



Where to File Patent Application

Yumiko Hamano
IP Consultant - IP Commercialization
Partner, ET Cube International

Patent

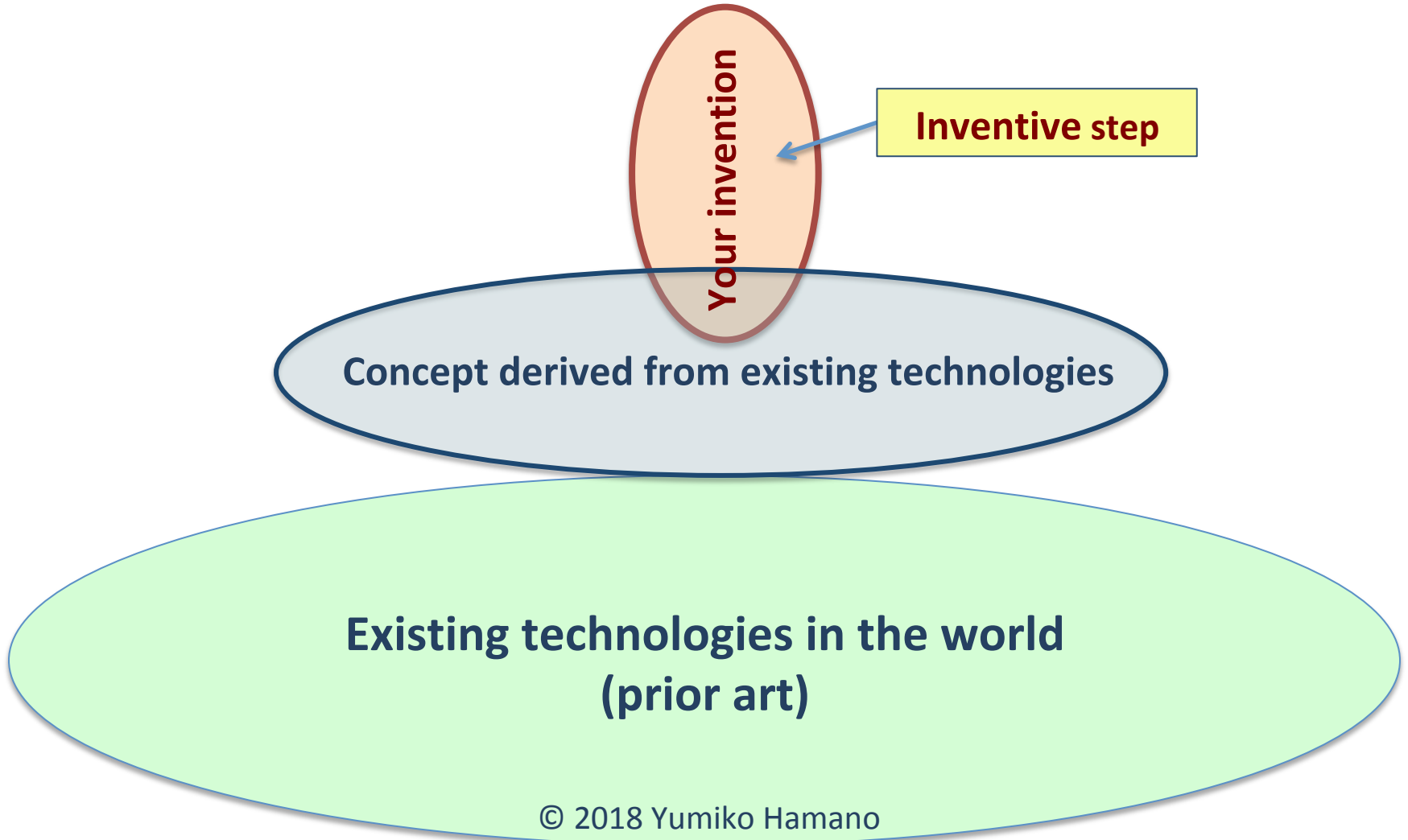
- A right granted by a state to the owner of an invention, to exclude others from making, using, selling or importing in the territory without the inventor's consent
- Granted to an invention of process, method, device, machine, compound, composition, and improvements thereof
- In exchange for a disclosure of specification of the invention
- Limited period, 20 years in many countries
- Territorial

Patent: Legal Requirements



1. Novelty
2. Inventive Step
3. Industrial Applicability

Inventive Step (Non-obviousness)



Where to File a Patent

- 1) National filing
- 2) PCT filing
- 3) Foreign filing

Where to File a Patent

- Where is your market?
- What is your market size?
- Competition?
- Barrier to entry?
- Cost of patent (filing, attorney, translation, annuities fee etc.)

Large companies' general criteria of PCT designated countries

- Must have: **US, EP, JP**
- Very large economy: **CN, IN**
- Large economy: **RU, KR, BR, MX**
- English speaking: **CA, AU, SA**
- South East Asia: **IN, TH**
- Other consideration: **Ease of doing business**

Where to File a Patent

National filing

→ Filing before the national patent office

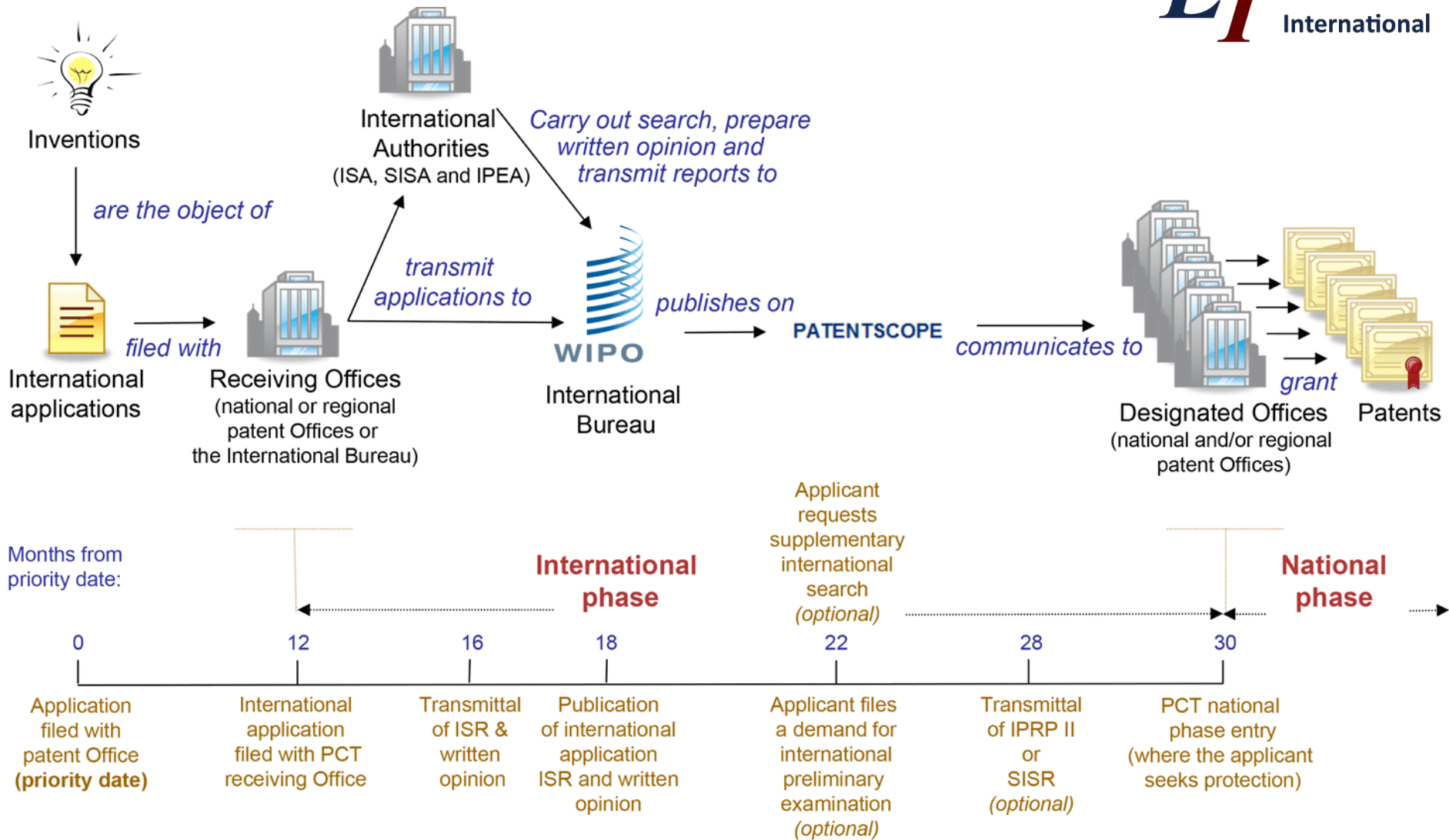
Where to File a Patent

Foreign direct patent filing

PCT Patent Filing

- A national or resident of one or of the PCT Contracting States
- Either with your national patent office or directly with WIPO
- Either on paper or electronically
- Filing at WIPO in any language
- Languages accepted by the Receiving Office
- The Request Form in 10 languages of the international publication: Arabic, Chinese, English, French, German, Japanese, Korean, Portuguese, Russian and Spanish.

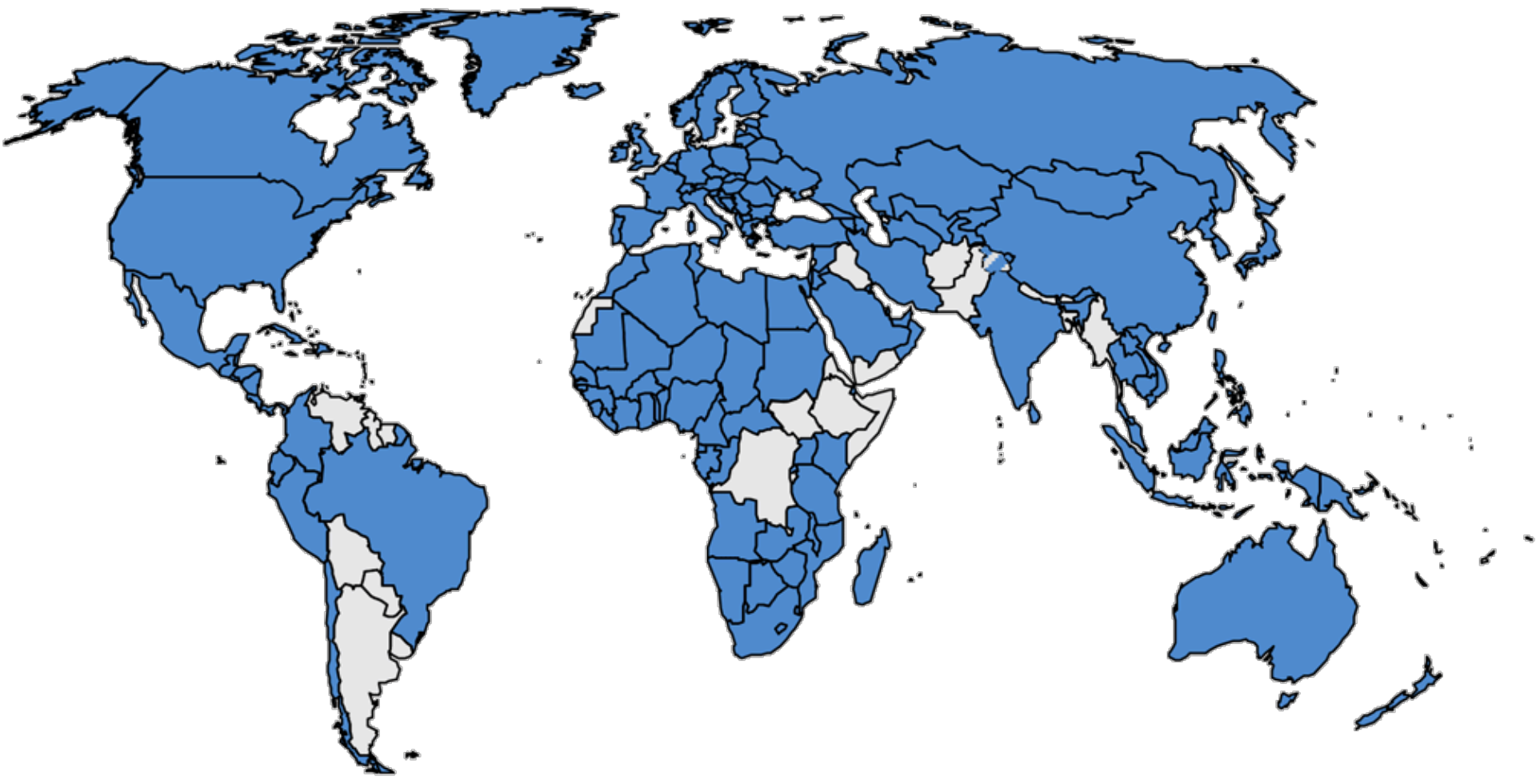
PCT Patent Application



PCT international patent filing

- File before the national receiving office
- Filing within 12 months from priority date
- International Search Report and opinion
- A19 amendment
- International Patent Publication
- International Preliminary Examination Report
- National phase 32 months from priority claim

152 PCT Contracting States



Advantages of PCT

- Up to 18 months to reflect on the desirability of seeking protection.
- Your application is in the form prescribed by the PCT.
- You can evaluate, based on the ISR and the written opinion, with reasonable probability the chance of your invention being patented.
- You have the possibility to amend the claims during the international phase.
- Many national office take into consideration ISR and IPER.
- International publication puts the world on notice of your application, which can be an effective means of advertising and looking for potential licensing.

Patent is certainly important for big companies....



But patent is even more important for small businesses and start-ups, because:

- The patent may be the only **competitive advantage**
- Essential **to find investors and commercialization partners or obtain access to enabling technologies**
- Investors typically view **patents as insurance** for their investment
- The value of a small company's patents may therefore be **a crucial factor** in the decision of a venture capitalist or other investor to invest in a company.
- Strong patents may also be used as **bargaining chips** for licensing, sales and business collaboration opportunities

Utility Models in Malaysia

- Referred to as Utility Innovation (Certificates) in Malaysia
- Do not require an inventive step and
- Can only cover a single claim per application

Copyrights

- Protection provided to the creators of “original works of authorship”
- Literary, dramatic, photographic, musical, artistic, and other works, both published and unpublished
- Protects expression of ideas rather than idea itself
- Right arises automatically at creation

Copyrights

- Protection in a tangible form
- Gives owner exclusive right to
 - Copy
 - Reproduce
 - Prepare derivative works
 - Distribute copies of work
 - Perform work publicly
 - Display work publicly

Copyrights

Important IP right for protecting computer software and algorithms

- When patenting is not available, then copyright often becomes the strongest form of protection that can be obtained in the information technology field
- A piece of software might not rise to a sufficient degree of novelty and inventive step for patent protection
- In many jurisdictions computer software is not patentable “per se”

Trademarks



- Type of IP in the form of a word, name, symbol, or device used to identify goods
- Indicates the origin of the goods
- Provides public assurance
- Distinguishes the goods from those of others
- Used to prevent others from using a similar mark that would likely confuse consumers
- Cannot prevent others from making, using, or selling same type of goods
- Only protects the mark (*e.g.*, a name) that identifies the good or services and not the goods themselves
- Strong and effective tool for branding

Industrial Designs

- Protection for ornamental features associated with articles used in commerce
- Limited uniformity world-wide in requirements and scope of protection available
- Design patents in some countries
- Protection of industrial design and patent protection not mutually exclusive in some countries



Trade Secrets

Trade Secrets

- Any confidential information with independent economic value not in public domain (often know-how of designs, manufacturing method)
- Any information belonging to an entity that is neither readily known nor readily ascertainable outside the entity

Examples of Trade secrets:

- Formulas, patterns, processes, methods, compilations, customer lists, etc.
- Secret formula for making Coca Cola®
(Coca Cola company holds formula as trade secret)

Trade Secrets

Advantage

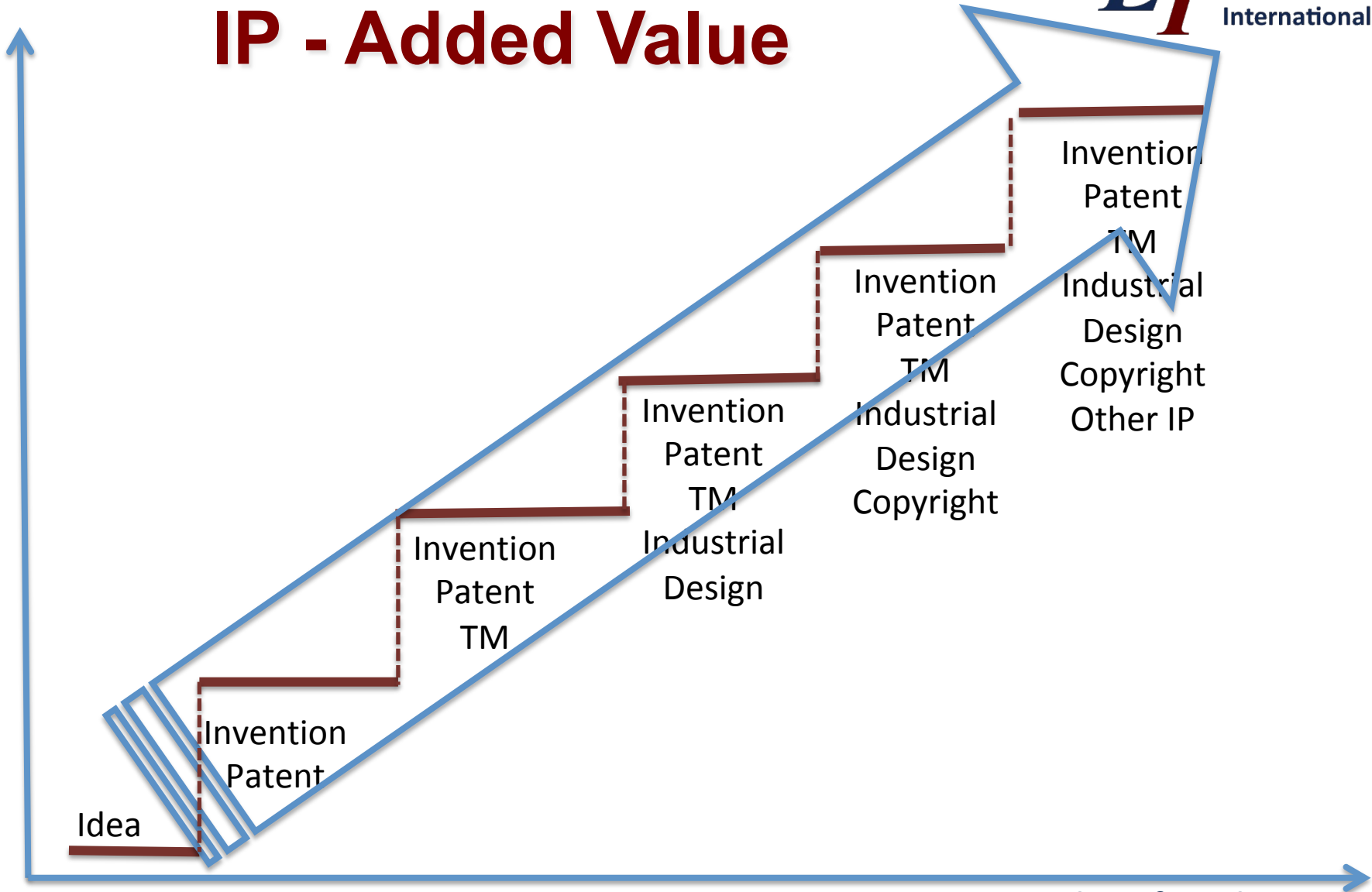
- No time limit for protection
- No patent filing costs

Disadvantage

- Protection only as long as secret is kept as secret
- Legally protected only where third parties have obtained the confidential information by illegitimate means (spying, economic espionage, stealing information etc.)
- No uniformed laws of trade secret. Many countries do not have any legal framework for trade secrets protection
- Limited protection i.e., companies are often less interested in licensing trade secrets compared to patents

IP rights

IP - Added Value





**Thank you for
your attention**

yhamano309@gmail.com

Yumikoh@etcube.com