

Mentor Guide

Session 3:

Securing IP Protection for your Mentee's Invention

 1 HOUR



INNOVATION COUNCIL

Session Objective

The objective of this session is to inform the mentee about how to seek protection for her invention/creation, for each type of IP right identified as relevant to the invention and best suited for the potential business plan. This should include the processes for seeking protection, strategic considerations for seeking international protection and potential resources to use for seeking such protection.

The results of this session should enable the mentee to start developing a strategic IP plan, which can be discussed and finalized in the last session.

Discussion and Suggested Questions

For each applicable IP right discuss a strategy for securing and protecting that right.

Patents

Discuss whether there were any public disclosures of the mentee's invention or if it was included in any product that may have been offered for sale. If none, proceed to the next discussion point. If there were, pursue the following line of questions:

- What was the nature of the public disclosure and under what circumstances did it occur?
- When did the public disclosure(s) occur?
- What was the nature of the offer for sale and under what circumstances did it occur? When was the offer for sale made?
- Was your invention described in detail when you offered a product including the invention for sale?
- Were the details of the invention and how to implement it sufficiently understood to make a product utilizing the invention or to prepare a patent application when the offer for sale was made?

Discuss the grace period, if any, for filing a patent application and indicate that time is of the essence and a patent application must be filed prior to the end of the grace period to preserve the patentability of the invention. If there is no grace period, discuss with the mentee that patent protection is likely unavailable and move on to discuss other types of protection.

Typically, the first step in seeking patent protection is to have a patentability search conducted to identify previous inventions related to the mentee's invention. Once the search is completed, a patent attorney or patent agent reviews the results of the search and renders an opinion regarding the potential patentability of the invention. However, it should be noted that there is uncertainty as to what constitutes patent eligible subject matter in many jurisdictions, especially for software and business methods, so for inventions that fall in this category of subject matter, it would be prudent to seek advice from a patent attorney or agent. If it is determined that patent protection is likely available for the mentee's invention, then a patent application needs to be drafted and filed in the appropriate jurisdiction.

From a timing perspective, in order to limit the amount of prior art that may arise before the filing of a patent application and potentially affect patentability, a patent search and patentability opinion should be rendered quickly.

To facilitate an inquiry into the fiscal resources available the following questions should be asked:

- What finances do you have available to seek a patent search?
- What patent attorney/agent resources are available in your country?
- What fees do they charge for their services?
- What fees does your country's patent office charge for filing a patent application and having it examined?
- Is seeking patent protection and affordable option?

If not, are there potential business partners that might be interested in investing in your invention for an interest in the IP rights and proceeds from commercialization of those rights and/or invention? If so, the mentee should be advised to seek legal counsel to negotiate and prepare agreements for such an arrangements, as this is outside the scope of this program.

There are a few options for having a draft patent application prepared and filed. In addition to fee-based preparation of a patent application, the mentee should be informed of pro bono options. Many patent offices and WIPO have pro bono programs through which the services of qualified patent attorneys and agents are offered. The mentee should be encouraged to explore the pro bono options in her own country's IP office or the regional patent office, and also the WIPO programs.

A few questions will help you to explore this area:

- Is your country a member of the Patent Cooperation Treaty?
- Are you familiar with the WIPO pro bono program for preparing a patent application?
- Is there a pro bono program in your country?
- If your country is a member of the PCT, and a separate patent search and opinion is not affordable, would you consider having a pro bono patent application prepared and filed with a PCT receiving office which would include a patent search? You should explain the PCT filing and search costs and compare to for fee services.
- Do you think that any of the aforementioned strategies are viable for you?

If not, we can explore other types of IP protection.

If the business plan indicates that international patent protection is desirable, then the patent application filing options should be discussed. For example, explore if it is likely more prudent and cost effective to file the application in the country of the mentee, or if she should consider a PCT application in one of the receiving offices. Included in the discussion, if appropriate, could be an explanation of the temporal advantage of using the PCT, as more time is provided to the patent applicant to determine in which countries patent protection is desirable. In this regard, the mentee should consider the major markets for products that might include the invention and what countries are likely to have manufacturing facilities that will make products that include the invention.

To facilitate this discussion, the following questions might help:

- Did you know that you can either file individual national patent applications in each country patent protection is desired under the Paris Convention within one year of filing of your first application or if a PCT application is filed enter the National phase in each desired country within 30 months of filing the first PCT application? Explain that the PCT process affords more time to develop a foreign filing strategy, based upon a better understanding of potential markets for the invention.

- Did you know that typically translation costs are the biggest costs of seeking patent protection in countries that do not accept the language your original patent application was prepared in?

It would be helpful to the mentee if you could provide some examples of translation costs in industrialized countries.

Trademarks

If it is determined that trademark protection is relevant to the mentee's business plan, then the mentee should be informed about seeking trademark registration.

Similar to patents, the first step is to determine if the mentee's selected trademark is eligible for registration. Again, a trademark attorney should be engaged to conduct a trademark search to ensure that the mentee's selected trademark is not already being used. Once the search results are reviewed and it is determined that trademark protection is available, then trademark registration may be sought.

The following questions will help guide the discussion:

- Like patents, do you understand that time is of the essence for seeking trademark protection in order to prevent another party from obtaining trademark protection for the mark you desire?
- Are you aware of any trademark attorneys in your country?
- What fees do they charge for trademark searches, trademark application preparation and trademark application filing?
- Do you have the financial resources to engage a trademark attorney to do a search?

If not, did you know there are public data bases available to search such as the WIPO Global Trademark Database, that could be searched by you to determine if your desired trademark is already registered? You should advise the mentee to first check her country's database, as the first application should be filed in her country.

If the business plan indicates that international trademark protection is desirable, then the trademark application filing strategy should be discussed. Although individual applications may be filed and prosecuted in each country for which registration is sought, the benefits of utilizing international treaties, such as the Madrid Treaty, administered by WIPO should be explored.

A few questions will help guide the mentee on foreign trademark filings:

- Have you researched the costs of seeking international trademark protection?
- Is international trademark protection financially viable for you?
- In what markets do you or your licensee intend to sell products that would bear your desired trademark?
- Did you know that under the Paris Convention, you may file separate trademark applications in each country you desire trademark protection within 6 months of filing your first trademark application or you may file an international application utilizing the Madrid Protocol with WIPO which will examine the application and forward it to designated countries for which trademark protection is sought?

Copyright

If the mentee's invention and/or other written materials relating to the invention are subject to copyright protection, the mentee should include the applicable copyright notice on them, as required by her country's legal system. The mentee could research the Copyright Law for her country to identify the notice requirements, which are typically straightforward, or seek legal advice. Nothing else may be required to assure copyright protection for your mentee's works.

The following questions will help the mentee understand what steps are necessary to secure copyright protection:

- What written materials, including software source code, do you wish to protect?
- Do you know what the legally required copyright notice is? If not, you should direct the mentee where to look for the proper copyright notice.
- Do you know that it is important to affix the copyright notice on your materials before making them publicly available?

Trade Secrets

If it is determined that the mentee's invention is best suited for trade secret protection, she should be informed as to how to maintain the trade secret in confidence, since there are no formal requirements under law for such protection. All documents that disclose the trade secret information must be marked as confidential.

The importance of maintaining the trade secret in confidence must be emphasized. The trade secret should only be shared when necessary to accomplish the business plan. If shared, a confidentiality agreement, originally prepared by an attorney, should be completed and signed by the party receiving the trade secret information. If there are employees working for the mentee, they should also be required to sign confidentiality agreements. The trade secret should only be disclosed to those employees who have a need to know the trade secret information to accomplish the business plan. Employees that are resigning should be strongly reminded, before they leave, that they are not allowed to disclose the trade secret information, pursuant to the terms of their confidentiality agreement.

The following questions will help the mentee understand the steps to take to protect trade secret materials:

- What written materials, including software source code, do you wish to protect as trade secrets?
- Do you know that it is important to mark those materials with a confidential notice before allowing anyone else to view those materials? You should advise the mentee on how to mark the materials, such as "Name, Confidential" or "Name, Confidential and Proprietary."
- Do you intend to share any of the trade secret information with anyone? If so, you should advise the mentee to have a nondisclosure or confidentiality agreement put in place with the other party.
- Do you have any employees that will have access to the trade secret information? If so, you should advise the mentee to have an employee agreement with confidentiality provisions put in place with those employees.