



Topic 3: Filing a Patent Application: Who, When, Where, What and Why

WIPO Patent Drafting Course for the ARIPO Member States and Observer States

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Main features of patent rights

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- Exclusive rights to **exclude others** from commercial exploitation the invention without a patent owner's consent
 - right to assign, or transfer by succession the patent and to conclude licensing contracts
 - the invention cannot be commercially made, used, distributed, imported, or sold by others without the patent owner's consent
- Limited duration, **20 years** from filing date
 - Annual renewal or maintenance fees (increasing with time)
- Geographically limited
- Duty of **disclosure**
- Need to fulfill **conditions of patentability**

Why should a patent application
be filed ?

Why should a patent application be filed?

Key reasons:

- **Strong market position and competitive advantage**
 - Protection from free riders and imitators
 - Market entry barrier for competitors in respect of the same inventions
- **Recovering R&D costs and obtaining higher returns on investments**
- **Licensing or transfer/sale** of the patent right
 - Important for universities and research organizations
- **Access to technology** through **cross-licensing**
- **Access to new markets**

Why should a patent application be filed?

Key reasons (cont'd):

- **Diminished risks of infringement**
- **Attracting investors** for your business
 - Highly important for start-ups, but also investments in settled companies
- **Prestige/reputation/image**
 - demonstration of high level of expertise, specialization and technological capacity
 - useful for raising funds, finding business partners and raising company's profile and market value

Why should a patent application be filed?

■ However, is it always wise to apply for patent protection?

- No

■ It does not always result in a commercially viable technology or product

■ Expensive and difficult to obtain, maintain and enforce



■ Necessary to analyze pros and cons and consider alternatives (e.g., utility models, trade secrets)

Fidget Spinner

Tens of millions sold

Suppliers struggling to meet demands



BENEFIT TO THE PATENT OWNER?

“The inventor [owner] kept the patent for 8 years but surrendered it in 2005 because she could not afford the USD\$400 renewal fee”

Source: <https://www.theguardian.com/lifeandstyle/2017/may/03/fidget-spinner-inventor-patent-catherine-hettinger>

Why should a patent application be filed?

Factors to be taken into account in deciding whether or not to file a patent application include:

- Is there a market for the invention?
- Are there potential licensees or investors who will be willing to help to take the invention to market?
- How valuable will the invention be to your business and to competitors?
- Is it easy to “reverse engineer” your invention from your product or “design around” it?
- Do the expected profits from an exclusive position in the market justify the costs of patenting?

Trade Secret or Patent?

Advantages of a TS protection:

- Involves no registration costs
 - Is not limited in time
 - Is immediately effective
 - Does not require disclosure
-
- TS protection may be advisable:
 - When it is likely that information can be kept secret for considerable period of time
 - When the secret relates to a manufacturing methods or formula rather than to a product (products would be more likely to be reverse engineered)
-
- Disadvantages of TS protection:
 - Reverse engineering
 - Protection is only effective against improper acquisition and use or disclosure of the confidential information
 - No protection against those who independently come up with the same idea (it may be patented/disclosed by them)
 - More difficult to enforce

Who is entitled to seek patent protection?

Who?

Inventor:

- **Natural person(s)** who conceived the invention
- Depends on the contribution to the claims of the patent
- Usually more than one person → joint inventors

Who?

Applicant:

- **Natural and legal persons/entities**
 - Individual inventor or joint inventors
 - Companies
 - Public institutions
 - Universities
 - R&D institutions
 - Government
- Joint applicants possible

Entitlement

Right to a patent belongs to an **inventor and his successor in title**

However, in practice, the right to a patent are **transferred to a third party (the applicant)** by virtue of an agreement with the inventor, statutory law, employment contract.

- Employer, if the invention is the result of the performance of his regular duties
- Employee, if the inventive activity is not part of his regular duties
- Person who commissions the work (unless otherwise in the contract)

- Inventor has the right to be mentioned as such in the application

Entitlement

In principle, IPRs derived from research funded by a Government Funding Agency belong to the R&D Institute that performed the relevant research.

- University ownership and IP policies
 - In principle, students who are not employees of the university own the IP rights in the works they produce based on knowledge received from lectures and teaching
 - Under some circumstances (e.g., substantial use of the university facilities, equipment and other resources) ownership has to be shared or assigned to the university or a third party)

IP Policies for Universities and Research Institutions

http://www.wipo.int/policy/en/university_ip_policies/

Database of IP policies

Search IP policies, manuals and model agreements from universities and research institutions worldwide. If you would like to request that examples of your policies, manuals or agreements added to the database, please [contact us](#).

Type of institution

*** Any ***
Public Research Institution
Public Research Support Agency
Public University
Private Research Institution
Private University

Focus

*** Any ***
Collaboration
Commercialization
Confidentiality
Conflict of Interest
Contract Research

Accompanying documents

*** Any ***
Guidelines and other resources
IP policy
Template forms and agreements

Country / Territory

Norway
Oman
Pakistan
Panama
Peru
Poland

Language

*** Any ***
Arabic

Search

When should a patent application
be filed ?

As soon as possible?

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

But...

- Enablement / Sufficiency requirements
- **No new matter** may be added in a patent application after the filing date.

When?

Any publicly disclosed information = prior art

- Prior to any public (written/oral) disclosure of the invention
- Any disclosure before filing the application (e.g., for test-marketing, to investors or other business partners) should be done only after signing a confidentiality or nondisclosure agreement.
- Safeguard – Grace period (non-prejudicial disclosure)
 - Attention: Different rules among various countries!

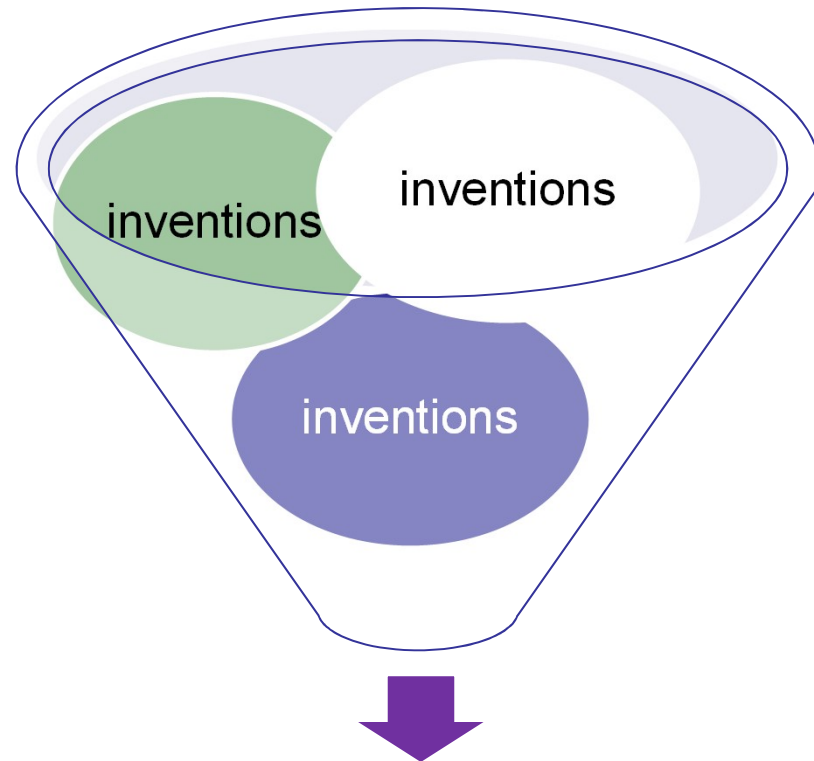
Grace period

Kenya	<p>Disclosure not to be taken into account in determining novelty and inventive step if it occurred within 12 months before the filing date (priority date):</p> <ol style="list-style-type: none">1. by the applicant or his predecessor in title;2. due to an evident abuse committed by a third party in relation to the applicant or his predecessor in title.
Mozambique	<p>Disclosure not to be taken into account in determining novelty if it occurred within 12 months before the filing date (priority date):</p> <p>(a) by the inventor or his successor in title, to a scientific or professional institution or publication, or in official or officially recognized competition, exhibition or trade fair;</p> <p>(b) due to an obvious abuse against the inventor or his successor in title.</p>
African Regional Intellectual Property Organization (ARIPO)	<p>Disclosure not to be taken into account in determining novelty if it occurred within six months before the filing date (priority date), by display of the invention at an official or officially recognized international exhibition.</p>
	<p>Source: http://www.wipo.int/export/sites/www/scp/en/national_laws/grace_period.pdf</p>

What (which) invention can be protected by patent?

Inventions

- Inventions (in a general sense)
Any new concepts that come out in the inventor's mind
- Patentable inventions
Inventions that comply with the requirements under the applicable patent law



Patentable inventions

Exclusions from Patentable Subject Matter

- Discoveries, scientific theories and mathematical methods as such;
- Schemes, rules and methods for performing mental acts, playing games or doing business as such;
- Programs for computers as such;
- Inventions the exploitation of which is against *ordre public* or morality;
- Diagnostic, therapeutic and surgical methods for the treatment of humans and animals;
- Plant and animal varieties;
- Plants and animals other than micro-organisms;
- Essentially biological processes for the production of plants and animals;
- Inventions affecting national security.

CERTAIN ASPECTS OF NATIONAL/REGIONAL PATENT LAWS¹

(6) Exclusions from Patentable Subject Matter

Country/Region	Exclusions from Patentable Subject Matter
Albania	<ol style="list-style-type: none"> 1. Discoveries, scientific theories and mathematical methods. 2. Aesthetic creations. 3. Schemes, rules and methods for performing mental acts, playing games or doing business. 4. Computer programs. 5. Presentation of information 6. Inventions the commercial exploitation of which is contrary to public order, morality or public health and human life, such as: <ol style="list-style-type: none"> (a) processes for cloning human beings; (b) processes for modifying the germ line genetic identity of human beings; (c) uses of human embryos for industrial or commercial purposes; (d) processes for modifying the genetic identity of animals which are likely to cause them suffering without any substantial medical benefit to man or animal, and also animals resulting from such processes. 7. Nuclear substances for military purposes. 8. Surgical, diagnostic and therapeutic methods for treating humans and animals. 9. Plant and animal varieties and essentially biological processes for their production, other than microbiological processes and products. 10. Human body at the various stages of its formation and development, and the simple discovery of one of its elements, including the sequence or partial sequence of a gene.
Algeria	<ol style="list-style-type: none"> 1. Principles, theories, scientific discoveries and mathematical methods. 2. Plans, principles and methods for intellectual activities and playing games. 3. Methods and systems of teaching, organization, administration and management. 4. Surgical, therapeutic and diagnostic methods for treating humans and animals. 5. Presentation of information. 6. Computer programs. 7. Aesthetic creations. 8. Plant and animal varieties and essentially biological processes for their production. 9. Inventions contrary to public policy or morality. 10. Inventions harmful to the health or life of humans or animals, preservation of plants, or protection of the environment.
Andorra	<ol style="list-style-type: none"> 1. Discoveries, scientific theories and mathematical methods. 2. Aesthetic creations. 3. Schemes, rules and methods for performing mental acts, playing games or doing business, and programs for

Source:

http://www.wipo.int/export/sites/www/scp/en/national_laws/exclusions.pdf

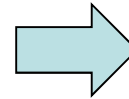
Where do you file a patent application?

Where to file patent applications?

In general,

Local filing

Lower costs (fewer intermediaries)
Local language (No translation costs)
Obtain a priority date



Foreign filings

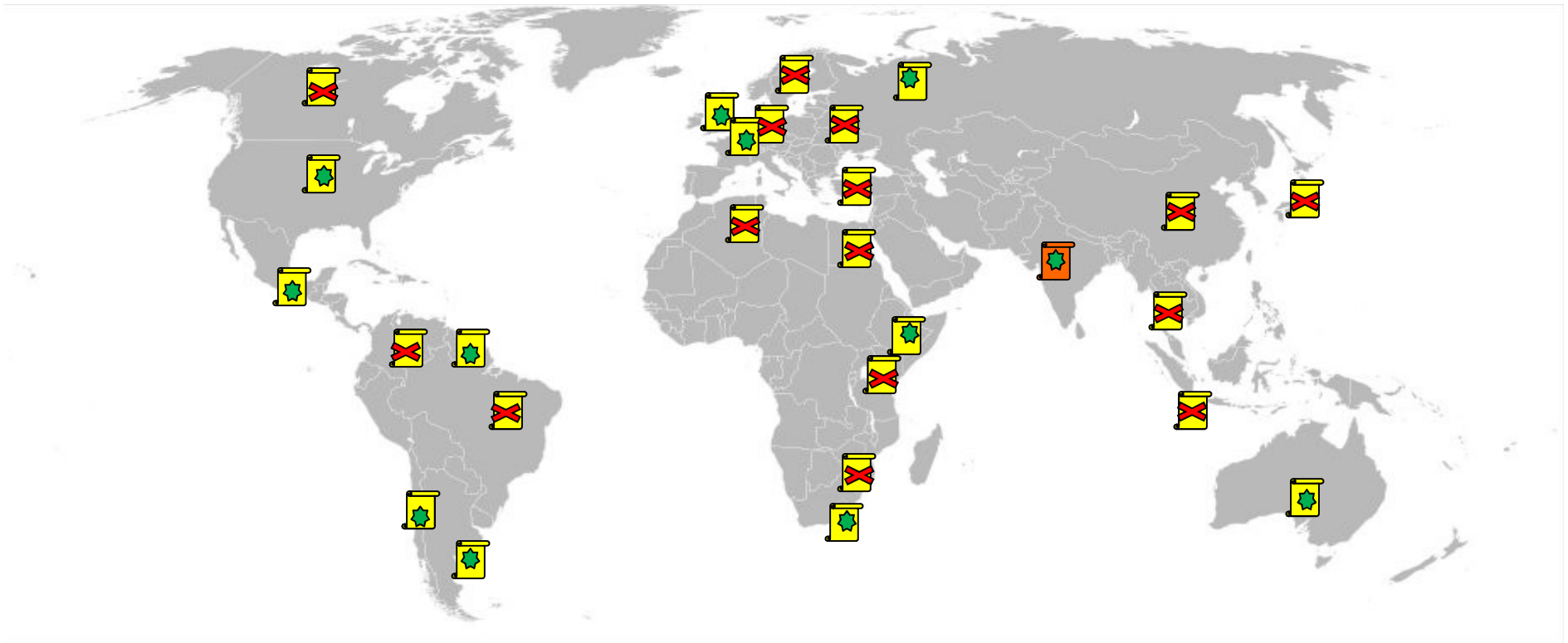
- **In which countries? - Key considerations:**
 - Where is the patented product likely to be commercialized?
 - Which are the main markets for similar products?
 - What are the costs involved in patenting in each target market and what is my budget?
 - Where are the main competitors based?
 - Where will the product be manufactured?
 - How difficult will it be to enforce a patent in a given country?

Various patent filing systems

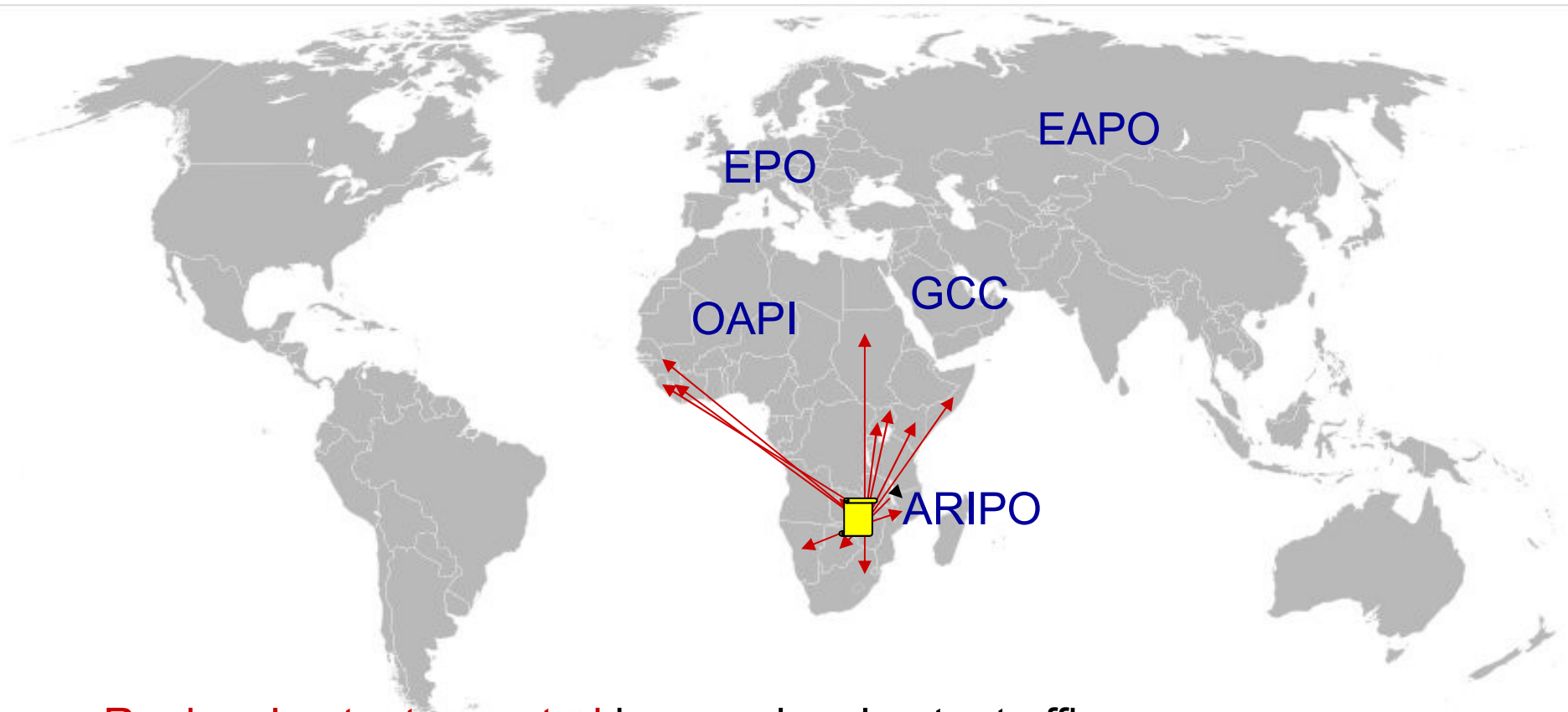
- Filing a national application with a national office
- Filing a regional application with a regional office
- Filing an international application using the Patent Cooperation Treaty (PCT)

Using national patent systems

- Different exclusions from patentable subject matter
- Different patentability requirements
- Different Forms, languages



Using regional patent 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)

Resources

- Directory of national / regional intellectual property offices
<http://www.wipo.int/directory/en/urls.jsp>
- National, regional and international IP laws (WIPO Lex)
<http://www.wipo.int/wipolex/en/>

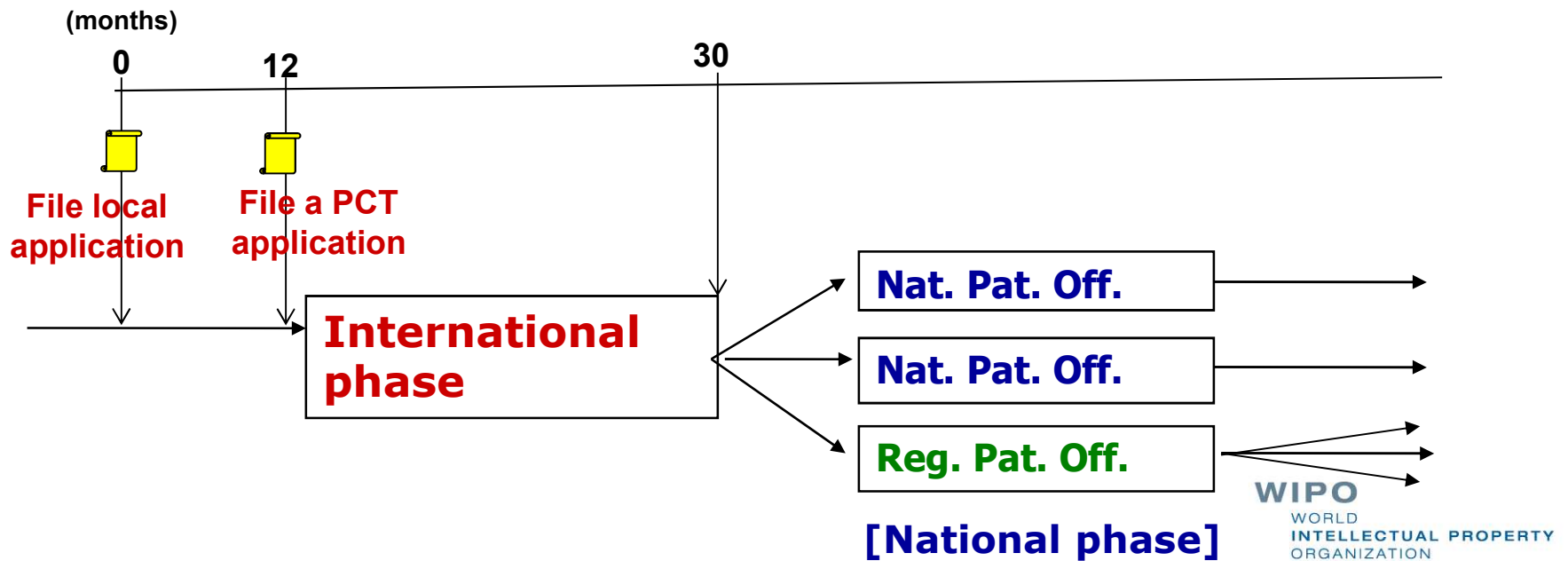
PCT international patent application

- 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.
- 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

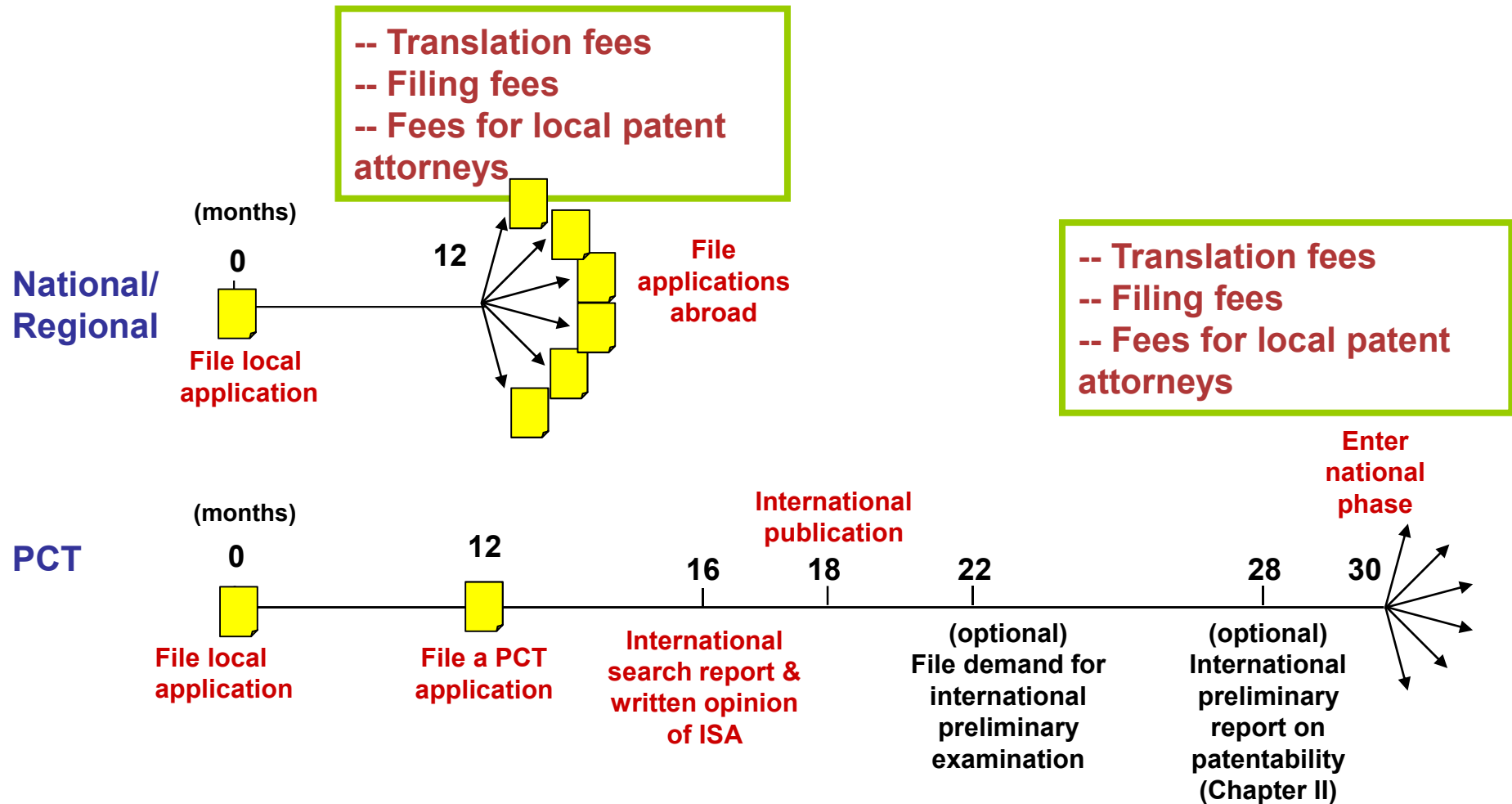


Seeking patent protection abroad

■ Outline of the PCT application process



National/regional patent application vs. PCT international application



PCT: Advantages

- **Additional time** to make a filing decision in various countries.
 - Postpone the major costs associated with seeking patents abroad

- **Basis for patenting decisions** provided
 - International search report and written opinion
 - International preliminary report on patentability (Chapter II)

- **One international application** – has legal effect in all PCT member countries → significantly reduces the initial transaction costs of submitting separate applications to each patent office

- **Global publicity** – signaling licensing possibilities

Contact and assistance

PCT

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

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

General questions: pct.infoline@wipo.int

Thank you!

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