

Patent Cooperation Treaty (PCT) Working Group

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THE INVENTOR ASSISTANCE PROGRAM (IAP)

Document prepared by the International Bureau

SUMMARY

1. This document sets out an introduction to the Inventor Assistance Program (IAP), created by WIPO in collaboration with the World Economic Forum.

INTRODUCTION

2. Though the majority of developing countries have established intellectual property legal frameworks and, in many cases, functioning patent systems, few local inventors are directly benefiting from these regimes. Within these countries, patent grants to foreigners far outnumber those to local applicants. While there are a number of reasons for this dynamic, the difficulties these inventors face with the procedural aspects present a fundamental hurdle towards securing patent protection.

3. Typically, inventors in developing countries represent themselves before their local patent Office. Their efforts, regrettably, are often unsuccessful. More than half of these inventors give up during the early stages of the patent grant procedure. They fail, not on the merits of their ideas, but because of the complexities of the system. Without a patent, many of these ideas die quietly without being developed to their full potential.

4. Patents serve as an important tool to attract investors and secure partners to develop technology. Without them, innovators from developing countries are at a significant disadvantage in the global market. The capacity for countries to develop and manage their own innovation plays a central role in growing economies. The United Nations Sustainable Development Goals acknowledge innovation as a key element for local growth and require

supporting domestic technology development, research and innovation in developing countries¹. Everyone should therefore have meaningful access to patent protection, from the individual inventor to large enterprises. To achieve this critical objective, broader participation in the patent system by inventors around the world needs to be facilitated.

5. Highly skilled patent professionals play an important role by helping inventors navigate the patent system. Unfortunately, such professionals are not always readily available to inventors in some developing countries, for several reasons. First, in some countries, the patent profession is not well established, due to a perceived lack of local demand. In other countries, local professionals focus on the patent prosecution of patent applications from foreign clients. As these applications will usually be part of patent family and will have been drafted by foreign professionals, local patent professionals often lack the experience with drafting patent applications from local inventors for domestic filings.

6. In a number of developing countries where a well-established patent profession exists, inventors still cannot access these services due to the associated costs. Instead, these inventors attempt to secure patents without professional help and fail, not based on the merits of their invention but due to the complexity of the patent system. For instance, in Colombia, between 2003 and 2013, more than half of local inventors who applied for a patent had their applications rejected based purely on formalities.² Similarly, in the Philippines, between 2003 and 2016, over 60 per cent of local inventors failed at the same stage.³

THE INVENTOR ASSISTANCE PROGRAM (IAP)

7. To overcome these challenges, in October 2016, WIPO, in cooperation with the World Economic Forum, established the Inventor Assistance Program (IAP). In a nutshell, the Program aims to level the playing field for inventors who have great ideas but struggle to turn them into valuable patented assets. The IAP supports under-resourced inventors in participating developing countries navigate the patent system with the help of volunteer patent specialists. These volunteers provide their services on a pro bono basis, ensuring free access for the applicant and limited operational expenditures for the participating countries. The assistance includes patent drafting and prosecution services before the inventor's local patent office and in selected jurisdictions.

8. Between April 2015 and March 2016, the IAP was launched as a pilot in Colombia, Morocco and the Philippines. In October 2016, the IAP became officially part of WIPO's programs. It currently includes five participating countries, more than 100 patent experts and ten sponsors. As of today, 39 inventors directly benefitted from services offered under the framework of the IAP. Four inventors have been granted patents in their country of residence. This number should increase as more applications supported by the IAP reach substantive examination in the patent process in their respective Office.

9. The IAP is also supporting selected inventors in obtaining professional assistance for national phase processing of international applications filed through the Patent Cooperation Treaty (PCT) in the United States of America and Europe. Efforts are underway to extend this possibility also to Japan and to other IAP participating countries.

¹ Goal 9 target 9.B. Goal 9 relates to Industry, Innovation and Infrastructure, and target 9.B mentions "Support domestic technology development, research and innovation in developing countries, including by ensuring a conducive policy environment for, inter alia, industrial diversification and value addition to commodities".

² Application to the Inventor Assistance Program by Colombia. Superintendencia de Industria y Comercio (SIC).

³ Application to the Inventor Assistance Program by the Philippines. Intellectual Property Office of the Philippines (IPOPPL).

HOW INVENTORS QUALIFY FOR THE IAP

10. To qualify for the IAP, inventors must demonstrate they meet three criteria:

- (a) be a resident of a participating country;
- (b) be under-resourced, as defined by locally established income eligibility criteria; and
- (c) have basic knowledge of the patent system.

11. With respect to the first criteria, at present, five developing countries have been accepted into the Inventor Assistance Program: Colombia, Ecuador, Morocco, the Philippines and South Africa.

12. With respect to eligibility criterion based on income, each participating country determines its own criteria. While the amounts vary by country, countries set the threshold at a level that supports local inventors without taking income away from local patent practitioners. For individuals, income is often set around three times the poverty level. For enterprises, only small and micro sized entities generally qualify. The thresholds set by the countries which currently participate in the IAP are shown in the Annex.

13. Finally, the inventor must demonstrate basic knowledge of the patent system, established either by already having filed a patent application or by taking an online course.⁴ The online course covers basics of the benefits of a patent, patent grant procedure and pro bono services and helps potential applicants to make a self-assessment as to whether their invention may be appropriate for patent protection. To date, more than 100 individuals have taken the online course, which is available in English, French and Spanish.

14. Some of the participating countries have also introduced requirements concerning the subject of the invention to filter out applications that are clearly ineligible for patent protection based on their subject matter or that have no clear prospects for commercial success. Ecuador, for example, incorporated a prior art search into the IAP selection process and other IAP participating countries are considering similar requirements.

PATENT OFFICES DRIVE LOCAL IAP PROGRAMS

15. The Program operates in partnership with national patent Offices which drive the IAP locally. Each participating country is responsible for local promotion and operation of the Program, with support from WIPO.

16. A focal point manages the day-to-day operation of the IAP in the participating country and serves as a point of contact for potential inventors and those accepted into the Program. This individual also manages program promotion and the selection process. In addition, the focal point works closely with WIPO to facilitate matchmaking of selected inventors with an appropriate patent professional.

17. National authorities are also in charge of establishing a National Screening Board, which decides on IAP applications from potential beneficiaries. In addition to representatives of the local patent Office, these National Screening Boards work particularly well when they are composed of representatives from other parts of the government, such as representatives from science and technology offices and agencies responsible for business relationships. Having broad membership can also provide early notification of those inventions or small businesses that can benefit from other local programs.

⁴ The English version of the online course is available at:

https://welc.wipo.int/authpage/signin.xhtml?goto=https%3A%2F%2Fwelc.wipo.int%3A443%2Facrp%2Fprogram%2Fdl%3Fcid%3DDDL_WIPOINVENT_E.

VOLUNTEER PATENT SPECIALISTS FUEL THE IAP

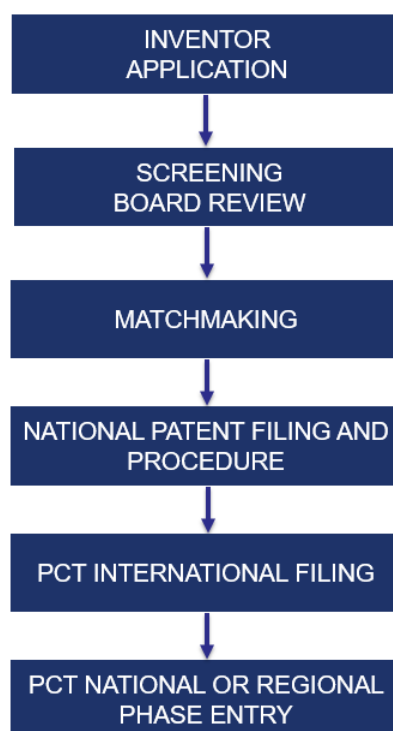
18. Volunteers offer their services through the program at no cost. The process starts when an inventor is matched with a qualified patent specialist, who helps the inventor navigate the patent application process before the inventor's local patent Office.

19. This volunteer also helps to coordinate protection abroad, if desired by the inventor. The IAP includes a network of over 100 volunteers in both participating countries and selected jurisdictions. Patent attorneys and agents participating in the program find the experience rewarding. It allows them to connect with local inventors and a broader professional network.

20. Patent attorneys and agents interested in joining the IAP can apply online via the WIPO website⁵. The application asks potential volunteers to provide details regarding their ability to practice before a patent office, available services, languages, and technical areas.

HOW DOES THE IAP WORK

21. The process for the IAP is shown in the Figure below.



22. Inventors apply to the IAP through their local patent Office. The patent Office verifies the applicant's eligibility. The application is then reviewed by the National Screening Board and a decision communicated to the inventor. If the application is rejected, the inventor is provided feedback and, where appropriate, given an opportunity to reapply.

23. Selected applications are forwarded to the WIPO Secretariat, which matches the inventor with a patent specialist based on the services needed, language and technical background. Basic information is provided to the patent specialist in order to perform a check on conflict of interest prior to accepting the case.

⁵ Application is available in English, French and Spanish at the following link: <https://www3.wipo.int/opinio/s?s=603>.

24. After matching the inventor and the volunteer, the WIPO Secretariat monitors the case to ensure the case continues to progress. The volunteer patent specialist keeps WIPO apprised of major milestones for the invention, for statistical purposes. However, WIPO does not receive any further details about the invention or the associated patent prosecution, which remain confidential between the inventor and the volunteer patent specialist, under a regular client-advisor professional relationship.

25. The local volunteer patent specialist, jointly with the client, may decide to file a PCT international application. If this is the case, the local volunteer may reach out to the WIPO Secretariat to connect with another volunteer to support a PCT national phase entry in selected jurisdictions. Beyond participating countries, volunteer patent attorneys are available in Europe and the United States.

INTERNATIONAL PROTECTION VIA THE PATENT COOPERATION TREATY (PCT)

26. The IAP provides support for filing of a patent application locally as well as abroad through the PCT. This additional benefit has led countries to participate in the program even when domestic initiatives are already in place. By helping under-resourced inventors to secure patents abroad, associated inventors and enterprises may increase their chances for success and attractiveness to potential investors. The IAP currently provides support for PCT national phase entries in the United States of America and in Europe, with plans to expand to additional key jurisdictions. However, the cost of national phase entries has proved to be a significant barrier to inventors seeking to file applications abroad. The IAP is investigating ways to reduce these obstacles. For example, grants provided to small businesses and individuals from the governments of participating countries may help, as well as fee reductions offered to applicants. However, while fee reductions for individual inventors and small entities apply to some national applications, more clarity is needed on how these reductions apply to PCT applications that enter the national phase.

GOVERNANCE OF THE IAP

27. The Governance of the IAP includes two main bodies: the Steering Committee and the WIPO Secretariat.

28. The Steering Committee makes major decisions for the Program and provides strategic direction. For instance, the Steering Committee decides on the admission of new countries wishing to participate in the Program and establishes the initiatives needed to address the challenges faced by the IAP.

29. The WIPO Secretariat plays a leading role in the international management and high-level coordination of the Program. This includes:

- (a) support for implementation in participating countries;
- (b) global program promotion, including recruitment of volunteers outside participating countries;
- (c) maintain the roster of volunteer patent specialists;
- (d) matchmaking selected inventors with volunteer patent attorneys or agents;
- (e) replying to general queries on the IAP;
- (f) managing the webpage of the IAP and the online course on pro-bono and patents.

MEMBERSHIP

30. Membership in the IAP is available to three types of entities: (a) Governments of participating countries; (b) patent specialist volunteers; and (c) sponsors.

GOVERNMENTS OF PARTICIPATING COUNTRIES

31. Developing countries may apply to join the IAP as a participating country. Requests are decided on a case-by-case basis by the Steering Committee, taking into account the current state and capacity of the local patent system as well as patent filings and grants to local applicants. A low number of applications by local residents, and/or a high number of rejections due to an evident lack of legal assistance are factors that would weigh in favor of IAP membership.

32. Governments of participating countries are expected to actively engage in local implementation and tailoring of the program to meet the local needs. These adaptations take into account the practice of inventors and patent attorneys and agents in the country concerned. Each participating country also takes the lead role in promoting the program within the country, including outreach efforts to inform inventors of the Program's existence and eligibility criteria.

PRO BONO PATENT ATTORNEYS

33. The IAP membership is open to any attorney or agent admitted to practice before the patent Office of the country in which the attorney desires to volunteer. To ensure high quality of legal services that are provided in the framework of the IAP, volunteer patent attorneys and agents are expected to have prior experience practicing before the local patent Office.

34. Given the jurisdictional restrictions of legal practice, rosters of *pro bono* patent attorneys will be built on a country by country basis. Attorneys who are admitted to practice in more than one IAP jurisdiction may apply for membership in multiple countries.

35. Volunteers must be willing to provide their services to under-resourced inventors at no cost. It is the responsibility of the patent attorney or agent to provide high quality legal services throughout the IAP representation, no different from that provided to paying clients. The professional-client relationship in the IAP cases shall be governed by the same laws, rules and ethical standards that apply to paying clients in the jurisdiction where the representation occurs.

SPONSORS

36. Sponsors play an important role in promoting the IAP and supporting the Program. At present, the IAP has ten sponsors, which include well-established firms, regional associations of professionals in the area of intellectual property, as well as international non-governmental organizations working in areas of interest for the Program⁶. One of the main roles of sponsors is to encourage patent attorneys and agents, in both participating countries and in selected jurisdictions, to join the program.

CHALLENGES FACED BY THE IAP

37. Implementation of the IAP has been successful. However, the Program also faced some challenges.

⁶ Current IAP sponsors include the Institute of Professional Representatives before the European Patent Office (epi), the International Chamber of Commerce (ICC), the Federal Circuit Bar Association (FCBA), the Inter-American Association of Intellectual Property (ASIPPI), the International Federation of Inventors' Association (IFIA), 3M, Medtronic, Novartis, Pfizer and Qualcomm.

CHALLENGES FACED BY POTENTIAL IAP BENEFICIARIES

38. While some inventors are already familiar with the patent system, educating potential beneficiaries about the benefits of patenting is critical to ensure local engagement. Regular government-led training programs are needed to promote knowledge on patents as a mechanism to secure protection for local inventions and facilitate the transfer of technology and the creation of IP assets.

CHALLENGES FACED BY CURRENT IAP BENEFICIARIES

39. While the program has helped inventors in IAP countries to secure professional services in their own countries, protection abroad remains difficult. In particular, the fees required for national phase entry of PCT applications are often beyond the reach of the under-resourced inventors participating in the program.

40. Beyond securing patents, inventors also need support to commercialize their inventions. The experience of the IAP has shown that limiting the scope of the Program to securing patents for local inventors has been key in its successful implementation. However, business strategies related to marketing and commercialization of a patented invention, assignments, licensing of technology and other patent transactions are not within the scope of the IAP.

CHALLENGES FACED BY THE PATENT PROFESSION

41. Not all countries that could benefit from the IAP have a local patent profession with the capacity to draft patent applications. In many countries, a patent attorney or agent must have a scientific background and pass an exam administered by a patent office. However, in most of the IAP's participating countries and those countries that could potentially participate in the program, practicing before the Office does not require training in a scientific discipline. As a result, while patent professionals in these countries may be well equipped to deal with the procedure of patent prosecution, they often lack the technical expertise to prepare a patent application from scratch, such as transforming material from an inventor into patent claims. Many countries are developing local expertise, for example, via services provided by Technology and Innovation Support Centers (TISCs) and by holding patent drafting seminars in cooperation with WIPO. However, when there is a lack of demand to support a local profession, it will remain a challenge to sustain this expertise over the long term.

42. *The Working Group is invited to note the contents of this document.*

[Annex follows]

INCOME AND INVENTION CRITERIA FOR IAP PARTICIPATING COUNTRIES

Country	Income Eligibility Criteria	Invention Eligibility Criteria
Colombia	<ul style="list-style-type: none"> • Inventors with a fixed or variable monthly income not exceeding four monthly legal minimum salaries (consult Act 789 of 2002). • Small companies as defined by law 905 of 2004: those with between 11 and 50 staff and total assets equivalent to between 501 and 5,000 minimum monthly salaries. • Micro companies as defined by law 905 of 2004: those with no more than 10 staff and total assets less than 500 minimum monthly salaries. 	<ul style="list-style-type: none"> • The invention must not be subject to any exclusions or exceptions to patentability as defined by Articles 15 and 20 of Decision 486 of 2000. • The invention must be usable by industry over the next 10 years
Ecuador	<p>The applicant is:</p> <ul style="list-style-type: none"> • an individual earning less than 3 monthly “remuneración básica unificada” (unified basic remuneration); or • a microenterprise having between 1 and 9 employees with a turnover of less than \$100,000.00; or • a small enterprise having between 10 and 49 employees, with a turnover of between \$100,001.00 and \$1,000,000.00 	None
Morocco	<ul style="list-style-type: none"> • Individual inventors not engaged in any other business activity. • Small- and medium-sized enterprises (SMEs) whose turnover does not exceed 75 million dirhams and whose permanent employees do not exceed 300, pursuant to Law No. 53.00 constituting the SME charter. • Self-employed people, as defined by Law No. 114.13, whose turnover is less than or equal to 500,000 dirhams for business activities or equal to 200,000 dirhams for service provision (this is a new legal category in Morocco for self-employed individuals). • Very small enterprises (VSEs) whose annual pre-tax turnover is less than 3 million dirhams. 	<ul style="list-style-type: none"> • The invention must not be subject to the exceptions to and/or exclusions from patentability, within the meaning of Law No. 17-97 on the protection of industrial property. • Technical and economic relevance of the invention
Philippines	<ul style="list-style-type: none"> • Any natural person who is earning P500,000.00 or less per annum. • Duly registered entity such as micro, small, start-up, spin-off companies with total assets less than P15,000,000.00 (Republic Act No. 9501). 	<ul style="list-style-type: none"> • The invention does not fall under the enumerations of non-patentable subject matter under Section 22 of the Intellectual Property Code of the Philippines, as amended by Republic Act No. 9502; • Commercial Potential: No prior art (arrangement that the applicant has to commercialize the technology subject of the application is a plus factor in the evaluation of an application for IAP).
South Africa	<p>The applicant is an individual or SME that is either:</p> <ul style="list-style-type: none"> • a person earning less than R 30 000 per month after tax, or • an enterprise with an annual turnover of less than R5 million. 	<p>The invention concerned:</p> <ul style="list-style-type: none"> • (on face value) meets patentability requirements. • has prospects for commercial success.

[End of Annex and of document]