

PATENT INFORMATION:

Info on different types of patents and procedures that can be followed in order to request the grant of a patent for an invention: I describe what cannot be patented, the International Patent Procedure, the fees, how long does it take to be granted a patent, etc.

I hope the information I am sending to you will help you having a clearer vision of the patent issue and procedure to follow.

Please note this paper is a compilation of patent information copyrighted and published by www.wipo.org. We have not innovated, modified or altered its content.

From filing until expiry of the patent, the invention passes through various stages in its life cycle:

- Once you have provided an adequate description of your invention, you can file your application for a patent directly at the Canadian Patent Office, as receiving office of International Patents, under the framework of the Patent Cooperation Treaty. If the minimum requirements are satisfied, this Office will send you confirmation of the filing date.
- In the next phase, the Canadian Patent Office will examine the patent application. If it meets all legal requirements (c.f. patent legislation and regulations), a patent is granted and published.
- As you know, you have a right of disposal over your patent throughout its entire active life, that is you can grant licenses on it or assign it to a third party. You have in your possession a legal document which describes and fully discloses your invention clearly enough for a person skilled in the art to carry it out.
- A patent expires at the latest 20 years after the filing date.

Main mistakes of inventors:

- To commercialise the product, in any place of the world, before patenting it: If you commercialise the product before patenting it, the feature of NOVELTY is destroyed, because the technical rule becomes public before filling the patent request.
If you feel the need to talk to someone before you apply, such as a potential business partner, you should ask him/her to sign a confidentiality agreement before you talk to them. This means they have to treat what you tell them in confidence. (I can provide you with a model type for this kind of agreements).
Any conversation you have with patent agents or solicitors is confidential, so anything you say will not count as revealing your invention early.
- To publish the investigation papers before patenting the invention in any place of the world: The publication of the content of the invention before filling the request for the grant of a patent can also destroy the NOVELTY element. By far the most common mistake made by people new to the world of patents is to reveal their invention too early: If you reveal your invention in any way – by word of mouth, demonstration, advertisement, article in a journal or any other way – before you apply for a patent, you are making your invention public. This could mean that you lose the possibility of being granted a patent.
You should avoid disseminating (the disclosure) the invention or publishing any article or text that may describe it because this could affect one of the requirements for filling a patent, that is to say, the NOVELTY requirement and therefore, it might also affect the validity of the patent that could be requested later on.
It cannot be emphasized enough that you should not disclose your invention before filing. Publish nothing about it, do not display it at an exhibition, as this will destroy the novelty of the invention, and you will no longer be able to patent it. It is

considered risky to negotiate with potential business partners before a patent application has been filed.

Your invention must be novel, that is, it must never have been made public in any way, anywhere in the world, before the date on which you file your application for a patent.

- Not to patent the invention and keep it in secret: If the invention can be easily imitated because of its external features it is not recommended to keep it into secret.
- To believe that what the inventor does not know, does not exist in consequence: Frequently, inventors believe that his/her invention is new because they have not seen something similar or identical in the market before. But the point is that this is not a reason to believe that the inventor's technical rule is not documented (patented). Frequent are the SURPRISES when an inventor discovers that what he/she invented has already been invented before, despite the fact that the product is not in the market. For this reason, the best thing to do before commencing any patent procedure is to check what is the percentage of success that the request of a patent may have. To do so, a previous search can be requested to the Canadian Patent Office. The result of the search to be granted in 15 days is a diagnosis on the level of NOVELTY of the invention.

This type of search can also be done for free through Internet, in data bases such as <http://es.espacenet.com>

You'll probably be surprised how many ideas already exist, even though you have never seen or heard of them. Of the millions of patent applications filed around the world every year, many fail to be granted – normally because a similar idea has been published before. To find out if your invention, or something like it, already exists, you can carry out an exploratory search of your own. In the long run, it can save you the time and expense of applying for a patent that is unlikely to be granted.

- There are some “priority deadlines” that sometimes are not respected and in consequence the NOVELTY characteristic of the inventions get lost: Once the patent applicant fills the request at the Canadian Office he/she must fill the application for the International Patent within the following 12 months counted as from the day of the first request.

What Cannot Be Patented?

- Ideas, hypotheses, discoveries, scientific theories, mathematical methods and aesthetic creations (designs) cannot be patented.
- Computer programs "as such" can also not be patented; however, inventions involving a program may under certain circumstances be patented. Computer-related inventions
- may be patentable, but only if they involve something more than just software running on a computer in a technically ordinary way.
- Rules of games, lottery systems, teaching methods and organisational procedures.
- Diagnostic, therapeutic and surgical methods used on the human or animal body.
- Plant varieties, animal species and essentially biological methods for breeding plants or animals.
- Inventions, the exploitation of which would be contrary to public policy or morality, also cannot be patented.
- In many countries, plant or animal varieties, discoveries of natural substances, commercial methods, or methods for medical treatment (as opposed to medical products) are generally not patentable.

Before filling the application for the grant of a patent

- You should evaluate the market in which you would like to exploit your invention in order to decide what type of patent would you like to request as the most convenient.

The decision will be directly connected to the extension of the territory of the market where you would like to exploit the patent.

- The types of patent are: National Patent (e.g. Canadian, UK, etc), European Patent (EPO), and International Patent (PCT). Please be aware that the Canadian Patent Office, grants national patents, but it is also in charge of the international patent procedure according to the PCT system.
- By submitting a national request in Canada you are granted A PRIORITY RIGHT for one year TO FILL THE INTERNATIONAL PATENT. If you submit the request for an international patent you get other 18 months of priority right before requesting the patent protection in the countries where you wish to exploit your invention that are part of the Patent Cooperation Treaty (PCT) or to request an European Patent.

The PCT does not provide for the grant of “international patents”: the task of and responsibility for granting patents remains exclusively in the hands of the patent Offices (e.g. Canadian Patent Office) of, or acting for, the countries where protection is sought (the “designated Offices” e.g. such as the UK).

The principal objective of the PCT is to simplify and to render more effective and more economical— in the interests of the users of the patent system and the Offices which have responsibility for administering it—the previously established means of applying in several countries for protection for inventions.

The International Filing

What are the advantages of an international application under the PCT?

An international application through the Patent Cooperation Treaty (PCT) allows filing for a patent in all of the Treaty States (116 as of June 1, 2002) chosen by the applicant. The filing entails a centralized application procedure with searches. However, the content examinations and final granting of the patent are done by the national or, respectively, regional offices named in the application, or, for example, the European Patent Office. Thus, contrary to popular opinion, there is no worldwide or international patent as such. There is only the possibility to apply internationally.

How long does it take?

The intl' patent application process usually takes between three and four years. There are ways to speed the process up, but these may not be in your best interests.

The process is designed for the applicant to “gain time” in order to avoid the payment of important fees at the beginning of the process. The process is artificially delayed in order for the applicant to go a step forward in the procedure only if he/she has the possibility to commercialize and exploit the patent.

Which address must be used for filing an international application other than the Canadian Patent Office?

The answer is The International Bureau of the World Intellectual Property Organisation:

International Bureau of WIPO
PCT Receiving Office Section
34, chemin des Colombettes
1211 Geneva 20
Switzerland

In the case of filings by hand-delivery, the PCT Receiving Office Section is open for that purpose from Monday to Friday, from 9.00 a.m. to 11.00 a.m. and from 2.15 p.m. to 4.15 p.m. A letter box is also available 24 hours a day, seven days a week.

For inquiries, please use the following numbers:

Telephone: (41-22) 338 93 52 (Head, PCT Receiving Office Section) or,
(41-22) 338 91 11 (switchboard);

Facsimile: (41-22) 910 06 10;
E-mail: ro.ib@wipo.int

The **PCT Information Service** can be contacted as follows:
Telephone: (41-22) 338 83 38
Facsimile: (41-22) 338 83 39
E-mail: pct.infoline@wipo.int

Where to get help on the PCT at WIPO on PCT-related questions (1)

PCT Infoline
Telephone +41 22 338 83 38
Fax +41 22 338 83 39
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PCT Processing Gijsbertus Beijer Tel. +41 22 338 94 79
Carlos Roy Tel. +41 22 338 95 61
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“PCT Receiving Office” Section Jean-Luc Baron Tel.+41 22 338 93 52
(RO/IB) Fax +41 22 910 06 10

Marketing and Distribution Section
Telephones +41 22 338 96 18
(PCT Publications) +41 22 338 99 30 / +41 22 338 95 90
Fax +41 22 740 18 12 / +41 22 733 54 28

WIPO Switchboard +41 22 338 91 11

PCT Internet Site Internet address <http://www.wipo.int/pct/en/index.html>

PCT-SAFE (Secure Applications Internet address <http://www.wipo.int/pct-safe> Filed Electronically) 04.02.04

Where to get help on the PCT at WIPO on PCT legal issues (2)

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Any resident or national of a PCT Contracting State (e.g. Canada, UK) may [file an international application](#) direct with the International Bureau of WIPO as receiving Office, as an alternative to filing with the competent national or regional Office (see [PCT Rule 19.1\(a\)\(iii\)](#)).

International applications may be filed direct with the International Bureau as receiving Office by [mail](#) or [hand-delivery](#) to WIPO's headquarters, or by [facsimile](#) provided that the original of the faxed application is furnished within 14 days from the date of the fax transmission.

The International Bureau will promptly send to the applicant by fax or by mail an acknowledgment of receipt of the international application or other document (Form PCT/RO/199 (available in [Adobe PDF](#) format). Where the international application is sent by facsimile, Form PCT/RO/199 will be faxed on the same day or, if received outside working hours or on non-working days, on the following working day.

The two-letter code IB will appear in international application numbers accorded by the International Bureau as receiving Office.

WIPO's new software, PCT-SAFE

WIPO's new software, PCT-SAFE, enables the fully electronic filing of PCT international applications, either on-line over the Internet or using physical media (e.g. CD-ROMs, DVDs). In order to facilitate the transition to electronic filing, this system is based on the PCT-EASY software (used in some 45 % of all PCT applications in the end of 2003, over 11 000 user registrations) and it also incorporates full PCT-EASY functionality, allowing for the creation and printing of the validated PCT-EASY request form and the PCT-EASY diskette.

Filing of Request in PCT-EASY Format Together with PCT-EASY Diskette Containing Request Data and Abstract

(a) Pursuant to Rule 89~~ter~~, any receiving Office may, if it is prepared to do so, accept the filing with it of an international application containing the request presented as a computer print-out prepared using the PCT-EASY software made available by the International Bureau ("request in PCT-EASY format") together with a computer diskette, prepared using that software, containing a copy in electronic form of the data contained in the request and of the abstract ("PCT-EASY diskette").

(b) Any receiving Office which, under paragraph (a), accepts the filing of requests in PCT-EASY format together with PCT-EASY diskettes shall notify the International Bureau accordingly. The International Bureau shall promptly publish any such information in the Gazette.

(c) Item 3(a) of the Schedule of Fees annexed to the Regulations shall apply to reduce the fees payable in respect of an international application containing the request in PCT-EASY format filed, together with a PCT-EASY diskette, with a receiving Office which, under paragraph (a), accepts the filing of such international applications.

Before and after the introduction of the PCT system

Before the introduction of the PCT system, virtually the only means by which protection of an invention could be obtained in several countries was to file a separate application in each country; these applications, each being dealt with in isolation, involved repetition of filing and the work of examination in each country. To achieve its objective, the PCT:

- establishes an international system which enables the filing, with a single patent Office (the “receiving Office”), of a single application (the “international application”) in one language having effect in each of the countries party to the PCT (“designated States”);
- provides for the formal examination of the international application by a single patent Office, the receiving Office;
- subjects each international application to an international search and examination which results in a report citing the relevant prior art (mainly published patent documents relating to previous inventions) which may have to be taken into account in deciding whether the invention is patentable and an opinion as to whether the claimed invention meets certain international criteria of patentability; the report and the opinion are made available first to the applicant and the report is later published;
- provides the option of an international preliminary examination of the international application which gives to the Offices that have to decide whether or not to grant a patent, and to the applicant, a report containing an opinion as to whether the claimed invention meets certain international criteria for patentability.

The international application implies two phases: the “international phase” of the PCT procedure, and the “national phase” which describes the last part of the patent granting procedure which is the task of the designated Offices.

International applications under the PCT

You complete an application – the procedures are set out in our booklet *PCT notes for private applicants* and also in the booklet *WIPO basic facts about the PCT*, both of which are available from our Central Enquiry Unit.

We receive your application and send it to WIPO along with a copy to an ‘international search authority’. In our case, this is the branch of the European Patent Office (EPO) at The Hague, where a search is carried out to see if your invention has been described by others before.

WIPO publishes your international application, together with the search report, as soon as possible after 18 months from your priority date.

After publication you can file a request for an ‘international preliminary examination’, which is carried out by the EPO. This examination is optional and you will have to pay a fee. However, it will give you an initial, non-binding opinion as to whether your invention is new and inventive (not obvious) and capable of being used in any kind of industry.

At least 30 months after the priority date, your application enters what is known as the ‘national phase’. Each country processes your application as a national one, as long as you have paid their fees and supplied a translation of the application (if needed) within the set time limit.

What special features have to be taken into account?

The WIPO-administered **Patent Cooperation Treaty (PCT)** provides for the filing of a single **international patent application** which has the same effect as national applications filed in the designated countries. An applicant seeking protection may file one application and request protection in as many signatory states as needed.

The Patent Cooperation Treaty (PCT) allows you the possibility of filing a single application for a patent in any of more than 123 treaty member states, which you specifically designate at the time of filing. This international route is a centralised filing and search procedure. The international patent application is the subject of an international search by an authority specialising in this area, the results of which are

made available to the applicant in an international search report. The applicant may opt to request an international preliminary examination, which may be considered to be an expert opinion on the application. The national or regional offices designated in the application are then responsible for granting the patent within their area of jurisdiction.

The competent Authorities are the same as would have been competent if the international application had been filed with the national Office of, or acting for, a Contracting State of which the applicant is a resident or national (see [PCT Rules 35.3](#) and [59.1\(b\)](#)). This may result in a wider choice of Authorities for international applications filed with the International Bureau as receiving Office if there are two or more applicants from different Contracting States. The choice of International Searching Authority (see [PCT Applicant's Guide, Volume I, Annex C](#)) must be indicated in the request and the choice of International Preliminary Examining Authority (see [PCT Applicant's Guide, Volume I, Annex C](#)) must be indicated in the demand.

Who can act as agent?

Any person who has the right to practice before the national Office of, or acting for, a Contracting State of which the applicant, or, if there are two or more applicants, any of the applicants, is a resident or national is entitled to practice in respect of the international application before the International Bureau in its capacity as receiving Office (see [PCT Rule 83.1bis](#)).

What fees are payable?

Fees may be paid in Swiss francs, US dollars, or euro. The amounts payable are as follows (see also, for applicable reductions, the [Schedule of Fees](#) annexed to the Regulations under the PCT and the [PCT Applicant's Guide, Volume I, Annex C\(1B\)](#)).

	Swiss francs	US dollars	euro
Transmittal fee	100	81	64
International filing fee	1,400	1,134	902
Supplement per sheet over 30	15	12	10
Search fee [Adobe PDF]	Depends on International Searching Authority chosen		
Fee for priority document (if applicable)	50	41	32
Reductions to the international filing fee are available for users of PCT-SAFE			

According to my search an European Patent may costs around 3099 Euros (one country: UK), an International Patent requested in the country may cost 3600 Euros, the same International Patent requested at WIPO in Switzerland may cost 4713.56 Swiss Francs (around 3040 Euros)

Special Fees Payable to the International Bureau

(a) The special publication fee provided for in Rule 48.4 shall be 200 Swiss francs.

(b) The special fee provided for in Rule 91.1(f) shall be payable to the International Bureau and

shall be 50 Swiss francs plus 12 Swiss francs for each sheet in excess of one. Where that fee has not been paid before the time of the completion of the technical preparations for international publication, the request for rectification shall not be published. Where the last sentence of Rule 91.1(f) applies and the said fee has not been paid before the time of the communication of the international application under Article 20, a copy of the request for rectification shall not be included in that communication.

(c) The special fee provided for in Rule 26bis.2(c) shall be payable to the International Bureau

and shall be 50 Swiss francs plus 12 Swiss francs for each sheet in excess of one. Where that fee has not been paid before the time of the completion of the technical preparations for international publication, the information concerning the priority claim which was considered not to have been made shall not be published. Where the last sentence of Rule 26bis.2(c) applies and the said fee has not been paid before the time of the communication of the international application under Article 20, a copy of the information concerning the priority claim which was considered not to have been made shall not be included in that communication.

What modes of payment of fees are available?

Fees may be paid in any of the following ways:

- by debit from a [current account](#) established with WIPO (Swiss francs only)
- by bank transfer to WIPO's [bank account](#) (Swiss francs, US dollars or euro)
- by transfer to WIPO's [postal account](#) (Swiss francs only)
- by [check](#) made payable to the World Intellectual Property Organization (Swiss francs, US dollars or euro)
- in [cash](#) (only if payment is made in person; in Swiss francs only).

All PCT filing fees will be payable to the International Bureau (in Swiss Francs or US Dollars). Any fees paid to the non-competent Office, other than a fee equal to the transmittal fee (where required), will be refunded by that Office.

Schedule

PCT system

Local patent application followed within 12 months by international application under the PCT, claiming Paris Convention priority, with “national phase” commencing at 30 months*:

- one set of formality requirements
- international search
- international publication
- international preliminary examination
- international application can be put in order before national phase
- translations and national fees required at 30 months*, and only if applicant wishes to proceed

General remarks on the PCT system

- The PCT system is a patent application “filing” system, not a patent “granting” system. There is no “PCT patent”.
- The PCT system provides for – an international phase comprising:
 - filing of the international application
 - international search
 - international publication and
 - international preliminary examination – a national/regional phase before designated Offices
- The decision on granting patents is made exclusively by national or regional Offices in the national phase.

International Patent Classification

The subject of the invention is classified in accordance with the [International Patent Classification \(IPC\)](#). The purpose of this classification is to ensure that specific information can be retrieved when searching millions of patent documents. The IPC currently consists of some 65,000 terms. Every five years, this classification system is

updated and refined to bring it into line with technological developments.

The International Patent Classification (IPC) is divided into the following sections:

A Human Necessities

B Performing Operations; Transporting

C Chemistry; Metallurgy

D Textiles; Paper

E Fixed Constructions

F Mechanical Engineering; Lighting; Heating; Weapons; Blasting

G Physics

H Electricity

More info: http://www.wipo.int/classifications/fulltext/new_ipc/index.htm

The International Patent Classification (IPC) is a hierarchical system in which the whole area of technology is divided into a range of sections, classes, subclasses and groups. This system is indispensable for the retrieval of patent documents in the search for establishing the novelty of an invention or determining the state of the art in a particular area of technology.

Please do not hesitate to contact me for further details, questions, remarks and anything else you may wish to know regarding the patentability of your invention, confidentiality agreements, licensing, etc.