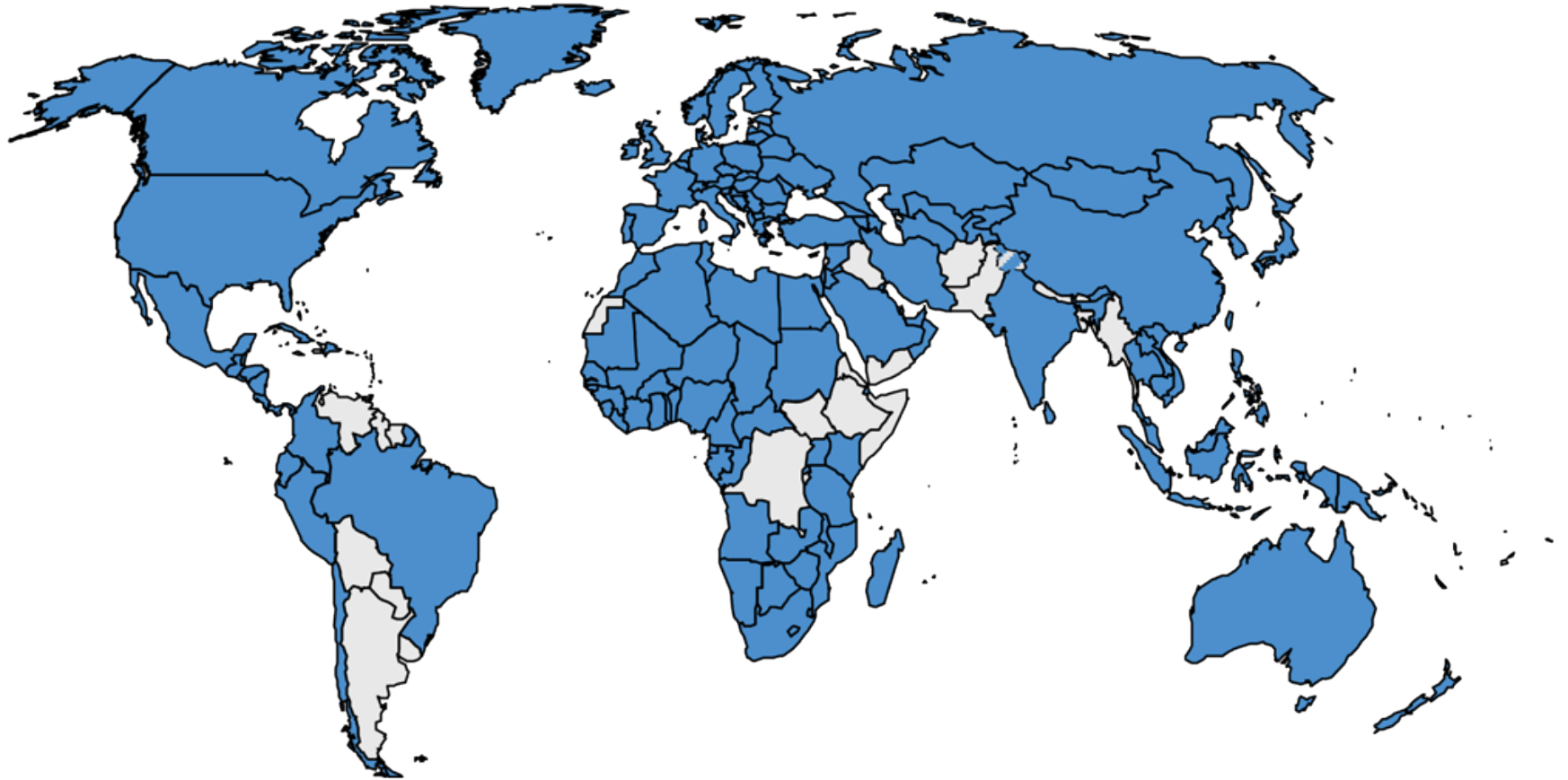
- How many sales/consumers for the product now? Over the next years?
- Cost
 - Is a translation needed?
 - Availability of a regional patent?
- Probability of patent grant
 - National legal requirements?
- Enforceability:
 - Is the patent of practical value?
 - Are the courts and customs fast and effective?

Using Regional Systems

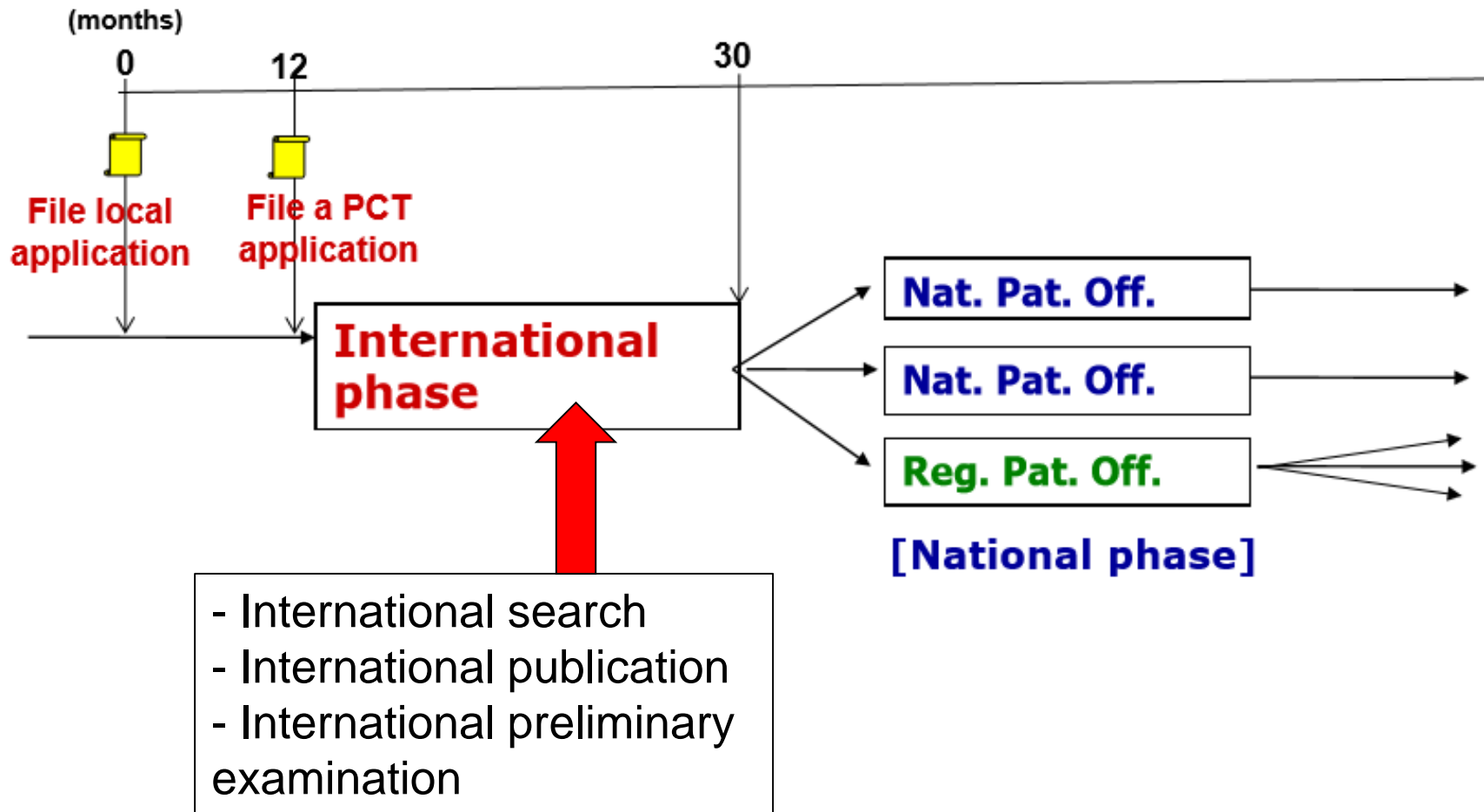


- **Regional patents granted** by a regional patent office
 - A regional patent having effect in all member states; or
 - A bundle of national patents (having effect in designated Member States)

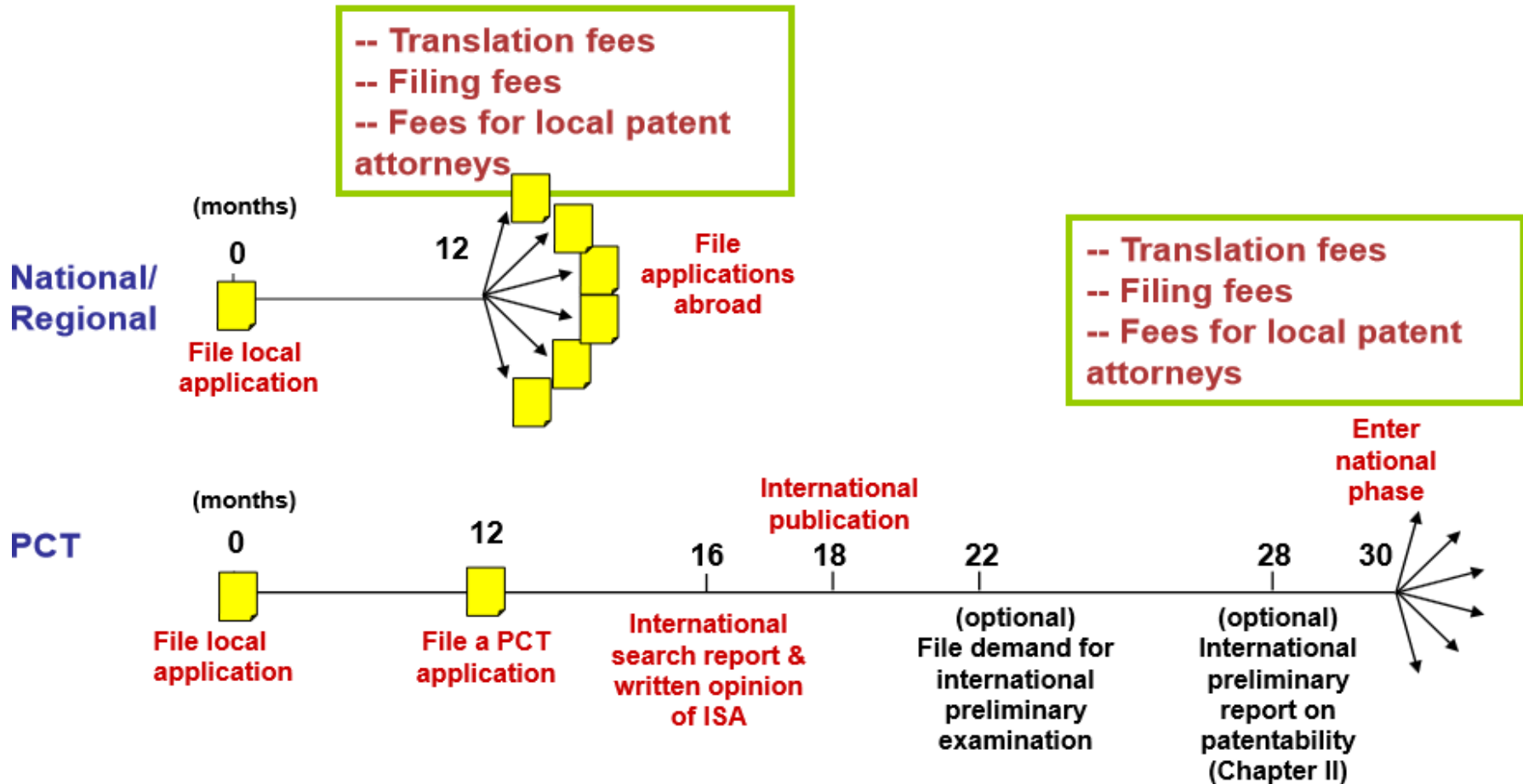
The PCT System Coverage (152 MSs)



Using the PCT System



National/Regional vs PCT



The PCT System

- Filing **one “international” patent application** has the same effect as filing national applications in 152 PCT Contracting States.
- In general, an applicant may **file** a PCT application **with its national office or WIPO**.
- Patent **granting decisions** made by each designated **national/regional patent office**.
- Possibility of 90% reductions of certain fees for LDC applicants and for a natural person from developing countries.
- Proposal by Brazil: at least 50% reduction for universities and public research institutions from developing countries

Advantages of the PCT system

- One international application – simpler formality
- Additional time to make a filing decision in various countries.
 - Postpone the major costs associated with seeking patents abroad
 - Better business prospect and geographic coverage
- Basis for patenting decisions provided
 - International search report and written opinion
 - International preliminary report on patentability (Chapter II)
- Global publicity – signalling licensing possibilities

Further assistance on PCT

■ PCT

- Further information: <http://www.wipo.int/pct/>

- PCT Distance Learning Course (4h) - Learn the PCT Video Series

- Guide: <http://www.wipo.int/pct/en/appguide/index.jsp>

- General questions: pct.infoline@wipo.int

Is filing a patent application the best option?

Some consideration

A. Timescale:

- i. Product lifecycle too short for patent system?
- ii. Too early to file

B. Secrecy:

- i. Can the idea be best protected by keeping it secret?

C. Investment cost vs. potential return:

- i. Initial drafting and preparation
- ii. PCT/foreign filing, translations
- iii. Prosecution and grant costs
- iv. Renewal/annuity fees

D. Inability to exploit patent rights:

- i. Limited licensing experience
- ii. Insufficient experience or funds for enforcement

THANK YOU

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