

Welcome to the IAP Learning Module

The module will introduce you to the key aspects of patents and patenting process, as well as to the benefits of pro bono legal services and the Inventor Assistance Program (IAP).

There are two parts in this module. It would take you around 30-45 minutes to complete all.

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Benefits of securing a patent

Why patents?

Today innovation plays a crucial role in the human progress, and patents, like other types of intellectual property (IP), are the key engine that drives innovation securing your investments in the development of new products and services. They make sure you get compensated for your inventive efforts.

A patent gives you control over the destiny of your invention. You decide who can make, use, or sell it.

If you do not patent your invention, your competitors may copy it without needing to ask for your permission and will take advantage of your invention.

A patent can deliver value for your business or innovation:

- It's a powerful business tool to gain exclusivity over a new product or process while developing a strong market position or earning revenues through licensing.
- You can use your patent to raise funds for your business.
- Patents can also help you boost your corporate image.

What do patents protect?

A patent gives its owner the right to control the use of an invention within a limited geographical area and time. The patent owner can stop others from commercially exploiting (making, using and selling) the patented invention without the owner's authorization.

Other IP rights

Depending on the nature of your creation, you may also be able to use other types of IP rights to protect your idea or innovative solution, and ultimately benefit from using them, including industrial designs, trademarks, copyright and trade secrets.

Industrial designs

Provide exclusivity over the ornamental shapes or aesthetic features of a product.

What can be protected?

- Wide variety of industrial, fashion and handicraft products: watches, jewelry, textiles, packages and containers, household products, toys, furniture, lighting equipment, electronic devices, cars, technical and medical instruments, sports equipment, etc.
- In the digital world, industrial designs may also be relevant to graphic symbols, graphical user interfaces (GUI), logos, electronic icons on computer monitors and smartphones.

Trademarks

- Signs used to distinguish the goods or services of one enterprise from those of other enterprises.
- Trademarks are the key element of the brand strategy.
- They play an important role in determining the success of products (whether goods or services) in the marketplace.

What can be protected?

Certain brands elements, like:

- Slogans.
- Symbols.
- Logos.

Copyright

- Protect a very wide range of creative works.
- Copyright does not protect ideas or concepts, it only protects the way these are expressed in a particular work.

What can be protected?

- Books, music, paintings, photographs, sculptures, architecture, films, video games, original databases and computer programs.
- In some countries, computer programs and other software can be protected through patents.

Trade secrets

- Can help protect confidential business information (technical, commercial), that has commercial value due to its confidential nature.
- In some jurisdictions, and in common parlance, trade secrets are sometimes referred to as “confidential information”, “know-how” or “proprietary information”.

What can be protected?

- Data compilations.
- List of suppliers and clients.
- Information about research and development activities and manufacturing processes.

One product can be protected by a variety of IP rights:



Your innovative technical solutions can be protected by patents.



Embedded computer programs controlling the operations can be protected by copyright.



Aesthetic aspects of your product can be protected by an industrial design.



A trademark can protect your brand used to market the product.



You can hold confidential business information as trade secrets.

Patents vs. utility models

While patents are widely available, utility models are offered in some countries (also known as “innovation patents,” “utility innovations” or “short-term patents”). These rights are similar to patents, letting you control who can make, sell or use your invention.

What qualifies for protection can vary. In general, utility models can protect less significant improvements that would not be possible under the patent system. Sometimes certain types of inventions, like processes, do not qualify for protection.

Typically, utility models offer protection for a shorter term and are less expensive. These rights are sometimes seen as less valuable than patents, since they are often not examined substantially and may be invalidated when enforced.

Patents vs. trade secrets

It may not make commercial sense to protect every invention with a patent. Applying for patent protection is a significant investment. Many enterprises use trade secret protection as an alternative.

Unlike patents, trade secrets are protected without registration – that is, without any procedural formalities or registration with any government or regulatory body. Trade secrets can be protected for an unlimited period of time or as long as the information remains confidential by taking reasonable measures to keep it safe.

Trade secrets only protect their owner from unauthorized uses of confidential information. There is no protection if the same information is acquired by another through independent development, reverse engineering, leakage or otherwise becomes generally known. Using trade secret protection is a good choice when information is difficult to recreate.

Trade secret rights can be combined with patent protection. For example, the same product may use patents to protect some functionality of an invention, trade secrets to protect the specific settings that improve the product's performance.

What qualifies for a patent

What is an invention?

Patents are granted for inventions in any field of technology, which are a new and inventive solution to a technical problem. It can be a product, a process or an improvement to either of these, e.g.:

- Mechanical devices and articles of manufacture
- Industrial or technical processes/methods
- Chemical compositions or compounds
- Isolated and characterized molecules
- Genetic organisms/gene sequences

Requirements

Generally, patents are granted for inventions that are new, useful in some way, and be a significant improvement over what already exists.

To be patentable, an invention must fulfill several requirements, including novelty, inventive step (non-obviousness) and industrial applicability (utility).

Novelty

- Your invention is new or novel (novelty requirement) if it show some new characteristic which is not known in the body of existing knowledge in its technical field, so called “prior art”.
- In general, prior art refers to all the relevant technical knowledge available to the public anywhere in the world prior to the filing date of your patent application, and includes patents, patent applications and non-patent literature of all kinds.

Inventive step

- Your invention is considered to involve an inventive step (non-obviousness requirement) when, taking into account the prior art, it is not have been obvious to a person skilled in the particular field of technology (one “of ordinary skill in the art”).
- At its most basic conceptual level, obviousness means that if any person of average skill in the scientific/technical field of the invention could put together different pieces of known information and arrive at the claimed invention, then that invention is not patentable.

Industrial applicability

- To be patentable, your invention must also be useful. In patent language, this is called “utility” in some jurisdictions, and “industrial application” in others.
- Typically, utility requires only that an invention performs the functions specified and achieves some minimally beneficial result.
- In some jurisdictions, the patent applicant may have to show that their invention satisfies a requirement for industrial application, which generally means that an invention can be made or used in any kind of industry in the broad sense, including agriculture, fishery, services, etc.

There are some other requirements that must also be met to obtain a patent.

First of all, your invention may be patented only if it falls within patentable subject matter under the relevant national/regional law. In some jurisdictions, patentable subject matter is positively defined in patent law, but in most national or regional patent laws, patentable subject matter is defined negatively by providing a list of what cannot be patented, including:

- Discoveries and substances as they naturally occur in the world.
- Abstractions and scientific theories.
- Schemes, rules and methods for performing mental acts.
- Aesthetic creations.

Furthermore, in return for the grant of exclusive patent rights, patent holders are required to sufficiently disclose to the public information about the invention. Therefore, your patent application must disclose the invention sufficiently clearly and completely to enable it to be carried out or replicated by a person with an ordinary level of skill in the relevant technical field.

Prior art search

During examination, many patent applications get rejected in light of other patents or technical publications that reveal similar information. Searching existing databases (prior art search) before you file can help you avoid wasting money on a patent application that will never come to fruition.

Many [patent offices](#) have made their patent databases freely available online. You can also do a search in WIPO's [PATENTSCOPE](#) database.

When you talk

Once you talk about your invention publicly, you may no longer be able to protect it with a patent. Pre-filing public disclosure can destroy the novelty of your invention. Consider filing for a patent application before you share it with others or enter into an agreement to keep it confidential. Some countries provide a short grace period (usually between 6 and 12 months) to give you time to file for protection if an invention has been publicly disclosed (for instance, at an international exhibition or similar).

Territoriality and costs

Territoriality of patent protection

At present, you cannot obtain a universal “world patent” or “international patent”. Patents protection is territorial, only providing protection in the countries or regions where they are granted. If your invention is not protected in a given country, anyone can use it without asking your permission in that market.

The cost of protection

Patents are not free. The actual costs of patent protection vary significantly from country to country and may include:

Before applying for a patent

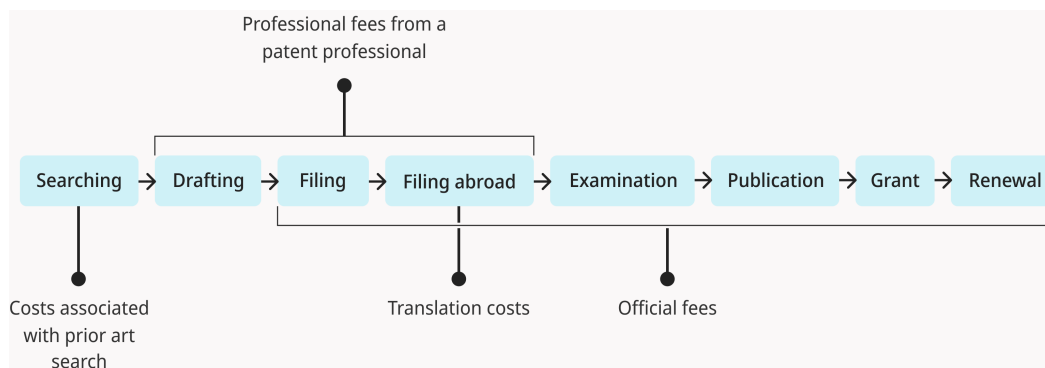
Costs associated with performing a search of existing patents, applications, and technical documents (known as a prior art search), such as professional services or access to certain databases.

During the application process

- Official fees to file an application, publish, examine or grant it, paid to the IP office, which vary widely from country to country.
- Professional fees from a patent professional to assist you in the patent application procedure (e.g. drafting the patent application, including preparation of drawings, corresponding with the patent office).
- Translation costs if the application will be filed abroad.

After the patent is granted

Renewal fees, which may be charged on an annual or semi-annual basis. These fees may start accruing even before a patent has granted.



Many offices offer discounts on official fees for individual inventors or small entities. In some offices, you may have to establish your eligibility for the discount. For more specific details on costs, check with the relevant [patent offices](#), or see [PCT fees](#).

How to secure a patent

The process

The steps to secure a patent vary from country to country, but broadly you would follow these steps:

1 Application

You have to submit a patent application to the relevant [national or regional patent office](#), paying the required fees. In many countries you can apply online.

2 Publication of the Application

In many countries, the patent applications are published 18 months after the filing date. If you have decided to withdraw your application, you may be able to stop its publication.

3 Examination

The patent office checks whether your application complies with administrative requirements. Some patent offices will also check if your invention satisfies the legal requirements. For example, to figure out if an invention is new, a patent examiner will search existing patents, patent applications, and sometimes technical publications.

A patent examiner may reject your application, finding it is not really new or a significant improvement over what already exists. This is very common! If you still want to protect the invention, you will need to argue why your invention qualifies for a patent in light of what has been revealed. As a result, you may also change what the claims that define the scope of the invention.

Patent examination may not be automatic. You may need to take a step or pay a fee to start the process. If you do not take this step, your application may become abandoned.

4 Grant and Publication

If the examination shows that your application meets both the administrative and legal requirements, a patent may be granted. In some countries you will need to pay a fee first before this happens.

If granted, the patent office will publish the patent.

For more information on how to secure a patent in your country, consult the relevant [national or regional patent office](#).

Patenting your inventions abroad

Three ways of filing for foreign patents:

National route

Apply to the national [patent office](#) of each country where you want to protect it separately. You will need to file in a language accepted by the office and pay the required fees.

Some countries require you to use the services of a locally based patent attorney or agent to complete the process.

Regional route

You may be able to file through a [regional patent office](#) instead of some countries. This route is not available in all regions.

International route

If you are a national or resident of a country which is part of the WIPO [International Patent System \(PCT\)](#), you can file an international PCT application simultaneously seeking protection for your invention in more than 157 countries.

Learn more about the [advantages of using the PCT](#).

Timeline for filing abroad

Since an invention must be new to qualify for protection, you only have a limited amount of time to file a patent application in different countries – any subsequent applications in other countries should be filed within 12 months (priority period) of the date of your first application (priority date).

When you use the PCT route for filing abroad, you will be given additional 18 months to decide whether to enter the national phase in any PCT member country.



Keeping your patent alive

A patent generally lasts 20 years from the date it is first filed.

To keep your patent alive, you may need to renew it on an annual or semi-annual basis, by paying a fee. For more specific details on costs, check with the relevant [patent office](#).

Inventors and ownership

The person who conceived the invention is the inventor, whereas the person (or company) that files the patent application is the applicant, and the holder or owner of the patent when the patent is granted.

When more than one person contributes in significant ways to the conception of an invention, they must be treated as joint inventors and mentioned as such in the patent application. If the joint inventors are also the applicants, the patent will be granted to them jointly.

While the inventor can be the applicant, often the applicant is the company or research institution that employs the inventor.

In many countries, inventions developed in the course of employment are automatically assigned to the employer who has the right to file a patent application, and who would be the owner of the patent. In some countries, this is only so if it is stated in the employment contract.

It is important to find out about the [specific legislation in the relevant country](#) and to ensure that employment contracts deal with issues of ownership over employee inventions to avoid possible disputes.

In most countries, an independent contractor hired by a company to develop a new product or process owns all rights to the invention, unless otherwise specifically agreed in writing. This means that unless the contractor has a written agreement with the company assigning the invention to that company, the company will have no ownership rights in what is developed, even if it paid for its development.

Anatomy of a patent application

A patent application includes several sections:



A detailed description of the invention (in clear language and enough detail that a person with an average understanding of the same technical field could use or reproduce the invention).



The patent claims, which define the invention in a legal sense and determine the scope of patent protection (define legally enforceable subject matter).



Drawings and an abstract (a short summary of the description and the claims).

The description and drawings provide an understanding of what the claims mean.

Patents as commercial assets

Building commercially relevant patent applications

Not always patentable inventions should be patented. Just because your technological idea is patentable doesn't mean that it will be a commercial success. It should be worth patent protection. A careful cost and benefit analysis, including consideration of possible alternatives, is essential before filing a patent application. Here's a few considerations:

Protect something potentially valuable in the market

- Check whether you've come up with really a new invention and it's not been done before.
- You can start with a search engine, but also available patent databases.

Check if your invention qualify for patent protection

The definition of an "invention" can vary from country to country.

Figure out about your invention or design around it

- Your patent can be particularly powerful.
- If someone could just come up with another effective way of doing it, a patent may not offer much commercial value.

Consider the markets where you need protection for your invention

When choosing where to file for patent protection, consider the markets where you and your competitors plan to make or sell your invention.

Consider how you'll bring the invention to the market

If you're working with other like partners or suppliers, patents can help establish what you own before you start working together.

Think about the technology

- Does it move fast?
- A patent can last up to 20 years, and it can also take several years to grant. Will the technology be obsolete before you get your patent?

Consider if you can afford a patent

- There are costs involved at the time of filing, when the application is examined, and to maintain the asset.
- If you're filing in multiple countries, the bills can add up fast.

Using your patent

Patents are valuable assets that you can strategically use in your business. You can do this by directly integrating the protected invention into your manufacturing process and selling products or services containing the claimed invention.

You can also use your patent to create additional revenue streams by giving others a permission to use your patent, or selling it out to another person or legal entity. Working with third parties can bring several benefits to your business, from creating new revenue streams to reducing the costs of expanding into new markets. If your invention is valuable, others may be willing to pay you to use it, even your competitors.

By granting a license, you authorize someone else to use your patent on mutually agreed terms in exchange for a lump sum, royalties, and/or other benefits, while maintaining your ownership.

Within the license agreement, you can limit the way your patent is being used by specifying for how long it can be used, in which particular markets and in what technical field. You can use this approach when you want your patent to be used in new industry markets where you lack specific know-how or entry points.

You can decide to license your patent to one single legal entity or person, therefore granting exclusivity, or keep the possibility to license to more entities, with a non-exclusive agreement.

By selling your patent (assignment), you transfer ownership of your patent to another person.

Patents may also be used to raise funds, for instance, they can be used as collateral for raising funds from investors, or borrowing money from banks, when they can serve as a financial guarantee.

Enforcement

The exclusive rights granted by a patent give you the opportunity to prevent or stop competitors from infringement and to seek compensation for damages.

Do you think your patent is being used by others without your permission? Before you take action:

- ✓ Collect information available to you about the activities, including who is using your patent, where they are using it, and how you know they are doing it.
- ✓ Consider whether you have enough information to prove that someone else is using your patent without your permission. To be using the patent, the third party must do each step in at least one of the claims.
- ✓ Consider whether the third party could have had permission from someone else to use your patent. This can happen if a patent has been licensed to others or sold to another party.
- ✓ Determine if there's any information that may make your patent invalid. For example, did your invention become public before you filed it? Have you paid all your renewal fees?
- ✓ Analyze the impact the use of your patent is having on your business.

Many of these are technical legal analysis. You can start the process yourself, but before you take action, seek expert legal advice.

If you decide to enforce your patent, some steps you may take:



Send a letter (known as a "cease and desist letter") informing the third party that you think they are using your patent. The letter will need to be specific, identifying the patent and explaining why you think your patent is being used



Try to settle your disputes via alternative dispute resolution mechanisms, for example, [WIPO's alternative dispute resolution services](#).



Initiate relevant proceedings before enforcement and judicial authorities.

You are responsible for identifying unauthorized use of your patent and deciding what steps to take. It does not happen automatically.

Pro bono services and the IAP

What is pro bono?

Drafting a patent application, and communicating with the patent office about it, is a highly technical process. A skilled patent professional can make a significant difference in crafting a valuable asset.

Not all inventors have the financial means to obtain the legal services that will help them protect and develop their inventions. Anyone can have a great idea wherever they sit along the income spectrum. Pro bono legal services help level the playing field for these under-resourced inventors.

The IAP

The World Intellectual Property Organization's Inventor Assistance Program (IAP) is designed to assist inventors who lack the financial resources to navigate the patent system on their own, by matching them with volunteer skilled professionals providing pro bono legal assistance to help secure patent protection.

The IAP beneficiaries get support in their own country and in selected jurisdictions.

The IAP complements domestic innovation programs and can be plugged into them to offer an international component.

You may wish to watch our short video [Why Apply to WIPO's Inventor Assistance Program](#).

Who can apply (inventors, SMEs)

Inventors (individual or as a part of small businesses) who live in an IAP participating country and meet the local eligibility criteria [\(check here\)](#) for support through the IAP.

How it works

How the IAP works

1 Apply to the IAP

Complete the application form. When finished, you will receive an email with your case ID.

Include details about the strategic value of your application and how your invention is new and different from existing solutions.

2 Check eligibility

Your country's focal point will check if you are eligible for the program. You may be asked to provide additional information.

Your application is not complete until you submit any additional requested details.

3 Get selected

The National Screening Board meet every few months to select IAP beneficiaries.

You will be informed of the decision via email.

4 Get matched

The IAP matches you with a volunteer patent specialist in your country based on the technical area of your invention.

It can take a few weeks after selection to identify your volunteer.

5 Work together

Once matched set up your first meeting and collaborate on the IP protection strategy for your invention.

The volunteer will help you navigate the patent application and grant procedure.

6 Go beyond

The IAP can provide volunteer patent specialists in selected countries and regions.

Talk to your volunteer about the benefits of seeking protection abroad.

Learn more on how the IAP is operated

You can learn more about the IAP and find practical information on how to use the [IAP Online Platform](#) by running through its [FAQ section](#).

What is offered

What kind of support is provided (other types of IP)

Through the IAP, volunteer specialists provide pro bono services related to the obtaining of patent protection, including:

- Drafting and filing patent applications.
- Managing patent applications, including filing divisional applications, amendments, conversions, withdrawal, and requests for substantive examination and publication.
- Other correspondence with the patent office.
- Prosecution before the patent office.

Litigation and commercialization services are outside of the scope of the IAP.

The precise scope of services will be defined on a case-by-case basis, through agreement between the applicant and the volunteer.

The pro bono assistance provided under the IAP is limited to patent and utility model matters only, so the IAP cannot help with other types of IP (designs, trademarks, etc.).

What does the IAP cost and cover?

While services provided directly by our volunteers through the IAP is free of charge, no direct financial assistance is offered.

The official costs associated with a patent application (e.g. those costs paid to the patent office) and any out-of-pocket costs necessary to complete your application (e.g. translation of documents) remain your responsibility.

Volunteer - inventor relationship

What to expect

The IAP volunteer will help you to draft and file a patent application for your invention that was specified in your IAP application selected by the National Screening Board.

If you have an improvement to your initial invention, or a new invention, you cannot ask your volunteer to help secure it – you will have to submit a new IAP application which should be reviewed by the National Screening Board.

Your first meeting

If at your first meeting with the volunteer, you come to an agreement that he/she cannot provide the expected or needed assistance by any reason, you will be matched with another volunteer, or an additional volunteer will be asked to help with a particular issue.

Confidentiality

The IAP application form does not require any confidential information about your invention. Brief description of the invention requested at the IAP application stage is aimed at understanding, in general, to what the invention relates for IAP admission purposes. If it is needed for the local selection process, invention details can be requested by the IAP focal point in your country through a confidentiality form.

You will provide further details regarding your invention to the volunteer respecting relevant confidentiality requirements established by local laws and regulations, e.g. after signing a confidentiality agreement with the volunteer.

The next steps

If you already have an application submitted to your national patent office, the volunteer will assist you with managing your application, correspondence with, and prosecution before the patent office.

If it's not done before, the volunteer can help you to make a prior art search to have a clear picture on the chances to obtain a patent.

You should take care of needed office actions, in particular examination request. Remember that you may need to take a step or pay a fee to start the examination process, otherwise your application may become abandoned.

Should you wish to protect your invention also in other countries, you will be connected with a volunteer patent specialist to get free assistance for the Patent Cooperation Treaty (PCT) national and regional phase entry in selected jurisdictions. The request should be sent to WIPO by your local patent specialist at least six months before the due date of the national or regional phase of the PCT application.