Introduction to the patent system and its benefits for inventors

Workshop for Women Inventors

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Structure of the Presentation

- The Role of the patent system
- Patents
  - What is a patent?
  - Conditions of patentability
  - Rights and limitations
  - Basics of patent application and enforcement
  - Why to seek patent protection? Alternatives?
- Q&A
Role of the patent system

Assist innovation

Assist dissemination and transfer of technology
Women Inventions – Leading the way

Source: Public domain:
https://pixabay.com/de/photos/rettungsinsel-rettungsboot-241788/
What is a patent?

- Granted for an Invention
- Product/process provides new **technical** solution

**Protection:**
- Territorial
- 20 years from the filing date
- Subject to fee
Conditions of patentability

- Differ from one country to another

- Inventions which are
  - new,
  - involve an inventive step and
  - are capable of industrial application,
  - not excluded from patentable subject matter

- Sufficient disclosure of the invention in the patent application
New (Novelty)

Novelty: invention ≠ part of the prior art

prior art = any knowledge made available to the public before the filing date of the relevant patent application (no universal definition)
Inventive step

Invention is

- not obvious with regard to prior art
- to a *person skilled in the art* (having ordinary skill in the art)
- on the filing date

Examples for a lack of inventive step can be:

- obvious combination of features
- substitution of a material for analogous use
- routine experiment
- selection of optimal material from known materials
Industrial applicability (utility)

- Invention can be made or used in any kind of industry, including agriculture, fishery etc.

  (-) if invention is not technically implementable (e.g. Perpetuum mobile)

- Whether the claimed subject matter is actually applied in a trade does not matter.
Exclusions from patentable subject matter

- Differ from one country to another

- Examples

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Disclosure of the invention

- Invention sufficiently clear and complete
  → invention can be carried out by a person skilled in the art (having ordinary skill)
Where to file a patent application?

Local filing
Lower costs (fewer intermediaries
No translation costs)

Foreign filings

In which countries?
- Market?
- Customers? Users?
- Competitors?
- Licensees?
- Legal requirements?
- Enforceability?
- PCT/Paris Convention

$$$$?
Patent Office

Formality check → Substantive examination → Patent granted

Publication

Patent register

Rejected

Not a final decision - judicial procedure available!

Appeal

Opposition

Nullity action

Patent Office

(Appeal body)

Court
Rights conferred by a patent

- **Right to prevent** a third party from exploiting the patented invention
  - make, sell, use, offer for sale, import for those purposes

- Right to conclude licensing contract /transfer ownership

- Not an exclusive **right to exploit** the invention!

- Not a **right to market** the invention!
Limitation to patent rights

- Term of protection
- Acts generally not be considered as infringement:
  - non-commercial use
  - activities carried out for scientific research purposes
  - use of the invention on a land vehicle/vessel/aircraft temporarily or accidentally present in the territory
  - Private prior use
- Compulsory licences

Balance between patentee’s rights and public interest
Enforcement of rights

- A patent is **not just a “conversation piece”**
- A patent owner shall take **action against alleged infringers**
  - The court may order:
    - Injunction
    - Damages
    - Seizure of infringing products
    - Destruction of infringing products
    - Penal sanctions (fines; imprisonment)
- **Counterattack (patent invalidation) possible**
Why do you seek patent protection?

- **Exclusive control** in the market
  - Protection from reverse engineering
  - Hindering competitors from developing substitutes
  - Securing market access

- **Licensing or transfer/sale** of the patent right
  - Better cooperation with other organizations (ex. PPP)
  - Improving negotiation position (ex. cross-licensing)

- Attracting **investors**

- Seeking **prestige/reputation/image**
Elements to be considered

- Nature of the technology and business model
- Alternatives?
  - Trade secrets
  - Other intellectual property rights
  - Lead time in the market
  - Complementary services and manufacturing facilities
  - Contracts
- Available resources
  - Application/Monitoring/Litigation
Questions?

Thank you

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