



Topic 2: Filing a Patent Application: Who, When, Where, What and Why

WIPO National Patent Drafting Course

Kuala Lumpur

February 13, 2017

Tomoko Miyamoto
Head, Patent Law Section, WIPO

Five Big Questions

- Why?
- What?
- When?
- Who?
- Where?

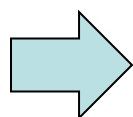


Inter-related questions

Why?

Why do you file a patent application?

- **Exclusive control** in the market?
 - Protection from imitation
 - Hindering competitors from developing substitutes
 - Securing market access
- **Licensing or transfer/sale** of the patent right?
 - Better cooperation with other organizations (ex. PPP)
 - Improving negotiation position (ex. cross-licensing)
- Attracting **investors**?
- Seeking **prestige/reputation/image**?
- **Motivation** of researchers?



Expectation of supernormal return

Appropriation mechanisms other than patents

- Lead time in the market
- Secrecy
- Complementary services and manufacturing facilities
- Human resource management
- Customer relations
- Suppliers' contracts
- Other legal mechanisms (trademarks, industrial designs)
- ...

For example, products with a short life cycle...

More questions

- Do we have capacity to monitor infringement of our patents?
- Do we have ability and interest to litigate?
- Protection as a trade secret (instead of disclosing an invention)?

- ← Available resources
- ← Position in the market/value chain
- ← Business model
- ← Nature of the technology

Real life examples: patents to control and facilitate access to new technologies

- Center for iPS Cell Research and Application (CiRA, Japan): production of **induced pluripotent stem cells (iPS cells)** from human somatic cells – allow access to pluripotent cells without the destruction of embryos, opening opportunities for medical research, particularly in the areas of diagnostics, drug screening and regenerative medicine.
- Objective: translating research results into effective treatments or drugs and delivering them to the broader population – insufficient means, need of private support.
- CiRA's patenting strategy: secure patents over key technologies resulting from research to **influence how those research results are used** – ensure dissemination.
- Dissemination strategy: **making technology available for development by other researchers** through reasonable **non-exclusive patent licensing** arrangements.
- Result: iPS cell research is broadened and accelerated so that new drugs and treatment methods can be available to patients more rapidly.

[http://www.wipo.int/wipo_magazine/en/2015/04/article_0002.html]

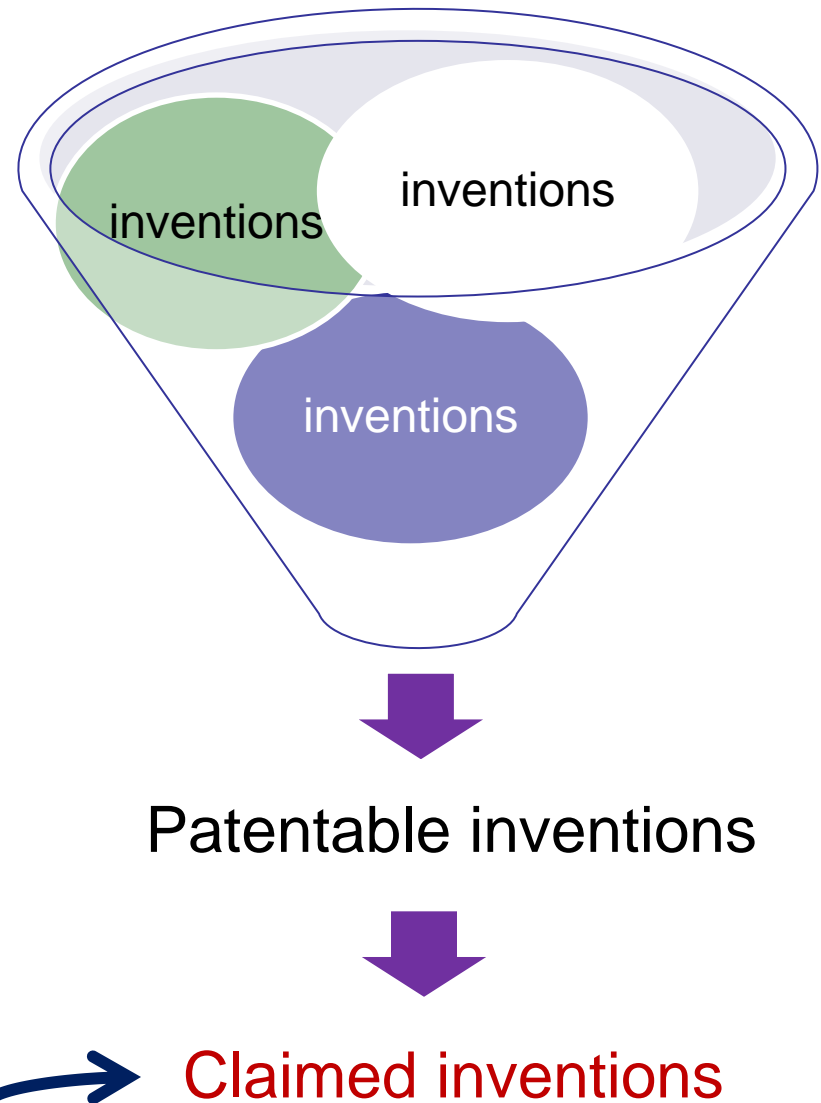
What?

Inventions

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

Patents = Intangible property

- scope of protection
- ownership



Personal mobility vehicles

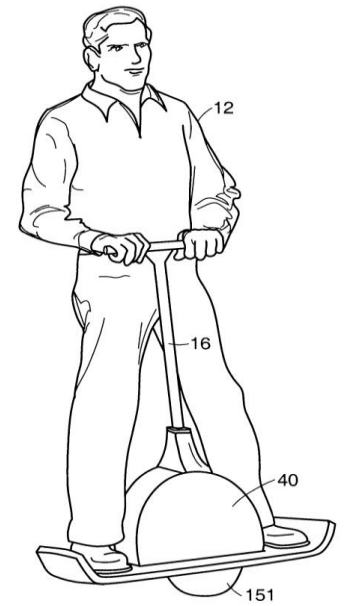
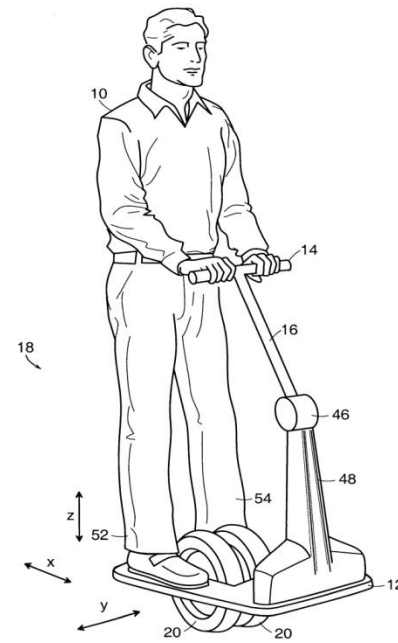
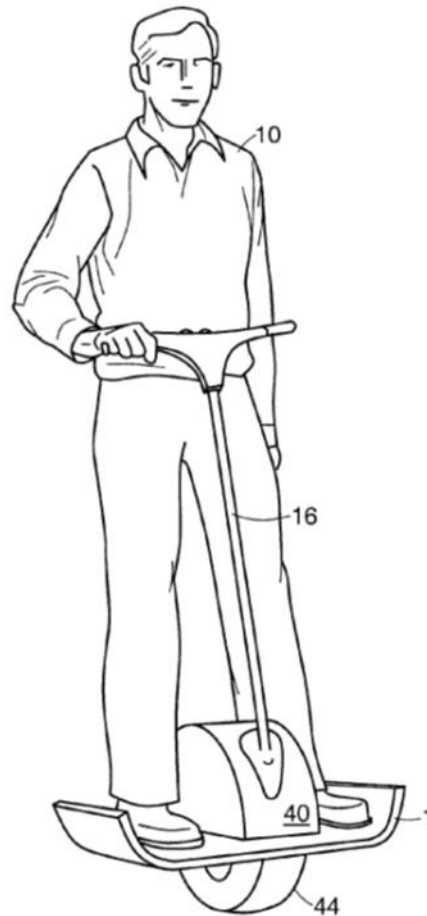
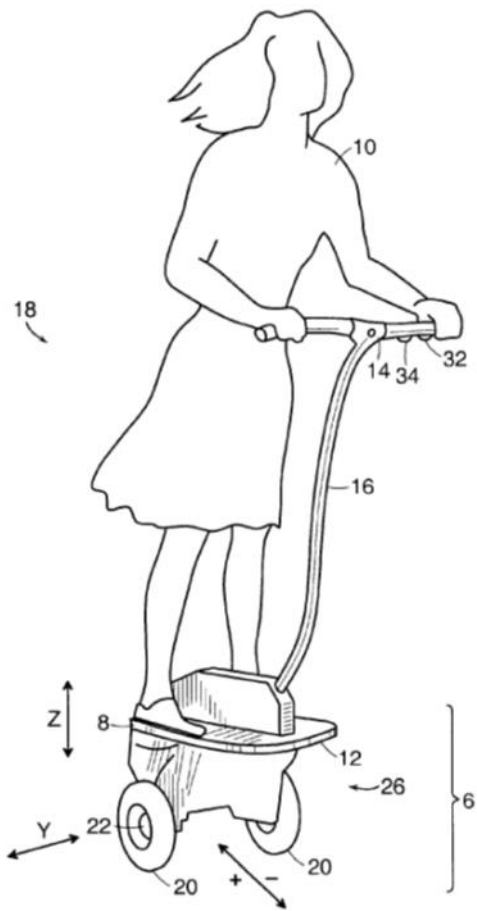


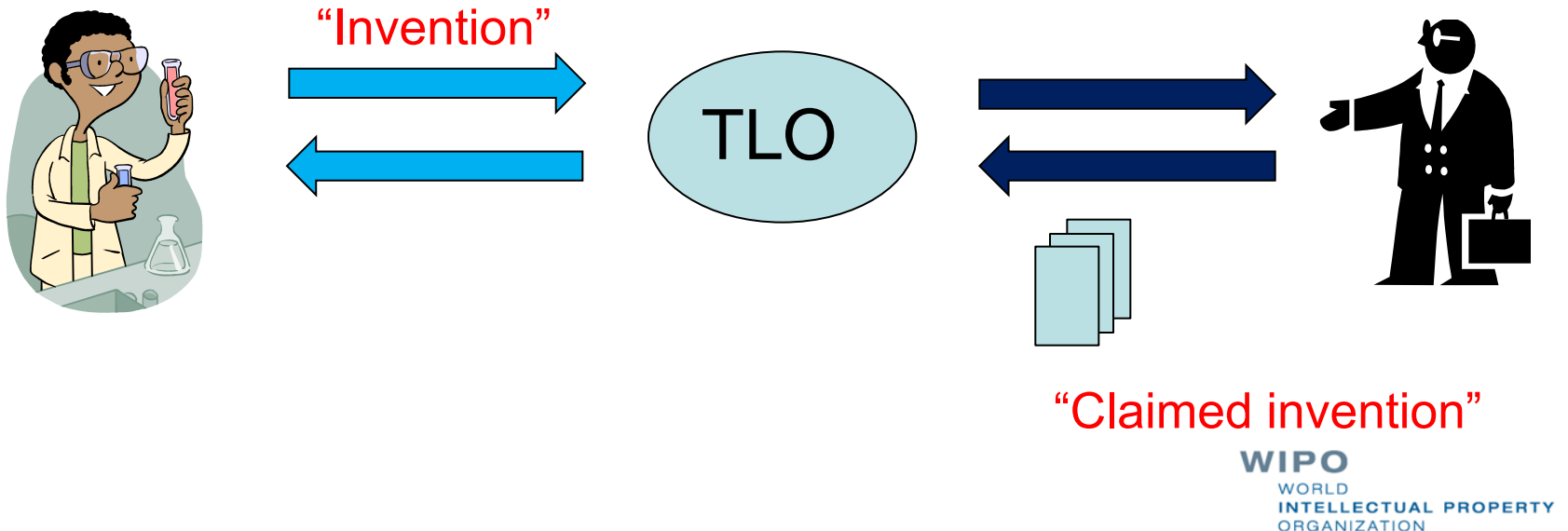
FIG. 15



FIG. 12

Identifying an inventive concept

- Identifying a patentable invention and a claimed invention
 - Collaborative efforts among the inventor, TLO and patent attorney (patent agent)



Who?

Entitlement

- Right to a patent belongs to an **inventor**. [Patents Act, Section 19]

- Where an invention was made by an employee or pursuant to a commission, the right to a patent is deemed to accrue to:
 - the person **who commissions the work**;
 - the **employer**, if the invention is the result of the performance of an employment contract;
 - the **employer**, if an invention was made by an employee whose employment contract does not require any inventive activity, using data or means provided by the employer. [Patents Act, Section 20]

- Section 20 applies to an employee of **the government or a government organization or enterprise**. [Patents Act, Section 21]
 - *University ownership and IP policies*

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

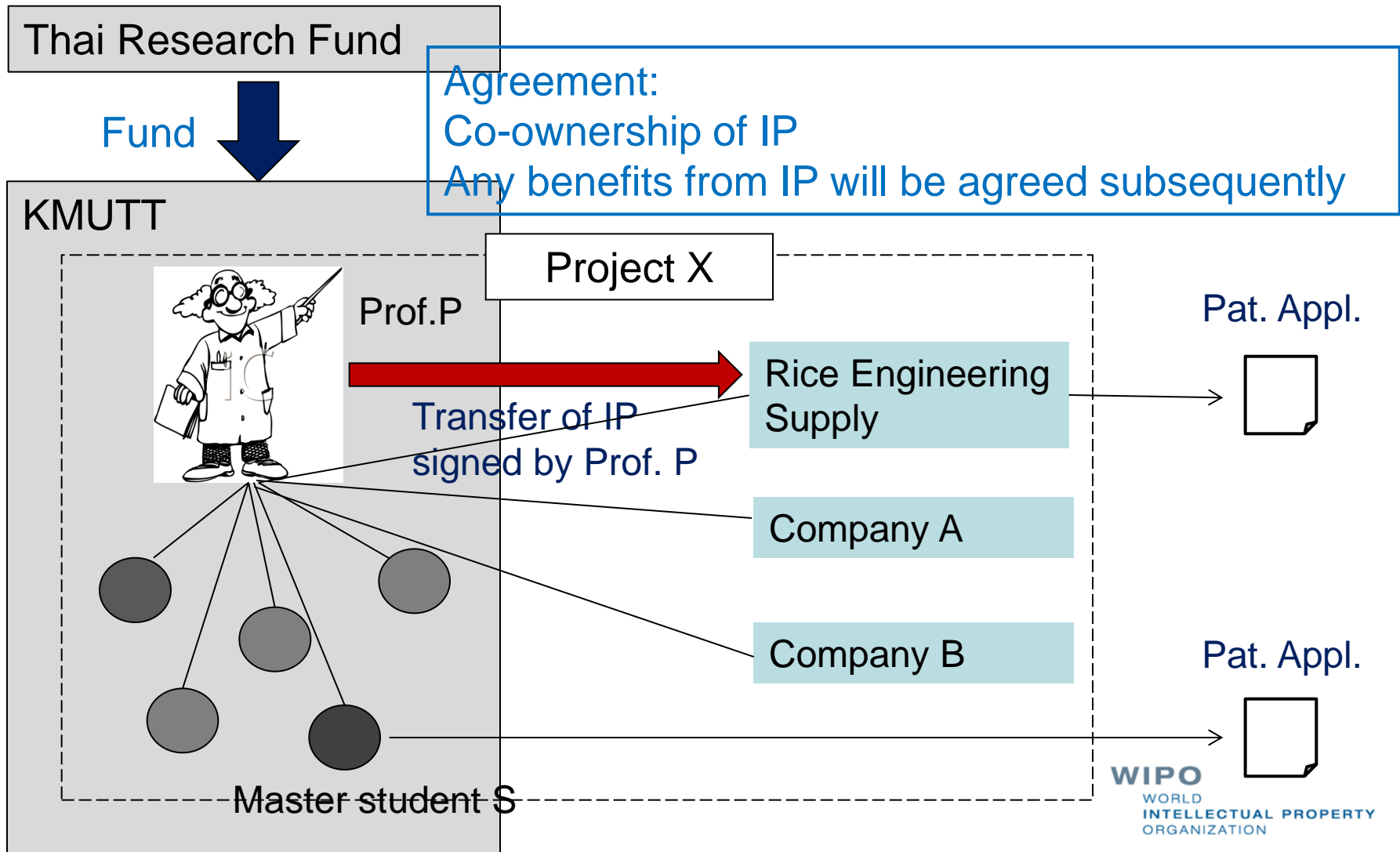
Norway
Oman
Pakistan
Panama
Peru
Poland

Language

*** Any ***
Arabic

Search

Rice Engineering Supply Co. Ltd. V. Mr. Bunrueng Srisawat Thai Supreme Court, 2006



When?

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

The application shall “*disclose the invention in a manner **sufficiently clear and complete** for it to be **carried out by a person having ordinary skill in the art.**” (Patents Regulations, Rule 12(1)(c))*

■ **No new matter** may be added in a patent application after the filing date. (Patents Act, Section 26(4))

When?

- Industrial applicability/utility
 - Where a sequence or partial sequence of a gene is used to produce a protein or a part of a protein, it is necessary to specify which protein or part of the protein is produced and **what function this protein or part of this protein performs**. (EU Biotech Directive)
- **12-month priority period** under Article 4 of the Paris Convention.
- No Malaysian residents shall, without a written authorization by the Registrar, **file a patent application outside Malaysia** unless:
 - A patent application for the same invention has been filed in Malaysia not less than two months before foreign filings;
 - No national security directions have been issued. (Patents Act, Section 23A)

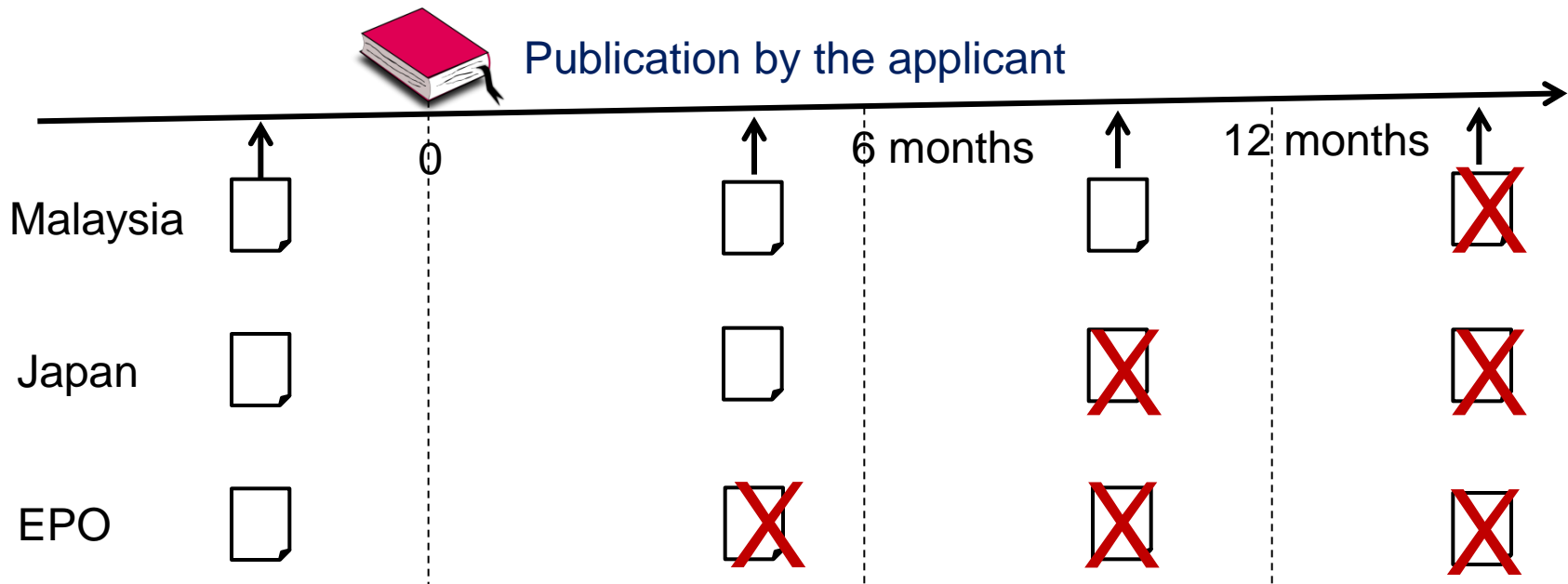
When?

Any publicly disclosed information = prior art

- Has the invention been publicly shown/published/displayed/used/exhibited?
- Is there any plan to do so?

■ Safeguard – **Grace period (non-prejudicial disclosure)** in Malaysia (Patents Act, Section 14(3))

■ **Attention: Different rules among various countries!**



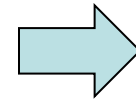
Where?

Where to file patent applications?

In general,

Local filing

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



Foreign filings

\$\$\$?

Certainty?

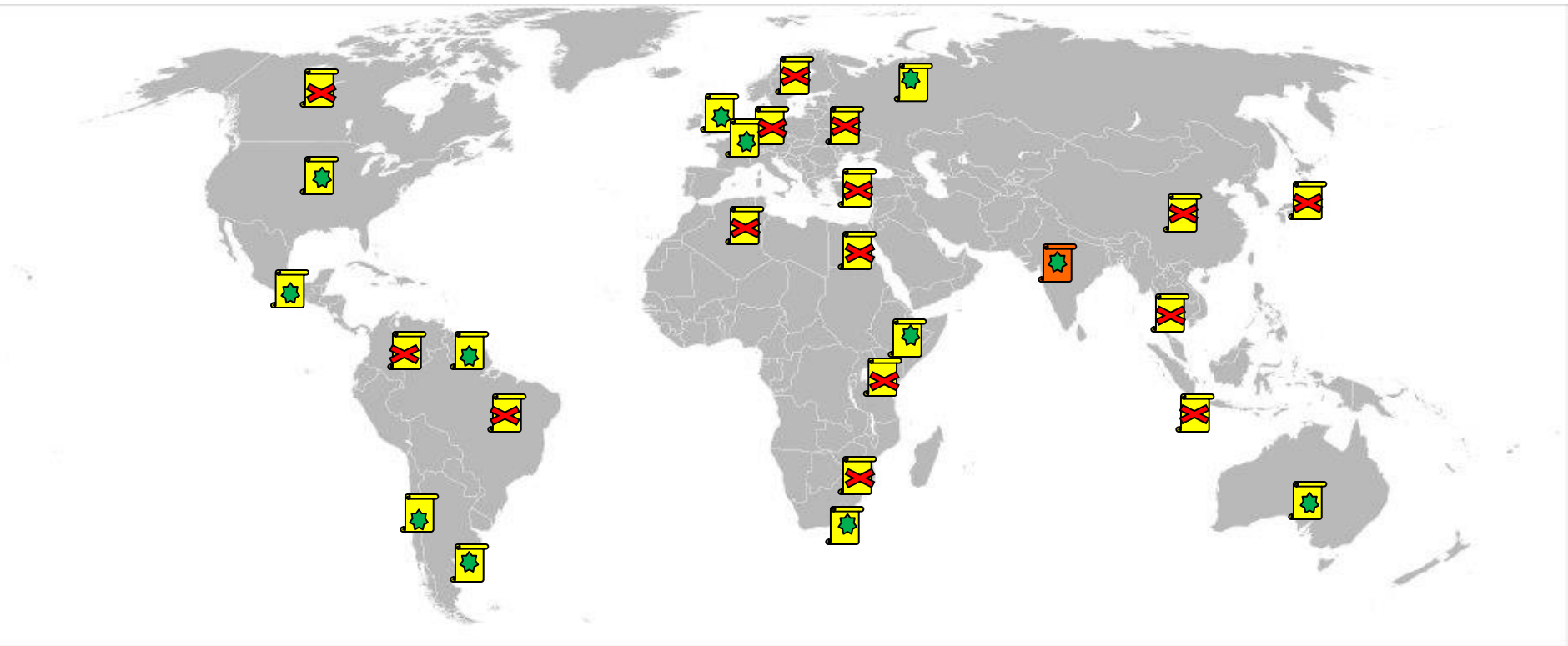
- In which countries?
 - Market?
 - Customers? Users?
 - Competitors?
 - Licensees?
 - Counterfeits (origin, transit)?
 - Legal requirements?
 - Enforceability?

Various patent filing systems

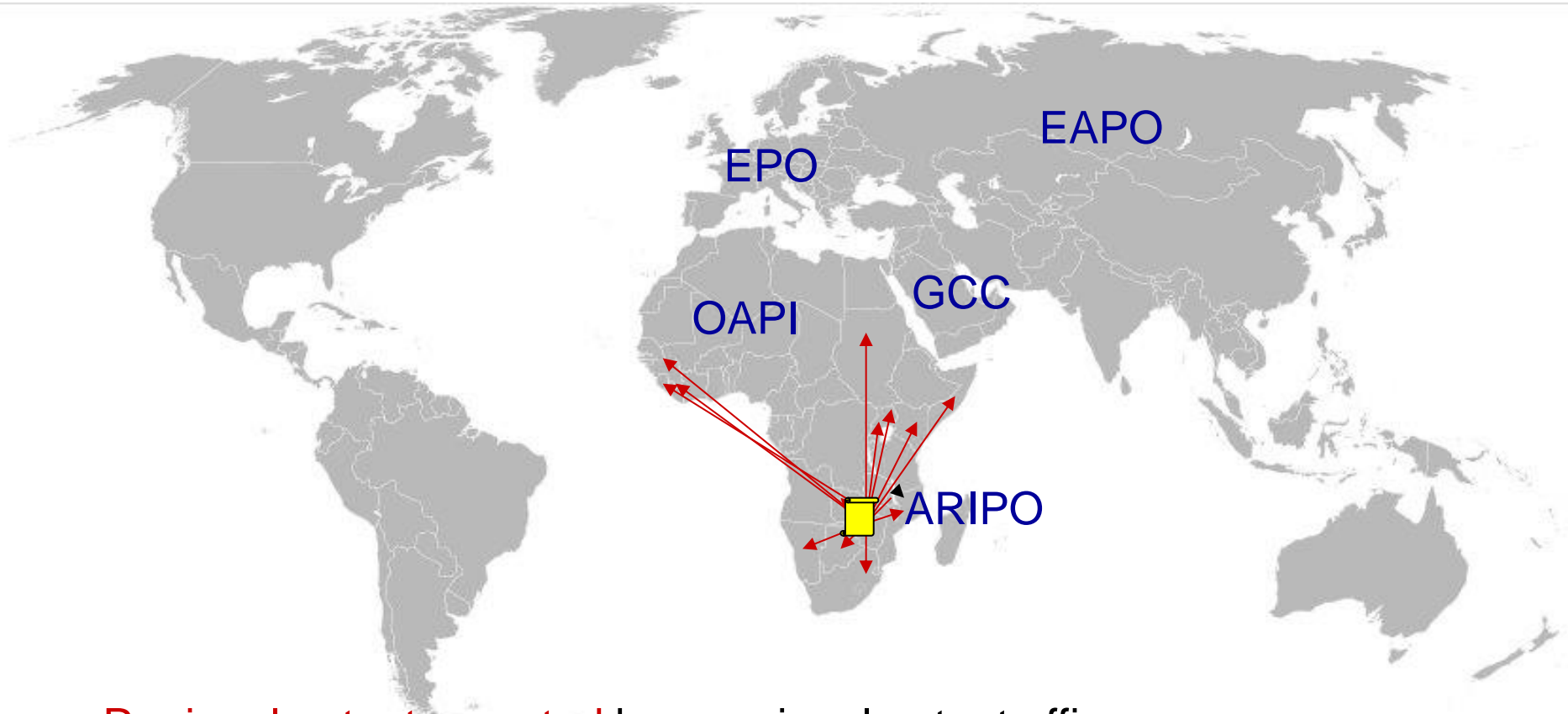
- Filing a national application with a national office
- Filing a regional application with a regional office
- Filing an international application using the Patent Cooperation Treaty (PCT)

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/>

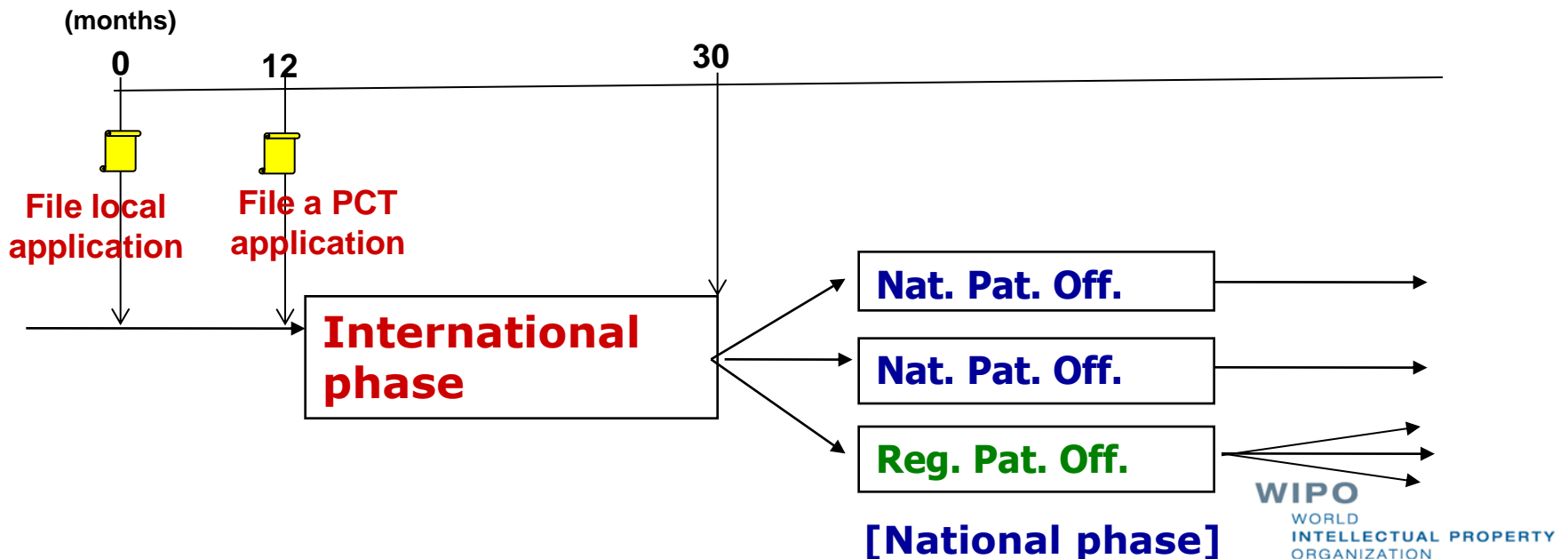
PCT international patent application

- Filing one “international” patent application has the same effect as filing national applications in 151 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

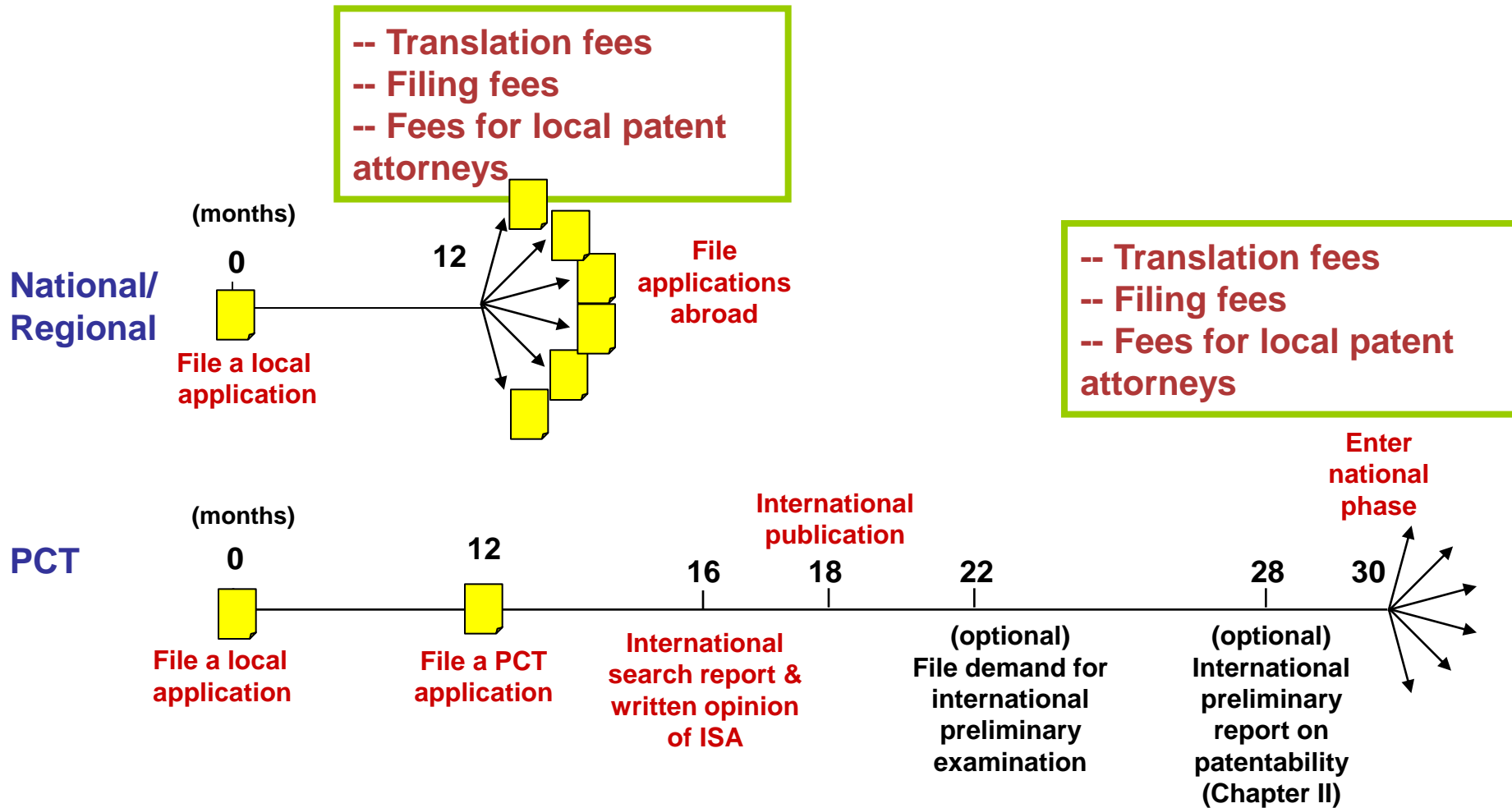


Seeking patent protection abroad

- Using national patent systems
- Using regional patent systems (EPO, EAPO, OAPI, ARIPO, GCC)
- Using the **Patent Cooperation Treaty (PCT) system**



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
 - Better business prospect and geographic coverage
 - Better alignment of a patent application with the business needs (ex. reduce national claim fees)

- **One international application** – simpler formality

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

- **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.

Tomoko.miyamoto@wipo.int