



## **Topic 2: Preliminary Consideration before Drafting a Patent Application**

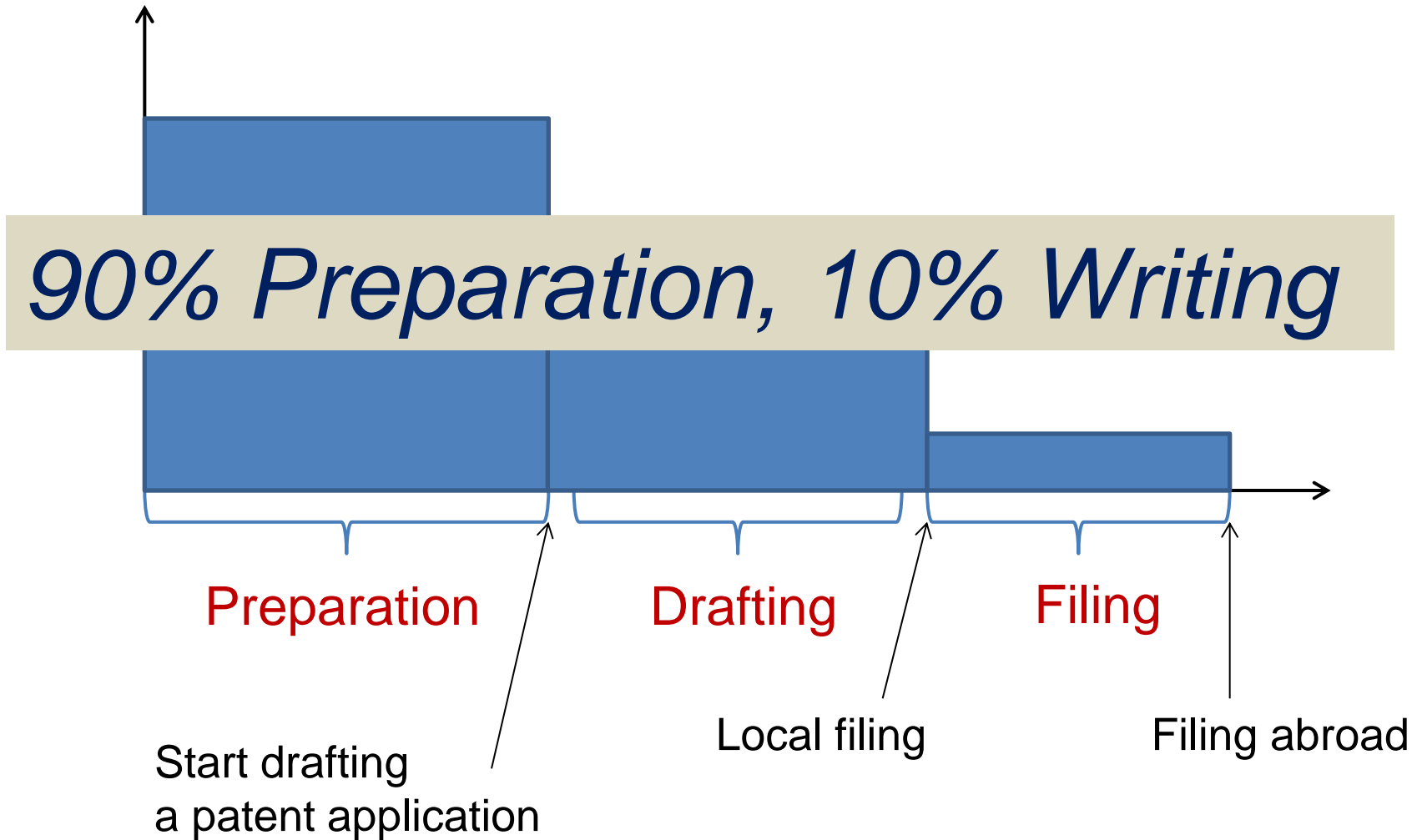
WIPO National Patent Drafting Course

**Bangkok**

**August 22, 2016**

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Head, Patent Law Section, WIPO

# Understanding the invention and preparing a patent application



# Four Big Questions

■ Why?

■ What?

■ When?

■ Where?

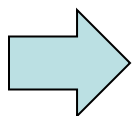


Inter-related questions

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)
- ...

Particularly, 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?

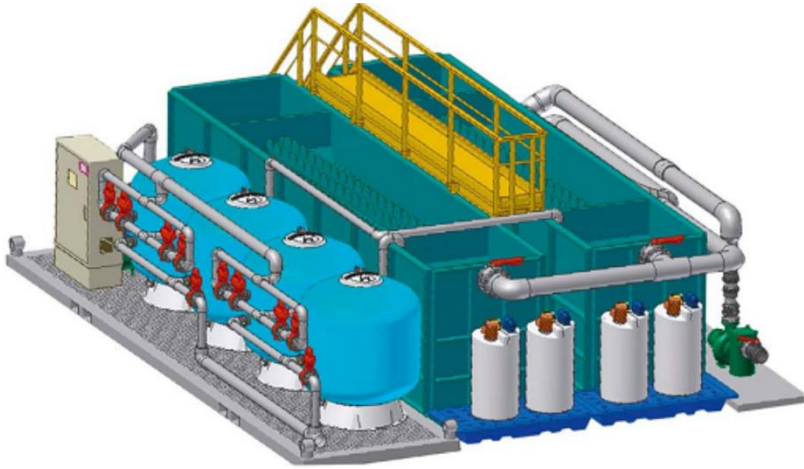
“*Trade Secrets*” means trade information **not yet publicly known or not yet accessible** by persons who are normally connected with the information. The **commercial values of which derive from its secrecy** and that the controller of the trade secrets has **taken appropriate measures to maintain the secrecy**.

[Trade Secret Act, Section 3]

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

What is the invention to be filed?



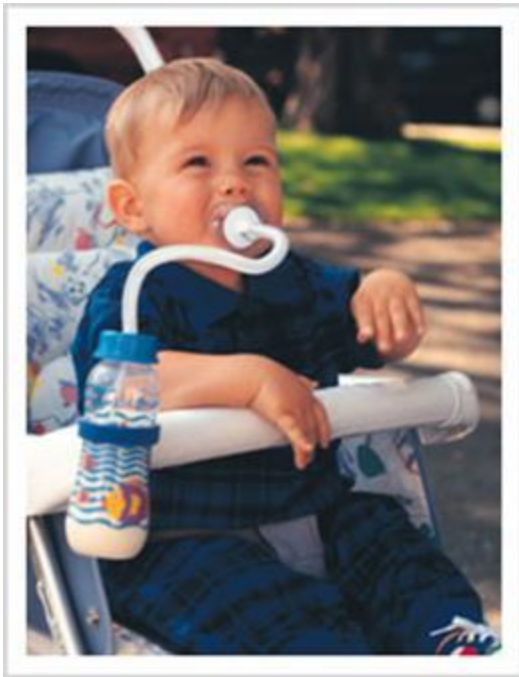


Michelin® X® TWEEL® SSL Comparison Tests

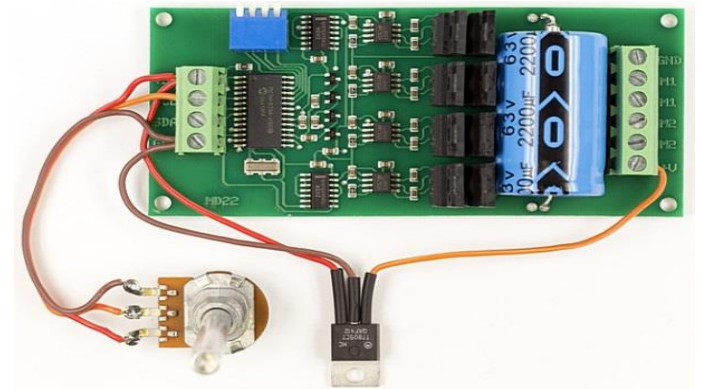
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The MICHELIN® X® TWEEL® SSL Airless Radial Tire™ for Skid Steer Loaders is on sale now in the US and Canada. This video is an update to



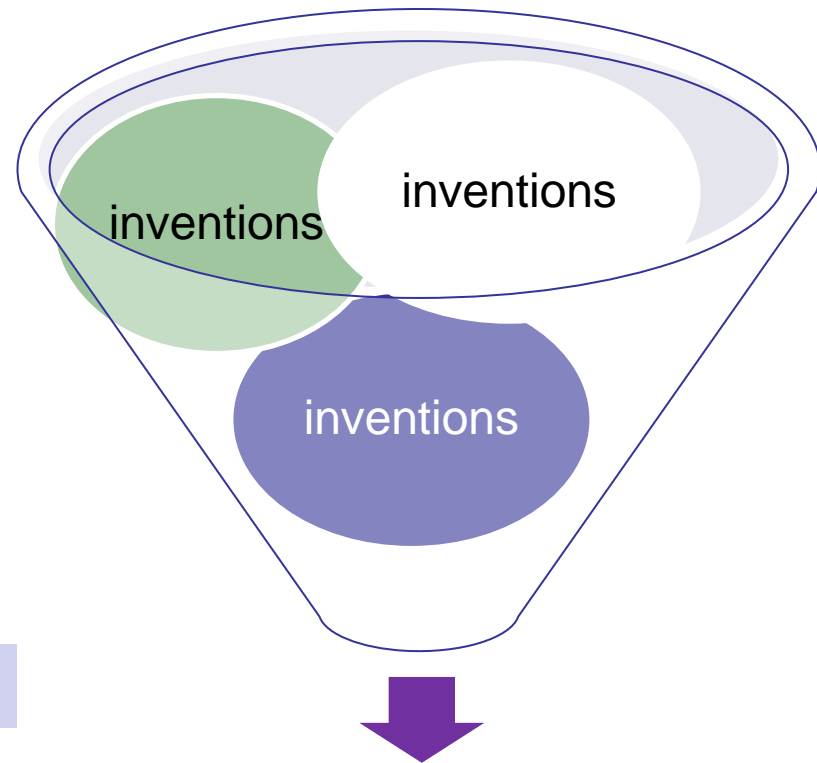
One invention or many inventions?



# Inventions

- **Inventions**  
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

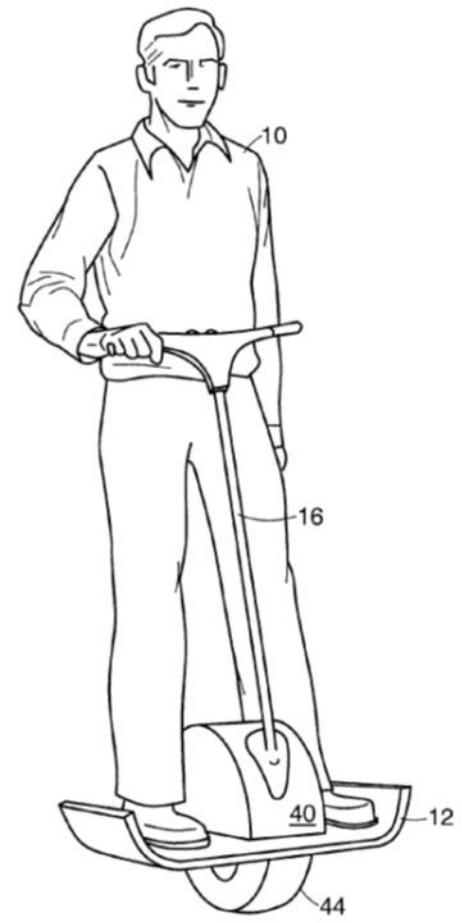
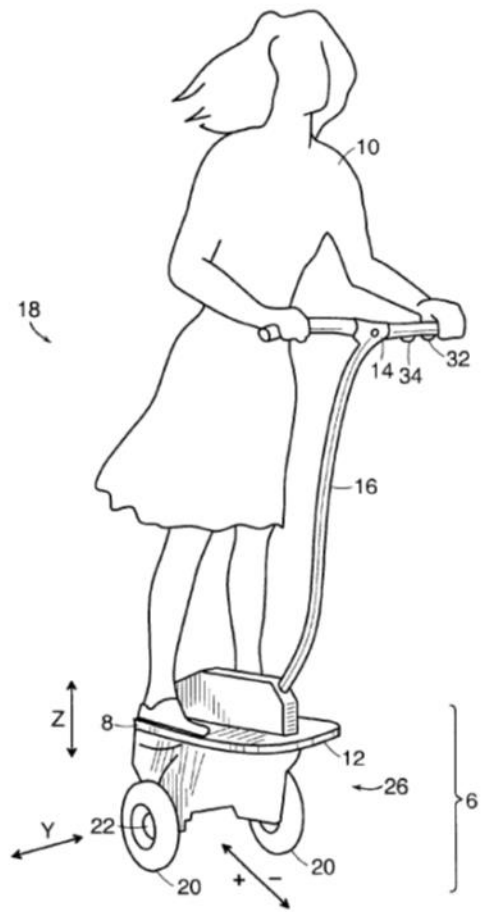


Patentable inventions

# Identifying an inventive concept

- Identifying a patentable invention – work together with the inventor
- ex. Invention disclosure form
  
- 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

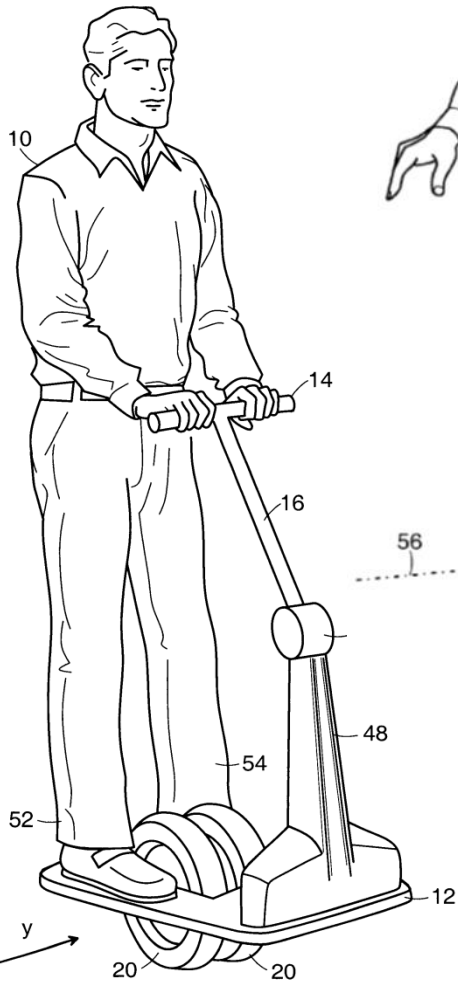


FIG. 10

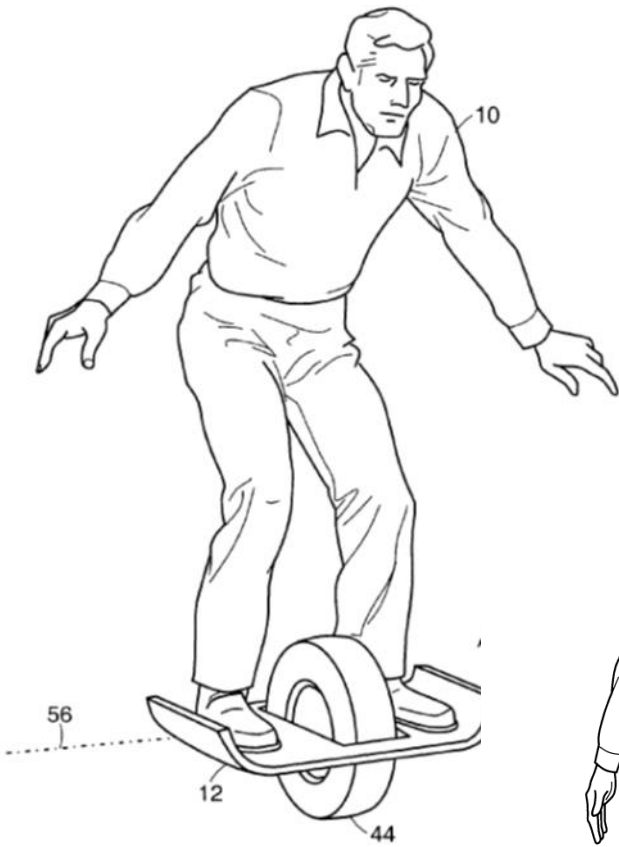


FIG. 12

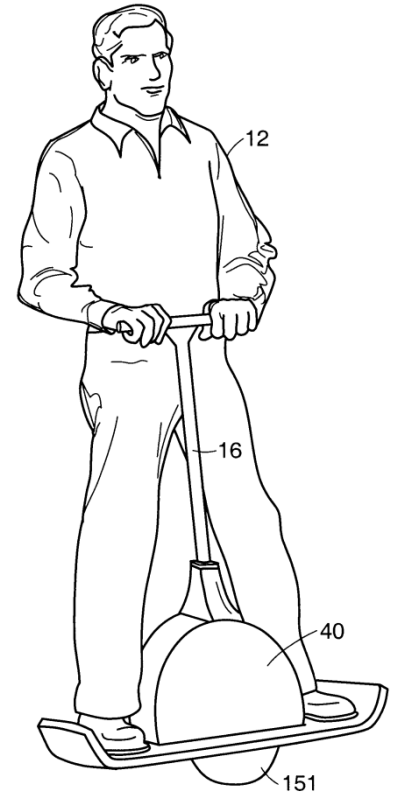
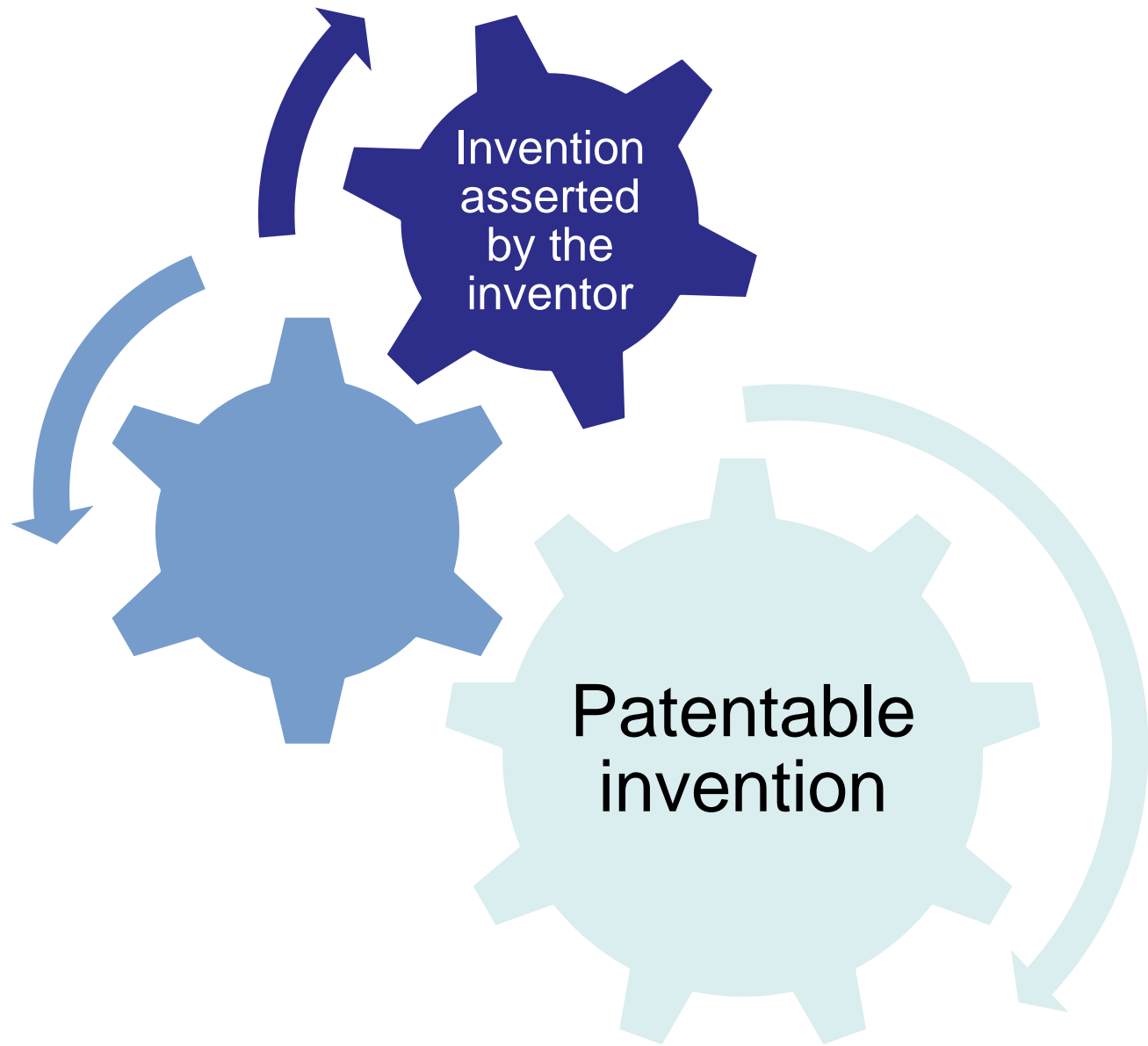


FIG. 15



# Entitlement

Who is entitled to seek patent protection?

- Are we entitled to a patent?
- Who is an inventor?
- Any co-inventor?
- Any contractual agreement relating to the entitlement?

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 contain [...] a detailed description of the invention in such **full, concise and clear and exact terms** as to **enable a person skilled in the art** [...] to make and use the invention [...].”* (Section 17(3) of the Patent Act)

- **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** in Thailand (Section 6, 3<sup>rd</sup> sentence and Section 19 of the Patent Act)

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

ex. If an invention is exhibited at an exhibition sponsored by the Thai government and held in Thailand, such disclosure does not prejudice the novelty under the Thai Patent Act, but it prejudices the novelty under the European Patent Convention if a corresponding European application is filed.

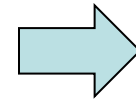
□ If improvement/development of the invention is foreseen, avoid self-collision with future applications.

Where do you file a patent application?

# Where to file patent applications?

## Local filing

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



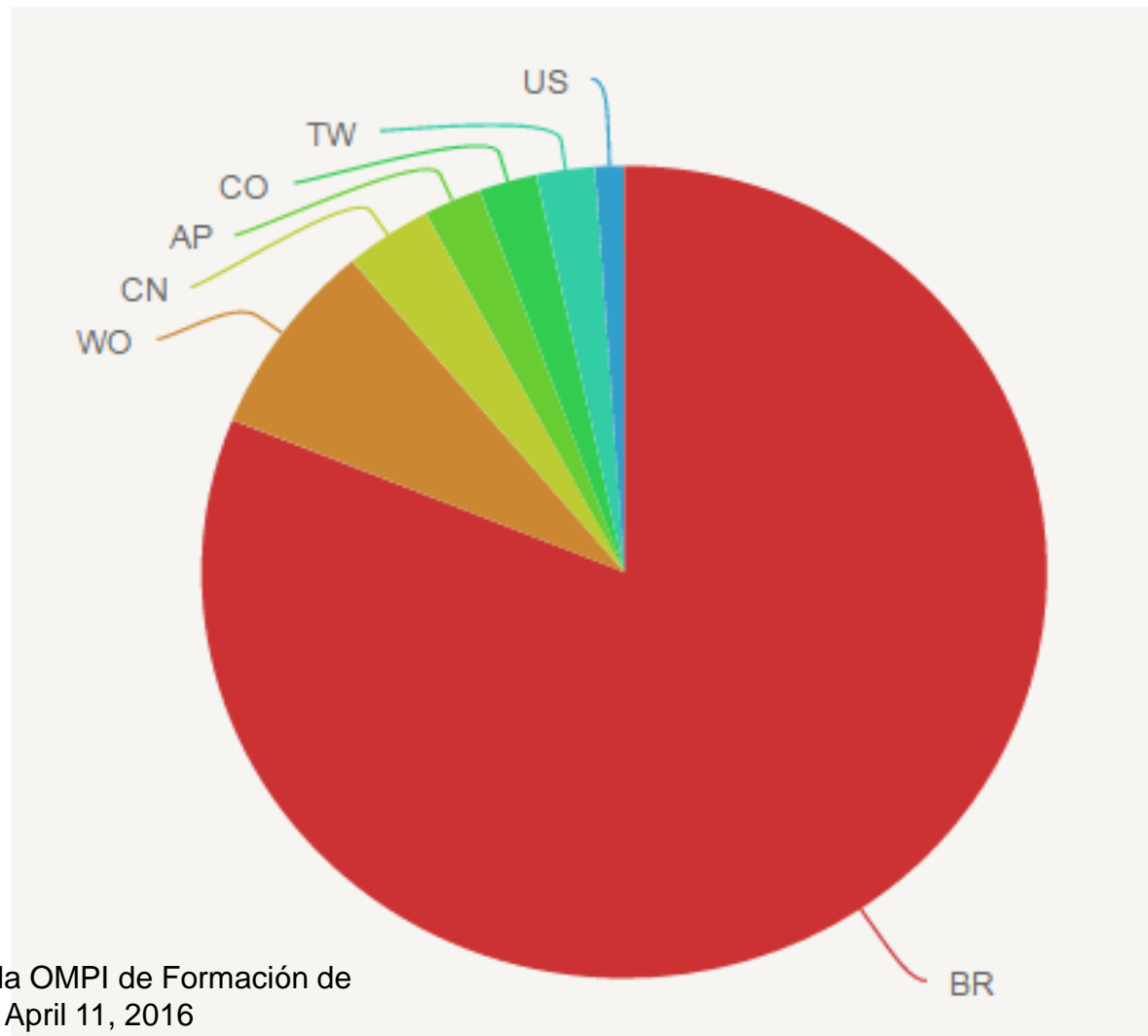
Foreign  
filings

\$\$\$?

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

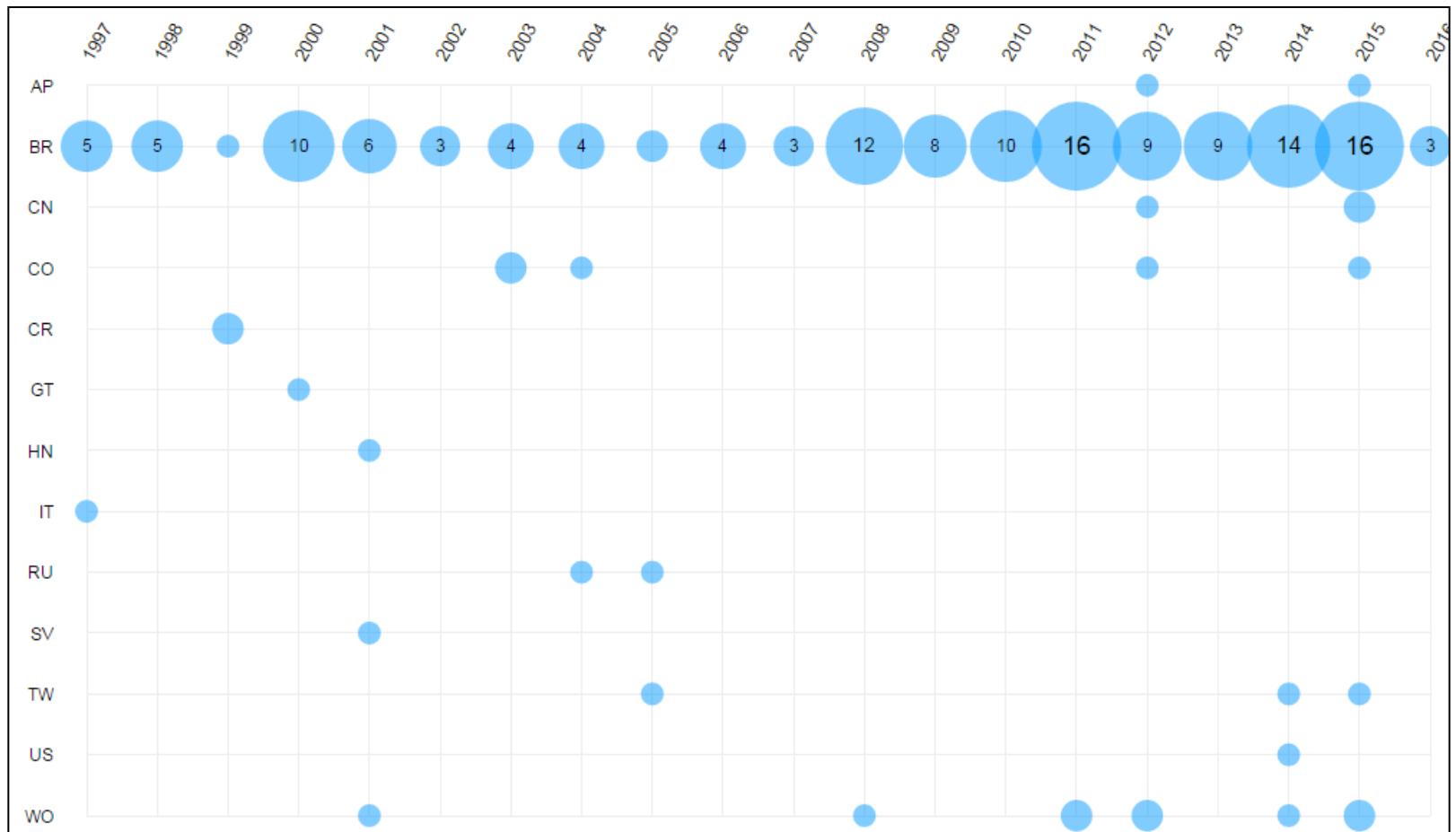
# Where is the (future) market?

Patents relating to picking of coffee (IPC A01D 26/04)



# Evolution of patenting activities in various countries

## Picking of coffee (IPC A01D 26/04)



# Who are competitors? Who are potential licensees?

## ■ Picking of coffee (IPC A01D 26/04)



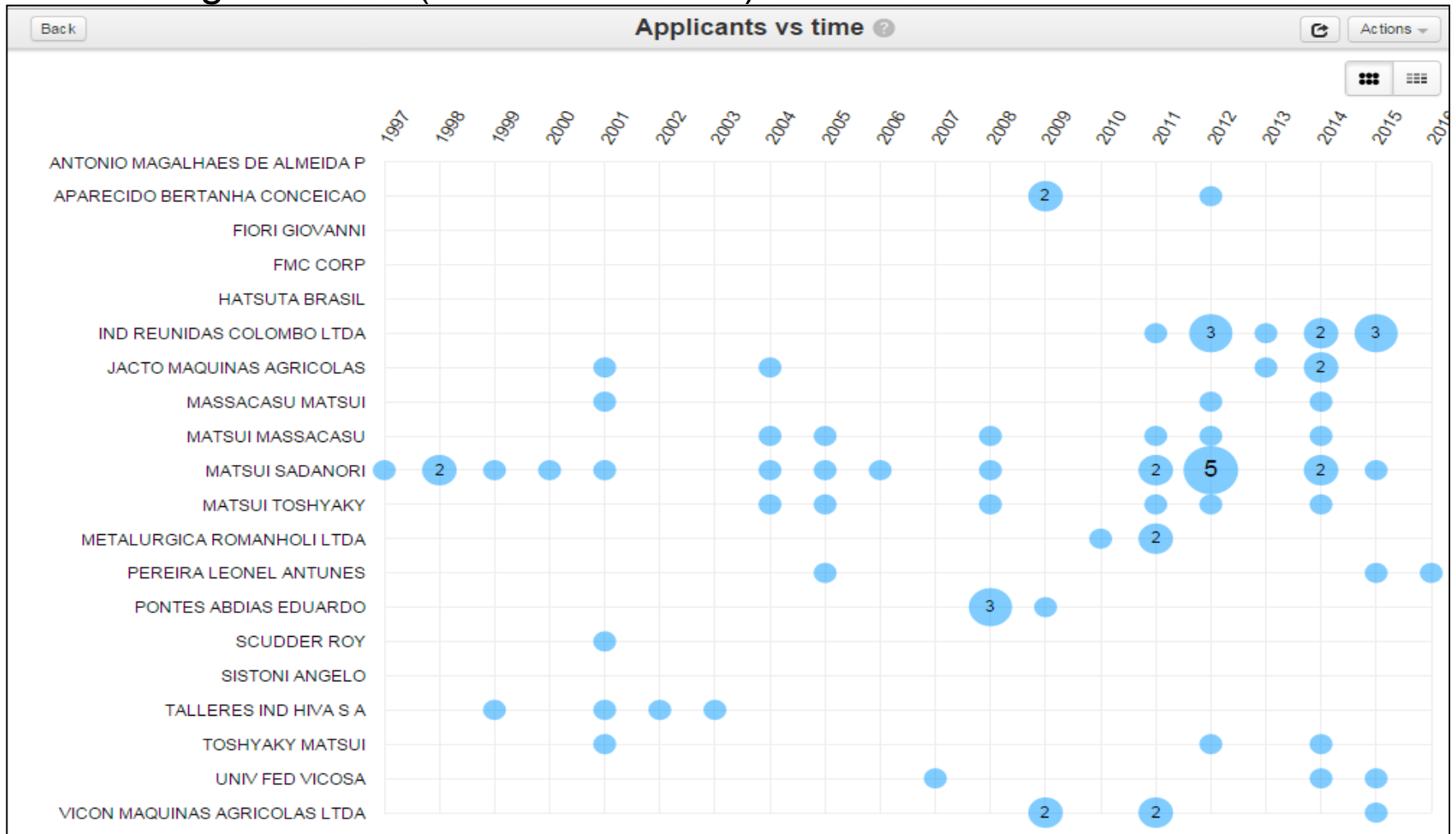
The screenshot shows a web interface for a patent database. At the top, there is a header "Applicant" with a question mark icon and a search icon. Below the header, there is a navigation bar with buttons for "5", "10", "20", "30", "40", and "50". The main content area displays a list of applicants for the IPC class A01D 26/04. The list is as follows:

ANTONIO MAGALHAES DE ALMEIDA P • APARECIDO BERTANHA CONCEICAO  
BERTANHA CONCEICAO APARECIDO • BRUDDEN EQUIP • CAMIC CAJURU MAQUINAS IND E CO  
DA CONCEICAO JESIVALDO PEREIRA • FEDERACION NAC DE CAFETEROS DE COLOMBIA • FIORI GIOVANNI  
**FMC CORP** • FORSTER NILBERTO JOAO • GUIMARAES FRANCISCO DOS REIS F • HATSUTA BRASIL  
HIDALGO VARGAS EDGAR • HOROWICZ ADOLFO • IGUACUMEC ELETROMECHANICA LTDA  
**IND REUNIDAS COLOMBO LTDA** • INOVACAO EM MECANIZACAO AGRICOLA CEIFA LTDA  
**JACTO MAQUINAS AGRICOLAS** • KOJI OBARA MILTON • LENDARO ERNESTO  
MASSACASU MATSUI • MATSUI MASSACASU • **MATSUI SADANORI**  
MATSUI TOSHYAKY • METALURGICA ROMANHOLI LTDA • MILTON KOJI OBARA • MURAKAMI JORGE HIROSHI  
NISHIMURA TAKASHI • PEREIRA LEONEL ANTUNES • PEREIRA SALVIO • PONTES ABDIAS EDUARDO  
RUY PAMPLONA • SCUDDER ROY • SHUNICHI OBATA • SISTONI ANGELO • SPIRLANDELLI AUGUSTO  
TALLERES IND HIVA S A • TOSHYAKY MATSUI • UNIV FED VICOSA  
**VICON MAQUINAS AGRICOLAS LTDA**



# Evolution by applicants

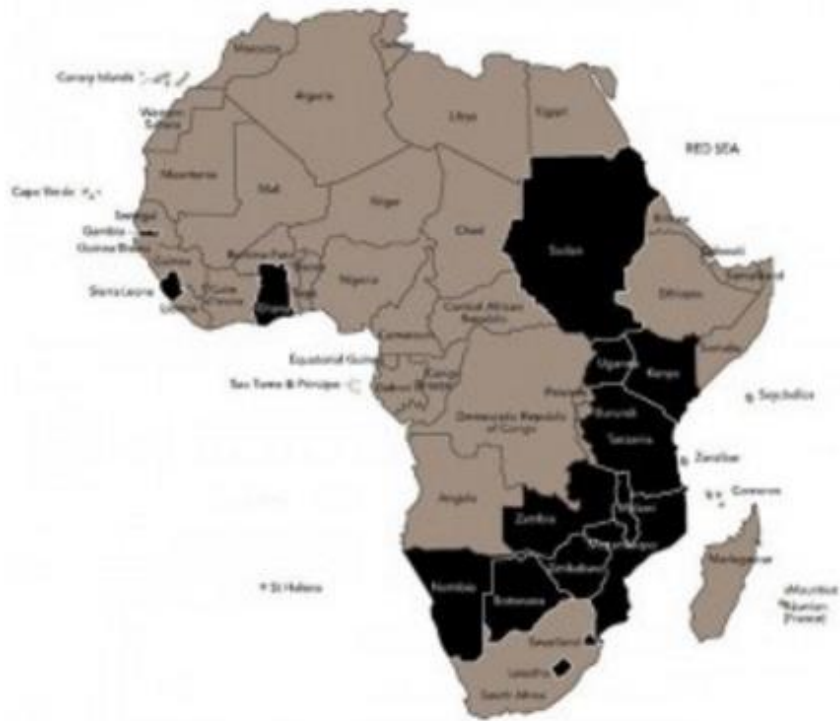
## ■ Picking of coffee (IPC A01D 26/04)



# Various patent filing systems

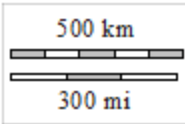
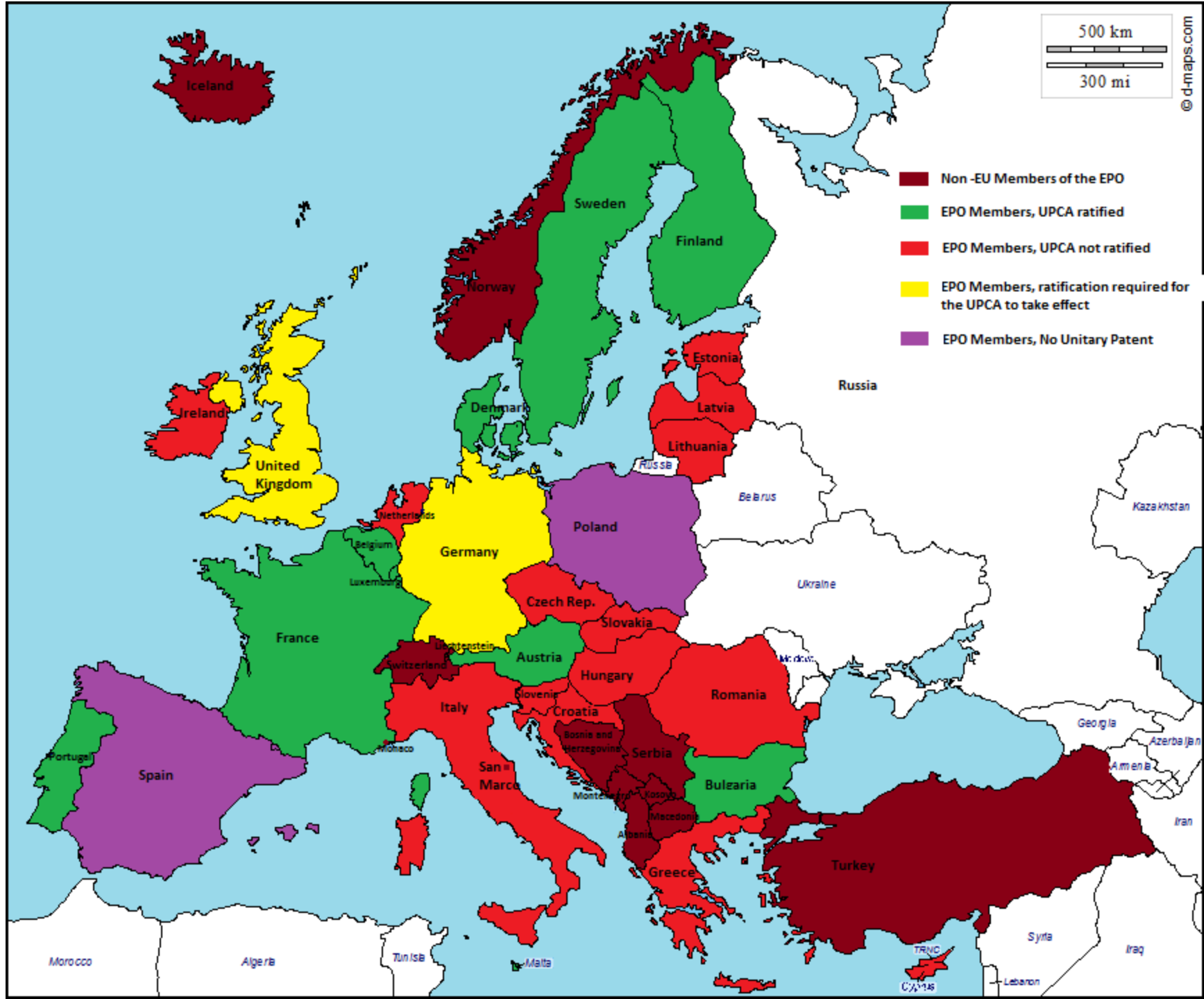
- Filing a national application with a national office
- Filing a regional application with a regional office
- Filing an international application using the Patent Cooperation Treaty (PCT)

# ARIPO



# OAPI





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- Non-EU Members of the EPO
- EPO Members, UPCA ratified
- EPO Members, UPCA not ratified
- EPO Members, ratification required for the UPCA to take effect
- EPO Members, No Unitary Patent

P E R T Y

- Eurasian Patent Office (EAPO)

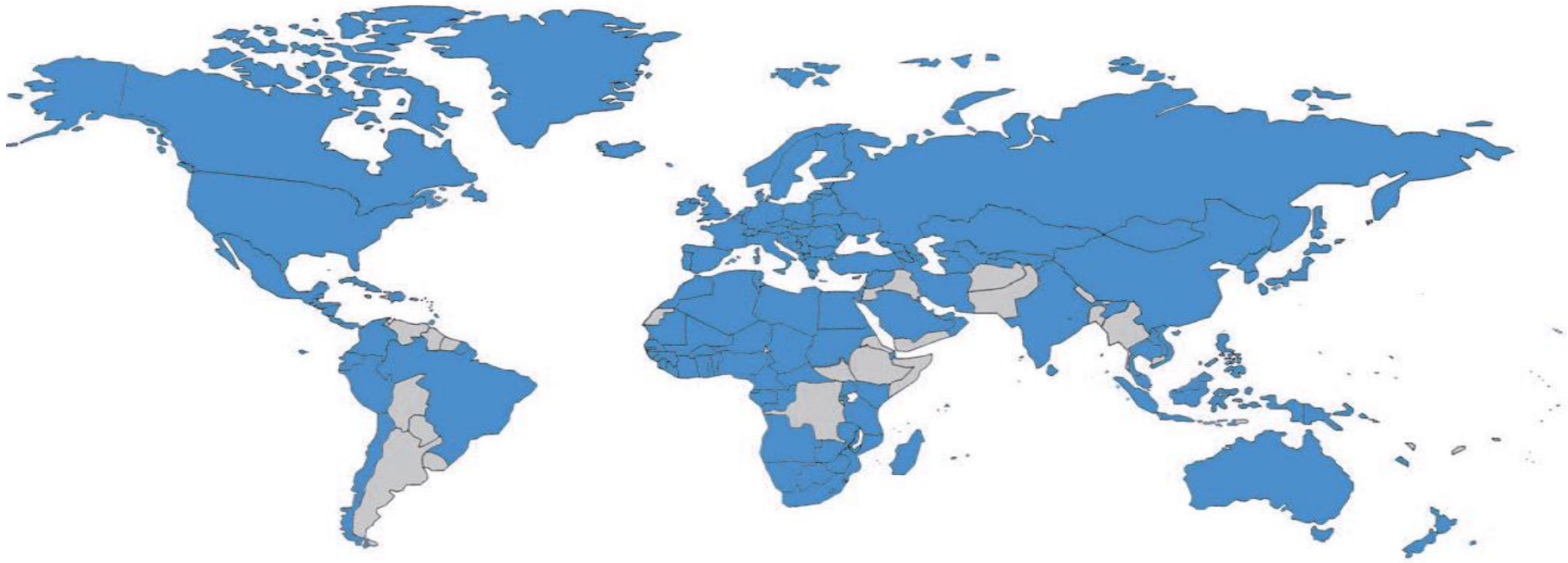
Armenia, Azerbaijan, Belarus, Kazakhstan, Kyrgyzstan, Moldova, Russian Federation, Tajikistan and Turkmenistan

- Gulf Cooperation Council (GCC) Patent Office

Bahrain, Kuwait, Oman, Qatar, Saudi Arabia and United Arab Emirates

# PCT international patent application

- Filing one “international” patent application has the same effect as filing national applications in 150 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.



# 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](mailto:pct.infoline@wipo.int)

# Thank you.

[Tomoko.miyamoto@wipo.int](mailto:Tomoko.miyamoto@wipo.int)