

# International Patent Regime

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# Patent-related treaties

WIPO-administered treaties	Member States
• Paris Convention (concluded 1883)	173
• Patent Cooperation Treaty (1970)	141
• Strasbourg Agreement (1971)	59
• Budapest Treaty (1977)	72
• Patent Law Treaty (2000)	19

## Treaties outside WIPO

- WTO TRIPS Agreement (1994)
- Regional treaties

# Paris Convention for the Protection of Industrial Property (1883)

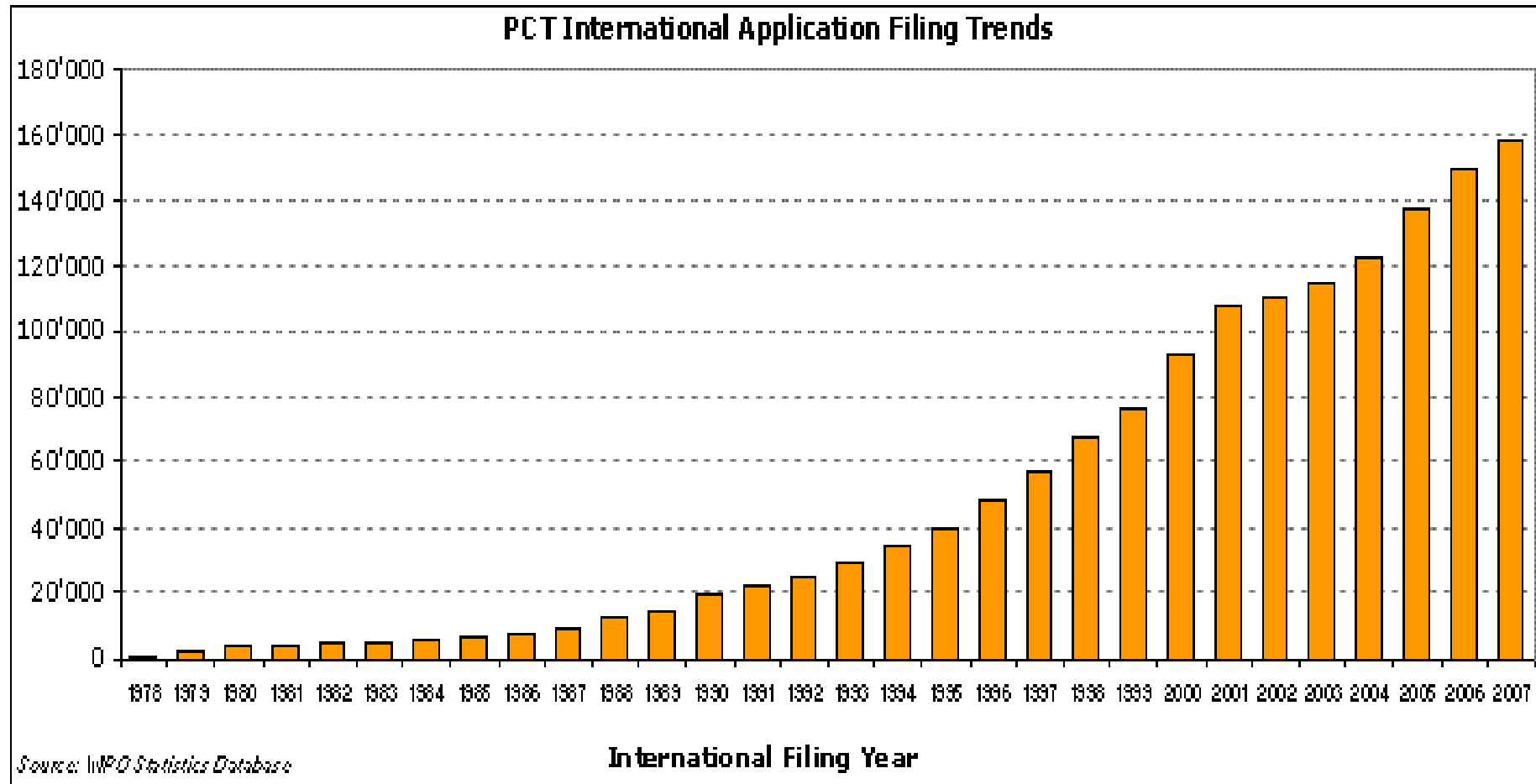
- National treatment national law must afford patent protection to foreigners the same as locals (Art 3)
- Right of priority up to 12 months from date of first application for the same invention filed in a Member State (Art 4)
- Independence of patents granted in different Member States (Art 4*bis*)
- Compulsory licensing (CL) to prevent patent abuses (Art 5A)

# Patent Cooperation Treaty 1970

- A mainly procedural international treaty facilitating certain steps in the process of obtaining patents internationally
- The PCT establishes a procedure for the filing and processing of a single application for a patent which has legal effect in the countries which are Treaty members
- Simplifies the procedure for obtaining patent protection in many countries, making it more efficient and economical for:
  - (1) users of the patent system (applicants and inventors); and
  - (2) patent Offices

- The decision on granting patents is made exclusively by national or regional Offices in the national phase
- Signed in June 1970, in Washington, D.C., and became operational in June 1978 with 18 States
- As of May 2015, the PCT has 144 Contracting States

## Growth in PCT filings



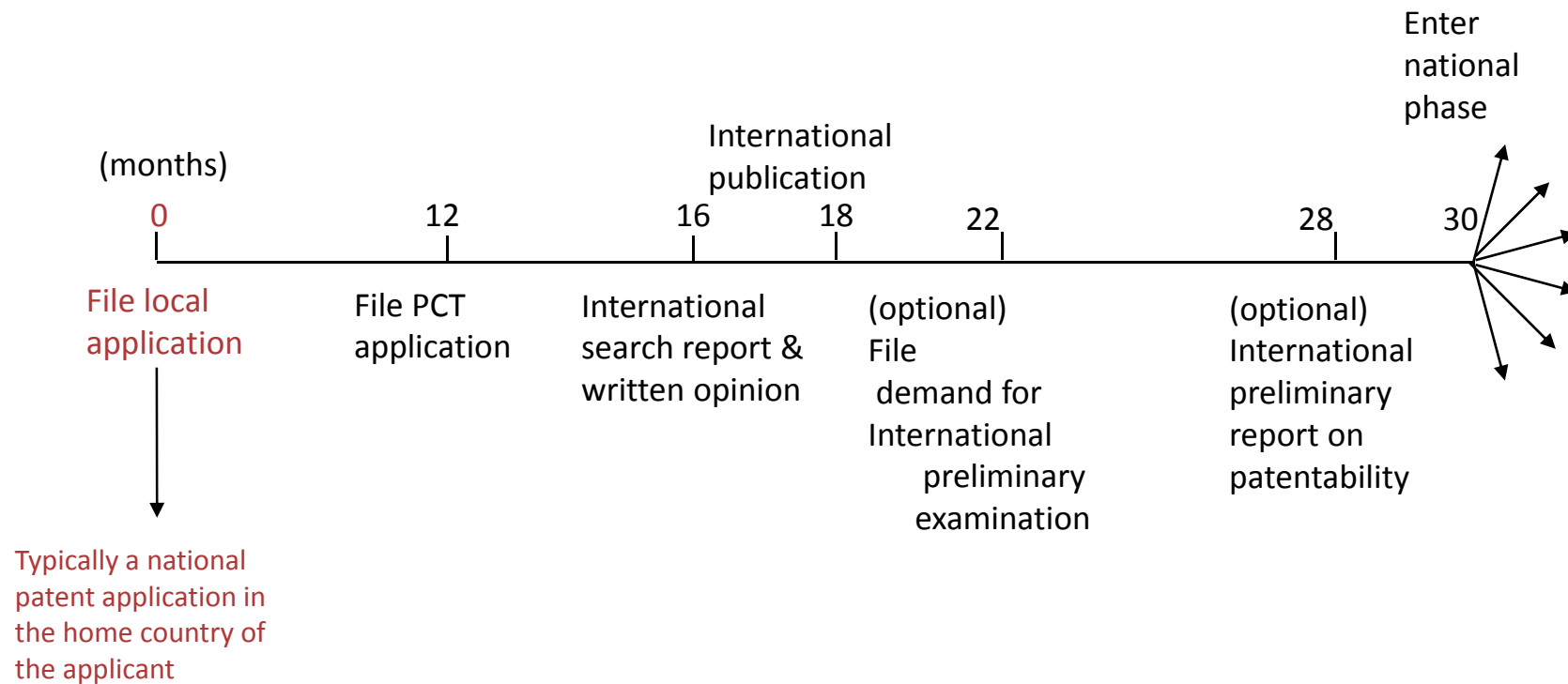
# The PCT System

--typical use, in more detail



# The PCT System

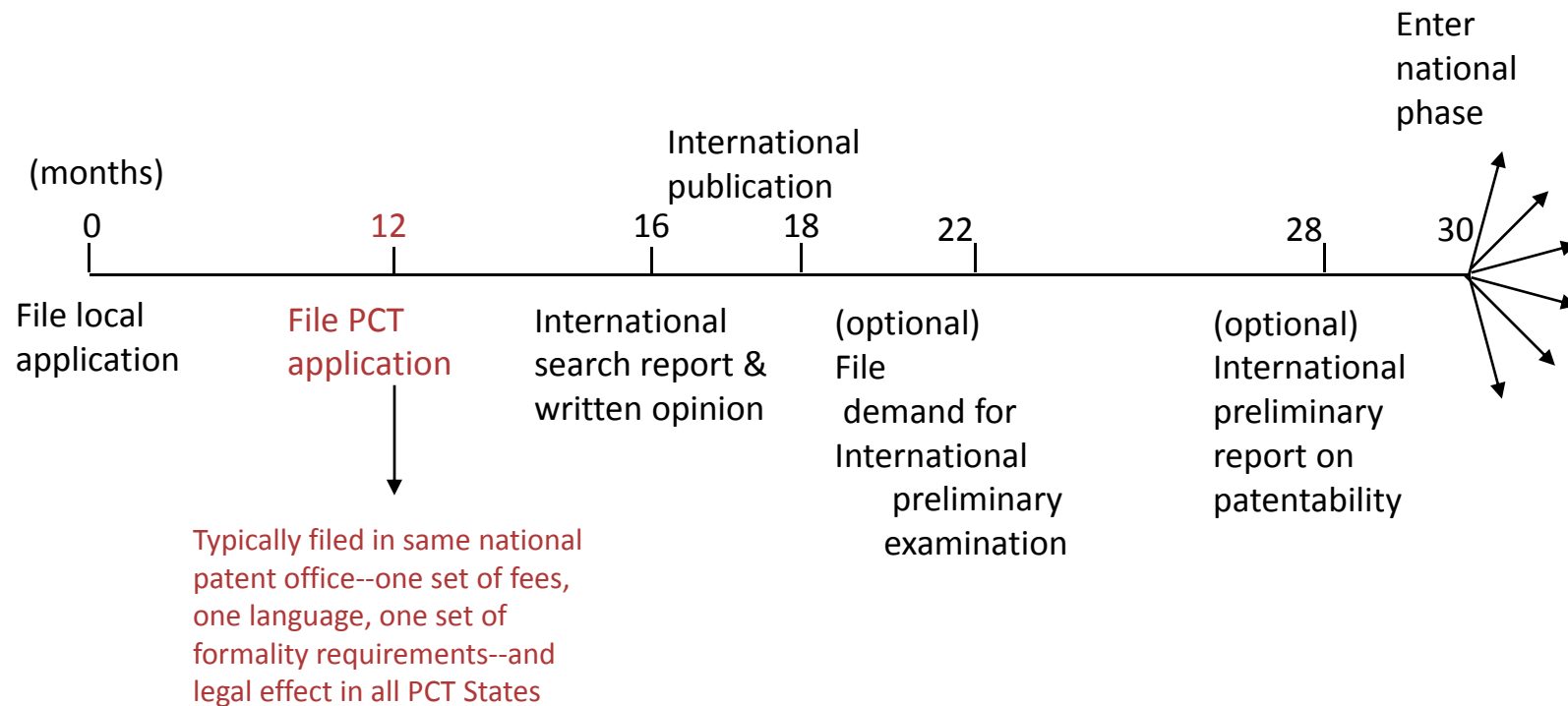
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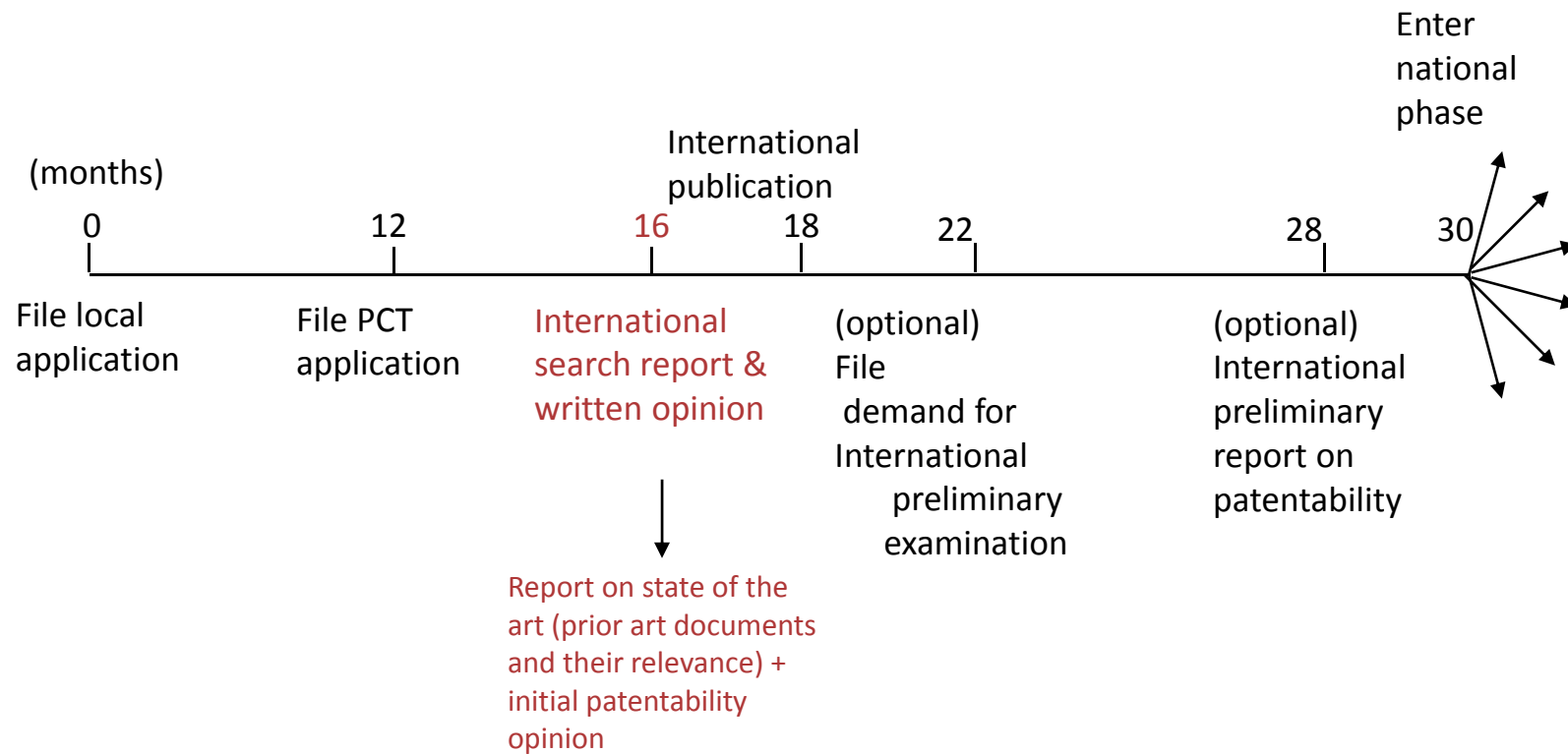
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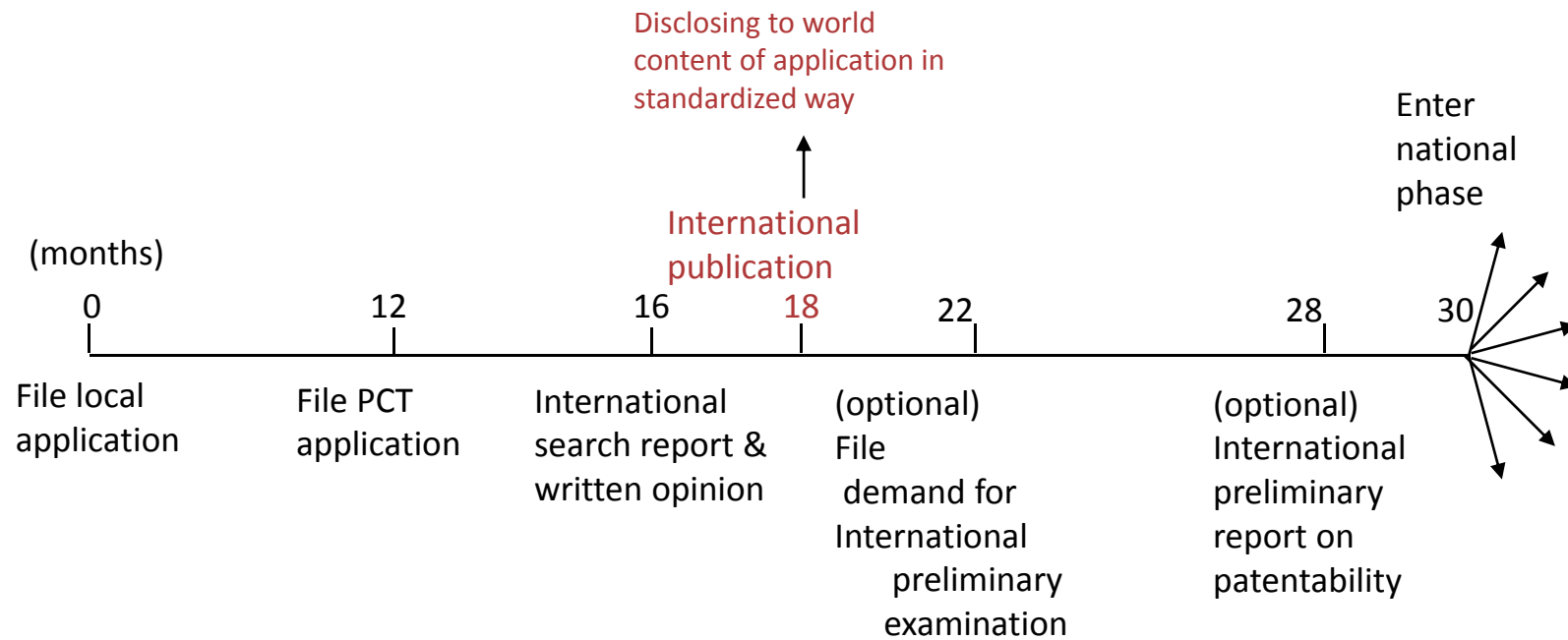
# The PCT System

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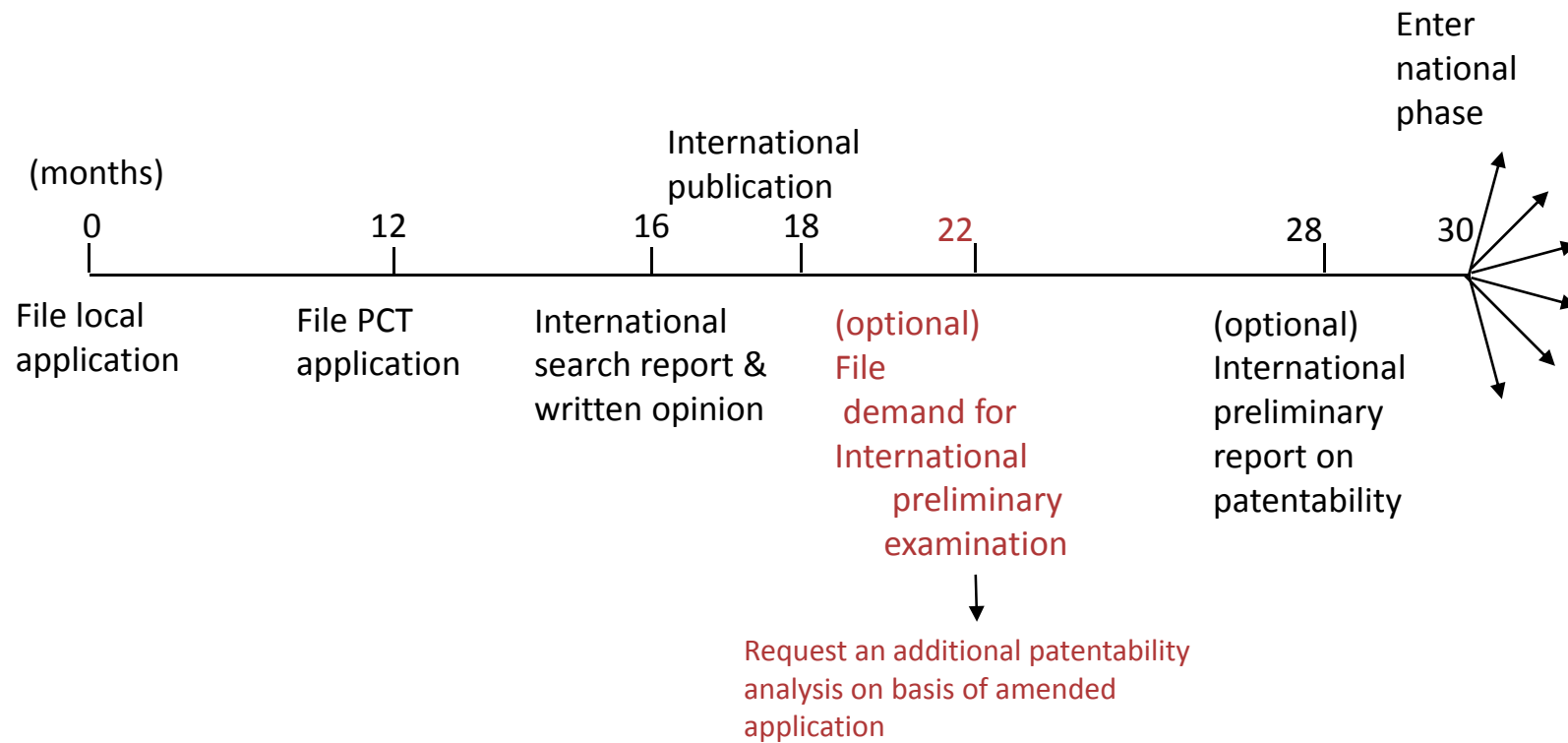
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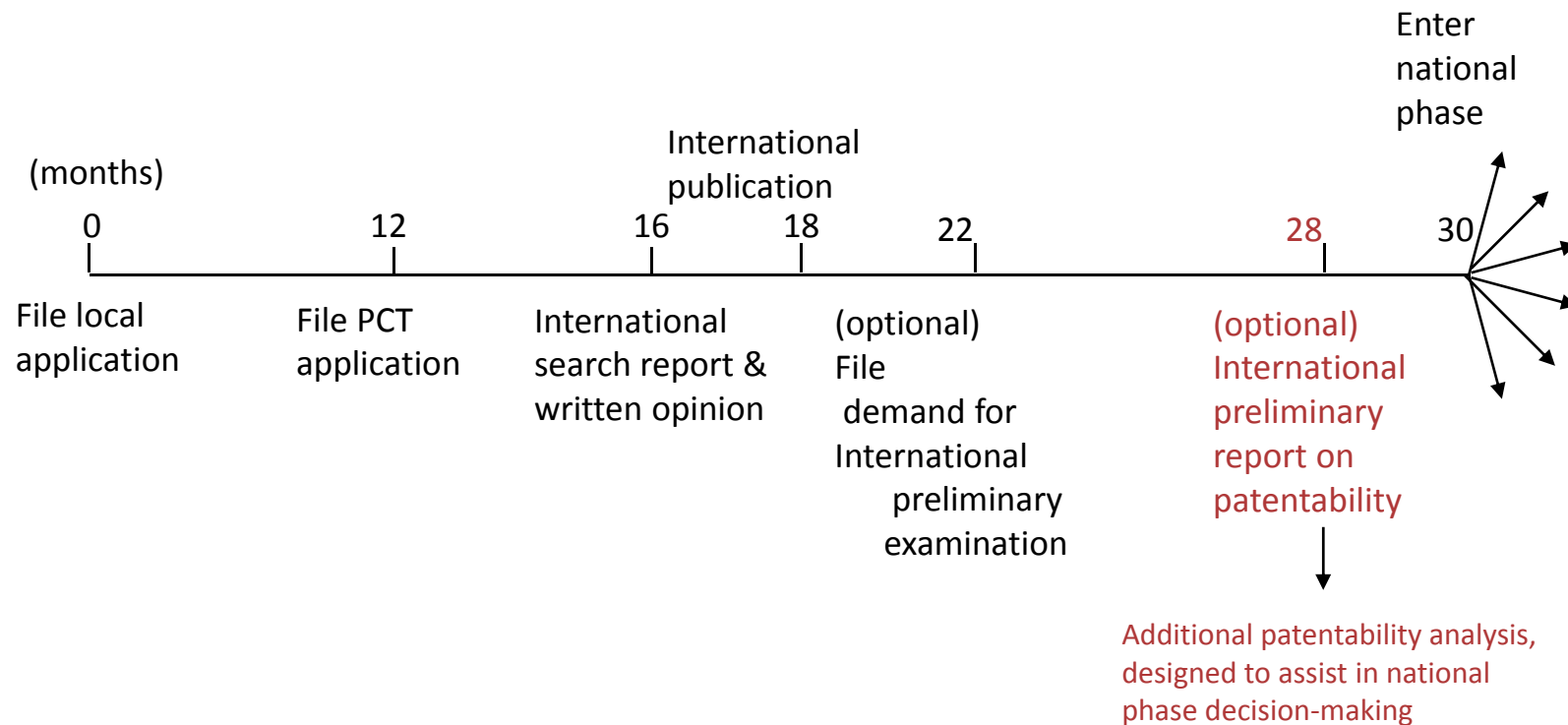
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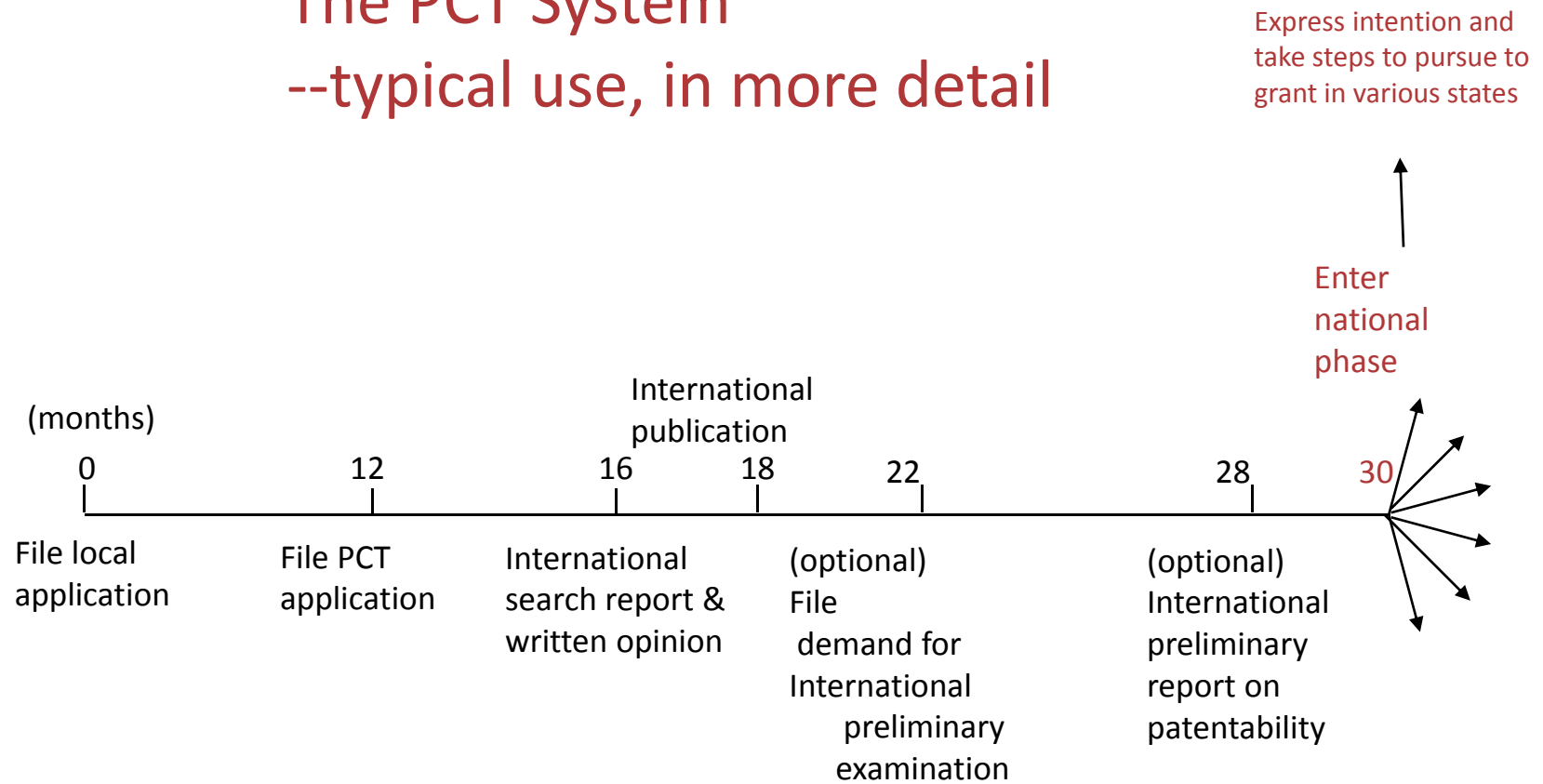
# The PCT System

--typical use, in more detail



# The PCT System

--typical use, in more detail



# Bibliographic data

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Organization  
International Bureau



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← Publication number

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(74) Agents: **BENSON, John, Everett et al.**; J.A. Kemp & Co.,  
14 South Square, Gray's Inn, London WC1R 5JJ (GB).

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PCT/GB2003/004367

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← Designated states

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Applicant →

(71) Applicant (for all designated States except MW, US):  
**THE ETHIOPIAN AGRICULTURAL RESEARCH ORGANISATION** [ET/ET]; P.O. Box 2003, Addis Ababa (ET).

**Published:**

- with international search report
- before the expiration of the time limit for amending the claims and to be republished in the event of receipt of amendments

Inventor →

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(72) Inventor; and

(75) Inventor/Applicant (for US only): **KASSA, Bayoh, Tirunch** [ET/ET]; The Ethiopian Agricultural Research Organisation, P.O. Box 2003, Addis Ababa (ET).

For two-letter codes and other abbreviations, refer to the "Guidance Notes on Codes and Abbreviations" appearing at the beginning of each regular issue of the PCT Gazette.

C. DOCUMENTS CONSIDERED TO BE RELEVANT		
Category*	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
X	JP 50-14535 B (NCR CORPORATION) 28 May 1975 (28.05.75), column 4, lines 3 to 27	7-9, 11
X Y A	GB 392415 A (JONES) 18 May 1933 (18.05.33) Fig. 1 page 3, lines 5-7 Fig. 5, support 36	1-3 4, 10 11-12
X Y	GB 2174500 A (STC) 5 November 1986 (05.11.86) page 1, lines 5-15, 22-34, 46-80; Fig. 1	1-3 4
A	US 4322752 A (BIXTY) 30 March 1982 (30.03.82) claim 1	1
A	GREEN, J.P. Integrated Circuit and Electronic Compass, IBM Technical Disclosure Bulletin, October 1975, Vol. 17, No. 6, pages 1344 and 1345	1-5

Symbols indicating which aspect of patentability the document cited is relevant to (for example, novelty, inventive step, etc.)

Documents relevant to whether or not your invention may be patentable

The claim numbers in your application to which the document is relevant



WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY

International application No.

Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Claims	<u>Claim(s) 3-15</u>	YES
	Claims	<u>Claim(s) 16</u>	NO
Inventive step (IS)	Claims	<u>Claim(s) 8, 10-12</u>	YES
	Claims	<u>Claim(s) 3-7, 9, 14-16</u>	NO
Industrial applicability (IA)	Claims	<u>Claim(s) 3-16</u>	YES
	Claims	_____	NO

2. Citations and explanations:

**INDEPENDENT CLAIM 3**

Document US-A-5 332 238, which is considered to represent the most relevant state of the art, discloses (cf. relevant passages indicated in the ISR) a device from which the subject-matter of **INDEPENDENT CLAIM 3**

Document US-A-5 332 238, which is considered to represent the most relevant state of the art,

Reasoning supporting  
the assessment

Patentability  
assessment  
of claims

What does the applicant do with the information from the ISR, ISO and IPRP Ch. II?

Used as a basis for their patenting decisions--decisions about:

- 1) whether to enter the national phase
- 2) where to enter the national phase

Example--

Based on the information received during both Chapters I and II, the Procter & Gamble company found that it:

- abandoned 20% of PCT filings at national phase (did not enter national phase at all anywhere);
- when it did enter national phase, it did so in only 70% of the States it had originally intended to patent in

## PCT Costs--in perspective

According to IP Global Estimator, the total cost of hypothetical application would be USD \$232,742

Thus, the PCT filing fees, including the international search by the EPO, (total: USD \$3,637) represented **1.6% of what the PCT applicant could expect to pay throughout the full life of this patent family**

## Patents under the TRIPS Agreement

- Mandatory minimum standards of protection
- Right to choose method of implementation
- Introduction of most-favored nation (MFN) treatment into IP law
- Patents available for all areas of technology

# Minimum standards

- WTO Members in domestic implementation of TRIPS rules
  - must not go below minimum standard of protection
  - but they may provide higher protection (« TRIPS-Plus »)
  - Example: minimum term of patent protection = 20 years from filing date
  - Increasing number of FTAs with TRIPS-Plus provisions , eg US – Vietnam Bilateral Trade Agreement (option to extend patent term in some cases)

# Art 27 Non-discrimination

- WTO Members must make patents available without discrimination
  - for any inventions (products or processes)
  - in all fields of technology
    - e.g. no exclusion of pharmaceuticals
  - as to place of invention
  - whether imported or locally produced

## Optional exclusions from patentability

- Inventions against *ordre public*; morality; human, animal, plant life or health; environment
- Methods of medical treatment
- Plants & animals
  - Incl biological processes for production of plants & animals
  - But not micro-organisms and non-biological production processes
  - Plant varieties: either patent or *sui generis* system or combination thereof

# Patentability requirements

- Novelty
  - anything not available to public prior to the date of patent application
- Inventive step (non-obviousness)
  - anything not obvious to person skilled in the art on date of patent application, having regard to prior art (=existing knowledge)
- Industrial application (utility)
  - any invention that may be manufactured or used in any commercial activity → need for an industrial product



# Art 28 Rights conferred

- Product patents: making, using, offering for sale, selling, or importing the substance
- Process patents:
  - Using the process (method-of-making)
  - Using, offering for sale, selling, or importing product directly obtained by process (method-of-use)

# Patent Law Treaty (PLT)

- Entered into force on April 28, 2005
- (Presently) 19 Contracting States
- Streamlines and simplifies formal requirements for national and regional patent applications and patents (e.g. filing date requirements)
  - in general, a maximum set of requirements that Offices may apply
  - model international forms
    - request form, change in name or address, change in applicant or owner, power of attorney etc.
  - avoidance of unintentional loss of rights
    - extension of time limit / continued processing
    - restoration of rights

Budapest Treaty on the International Recognition of the  
Deposit of Microorganisms for the Purposes of Patent  
Procedure, 1977.

## Strasbourg Agreement Concerning the International Patent Classification, 1971

- The International Patent Classification (IPC), established by the Strasbourg Agreement 1971, provides for a hierarchical system of language independent symbols for the classification of patents and utility models according to the different areas of technology to which they pertain.
- Version 2015.01 of the IPC came into force on January 1, 2015.

- [A01B](#) SOIL WORKING IN AGRICULTURE OR FORESTRY; PARTS, DETAILS, OR ACCESSORIES OF AGRICULTURAL MACHINES OR IMPLEMENTS, IN GENERAL (making or covering furrows or holes for sowing, planting or manuring [A01C 5/00](#); machines for harvesting root crops [A01D](#); mowers convertible to soil working [apparatus](#) or capable of soil working [A01D 42/04](#); mowers combined with soil working implements [A01D 43/12](#); soil working for engineering purposes [E01](#), [E02](#), [E21](#))

# Regional treaties

- African Regional Intellectual Property Organization (ARIPO)
- Eurasian Patent Office (EAPO)
- European Patent Office (EPO)
- Gulf Cooperation Council (GCC)
- Organisation africaine de la propriété intellectuelle (OAPI)

# Exceptions to *granted* patent rights

- General exception clause (Art 30 TRIPS)
- Three-step test comparable to copyright
  - Exceptions are limited (step 1)
  - No unreasonable conflict with normal exploitation of patent (step 2)
  - No unreasonable prejudice to legitimate interests of patent owner, taking into account legitimate third party interests (step 3)