



International Protection of IP Rights; patent protection

WIPO TRAINING OF TRAINERS ON EFFECTIVE INTELLECTUAL
PROPERTY ASSET MANAGEMENT BY SMEs

Istanbul
September 13-15
2011

Li Maor

Consultant, Division for Certain Countries in Europe and Asia (DCEA)

The Patent System

Two important functions:

- *Protection*: gives the right to exclude others from commercially exploiting the invention covered by a patent in a certain country or a region **and** for a limited time;
- *Disclosure*: gives the public access to information (important resource for researchers, SMEs, inventors, etc.).

The Patent System

- Having a patent DOES NOT mean- the right to exploit the subject invention of a patent
- NEGATIVE (exclusive) right
- Territorial: valid only in Jurisdiction of the granting government
- Term: Maximum twenty years from filing date (or 25)
- Value: converting technology, knowhow or trade secrets, which may otherwise fall into the public domain, into a legitimate property right

Patent application

■ *abstract*

- a short summary of your invention
- The abstract describes your invention and says how it can be used, but does not discuss the scope of your claims
- 150 words or less

■ *Description (specification)*

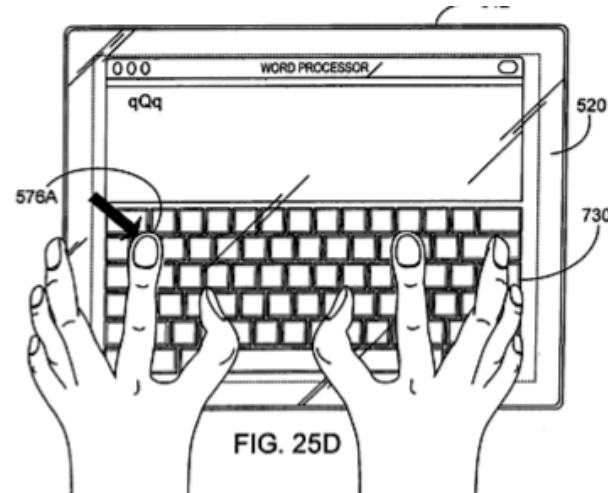
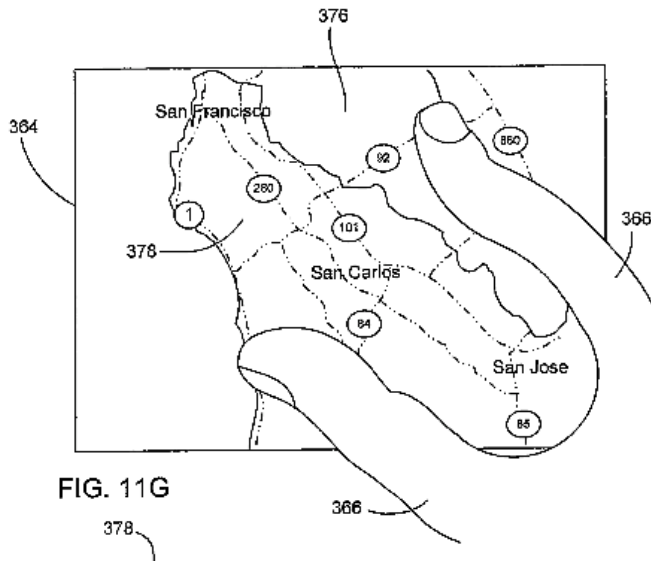
- Describes how the invention works (addresses a particular technical problem)
- Provides background information on this problem
- Indicates other known solutions to the problem

Patent application

■ *Claims*

■ Define the scope of protection sought by the applicant

■ *Drawings (if applicable)*



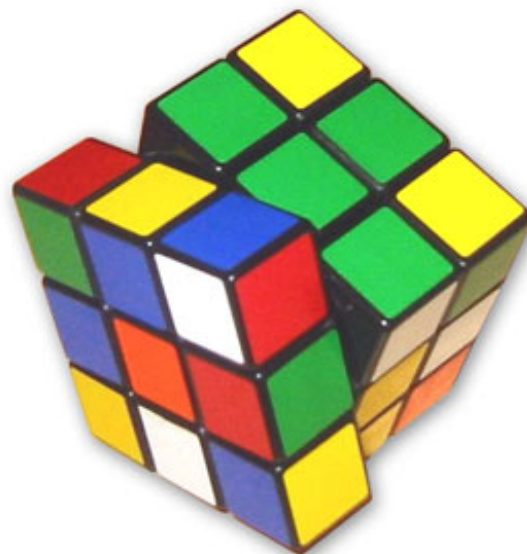
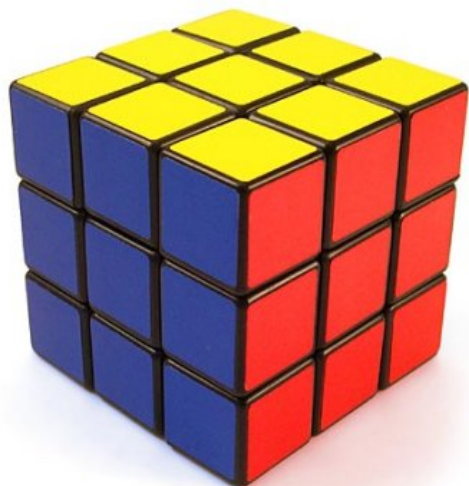
Example: PCT publication WO 2006/020305 “Gestures for Touch-Sensitive Input Devices” Published in February 2006

Business intelligence



Example: PCT publication WO 2006/020305 “Gestures for Touch-Sensitive Input Devices”

Apple iPhone, released in January 2007



The Patent System

ROYAUME DE BELGIQUE



MINISTÈRE DES AFFAIRES ÉCONOMIQUES

BREVET D'IMPORTATION

N° 887.875

Classif. internat.: A63 F

Mis en lecture le: 01-07-1981

Le Ministre des Affaires Économiques,

Vu la loi du 24 mai 1854 sur les brevets d'invention;

Vu le procès-verbal dressé le 10 mars 1981 à 14 h 50

au Service de la Propriété Industrielle;

ARRÊTE :

Article 1. — Il est délivré à la Sté dite : POLITECHNIKA IPARI SZOVETKEZET

Kosztá József utca, 21, Budapest (Hongrie)

repr. par le Cabinet Bede à Bruxelles

un brevet d'importation pour : Joutet logique spatial

qu'elle déclare avoir été breveté en Hongrie le 30 janvier 1975 sous le n° 170.062 au nom de E. Rubik dont elle est l'ayant cause.

Article 2. — Ce brevet lui est délivré sans examen préalable, à ses risques et périls, sans garantie soit de la réalité, de la nouveauté ou du mérite de l'invention, soit de l'exactitude de la description, et sans préjudice du droit des tiers.

Au présent arrêté demeurent joint un des doubles de la spécification de l'invention (mémoire descriptif) et éventuellement destinés, signés par l'intéressé et déposés à l'appui de sa demande de brevet.

Bruxelles, le 31 MARS 1981.

PAR DÉLÉGATION SPÉCIALE:

Le Directeur

L. SALPÊTEUR

POLITECHNIKA Ipari Szövetkezet 887875

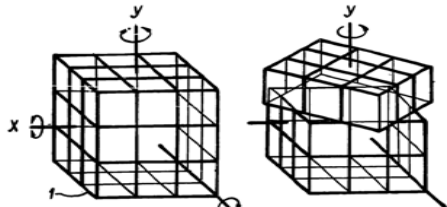


Fig. 1

Fig. 2

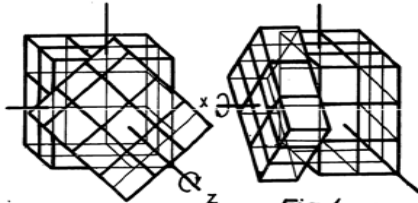


Fig. 3

Fig. 4

Bruxelles, le 10 mars 1981
P.Fon. Politechnika Ipari Szövetkezet
P.Fon. CABINET BEDE, s. v. g. Schoubbeek

POLITECHNIKA Ipari Szövetkezet 887875

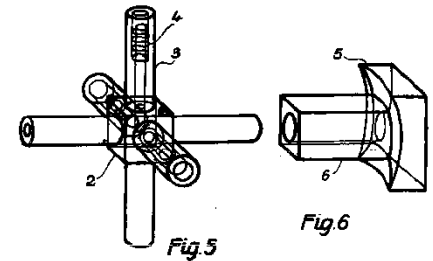


Fig. 5

Fig. 6

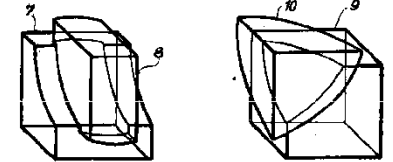


Fig. 7

Fig. 8

Bruxelles, le 10 mars 1981
P.Fon. Politechnika Ipari Szövetkezet
P.Fon. CABINET BEDE, s. v. g. Schoubbeek

The patent system



■ *Priority Right*

- time-limited right, triggered by the first filing of an application for a patent, an industrial design or a trademark respectively. The priority right allows the claimant to file a subsequent application in another country for the same invention, design, or trademark effective as of the date of filing the first application



The Patent System

- Local patent application followed within 12 months by multiple foreign applications claiming priority under Paris Convention:
- multiple formality requirements/searches/publication
- multiple examination and prosecution of applications
- translations and national fees required at 12 months

Actual cost of filing national (US\$ 10,000 to 20,000...)

Example 1: **Computer implemented method for facilitating certain functionality via the Internet**

Patent search with detailed patentability assessment = \$2,400

Provisional patent application prepared and filed = \$3,000

Filing fee to the USPTO = \$110

Nonprovisional patent application based off provisional filing = \$10,000

Filing fee to the USPTO for nonprovisional patent application = \$1,200

Professional illustrations for nonprovisional patent application = \$400

TOTAL COST through filing nonprovisional patent application = **\$17,110.00** (if provisional patent application is skipped the cost would be \$110 less)

Example 2: **Consumer electronics product**

Patent search with detailed patentability assessment = \$2,000

Provisional patent application prepared and filed = \$2,000

Filing fee to the USPTO = \$110

Nonprovisional patent application based off provisional filing = \$7,500

Filing fee to the USPTO for nonprovisional patent application = \$800

Professional illustrations for nonprovisional patent application = \$400

TOTAL COST through filing nonprovisional patent application = **\$12,810** (if provisional patent application is skipped the cost would be \$110 less)

Example 3: **Mechanical tool**

Patent search with detailed patentability assessment = \$1,600

Provisional patent application prepared and filed = \$1,500

Filing fee to the USPTO = \$110

Nonprovisional patent application based off provisional filing = \$6,500

Filing fee to the USPTO for nonprovisional patent application = \$600

Professional illustrations for nonprovisional patent application = \$400

TOTAL COST through filing nonprovisional patent application = **\$10,710** (if provisional patent application is skipped the cost would be \$110 less)

The problem

- Where do I get this money from...?



International patent is a misnomer



**There is no such thing
as a global patent**

**There is no court
with global jurisdiction**

There is no such animal as a world patent

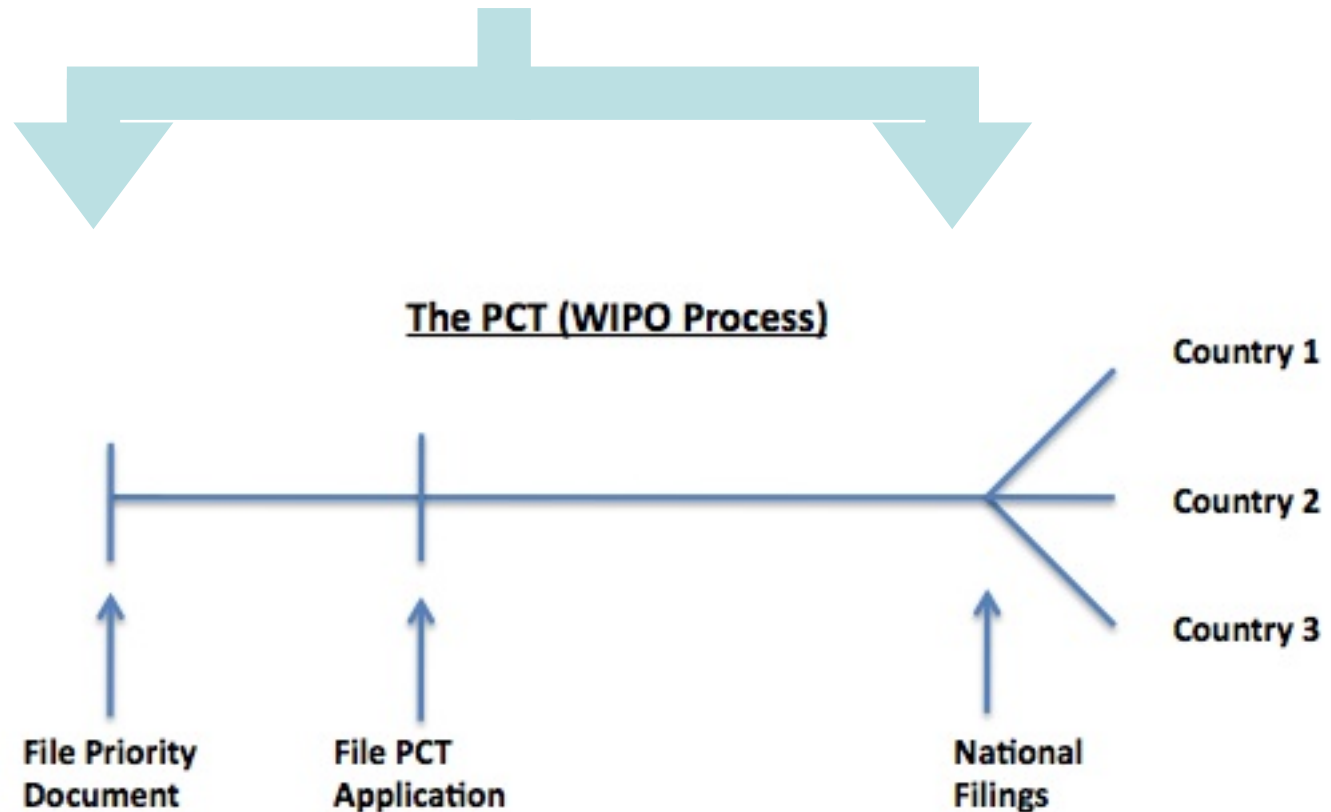
(12) INTERNATIONAL APPLICATION PUBLISHED UNDER THE PATENT COOPERATION TREATY (PCT)

(19) World Intellectual Property Organization
International Bureau



(10) International Publication Number
WO 2011/102814 A1

(43) International Publication Date
25 August 2011 (25.08.2011)

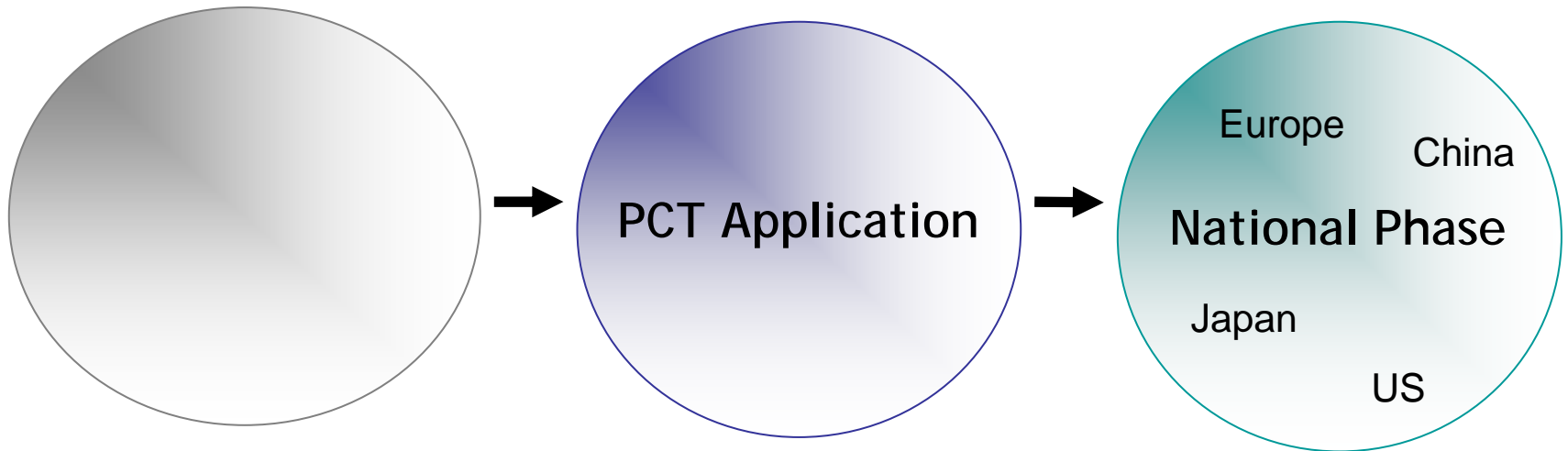


PCT System (Patent Cooperation System)

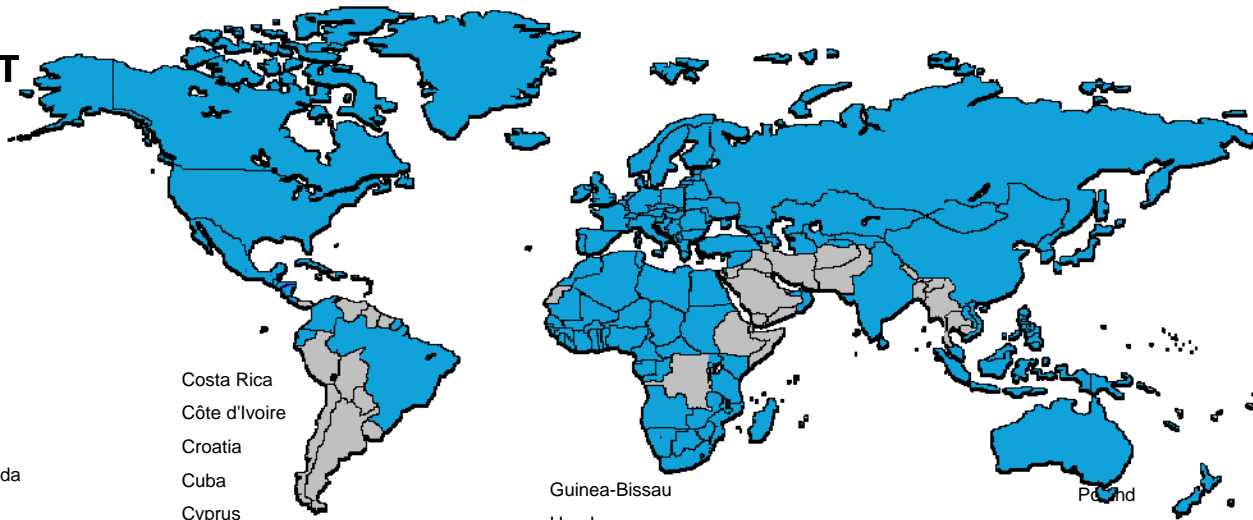
0 Months

12 Months

18 Months



The PCT System



144 PCT States

- St. Kitts and Nevis
- Sweden
- Switzerland
- Syrian Arab Republic
- Tajikistan
- Thailand (24 Dec. 2009)**
- The former Yugoslav Republic of Macedonia

- Albania
- Algeria
- Angola
- Antigua and Barbuda
- Armenia
- Australia
- Austria
- Azerbaijan
- Bahrain
- Barbados
- Belarus
- Belgium
- Belize
- Benin
- Bosnia and Herzegovina
- Botswana
- Brazil
- Bulgaria
- Burkina Faso
- Cameroon
- Canada
- Central African Republic
- Chad
- China
- Colombia
- Comoros
- Congo

- Costa Rica
- Côte d'Ivoire
- Croatia
- Cuba
- Cyprus
- Czech Republic
- Democratic People's Republic of Korea
- Denmark
- Dominica
- Dominican Republic
- Ecuador
- Egypt
- El Salvador
- Equatorial Guinea
- Estonia
- Finland
- France
- Gabon
- Gambia
- Georgia
- Germany
- Ghana
- Greece
- Grenada
- Guatemala
- Guinea

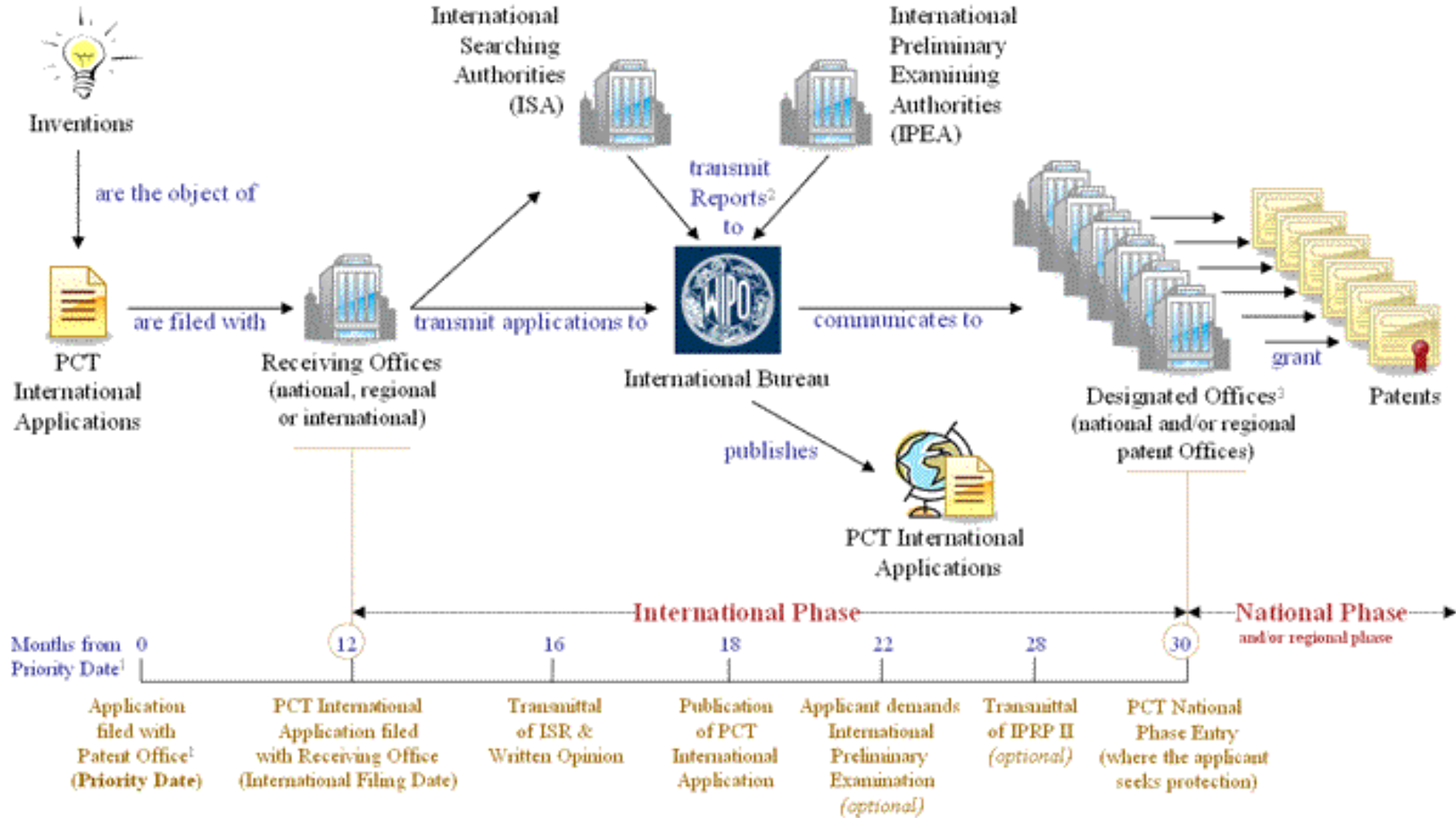
- Guinea-Bissau
- Honduras
- Hungary
- Iceland
- India
- Indonesia
- Ireland
- Israel
- Italy
- Japan
- Kazakhstan
- Kenya
- Kyrgyzstan
- Lao People's Dem Rep.
- Latvia
- Lesotho
- Liberia
- Libyan Arab Jamahiriya
- Liechtenstein
- Lithuania
- Luxembourg
- Madagascar

- Malawi
- Malaysia
- Mali
- Malta
- Mauritania
- Mexico
- Monaco
- Mongolia
- Montenegro
- Morocco
- Mozambique
- Namibia
- Netherlands
- New Zealand
- Nicaragua
- Niger
- Nigeria
- Norway
- Oman
- Papua New Guinea
- Philippines

- Poland
- Portugal
- Republic of Korea
- Republic of Moldova
- Romania
- Russian Federation
- Saint Lucia
- Saint Vincent and the Grenadines
- San Marino
- Sao Tomé e Príncipe
- Senegal
- Seychelles
- Sierra Leone
- Singapore
- Slovakia
- Slovenia
- South Africa
- Spain
- Sri Lanka
- Sudan
- Swaziland

- Togo
- Trinidad and Tobago
- Tunisia
- Turkey
- Turkmenistan
- Uganda
- Ukraine
- United Arab Emirates
- United Kingdom
- United Republic of Tanzania
- United States of America
- Uzbekistan
- Viet Nam
- Yugoslavia
- Zambia
- Zimbabwe

The PCT System



Bibliographic data

(19) World Intellectual Property
Organization
International Bureau



(43) International Publication Date
22 April 2004 (22.04.2004)

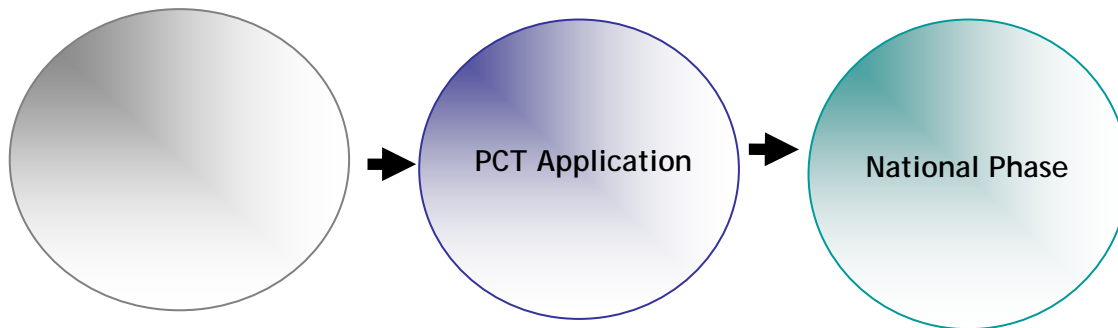
PCT

(10) International Publication Number
WO 2004/032631 A1

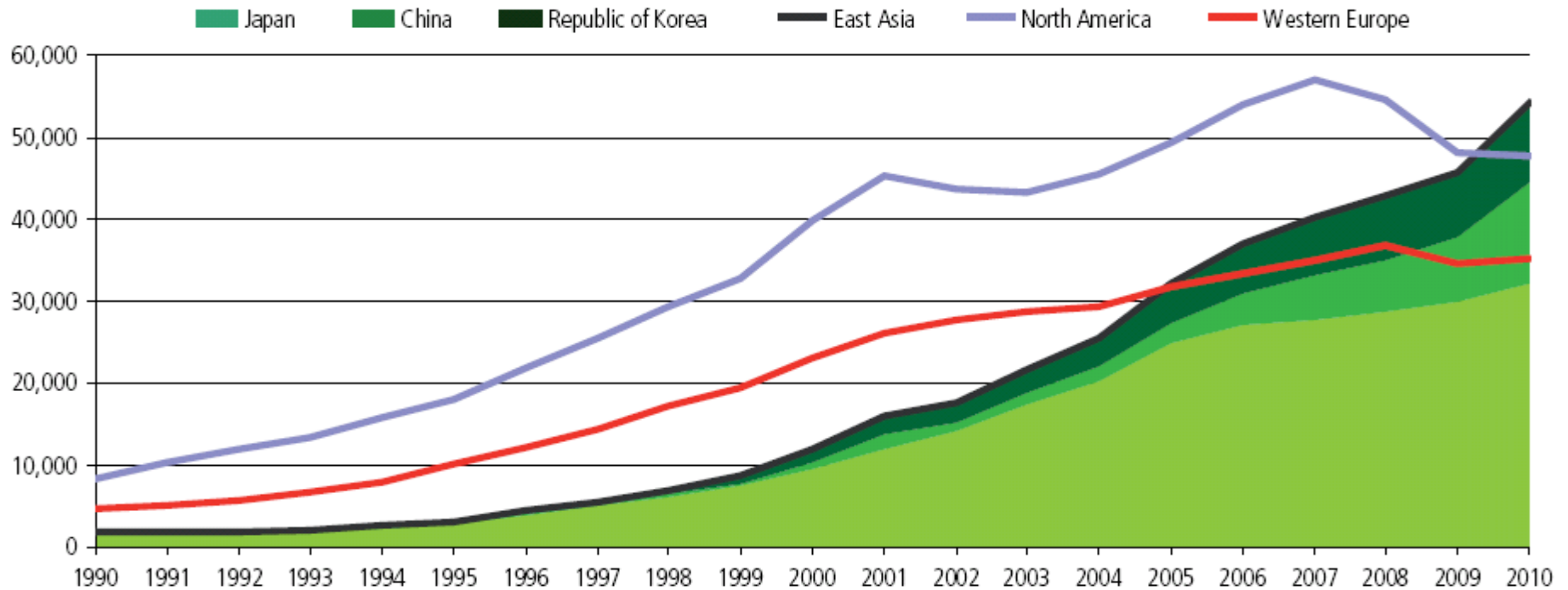
Publication date	→			←	Publication number
Classification	→	(51) International Patent Classification ⁷ : A01N 65/00	(74) Agents: BENSON, John, Everett et al. ; J.A. Kemp & Co., 14 South Square, Gray's Inn, London WC1R 5JJ (GB).		
Application number	→	(21) International Application Number: PCT/GB2003/004367	(81) Designated States (national): AE, AG, AL, AM, AT, AU, AZ, BA, BB, BG, BR, BY, BZ, CA, CH, CN, CO, CR, CU, CZ, DE, DK, DM, DZ, EC, EE, EG, ES, FI, GB, GD, GE, GH, GM, HR, HU, ID, IL, IN, IS, JP, KE, KG, KR, KZ, LC, LK, LR, LS, LT, LU, LV, MA, MD, MG, MK, MN, MW, MX, MZ, NI, NO, NZ, OM, PG, PH, PL, PT, RO, RU, SC, SG, SK, SL, SY, TJ, TM, TN, TR, TT, TZ, UA, UG, US, UZ, VC, VN, YU, ZA, ZM, ZW.	←	Designated states
Filing date	→	(22) International Filing Date: 10 October 2003 (10.10.2003)			
	→	(25) Filing Language: English			
	→	(26) Publication Language: English			
Priority date	→	(30) Priority Data: 0223657.8 10 October 2002 (10.10.2002) GB	(84) Designated States (regional): ARIPO patent (GH, GM, KE, LS, MW, MZ, SD, SL, SZ, TZ, UG, ZM, ZW), Eurasian patent (AM, AZ, BY, KG, KZ, MD, RU, TJ, TM), European patent (AT, BE, BG, CH, CY, CZ, DE, DK, EE, ES, FI, FR, GB, GR, HU, IE, IT, LU, MC, NL, PT, RO, SE, SI, SK, TR), OAPI patent (BF, BJ, CF, CG, CI, CM, GA, GN, GQ, GW, ML, MR, NE, SN, TD, TG).		
Applicant	→	(71) Applicant (for all designated States except MW, US): THE ETHIOPIAN AGRICULTURAL RESEARCH ORGANISATION [ET/ET]; P.O. Box 2003, Addis Ababa (ET).	Published: — with international search report — before the expiration of the time limit for amending the claims and to be republished in the event of receipt of amendments		
Inventor	→	(71) Applicant (for MW only): PITTARDS PLC [GB/GB]; Sherborne Road, Yeovil, Somerset BA21 5BA (GB).			
	→	(72) Inventor; and (75) Inventor/Applicant (for US only): KASSA, Bayoh, Tirunch [ET/ET]; The Ethiopian Agricultural Research Organisation, P.O. Box 2003, Addis Ababa (ET).	For two-letter codes and other abbreviations, refer to the "Guidance Notes on Codes and Abbreviations" appearing at the beginning of each regular issue of the PCT Gazette.		

The PCT System and its Advantages

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



Patent Filings – Worldwide



Source: WIPO Statistics Database

Patent Filings – Worldwide

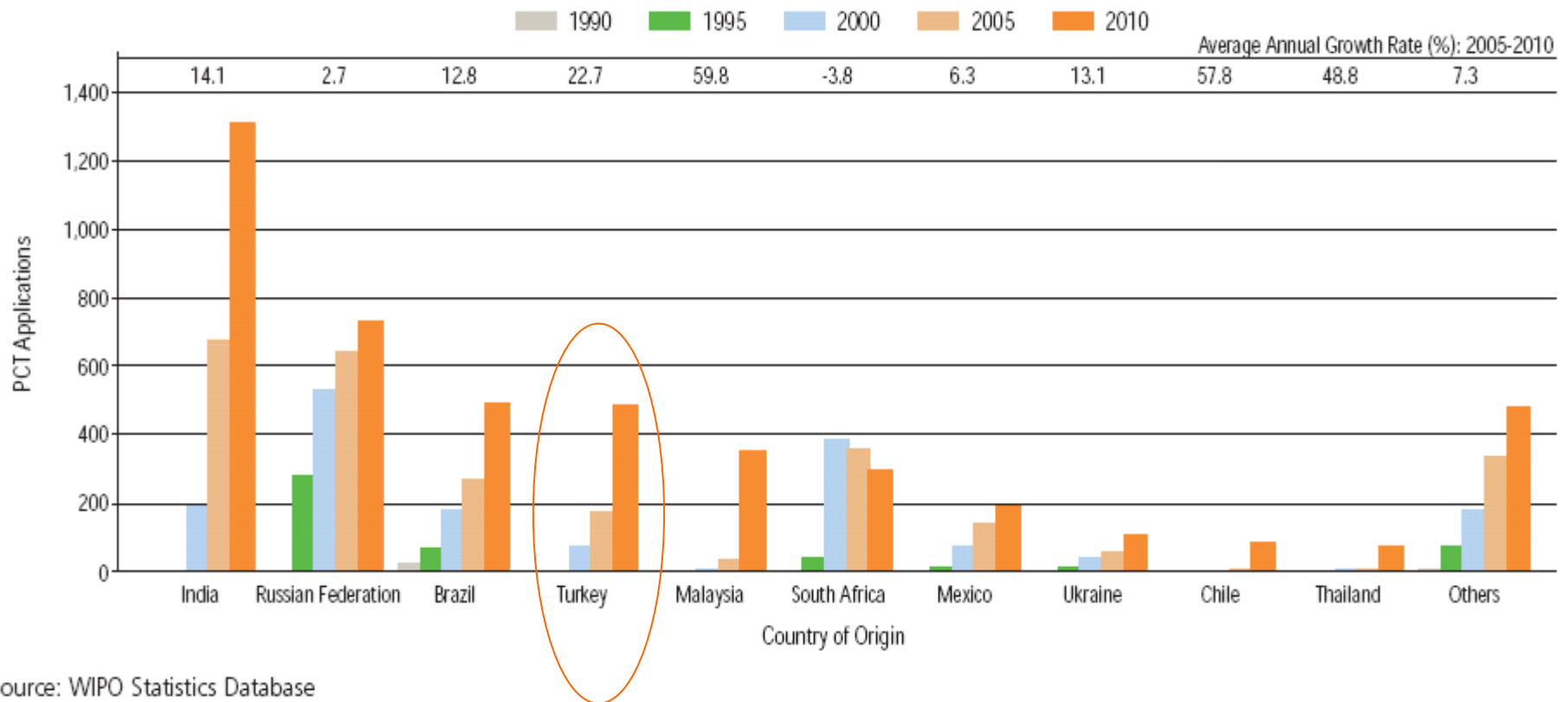
Table A.2: PCT applications by country of origin

Country of Origin	Year of Filing					2010 Share (%)	Change compared to 2009 (%)
	2006	2007	2008	2009	2010		
United States of America	51,280	54,043	51,638	45,617	44,890	27.3	1.6
Japan	27,025	27,143	28,760	29,802	32,180	19.6	8.0
Germany	16,736	17,821	18,855	16,797	17,358	10.7	4.5
China	3,942	5,455	6,120	7,900	12,295	7.5	55.6
Republic of Korea	5,945	7,064	7,899	8,035	9,668	5.9	20.3
France	6,256	6,560	7,072	7,237	7,288	4.4	0.7
United Kingdom	5,097	5,542	5,466	5,044	4,908	3.0	-2.7
Netherlands	4,553	4,433	4,363	4,462	4,078	2.5	-8.6
Switzerland	3,521	3,833	3,799	3,671	3,728	2.3	1.6
Sweden	3,336	3,655	4,137	3,567	3,314	2.0	-7.1
Canada	2,575	2,879	2,976	2,527	2,721	1.7	7.7
Italy	2,598	2,946	2,883	2,652	2,658	1.6	0.2
Finland	1,846	2,009	2,214	2,123	2,145	1.3	1.0
Australia	1,996	2,052	1,938	1,740	1,776	1.1	2.1
Spain	1,204	1,297	1,390	1,564	1,752	1.1	12.0
Israel	1,593	1,737	1,899	1,555	1,488	0.9	-4.3
India	833	902	1,072	961	1,313	0.8	36.6
Denmark	1,158	1,151	1,357	1,341	1,173	0.7	-12.7
Austria	911	1,009	953	1,024	1,140	0.7	11.3
Belgium	1,030	1,124	1,135	1,008	1,057	0.6	4.9
All others	6,006	6,672	7,308	6,763	7,170	4.4	5.9
Total	149,541	159,927	163,234	155,398	164,300	100.0	5.7

Source: WIPO Statistics Database

Patent Filings – Worldwide

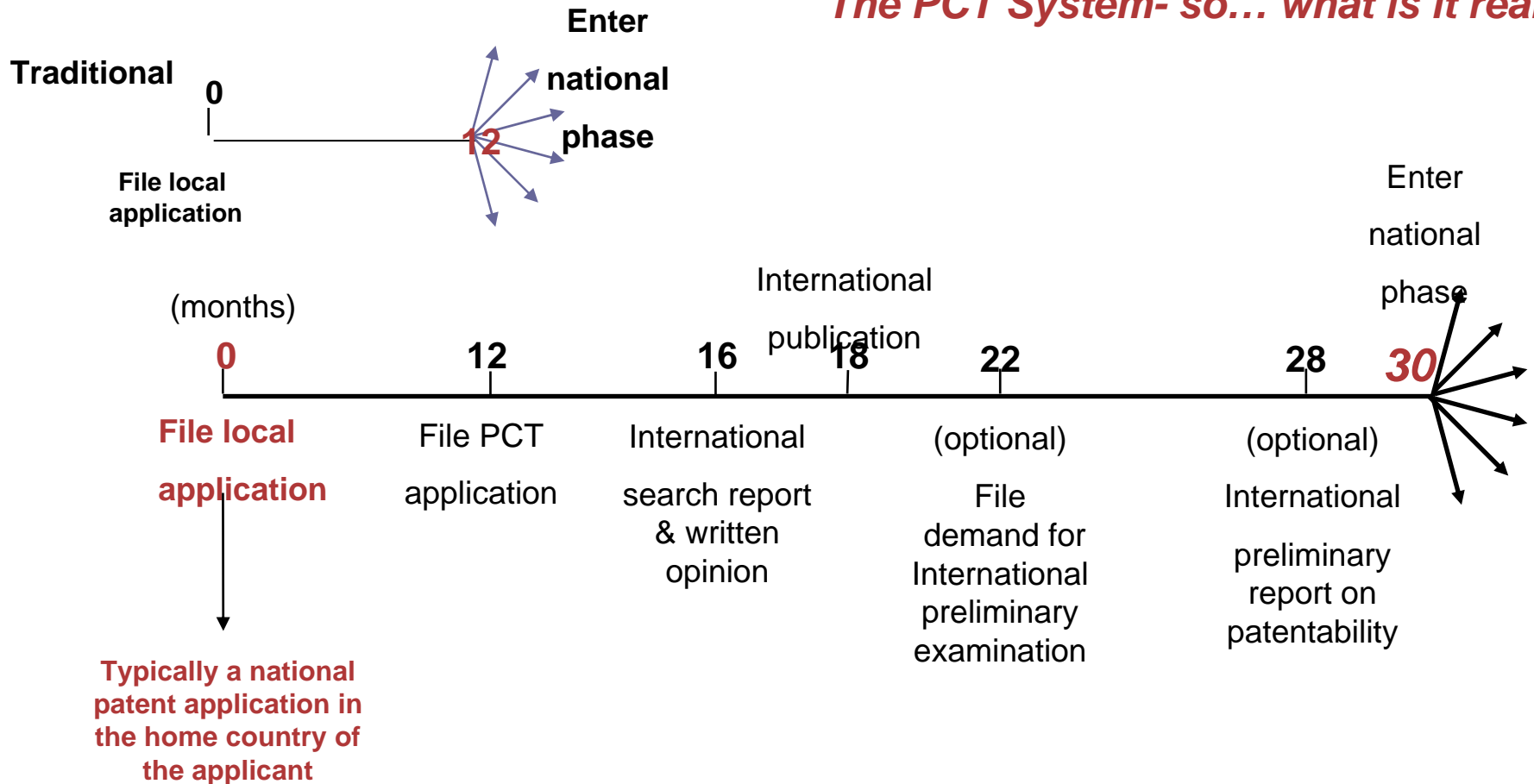
Figure A.5: Top 10 middle income countries: PCT applications



Source: WIPO Statistics Database

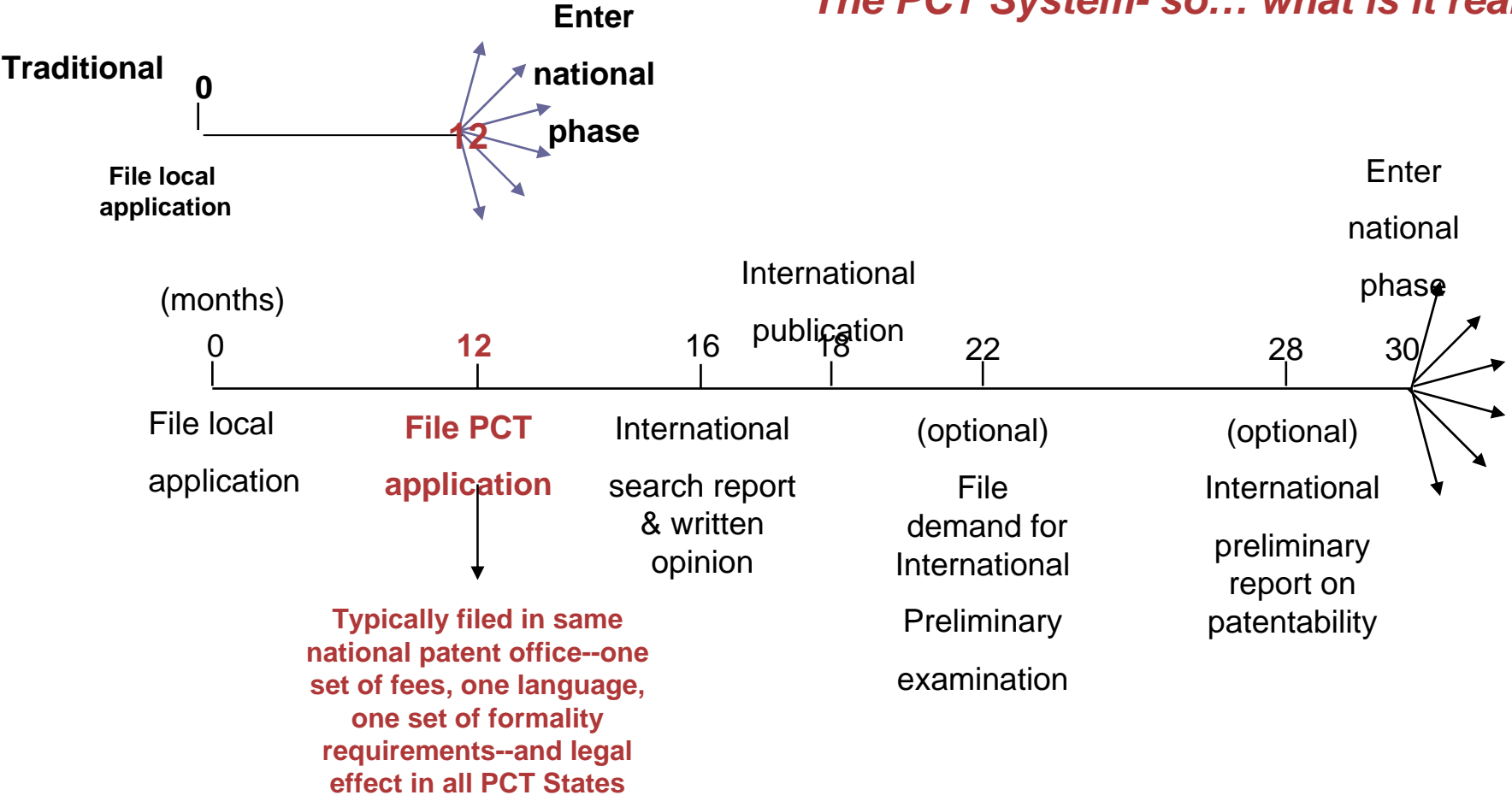
The PCT System

The PCT System- so... what is it really?



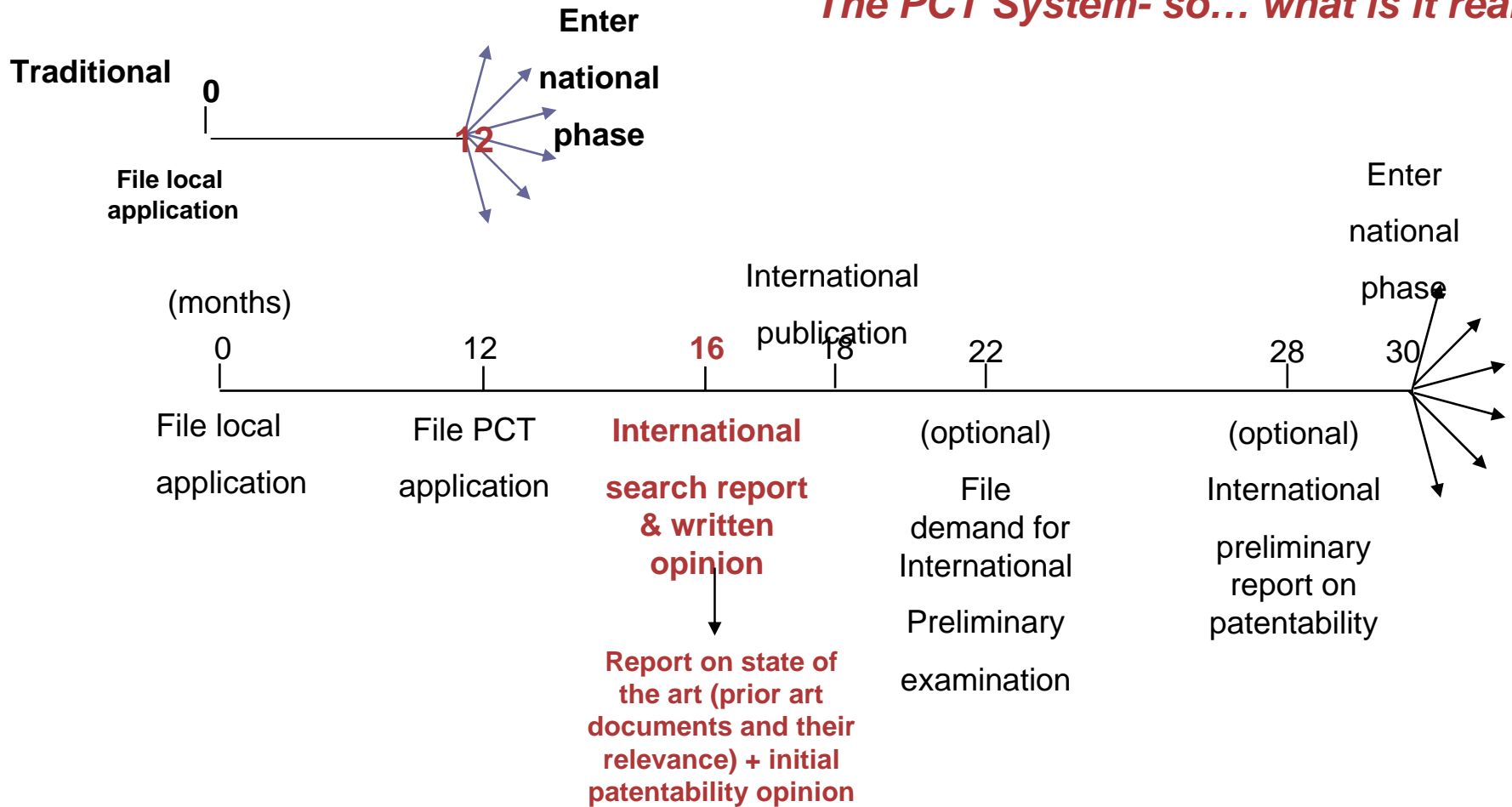
The PCT System

The PCT System- so... what is it really?



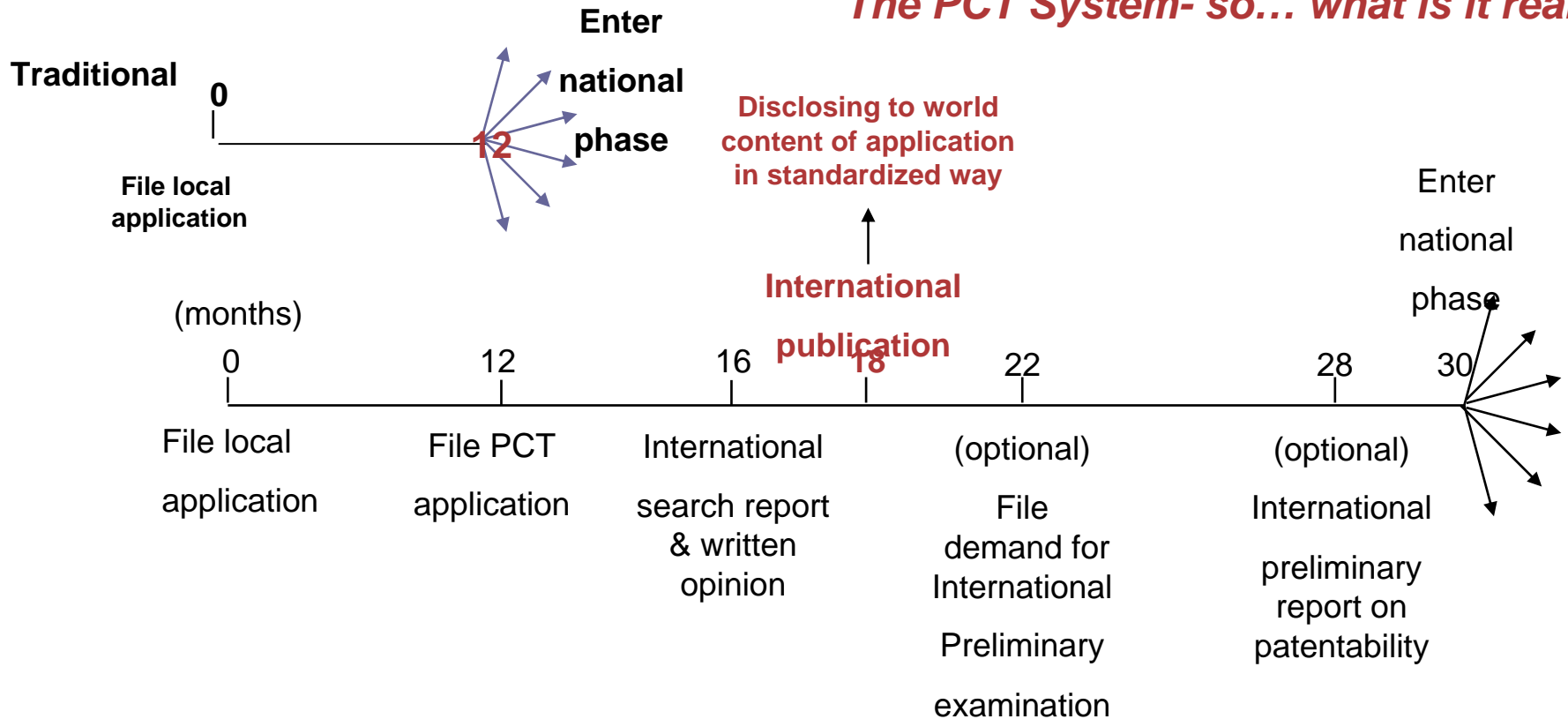
The PCT System

The PCT System- so... what is it really?



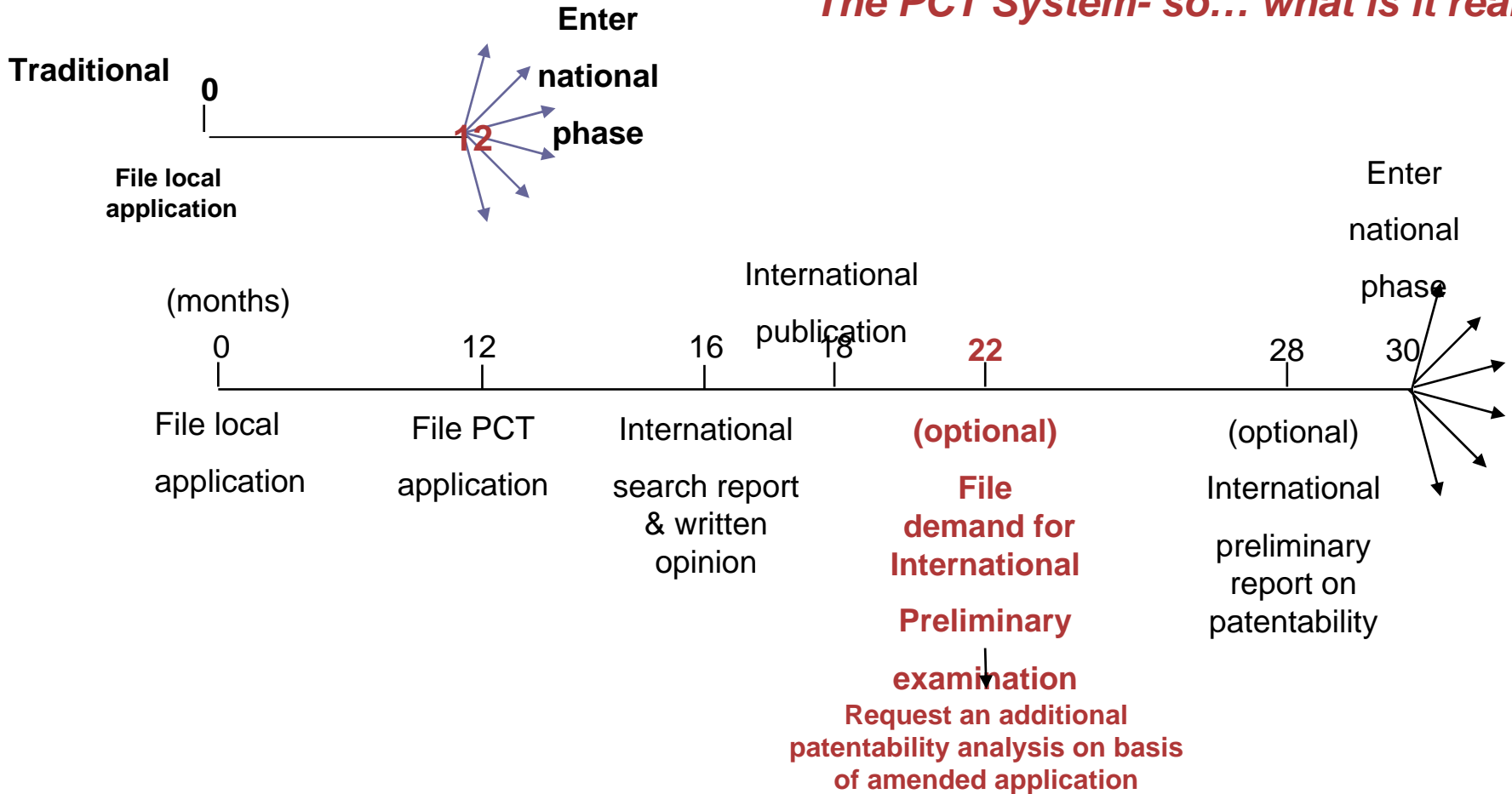
The PCT System

The PCT System- so... what is it really?



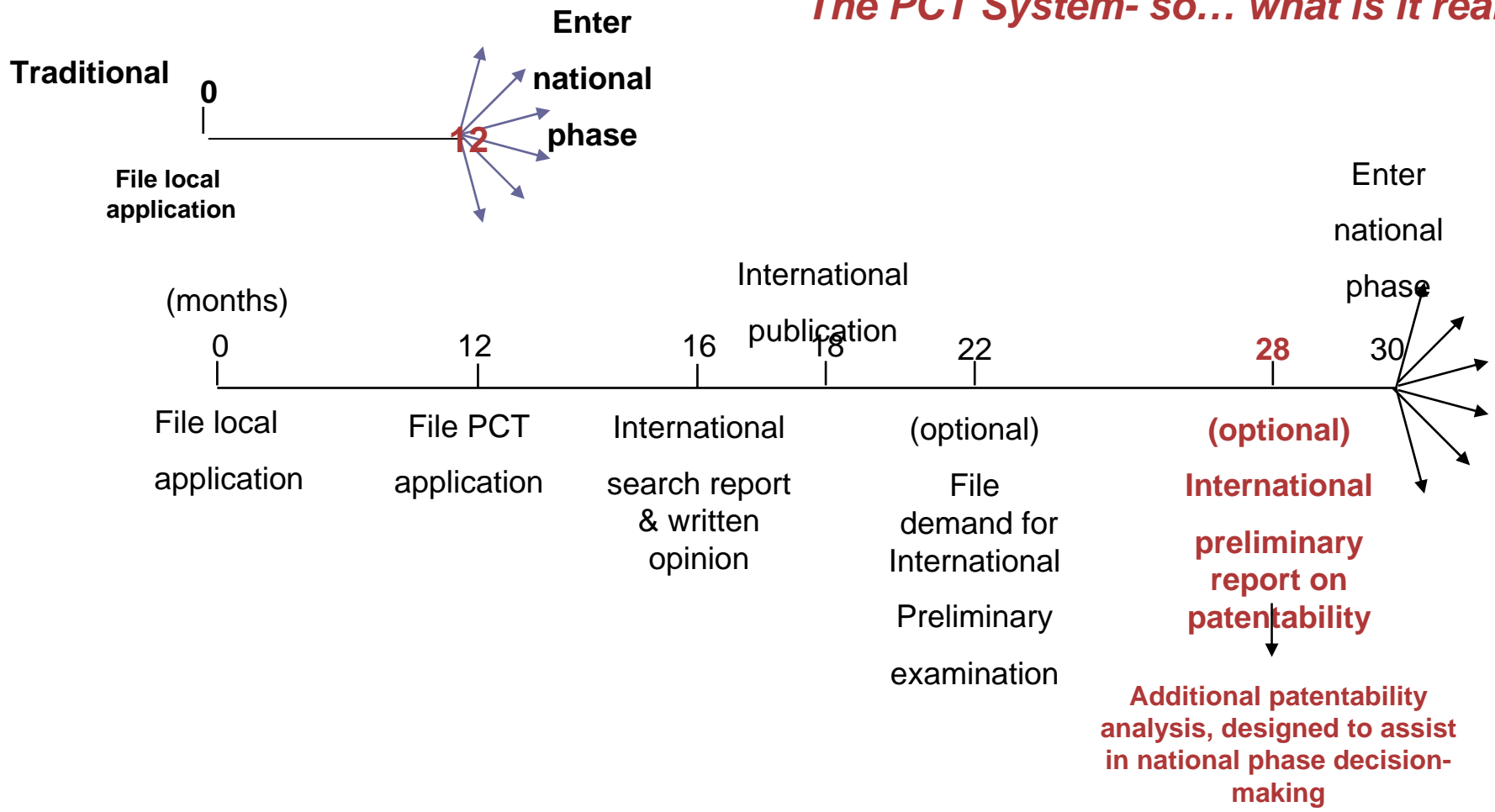
The PCT System

The PCT System- so... what is it really?

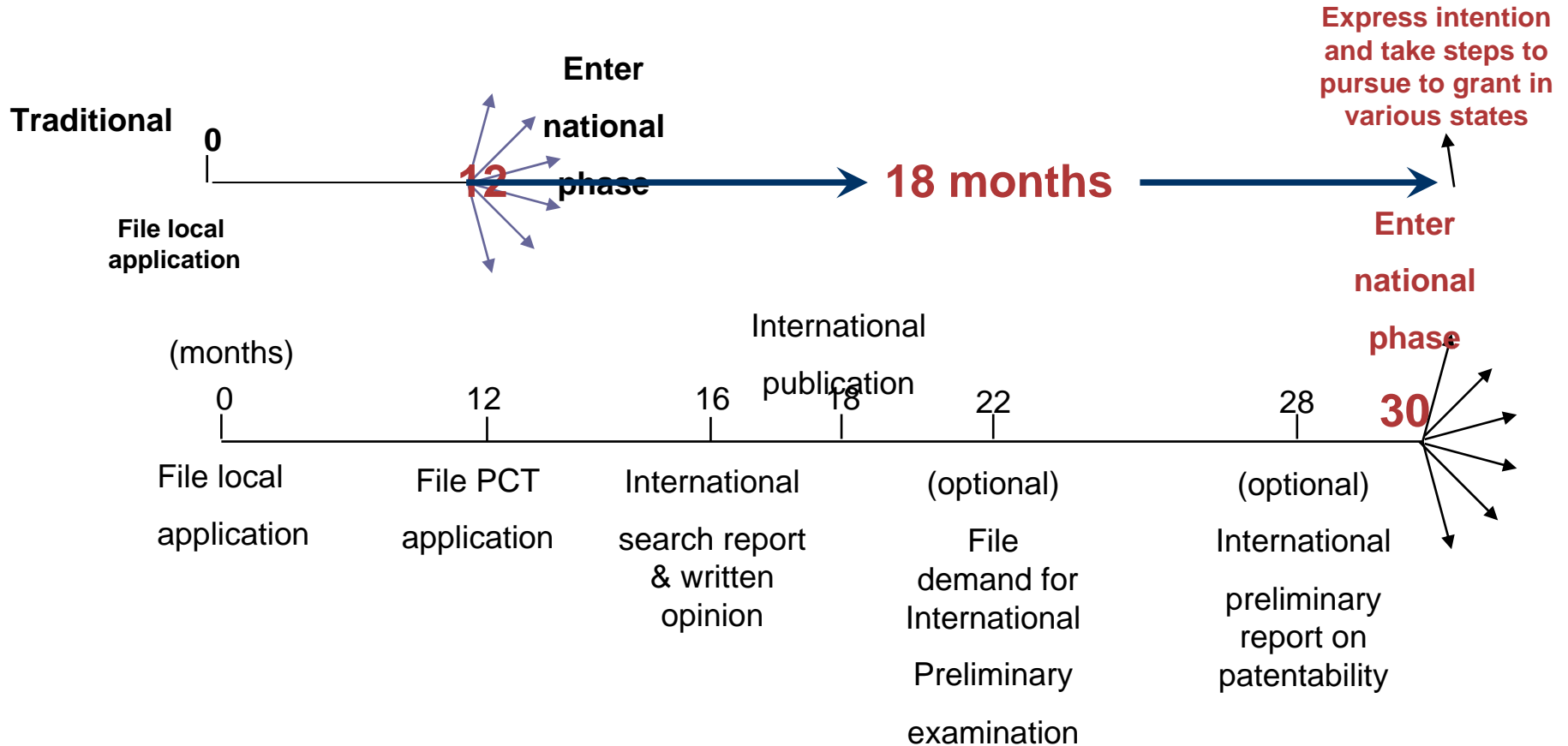


The PCT System

The PCT System- so... what is it really?



The PCT System



The PCT System

- Only **one application** filed, containing, by default, the designation of all States (for every kind of protection available) and usual priority claim(s)
- Has the effect of a regular national filing (including establishment of a priority date) in each designated State: the international filing date is the filing date in each designated State
- Filed in **one language**
- Filed with **one office-** Receiving Office ('RO')
- One set of formality requirements
- **Delays national processing until 30 months** from the priority date

The PCT System – benefits for uncertainty

- Keep options open by making all possible designations for all types of protection
- Various possibilities for withdrawal
- International publication can be prevented or postponed until as late as 15 days before the actual publication date – conditional withdrawal possible
- Further expenses can be avoided simply by no longer prosecuting the application or not entering the national phase
- Amendments made during the international phase have effect in all designated/elected States
- More time for better quality translation for the national phase
- Better planning of the expenditures for the national phase

The PCT System

Brings the world within reach



How?

PCT application = Legal effect of a regular national patent application in all PCT States

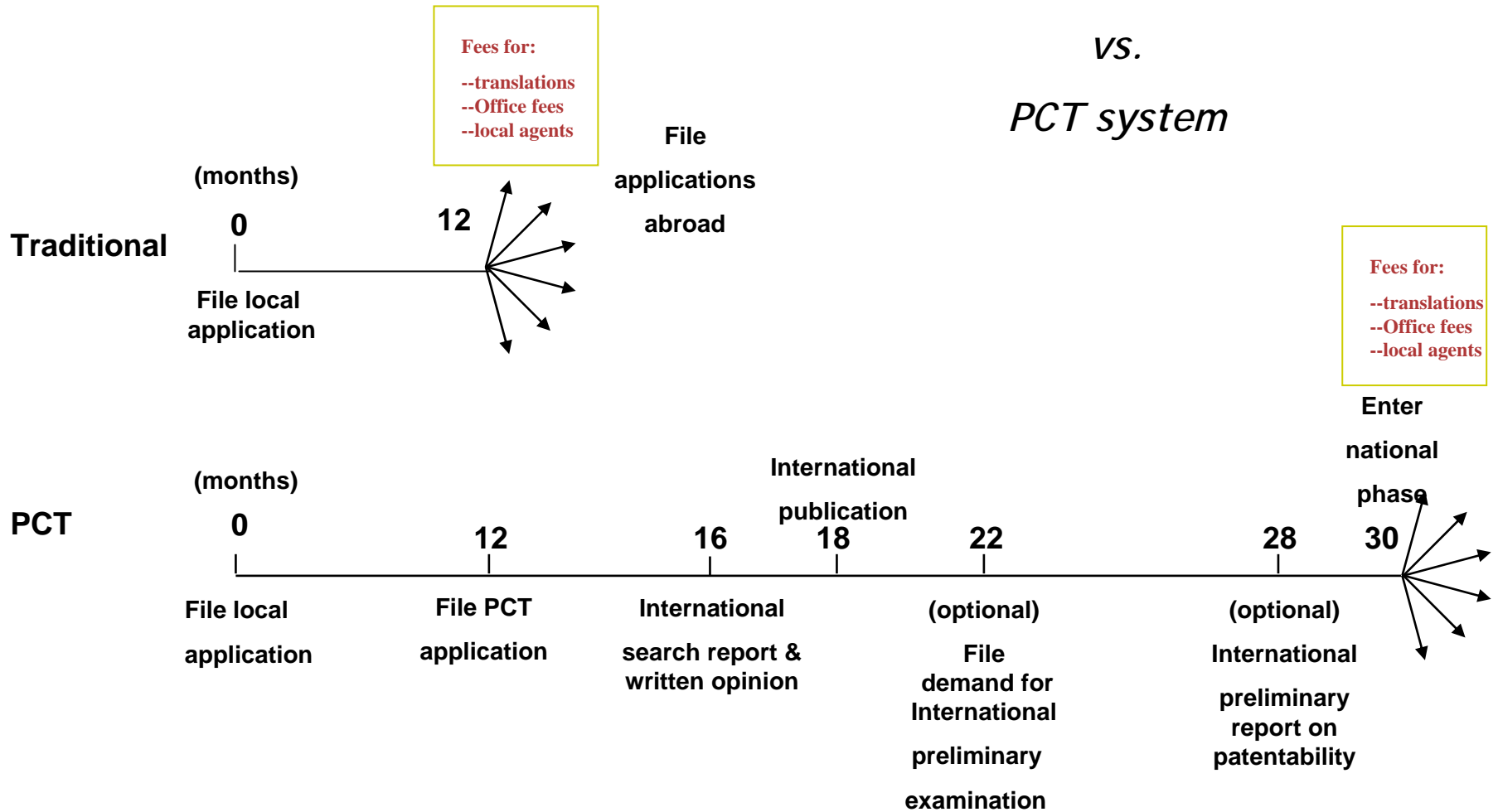
The PCT System

When are these costs incurred?

Traditional patent system

VS.

PCT system



The PCT System

PCT Costs - in perspective

How do PCT fees fit into the overall costs of patenting?

July 2007 calculation of estimated percentage which the PCT filing fees represent in the overall budget of a PCT applicant seeking patents in several countries (using “IP Global Estimator®”^{*} software):

hypothetical PCT application filing was:

filed in the USPTO as RO by a US large-entity applicant contained 46 pages and 12 claims (3 independent) International Search and Preliminary Examination to be carried out by the EPO entry into national/regional stage in the US, Canada, Australia, Mexico, Japan, and the EPO (and in the EPO designating France, Germany, Italy, Netherlands, Sweden, and the UK)

^{*}“IP Global Estimator software ®” (www.globalip.com) is a useful tool for calculating overall patent related expenses, including fees and annuities, translations, photocopying and other misc. costs, as well as minimum attorney fees that are based on standard country-by-country charges for the basic prosecution of a straightforward application



The PCT System

PCT Costs - in perspective

According to IP Global Estimator, the total cost of hypothetical application (RO/US, ISA/EP, 46 pages/12 claims w/3 independent, national phase in AU, CA, EPO, JP, MX, US, and EP validation in DE, FR, GB, IT, NL & SE, + maintenance fees--from filing until expiration of 12 national phase patents at 20 years from the filing date) would be **USD \$232,742**

The PCT filing fees, including the international search by the EPO, (total: USD \$3,637) represented **1.6%** of what the PCT applicant could expect to pay throughout the full life of this patent family

If the payment of annual maintenance fees is eliminated from the above calculation, the total amount that the applicant would expect to pay to see his/her patents granted is reduced to USD **\$86,398**. PCT filing fees would then represent **4.2%** of this amount

[Estimate date: July 1, 2007]

The PCT System

What does the applicant do with the information from the ISR, ISO and IPRP Ch. II?

a basis for patenting decisions:

- **whether to enter the national phase**
- **where to enter the national phase**

P&G:

Based on the information received during both Chapters I and II, the Procter & Gamble company found that it:

- **abandoned 20% of PCT filings at national phase** (did not enter national phase at all anywhere)
- when it did enter national phase, it did so in **only 70% of the States** it had originally intended to patent in

PATENTSCOPE[®] Documents

3. (WO2008128939) OIL-IN-WATER EMULSION INFLUENZA VACCINE

PCT Biblio. Data	National Phase	Notices	Documents
International Application Status ⓘ			
Date	Title	View	Download
12.11.2009	International Application Status Report	HTML , PDF (1p.)	PDF (1p.) , XML
Published International Application			
Date	Title	View	Download
30.10.2008	Initial Publication with ISR (A1 44/2008)	HTML , PDF (169p.)	PDF (169p.) , ZIP(XML + TIFFs)
30.10.2008	Listas de secuencias	PDF (0p.)	PDF (0p.) , ZIP(XML + TIFFs)
30.10.2008	Declaración	PDF (2p.)	PDF (2p.) , ZIP(XML + TIFFs)
30.10.2008	Declaración	PDF (1p.)	PDF (1p.) , ZIP(XML + TIFFs)
30.10.2008	Declaración	PDF (1p.)	PDF (1p.) , ZIP(XML + TIFFs)
Related Documents on file at the International Bureau			
Date	Title	View	Download
20.10.2009	Written Opinion of the International Search Authority	PDF (9p.)	PDF (9p.) , ZIP(XML + TIFFs)
20.10.2009	International Preliminary Report on Patentability Chapter II (IPEA/409)	PDF (15p.)	PDF (15p.) , ZIP(XML + TIFFs)
30.10.2008	GB 0711357.4 12.06.2007 (Pr. Doc.)	PDF (113p.)	PDF (113p.) , ZIP(XML + TIFFs)
30.10.2008	GB 0707697.9 20.04.2007 (Pr. Doc.)	PDF (113p.)	PDF (113p.) , ZIP(XML + TIFFs)
30.10.2008	GB 0712062.9 21.06.2007 (Pr. Doc.)	PDF (83p.)	PDF (83p.) , ZIP(XML + TIFFs)
30.10.2008	EP PCT/EP2007/060743 10.10.2007 (Pr. Doc.)	PDF (91p.)	PDF (91p.) , ZIP(XML + TIFFs)
30.10.2008	GB 0724651.5 18.12.2007 (Pr. Doc.)	PDF (123p.)	PDF (123p.) , ZIP(XML + TIFFs)
30.10.2008	Notification Concerning Submission or Transmittal of Priority Document (IB/304)	PDF (1p.)	PDF (1p.) , ZIP(XML + TIFFs)
30.10.2008	Request form (RO/101)	PDF (5p.)	PDF (5p.) , ZIP(XML + TIFFs)

For all collections:

- Published Documents

For PCT:

- Search reports (prior art)
- Written opinions and preliminary examination reports (patentability)
- Most documents from the PCT international phase

WIPO's PATENTSCOPE[®] Search Service[®]

- WIPO's Patent Information Portal
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- National patent collections from 11 participating offices
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