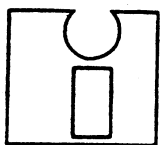


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WORLDINTELLECTUAL
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INVENTORS AT THE DAWN OF THE NEW MILLENNIUM: WIPO-IFIA INTERNATIONAL SYMPOSIUM

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the World Intellectual Property Organization (WIPO)
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PATENTING STRATEGIES - WHEN, WHAT AND WHY: HOW SHOULD
INVENTORS AND SMEs PLAN FOR OBTAINING PROTECTION
FOR THEIR INVENTIONS - USE OF PUBLIC OR PRIVATE SERVICES
INTELLECTUAL PROPERTY INFORMATION
(INCLUDING THE PATENT COOPERATION TREATY, ETC.)

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INTRODUCTION

1. Inventors normally invest considerable time, effort, and money into the development of their products. Therefore, the inventors should be entitled to reap the financial benefit of bringing their products into the marketplace.
2. Intellectual property laws protect inventors by giving them exclusive rights to create, manufacture and/or sell their final products without having competitors duplicate the inventions.
3. Intellectual property law includes four different types of protection for inventors: copyrights, patents, trademarks, and trade secrets. It may be possible for an inventor to take advantage of more than one of these types of protection; therefore, it is necessary to know the differences that exist between these categories.
4. Patents are marketing tools. A patented product does very little good unless others are able to experience its benefits. In other words, it has to get into the marketplace for people to buy and use. A patent can facilitate that process.
5. Winning a patent is a function of marketing. It provides the future marketing effort with a product that cannot be manufactured or sold without the permission of the patent owner or his licensee.

TYPES OF PROTECTION

6. The basic definitions of the four types of protection are as follows:
 - copyrights grant exclusive right, by law, for the publication of a literary, dramatic, or musical work or computer software;
 - patents grant exclusive rights for a specific period of time to buy or sell an invention;
 - trade secrets are granted for a formula or device, the basis of which is not known to competitors;
 - trademarks identify a product as being unique to a manufacturer, and competitors cannot copy that particular product. A symbol, sign, or letter identifies the specific product.
7. The best choice of protection depends on the particular set of circumstances of the inventor. If, for instance, an invention is a trendy item, identifying and protecting its name through copyright alone may be sufficient for its probable limited lifespan.
8. However, if a product is going to be around for some time, it may be the inventor's best interest to obtain the 20-year protection the patent offers.

9. At the end of 20 years, though the patent expires, and the competition might be able to manufacture a similar product and even better suggestion might be there for to obtain trade secret protection.

10. Initially, the inventor may be overwhelmed with the many choices available in the area of protection. This allows the inventor flexibility, and, with enough knowledge concerning the intellectual property laws, the inventor can then make the correct protection choice.

LEGAL ASPECTS

11. It is important to remember that copyrights, patents, trade secrets, and trademarks are limited in their applications, and the protection afforded is generally for a set period of time.

12. The invention must meet certain criteria before it can be considered for property protection. In some cases, not understanding the criteria for obtaining protection may actually cause the inventor to forfeit the right to protection. For this reason, it is necessary to have a working knowledge of the legal aspects in order to make the proper business decisions.

13. Inventors who are not familiar with the legal process behind filing for protection would be wise to contact a patent attorney. There are many excellent patent attorneys who practice property law, and while it may be expensive, the consultation is definitely worth it.

14. The main problem for the inventor is that intellectual property laws are not etched in stone; therefore, they are subject to change. Also, the law is subject to interpretation. This means the laws are not black and white. In some areas, laws can overlap or else obtaining one form of protection can nullify another form.

15. This can cause a great deal of confusion. However, inventors must decide which form of protection best applies to their particular products.

16. In addition to the legal aspects, the inventor must also consider the business decision for bringing an invention to the marketplace. A patent does not ensure the success of an invention in the marketplace. The inventor must then decide if it is worth the money and aggravation to obtain a patent, when there may not be a market for the invention.

17. So, when it comes to intellectual property laws, the inventor has a lot of issues to resolve both legal and non-legal.

THE NOVELTY SEARCH

18. When a Patent Officer receives a patent application, they conduct an exhaustive search. Their main objective is to find whether the invention is novel, new and unobvious. If other patents or relevant publications exist, then the Patent Officer may not issue a patent. For this reason, the inventor should check and make sure another similar invention does not exist before submitting the patent application.

19. The patent application process is difficult, time-consuming and expensive; therefore, the inventor should conduct a "Pre-Application Search" (PAS), before filing a patent application. In this search, the inventor should look for any printed publication, public

knowledge, or patent already issued in his country or a foreign country that may relate to the particular invention. This pre-existing information is called "prior art".

20. Before starting a Pre-Application Search, the inventor must decide how to conduct the search: personally, to use the WIPO and Patent Office services, or to hire an outside person or company.

21. A nearly patent search is usually discouraging. Normally, the basic inventive ideas are formulated in such an unspecified way that many publications will apply to this broad description.

22. Dependent on the outcome of the novelty search, the next decision will be whether to stop or to go ahead in developing the invention. If nothing of relevance was found, it is easy and you should go ahead. The decision becomes more difficult if you find one or several pertinent documents.

23. Before you start your novelty search, you may reduce your work by elimination, in connection with related inventions. Elimination also goes for the geographical area, in connection with the countries with related industries.

24. Most important is to restrict the search to the appropriate area. If an invention can be used in a different field, the Patent Office will classify it in various classes. It is, however, more important to study the patents classified in the most relevant area.

THE PATENTABILITY EVALUATION

25. Those with new product ideas and new to the world of patents often perceive a patent search to be an objective method of determining the patentability of an invention.

26. While the patent search conducted prior to filing a patent might be the most well-known, there are many other reasons for a search. There are also a number of different kinds of patent searches.

27. The inventor must search the patent databases as an element of pre-employment background investigations. And must also search the patents in order to establish product uniqueness while preparing to locate potential licensees for his own products.

28. Nevertheless, inventors must know that it takes a skilled patent professional with years of search and interpretation experience to authoritatively give advice to an inventor on whether or not to file a patent.

TECHNICAL EVALUATION

29. Credibility. Above all else, a technical invention needs technical credibility. Establishing this credibility should be the primary goal of the technical evaluation.

30. Most patented items do not need a technical evaluation. It is usually apparent whether or not a product works. In those cases where there is doubt, a prospective licensee or investor

will never get serious unless she can first be assured that the invention performs as represented by the inventor.

31. The best way to get an independent technical evaluation is to hire a consultant or consulting firm specializing in your invention's industry.

MARKETABILITY EVALUATION

32. The marketability or commercial feasibility evaluation is what most people have in mind when they advise inventor to get an objective evaluation.

33. One very popular method companies and investors use to decide whether to license new products or begin new ventures is to try to think of a reason not to do it. Once they see what is in their opinion a "killer deal" aspect to the project, they trash it and go on to the next one. Once they trash it in their mind, it is very difficult to overcome the objection.

34. The best evaluation can be independent and knowledgeable, yet it is still subjective when predicting market success.

35. What is success anyway? The word "success" is generally defined as the evaluator's summary judgment of the likelihood that the inventor will be able to successfully market and/or license the invention.

36. But what does this really mean? We can think of many examples of products that have been launched or licensed which have failed to bring any profit to the inventor.

37. Most inventors who have their idea evaluated by experts seem to look to the evaluation to confirm success. If future success is confirmed, it will be easier to raise capital to build a company around the idea and make a fortune. I wish this perception were true. But it is not, never has been, and never will be. Please do not fall into this mindset.

38. Most evaluations do little for the actual commercialization process unless they are performed by those who have the power to commercialize. Other kinds of evaluations can actually be detrimental.

CONCLUSIONS

39. Whether to apply for a patent is a decision that the inventor must take at the end of the Pre-Application Search (PAS). The inventor must analyze the data from the search to determine if there is another invention already existing. Then, the potential market for the invention, as well as the business and economic factors of a particular invention must be calculated. Another element the inventor must consider is whether there are other forms of protection that would work as well as a patent. The major decision, however, is how much the inventor wants a patent.

40. A successful inventor is like the conductor of an orchestra. He knows only a little about each instrument and yet somehow organizes the playing of a symphony. He is a salesperson, marketing researcher, technical researcher, public relations officer, talent scout, evaluator and

negotiator. These roles, at first, should be willingly accepted and then gradually given over to those who are specialists.

41. Evaluators can in no way be a good indicator of potential success. There are simply too many unknowns that will occur along the commercialization path.

42. It is not the function of evaluation to identify ideas or inventions, which will become innovations. Rather, the purpose of evaluation is to identify those ideas or inventions with serious technical or commercial flaws.

43. In order to be beneficial, the evaluation should occur well before sufficient data are available to prove either legal, technical or commercial success. Thus, projecting success in either case can be extremely unreliable.

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