



Identifying Inventions in the Public Domain: A Guide for Inventors and Entrepreneurs

Online
16 July
2020

Nathalie Montillot

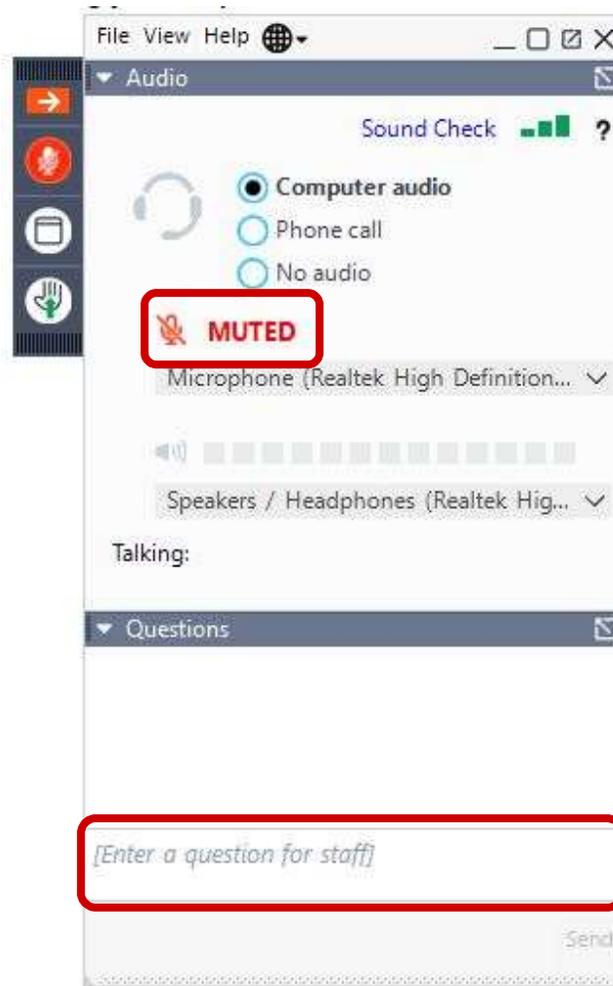
Program Officer, Technology and Innovation Support Division

Presenter

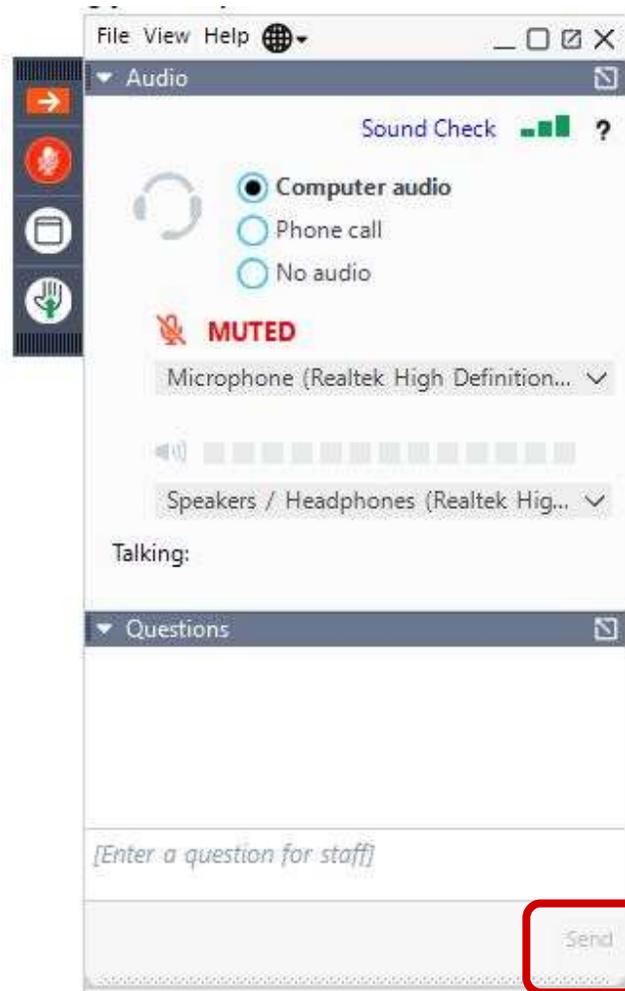


- Donna Perdue, Founder, Perdue IP Law, APC, San Diego, USA

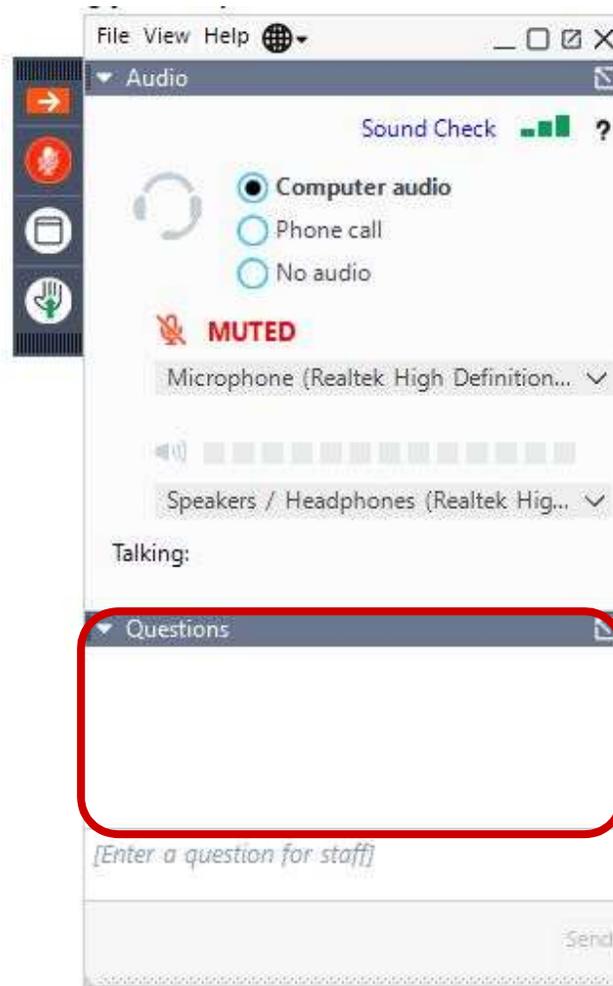
Webinar: Asking questions



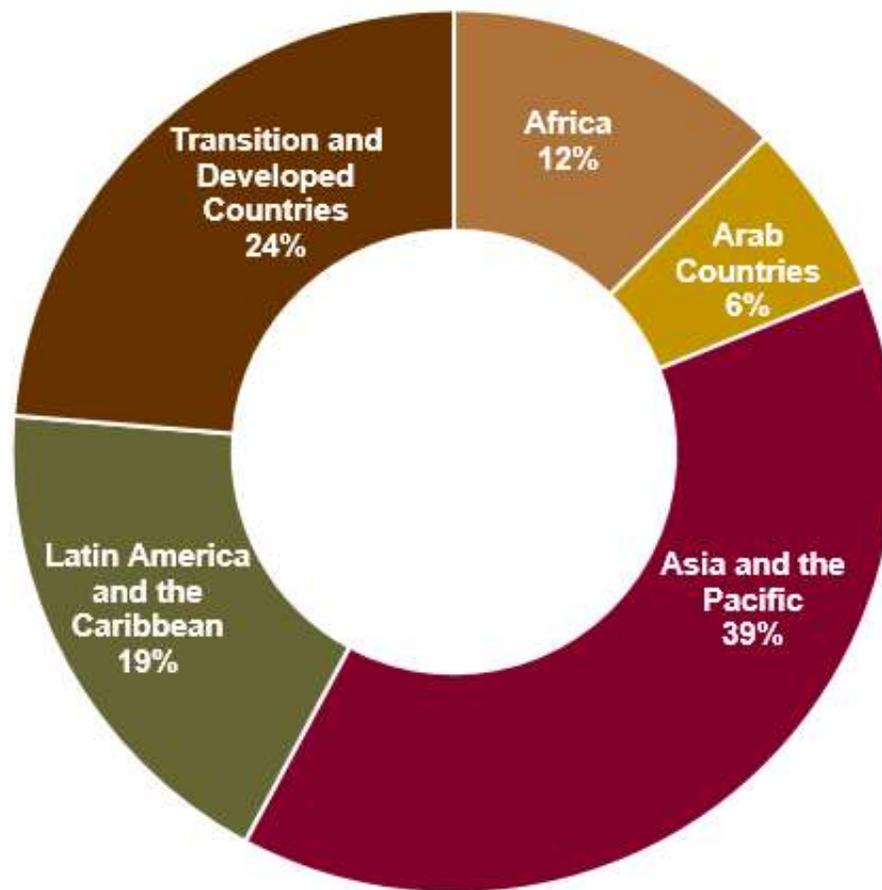
Webinar: Asking questions



Webinar: Asking questions



Regional distribution: registered participants



tisc@wipo.int

IDENTIFYING INVENTIONS IN THE PUBLIC DOMAIN: A Guide for Inventors and Entrepreneurs

Webinar: Overview of the WIPO Guide on Identifying
Inventions in the Public Domain

Presenter: Donna O. Perdue, Ph.D., J.D. ▪ Perdue IP Law, APC
July 16, 2020

IDENTIFYING INVENTIONS IN THE PUBLIC DOMAIN: A Guide for Inventors and Entrepreneurs

Purpose: Help the reader determine whether specific inventions appear to be protected by enforceable patents, or may be in the public domain

Process: Teach the tools of freedom to operate (FTO) determination

- Concepts, practical training, checklists, templates, examples
- Risk management

People: Anyone involved with or interested in IP related to inventions

- Technology and Innovation Support Center (TISC) staff
- Inventors, entrepreneurs, engineers, managers, IP professionals

Scenario: An invention, a TISC, a question

Inventor/entrepreneur has an idea for addressing a problem
= a plan for using an **invention**

INVENTION: A product or a process that provides a new way of doing something, or offers a new technical solution to a problem
(www.wipo.int/patents/en)

Inventor/entrepreneur (“client”) visits a TISC:

- Describes their plan: technical details and business information
- Asks: **Can they use the invention according to their plan? Any IP issues?**

Framing the question

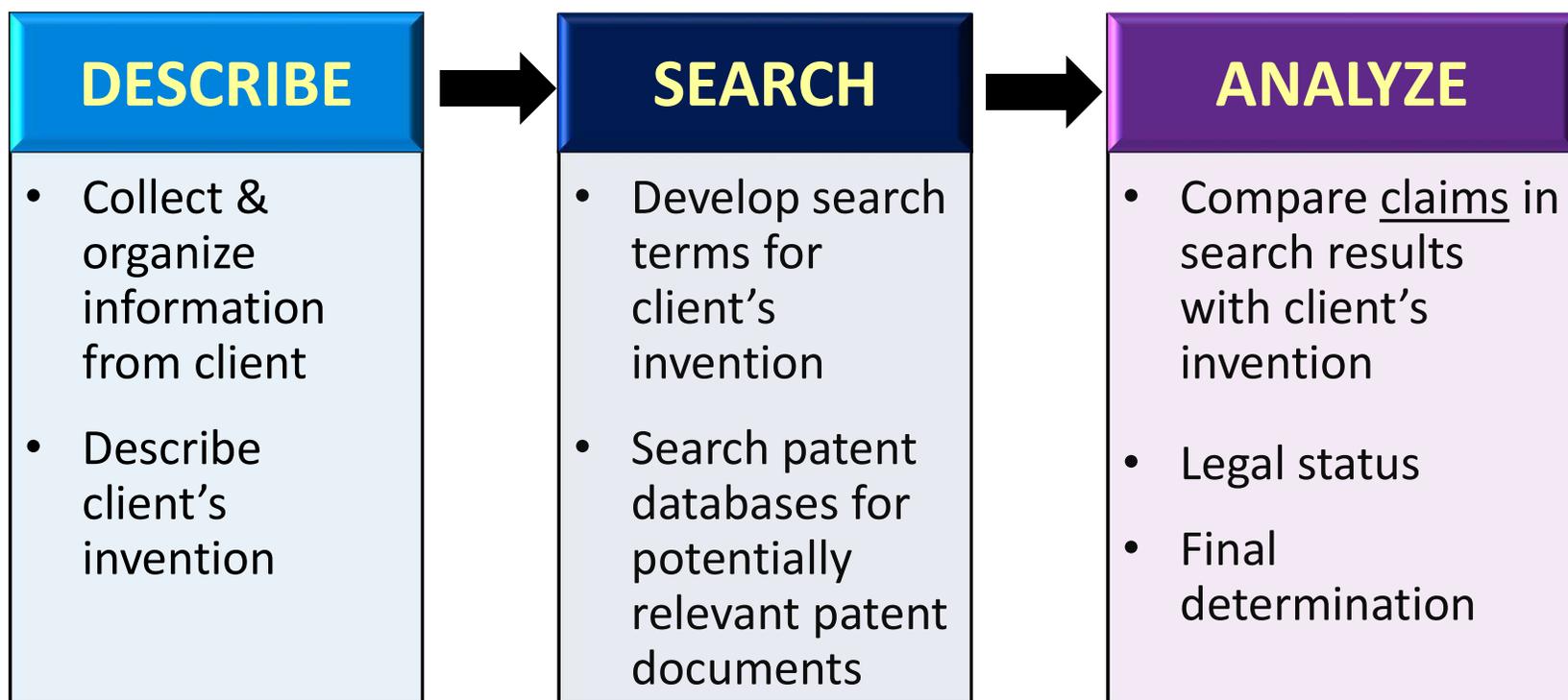
Initial question: Any IP issues related to the client's plans?

Frame the question to allow search & analysis of patent information:

- Are there **any enforceable patents** with **claims** that could **cover** the client's planned **use** of the **invention**?
-

Framed like this, the question can be addressed using the process of **freedom to operate (FTO) determination** taught in the WIPO Guide.

Guide teaches a three-stage process of FTO determination



Limits, risks, caveats, disclaimers for the guide

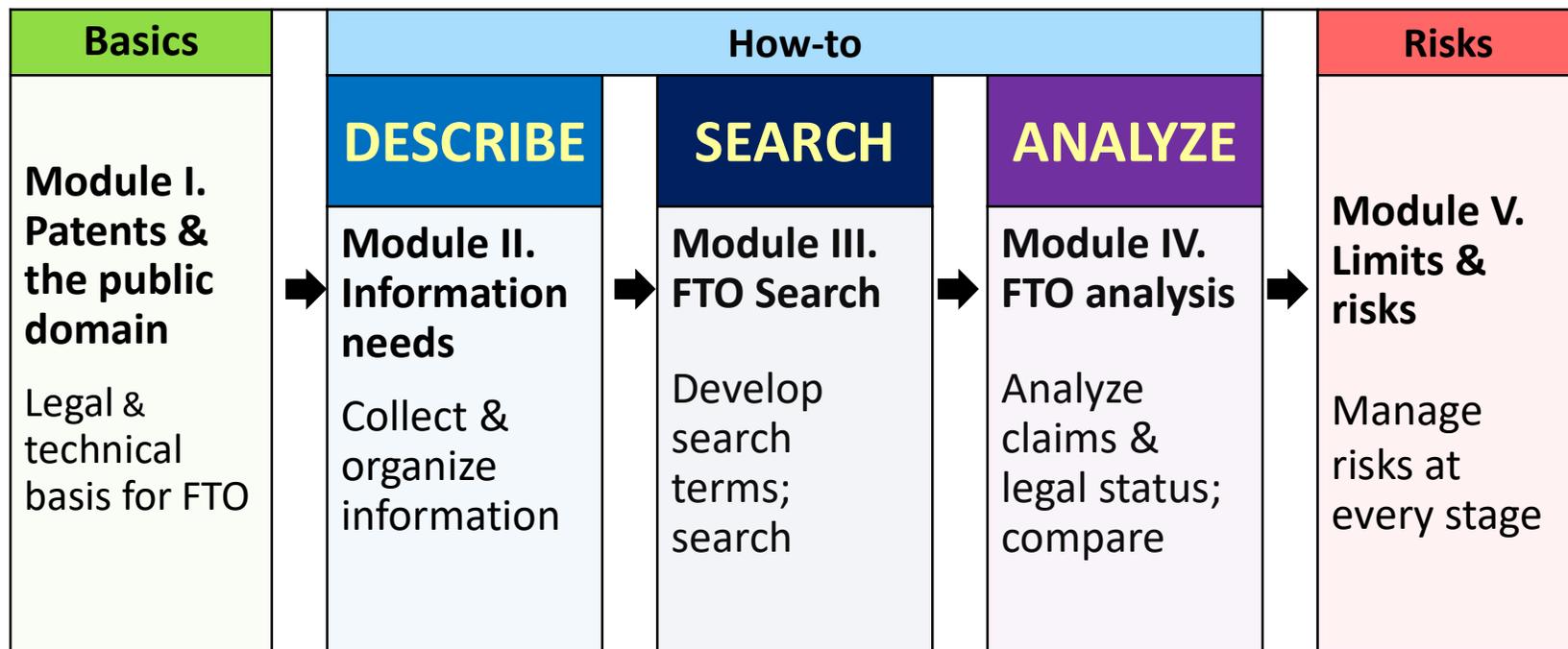
The WIPO Guide:

- Teaches concepts and tools of FTO determination
- Teaches ways to use FTO tools in a **technical** manner
 - Understanding the limitations and risks

The WIPO Guide :

- Does **not** teach legal analysis or provide guarantees
- Does **not** consider whether the client's invention is patentable
- Does **not** teach patent searching
- Does **not** teach a “treasure map” to find public domain inventions

Structure of the guide



Module I. Patents and the public domain

Learn fundamental IP principles and concepts:

- How patent rights are created, interpreted, enforced
- How an invention may be covered by multiple patents
- How to explore patent rights around an invention using FTO tools
- What is a public domain invention

Key concepts for FTO

- **Patents have limits**

- Patent rights are defined by the **claims** of a granted patent. Claims control scope of “the patented invention”
- A patent is enforceable **only** in the granting country & for a limited time

- **Multiple patents can cover an invention**

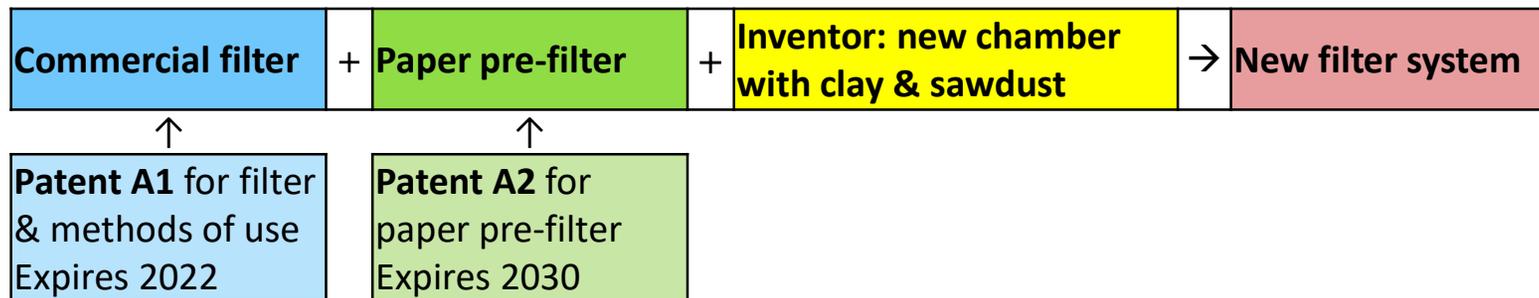
- Innovation is incremental: a new invention can use a previously patented invention as a feature
- An earlier patent can cover a feature of a new invention

Key concepts for FTO: Example

Inventor developed a new water filter system = a new invention

- Start with commercial water filter & add second filter unit
 - Paper pre-filter + chamber with local clay and sawdust.

FTO Determination for Country A, patents in force 2020.



Public domain invention

A public domain invention is:

a **publicly disclosed** invention

that is **not** covered by **any enforceable patents**

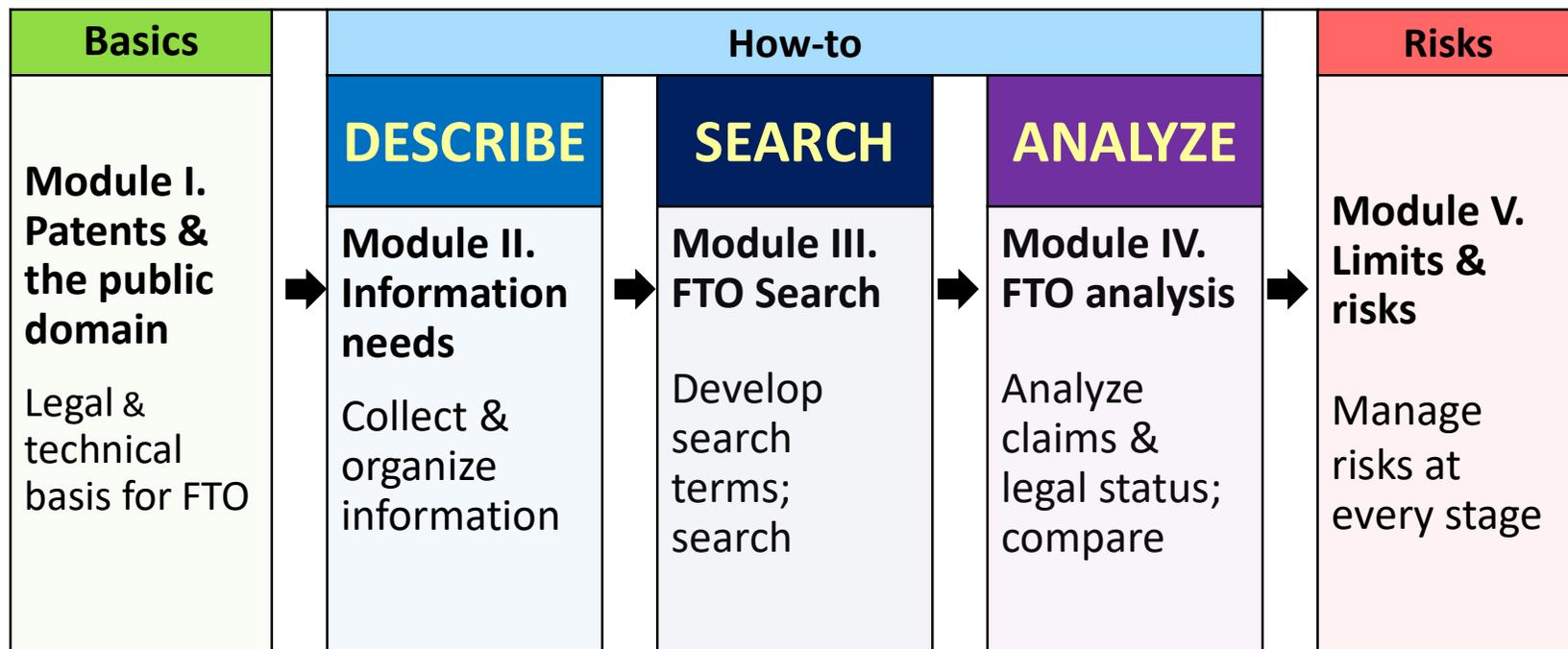
in a specific country, at a defined time

such that anyone may freely use the invention

in that country at that time,

without liability for patent infringement

How-to: Modules II, III, IV



Module II. Identifying technology information needs

Learn to gather & organize information to describe the client's invention in a format that can be used for FTO determination

- **Gather information** from client about invention and plans for using it
 - Interview questions at Figure 2
- **Organize information**
 - Describe the invention in technical terms; follow-on analysis
 - Develop a **complete description** of the invention; identify features
 - Identify possible countries & time frames
 - **Summary Report** - template at Annex A. 2

Module III. FTO Search: Finding sources of information to identify inventions in the public domain and carrying out an FTO search

Learn to search for patent documents with claims that may be relevant to any feature of the client's invention

- **Prepare** for search
 - Generate inputs
 - Key words
 - Patent classification codes
 - [Non-text inputs]
 - Select database(s) to search; find tools; choose limits
- **Search**
 - Use a hybrid strategy: key words and patent classification codes
 - Review, refine, repeat → stop
- **Collect & organize results** in search report

Key words:
Use tools

Generate



Curate

Ex: rebaudioside

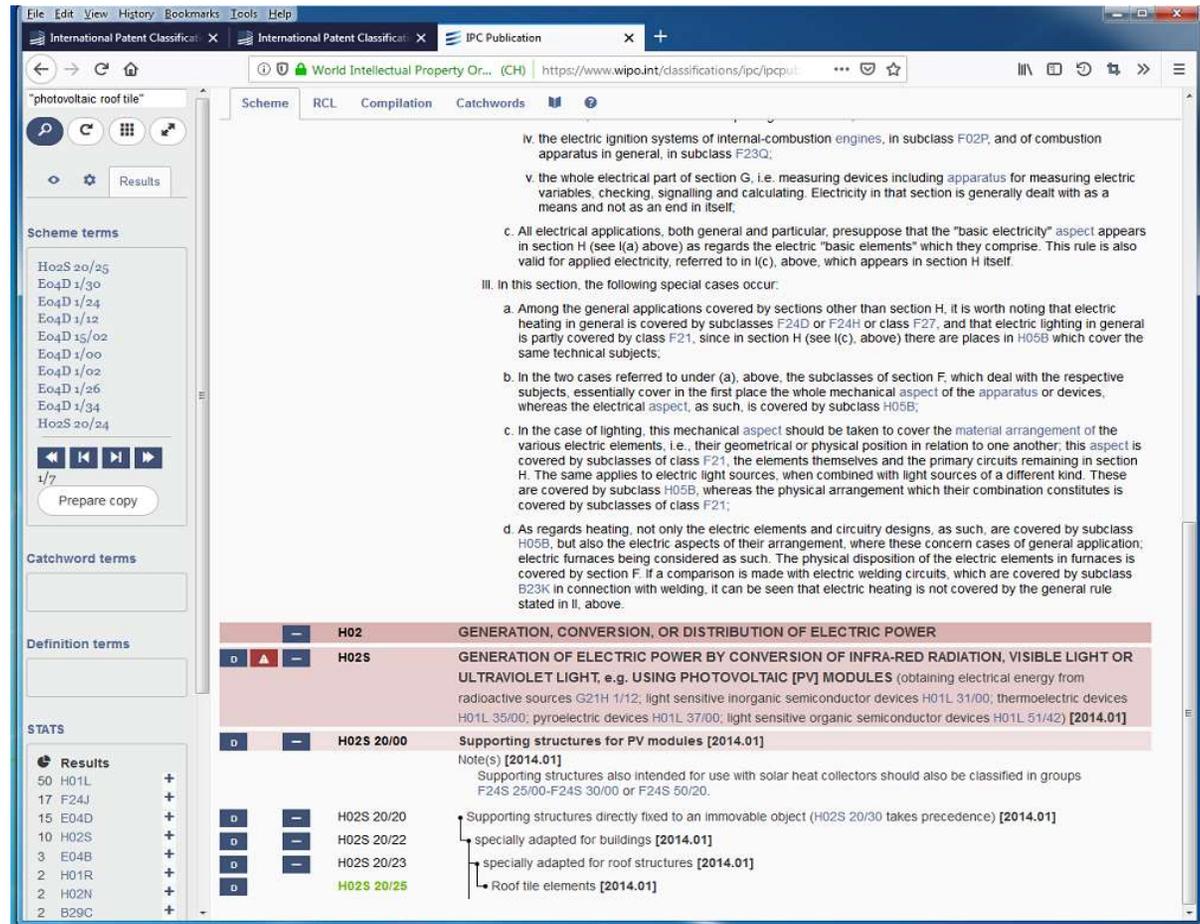
The screenshot shows the WIPO Pearl - Concept Map Search interface. The browser address bar displays www.wipo.int/wipopearl/search/conceptMapSearch.html. The page title is "WIPO Pearl - Concept Map Search". Below the title, there is a search bar with the text "rebaudioside" and a "Reset" button. The search results are displayed as a concept map with "rebaudioside" at the center. The map shows various relationships between concepts, including "erythritol", "gelling agent", "sweetener", "setting agent", "water-retaining agent", "preservative", "flavouring agent", "intense sweetener", "thickener", "cassia gum", "monosodium glutamate", "soy flour", "protein supplement", "soy protein isolate", and "soy milk". A legend at the bottom explains the relationship types: a red dot for associative relations, a blue line for generic or partitive relations, and a red dot for concepts in different subject fields/subfields.

Patent classification codes: Use tools

Ex: Invention is a roof tile with photovoltaic cell

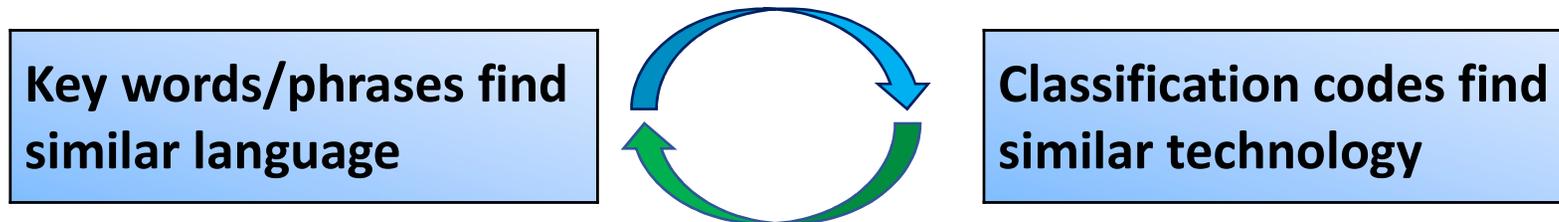
WIPO IPCCAT

- Most relevant IPC H02S 20/25



FTO Search & Search Report

Use a hybrid search strategy with different types of inputs



Organize search results and generate search report

- Sort or rank search results
- Identify potentially relevant patent documents
- **Search report** – Organized search results and optional comments

Why a hybrid strategy? Example using mask invention

Client: face mask with extra layers to stop dust and sand, ear loops

Key words: face mask, protective mask, filtering mask, respiratory mask, anti-dust mask

IPC code: A41D13/11 Protective face masks, e.g. for surgical use, or for use in foul atmospheres. Search A41D13/11 inventive = 535; 298 w/o “mask”

Use hybrid search because key words alone might not find claims that do not use “mask” in the claim language, such as:

An otically supported polygonal barrier to respiratory pathways . . . OR

A respiratory protection device comprising a central panel of filter media, and upper & lower panels with engageable extensions to form a chamber over the face.

Module IV. FTO Analysis: Reading Claims and Legal Status Information

Learn tools to evaluate whether FTO search found *any* patent documents that could potentially affect the client's plans to use the invention:

- *Informal* FTO analysis of claim scope and legal status
- Determinations for each patent document you analyzed
- Final Report to communicate your findings to the client
 - **Technical report of FTO search & analysis; no legal conclusions**

FTO analysis: Claim scope & legal status; final determination

Infringement analysis of claims

- Determine potential scope of a claim (“claim construction”)
- Compare claim with the client’s invention; classify each claim

Legal status determination

- Determine whether a patent is **enforceable** in the country of grant, at the time when the client plans to use the invention in that country
 - *If* FTO search included applications, determine legal status of application
-

Final determination:

- Classify each patent based on infringement analysis **and** legal status
- Sometimes a final determination cannot be reached

Final Report

Summary of the invention & FTO search

FTO Analysis: Use **technical** language

- Identify all documents analyzed, *e.g.*, in a table showing final determinations
- **Discuss specific documents you want to bring to the client's attention**
- Identify potential coverage, potential clear spaces, and unsettled issues

CONCLUSIONS: This may be the only section the client will read in detail

- No conclusion regarding public domain status is required
- **Do not use legal language**, or make legal conclusions, or offer legal advice
- Discuss limitations and risks: include disclaimers

Risk management for FTO determination

FTO determination involves making a series of informed guesses based on the best information available at the time

Guide teaches strategies to recognize & manage risk at each stage:

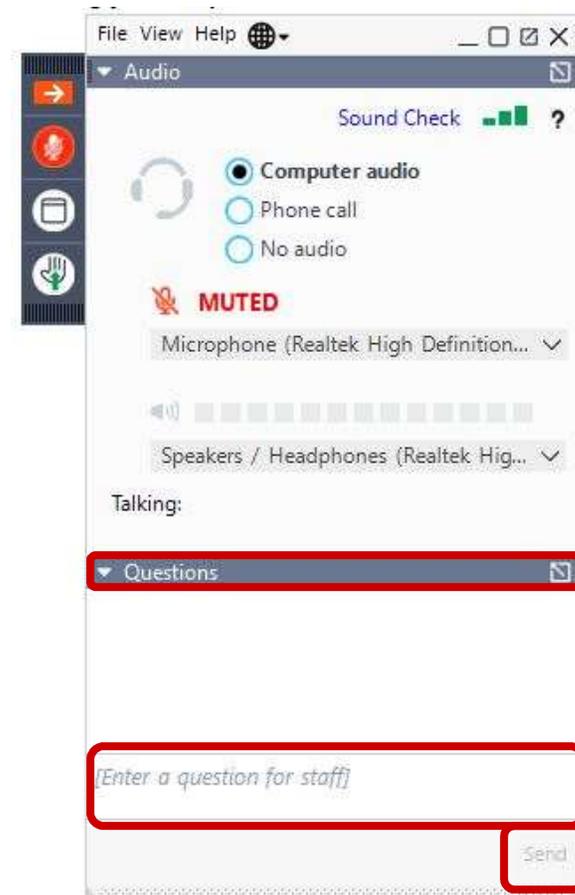
- Risk cannot be eliminated, only managed
- Inform clients of risks and limitations
- No legal advice, no guarantees

Thank you for your attention

Donna O. Perdue
Perdue IP Law, APC San Diego, CA USA
donna.perdue@perdueiplaw.com
www.perdueiplaw.com

Question & Answer session

Please wait a moment while we review your questions...



tisc@wipo.int

What's next?

- Ask the Expert session on eTISC
 - Dates: July 27 to August 7, 2020
 - Link: <https://etisc.wipo.int/ask-the-expert>
- Ask the Expert session on the *Guide on Using Inventions in the Public Domain* **until July 23**
 - <https://etisc.wipo.int/ask-the-expert>
- Guides: <https://www.wipo.int/tisc/en/>

tisc@wipo.int