

FISHER ADAMS KELLY

PATENT & TRADE MARKS ATTORNEYS
AUSTRALIA & NEW ZEALAND

*What is Intellectual Property and
why is it important?*

Mark Egerton

www.fak.com.au

April 2008

Intellectual Property

- ◆ any new idea, discovery, invention, mark, scheme, concept or way of performing a task or function that is the result of human intellectual activity

Intellectual Property

- ◆ inventions and discoveries
- ◆ trade marks and other commercial indicia
- ◆ artistic works, broadcasts, performances, computer programs and other copyrightable material
- ◆ industrial designs and circuit layouts

Intellectual Property Rights

- ◆ the right to exclusively exploit or otherwise obtain commercial or economic benefit from intellectual property

Intellectual Property Rights

- ◆ Non-registered rights
 - ◆ Confidential information and trade secrets
 - ◆ Copyright - exists as of the creation of an artistic work or other copyrightable work
 - ◆ Non-registered trade marks and other trade indicia connected with business reputation and goodwill

Intellectual Property Rights

- ◆ Registered rights
 - ◆ Patents
 - ◆ Plant Breeder's Rights
 - ◆ Trademarks
 - ◆ Registered designs

Patents

- ◆ limited term of 20 years compared to “perennial” trade secrets
- ◆ requires full public disclosure of invention in patent specification (“quid pro quo”)
- ◆ validity can be challenged at any time and clear criteria are applied to patentability
- ◆ scope of monopoly is defined

Patents

- ◆ patent term typically 20 years from filing date
- ◆ Australia has standard 20 year patent and 8 year innovation patent
- ◆ excludes others from exploiting patented invention but does not prevent patentee infringing other patents

What is patentable?

- ◆ new inventions that have a practical, commercially useful form
- ◆ excluded are artistic works, mere information or discoveries, abstract or mathematical formulae, printed matter, plans, schemes or ideas that are not technological in nature
- ◆ human beings and processes for producing human beings are excluded in Australia; similar types of exclusions exist in other countries

What is patentable?

- ◆ varies from country to country
- ◆ Australia and US allow:
 - ◆ *methods and processes, including methods of manufacture, methods of medical treatment of humans and methods of doing business*
 - ◆ *apparatus, machines and devices e.g., can openers, jet engines and robotic workstations*
 - ◆ *compositions of matter e.g. chemical entities such as drugs, isolated genes and transgenic organisms*

What is patentable?

- ◆ Europe, Japan, China, Canada, New Zealand and many other countries do not allow methods of medical treatment of humans whether such methods involve administration of drugs or surgical methods
- ◆ Many of these countries also do not allow methods of diagnosis practiced on the human body

Invention vs Discovery

- ◆ Discovery: the circumference of a circle is directly proportional to the diameter of the circle
- ◆ Invention: a method of manufacturing a wheel wherein the diameter of the wheel is measured and used to determine the circumference of the wheel or vice versa

Requirements for patentability

- ◆ To be patentable, an invention must be:
 - ◆ *novel*
 - ◆ *inventive or non-obvious (or innovative)*
 - ◆ *useful*
- ◆ In other words, a patentable invention must be something new which displays the *imprint of inventive or innovative human activity*

Requirements for patent specification- the “quid pro quo”

- ◆ specification must fully describe the invention, which in some countries requires a description of the “best method” of performing the invention known to the inventor
- ◆ claims clearly defining the invention which function to “mark out” the territory on which others may not trespass

Requirements for patent specification- the “quid pro quo”

- ◆ *claims may extend beyond the actual work performed by the inventor subject to legal criteria that vary from one jurisdiction to another*
 - ◆ *Fair basis*
 - ◆ *Sufficiency*
 - ◆ *Written Description*
 - ◆ *Enablement*

Patent System

- ◆ Generally, patent application must be filed before first public disclosure or sale of invention, although “grace period” is available in countries such as Australia, USA, Canada
- ◆ Provisional application can provide world-wide interim protection for 12 months via Paris Convention

Patent System

- ◆ complete application must be filed within 12 months of provisional to maintain protection in Australia and overseas
- ◆ single application under Patent Co-operation Treaty (PCT) can provide interim protection in 132 countries for further 18 months

Patent System

- ◆ 30/31 months after provisional filing the PCT countries where a granted patent is sought must be selected
- ◆ each national application is then examined according to national law and patent refused or granted
- ◆ patent is not enforceable against infringers until granted

Inventorship

- ◆ Inventorship
 - ◆ *is a question of fact assessed in light of appropriate legal principles*
 - ◆ *authorship is not the same as inventorship*
 - ◆ *intellectual contribution, particularly at early conceptual stages is important*
 - ◆ *audit may be needed to determine inventorship*

Inventorship principles

- ◆ inventors must intellectually contribute to an inventive concept
- ◆ the invention is fully conceived when the inventor has a *“definite and permanent idea of the complete and operative invention, as it is hereafter to be applied in practice. An idea is sufficiently definite and permanent when only ordinary skill would be necessary to reduce the invention to practice, without extensive research or experimentation”*
- ◆ this does not require that the invention has actually been performed
- ◆ persons performing purely technical work, even at a high level of proficiency, are not inventors if merely working under instruction or confirming that the invention works; may be inventor if solving unforeseen problems

Inventorship principles

- ◆ inventions are often produced collaboratively by joint inventorship
- ◆ *“The exact parameters of what constitutes joint inventorship are quite difficult to define. It is one of the muddiest concepts in the muddy metaphysics of the patent law. On the one hand, it is reasonably clear that a person who has merely followed instructions of another in performing experiments is not a co-inventor of the object to which those experiments are directed. To claim inventorship is to claim at least some role in the final conception of that which is sought to be patented. Perhaps one need not be able to point to a specific component as one’s sole idea, but one must be able to say that without his contribution to the final conception, it would have been less – less efficient, less simple, less economical, less something of benefit”*

Mueller Brass Co v Reading Industries 17 USPQ 361

Inventorship

- ◆ inventorship has implications for patent ownership
 - ◆ *can lead to patent issuing to wrong owner, which is a ground of invalidity*
- ◆ incorrect attribution of inventorship can have other serious legal consequences
 - ◆ *patent invalidity*
 - ◆ *patent unenforceability*

Laboratory Notebooks

- ◆ Good laboratory notebook practice
 - ◆ assists in inventorship determinations
 - ◆ assists in asserting “first to invent” status in a US interference

Laboratory Notebooks

- ◆ Good laboratory notebook practice
 - ◆ standard institutional notebook with serial number
 - ◆ bound pages sequentially numbered
 - ◆ pages should not be removed
 - ◆ strikethrough errors; do not use whiteout
 - ◆ sign off and date each day
 - ◆ have witness sign off; witness should not be involved in or supervise work

Laboratory Notebooks

- ◆ Good laboratory notebook practice *cont'd*
 - ◆ enter data directly into notebook; when attaching forms, photographs, charts, statistical printouts, *etc.*, use glue or tape to ensure permanence
 - ◆ strikethrough blank portions of page
 - ◆ completed notebooks centrally stored

Laboratory Notebooks

- ◆ Good laboratory notebook practice *cont'd*
 - ◆ methodology clearly set out
 - ◆ cross reference to sample sources, machines and equipment used
 - ◆ clearly record conclusions from experiments
 - ◆ record concepts, ideas or “hunches” you may have

Publication vs Patenting

- ◆ not mutually exclusive but complementary
- ◆ preparation of scientific manuscript or conference presentation and preparation of patent specification can proceed together
- ◆ management is the key

Patent Websites

Australian Patent Office Decisions:

www.austlii.edu.au/au/cases/cth/APO/

Australian Patents, Trade Marks and Designs:

www.ipaustralia.gov.au

US patents: www.uspto.gov

European, Japanese and PCT: ep.espacenet.com