



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

WIPO National Patent Drafting Course

Manila

November 21, 2016

Tomoko Miyamoto
Head, Patent Law Section, WIPO

Five Big Questions

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

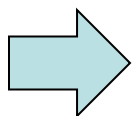


Inter-related questions

Why do you file a patent application?

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.

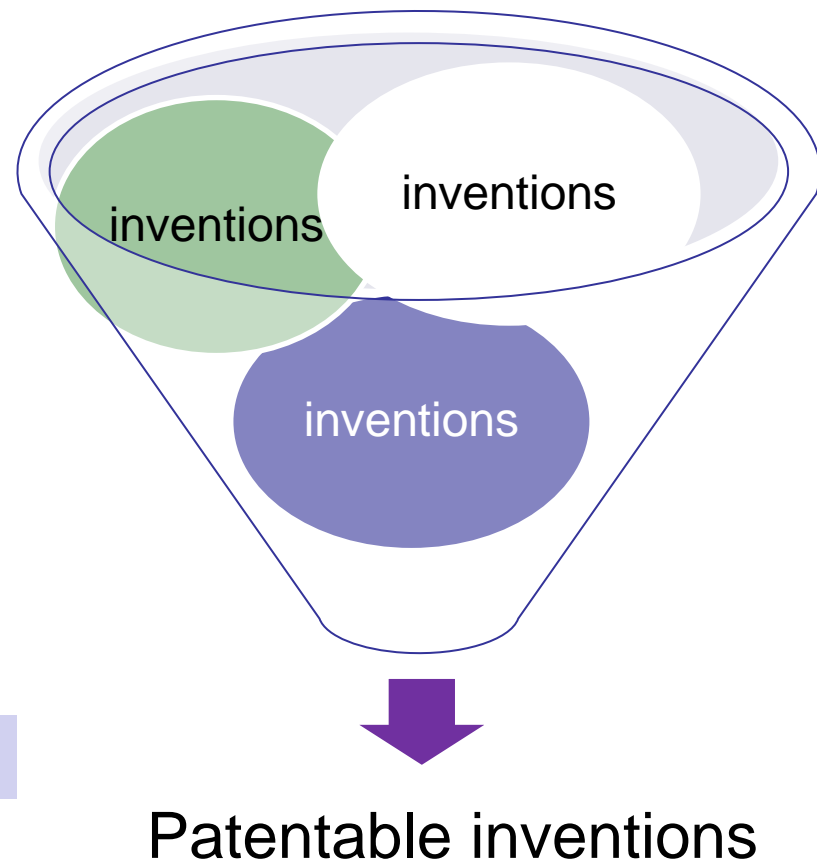
[http://www.wipo.int/wipo_magazine/en/2015/04/article_0002.html]

What (which) invention should you protect?

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

Patents = Intangible property



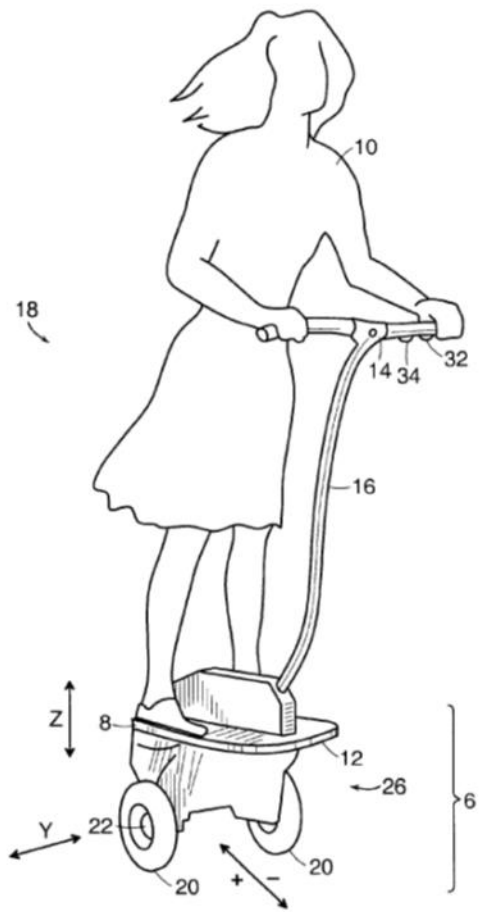
Identifying an inventive concept

- Identifying a patentable invention – work together with the inventor

- Inventors might not always know what he has “invented”
 - Which features are new and inventive?
 - Which features are essential and which are not?
 - What are the meritorious features?

- Example

Personal mobility vehicles



Example

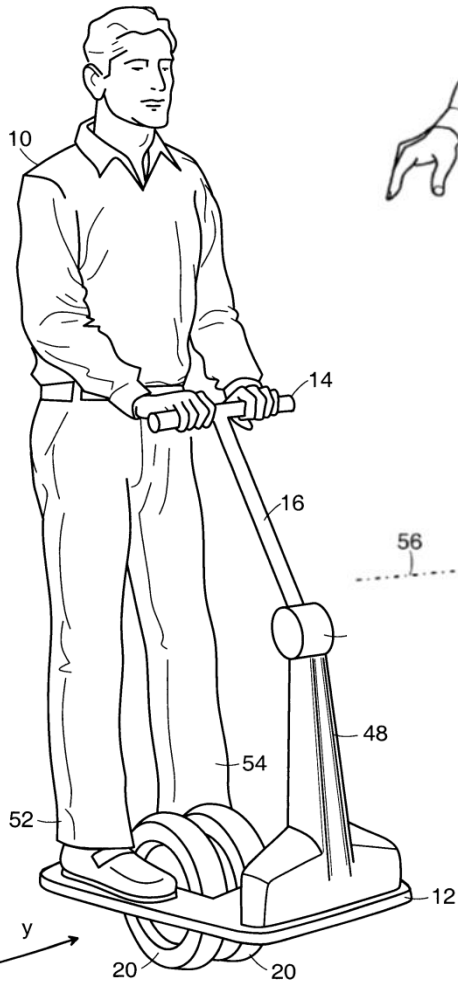


FIG. 10

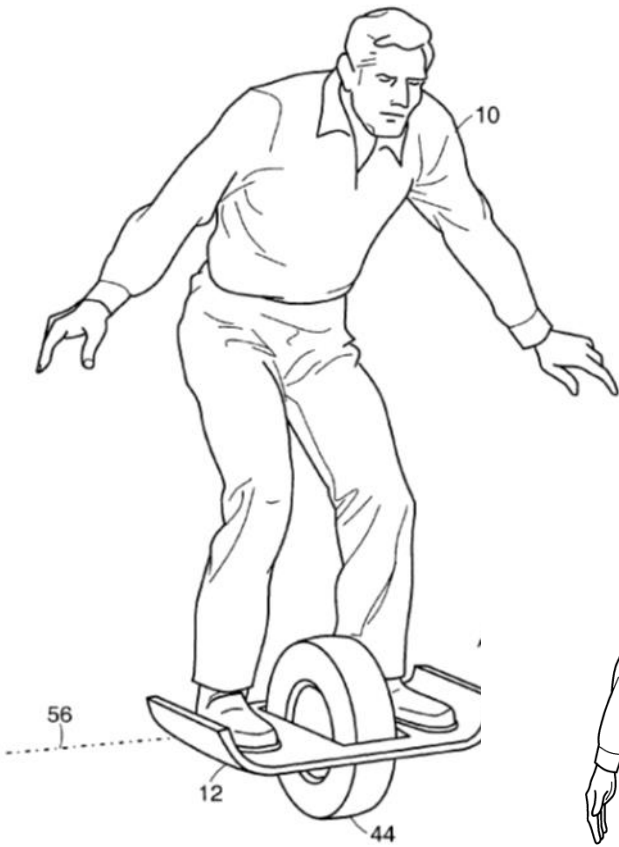


FIG. 12

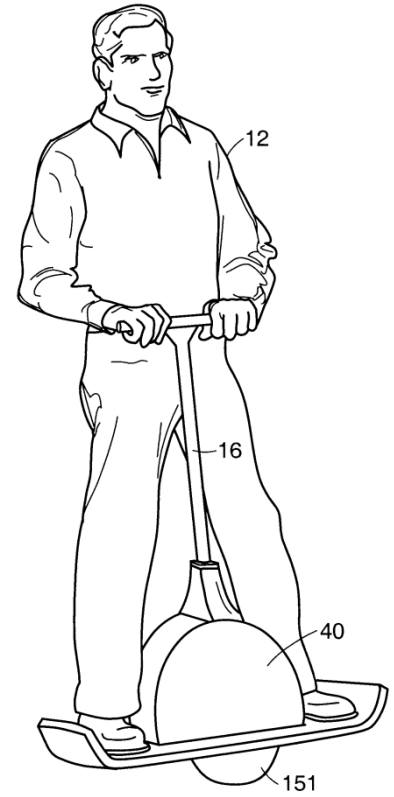


FIG. 15

Who is entitled to seek patent protection?

Entitlement

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

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

[IP Code Section 30]

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

[Technology Transfer Act, Section 6]

- 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

- Thai Research Fund (TRF) subsidized KMUTT for a project led by Prof. S.
- Mr. Srisawat, a master student of Prof. S and one of the researchers participated in the project, filed a patent application of invention X in 1999.
- Rice Engineering Supply (RES), which was also involved in the project, filed substantially the same patent application in 2000.
- TRF-KMUTT agreement: Fund receiver and Fund provider are co-owners of IP. Any benefit from IP will be agreed subsequently.
- As such a benefit sharing agreement, Prof. S made a Deed of Agreement on transfer of IP regarding the research result from KMUTT/TRF to RES.

The Court found that Prof. S was not a right owner who has the right to transfer the IP to RES. Hence, RES has no right to a patent.

When do you file a patent application?

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 skilled in the art.**” (IP Code, Section 35.1)*

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

When?

■ Industrial applicability/utility

- Inventions of a gene, a vector, a recombinant vector, a recombinant protein etc. whose **utility** is not described in a specification or cannot be inferred, do not meet the industrial applicability. (Japan, Examination Guidelines)
- 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.

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 the Philippines (IP Code, Section 25)

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

ex. If an invention is published in a tech. journal by the inventor within 12 months from the filing date, such disclosure does not prejudice the novelty under the Philippine IP Code, but it prejudices the novelty under the European Patent Convention if a corresponding European application is filed.

□ If improvement/development of the invention is foreseen, avoid self-collision with future applications.

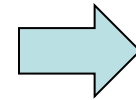
Where do you file a patent application?

Where to file patent applications?

In general,

Local filing

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



Foreign filings

\$\$\$?

Certainty?

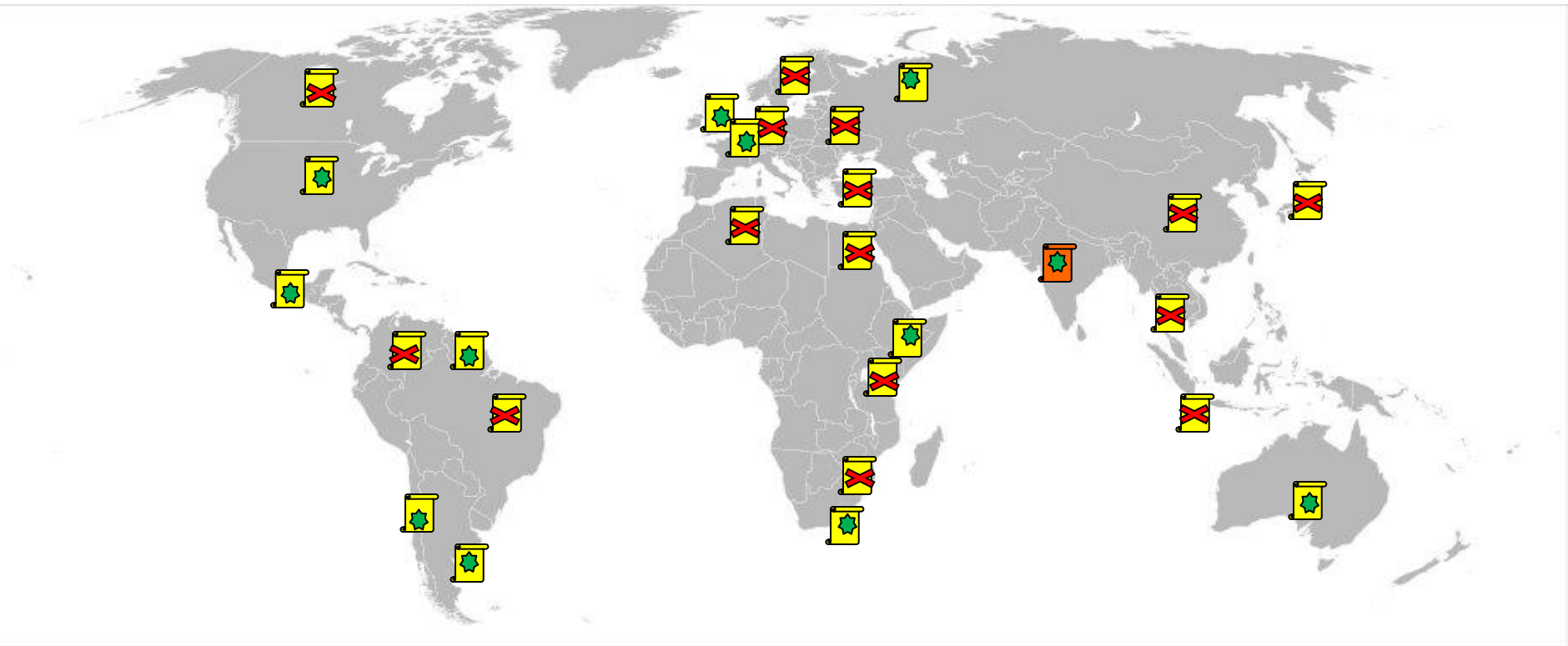
- In which countries?
 - Market?
 - Customers? Users?
 - Competitors?
 - Licensees?
 - Counterfeits (origin, transit)?
 - Legal requirements?
 - Enforceability?

Various patent filing systems

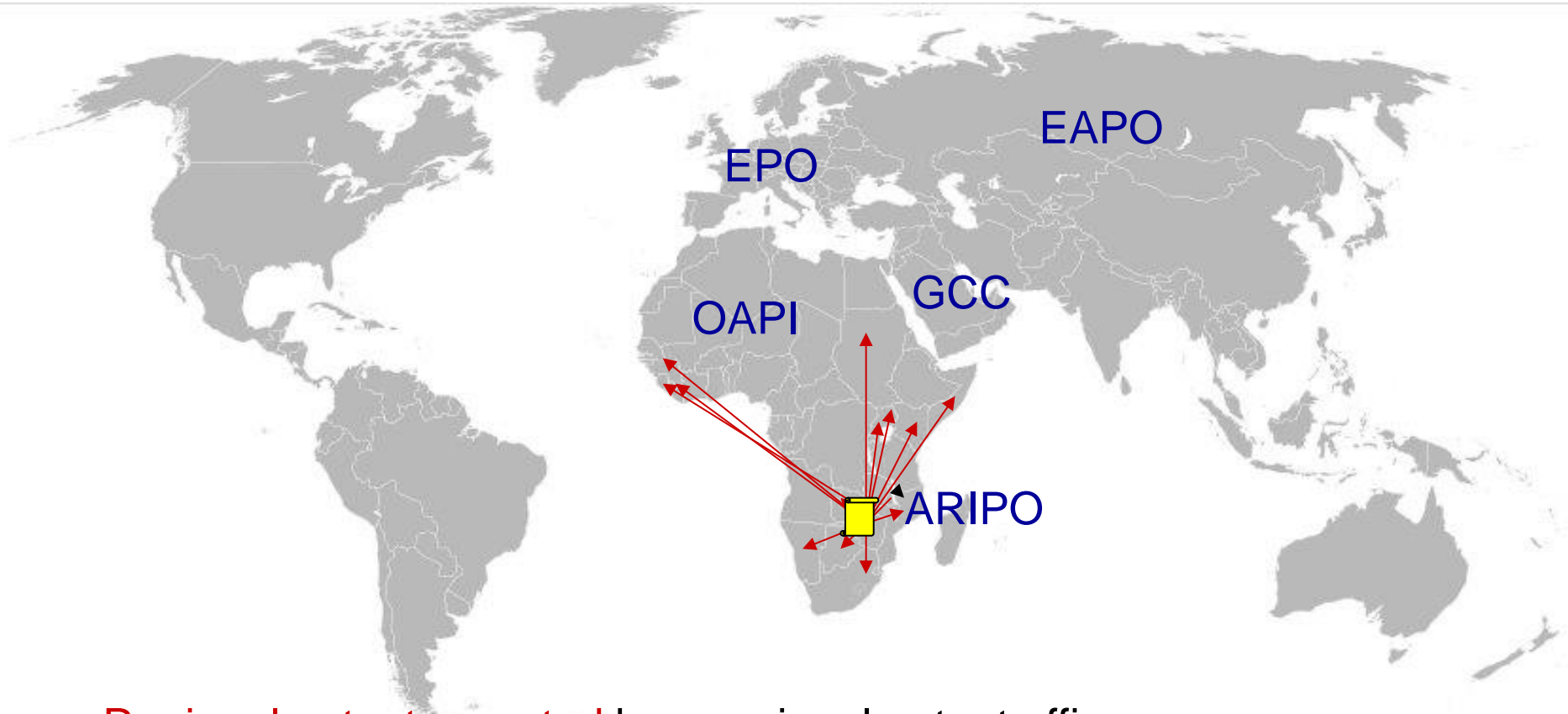
- Filing a national application with a national office
- Filing a regional application with a regional office
- Filing an international application using the Patent Cooperation Treaty (PCT)

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/>

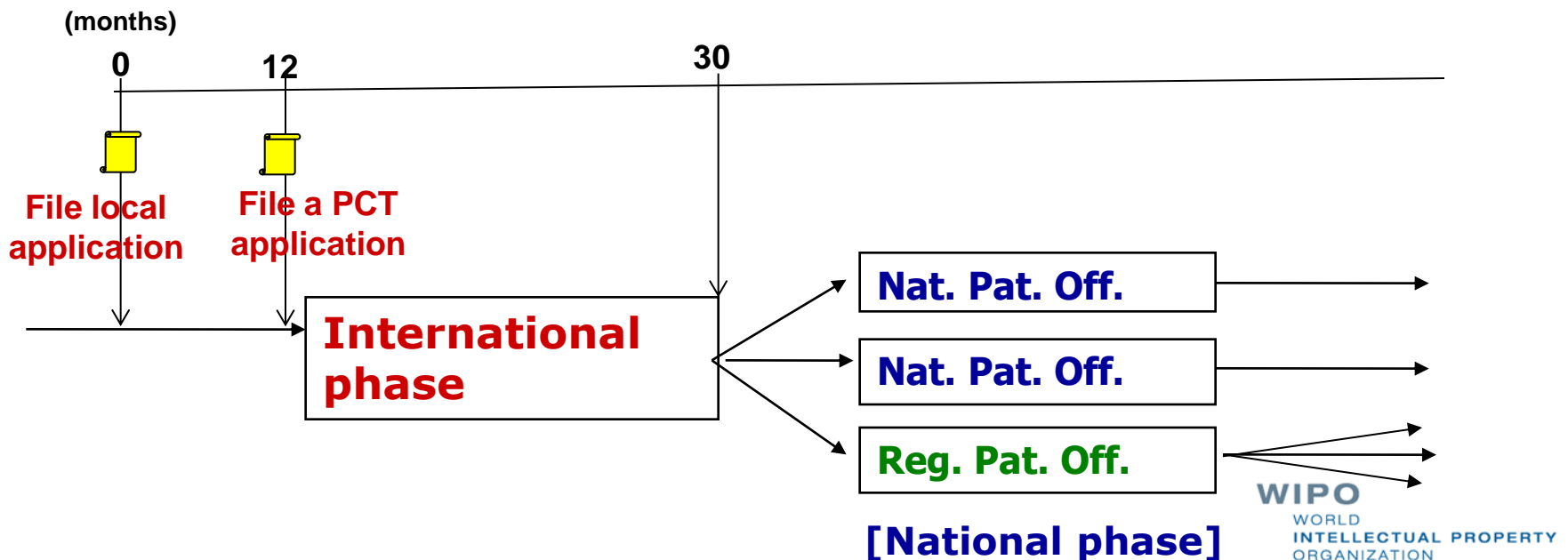
PCT international patent application

- 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

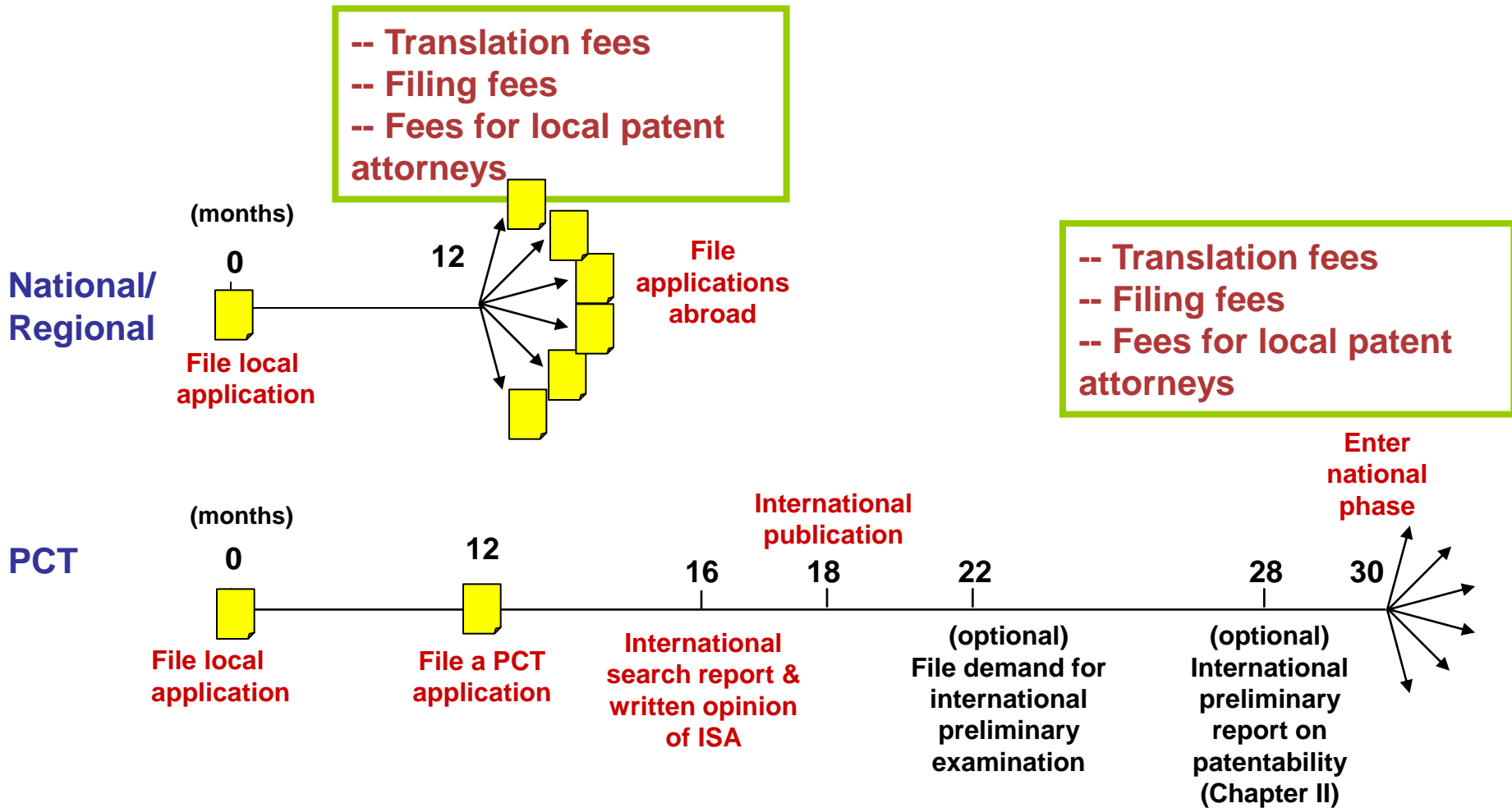


Seeking patent protection abroad

- 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

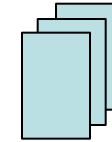
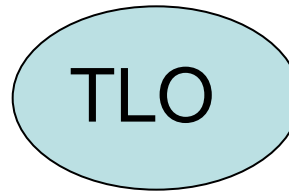
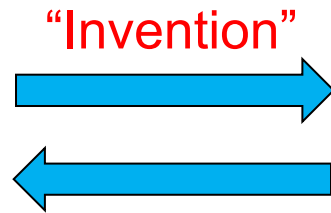
Contact and assistance

PCT

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

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

General questions: pct.infoline@wipo.int



Objective

Clarification of:

- Technology
- Patentability
- Policy compliance

Aims

Clear grasp of the invention (as if you were the inventor)
 Understanding of

- prior technology
- other structures and conditions achieving the similar results
- other applications, use etc.
- essential features (inventive concept) of the invention

Tools

- Invention disclosure form
- Meetings
- Video/tel. Conf.
- Other communications

ASK QUESTIONS

Thank you.

Tomoko.miyamoto@wipo.int