

PATENTS

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1) What is a patent?

Under US law, there are three types of recognized patents, namely:

- Utility
- Design
- Plant

- Utility patents may be granted to anyone who invents or discovers any new and useful process, machine, article of manufacture, or composition of matter, or any new and useful improvement thereof.

- Design patents may be granted to anyone who invents a new, original, and ornamental design for an article of manufacture.

- Plant patents may be granted to anyone who invents or discovers and asexually reproduces any distinct and new variety of plant.

A common misconception is that a patent gives its owner the right to make, use or sell inventions. In fact, a patent gives its owner the right to **EXCLUDE** other people from making, using or selling the claimed invention. The patent owner him-/herself may also be forbidden from using his/her own invention, due to the existence of another patent or other legal restrictions.

2) How long are patents valid?

In the US, this depends on when the patent was filed. If prior to June 8th 1995, the term is the later of two dates, either 17 years from the date of issuance or 20 years from the date of the first US filing. If filed after this date, the term is always 20 years. The valid patent term from the date of issuance in the US is 14 years for design patents and 17 years for plant patents.

3) Which inventions can be patented?

Again in the US, in order to be patentable, the invention must fall into one of five classes, namely

- Processes
- Machines
- Manufactures (ie. objects made by humans or machines/robots)
- Compositions of matter
- New uses of any of the above

The invention must be **useful**, and **utility tests** dictate that it cannot be a purely theoretical phenomenon. In the 1800s, US patent applicants had to provide a working model of their invention, but this requirement was later dropped. However, the US Patent Office still has the power to require submission of such models in certain cases (and has done so when applicants claim to have invented machines such as perpetual motion).

The invention must also be **novel** (ie. something that no-one has done before). It must be **unobvious** to a person having ordinary skill in the art to which said subject matter

pertains (you could not patent a sponge as an 'Automobile windscreen debri-remover' for example).

4) The Paris Convention

The Paris Convention is a treaty adhered to by 130 countries, and which helps patent applicants obtain protection in more than one country. Without the Convention, an applicant would otherwise have to file an application in several countries simultaneously (because, for example, filing in country A would prevent the filing of a patent application in country B). Because of the Convention, the applicant need only file in one of two countries and then postpone filing in country B for almost a year. Once the filing is done in B, the applicant claims priority from the A filing and the B patent office will treat its application as if it had been filed on the date A was filed. The convention allows an inventor to defer costs, and in addition, if the patent later gets abandoned within 12 months, the inventor will save money that would be spent filing in other countries.

5) PCT (Patent Cooperation Treaty)

The PCT is adhered to by 130 countries and administered by the **World Intellectual Property Organization**. It represents an effort by many countries to provide streamlining of patent application across several countries. Under PCT protocol, a patent applicant can wait for up to 30 months to decide in which countries the patent should be applied for.

6) ISA (International Searching Authority)

Every PCT patent application has to be searched by one of the International Searching Authorities. In the US it is the **US Patent Office**, in Europe it is the **European Patent Office**, in Russia it is the **Russian Agency for Patents and Trade Marks** (formerly the Russian Patent Office) etc.

7) What is an International Patent Application?

An International Patent Application is one filed under the Patent Cooperation Treaty and administered by the **World Intellectual Property Organization**. An International Patent Application does not lead to an International patent, but merely permits the pursuit of patent coverage over a wider range of permissible times than if the application had not been filed.

8) EPC (European Patent Convention)

This Convention has given rise to the European Patent Office (EPO). Although the EPO had its origins in the European Union, EPO formalities can also lead to patent coverage in non EU countries.

9) Can individuals do their own patent searching?

Yes. One of the most important providers of online patent information is **Derwent** (See the last section of this document 'Ordering patents at the University of Auckland'). Derwent has available the following patent resources:

World Patent Index (cont...)

Inpadoc
Japio (Japanese)
US Copyrights
US Patents Fulltext
Trademarkscan
Lexis (US utility, design and plant patents in full text)
Questel (commercial databases on patents and trademarks)

10) Patents vs Copyright

There are important differences between patents and copyright. A copyright covers the expression of a given work, but does not stop someone appropriating ideas embedded within that work. This mostly affects software programs. If a program has a clever idea embedded within it and the writer wishes to protect the use of those ideas, the writer will be unlikely to be able to do so through copyright but may be able to do so through a patent. Bear in mind however that copyright is between 50 and 75 years (internationally) compared to a (US) patent life of 14-17 years.

11) What Is a Trademark or Servicemark?

A trademark is a word, name, symbol, or device used in trade with goods to indicate the source of the goods and to distinguish them from the goods of others. A servicemark is the same as a trademark except that it identifies and distinguishes the source of a service rather than a product. The terms 'trademark' and 'mark' are commonly used to refer to both trademarks and servicemarks.

Trademark rights may be used to prevent others from using a similar mark which may be confusing (ie a pizza delivery car with the same company markings as a police car), but not to prevent others from making or selling the same goods or services under a clearly different mark. Trademarks which are used in US interstate or foreign commerce may be registered with the USPTO (US Patent and Trademark Office). The registration procedure for trademarks and general information concerning trademarks is described on the page 'Basic Facts about Trademarks' (<http://www.uspto.gov/web/offices/tac/doc/basic/>).

12) Why keep laboratory notebooks?

Lab notebooks or other records of lab results are important for several reasons. In the US, if two applicants are seeking a patent on the same invention, the patent is not necessarily awarded to the person who files for it first, but rather is sometimes awarded to the person who was the first to invent. Establishing priority of invention often rests on data records and other documentation.

13) Provisional Patent Applications

Effective as of June 8th 1995 as a result of the GATT free trade talks, one can file a Provisional Patent Application with the US Patent and Trademark Office. This is intended as a low-cost way of postponing the cost of drafting and filing a full latent application. It need not contain claims and the filing fee is \$200 for large entities and \$100 for small ones. The applicant must then wait almost a year before filing a full patent application.

Patent FAQ (US patent details)

Q. What do the terms 'patent pending' and 'patent applied for' mean?

A. They are used by a manufacturer or vendor of an article to inform the public that an application for patent on that article is on file at the Patent and Trademark Office. In the US, the law imposes a fine on those who use these terms falsely to deceive the public.

Q. Is there any danger that the 'Patent and Trademark Office' will give others information contained in my application while it is pending?

A. No. All patent applications are maintained in the strictest secrecy until the patent is issued. After that, however, the Office file containing the application and all correspondence leading up to issuance of the patent is made available in the Files Information Room for inspection by anyone.

Q. If two or more persons work together to make an invention, to whom will the patent be granted?

A. If each had a share in the ideas forming the invention, they are joint inventors and a patent will be issued to them jointly on the basis of a proper patent application. If on the other hand one of these persons has provided all of the ideas of the invention, and the other has only followed instructions in making it, the person who contributed the ideas is the sole inventor and the patent application and patent shall be in his name alone. (Also see section 12 above)

Q. If one person furnishes all of the ideas to make an invention and another employs him or furnished the money for building and testing the invention, should the patent application be filed by them jointly?

A. No. The application must be signed by the inventor only, and filed in the Patent and Trademark Office in his/her name. This is the person who furnishes the ideas, not the employer or person/s who finance/s the project.

The preceding information was variously modified from the following sources:

'General Information about Patents' @

<http://www.oppedahl.com/patents/>

'General Information Concerning Patents' @

<http://www.uspto.gov/web/offices/pac/doc/general/#patent>

'The Lectric Law Library' @

<http://www.lectlaw.com>

Ordering patents at the University of Auckland

Students and/or staff at the University of Auckland should use the Interloans Service to order all patents, NZ or otherwise. You can do this by going to the Interloans Dep on the 1st floor of the General Library next to the Photocopying office, or by going online to Interloans via the LEARN link at <http://www.library.auckland.ac.nz/forms/docdel/interloans/>

Interloans will purchase New Zealand patents from Searchlink Limited in Wellington. The charge is \$25 for the first 30 pages and 20c/page after that. This cost is entirely covered by the library if you request the patent via Interloans. **Please note that if you request the patent from Searchlink yourself, the library will not cover the cost.**

Non-NZ patents

The Interloans Dep orders U.S. patents from **Optipat** at www.optipat.com (**Micropatent**) If they don't have the patent number they locate it first at www.delphion.com

These two sites are part of **Derwent patents** of Thompson Scientific at: <http://scientific.thomson.com/products/dwpi/>

This site has some free resources, including a biology browser and a comprehensive index to organism names. Otherwise, use of the site will require registration. Micropatent is the world's largest commercial provider of US file histories. Recent patents can be downloaded by Interloans staff but older patents must be ordered in print form.

Again, **please give all such requests to the Interloans Dep.** If you have it, always include the patent number with your request.

If you order patents directly yourself, you will be charged for them.

Interloans also order other types of patents from this site including European Patent Office (EPO) and those with WIPO (World Intellectual Property Organization) and PCT numbers. Foreign patents are quite expensive and Interloans will often order them from the British Library.

Locating patents

The best sources in which to search for foreign patents are the databases **Scopus** and **SciFinder Scholar**. Scopus has details of 12.7 million patents, most of which are linked to EPO, while SciFinder Scholar has access to 5.2 million patents from both Europe and the US.

Access from Scopus is by searching under topic or patent number (generally patent number is the less successful method) and then clicking the 'Patents' link in the results options. You can then narrow it down to the type of patent (EPO, WIPO etc).

Access on SciFinder Scholar is by choosing either the 'Explore' option if you intend to do a topic search, then by limiting the results to patents,

or by choosing the 'Locate' option if you already have the patent number.