



## Topic 10: **Preparing grant and publication**

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# Overview

- Patent information in general
- Items to be checked for publication

# Role of patents

- ▶ Historically two competing interests of two stakeholders:

Protection of innovative idea

Inventor



Disclosure of technical teaching  
for further use by others

Public

# Role of patent information

Publication of patent information serves two purposes:

- ▶ Informing of existing **protection** rights  
what? where? when?
- ▶ **Disclosure** and dissemination of technical teaching

# What is **published** over life cycle ?

- Varies strongly from country to country
- Minimum: notification of grants or other events in Gazettes
  - if so: further information only retrievable through file inspection
- Often but not always:
  - full specification of granted patents
  - applications
    - usually 18 month after filing
    - many countries (DCs) don't (PCT NPE)
  - search reports, corrections, amendments, translations
  - legal status

# What is published over life cycle ?

Conclusion:

- In (many)(some) countries the public life of an application only starts after granting
- In (many)(some) countries only file inspection discloses technical teaching and scope of protection
- That violates the basic concept of the patent system to grant protection in exchange of disclosure
- It also prevents early information on possible infringement of potential patent rights.

# Checking before grant

- i.e. after agreement on acceptable claims
- Publication of grant has to comply with certain additional requirements beyond novelty, etc
- These requirements are usually defined in separate regulations, and may vary from country to country
- Only what is defined in regulations can be enforced, e.g. by rejection
- The following gives only some general guidance

# Components of a patent document to be checked for grant

- ▶ Bibliographic data (frontpage)
- Title, abstract, applicant(s), inventor(s), priorities, ..
- ▶ Description part
- Problem to be solved, prior art, inventive idea, embodiments
- ▶ Drawings
- ▶ Claims
- ▶ (State of art search report)





# Checking

- Nothing added to initial disclosure, in
  - Claims
  - Description
  - Drawings
- Sufficient disclosure of inventions in a patent application
- Title not too general
- Abstract referring to solution not only problem or general background

# Checking

- Drawings:
  - Reference numerals included
  - Quality
- Description
  - Inclusion of relevant state of the art (e.g. in case of two part claims)
  - Check that no additional “beneficial” features of invention are introduced in this way
  - Problem to be solved should be mentioned & solution (e.g. amended wording of claims)
  - No derogative or promotional statements

Thank you