

GUIDELINES FOR THE CUSTOMIZATION
OF THE PATENT GUIDE
INVENTING THE FUTURE - AN INTRODUCTION TO PATENTS FOR
SMALL AND MEDIUM-SIZED ENTERPRISES

Overall objective

- The main objective of customizing the guide is to make it suitable for providing specific guidance to SMEs based on national patent law, regulations, practices, forms, fees, institutions, case law, court decisions, and the specific administrative procedures available in each country.
- While doing so, it is important to include illustrations, examples and case studies from the country for which the guide is being customized. Authorization for the images included in the international edition of the guide have only been granted for that specific edition. Therefore, customized guides should include different examples and images or, if the same images are included, authorization should be requested directly to the relevant companies/inventors.
- The guide is to be translated into the local language(s).

General remarks

- The words “your national patent office” should be replaced every time they appear with the actual name of the industrial property (IP) office in the country concerned.
- The words “your country” should be replaced every time they appear with the name of the country.

SECTION 1: PATENTS

What is a Patent?

- Provide the exact definition as contained in your national law.
- Adapt the section taking into account any differences there may be in your country

What is an invention?

- This section probably does not require customization

Why should you consider patenting your inventions?

- This section probably does not require customization

What other legal instruments are available for protecting your products?

- This section needs to be adapted depending on the IP rights that are available in each country. For each IP right a definition that better reflects the national definition may be used.
- Are utility models available in your country? If not, reference to utility models could be taken out.
- Is there legislation on the protection of confidential information or trade secrets? What are the main criteria for confidential business information to benefit from protection?
- Trademarks: it would be useful to include the web address of the institution in charge of registering trademarks if this differs from the institution in charge of granting patents.
- Industrial designs: replace with “design patents” or “industrial designs and models” if this is the correct wording in your country. If unregistered designs are also protected in your country, this should also be included as a separate IP right. In addition, include the web address of the institution in charge of registering trademarks if this differs from the institution in charge of granting patents.
- Copyright: it would be useful to provide the web address of the copyright registry if there is one.
- Does your country provide a *sui generis* system for the protection of new plant varieties? If so, the web address of the registry could be included. If not, reference to this could be taken out.
- Does your country offer protection for the layout-design (or topography) of integrated circuits? If not, reference to this could be taken out.

Patents versus secrecy

- Indicate under what legislation are trade secrets protected in your country and check the rest of the box to see if there is anything that is inconsistent with national law and practice.

What can be patented?

- This question, as well as subsequent ones, should be adapted if the patentability requirements are different from those stated in the international edition of the guide.

Utility Models

- Are utility models or short term patents (by whatever name they may be known) available in your country?
- What are the conditions for their protection? Is it required to fulfil an “inventive step” or non-obviousness requirement?
- Are utility models granted faster than patents? If so, how much time is taken on average?

- Are fees for utility model grant lower than for patents?
- What is the duration of utility models? How does it compare to the duration of patents?
- Are utility models limited to some fields of technology? Are they available for processes or only for products?
- Can a utility model application be converted into a patent application?
- Is it possible to apply for a utility model and a patent for the same invention?

What is patentable subject matter?

- Include the list of non-patentable subject matter provided for in your national legislation.

Protecting Computer Software

- Is computer software protectable by patents in your country? Are there any specific conditions? Is it included as unpatentable subject matter? Is there a distinction (in terms of their patentability) between computer software and computer-implemented inventions?
- Is computer software protected under copyright law? Is there a copyright registry and, if so, what is the address?

How is an invention judged to be new or novel?

- What is the definition of prior art in your country? What is included in the prior art?
- How is “secret prior art” treated in your country?

When is an invention considered to involve an inventive step?

- Explain the non-obviousness (or inventive step) requirement in accordance with your national legislation.
- Do national courts consider secondary objective evidence of non-obviousness when assessing the validity of a patent? If so, consider summarizing some of the factors that may be considered to be secondary objective evidence of non-obviousness.

What is meant by “capable of industrial application”?

- Explain this requirement in accordance with your national legislation.
- Has the utility requirement become important for examining biotechnology-related applications in your country?

What is the disclosure requirement?

- Is this considered to be a patentability requirement in your country?

- Does your country require the inventor to disclose the “best mode” for practicing the invention? If not, reference to this may be taken out.
- Are applicants required to deposit the microorganism if the invention relates to microorganisms? Where can the deposit be made? Is there a national institution that accepts such deposits? Reference could be made to the International Depositary Authorities (under the Budapest Treaty), a list of which is available at: <http://www.wipo.int/treaties/en/registration/budapest/index.html>

Patents in the life science

- What can be patented in your country in the field of life sciences?
- Can microorganisms be patented?
- Are there any other exclusions from patentability that relate to the life sciences?
- Can purified and isolated biological materials be patented?
- Does your country provide for a *sui generis* system for the protection of new plant varieties? Amend the text accordingly and a reference could be made to the national institution that grants such titles of protection.

What rights are granted by patents?

- State the rights that are granted in your country to patent owners. In particular, distinguish between the rights granted for process patents and those granted for product patents.
- Replace “relevant regulatory body” with the actual name of the body in charge of granting marketing approval to pharmaceutical products.

Who is an inventor and who owns the rights over a patent?

- State whether patents and patent applications in your country mention both the inventor(s) and the applicant(s).
- What is the situation in your country with inventions developed by employees? Are inventions automatically assigned to the employer? What rights does the inventor have? Is he entitled under national law to receive financial benefits/rewards for the invention? What happens when inventions are developed outside working hours? Do these rules also apply to university employees?
- Who owns the rights over an invention developed by an independent contractor?
- What happens when a patent is jointly owned by two or more companies and institutions? Can each side license/enforce it independently? Do they require the permission of the other owner(s)? Amend the text accordingly.

SECTION 2: HOW TO GET A PATENT

Where should you start?

- This section probably does not require customization

How and where can you conduct a prior art search?

- Has the national patent office made its patent database available on-line? If so, provide a link to the database. Is it free of charge?
- Does the national patent office conduct patent searches for a fee? What type of search services are provided by the national patent office? Are there any other major providers of patent information in your country?
- Include a link to the list of on-line patent databases available from the WIPO website at: www.wipo.int/ipdl/en/resources/links.jsp.

The International Patent Classification

- State whether your country applies the international patent classification. If not, reference could also be made to the classification applied in your country.

How to apply for patent protection

- Indicate whether your national patent office provides for on-line filing of patent applications. If not, reference to on-line filing may be omitted.
- Indicate whether your country provides the option of filing provisional patent applications. If not, reference to this can be omitted.

Processing an application – step by step

- Describe the full procedure for obtaining patent protection in your country.
- Does your country provide for a substantive examination of patent applications? Is it necessary for applicants to make a request for an examination to be performed?
- Are patent applications published 18 months after the filing date?
- Does the patent office provide a period for opposition by applicants? Are opposition proceedings pre-grant or post-grant? What are the time limits for oppositions to be submitted?
- It would be preferable to add a flow chart, with an outline of the procedure and the average time taken at each stage, to replace the stylized graph provided in the international edition

How much does it cost to patent an invention?

- Include a small table with the main official fees associated with patenting an invention (e.g. search fee, application fee, publication fee, maintenance or renewal fee, etc.) and amend text accordingly. Alternatively, include a link to a web page where up-to-date information on fees may be obtained.
- Indicate how costs may be affected by the number of claims or the number of pages of the patent application.
- If there are any national institutions or funds that provide grants or soft loans or any other type of assistance for patenting in the domestic market or abroad, information on this may be included here.

When should you file a patent application?

- State whether your country relies on a first-to-file system
- Are applicants allowed to make any changes to the patent application (e.g. to the description, to the claims or to both) once it has been filed? Short explanation of what types of changes are permitted may be added.
- Is your country a member of the Paris Convention, which provides for a 12-month priority period? Is it a member of the Patent Cooperation Treaty? Amend the paragraph accordingly.
- Include any other consideration that may affect the timing of filing applications in your country.

How important is it to keep an invention confidential prior to filing a patent application?

- Does national legislation provide for a grace period? If not, reference to this (as well as the following question on grace periods) can be omitted.

What is a grace period?

- If national legislation provides for a grace period, some information on its duration and types of disclosure that are covered by the grace period can be included. If national legislation does not provide for a grace period, reference may still be made to it if it is considered important for applicants to be aware that the provision exists in other countries.

Provisional patent applications

- Is it possible to file provisional patent applications in your country? If not, reference to this may be omitted. Check whether the three bullet points in the box fully reflect the way provisional patent applications work in your country.

What is the structure of a patent application?

- This part should be amended depending on the specific structure of a patent application in each country and any specific requirements.
- Information on formal rules on drawings may be included (such as information on when they are or are not required, format in which they are to be submitted, etc).
- Are there any limits as to the number of claims or independent claims that may be included in the patent application?

How long does it take to obtain patent protection?

- Even if the time required for granting a patent will vary significantly depending on field of technology, this information is very important for applicants. It is important to include information on the average time (or minimum time) required for grant.
- Does the national patent office provide a procedure for accelerated grant? Under what circumstances may companies benefit from it?

Proofreading a granted patent

- What are the procedures for correcting any mistake there may be on a granted patent?

From what date is your invention protected?

- Amend this section on the basis of national legislation. From what date is it possible for applicants to enforce their patent? Is it possible to sue infringers for any infringement that took place prior to the grant of the patent?
- Is it possible to file a patent and utility model application simultaneously in your country? If not, reference to this may be omitted.

How long does patent protection last?

- Does national legislation provide for Supplementary Protection Certificates or any other mechanism to extend the term of a patent beyond the 20 years from the filing date of the application?

Patent Pending

- Are there any requirements for marking a patented product in order to be able to enforce it?

Do you need a patent agent to file a patent application?

- State whether resident applicants are required to be represented by patent agents. State also what are the requirements for foreign (or non-resident) applicants
- Indicate who has the right to represent an applicant vis-à-vis the patent office (lawyers? Officially approved IP agents? Any other category?). If there is a list of official patent agents, a web link to the list may be provided.

Can you apply for protection of many inventions through a single application?

- A brief explanation of the unity of invention concept is required.
- Explanation of “continuation in parts” and/or divisional applications may also be included if applicable.

SECTION 3: PATENTING ABROAD

Why apply for patents abroad?

- This section probably does not require customization

When should you apply for patent protection abroad?

- The text included in the international edition of the guide assumes that countries are members of the Paris Convention and that patent applications are published 18 months after filing. If this was not the case in the country concerned, it will be necessary to amend the text accordingly.

Where should you protect your invention?

- This section probably does not require customization

How do you apply for patent protection abroad?

- Is your country a member of any of the regional protection systems? If so, additional information on the regional system of which your country is a member could be provided.
- Is your country a member of the Patent Cooperation Treaty? If not, reference to the international route can be omitted. Similarly, the box on the “Advantages of the PCT” can also be taken out.

SECTION 4: COMMERCIALIZING PATENTED TECHNOLOGY

How do you commercialize patented technology?

- This section probably does not require customization

How do you take a patented product to market?

- This section probably does not require customization

Can you sell your patent?

- Indicate whether patent assignments need to be reported to the patent office and what is the procedure for doing so.

How do you license your patent to be exploited by others?

- Indicate whether the license agreement needs to be registered with any government authority, and, if so, provide the web address of the relevant institution.

What royalty rate should you expect to receive for your patent?

- This section probably does not require customization

What is the difference between an exclusive and non-exclusive license?

- This section probably does not require customization

Should you grant an exclusive or non-exclusive license for your patent?

- This section probably does not require customization

When is the best time to license your invention?

- This section probably does not require customization

If you are interested in a competitor's patent, can you obtain permission to use it?

- This section probably does not require customization

SECTION 5: ENFORCING PATENTS

Why should you enforce your patent rights?

- This section probably does not require customization

Who is responsible for enforcing patent rights?

- This section probably does not require customization

What should you do if your patent is being used by others without your authorization?

- Indicate the role of courts, police and customs in patent matters in your country. Include reference to relevant laws, regulations, notifications, etc.
- You may make specific reference to institutions that may be of assistance in case of infringement, provide address, e-mail and/or website, if available.

- Check the rest of the text to see whether it is suitable and whether it reflects enforcement measures available in your country and amend accordingly.

Annexes

- Annex I provides a list of websites of patent offices and may remain in the customized version.
- If your country is a party to the Patent Cooperation Treaty, Annex II should contain a list of member states with a web link to the website of the PCT website for a more updated list.
- A facsimile of the national application form could be provided as Annex IV.

Additional issues

A number of issues that have not been included in the international edition that may be considered for inclusion in the customized versions include:

- Reference to any institutions that may provide funding for filing applications nationally/internationally
- Regulations on compulsory licensing
- Indication as to whether there is a research exception

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