



#### Introduction to WIPO



Speaker: Mr. John Sandage

Deputy Director General,

Patents and Technology Sector, WIPO

E-mail: john.sandage@wipo.int

Salt Lake City, United States of America November 04, 2016



MISSION: To lead the

development of a balanced and effective international intellectual property (IP) system that enables innovation and creativity for the benefit of all.

- MEMBER STATES: 188
- OBSERVERS: more than 390 (NGOs, IGOs, industry groups, etc.)
- STAFF: more than 1. 200
- ADMINISTERED TREATIES: 26
- MAIN BODIES: General Assembly, CC, WIPO CONFERENCE

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## WIPO is Service and Development oriented

Economic Development

Norm Setting

Services to Industry

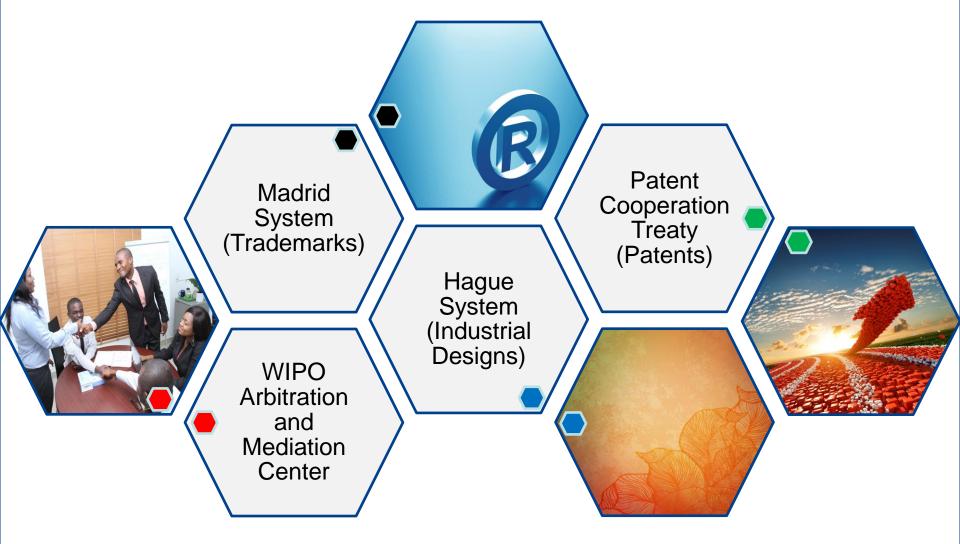
Global Infrastructure

### ACCESS TO INTERNATIONAL MARKETS



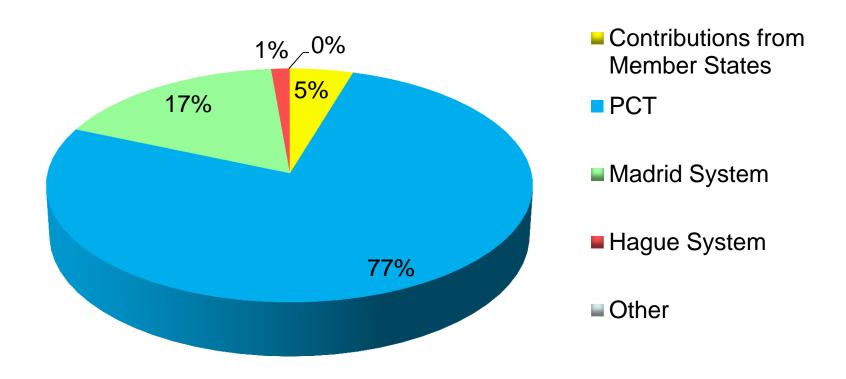
WIPO main offices

#### WIPO: Provider of Premier Global IP Services



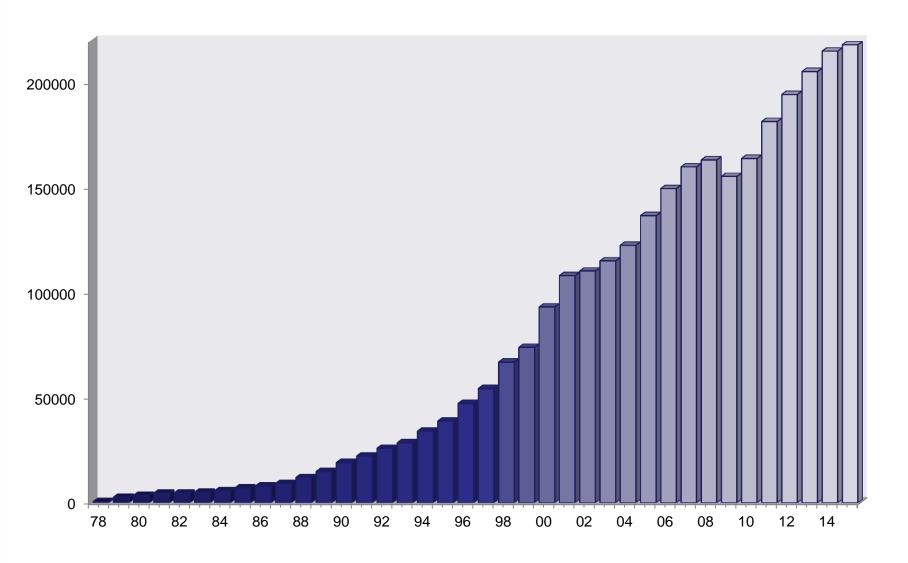
### WIPO's Budget: 756,3 Million CHF for 2016 - 2017

#### **Budget by income**





## **PCT Applications**



2015: 218,000 (+1.7%)

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## **PCT Operations at a glance:**

- WIPO's International Bureau received 220,000 record copies in 2014, growing 3% over the prior biennium:
  - USA was first, with 57,000 filings.
  - The share of fully electronic filings continued to increase, now 91% of all filings.
- Number of PCT Staff is decreasing:
  - The number of PCT staff has been reduced by 33% -- from a high of 456 to 296 over the last 12 years a reduction of 160 FTEs.
  - But Examiner productivity has risen 22%.
- Quality of work by IB is improving:
  - Overall output quality has increased from 81% to 93%.
  - Due mainly to improved timeliness and reduced errors.
- No fee increase in 7 years!



## WIPO Systems – and now The Hague!

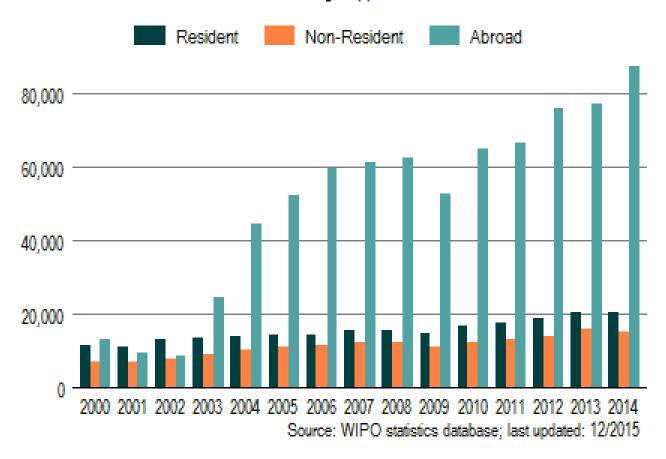
- Patent Cooperation Treaty (PCT)
- Madrid System
- Alternative Dispute Resolution
- The Hague System
  - Second largest filer worldwide is Procter and Gamble (US), with 95 filings

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 Among the top five origins, the United States of America saw the fastest growth in the number of registered designs (+14.2%)

## Industrial Design Applications

Industrial Design Applications





Repositories of Information

 Databases e.g. Patentscope and Global Brand Database



**Platforms** 

- Common platform for e-data exchange among IPOs: IPAS, DAS
- Other platforms: WIPO GREEN and WIPO Re:Search

Treatment of Information

- International Classification Systems (Organize into indexed, manageable structures for easy retrieval)
- Standards for IP Offices (Help streamline data processing)





- World Intellectual Property Report (2015): Breakthrough Innovation and Economic Growth
- The PCT Yearly Review provides an overview of the performance and development of the PCT system:

  <a href="http://www.wipo.int/ipstats/en/statistics/pct/">http://www.wipo.int/ipstats/en/statistics/pct/</a>
- Madrid Yearly Review: <a href="http://www.wipo.int/ipstats/en">http://www.wipo.int/ipstats/en</a>
- Hague Yearly Review: <a href="http://www.wipo.int/ipstats/en/">http://www.wipo.int/ipstats/en/</a>
- The WIPO IP Facts and Figures
  provides an overview of IP activity based
  on the latest available year of statistics.
  It serves as a quick reference guide for
  statistics: http://www.wipo.int/ipstats/en/
- World Intellectual Property Indicators (WIPI) provides an overview of latest trends in IP filings and registrations covering more than 100 offices:

  <a href="http://www.wipo.int/ipstats/en/wipi/index.html">http://www.wipo.int/ipstats/en/wipi/index.html</a>
- WIPO IP Statistics Data Center
  <a href="http://ipstatsdb.wipo.org/ipstatv2/ipstats/">http://ipstatsdb.wipo.org/ipstatv2/ipstats/</a>
  <a href="patentsSearch">patentsSearch</a>

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## Country Profile



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#### The Global Innovation Index

#### **RANKING 2015**

- 1. SWITZERLAND
- 2. UNITED KINGDOM
- 3. SWEDEN
- 4. NETHERLANDS
- 5. UNITED STATES OF AMERICA
- 6. FINLAND
- 7. SINGAPORE
- 8. IRELAND
- 9. LUXEMBURG
- 10. DENMARK
- 11. HONG KONG (CHINA)
- 12. GERMANY
- 13. ICELAND
- 14. KOREA, REPUBLIC OF
- 15. NEW ZEALAND

#### **RANKING 2016**

- 1. SWITZERLAND
- 2. SWEDEN
- 3. UNITED KINGDOM
- 4. UNITED STATES OF AMERICA
- 5. FINLAND
- SINGAPORE
- 7. IRELAND
- 8. DENMARK
- 9. NETHERLANDS
- 10. GERMANY
- 11. KOREA, REPUBLIC OF
- 12. LUXEMBOURG
- 13. ICELAND
- 14. HONG KONG (CHINA)
- 15. CANADA



## **Top PCT Applicants 2015\***

() of published	1. Huawei Technologies—CN (3,898)**	+450		
PCT applications	2. Qualcomm—US (2,442)			
	3. ZTE—CN (2,155)			
	4. Samsung—KR (1,683)	+300, up from #11		
	5. Mitsubishi Electric—JP (1,593)			
	6. Ericsson—SE (1,481)			
*48,539 total PCT applicants in 2015	7. LG Electronics—KR (1,457)	+320, up from #16		
	8. Sony—JP (1,381)	+400, up from #21		
	9. Philips—NL (1,378)			
	10. Hewlett-Packard—US (1,310)	+485, up from #25		
	11. Siemens—DE (1,292)			
	12. Intel—US (1,250)	2015:		
	13. Bosch—DE (1,247)	<ul><li>85% businesses</li><li>8% individuals</li><li>5% universities</li></ul>		
	14. Boe Technology—CN (1,227)			
	15. Toyota—JP (1,214)	<ul><li>2% government and</li></ul>		
	16. Panasonic—JP (1,185)	research institutions		
	17. Hitachi—JP (1,165)			
**more than 15 per WIPO working	18. Halliburton—US (1,121)	WIPO		
	19. Sharp—JP (1,073)	WORLD INTELLECTUAL PROPERTY ORGANIZATION		
day	20. Tencent Technology—CN (981)			

## **Top University PCT Applicants 2015**

- 1. University of California (US)
- 2. MIT (US)
- 3. Johns Hopkins (US)
- 4. University of Texas (US)
- 5. Harvard University (US)
- 6. University of Michigan (US)
- 7. University of Florida (US)
- 8. Tsinghua University (CN)
- 9. University of Tokyo (JP)
- 10. Stanford University (US)
- 11. Seoul National University (KR)
- 12. Peking University (CN)
- 13. Columbia University (US)
- 14. Isis Innovation Limited (GB)
- 15. Cornell University (US)
- 16. University of Pennsylvania (US)
- 17. Kyoto University (JP)
- 18. Korea University (KR)
- 19. CalTech (US)
- 20. Danemarks Tekniske Universitet (DK)



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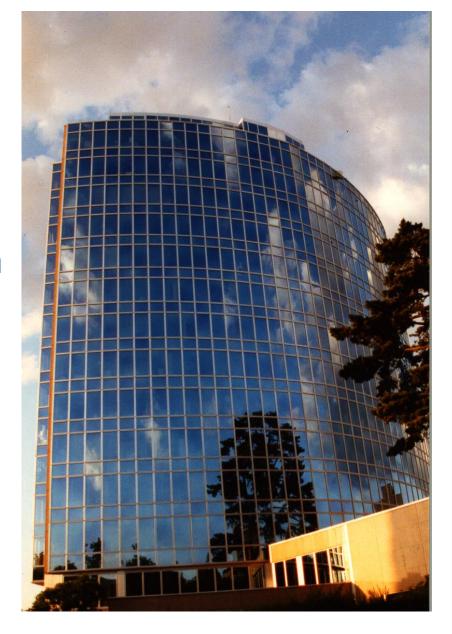
 WIPO Magazine www.wipo.int/wipo\_magazine/en/

• WIPO Wire: www.wipo.int/newsletters/en

Press releases
 www.wipo.int/pressroom/en/



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# The International Registration of Trademarks, Using the Madrid System

Roving Seminar on WIPO Services and Initiatives



Matthew Forno
Senior Counsellor
Information and Promotion Division
Brands and Designs Sector, WIPO

Salt Lake City, United States of America November 4, 2016

## It begins with a trademark and a plan to export...



#### DAIMLER

/HI/EIDO





**MICROMAX** 















## **Protection Options**

- ...Then a choice must be made regarding the best way to protect your trademark/s abroad:
- The national route file trademark application/s with the IP Office of each country in which you want protection
- The regional route apply through a regional trademark registration system with effect in all member states (ARIPO, Benelux Office for IP, EUIPO and OAPI)
- The international route file through the Madrid System

#### The International Route

The international route through the Madrid System may be the preferred option when you:

- Seek protection in multiple markets, particularly if these are in different regions
- Want flexibility to add new markets as your export plans develop
- Have limited budget and/or time to spend on registration and management of your trademarks

## The Madrid System is Convenient

- Access a centralized filing and management procedure
- File one application, in one language and pay one set of fees for protection in multiple markets
- Expand protection to new markets as your business strategy evolves



## The Madrid System is Cost-effective

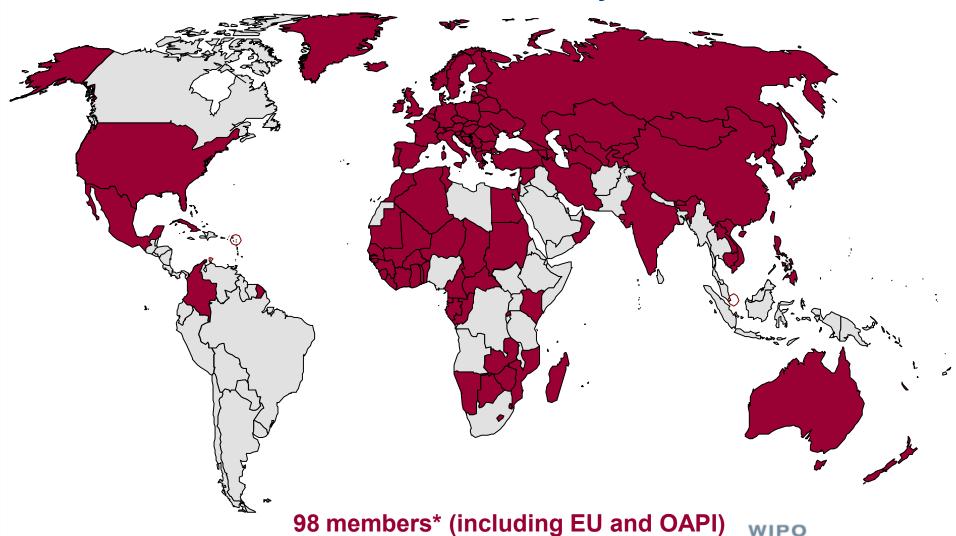
- File an international application, which is the equivalent of a bundle of national applications, effectively saving time and money
- Avoid paying for translations into multiple languages or working through the administrative procedures of multiple IP Offices

## The Madrid System offers Broad Geographic Coverage

- Protect your trademark/s simultaneously in the 114 countries covered by the 98 members of the System
- Access markets that represent in excess of 80% of world trade, with potential for expansion as membership grows
- Recent accession include
  - 2013: India, Rwanda and Tunisia
  - 2014: OAPI and Zimbabwe
  - 2015: Algeria, Cambodia, The Gambia and Lao PDR
  - 2016: Brunei Darussalam



## Members of the Madrid System



covering 114 countries

\*All are party to the Protocol, the governing treaty, while 55 are also party to the Agreement

## How the Madrid System Works

#### The International Trademark Registration Process



## Stage 1

## Application through your National or Regional IP Office (Office of origin)

- To be entitled to use the Madrid System, you must:
  - Have a real and effective industrial or commercial establishment in, or
  - Be domiciled in, or
  - Be a national of a member of the Madrid System
- Before filing an international application, you need to have registered or filed an application (basic mark) in your Office of origin
- Submit an **international application** through this same IP Office, which will certify and forward it to WIPO

## Stage 2

#### Formal examination by WIPO

- WIPO conducts a formalities examination of your international application
- Once requirements have been met, the mark is recorded in the International Register
- WIPO sends a certificate of international registration to the holder and notifies the IP Offices, of the designated Contracting Parties, in which protection is sought
- The scope of protection is not known at this stage. It is only determined after substantive examination and decision by the IP Offices, as outlined in Stage 3

## Stage 3

## Substantive examination by IP Offices (Office of the designated Contracting Party)

- IP Offices make a decision within 12 or 18 months in accordance with their legislation. WIPO records the decisions and notifies you
- If an IP Office refuses to protect your mark, it will not affect the decisions of other offices. You can contest a refusal decision before the IP Office concerned
- If an IP Office accepts to protect your mark, it will issue statement of grant of protection
- The international registration is valid for 10 years. Renew directly with WIPO with effect in the designated Contracting Parties

#### Costs

#### Fees are payable to WIPO in Swiss francs

- Basic fee\*, which includes 3 classes of goods/services
  - 653 Swiss francs b/w reproduction of mark
  - 903 Swiss francs color reproduction of mark
- Fees for designating Contracting Parties (dCP)
  - Standard fees complementary (100 Swiss francs per dCP and supplementary (100 Swiss francs per class beyond 3)

OR

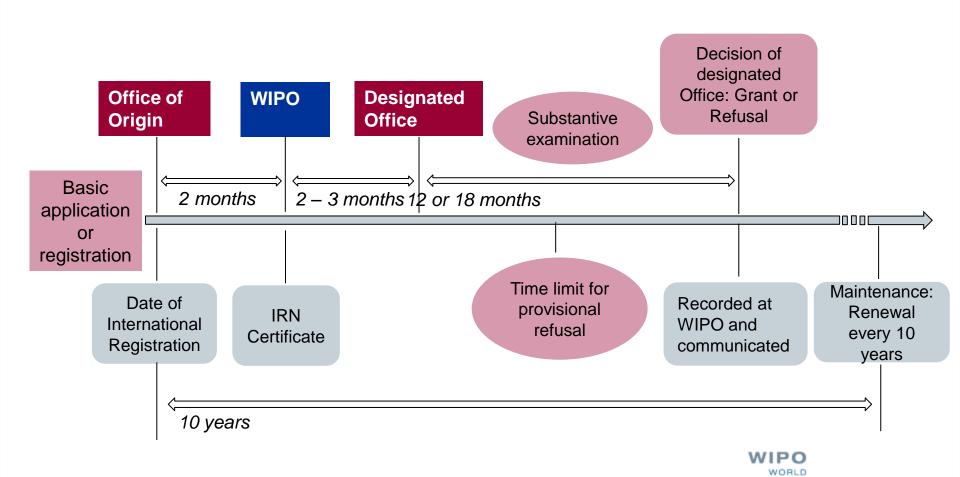
Individual fees where this is declared



<sup>\*</sup> Applicants from Least Developed Countries benefit from a 90% reduction in the basic fee

#### **Timeline**

#### The International Trademark Registration Process



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### WIPO Resources and E-Services

#### **SEARCH**

Global Brand Database – search marks by text and image from national/international sources, including trademarks, appellations of origin and official emblems

Member Procedures

#### FILE

Forms and E-Forms

<u>Madrid Goods & Services Manager</u> – correct good & service specifications and translation

**International Application Simulator** 

Fee Calculator

E-Payment – online payment system by credit card/WIPO current account

#### **MONITOR**

Madrid Monitor (Beta) – search and access international registration(IR) information

ROMARIN - IR database

Madrid Real-Time Status of international applications and progress of requests

Madrid Electronic Alert – monitor IR changes

#### **MANAGE**

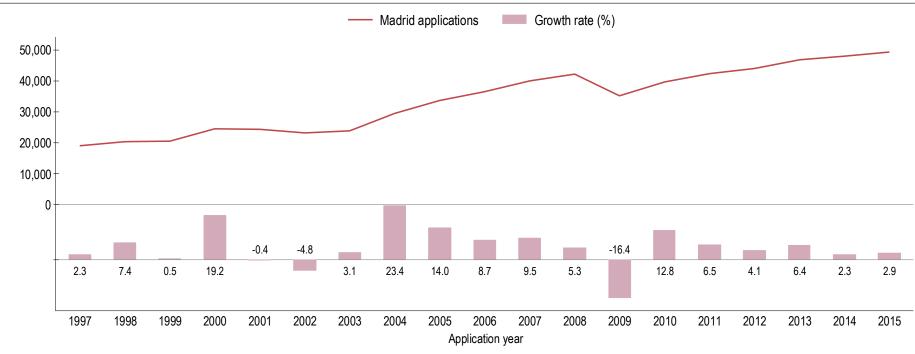
<u>Madrid Portfolio Manager</u> – access registration documents, uploading of requests for recording, payments

<u>Forms and E-Forms</u> – <u>E-Subsequent</u> <u>Designation</u> and <u>E-Renewal</u>

Extracts from the International Register

## International Applications

Figure A.1.1 Trend in international applications





### General Profile 2015

#### **51,938 International Registrations**

Average Number of Designations	6.75
Average Number of Classes	2.49
Average Fee	CHF 3,102
All Fees	68% < CHF 3,000



## **Top Filing Contracting Parties**

Contracting Parties	2013	2014	2015
United States of America	5,893	5,414	8,486
European Union	6,814	6,996	8,131
Germany	4,357	3,883	4,603
France	3,514	3,377	3,718
Switzerland	2,885	2,994	3,128
Japan	1,855	1,729	2,407
China	2,455	1,738	2,231
Australia	1,195	1,246	2,229
Italy	2,118	2,070	2,165
United Kingdom	1,580	1,560	2,068



## **Top Designated Contracting Parties**

Contracting Parties	2013	2014	2015
China	20,275	20,309	24,849
United States of America	17,322	17,268	21,996
European Union	17,598	17,270	21,721
Russian Federation	18,239	16,573	17,436
Japan	13,179	12,814	15,776
Switzerland	13,215	12,759	14,584
Australia	11,675	11,533	14,292
Republic of Korea	10,967	10,402	12,997
India	1,916	8,138	11,391
Mexico	5,095	8,533	10,569



## **Top Applicants**

#	Name	Origin	Applications
1	NOVARTIS	Switzerland	197
2	LIDL	Germany	152
3	L'ORÉAL	France	130
4	PHILIPS	Netherlands	126
5	RICHTER GEDEON NYRT	Hungary	124
	BOEHRINGER INGELHEIM		
6	PHARMA	Germany	90
7	APPLE	USA	85
8	DAIMLER	Germany	83
9	BIOFARMA	France	81
10	GLAXO GROUP	United Kingdom	68

## Recent Developments

- <u>Madrid Monitor</u> (Beta) integrates <u>ROMARIN</u>, the <u>WIPO</u> <u>Gazette</u>, <u>Madrid E-Alert</u> and <u>Real-time Status</u>
- Madrid E-Filing (Australia and Benelux)
- Algeria's accession to Protocol
  - Madrid operating, for practical purposes, as singletreaty system
  - One form needed for international applications (MM2)
- Decision to Freeze Accessions to Agreement
- Publication of Madrid System Pendency Rates at WIPO



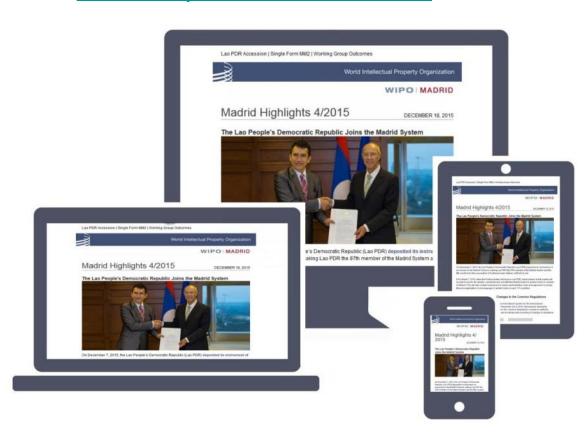
## Short-term Future of the System (2-3yrs)

- Enlarging Membership
  - ASEAN countries Indonesia, Malaysia and Thailand
  - Canada
  - Caribbean countries Trinidad and Tobago, and Jamaica
  - African countries Malawi and South Africa
  - Latin American countries
  - Arab Countries
- Broad-based review of E-Services and development of an online Customer Resources Center
  - Madrid Member Profiles database



## Keep Updated on the Madrid System

- Visit the Madrid Website <u>www.wipon.int/madrid/en</u>
- Subscribe to
   Madrid Notices,
   our regular legal
   and news updates
- Sign up for <u>Madrid Highlights</u>, our quarterly newsletter





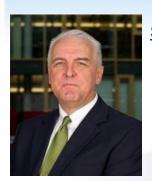
## Thank you for your attention



matthew.forno@wipo.int



# The Patent Cooperation Treaty (PCT) Current Status & Recent/Future Developments

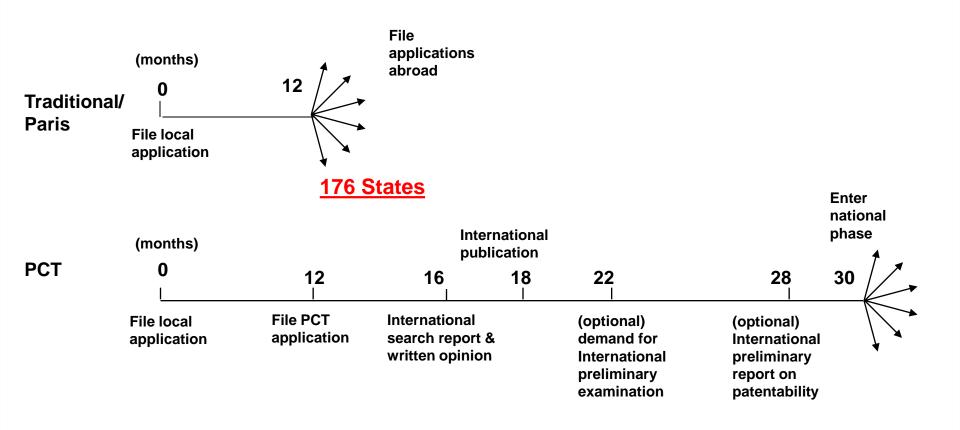


Speaker: Matthew Bryan, Director, PCT Legal Division

Salt Lake City, United States of America November 4, 2016

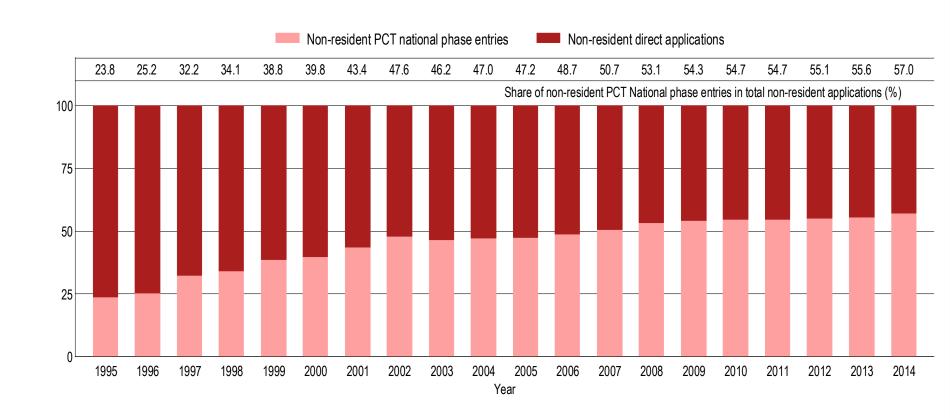
## **Overview/Current Status**

## Seeking patents multinationally: traditional patent system vs. PCT system



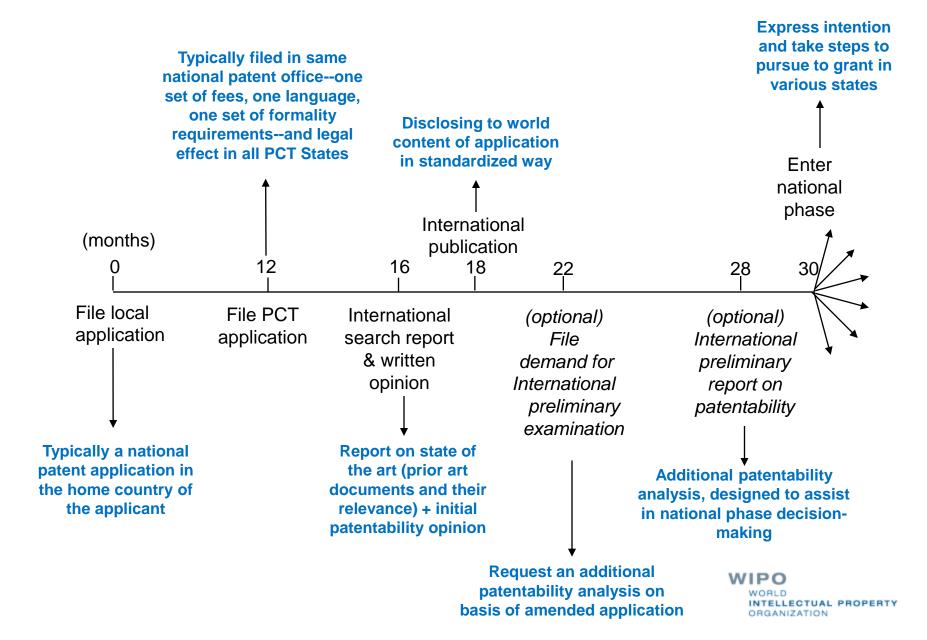


## Paris route vs. PCT national phase





## The PCT System



## **Advantages for PCT Users**

The PCT, as the cornerstone of the international patent system, provides a worldwide system for simplified filing and processing of patent applications, which—

- postpones the major costs associated with internationalizing a patent application
- 2. provides a strong basis for patenting decisions
- 3. harmonizes formal requirements
- 4. protects applicant from certain inadvertent errors
- 5. evolves to meet user needs
- is used by the world's major corporations, universities and research institutions when they seek multinational patent protection
- 7. can result (if PCT reports are positive) in accelerated national phase processing in a number of countries wipo

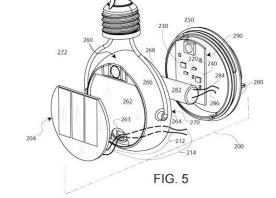
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## **PCT Testimonial: Start-up**

**Nokero** (produces solar-powered lights which replace kerosene lamps and candles used in developing and least -developed countries--it has so far distributed over 1.4 million lights in 120 countries and won a United States Patent and Trademark Office's Patents for Humanity Award)

"When it comes to patenting, because we operate in so many different markets, we use WIPO's Patent Cooperation Treaty (PCT). Every start-up has limited funds and the PCT is a great mechanism for <u>delaying patent filing costs</u>, allowing time to test the market and overcome any unforeseen technical problems. Without the PCT, protecting an invention in international markets would be a high-risk strategy with huge upfront costs."





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### **PCT Testimonial: Inventor**

Professor Shuji Nakamura—co-winner of the 2014 Nobel Prize for Physics for his work on blue LED technology—is quoted in a December 2014 WIPO Magazine article:



"... The PCT is critical for these early stage technologies because it gives us the opportunity to protect our patents globally while allowing the market and the technology to mature further before determining which countries might be most valuable to commercial partners."

## **PCT Testimonial: Large Company**

#### Qualcomm:

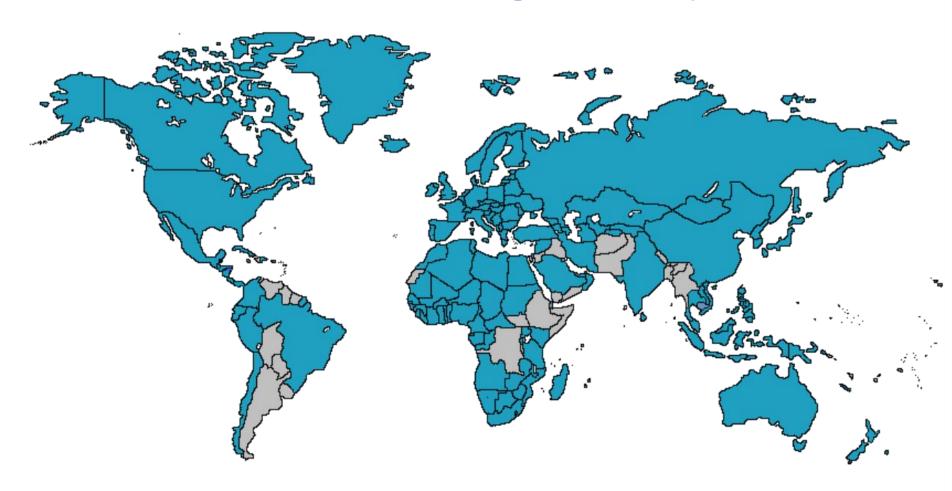
- Started in 1985 with 7 people
- Today more than 170 offices in more than 40 countries, and 33,000 employees
- \$25.3 billion in revenue in FY 2015
- #2 user of PCT in 2015: 2442 PCT applications published



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"Over the past 25 years, Qualcomm has been one of the largest users of the PCT system. To date we have filed more than 9,000 patent applications. International patent applications are important to the protection of innovations around the globe. The PCT helps put innovation into practice by providing a simple and cost-effective way to file international patent applications. The PCT is critical for Qualcomm because we are, above all, an innovation company....[PCT] has been a vital partner in the success of our company and the growth of the wireless industry." CEO Paul Jacobs, 2011

## **PCT Coverage Today**





### 151 PCT States

#### Recent accessions:

Kuwait Djibouti Cambodia



Costa Rica Côte d'Ivoire Croatia Malawi Guinea-Bissau Poland Cuba Malaysia Honduras Sweden Portugal Cyprus Mali

Malta

Mexico

Monaco

Mongolia

Morocco

Namibia

Montenegro

Mozambique

Netherlands

Nicaragua

Niger

Nigeria

Norway

Panama

Philippines

Papua New Guinea

Oman

Peru

New Zealand

Algeria Angola Antiqua and Barbuda

Armenia Australia

Austria Azerbaijan

Albania

Bahrain **Barbados** 

Belarus Belgium

Belize Benin

Bosnia and Herzegovina Botswana

Brazil

Brunei Darussalam

Bulgaria Burkina Faso

Cambodia (8 Dec. '16)

Cameroon Canada

Central African Republic

Chad Chile China Colombia Comoros Congo

Republic of Korea Denmark Diibouti (23 Sept. '16)

Democratic People's

Czech Republic

Dominica

Dominican Republic

Ecuador Egypt El Salvador

**Equatorial Guinea** 

Estonia Finland France, Gabon Gambia Georgia Germany Ghana Greece Grenada Guatemala

Guinea

Hungary Iceland India Indonesia Iran (Islamic Republic of) Ireland

Israel Italy Japan Kazakhstan Kenva

Kuwait (9 Sept. '16)

Kyrgyzstan

Lao People's Dem Rep. Latvia

Lesotho Liberia

Libyan Arab Jamahiriya

Liechtenstein Lithuania Luxembourg Madagascar

Qatar Mauritania

Republic of Korea Republic of Moldova

Romania Rwanda

Russian Federation Saint Lucia

Saint Vincent and the Grenadines

San Marino Sao Tomé e Principe

Saudi Arabia Senegal Serbia Seychelles Sierra Leone Singapore

Slovakia Slovenia South Africa

> Spain Sri Lanka Sudan Swaziland

St. Kitts and Nevis

Switzerland

Syrian Arab Republic

**Tajikistan** Thailand

The former Yugoslav

Republic of Macedonia

Togo

Trinidad and Tobago

Tunisia Turkev Turkmenistan Uganda Ukraine

United Arab Emirates United Kingdom

United Republic of Tanzania United States of America

Uzbekistan Viet Nam Zambia Zimbabwe

#### WIPO

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## **UN Member States not yet in PCT**

Afghanistan

Andorra\*

Argentina\*\*

Bahamas

Bangladesh\*

Bhutan

**Bolivia** 

Burundi

Cape Verde

Democratic Republic of

Congo

**Eritrea** 

Ethiopia

Fiji

Guyana

Haiti

Iraq

Jamaica

Jordan\*

Kiribati

Lebanon

Maldives

Marshall Islands

Mauritius

Micronesia

Myanmar

Nauru

Nepal

Pakistan

Palau

Paraguay\*\*

Samoa

Solomon Islands

Somalia

South Sudan

Suriname\*

Timor-Leste

Tonga

Tuvalu

Uruguay\*\*

Vanuatu

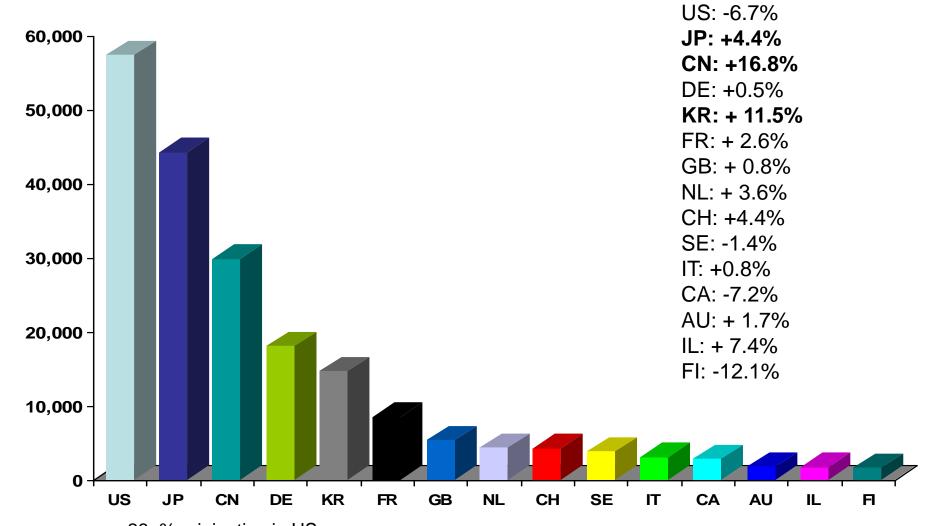
Venezuela

Yemen

(42)

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## International applications received in 2015 by country of origin

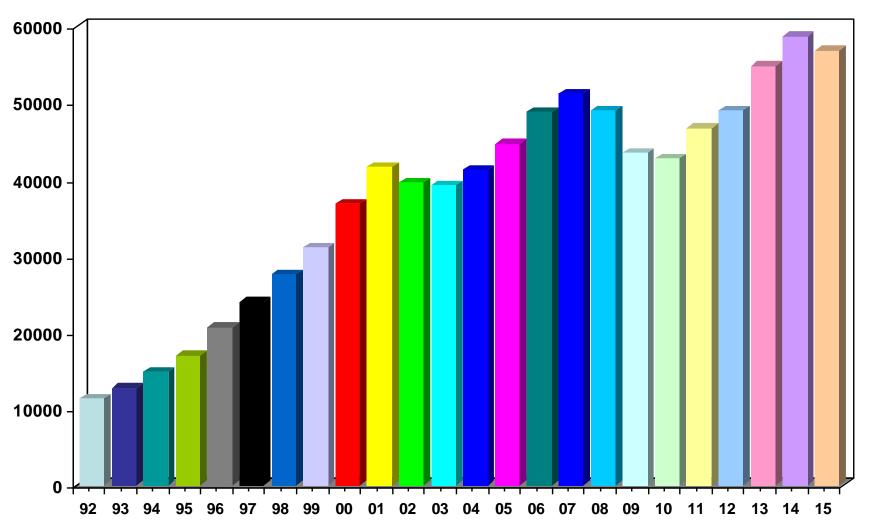


- 26+% originating in US
- 75% from top 5 countries; 92+% of filings from top 15 countries
- PCT applications filed by applicants from 132 countries
- Very close to having 80% of UN member countries in the PCT

#### WIPO

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## PCT use in the US (receiving Office)



- Joined PCT effective June 1, 1978
- 57,385 PCT applications filed by US applicants in 2015 with RO/US



## **PCT International Searching Authorities**

The appointed ISAs/IPEAs are the following 22 offices:

Australia

**Austria** 

Brazil

Canada

Chile

China

Egypt

**European Patent Office** 

**Finland** 

India

Israel

Japan

Nordic Patent Institute

Republic of Korea

Russian Federation

Singapore

Spain

Sweden

**Turkish Patent Institute** 

Ukraine

**United States of America** 

Visegrad Patent Institute

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## **Recent/Future Developments**

## July 1, 2016 PCT Rule Amendments (1)

- legal basis and procedure for removing/withholding certain "sensitive information" from public access on applicant's request (Rules 9, 48 & 94)
  - upon reasoned request by the applicant to the IB
  - Information will be omitted from publication/public file access, if
    - 1) it does not obviously serve the purpose of informing the public about the international application,
    - 2) publication of or public access to such information would clearly prejudice the personal or economic interests of any person, and
    - 3) if there is no prevailing public interest to have access to that information
  - effective as from 1 July 2016 for applications filed on or after that date
- language of communication with IB via ePCT opened to all publication languages (Rule 92)



## July 1, 2016 PCT Rule Amendments (2)

- required transmittal by RO to IB of documents submitted in support of requests for restoration of priority right (Rules 26*bis* & 48)
  - Exception: if "sensitive information" standard (Rule 48(I)) met
- "general unavailability of electronic communications services" as grounds for excuse of delay in meeting certain time limits (Rule 82 *quater*)
  - Extension of *force majeure* provisions to time limits missed due to "general failures of electronic communication services"
    - PCT Assembly: "covers outages that affect widespread geographical areas or many individuals, as distinct from localized problems associated with a particular building or single user"
  - Amended paragraph 30 of RO Guidelines:
    - Element of "unforeseeable" must be present and no reasonable alternative filing means available
  - Effective as from 1 July 2016 for applications filed on or after that date, and for applications filed before that date where the "event" occurred on or after that date



## July 1, 2017 PCT Rule Amendments (1)

- transmittal by RO of earlier search and/or classification results to ISA, where national law permits (Rules 12*bis*, 23*bis* & 41))
  - General Rule: ROs forward the search/classification results from applications of which priority is claimed without the applicant's express permission, where permitted by national law
  - Exception:
    - ROs which have notified the IB (before April 14, 2016) of incompatibility of such forwarding with applicable national law are not required to do so
      - ■USPTO (and 10 other ROs) made this notification
    - Even in cases in which ROs in principle apply the procedure, when filing the PCT application applicants may request to not have the earlier search results forwarded to the ISA (ROs which act in this way are to notify the IB in advance)

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Effective as from 1 July 2017 for applications filed on or after that date

## July 1, 2017 PCT Rule Amendments (2)

- designated Offices required to provide IB with timely national phase entry and related data (Rules 86 & 95)
  - Objective: visibility of the status of PCT application during the national phase on PATENTSCOPE under the "National phase" tab
  - Obligation for designated Offices to timely send national phase entry and related data to the IB (within 2 months from expiry of national phase deadline or asap thereafter)
  - Data required to be transmitted:
    - Date national phase entered
    - National application number
    - Number and date of any national publication
    - Number and date of grant
  - Effective as from 1 July 2017 for applications in respect of which the acts referred to in Article 22 or Article 39 are performed on or after that date

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## **PCT Assembly 2016**

- Outcomes
  - Appointment of Turkish Patent Institute as PCT ISA/IPEA (#22)
  - Amendments to the PCT Regulations (entry into force: 1 July 2017)
    - Modifying time limit to request Supplementary International Search (from 19 to 22 months)
    - Further small change to Rule 23bis
    - Removal of unnecessary incompatibility provisions



## PCT Working Group 2016 (1)

- Outcomes:
  - Report provided on upcoming 3<sup>rd</sup> pilot of IP5 collaborative search and examination
    - Planned that all IP5 offices will participate, will be applicant driven (to assess business interest), will involve at least 100 PCT applications per office and last up to 3 years, so as to fully assess impact
  - IB will consult with Offices and user groups on:
    - proposed pilot for ePCT national phase entry functionality
    - technical/legal/administrative issues related to color drawings
    - translation difficulties relating to the number of words in abstracts and drawings
    - inclusion of CPC/other national classification symbols on front page of published international applications
  - Examiner training
    - IB will:
      - compile info on examiner training provided by offices
      - invite offices to provide training to examiners from other offices
      - develop concept for improved coordination of examiner training
      - invite sharing of training materials



## PCT Working Group 2016 (2)

- Outcomes (cont.):
  - No agreement on proposals concerning:
    - same day priority claims
    - missing parts/erroneously filed procedure
    - fee reductions proposed by Brazil for universities and public research organizations—for further discussion next year
    - proposed amendments to Schedule of Fees and Rule 92*bis* to assist IB in responding to potentially abusive use of PCT fee reductions



## Other practice changes

- Payment by cheque to the IB no longer accepted
  - Following the introduction of further restrictions with regard to the processing of cheques by the International Bureau's banking partners, the International Bureau will no longer accept payment by cheque with effect from January 1, 2017.
  - Any cheque received on or after this date will be systematically returned to the issuer



## The PCT—1978 to 2016 (1)

- As filing tool: PCT has been extremely successful
  - preferred route for international patenting (≈218,000 applications in 2015, > 57% "market share")
  - harmonization of formal and procedural requirements, beyond PCT
    - national laws; Patent Law Treaty (PLT)



## The PCT—1978 to 2016 (2)

- As worksharing tool: (which it was intended by its founders to be), PCT has not been as effective in practice
  - had it been successful up to now in this sense, it would have been of more assistance in addressing national quality of examination and (for some Offices) backlogs in processing
  - expectation by founders was: "flying start" for offices, which would complete, further check, and criticize ...
  - reality: many Offices start "from scratch", perhaps not in complete isolation, but to a great degree ...
- What is needed: build more trust between patent offices, so that duplicative international phase and national phase processing can be reduced



## Continued areas of PCT focus (1)

- Quality:
  - Improve the quality and consistency of PCT international phase reports
  - Develop quality metrics for measuring usefulness of international phase reports
  - Develop quality feedback system for offices (e.g., DO to ISA)
  - Explore collaborative search and examination
  - Improve timeliness of PCT work
- Help designated Offices to better understand reports
  - Search strategies, standardized clauses, explanations of relevance of cited documents, etc.
- Improve timeliness of actions in international phase
  - ISAs/IPEAs, ROs (eSearchCopy)
- Improve access to national search and examination reports
  - PATENTSCOPE, WIPO-CASE, Global Dossier
- Make progress against misleading invitations sent to PCT users



#### INTERNATIONAL INTELLECTUAL PROPERTY OFFICE PATENT REGISTRATION APPLICATION

Administration for Commerce & Industry Here: We acknowledge recording your patent



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#### REGISTRATION OF THE INTERNATIONAL PATENT



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· Publication Number:

· Publication Date:

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· Title:

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#### REGISTRATION OF INTERNATIONAL PATENTS INTELLECTUAL PROPERTY OFFICE

Administration for Commerce & Industry



INVOICE

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DATE:

REG: INTERNATIONAL PATENT APPLICATION 59
PUBLICATION NUMBER:

IMPORTANT: UPON PAYMENT RECEIPT IN THE AMOUNT OF EUR 1.998,80 BY THIS OFFICE, APPLICATION PROCESSING WILL COMMENCE

APPLICATION REGISTRATION/PUBLICATION OF YOUR INTERN PATENT APPLICATION: Below find summarization of published intern. Patent Application in the WIPO Patentscope Gazette INVOICE/ACCOUNT NUMBER: 597047

APPLICATION REGISTRATION/PUBLICATION FEE: 1.998.80 €

PAYMENT TERMS:

APPLICATION REGISTRATION/PUBLICATION FEE
NEEDS TO BE PAID <u>WITHIN 8 DAYS</u> OF RECEIPT
OF PAYMENT NOTIFICATION

PAYMENT DETAILS:

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ACCOUNT: 1610000121500271 IBAN: BA391610000121500271 SWIFT/BIC: RZBABA2S

Priority Data:

International Application No.:

Publication Date:

Title:

Publication Number:

International Filing Date:

IMPORTANT: APPLICATION REGISTRATION/PUBLICATION FEE IN THE AMOUNT OF <u>EUR 1.998.80</u> NEEDS TO BE PAID <u>WITHIN 8 DAYS</u> OF RECEIPT OF PAYMENT NOTIFICATION FOR APPLICATION PROCESSING

	INVOICE/ACCOUNT NUMBER: 597047			
ITEM	DESCRIPTION	CURRENCY	AMOUNT	
001	APPLICATION REGISTRATION/PUBLICATION FEE INTL. PATENT APPLICATION NTL. APPLICATION NUMBER: PUBLICATION DATE:			1.998,80
002	PROCESSING FEE USE BELOW DETAILS FOR PAYMENT:		EUR	0,00
	BENEFICIARY: WIPO-WORLD INTELLIGENT	SUBTOTAL	EUR	1.998,80
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	ACCOUNT: 1610000121500271 IBAN: BA391610000121500271 ADDITIONAL P	UBLICATION FEE	EUR	0,00
		VOICE TOTAL	EUR	1.998,80

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#### **WARNING: Requests for Payment of Fees**

It has come to the attention of the International Bureau that PCT applicants and agents are receiving invitations to pay fees that do not come from the International Bureau of WIPO and are unrelated to the processing of international applications under the PCT. Whatever registration services might be offered in such invitations, they bear no connection to WIPO or to any of its official publications.

PCT applicants and agents should note that it is the International Bureau of WIPO alone which publishes all PCT applications promptly after the expiration of 18 months from the priority date (see PCT Article 21(2)(a)); there is no separate fee for such international publication, and the legal effects of international publication are set out in PCT Article 29.

The invitations often identify a particular PCT application by its international publication number (eg: WO 02 xxxxxx), publication date, title of the invention, international application number, priority information and IPC symbols; examples of such invitations can be viewed below.

## TO THE PARTY OF TH

#### IIP - International Intellectual Property Office

Published on February 22, 2016

IPTI – International Patents & Trademark Index

#### Invitation not listed here? E-mail us a copy

- Trademarks (Madrid System)
- Patents (PCT System)

#### Mitigating this unscrupulous practice

- WIPO invites its customers to use and adapt this standard text to notify applicants and inventors about such fee requests. [WORD]
- Circular letter addressed by WIPO Director General, Francis Gurry to all PCT Contracting States and Regional Organizations.

How to make a complaint?



## **Continued areas of PCT focus (2)**

- Helping developing countries benefit from the PCT
  - top 15 countries responsible for 92% of IAs filed in 2015
  - improve training for patent examiners (especially in developing and least developed countries), and better coordinate training already provided
- Making PCT accessible to applicants of all types from all Contracting States
  - fee reductions (SMEs, universities, research institutes, individual applicants)



## Continued areas of PCT focus (3)

- ePCT: electronic interface to entire PCT international phase process
  - real time access to IB files and bibliographic data
  - notifications of significant events and approaching deadlines
  - Online electronic preparation and filing with real-time validations (currently with 43 receiving offices, including IB, Algeria, Austria, Australia, Azerbaijan, Brazil, Brunei, Bulgaria, Canada, Chile, Colombia, Cuba, Czech Republic, Denmark, EAPO, Estonia, EPO, Finland, Hungary, Iceland, India, Indonesia, Israel, Iran, Latvia, Malaysia, Mexico, New Zealand, Norway, Oman, Philippines, Poland, Portugal, Qatar, Republic of Korea, Russian Federation, Saudi Arabia, Slovakia, Sweden, Singapore, Turkey, South Africa, and the United States of America)
  - Multilingual (10 language) interface available
  - Working on centralized fee payment mechanisms
  - US PCT users filing with ROUS can now (as of 1 June 2016) use ePCT to prepare their PCT application and upload the resulting .zip file in EFSWeb, but....
    - care should be taken to ensure that the technical data loaded into ePCT is not subject to export controls
  - Consulting on how ePCT could be used for national phase entry



#### The PCT of the Future

- Should include: (in the view of the IB)
  - Renewed emphasis of the "Cooperation" element in PCT:
    - Offices and Authorities performing their roles in a timely way and to the level of quality necessary to allow other Offices and the public at large to trust in the work performed by them
      - Increase the capacity to measure that quality
      - Full faith and credit should be given to an Office's own ISA workproduct
      - Further consider allowing the market/competition (e.g., greater ISA choice for applicants) to exert an effect
      - Make use of DO feedback, as particularly interested consumers of PCT reports
    - Development of IT systems and standards to support sharing information with other Offices more effectively
      - Centralized fee payment mechanism?
    - Establishment of appropriate applicant incentives so that they play a more effective part in the cooperation
    - Provision of training and assistance to Offices from all Contracting States so that they are able to perform their roles effectively



#### Reminders

- The PCT contains useful mechanisms, such as:
  - Third party observations
  - Restoration of priority procedures
  - A way to draw attention to individual applications by including licensing-related information
  - Being able to request excuse of delay in meeting national phase entry deadline
- Always:
  - View and review filed application online asap after filing
  - Review published application immediately after publication
  - Respect national phase entry time limit
  - Request RO to prepare and transmit priority document
  - Consider submitting any restoration of priority requests to RO/IB
  - File 92*bis* requests only with IB directly
  - Call/email when you have a doubt or question
- Never:
  - Submit a notice of withdrawal to the RO or any authority other than the IB

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### **PCT Information and Training**

- 29 video segments on WIPO's Youtube channel and WIPO's PCT page about individual PCT topics
- PCT Distance learning course content available in the 10 PCT publication languages, and a 2<sup>nd</sup> detailed PCT DL course under preparation
- PCT Webinars
  - free updates on developments in PCT procedures, and PCT strategies—previous webinars are archived and freely available
  - upon request also for companies or law firms, for example, for focused training on how to use ePCT
- Videoconference and audio possibilities also available
- In-person PCT Seminars and training sessions: see PCT seminar calendar (<a href="http://www.wipo.int/pct/en/seminar.pdf">http://www.wipo.int/pct/en/seminar/seminar.pdf</a>)
- Monthly Newsletter (<a href="http://www.wipo.int/pct/en/newslett/">http://www.wipo.int/pct/en/newslett/</a>)
- Extensive information resources on PCT website (http://www.wipo.int/pct/en/)



#### **PCT Resources/Information**

## For general questions about the PCT, contact the PCT Information Service at:

Telephone: (+41-22) 338 83 38

Facsimile: (+41-22) 338 83 39

E-mail: pct.infoline@wipo.int

matthew.bryan@wipo.int





# The International Registration of Industrial Designs, Using the Hague System

Roving Seminar on WIPO Services and Initiatives

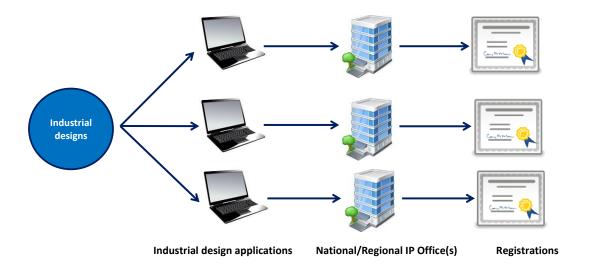
Matthew Forno
Senior Counsellor
Information and Promotion Division
Brands and Designs Sector, WIPO

### What is the Hague System?

- A one-stop shop to obtain and maintain industrial design protection in export markets
- A closed system and an option to the national route
- A purely procedural treaty
- The domestic legislation of the designated Contracting Parties set the conditions for protecting industrial designs and determine the rights which result from protection

### Paris Route vs. Hague Route

#### **Direct/Paris Route**



#### **The Hague System**



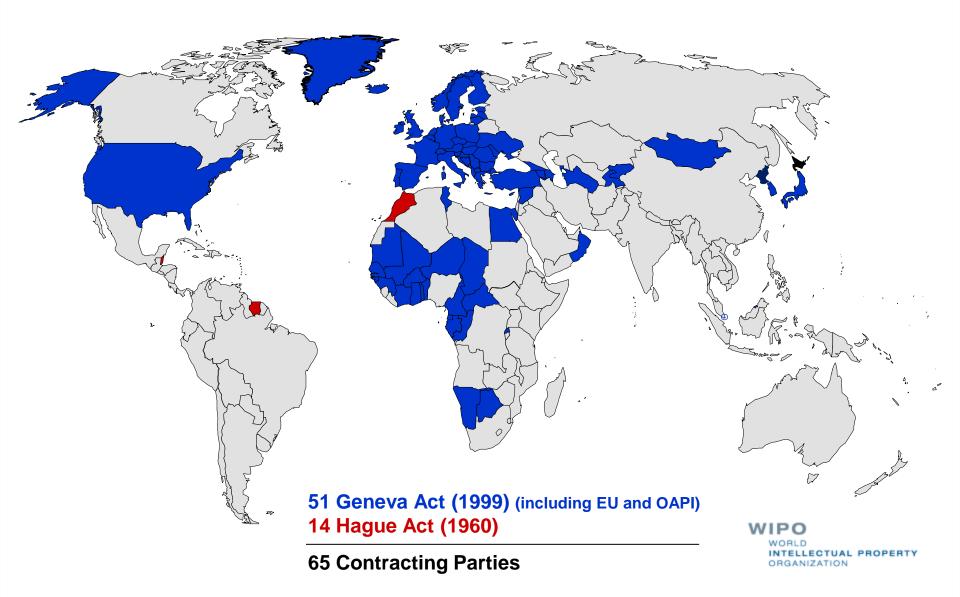


### Key Features of the Hague System

- Entitlement, but no basic design
- Direct filing with the International Bureau of WIPO
- One application one language one set of fees
- One registration covering multiple territories
- «Self-designation» is possible
- Possible deferment
- Fixed time limit for refusal 6 or 12 months
- Renewal every 5 years 15 years for the 1999 Act
- Centralized management of portfolio



## Hague Union: Going Global



## Hague Union Members according to the most recent applicable Act

#### Geneva Act (1999)

•African Intellectual Property Organization, Albania, Armenia, Azerbaijan, Bosnia and Herzegovina, Botswana, Brunei Darussalam, Bulgaria, Croatia, D.P.R. of Korea, Denmark, Egypt, Estonia, European Union, Finland, France, Georgia, Germany, Ghana, Hungary, Iceland, Japan, Kyrgyzstan, Latvia, Liechtenstein, Lithuania, Monaco, Mongolia, Montenegro, Namibia, Norway, Oman, Poland, Republic of Korea, Republic of Moldova, Romania, Rwanda, Sao Tome and Principe, Serbia, Singapore, Slovenia, Spain, Syrian Arab Republic, Switzerland, Tajikistan, the former Y.R. of Macedonia, Tunisia, Turkey, Turkmenistan, Ukraine and the United States of America (51)

## Hague Act (1960)

•Belgium, Belize, Benin, Côte d'Ivoire, Gabon, Greece, Italy, Luxembourg, Mali, Morocco, Netherlands, Niger, Senegal and Suriname (14)



#### **Potential Accessions**





## Trends: Continuing Growth



#### 2015:

- 3,581 international registrations contained 14,484 designs;
- Growth (%) 2014-2015: +32.5% registrations, +7.3% designs
- 2016 (until September 30):
  - 3,892 international registrations contained 13,456 designs
  - Growth (%) to same period in 2015: +62.9% registrations, +32 % designs

### Trends: 2016 (until September 30):

## TOP 10 Designations (designs recorded by Designated Contracting Party)

		Growth
European Union	10615	+23%
Switzerland	6348	-2%
Turkey	4613	+10%
United States of America	3181	+422%
Norway	2339	-4%
Singapore	2131	+4%
Ukraine	2105	+2%
Republic of Korea	1901	+20%
Japan	1695	+376%
Morocco	1432	-4%



### Trends: 2016 (until September 30):

TOP 10 origins (designs registered by country of address of the holder)

		Growth
Germany	2712	20%
Switzerland	1939	-21%
Republic of Korea	1480	+87%
United States of America	1009	+160%
Netherlands	971	+120%
France	968	+11%
Italy	869	+15%
Japan	592	+498%
Turkey	380	+98%
Denmark	300	+261%

WIPO
WORLD
INTELLECTUAL PROPERTY
ORGANIZATION

## Trends: 2016 (until September 30): TOP 10 applicants by designs

		Applications	Designs
Fonkel Meubelmarketing	NL	25	709
SAMSUNG ELECTRONICS CO., LTD.	KR	253	700
LG ELECTRONICS INC.	KR	516	551
RENAULT s.a.s.	FR	43	289
Volkswagen Aktiengesellschaft	DE	56	277
SWATCH AG (SWATCH SA) (SWATCH LTD.)	СН	82	255
The Procter & Gamble Company	US	50	241
Microsoft Corporation	US	25	187
Wenko-Wenselaar GmbH & Co. KG HERMES SELLIER	DE FR	16 20	180 142
	1 1 1	20	1 TZ



### Two Filing Options for US Applicants

#### **INDIRECT:**

## WIPO Paper Form *via* EFS Web

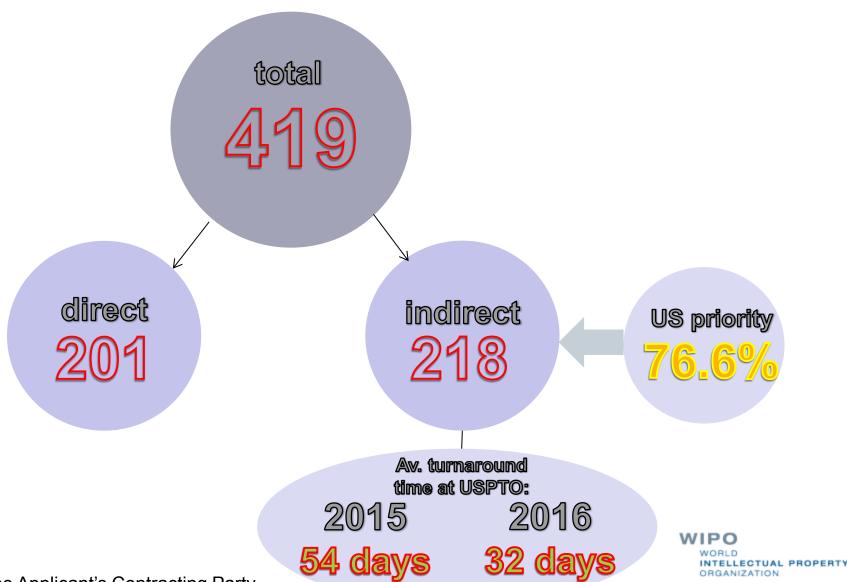
-Familiar environment
-USPTO's Quick Guide
-Integrated Export License
Process
-Transmittal Fee

#### **DIRECT:**

#### **WIPO E-filing Interface**

Dedicated electronic tool
 Easier than using paper form
 Embedded alerts and guidance
 Integrated fee calculator
 No additional fees
 No intermediary
 Workbench / Re-use functions
 Online correction of irregularities

## US Filings\*(as received at the IB May 2015 up to September 30, 2016)



\* By the Applicant's Contracting Party



## Have Export License? Then File Directly



## E-Filing Platform

The E-filing platform includes the following features:

	9
a WIPO Us	ser account
facilitated download	ling of reproductions
real time checking of	of certain formalities
saving of applica	ations in progress
fully integrated	d fee calculator
payment of fee	es by credit card
and muc	h more



## New Features of the E-Filing Portfolio Manager



Send corrections to irregularities or defects



Receive and download notifications from the IB relating to international applications



Retrieve in real-time current status of IA



### Hague Express Database

#### **Hague Express**

CURRENT SEARCH PROD:watch \*

The Hague Express Database, updated weekly, includes bibliographical data and, as far as international registrations governed exclusively or partly by the 1999 and/or by the 1960 Act(s) of the Hague Agreement are concerned, reproductions of industrial designs relating to international registrations that have been recorded in the International Register and published in the International Designs Bulletin as of issue No. 1/1999. International registrations that have lapsed

Display: List

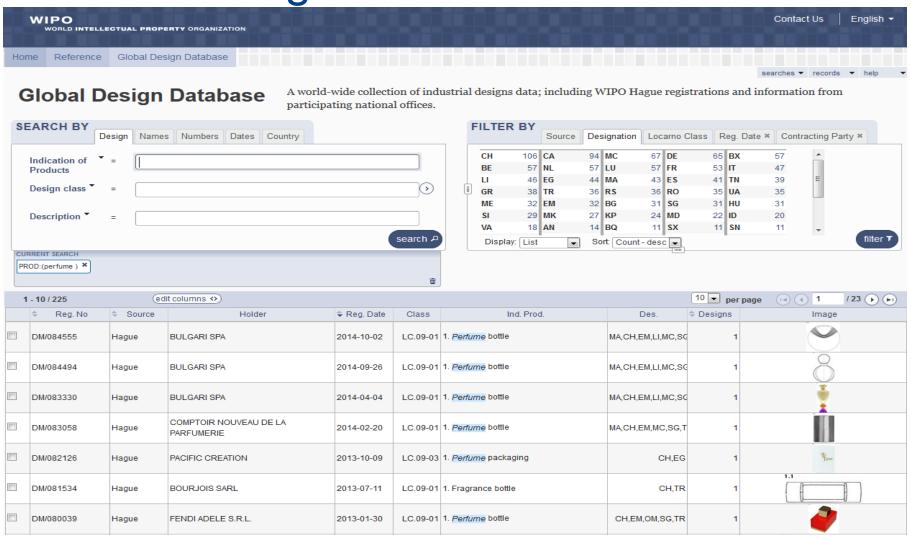
Sort: Count - desc ▼

are not removed from the database. **SEARCH BY** FILTER BY Names Numbers Dates Country Designation Locarno Class Reg. Date \* Contracting Party \* CH 1,535 MC 1,131 TN 991 MA 963 LI 960 Indication of watch FR 894 DE 890 IT 889 EG 887 BX 851 Products 851 NL 851 LU 851 ES 813 ME BE 684 Locarno MK 683 GR 642 MN 634 SG 611 TR 594 UA 591 ID 586 EM 583 KP 556 Description \* RS 523 VA 489 SI 462 CW 409 BQ 408 406 GE 380 RO 376 BZ 364

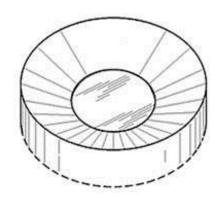
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	DM/046674	HYSEK JÖRG	1999-02-03	03-01	Etui pour montre	AN,EG,ES,ID,MA,TN,V	1	
	DM/082429	CARTIER CREATION STUDIO SA	2013-12-13	10-02	Watch; 2. Watch case; 3. Watch dial; 4. Watch; 5. Watch bracelet; 6. Watch dial; 7. Watch dial	CH,EM,SG,TR	8	6
	DM/083367	FRANCK MULLER WATCHLAND SA	2014-04-09	10-02	1. Montre-bracelet	EM,MC,SG	1	Ö
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	DM/073485	BÉDAT & CO SA	2010-03-26	10-02	Watch	BX,KP,CH,EM,LI,OA,S	1	CO COOR
	DM/073351	HUBLOT SA, GENÈVE	2010-03-18	10-02	Watch	CH,EM,SG	1	
	DM/073317	OMEGA SA (OMEGA AG) (OMEGA LTD.)	2010-02-12	10-02	Watch	BZ,MA,MC,ME,AL,AM,I	1	
	DM/072570	ALEXIS BARTHELAY (SOCIÉTÉ ANONYME)	2009-10-20	10-02	Watch	MA,CH,EG,EM,OM,SG	1	

## Global Design Database







## Tips

Guidance on Preparing and Providing Reproductions in Order to Forestall Possible Refusals on the Ground of Insufficient Disclosure of an Industrial Design by Examining Offices at <a href="http://www.wipo.int/export/sites/www/hague/en/how\_to/pdf/guidance.pdf">http://www.wipo.int/export/sites/www/hague/en/how\_to/pdf/guidance.pdf</a>

 Established in consultation with Contracting Parties, in particular all those that currently have an Examining Office, and several user organizations



#### In Conclusion

Many advantages in using the Hague System: flexibility of the system, tailormade designations, multiple design application, simple fee structure, and subsequent management.

- Design protection is not simple,
  - But Hague makes it simpler...





## Thank you for your attention

103

matthew.forno@wipo.int

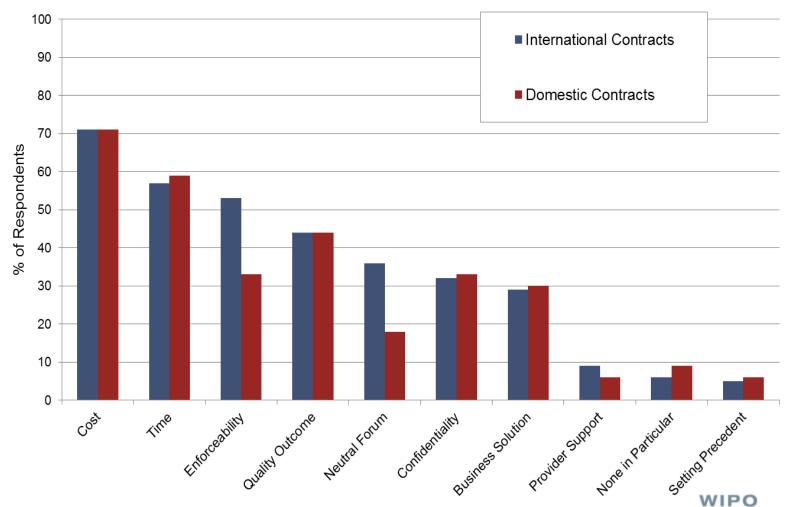


# Resolving IP Disputes outside the Courts through WIPO ADR: WIPO's Arbitration and Mediation Center

Matthew Bryan
Director
Patent Cooperation Treaty Legal Division
WIPO

Salt Lake City, United States of America November 4, 2016

## Top Ten Priorities in Choice of Dispute Resolution Clause (WIPO Survey)



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#### WIPO Arbitration and Mediation Center

- Facilitates the resolution of commercial disputes between private parties involving <u>IP and technology</u>, through procedures other than court litigation (alternative dispute resolution: ADR)
  - Offices in Geneva and Singapore
  - Users around the world
- ADR of IP disputes benefits from a <u>specialized ADR provider</u>
  - WIPO mediators, arbitrators and experts <u>experienced</u> in IP and technology - able to deliver informed results efficiently
- Competitive WIPO fees
- International neutrality
- Services include mediation, (expedited) arbitration, expert determination, and domain name dispute resolution

## WIPO ADR Mediation, Arbitration, Expert Determination

- Mediation: informal consensual process in which a neutral intermediary, the mediator, assists the parties in reaching a settlement of their dispute, based on the parties' respective interests. The mediator cannot impose a decision. The settlement agreement has force of contract. Mediation leaves open available court or agreed arbitration options.
- Arbitration: consensual procedure in which the parties submit their dispute to one or more chosen arbitrators, for a binding and final decision (award) based on the parties' rights and obligations and enforceable internationally. Arbitration normally forecloses court options.
- **Expert Determination**: consensual procedure in which the parties submit a <u>specific matter</u> (e.g., technical question) to one or more experts who make a <u>determination</u> on the matter, which can be binding unless the parties have agreed otherwise.

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## Why Consider WIPO ADR?

- Cost of IP court litigation
  - Calls for expedient solutions
- Internationalization of creation/use of IP
  - Calls for cross-border solutions; consolidate in one procedure
- Technical and specialized nature of IP
  - Calls for specific expertise of the neutral
- Short product and market cycles in IP
  - Calls for time-efficient procedures
- Confidential nature of IP
  - Calls for private procedures
- Collaborative nature of IP creation and commercialization
  - Calls for mechanisms that preserve relations

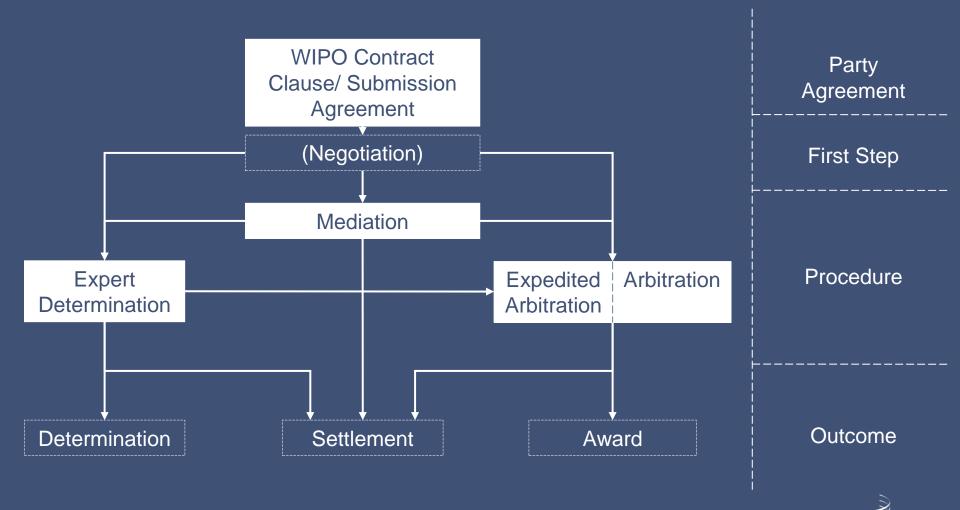


### Routes to WIPO ADR

- ADR <u>contract clause</u> electing WIPO Rules
  - WIPO Mediation, and/or
  - WIPO Arbitration / Expedited Arbitration, and/or
  - WIPO Expert Determination
  - Model clauses: www.wipo.int/amc/en/clauses/index.html
    - Parties can shape the process via the clause (e.g., location, language, law)
- ADR submission agreement electing WIPO Rules, e.g., in existing non-contractual disputes
- Unilateral request for WIPO Mediation by one party (Art. 4 WIPO Mediation Rules)
- Court referrals



## WIPO ADR Options



## WIPO Model Clause Example: Mediation followed by Expedited Arbitration

"Any dispute, controversy or claim arising under, out of or relating to this contract and any subsequent amendments of this contract, including, without limitation, its formation, validity, binding effect, interpretation, performance, breach or termination, as well as non-contractual claims, shall be submitted to mediation in accordance with the WIPO Mediation Rules. The place of mediation shall be [specify place]. The language to be used in the mediation shall be [specify language]"

If, and to the extent that, <u>any such dispute</u>, controversy or claim <u>has not been settled</u> <u>pursuant to the mediation within [60][90] days of the commencement of the mediation</u>, it shall, <u>upon the filing of a Request for Arbitration by either party, be referred to and finally determined by arbitration in accordance with the WIPO Expedited Arbitration <u>Rules</u>. Alternatively, if, before the expiration of the said period of [60][90] days, either party fails to participate or to continue to participate in the mediation, the dispute, controversy or claim shall, upon the filing of a Request for Arbitration by the other party, be referred to and finally determined by arbitration in accordance with the WIPO Expedited Arbitration Rules. The place of arbitration shall be [<u>specify place</u>]. The language to be used in the arbitral proceedings shall be [<u>specify language</u>]. The dispute, controversy or claim referred to arbitration shall be decided in accordance with [specify jurisdiction] law."</u>

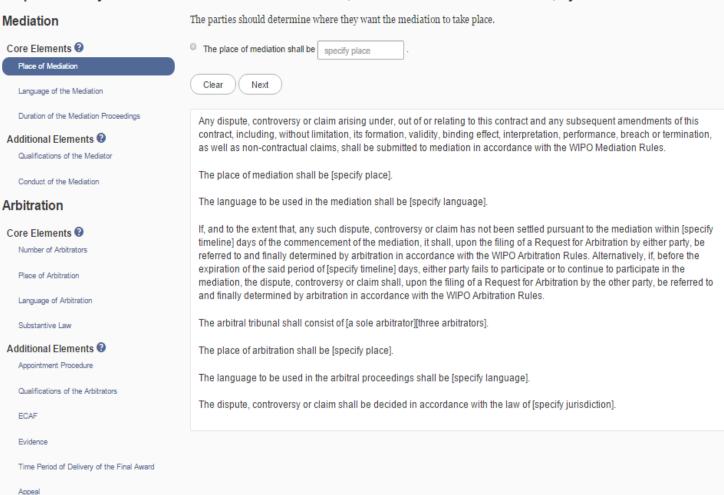




Home IP Services Alternative Dispute Resolution WIPO Clause Generator

#### **WIPO Clause Generator**

#### Step 3 – Build your clause: WIPO Mediation followed, in the absence of a settlement, by Arbitration Clause



#### Step 4 – Download or copy the final result

Download





### WIPO Center Case Role

- Administering cases
  - Under WIPO Rules, or under special procedures
  - Active management: containing time and costs
    - WIPO ECAF (optional online case management)
- Facilitating <u>selection and appointment</u> of mediators, arbitrators, experts
  - WIPO list of 1,500+ neutrals
    - From numerous countries in all regions
    - Specialized in different areas of IP and IT



## WIPO Electronic Case Facility (ECAF)

Simple; secure; instant; location-independent; optional

#### ECAF HOME

Help Arbitration Mediation Expert Determination Logout

#### WIPO Electronic Case Facility (ECAF)

Case: WIPOA20020

Licensing v. AB Technics Inc.



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#### **WIPO Arbitration**



#### **WIPO Expedited Arbitration**



- One exchange of pleadings
- Shorter time limits
- Sole arbitrator
- Shorter hearings
- Fixed fees

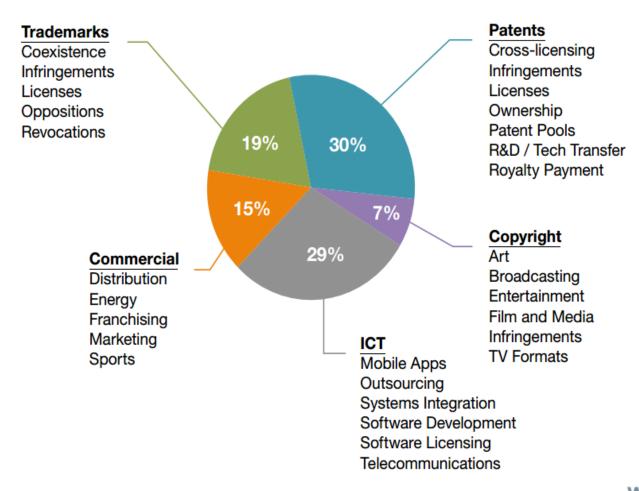


## WIPO Mediation, Arbitration and Expert Determination Cases

- IP/IT disputes and commercial disputes, for example:
  - Contractual: patent licenses, software/ICT, R&D and technology transfer agreements, patent pools, distribution agreements, joint ventures, copyright collecting societies, trademark coexistence agreements, settlement agreements
  - Non-contractual: infringement of IP rights
- Domestic and international disputes (25/75%)
- Case venues around the world
- Amounts in dispute from USD 50,000 to USD 1 billion

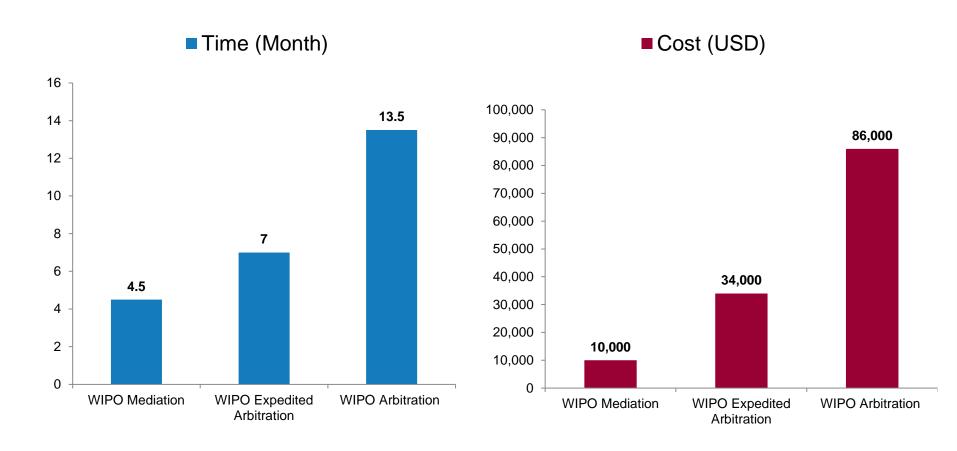


## Dispute Areas in WIPO Mediation and Arbitration Cases





## **WIPO Cases: Typical Time and Cost**



<sup>\*</sup> Excluding cost of parties legal representation



IP Services

Alternative Dispute Resolution



#### Mediation, (Expedited) Arbitration, Expert Determination Fee Calculator

The fees referenced below are estimates, in **United States dollars**. Final amounts payable are to be decided in consultation with the Center.

Type of Procedure	Mediation	V
	0	
Amount in Dispute in USD	500000	
	0	
Dispute is not quantifiable or		
Request does not indicate any		
claims for a monetary amount		
WIPO PCT Filer, Hague	☑ ②	
System Filer, Madrid System		
Filer, WIPO Green Technology		
Provider or Seeker		
	Calculate Reset	

#### Schedule of Fees

Mediation

Arbitration / Expedited Arbitration

**Expert Determination** 

Emergency Relief Proceedings (Effective from June 1, 2014)

Registration Fee No Registration Fee

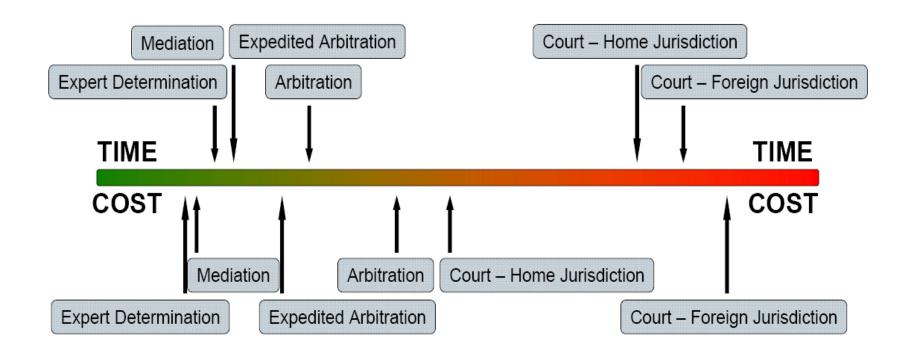
Administration Fee USD 375

Mediator's Fee USD 300-USD 600 per hour USD 1,500-USD 3,500 per day.

For further information and payment details, click on the applicable schedule of fees and costs on the right hand side of the page.



## Relative Time and Cost of Technology Dispute Resolution





## Uniform Domain Name Dispute Resolution Policy (UDRP)

- 1999: WIPO-created <u>international</u> administrative ADR procedure
- Allows trademark owners to resolve "clear cut" cases of abusive domain name registration and use ("cybersquatting")
- Operates outside the courts, but preserves party court option
- Uniform: applicable to <u>all gTLDs</u> "old" (.com, .net, .org, etc.)
   and "new" (.bike, .nyc, .xyz, etc.)
  - Also available for 75 ccTLDs
- Applicable via <u>mandatory</u> "contract web" between ICANN, registrars, and registrants



## **UDRP**: Principal Advantages

- Significantly <u>quicker and cheaper</u> than court litigation
  - Two-month average; fixed fees (USD 1,500)
- Predictable criteria and results
- Decision (transfer) <u>implemented directly</u> by registrar
- Prevents consumer confusion/brand abuse



### The UDRP Test – Three Elements

- Trademark must be identical or confusingly similar to the domain name; and
- The registrant of the domain name must have no rights or legitimate interests in the domain name; and
- The domain name must have been registered and used in bad faith.

## Voguecatch.com - Case No. D2012-0136



home | shopping quide|contact us | about us |size's list | tracking | payment | privacy poli

home

#### product search: product name



#### 88 Products List

#### **New Arrival**

- @ clothing for male
- clothing for female
- shoes for male
- shoes for female

#### Clothing For Male

- **⊞** Coat
- Sweater
- **■** T-Shirt
- **■** Suit
- Jean
- Jacket
- **■** Shirt
- **⊞** Hoody
- **■** Short
- **THE NORTH FACE**

#### Clothing For Female

- Hoody
- **⊞** Coat
- **■** Suit
- **■** Jacket
- Women sweater

#### new arrivals









188278

Jordan Team Iso M 6

free shipping

price:\$45 BUY NOW



188196

Monder vest W 29

BUY NOW

188051 air MAX TN M 34

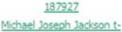
free shipping free shipping price:\$95

price:\$38 BUY NOW 187995

air max 2011 M 2 free shipping

> price:\$37 BUY NOW







187329 ARMANI t-shirt boys 23



187249 Nike Air Max 24-7 kid 6



187137 Jordan six Ring&4 M 6

> WIPO WORLD INTELLECTUAL PROPERTY

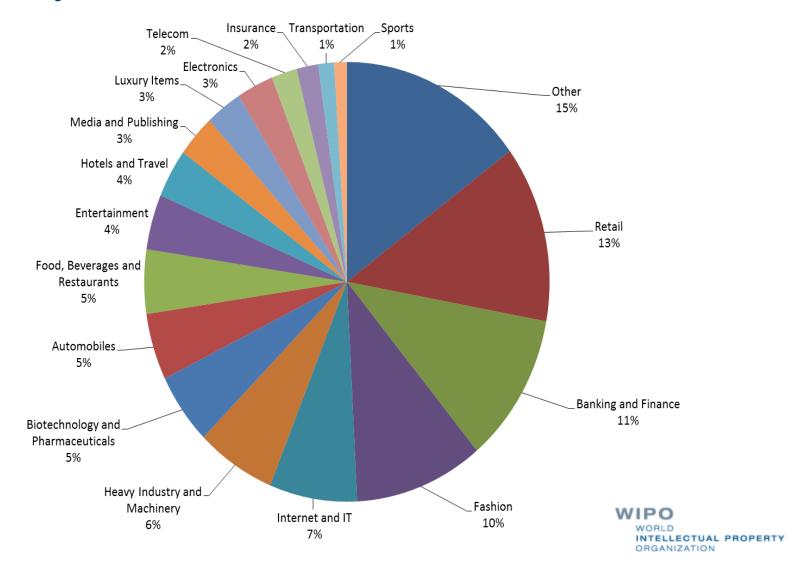
> > ORGANIZATION

## Domain Name Dispute Filing with WIPO

- 16 years' experience as the <u>global leader</u> in domain name dispute resolution
  - 35,000+ cases covering 65,000+ domain names
    - 2015 total: 2,754 cases
  - Involving parties based in <u>113 countries</u>
  - Multilingual case administration (21 languages to date)
  - Paperless filing: WIPO-initiated eUDRP
  - US first-ranked for WIPO case parties and panelists



## WIPO UDRP Complainant Areas of Activity



## Key WIPO UDRP Resources

- WIPO <u>Guide</u> to the UDRP <u>www.wipo.int/amc/en/domains/guide</u>
- Model <u>pleadings</u> (complaint and response) <u>www.wipo.int/amc/en/domains/complainant</u>
- Legal <u>Index</u> of UDRP Decisions <u>www.wipo.int/amc/en/domains/search/index.html</u>
- WIPO <u>Jurisprudential Overview</u> of Selected UDRP Questions

www.wipo.int/amc/en/domains/search/overview/index.html



### WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0")

#### 1. First UDRP Element

- 1.1 Does ownership of a registered trademark to which the domain name is identical or confusingly similar automatically satisfy the requirements under paragraph 4(a)(i) of the UDRP?
- 1.2 What is the test for identity or confusing similarity, and can the content of a website be relevant in determining this?
- 1.3 Is a domain name consisting of a trademark and a negative term confusingly similar to the complainant's trademark? ("sucks cases")
- 1.4 Does the complainant have UDRP-relevant trademark rights in a trademark that was registered, or in which the complainant acquired unregistered rights, after the domain name was registered?
- 1.5 Can a complainant show UDRP-relevant rights in a geographical term or identifier?
- 1.6 Can a complainant show UDRP-relevant rights in a personal name?
- 1.7 What needs to be shown for the complainant to successfully assert common law or unregistered trademark rights?
- 1.8 Can a trademark licensee or a related company to a trademark holder have rights in a trademark for the purpose of filing a UDRP case?
- 1.9 Is a domain name consisting of a trademark and a generic, descriptive or geographical term confusingly similar to a complainant's trademark?
- 1.10 Is a domain name which contains a common or obvious misspelling of a trademark (i.e., typosquatting) confusingly similar to a complainant's trademark?
- 1.11 Are disclaimed or design elements of a trademark considered in assessing identity or confusing similarity?

#### 2. Second UDRP Element

- 2.1 Is the complainant required to prove that the respondent lacks rights or legitimate interests in the disputed domain name?
- 2.2 Does a respondent automatically have rights or legitimate interests in a domain name comprised of a dictionary word(s)?
- 2.3 Can a reseller/distributor of trademarked goods or services have rights or legitimate interests in a domain name which contains such trademark?
- 2.4 Can a criticism site generate rights or legitimate interests in the disputed domain name?
- 2.5 Can a fan site generate rights or legitimate interests in the disputed domain name?
- 2.6 Do parking and landing pages or pay-per-click (PPC) links generate rights or legitimate interests in the disputed domain name?
- 2.7 Does a respondent trademark corresponding to a disputed domain name automatically generate rights or legitimate interests?

#### 3. Third UDRP Element

- 3.1 Can bad faith be found if the domain name was registered before the trademark was registered or before unregistered trademark rights were acquired?
- 3.2 Can there be use in bad faith when the domain name is not actively used and the domain name holder has taken no active steps to sell the domain name or to contact the trademark holder (passive holding)?
- 3.3 What constitutes a pattern of conduct of preventing a trademark holder from reflecting the mark in a corresponding domain name?
- 3.4 Can constructive notice, or a finding that a respondent "knew or should have known" about a trademark, or willful blindness, form a basis for finding bad faith?
- 3.5 What is the role of a disclaimer on the web page of a disputed domain name?
- 3.6 Can statements made in settlement discussions be relevant to showing bad faith?
- 3.7 Does the renewal of the registration of a domain name amount to a registration for the purposes of determining whether the domain name was registered in bad faith?
- 3.8 Can third-party or "automatically generated" material appearing on a website form a basis for finding registration and/or use in bad faith?
- 3.9 Can use of a privacy or proxy registration service form a basis for finding bad faith?
- 3.10 Can the use of "robots.txt" or similar mechanisms to prevent website content being accessed in an on-line archive form a basis for finding in bad faith?
- 3.11 Can tarnishment of a trademark form a basis for finding bad faith?



## Further Information (1)

- WIPO Arbitration and Mediation Center Offices
  - Geneva, Switzerland
  - Singapore, Singapore
- WIPO External Offices
  - Rio de Janeiro, Brazil
  - Beijing, China
  - Tokyo, Japan
  - Moscow, Russia
  - Singapore, Singapore







## Further Information (2)

- Queries and case filing: arbiter.mail@wipo.int
- Model clauses:
  <u>www.wipo.int/amc/en/clauses/</u>
- Info on procedures, neutrals and case examples:
  www.wipo.int/amc/



# Global IP Databases, Platforms and Tools for the Connected Knowledge Economy



Irene Kitsara, IP Information Officer,
Access to Information and Knowledge Division,
Global Infrastructure Sector

### **Outline**

- A. Global IP Databases
  - PATENTSCOPE
  - Global Brand Database
  - Global Design Database
  - WIPO DAS
  - WIPO Lex
- B. Tools facilitating understanding of patent data and IP Managementrelated decisions
  - Patent Analytics (Patent Landscape Reports (PLR) and related resources)
- C. Collaboration platforms
  - WIPO RE:SEARCH
  - WIPO GREEN
  - WIPO Match



## The importance of infrastructure in a knowledge economy



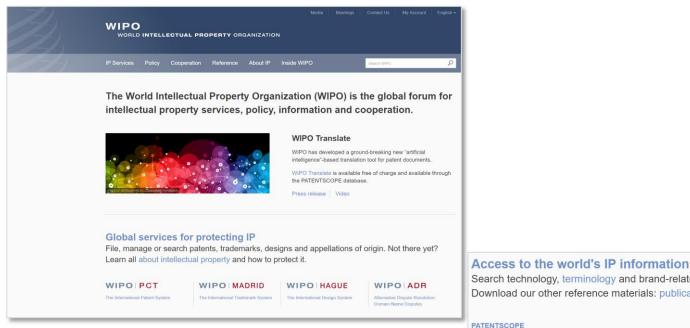
"Just as participation in the physical economy requires access to roads, bridges, and vehicles to transport goods, similar infrastructure is needed in the virtual and knowledge economy. However, here the highway is the Internet and other networks, bridges are interoperable data standards, and vehicles are computers and databases" Director General Francis Gurry

### Challenges of:

- Access to relevant information (information sources, tools and search skills)
- Analysis, understanding and strategic use of information (content understanding, decision-making, establishment of partnerships)



## A. Global IP Databases: Access point



www.wipo.int

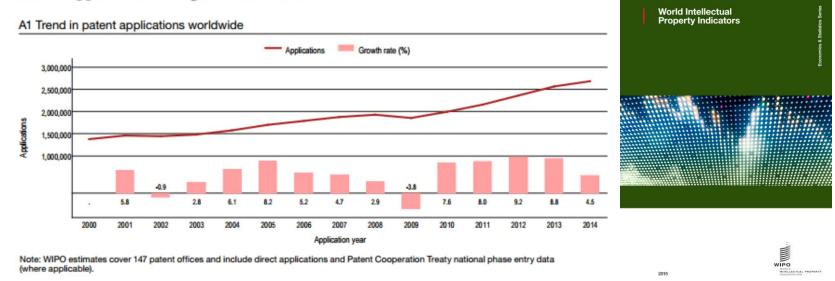


14,100 records of national IP laws and treaties of some 200 countries



## Growing importance of patent information

#### Patent applications and grants worldwide



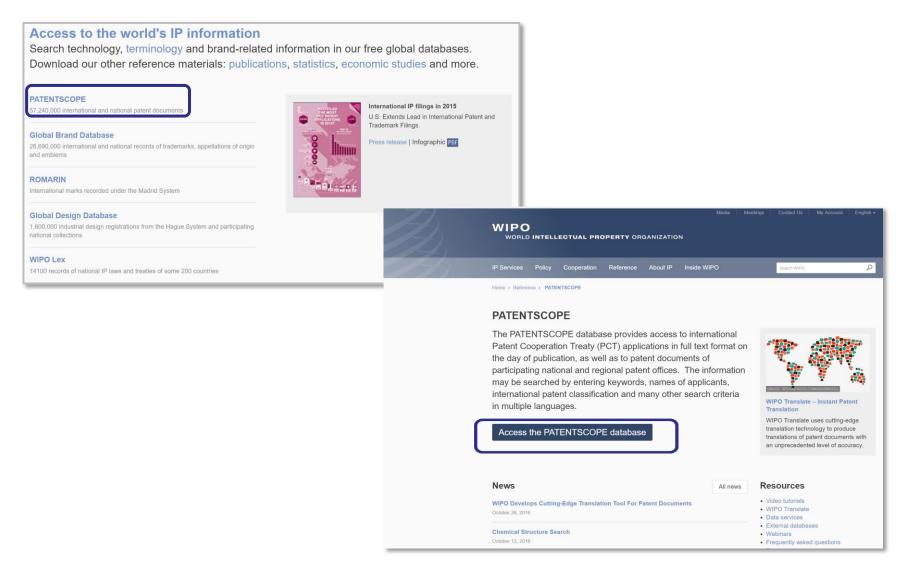
Source: WIPO Statistics Database, October 2015.

- Increase in patent applications worldwide and in the information included therein
- PATENTSCOPE: 58 mio patent documents
- Challenge: access to the information and pertinence of the retrieved information

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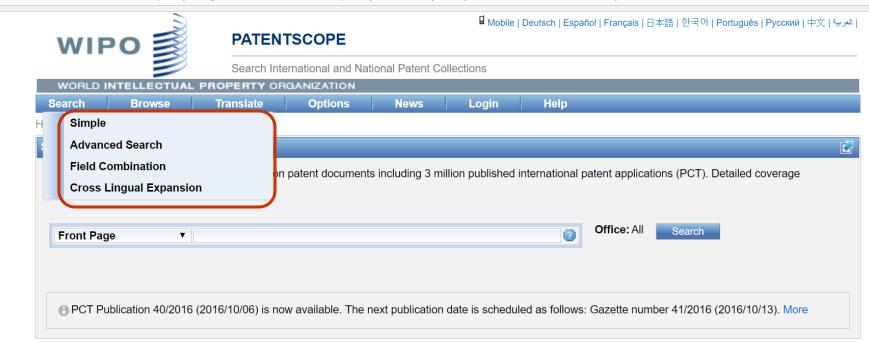
### WIPO's Patent Database: PATENTSCOPE





## PATENTSCOPE and its search functionalities

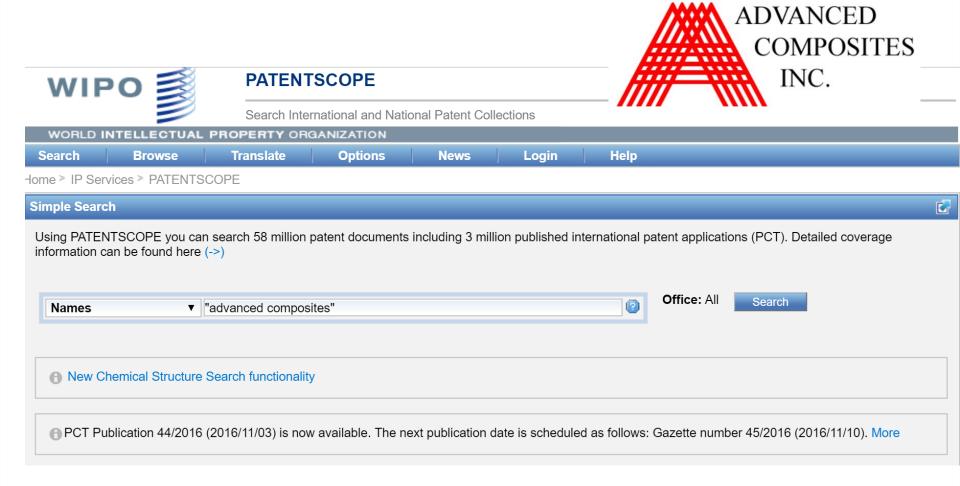
■ World Intellectual Property Organization [CH] https://patentscope.wipo.int/search/en/search.jsf



- 3 million published PCT applications
- 58 million patent documents (regional and national collections)



## PATENTSCOPE: Simple Search





## PATENTSCOPE: Advanced search

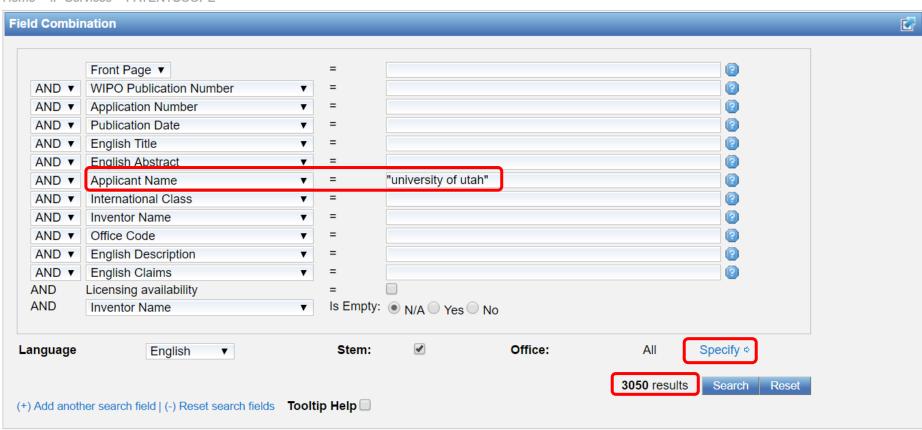
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### PATENTSCOPE: Field combination



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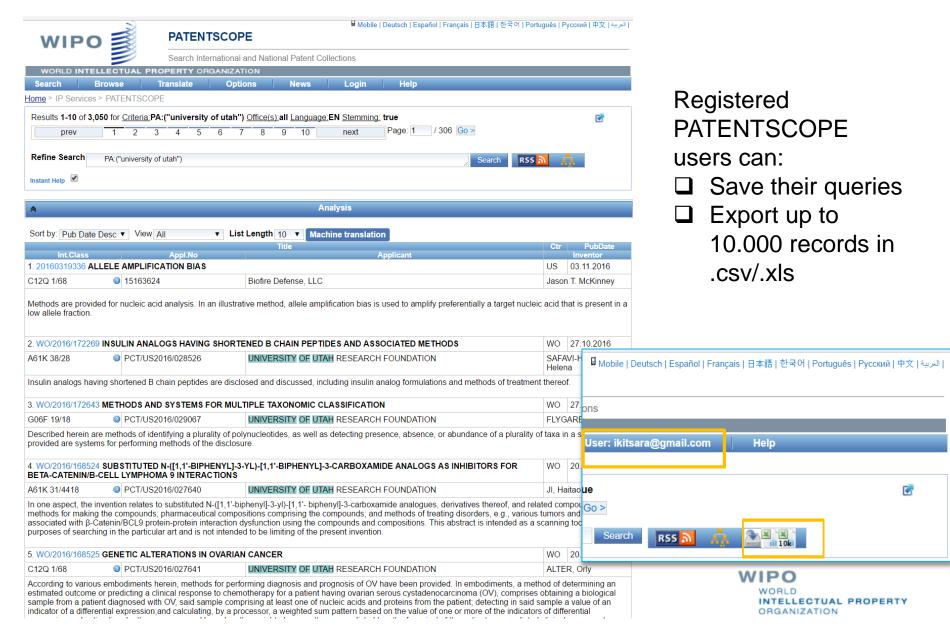
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## University of Utah and the PCT

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AND ▼	Inventor Name	▼	=				2
AND ▼	Office Code	▼	=				2
AND ▼	English Description	▼	=				2
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## PATENTSCOPE: the search results



## A PCT document

(12) INTERNATIONAL APPLICATION PUBLISHED UNDER THE PATENT COOPERATION TREATY (PCT)

(19) World Intellectual Property Organization International Bureau



(10) International Publication Number WO 2016/172269 A2

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PCT/US2016/028526

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(25) Filing Language:

(26) Publication Language:

English

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20 April 2015 (20.04.2015)

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Santhosh; 253 S. 700 E., Apt. 23, Salt Lake City, Utah 84102 (US). SCHLEGEL, Amnon; 4229 S. Park Terrace Dr., Salt Lake City, Utah 84124 (US), BANDYOPAD-HYAY, Pradip K.; 692 H. Street, Salt Lake City, Utah 84103 (US), YANDELL, Mark; 15 N. 2030 E., Room 2100, Salt Lake City, Utah 84112 (US). ROBINSON, Samuel D.: 470 L Street, Salt Lake City, Utah 84103 (US).

- English (74) Agent: ALDER, Todd B.; P.O. Box 1219, Sandy, Utah 84091-1219 (US).
  - (81) Designated States (unless otherwise indicated, for every kind of national protection available); AE, AG, AL, AM, AO, AT, AU, AZ, BA, BB, BG, BH, BN, BR, BW, BY, BZ, CA, CH, CL, CN, CO, CR, CU, CZ, DE, DK, DM, DO, DZ, EC, EE, EG, ES, FI, GB, GD, GE, GH, GM, GT, HN, HR, HU, ID, IL, IN, IR, IS, JP, KE, KG, KN, KP, KR, KZ, LA, LC, LK, LR, LS, LU, LY, MA, MD, ME, MG, MK, MN, MW, MX, MY, MZ, NA, NG, NI, NO, NZ, OM, PA, PE, PG, PH, PL, PT, QA, RO, RS, RU, RW, SA, SC, SD, SE, SG, SK, SL, SM, ST, SV, SY, TH, TJ, TM, TN, TR, TT, TZ, UA, UG, US, UZ, VC, VN, ZA, ZM, ZW.

[Continued on next page]

#### (54) Title: INSULIN ANALOGS HAVING SHORTENED B CHAIN PEPTIDES AND ASSOCIATED METHODS

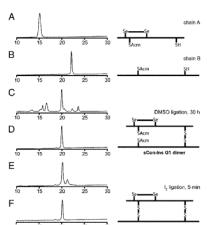


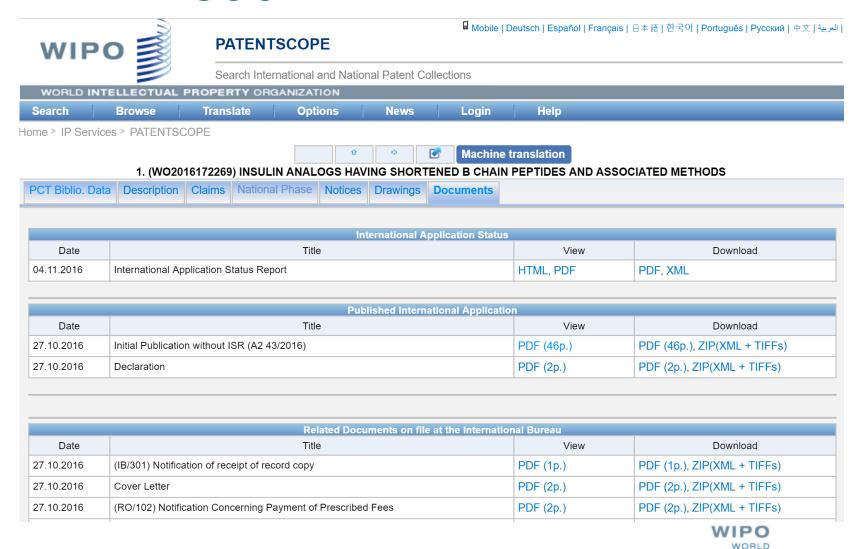
FIG. 1

(57) Abstract: Insulin analogs having shortened B chain peptides are disclosed and discussed, including insulin analog formulations and methods of treatment thereof.

> WIPO WORLD

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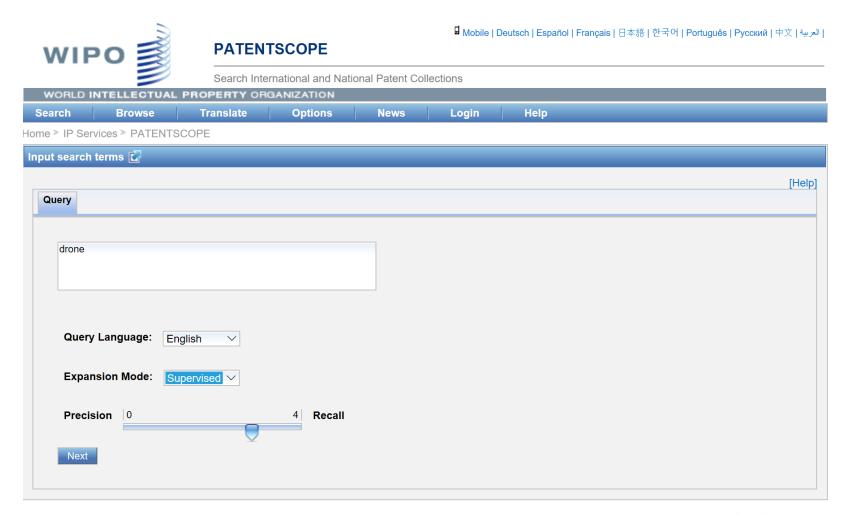
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## **CLIR: Cross Lingual Expansion**





## **Drones on CLIR**



### **PATENTSCOPE**

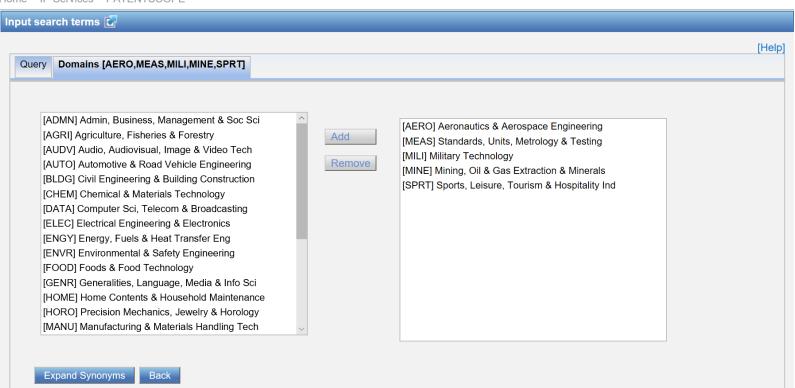
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# Drones on CLIR (2)

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WORLD INTELLECTUAL PI	ROPERTY ORGANIZATION	
Search Browse	Translate Options News	S Login Help
Home > IP Services > PATENTSCO	WIPO Translate	
	WIPO Pearl	[Help]
English German Spanish	rench   Italian   Japanese	
"drone" OR "unmanned aerial vehicle		
Field(s) you want to search:	Abstract	
Acceptable distance between ma		
Stemming		

Start Over

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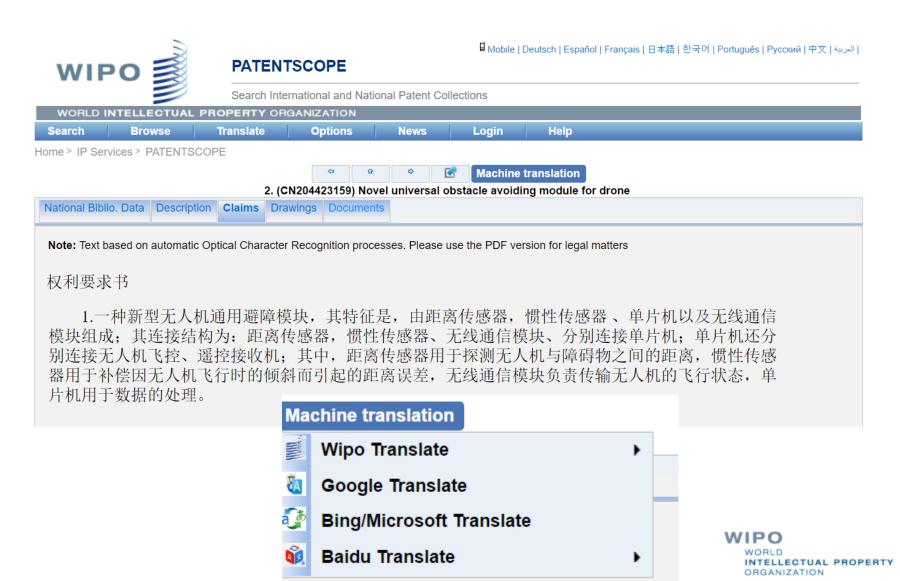
# Search results including all variations and translation of variations



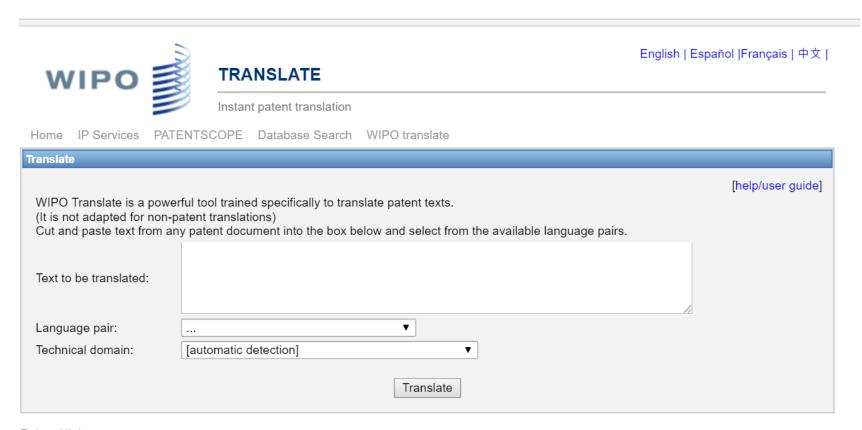
The invention relates to a method to inspect components of a wind turbine. An unmanned aerial vehicle (UAV) is guided to the component for the inspection. A certain predefined distance between the unmanned aerial vehicle and the component is chosen in a way that high resolution images (IMG 1-IMG 9) of the component are gathered by the unmanned aerial vehicle (UAV). The images are gathered by an image acquisition system (IAS). The inspection is done remote controlled and based on the images. Which are gathered by the unmanned aerial vehicle.

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## **WIPO Translation Tools**



# WIPO Translate – statistical machine translation



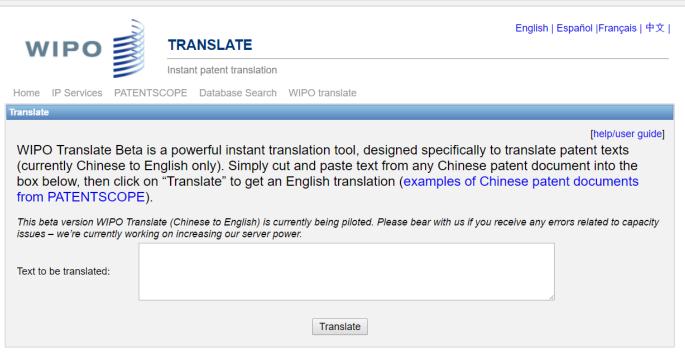
#### Related links

WIPO Translate Beta, featuring neural translation technology (Chinese to English)



## WIPO Translation beta version

i patentscope.wipo.int/translate/demoNmt.jsf

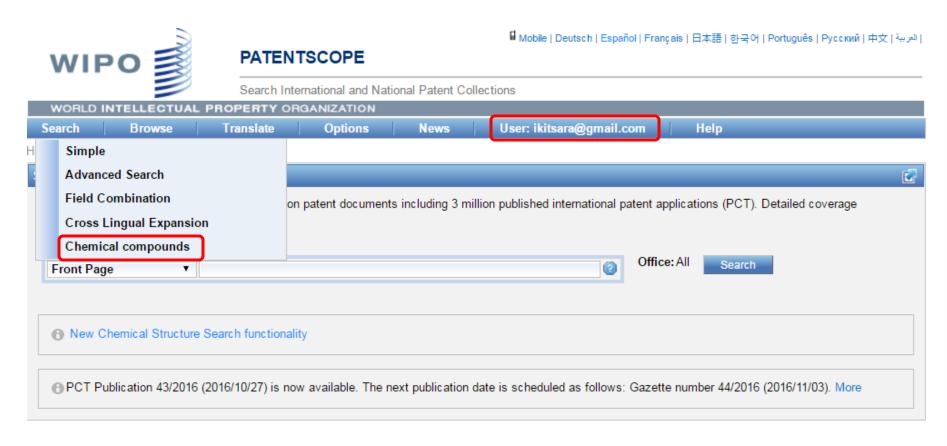


#### Related links

- WIPO Translate full version (all language pairs)
- WIPO Develops Cutting-Edge Translation Tool For Patent Documents

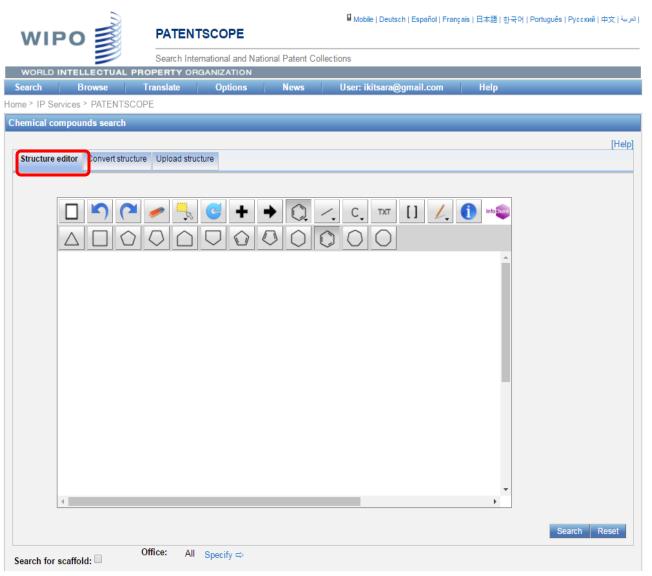


# New PATENTSCOPE feature: Chemical compound search





## **Chemical Compound Search**

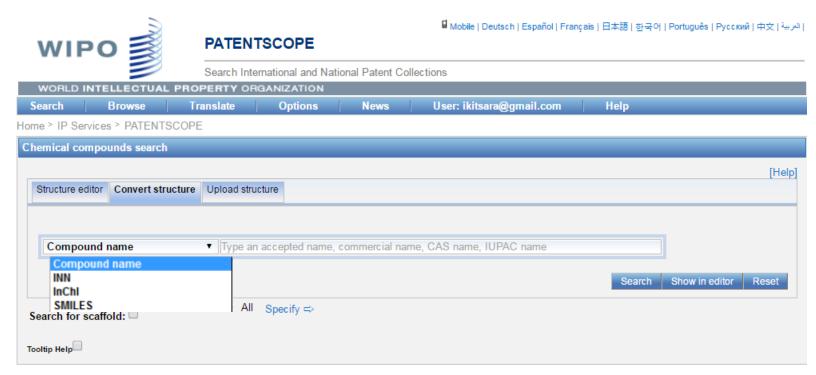


### Draw or edit:

- ✓ Chemical structures
- ✓ Reactions
- Fragments similar to chemical sketches on paper;

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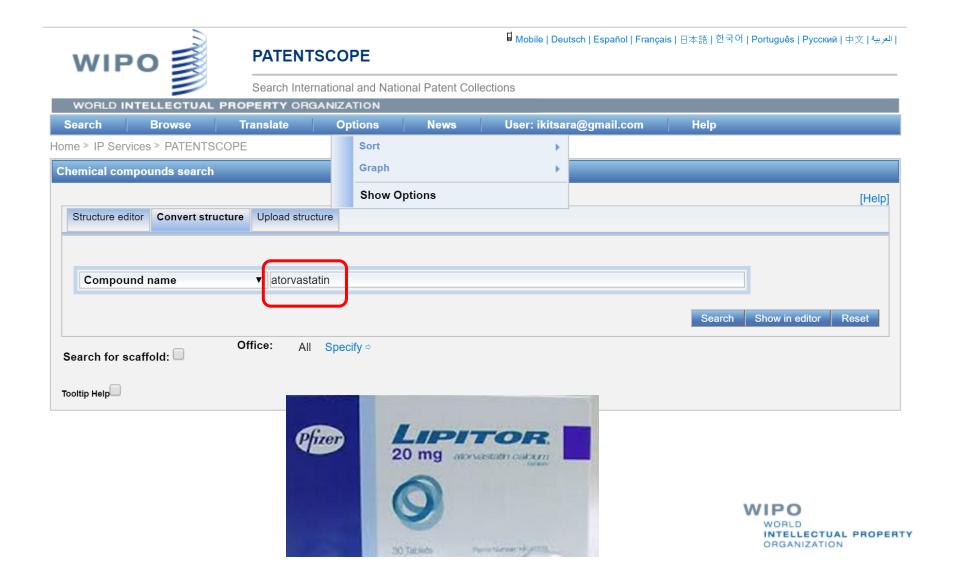
## Convert structure



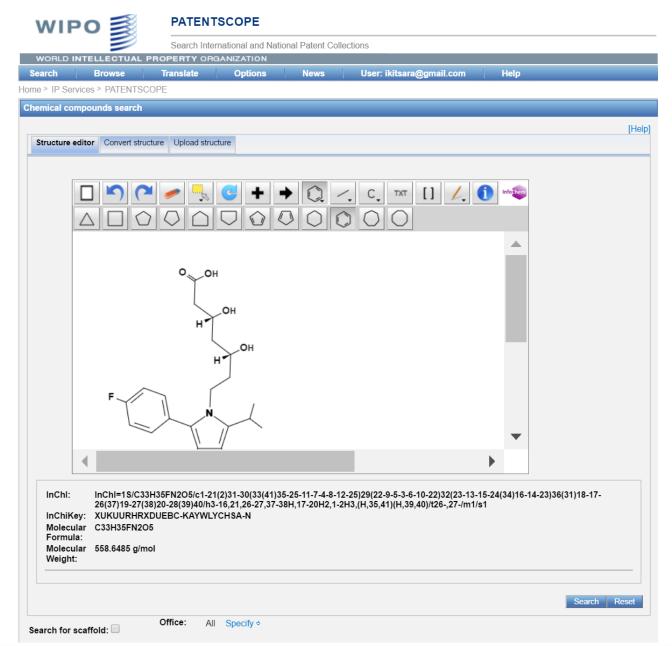
- PCT applications in EN and DE since 1978
- US national collection since 1979
- IUPAC/clinical/chemical/commercial names/CAS number/SMILES supported
- Exact compounds can be searched no Markush structures supported



## Convert structure example

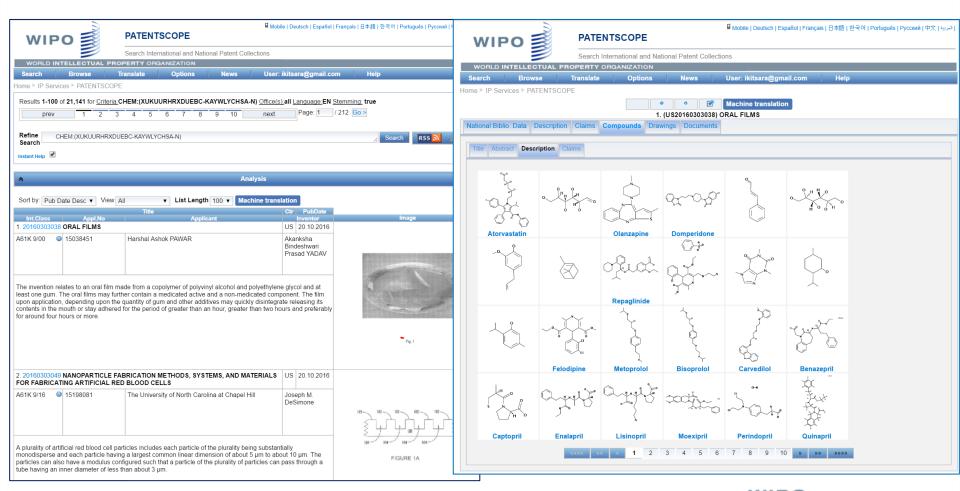


## ...and search for the chemical structure

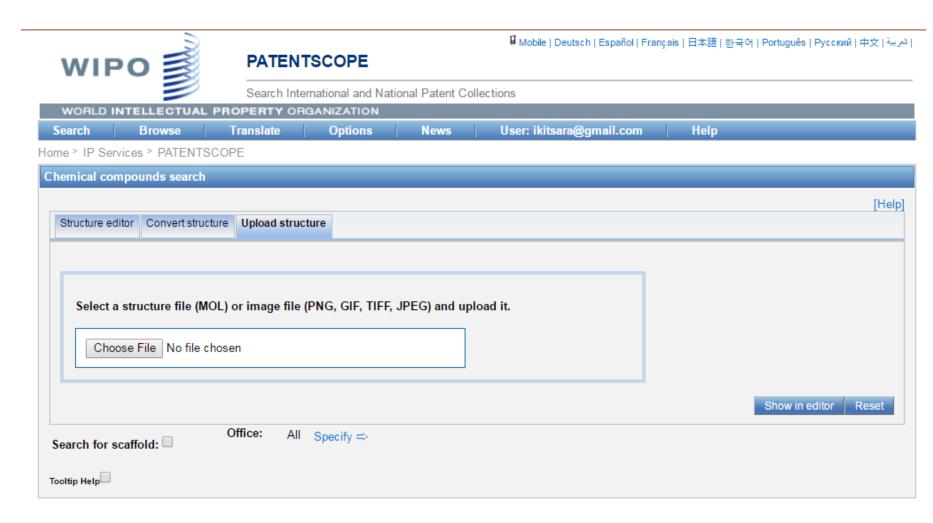




## Chemical compound search results

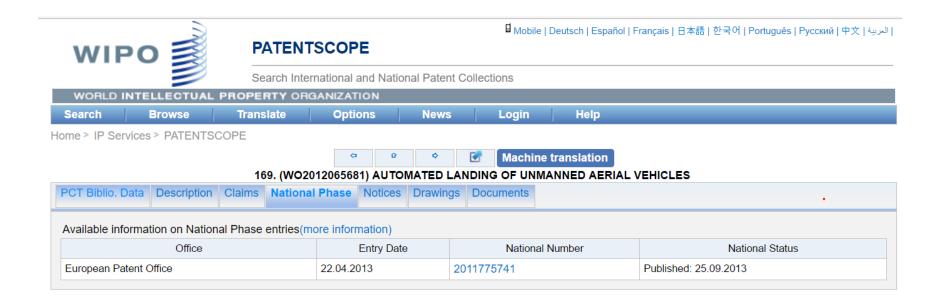


## Upload structure





# National phase and other available information





# Legal status information and how WIPO helps accessing such information

- Legal status data essential for certain types of analysis (FTOs, portfolio analysis, CI/BI)
- Challenge of accessing relevant and up-to date legal status information
- Need to access the primary source of legal status information -Patent Registers/Gazettes for most up-to-date information
- Portal to national patent registers pilot project after a WIPO feasibility study on availability, reliability and comparability of patent legal status data
  - (http://www.wipo.int/patentscope/en/programs/legal\_status)
- Towards the development of a new standard: the work of the Legal Status Task Force of the CWS

(http://www.wipo.int/edocs/mdocs/cws/en/cws\_4\_bis/cws\_4\_bis\_5.pdf)

## Patent Register Portal





## Patent Register Portal

🗎 www.wipo.int/branddb/portal/portal.jsp

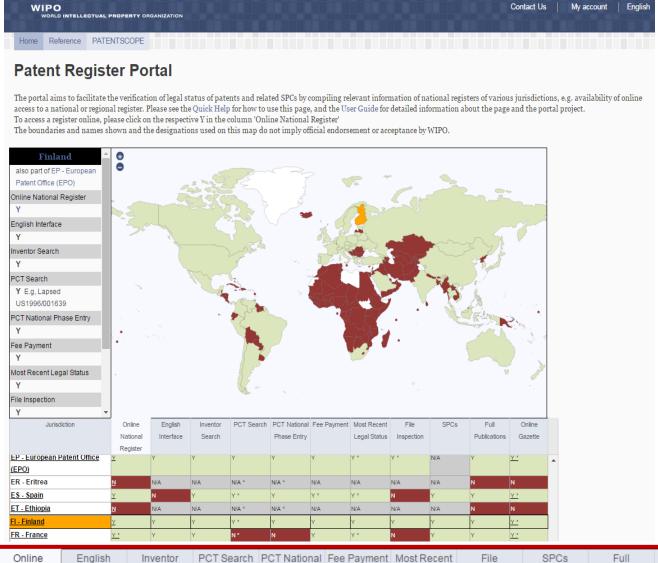
Inventor

Search

National

Register

Interface



Phase Entry

Legal Status

Inspection

- Information on availability of online patent registers/Gazettes, search modalities, links & tips on searching for legal status in various patent registers
- Color code:
- New DA Project on the "Use of information in the public domain for economic development"
- **Updated portal** beginning of 2017

Online

Gazette

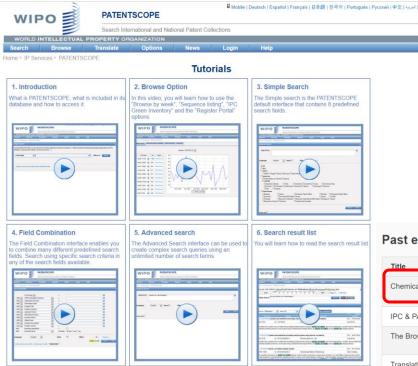
Publications

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## PATENTSCOPE: learning resources

### Video tutorials



### **Webinars**

## Register for upcoming webinars

- Options & Help menus in details October 25 | October 27
- Complex queries November 22 | November 24
- Retrospective of 2016 and plans for 2017 December 6 | December 8

### Past events

Title	Description	Date
Chemical structure search PPT	How to use the chemical structure search in PATENTSCOPE	September 2016
IPC & PATENTSCOPE PPT	How to do make the most of the IPC in PATENTSCOPE	August 2016
The Browse menu in PATENTSCOPE PPT	Find out the different features offered in the PATENTSCOPE Browse menu	July 2016
Translation Tools in PATENTSCOPE PPT	Demonstration of the use of the different translation tools available in PATENTSCOPE	June 2016



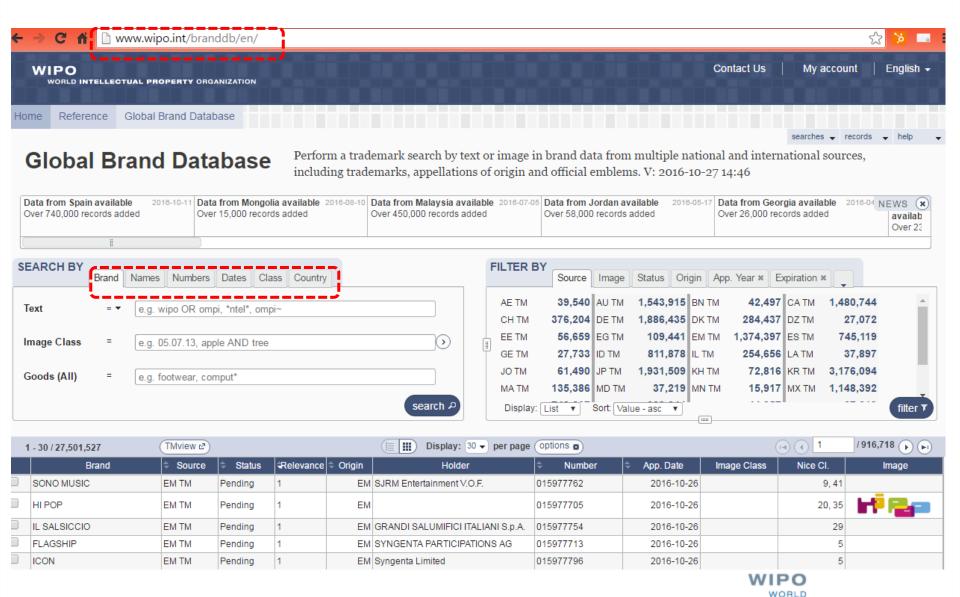
## **Global Brand Database**

- Over 27,5 million records relating to nationally and internationally-protected trademarks
- Allows searches across multiple collections, including:
  - Trademarks registered under Madrid System and EUIPO
  - Appellations of Origin registered under Lisbon System
  - Emblems protected under the Paris Convention 6ter
  - 31 national collections, with more to come soon





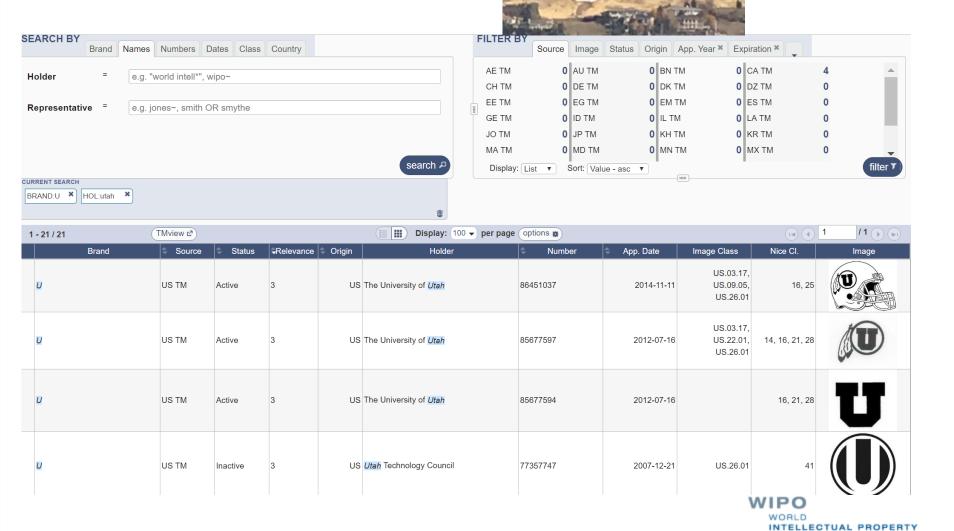
## **Global Brand Database**



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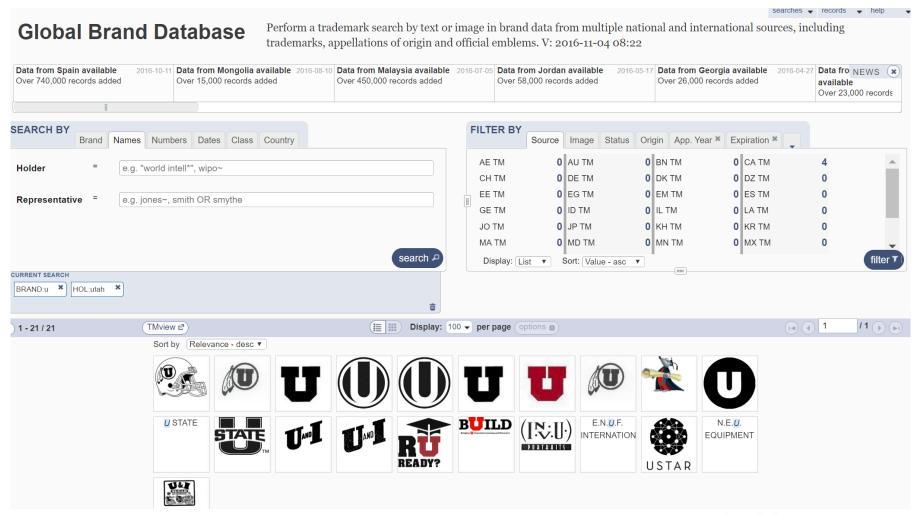
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## Global Brand DB and



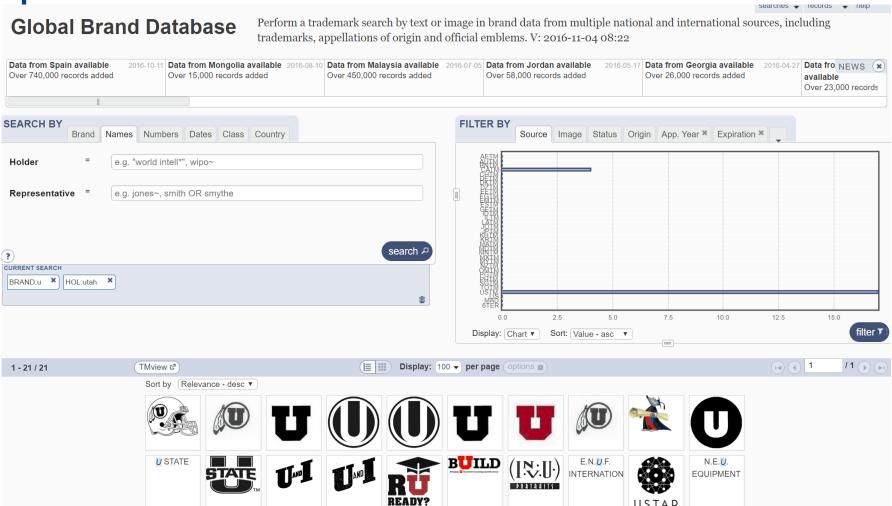
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## **Global Brand DB**



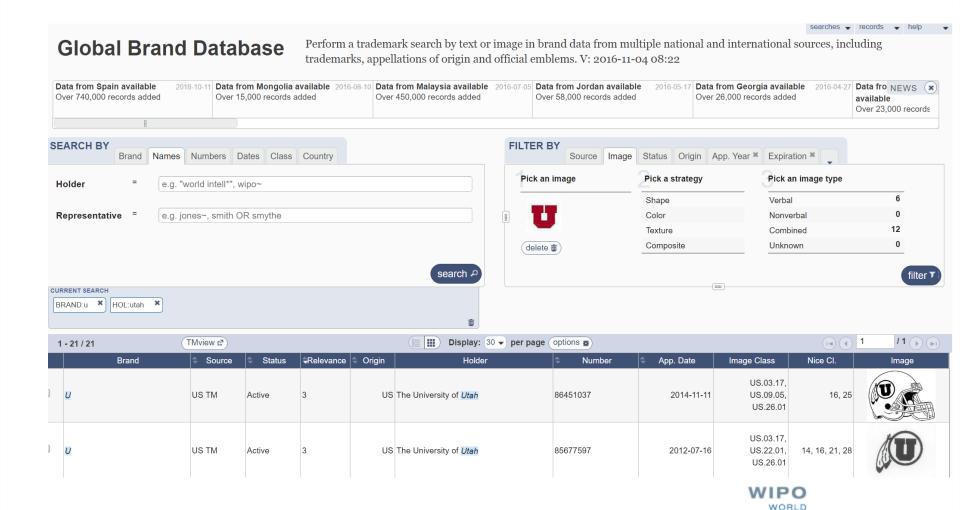
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# Geographical distribution of TM protection





## Unique image similarity search feature



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## A database entry

### **Global Brand Database**

Perform a trademark search by text or image in brand data from multiple national and international sources, including trademarks, appellations of origin and official emblems. V: 2016-11-04 10:27

Data from Spain available
Over 740,000 records added
Over 15,000 records added
Over 450,000 records added

Data from Malaysia available
Over 58,000 records added
Over 58,000 records added
Over 58,000 records added
Over 26,000 records added
Over 26,000 records added
Over 23,000 records

♠ back

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U.S. Trademark



To ensure the most reliable and accurate search results of U.S. applications and registrations, users - particularly those filing applications with the USPTO - should access the Trademark Electronic Search System (TESS) at tess2.uspto.gov and search U.S. application and registration data using the available assisted search forms and other search tools available on the USPTO website.

#### 86451037 - U

Status: Live/Registered, Registered

- (111) Registration Number 4789085
- (151) Date of the registration 11.08.2015
- (210) Serial number of the application 86451037
- (220) Date of filing of the application 11.11.2014
- (270) Language(s) of the application English
- (540) Mark



- (332) Description of the figurative elements of the mark according to a national classification
- 6 03.17.02, 09.05.25, 26.01.02.
- (550) Indication relating to the nature or kind of mark

  Trademark
- (571) Description of mark

The mark consists of the design of a football helmet. On the side of the helmet there is an image of a drum with a feather attached on the left side and the letter "U" in a stylized format inside the drum

(591) Information concerning colors claimed

Color is not claimed as a feature of the mark.

(641) Number(s) and date(s) of other legally related applications

(US Registrations) 3466087; 4390768; 4390769; and others

(750) Address for correspondence

WILLIAM H. BREWSTER, KILPATRICK TOWNSEND & STOCKTON LLP, 1100 PEACHTREE ST NE STE 2800, ATLANTA, GA 30309-4528

(731) Name and address of the applicant

(Applicant) The University of Utah Corporation UTAH, 270 S. 1500 E. University Bookstore, Salt Lake City UT 84112

(732) Name and address of the holder of the registration

(Owner) The University of Utah Corporation UTAH, 270 S. 1500 E. University Bookstore, Salt Lake City UT 84112 (Registrant) The University of Utah Corporation UTAH, 270 S. 1500 E. University Bookstore, Salt Lake City UT 84112

(740) Name and address of the representative

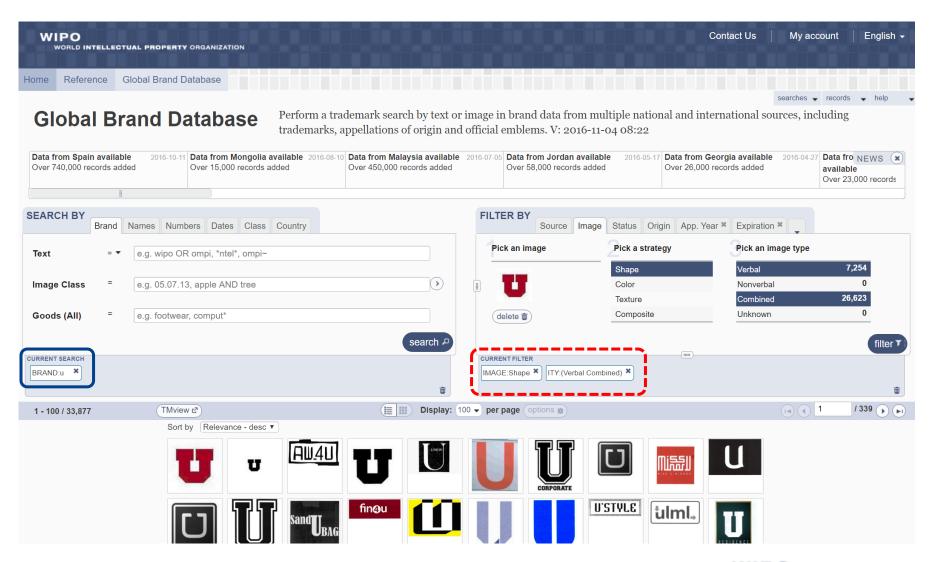
(Attorney of Record) William H. Brewster

- (511) The International Classification of Goods and Services for the Purposes of the Registration of Marks (Nice Classification) and the list of goods and services classified according thereto
  - 16 Temporary tattoo transfers; paper gift tags; decals
  - 25 Clothing, namely, shirts
- (512) National classification and/or list of goods and/or services classified according thereto

002, 005, 022, 023, 029, 037, 038, 050, 022, 039

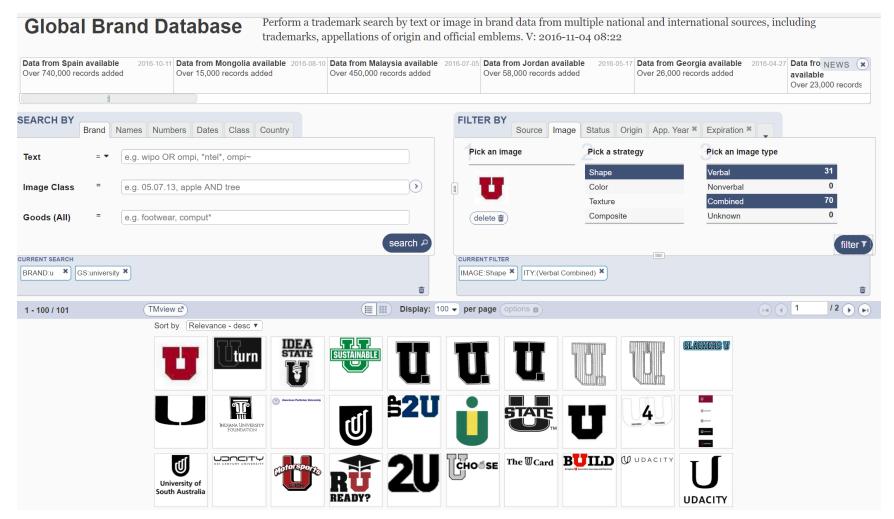


## Grid view – for a faster overview of the results



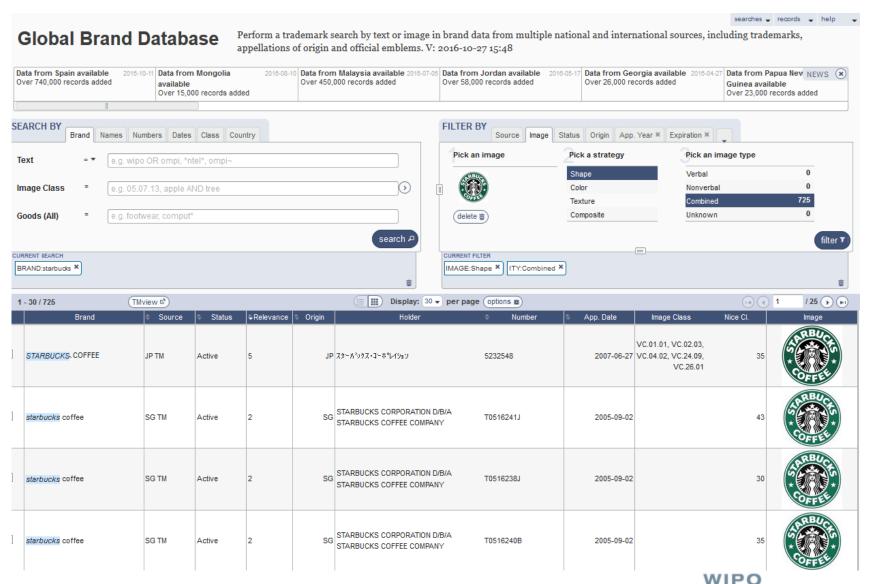
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## Define your strategy – add text or...



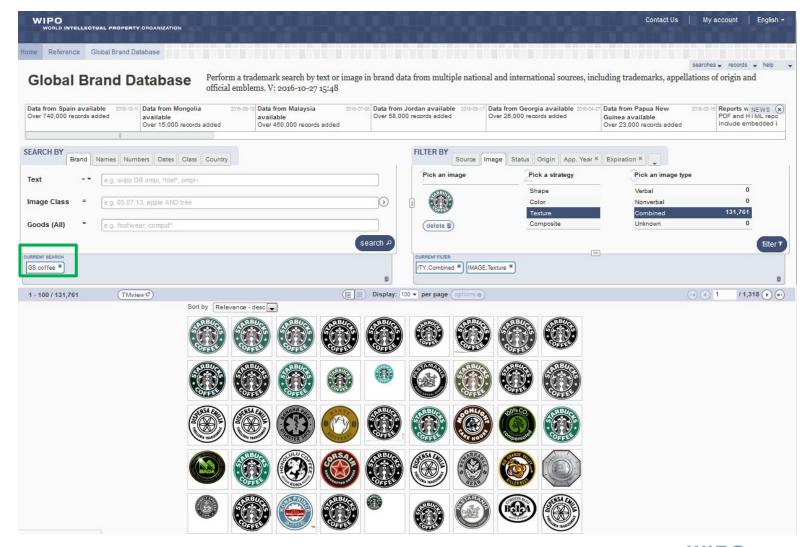


## Define your search strategy and...



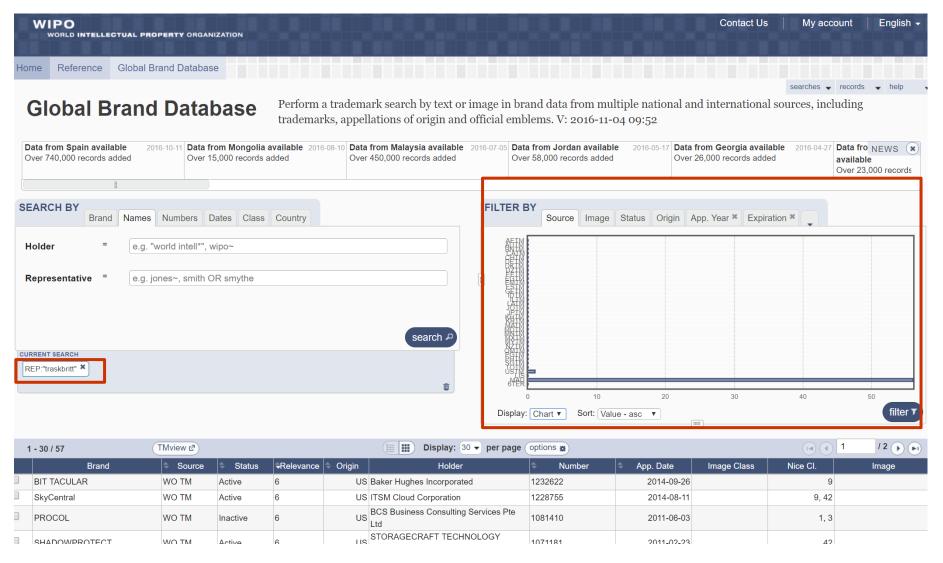
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# ...for more relevant results combine with Nice/National classification



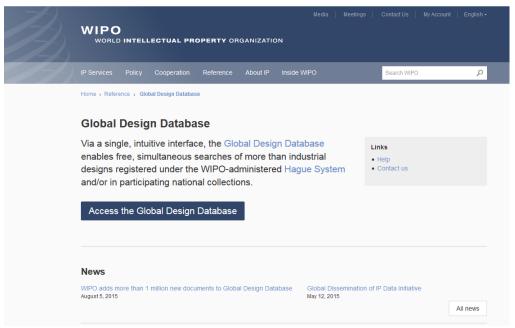


## Search by representative





## Global Design Database



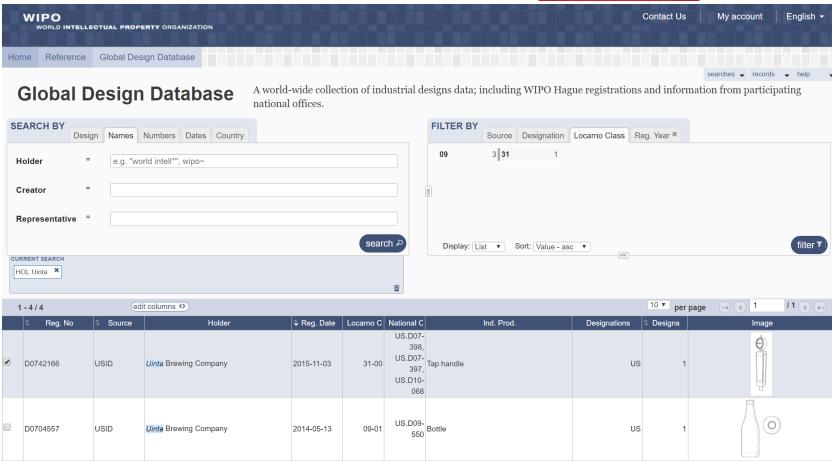
http://www.wipo.int/designdb

- Launched in 2015
- Simultaneous search of more than 1,6 million industrial designs registered in the available national collections or under the Hague System



## Global Design Database and







## An example of a database entry

Reference

Global Design Database

### **Global Design Database**

WORLD INTELLECTUAL PROPERTY ORGANIZATION

A world-wide collection of industrial designs data; including WIPO Hague registrations and information from participating national offices.

back

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#### US Industrial Design

To ensure the most reliable and accurate search results of U.S. applications and registrations, users - particularly those filing application application and registration data using the available assisted search forms and other search tools available on the USPTO website.

D0697420 - Bottle with a compass design

(11) International Registration Number

D0697420

Filing Date of the Application

2011-08-31

(15) Date of the international registration

2014-01-14

(54) Indication of products

Bottle with a compass design

(51) Class and subclass of the Locarno Classification

**1** 09-01

(52) National classification

**1** D09-516

Name and address of creator of designs

[Inventor] Hamill; William D. (Park City, UT US) (73) Name and address of the holder(s)

[Applicant] Hamill; William D. (Park City, UT US)

(73) Name and address of the holder(s) [Assignee] Uinta Brewing Company (Salt Lake City, UT US)

(74) Name and address of representative

[Agent(s)] Thorpe North & Western LLP (unknown)

Description of the characteristic features of the design(s), or matter for which protection is not sought

The ornamental design for a bottle with a compass design, as shown herein.

(55) Description of images

FIG. 1 is a perspective view of a bottle with a compass design in accordance with an embodiment of the present invention

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English -

FIG. 2 is a front view thereof;;

FIG. 3 is a rear view thereof;;

FIG 4 is side view thereof:

FIG. 5 is an opposing side view thereof;;

FIG. 6 is a top view thereof; and.:

FIG. 7 is a bottom view thereof.:

The portions of the drawings shown in broken lines form no part of the claimed design.







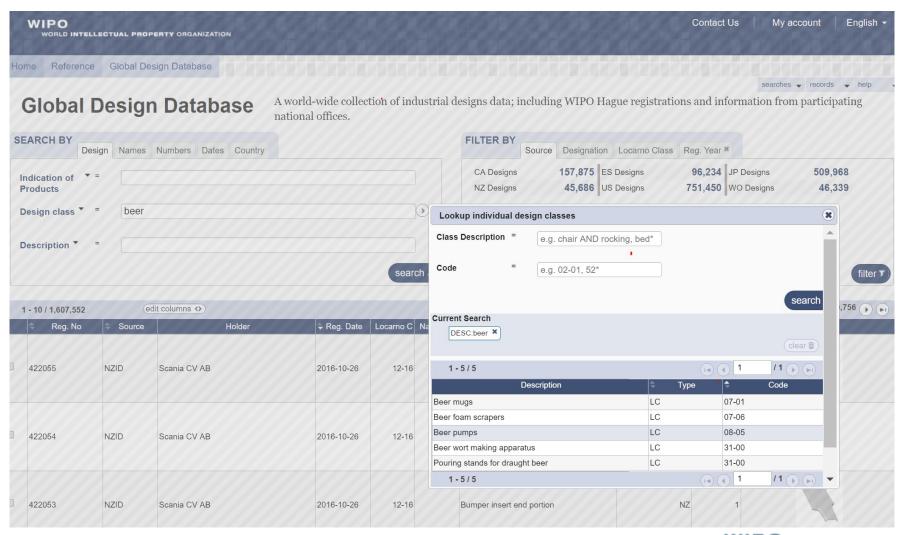






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## Search by national/Locarno Classification





# WIPO Digital Access System (DAS)

- DAS (Digital Access System) used by 14 IPOs
- A System that allows IPOs and applicants to securely exchange or submit a digital copy of priority documents to multiple IPOs

### **Participating Offices**

The digital libraries of the following offices are participating in the WIPO Digital Document Access Service (DAS), established under the Framework Provisions for the Digital Access Service.

There are two different types of notification possible:

- Depositing Office (paragraph 10 of the Framework Provisions): The Office, which
  is usually acting as the Office of first filing, allows applications to be made available to the
  Service:
- Accessing Office (paragraph 12 of the Framework Provisions): The Office, acting as an
  Office of second filing, allows the applicant to request that a priority document be retrieved
  from the Service instead of having to file a certified copy.

At present, the service is operational for patent documents only. One office is ready to deposit and retrieve patent and utility model documents. Documents relating to other IP rights, such as industrial Designs and trademarks will be exchanged through the system once the participating offices have made the necessary operational and technical changes.

The main effects of the notifications, as well as information on digital libraries which have been designated, are summarized in the table below. For more information, refer to the complete notifications.



## **WIPO DAS**

### Why use this service?

### **Applicants**

### Easy

 Simply ask the office of first filing to add the priority document into the system, and request offices of second filing to use the service for obtaining access.

#### Secure

- Use of an access code to authorize access;
- · Documents exchanged via secure channels;
- Service hosted and administered by WIPO.

### Quick

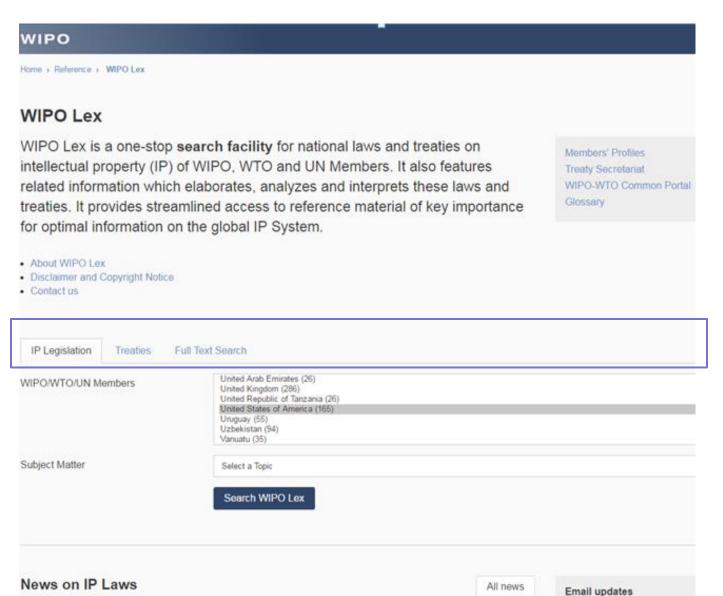
 No need to provide a certified copy of a priority document separately to each office of second filing.

### Inexpensive

- · No need to pay for multiple copies of paper priority documents;
- No charges by WIPO. Offices can charge, but it is expected that most will not.



## **WIPO Lex**



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## WIPO Lex - USA

#### WIPO Home > Reference > WIPO Lex United States of America (168 texts) Quick Access: Laws (90 texts) | Implementing Rules/Regulations (77 texts) | Treaty Approvals (1 texts) IP Legal Literature (14 texts) | Treaty Membership (114 texts) | Relevant links Outline of the Legal and Regulatory Framework for Intellectual Property in the United States of America Constitution / Basic Law Laws . The Constitution of the United States of America (1787) Main IP Laws: enacted by the Legislature . Defend Trade Secrets Act of 2016 (Public Law No. 114-153) (2016) U.S. Patent Law, 35 U.S.C. §§ 1 et seq. (consolidated as of May 2015) (2015) U.S. Trademark Law. Rules of Practice in Trademark Cases, 37 C.F.R. 2 et seq. & Federal Statues; Trademark Act, 15 U.S.C. §§ 1051 et seq. & Patent Act, 35 U.S.C. Part 1 (Consolidated Trademark Law and Regulation as of July 11, 2015) (2015) Act to Correct and Improve Certain Provisions of the Leahy-Smith America Invents Act and Title 35, United States Code (Public Law No. 112-274, 126 Stat. Patent Law Treaties Implementation Act of 2012 (Public Law 112–211, 126 Stat. 1527) (2012) . Act to Amend the Trademark Act of 1946 to Correct an Error in the Provision IP-related Laws: enacted by the Legislature Leahy-Smith America Invents Act (AIA) (2011) Small Business Act (as amended through Public Law 113-76, 128 Stat. 5 on January 17, 2014) (2014) Stevenson – Wydler Technology Innovation Act of 1980, as amended through Unlocking Consumer Choice and Wireless Competition Act (Public Law 113-144, 128 Stat. 1751), 2014 (2014) 3982), 2011 (2011) Communications Act of 1934, (as amended through Public Law 112–96, enacted February 22, 2012), Title 47 U.S.C., Section 151 et. seq (2013) U.S. Copyright Law, 17, U.S.C. §§ 101 et seg. (Consolidated Copyright Law U.S. Crimes and Criminal Procedure, 18 U.S.C. §§ 1 et seq. (2013) . Copyright Cleanup, Clarification, and Corrections Act of 2010 (2010) Code of Federal Regulations, Title 19, Customs Duties (Revised as of April 1, 2012) (2012) Trademark Technical and Conforming Amendment Act of 2010 (Public Law America Competes Reauthorization Act of 2010 (Public Law 111-358, 124 Stat. 3982) (2011) · Prioritizing Resources and Organization for Intellectual Property Act of 200 National Defense Authorization Act for Fiscal Year 2012 (2011) · Vessel Hull Design Protection Amendments of 2008 (Public Law 110-434, United States- Panama Trade Promotion Agreement Implementation Act (Public Law 112-43, 125 Stat. 497) (2011) · Copyright Royalty Judges Program Technical Corrections Act (Public Law United States—Colombia Trade Promotion Agreement Implementation Act (2011) Plant Variety Protection Act. 7 U.S.C. §§ 2321 et seg. & Plant Variety Prote United States - Korea Free Trade Agreement Implementation Act (2011) 28 U.S.C Chapter 91-United States Court of Federal Claims (2011) Section 355 of the Federal Food, Drug, and Cosmetic Act, 21 U.S.C.§ 355 (2010) U.S. Code: Title 47 - Telecommunications (Revised as of October, 2010) (2010) Implementing Intellectual Property . U.S. Trademark Law: Rules of Practice in Trademark Cases, 37 C.F.R. 2 et seq. & Federal Statues; Trademark Act, 15 U.S.C. §§ 1051 et seq. & Patent Act, 35 Rules/Regulations U.S.C. Part 1 (Consolidated Trademark Law and Regulation as of July 11, 2015) (2015)

. 37 CFR Part 1- Revisions to Implement the Patent Term Adjustment Provisions of the Leahy-Smith America Invents Act Technical Corrections Act; Final Rule

Extension of the Extended Missing Parts Pilot Program; Notice (2014)
 37 CFR Part 201 - Changes to Recordation Practices. Final Rule (2014)

Elimination of Patents Search Templates: Notice (2014)

### WORLD

INTELLECTUAL PROPERTY ORGANIZATION

# B. Tools facilitating access to, understanding and use of IP information

- Patent Landscape Reports
- Guidelines for Preparing Patent Landscape Reports
- Manual on Open Source Tools for Patent Analytics



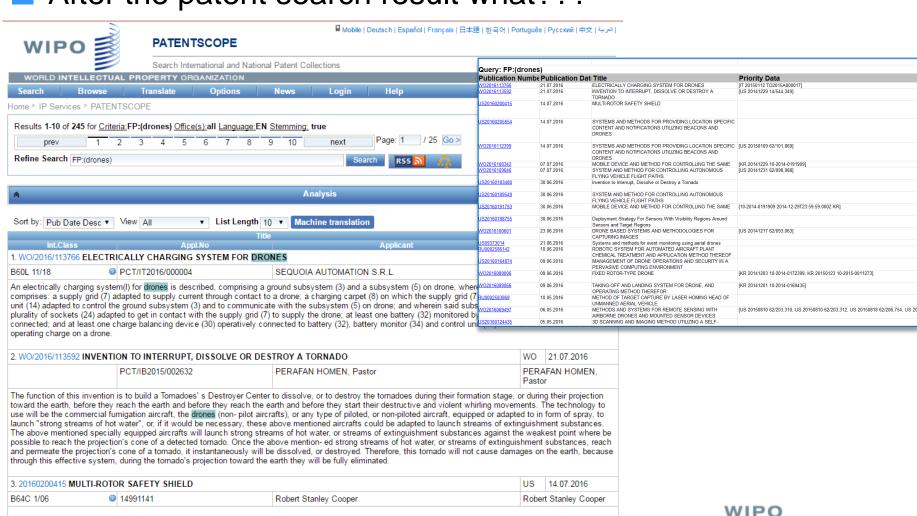
## What is patent analysis?

After the patent search result what???

The Multi-Rotor Safety Shield (MRSS) provides a complete and substantial encasement system which can be secured about a Drone, protecting a multitude of aircraft components from contact with any outside disturbance and which can protect the sensitive components from dust, water, wind, rain, snow, fingers, toes, appendages of

any kind, and atmospheric changes as example, from disabling the Drone and can protect people, places or things from high velocity spinning exposed rotor/propellers.

The MRSS provides rigid non-permeable platform for attaching or incorporating additional safety devices as found in the Drone industry (or other industries) resulting in a safety device that completely prevents the loss a Drone due to the catastrophic failure of any Drone system or combination of systems which would typically result in



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## Importance of patent analytics

Data-driven decisions



- A powerful tool allowing for:
  - Structured presentation of patent search results
  - Meaningful interpretation of the results
  - User-friendly illustration of the information with support of statistics, visualizations and narrative
  - Facilitation of interdisciplinary dialogue among various stakeholders
  - Informed decisions about R&D prioritization and investment, technology and know-how transfer, local manufacturing

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## What is a Patent Landscape Report (PLR)?

- Research and analysis of innovation patterns and patenting trends in a specific technological field/geographical area using patent information
- Content and analysis types customized to the concrete needs
- It can have a very narrow to a very broad scope and serve various needs, e.g. WIPO PLR on atazanavir and the PLR on animal genetic resources
- Geographical coverage can vary and can have or include country focus (e.g. BRIC countries)
- It typically does not include legal status information, yet in some cases such data forms part of the report

## What kind of questions can a PLR answer?

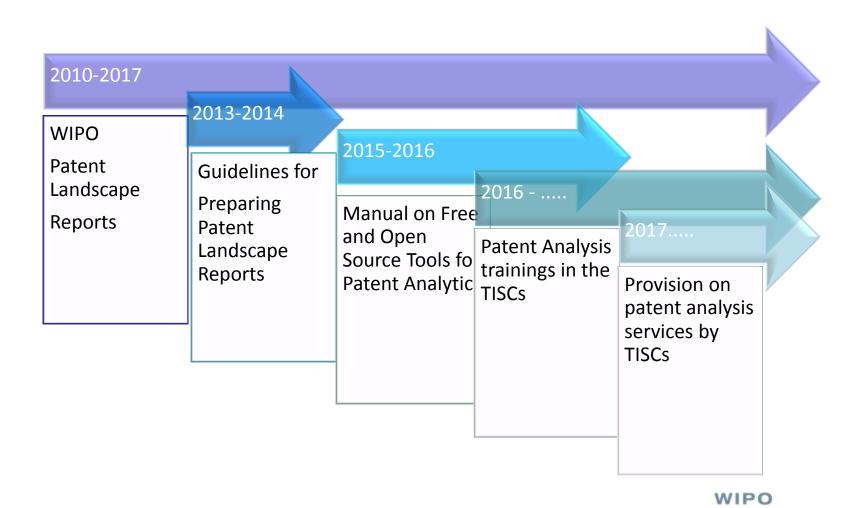


(The Answer to The Ultimate Question of Life, the Universe, and Everything, The Hitchhiker's Guide to the Galaxy, Douglas Adams)

- Which **technology trends** exist in which **geographical areas** and how have they developed **over time**?
- Are there gaps or **white spaces**, i.e. areas with little patent protection, that permit business opportunities or give them an added value?
- Which players are the most active in a said technical area and what is their specific focus and strategy?
- Which other patents are relevant for a company's activities or a product development/commercialization? (Infringement/FTO, licensing-in, collaborations)
- Which patents are about to expire? Which technologies move in the public domain and provide business opportunities?
- What is the patent portfolio of competitors and what is the impact on the company's portfolio and activities? Correlation and effect on value



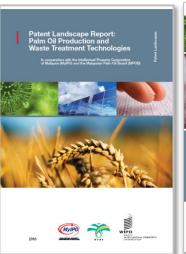
# Evolution of WIPO Patent Analytics activities



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## WIPO Patent Landscape Reports Topics



















### Dedicated WIPO PLR website



#### WIPO's patent landscape reports

Under the Development Agenda project "Developing Tools for Access to Patent Information" WIPO is mandated to produce patent landscape reports in areas of particular interest to developing and least developed countries, such as public health, food security, climate change, and the environment.



Microalgae-Related Technologies



devices for visually and hearing impaired persons



Waste Recycling



**Animal Genetic** Resources

All reports

2015 statistics: 54.500 PDF downloads

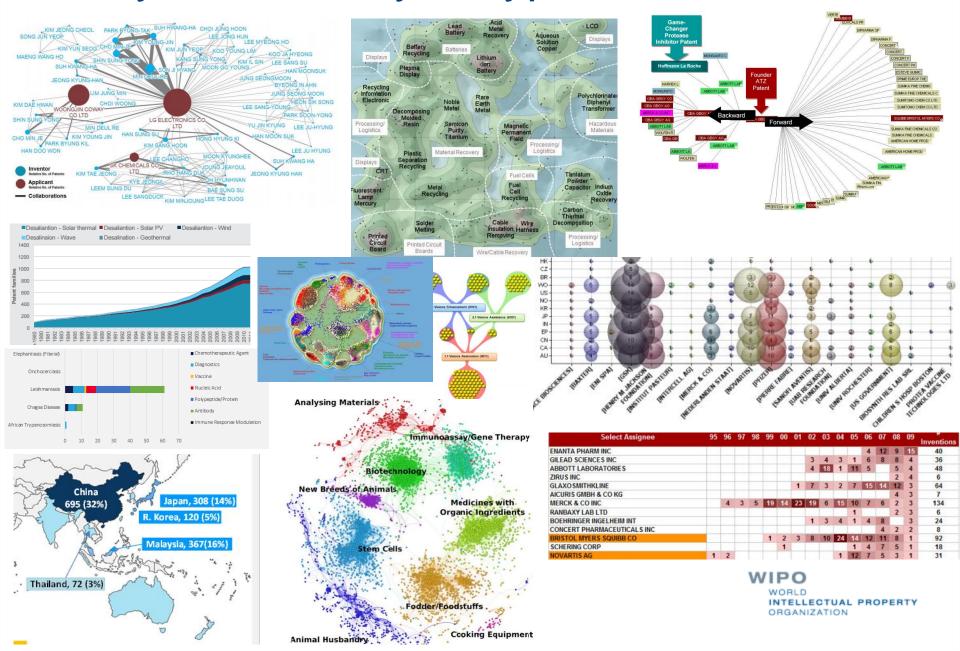
WIPO

INTELLECTUAL PROPERTY

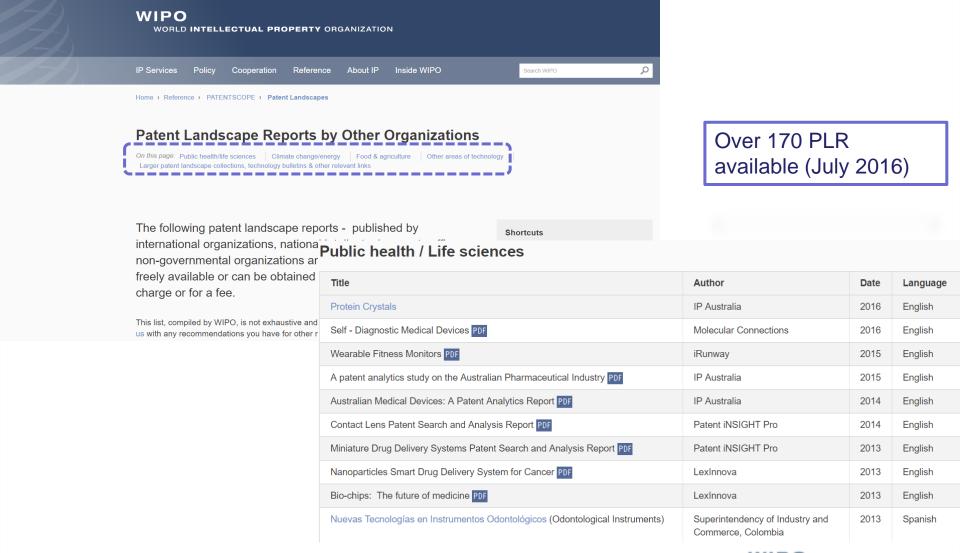
**PLR Guidelines** 

Reports by other organizations

# Variety in the analysis types and tools used



# Unique compilation of PLR prepared by other organizations



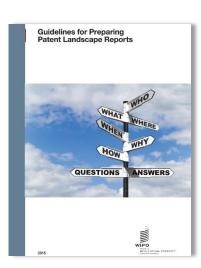
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# Guidelines for Preparing Patent Landscape Reports

Published in September 2015 and available on <a href="http://www.wipo.int/patentscope/en/programs/patent\_landscapes">http://www.wipo.int/patentscope/en/programs/patent\_landscapes</a>

### Structure:

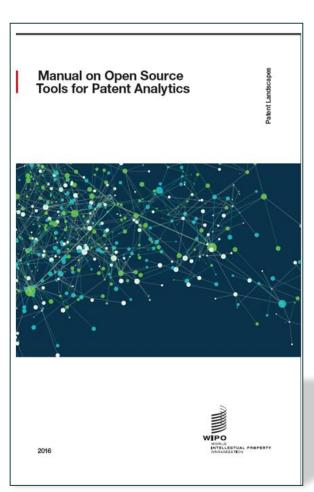
- Background information on patent information
- Objectives and motivations for preparing PLRs
- Different types of patent analysis
- Tasks associated with the preparation of PLRs
- Stages in the preparation of PLRs
- Examples and experience from WIPO's work in





# The Manual on Open Source Tools for Patent Analytics

- Project launched in May 2015, funded by FIT-JP
- Aimed at exploring:
  - various free and open source tools which could be used for various patent analysis tasks by users in developing countries
  - Includes walkthrough for using selected software for various analytics tasks





# Which analytics tasks, databases and tools does the Manual cover?









- Obtaining Data rplos
- Cleaning Data
- Visualizing Data
- Sharing Data



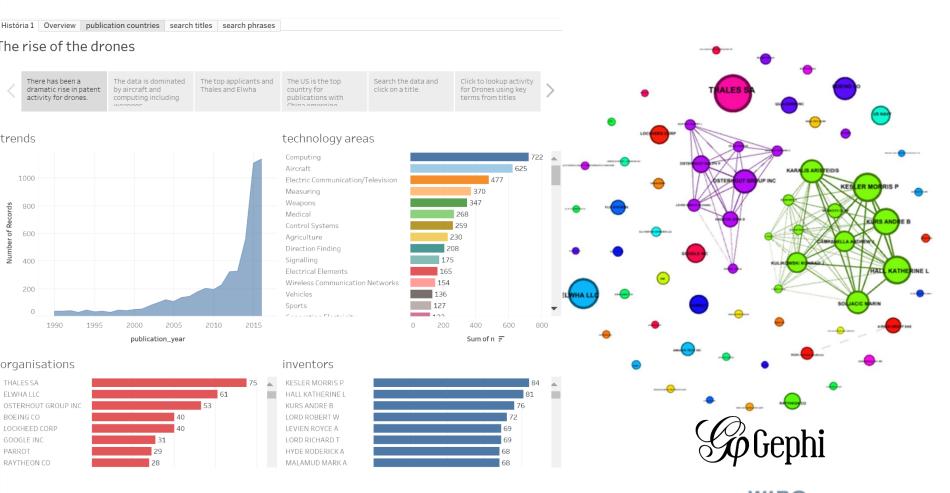








# What can the users produce when using these tools?

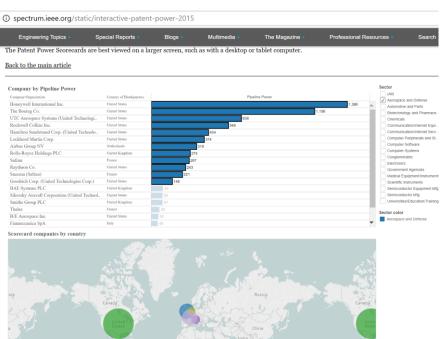




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# Who else is using these tools?

# IEEE Patent Power Scorecards



### **OECD**



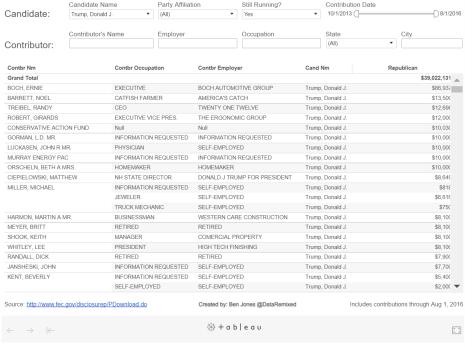


## Who else is using these tools? (2)

### State of Utah

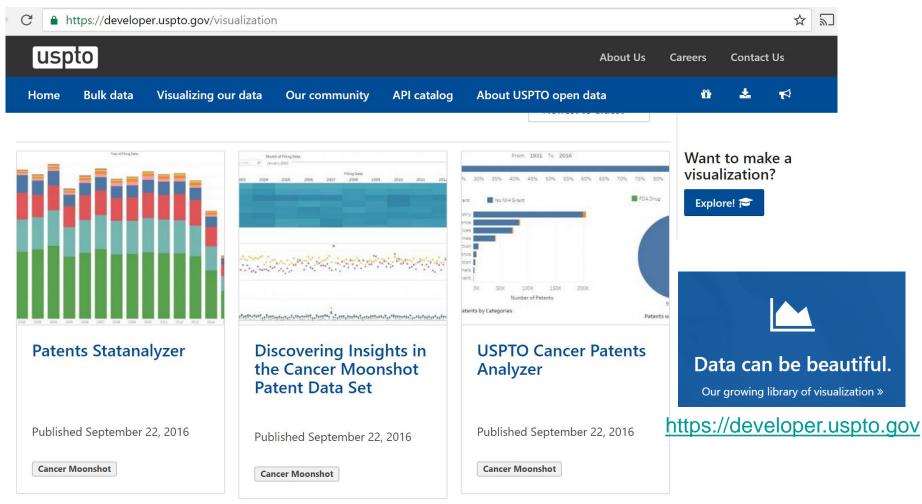


# Federal Election Committee





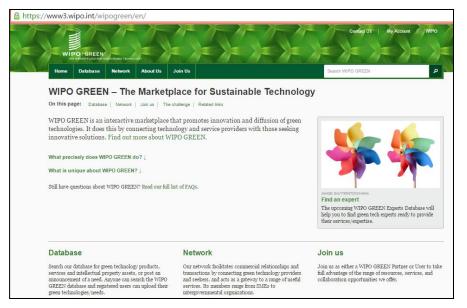
# What our USPTO colleagues are doing





## C. Multi-stakeholder Platforms

### **WIPO GREEN**



### WIPO Re:Search

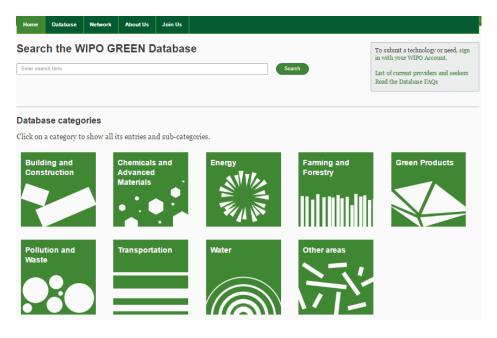


### **WIPO Match**



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### WIPO Green

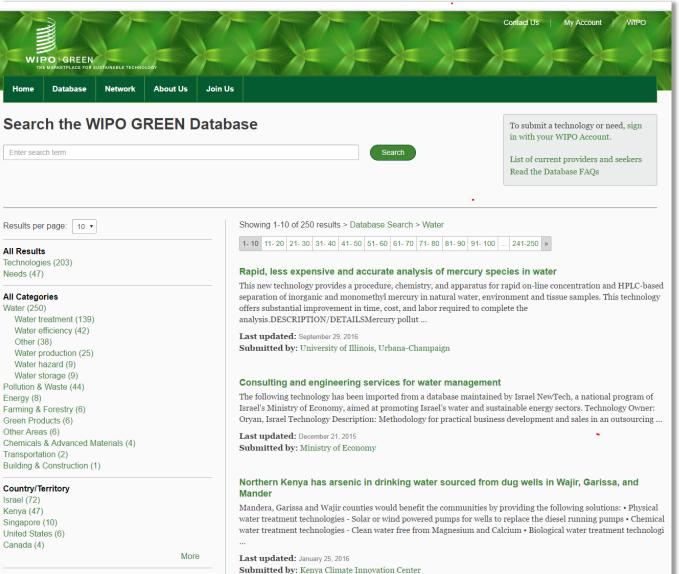


https://www3.wipo.int/wipogreen

- The marketplace for sustainable technology: search functionality for technology providers and seekers
- Network of green technologies stakeholders
- Grouped in 9 technology areas



## WIPO Green example: Water



#### Provider (Company/organization)

Ministry of Economy (72)
African Agricultural Technology Foundation (26)
Kenya Climate Innovation Center (15)

#### Water Decontamination through the use of Photocatalysts

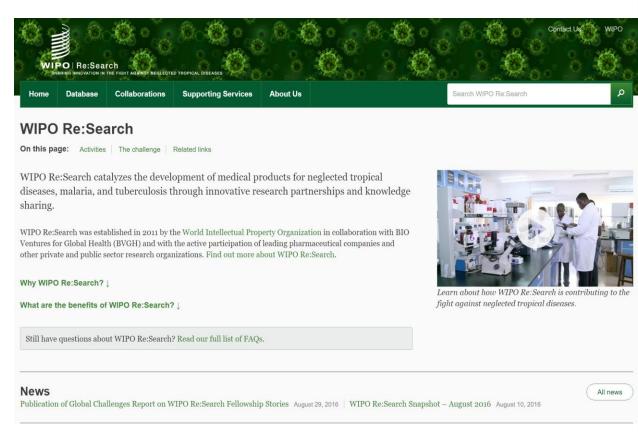
Dr. Peter Smirniotis and collaborators with his lab have a way to photocatalytically degrade organic compounds by

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### WIPO Re:Search

- Initiative aiming at promoting the development of medicines for neglected diseases, malaria and TB
- Includes a database with information on availability of IP rights and other information
- Voluntary contribution



http://www.wipo.int/research



# What can you search for?

Structured Search	Full Text Search		
Provider:	Aberystwyth University African Institute of Biomedical Sciences and Technology (AIBST) Alnylam Caltech Center for Infectious Disease Research Center for World Health and Medicine (CWHM) Centre of Excellence for Malaria Diagnosis, University of Lagos Drugs for Neglected Diseases initiative (DNDI) Eisal Eskitis Institute GlaxoSmithKline (GSK) Infectious Disease Research Institute (IDRI) International Centre for Genetic Engineering and Biotechnology (ICGEB)	<ul> <li>Kumasi Centre for Research in Tropical Medicine (KCRTM)</li> <li>Liverpool School of Tropical Medicine (LSTM)</li> <li>Massachussets Institute of Technology (MIT)</li> <li>McGill University (McGill)</li> <li>Medical Research Council of South Africa (MRC)</li> <li>Medicines for Malaria Venture (MMV)</li> <li>Merck (MSD)</li> <li>National Institute of Parasitic Diseases, China</li> <li>National University of Singapore</li> <li>NIH (USA)</li> <li>Northeastern University (NEU)</li> <li>Novartis</li> <li>PATH</li> <li>Pfizer</li> </ul>	Sanofi Stanford University Swiss Tropical and Public Health Institute Theodor Bilharz Research Institute - (TBRI) Trypanosomiasis Research Centre at the Kenya Agriculture Research Institute (KARI) University of Bamako, Mali University of British Columbia University of British Columbia University of Buea, Cameroon University of California Berkeley University of Dundee, UK University of Edinburgh, UK University of South Florida University of Ibadan, Nigeria University of Kansas (KU) University of Washington, Seattle Walter Reed Army Institute of Research (WRAIR)
Disease:	Buruli Ulcer Chagas disease (American trypanosomiasis) Cysticercosis Dengue/dengue hemorrhagic fever Dracuncullasis (guinea-worm disease) Echinococcosis Endemic treponematoses (Yaws) Foodborne trematode infections (Clonorchiasis, Fascioliasis, Human African trypanosomiasis  Human African trypanosomiasis  Hit-to-Li Lead Se Pre-Clir Clinical Markete Enablin Intellect Formula Diagnos Vaccine New Bic		ies cal Candidate andidate I Product Technology (platform) al Property (patents) ion



### **WIPO Match**

WIPO Match Leveraging IP for Development

> A free online tool that brings people and organizations together to harness the power of intellectual property for economic and social development



On-line market place to match specific IP Technical Assistance needs with resources offered by potential providers/donors.



### WIPO Match

### Who can join?



#### Seekers

- IP offices
- · IP-related government bodies
- · Public research institutions, universities
- Foundations (inc. research foundations)
- Inter-governmental organizations

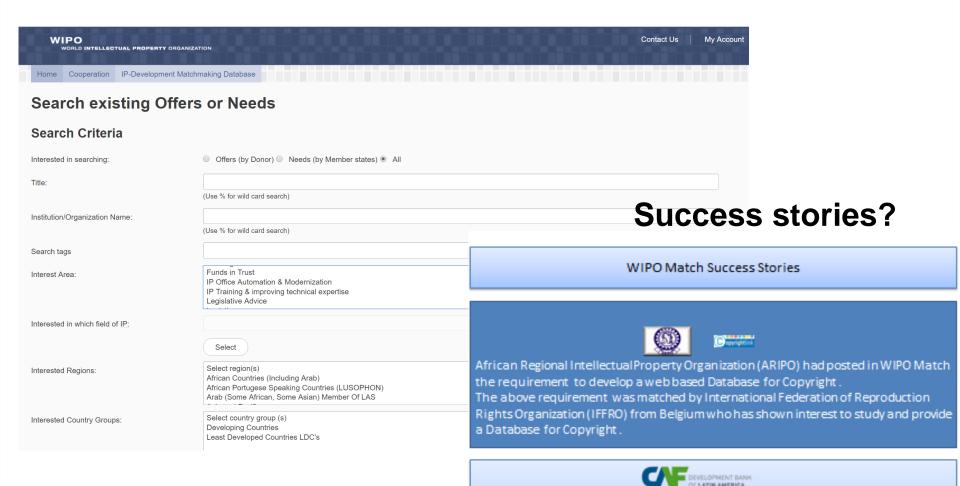
Seekers must come from developing countries, countries in transition, or least developed countries.

#### **Providers**

- Governments
- · Non-governmental organizations, Intergovernmental organizations
- Foundations (inc. research foundations)
- Companies
- Universities



### WIPO Match





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Thank you!

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