

The patenting process: from lab to law

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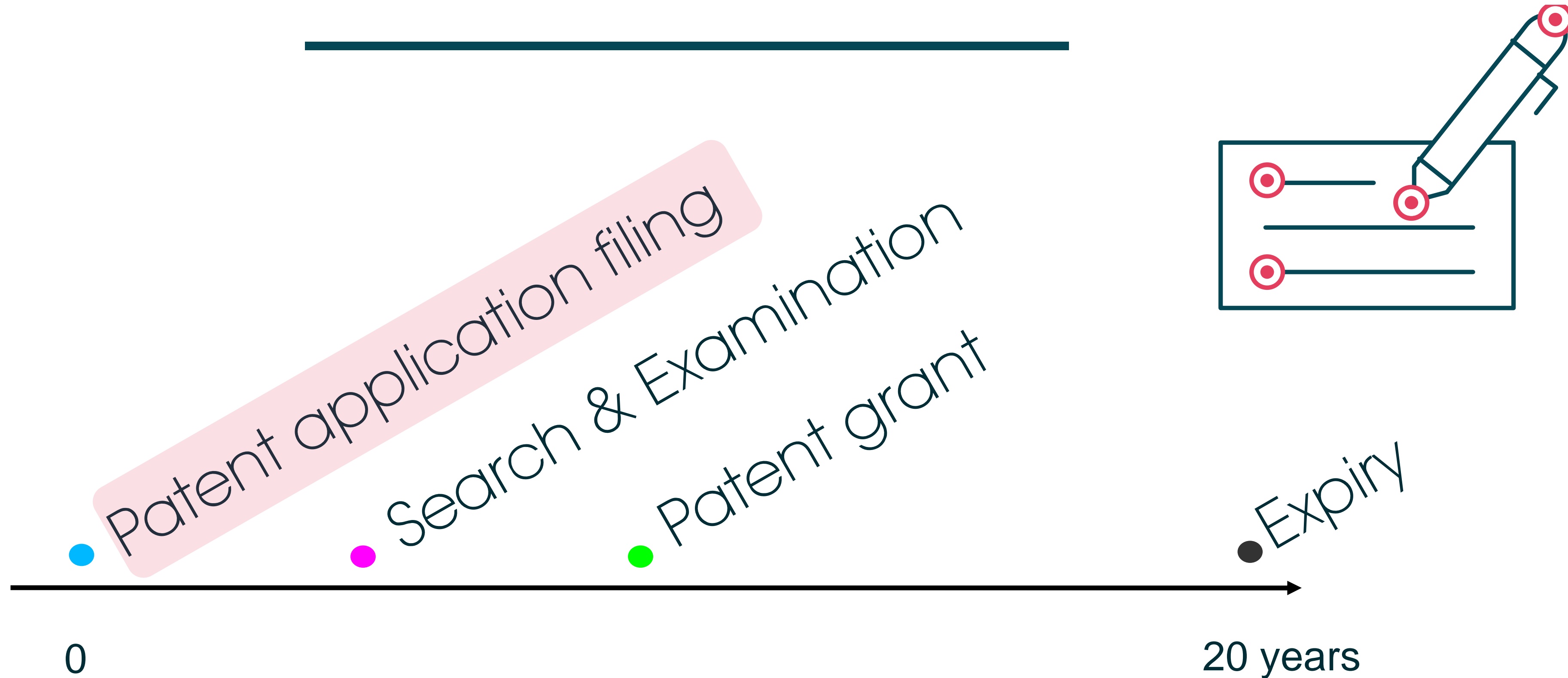
I N D E X

1. Introduction to IP: Industrial and Intellectual property
2. Patents and Utility models
3. The Patent system:
 - The Invention Disclosure document
 - The Patent document
 - Patent chronology
 - Patentability requirements

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 - **Patent chronology**
 - Patentability requirements

Patent chronology



A patent application only becomes a patent after grant!

Where to file? Types of filings.
Priority right.

Patent chronology: types of filings

- ❖ **National:** filed before the patent office of a country, granted patent will have effect only in said country



Patent chronology: types of filings

❖ Regional:

- filed before a supranational patent office
- granted as a regional patent valid in all member states or as a bunch of patents each for a different member state



Patent chronology: types of filings

Map showing the geographic coverage of European patents as of 1 October 2022

■ Member states (39)

- | | | |
|------------------|-------------------|------------------|
| - Albania | - Hungary | - Norway |
| - Austria | - Iceland | - Poland |
| - Belgium | - Ireland | - Portugal |
| - Bulgaria | - Italy | - Romania |
| - Croatia | - Latvia | - San Marino |
| - Cyprus | - Liechtenstein | - Serbia |
| - Czech Republic | - Lithuania | - Slovakia |
| - Denmark | - Luxembourg | - Slovenia |
| - Estonia | - Malta | - Spain |
| - Finland | - Monaco | - Sweden |
| - France | - Montenegro | - Switzerland |
| - Germany | - Netherlands | - Türkiye |
| - Greece | - North Macedonia | - United Kingdom |

■ Extension states (1)

- Bosnia and Herzegovina

■ Validation states (4)

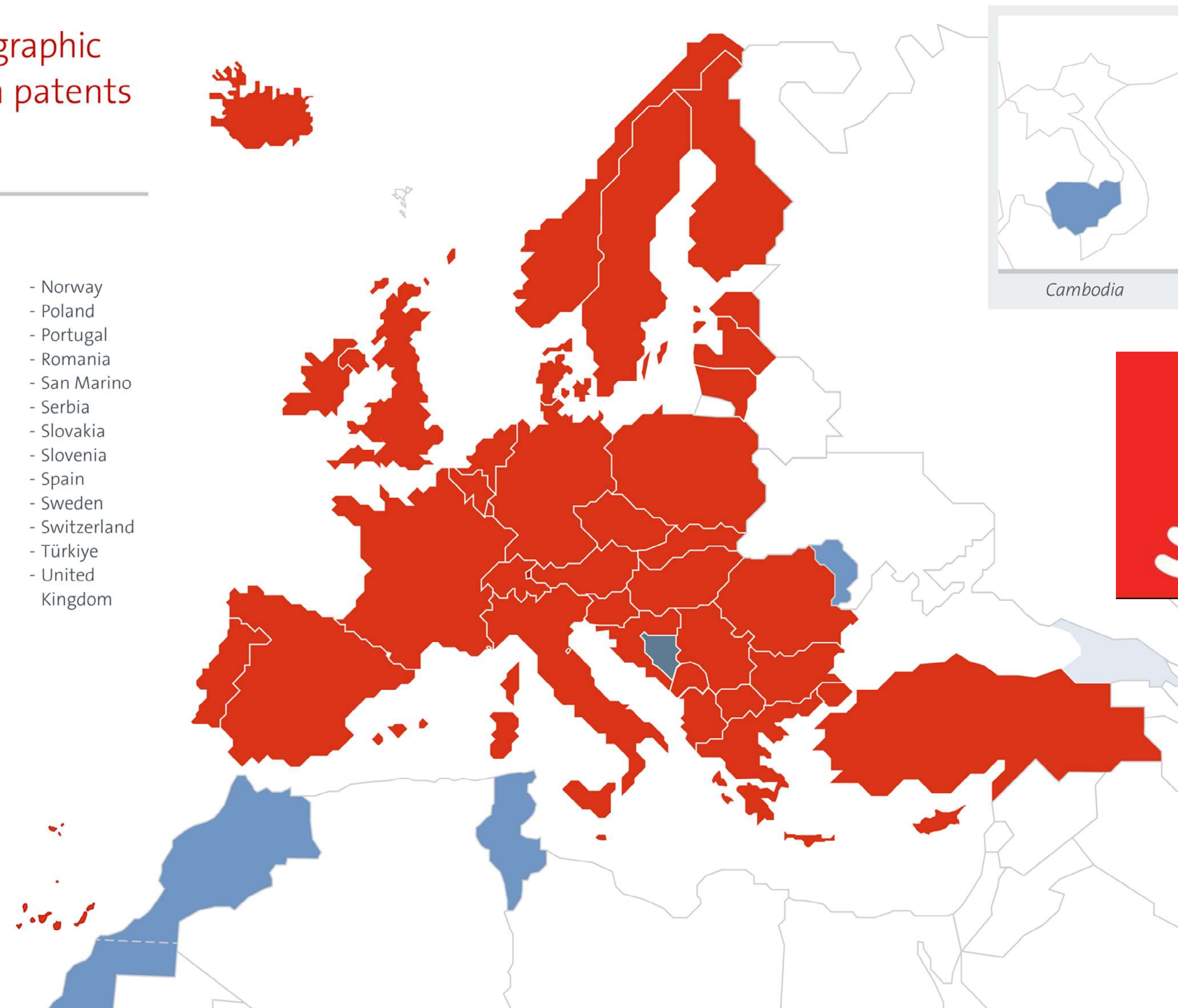
Agreement in force

- Cambodia
- Republic of Moldova
- Morocco
- Tunisia

■ Future validation states (1)

Agreement signed but not in force yet

- Georgia



Patent chronology: types of filings

❖ International Patent Application (PCT application):

- filed before WIPO or before a national office of a member state acting as receiving office
- It is only a patent application – **international patents do not exist!**
- Allows delaying large expenditure for filing patent applications worldwide → 30 months

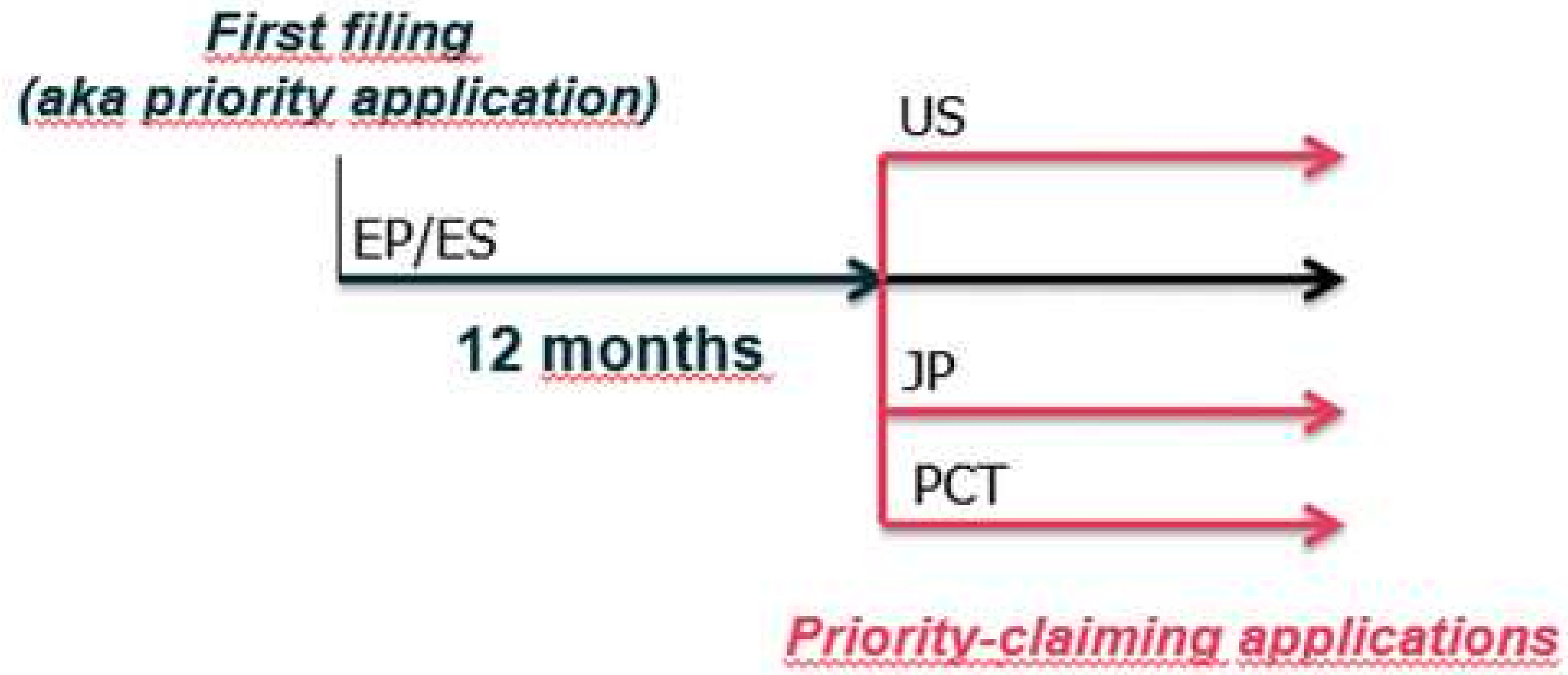




A world map showing the distribution of the world population. The map is color-coded: blue for high population density, yellow for medium population density, and white for low population density. The map shows that the majority of the world's population is concentrated in East Asia, South Asia, and Europe.

Patent chronology: priority

The **priority right**: 12 months to extend protection to other territories whilst maintaining original filing date of first filing

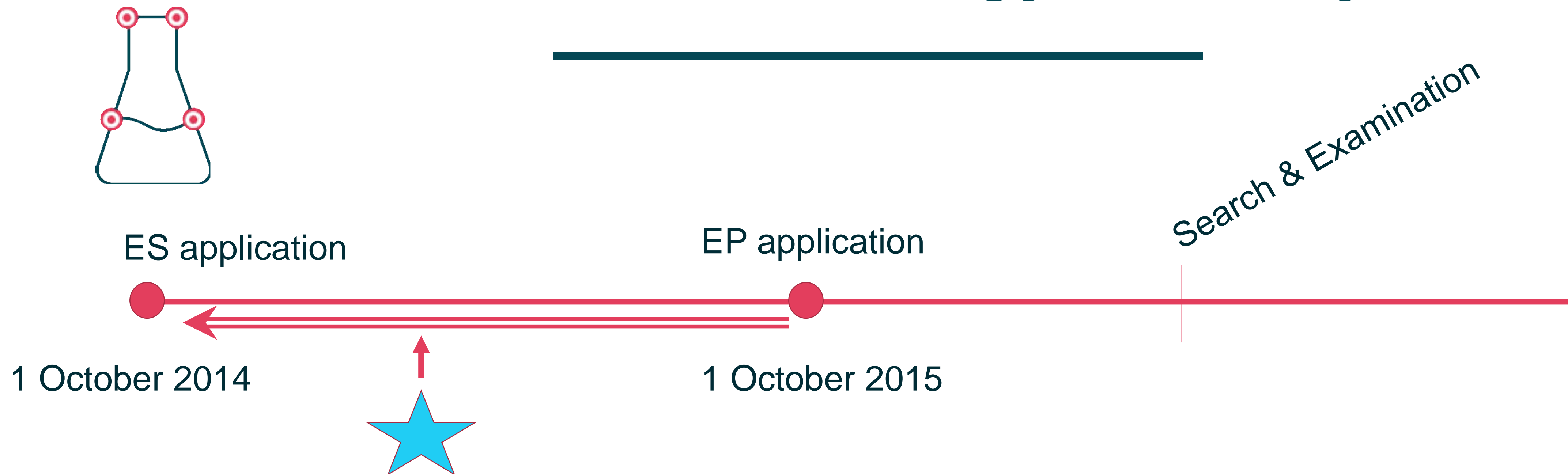


Patent chronology: priority

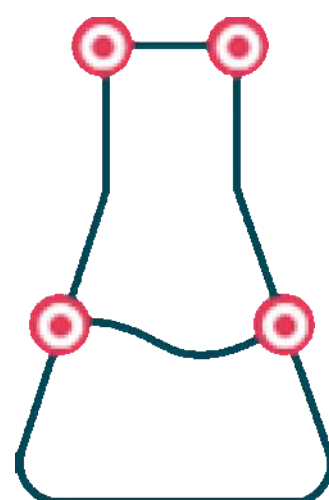
Article 89 EPC "Effect of priority right":

*“The right of priority shall have the effect that **the date of priority shall count as the date of filing** of the European patent application for the purpose of art. 54, paragraph”*

Patent chronology: priority



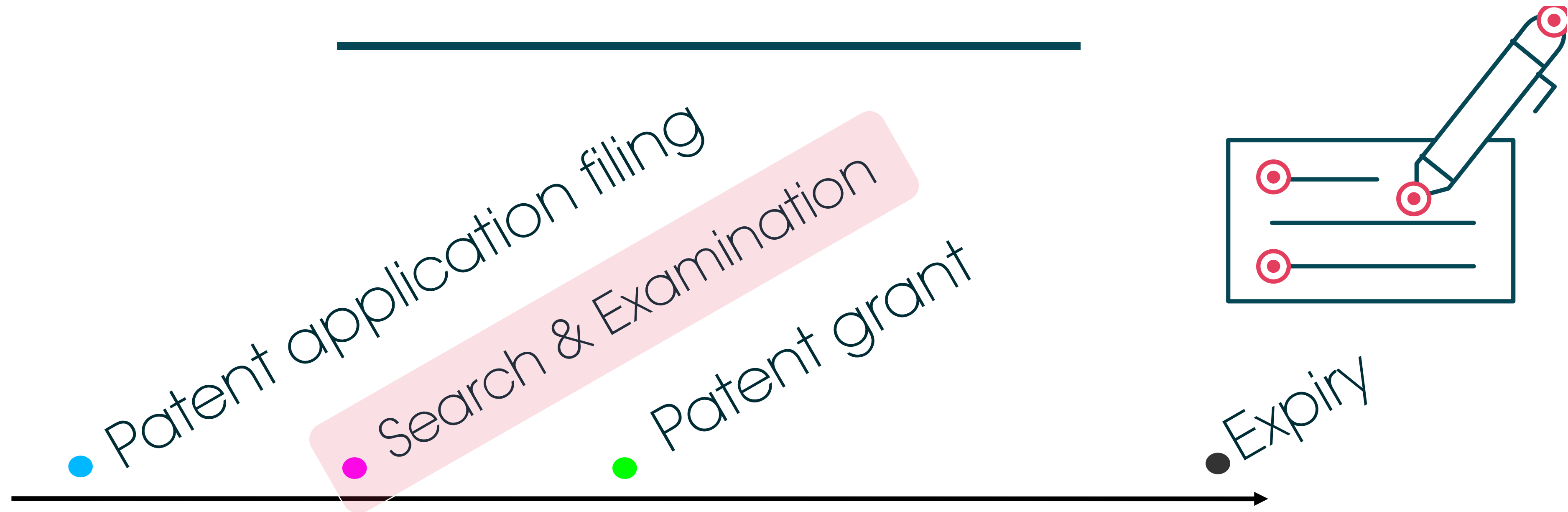
Australian journal publication
3 March 2015



Is your EP application novel?



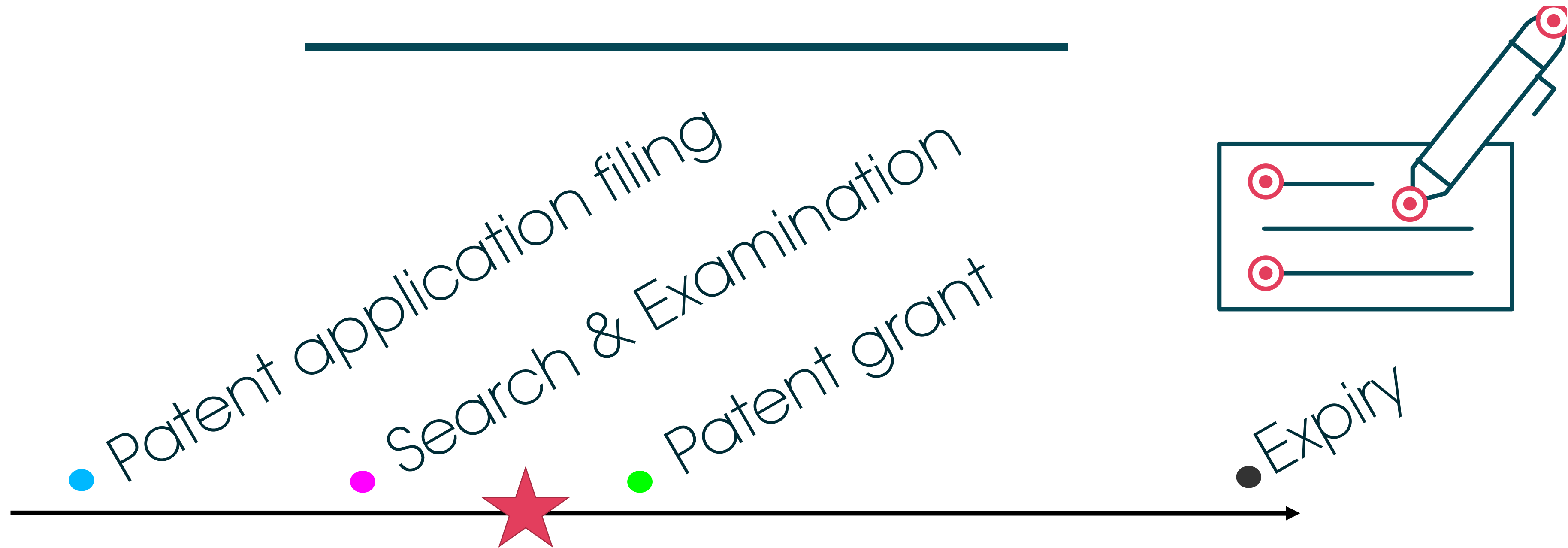
Patent chronology: examination



After the patent application is filed, the Patent Office will eventually:

- ❖ **Search** for prior art related to the invention defined in the claims
- ❖ **Examine** whether the application, and in particular the claims, meet patentability requirements

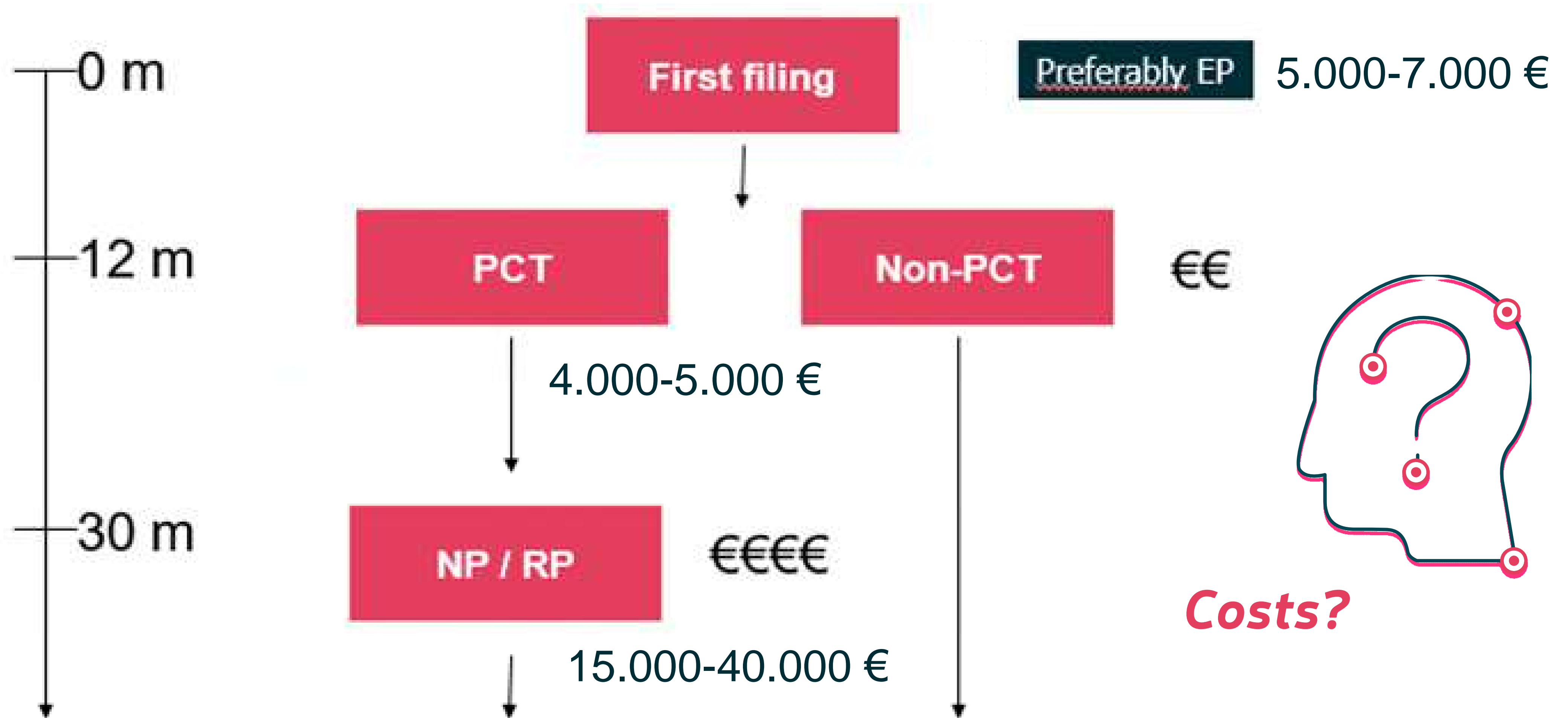
Patent chronology: publication



After **18 months** from the date of filing, your patent application will be made available to the public.

- ❖ Search report (SR) usually received before 18 months, so if SR negative, can withdraw application to avoid publication

Patent chronology: filing strategy



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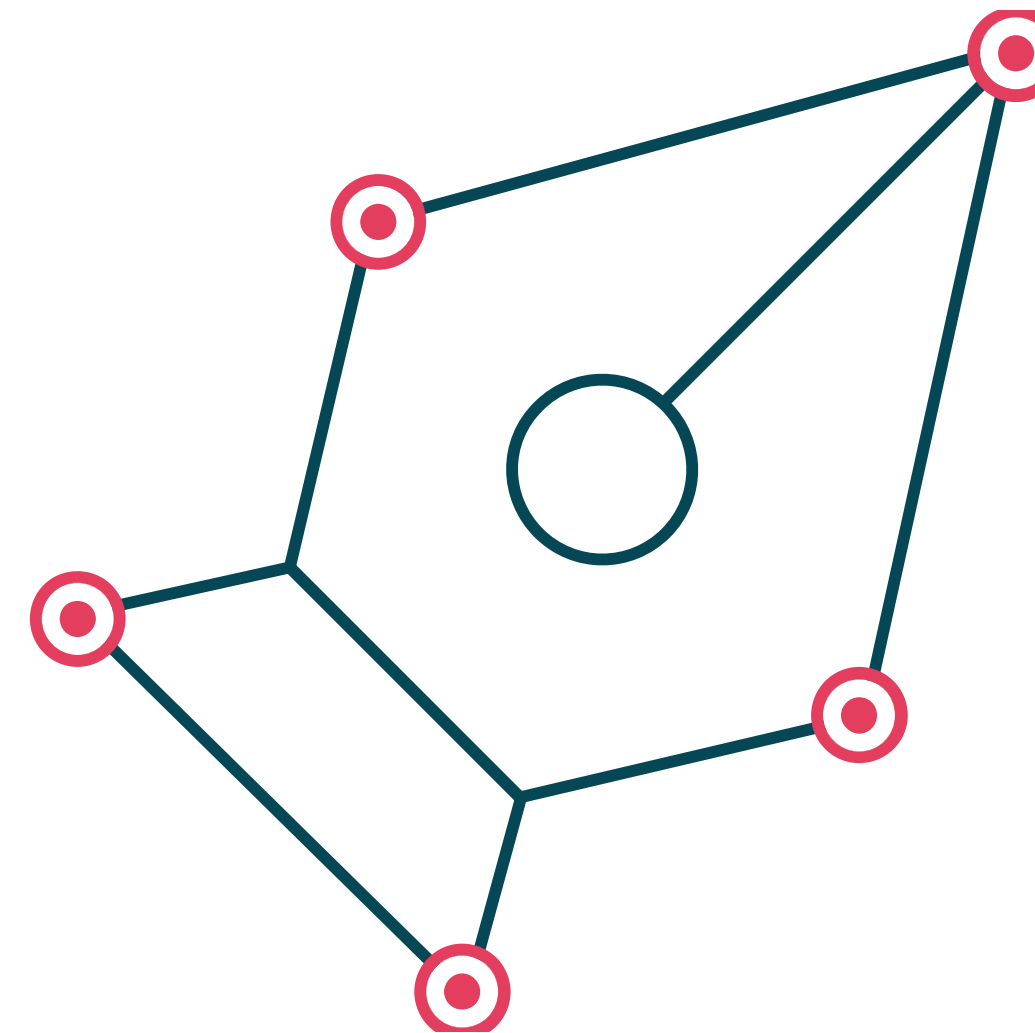
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Patentability requirements

There are a number of patentability requirements that must be met before a patent right can be granted:

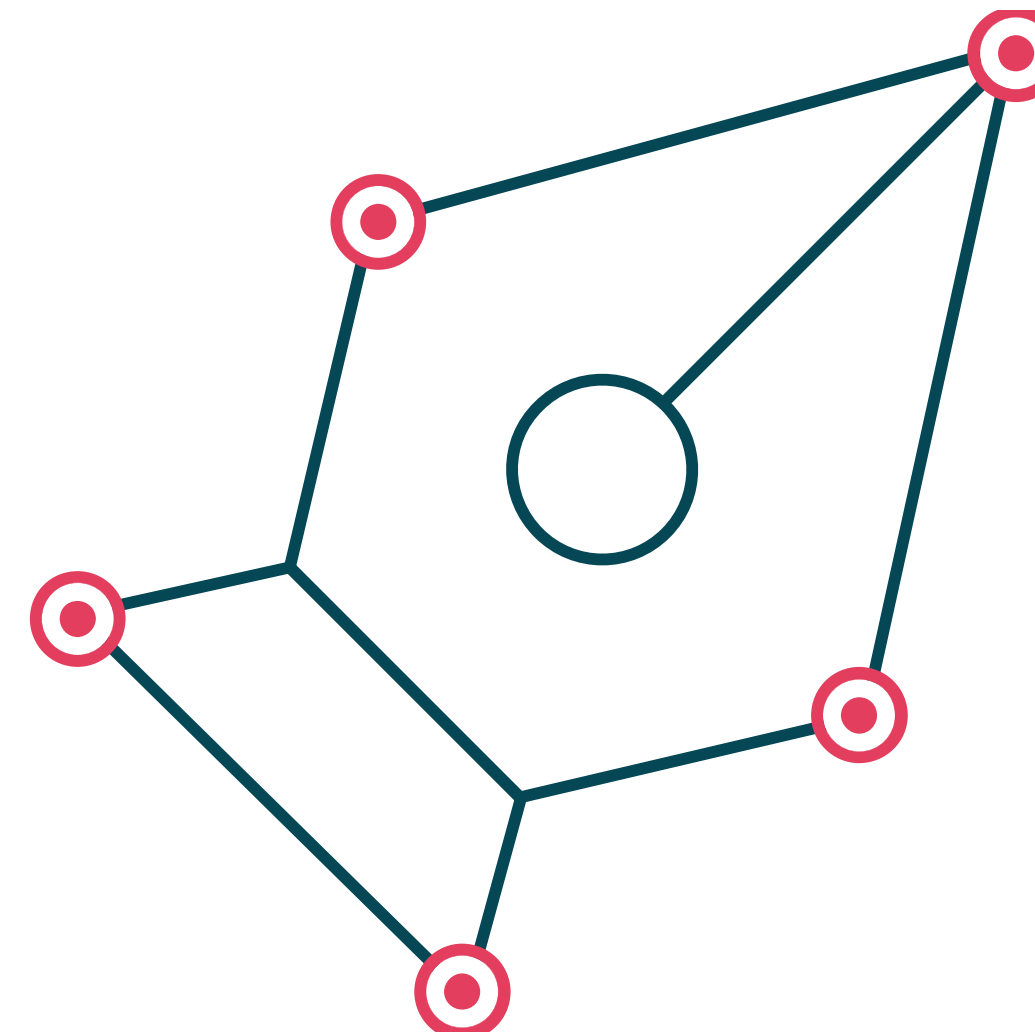
- ❖ Novelty
- ❖ Inventive step
- ❖ Clarity
- ❖ Sufficiency of disclosure
- ❖ Added matter
- ❖ Unity of invention



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Patentability requirements: novelty

An invention is not novel if all the features of the claimed invention are described, explicitly or implicitly, in any **one** prior art document – **cannot combine documents when assessing novelty!**

INVENTION: A + B + C

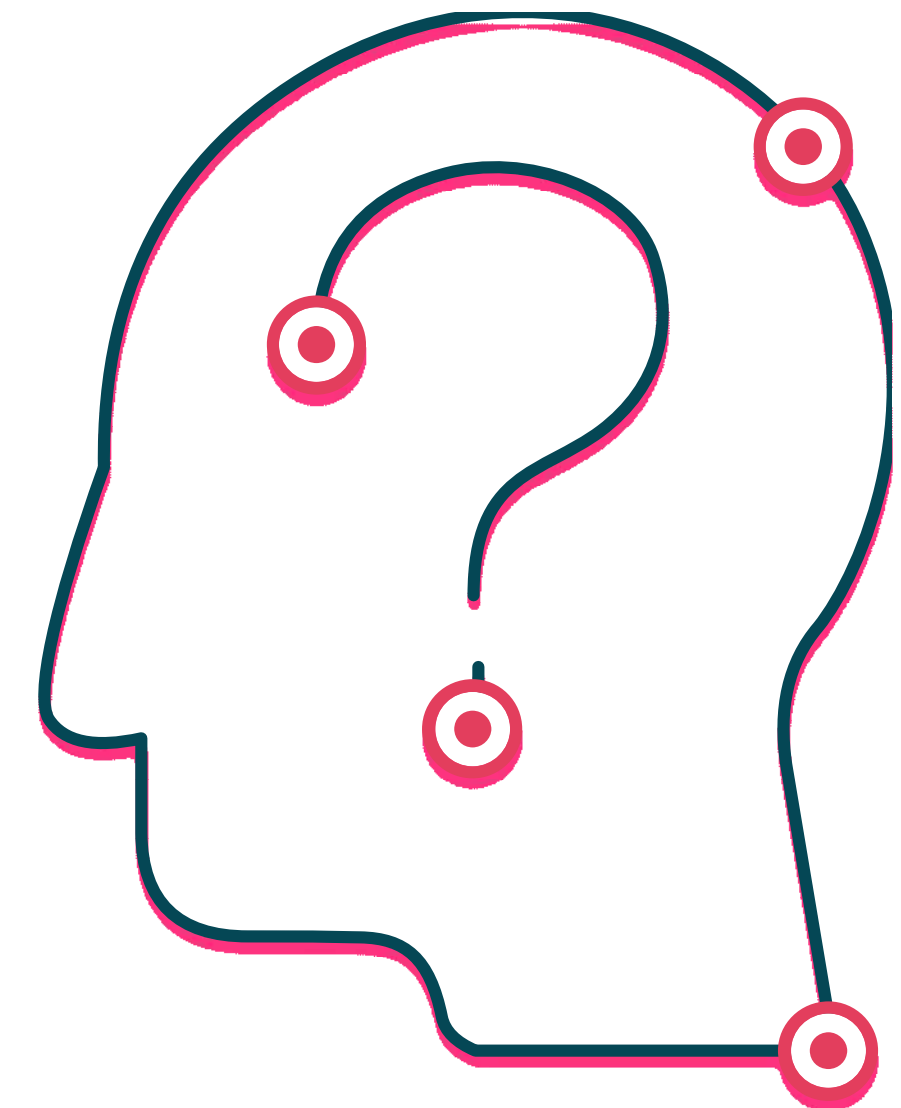
PRIOR ART DOCUMENT: A + B

NOVEL

INVENTION: A + B + C

PRIOR ART DOCUMENT: A + B + C + D

NOT NOVEL



Patentability requirements: novelty

What is the prior art (state of the art)? Article 54 EPC:

(1) An invention shall be considered to be new if it does not form part of the state of the art.

(2) The state of the art shall be held to comprise **everything made available to the public** by means of a written or oral description, by use, or in any other way, **before the date of filing** of the European patent application.

(3) Additionally, the content of European patent applications as filed, of which the dates of filing are prior to the date referred to in paragraph (2) and which were published on or after that date, shall be considered as comprised in the state of the art.

Patentability requirements: novelty



**DO NOT MAKE ANY INFORMATION PUBLIC
BEFORE FILING A PATENT APPLICATION**

Patentability requirements: novelty

❖ Invention claims:

1. Table comprising three legs.
2. Table according to claim 1, comprising a further leg.
3. Table comprising three legs and an extendable surface.



❖ Prior art: Object comprising a horizontal surface and four legs.



Is it novel?



Patentability requirements: inventive step

In practice, the “**problem-solution approach**” is used:

1. What is the **closest prior art**?
2. What is the **difference**, in terms of the claimed technical features, between the claimed invention on the one hand and the closest prior art on the other?
3. What **technical effect** is caused by this difference?
4. What therefore, is the **objective technical problem** underlying the claimed invention?
5. Would the skilled person solve this problem in the manner indicated on the basis of the totality of the prior art, without any stage employing any inventive skill?

Patentability requirements: inventive step

❖ Invention claim:

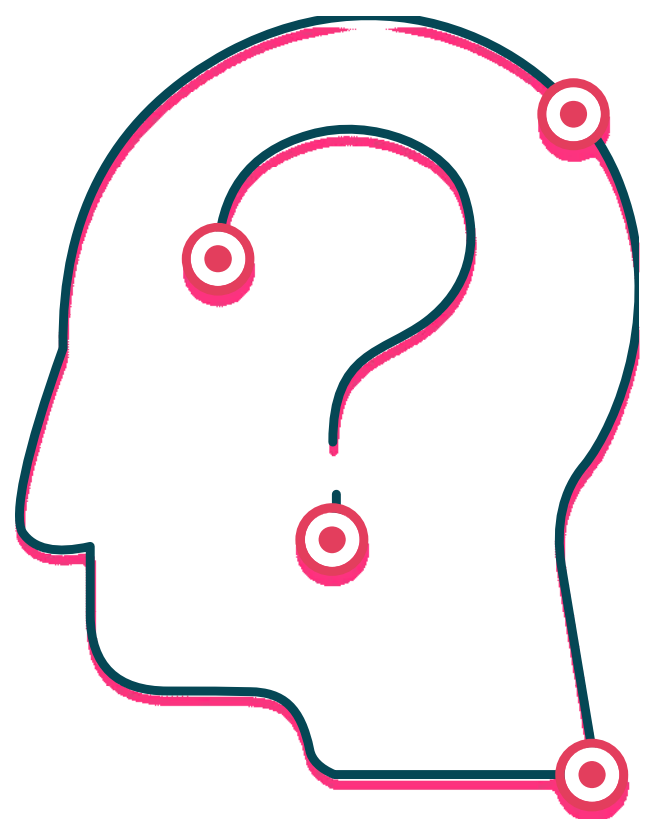
1. Table comprising three legs and an extendable surface.

❖ Prior art:

- **D1:** Object comprising a horizontal surface and four legs.
- **D2:** Theatre stage with extendable floor
- **D3:** Extendable teaching board



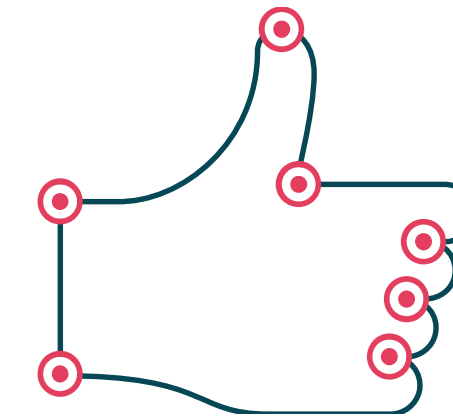
Is it inventive?



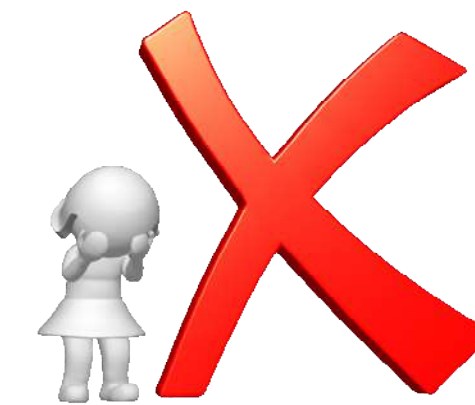
We have a patent: what now?

What can you do with a patent? (True or false?)

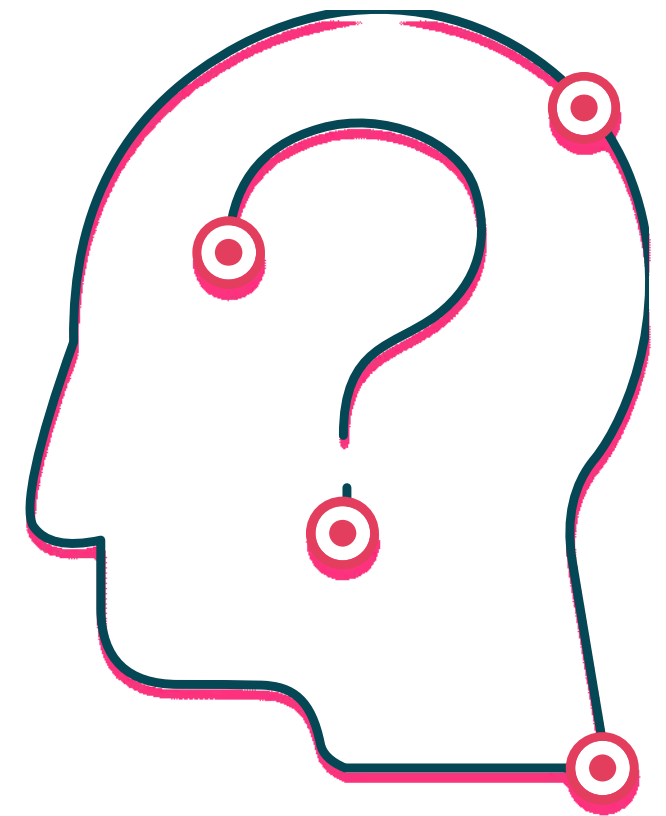
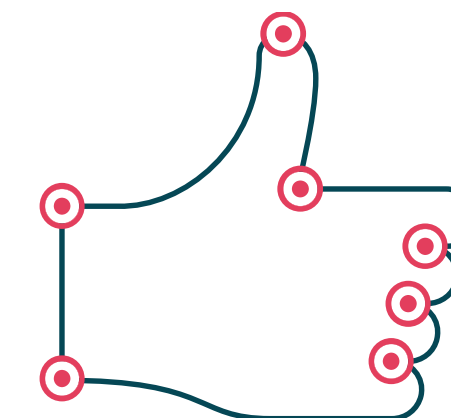
❖ Property: sell / rent (license) it



❖ Exploitation: put the patented product on the market

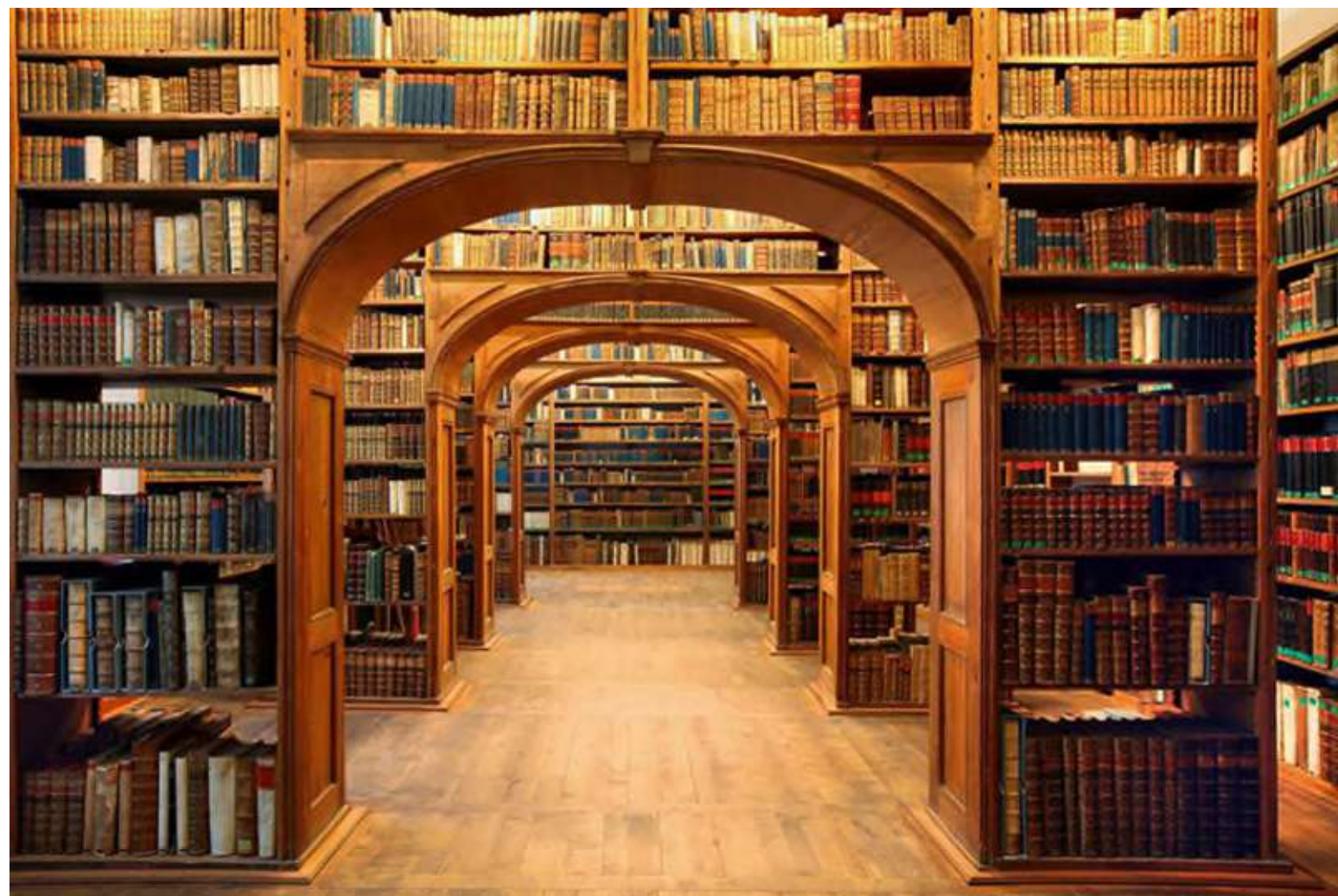


❖ Litigation: sue people who sell the patented invention



Patents: other uses

Billions of € from the budget allocated to research by the EU is spent on redundant research

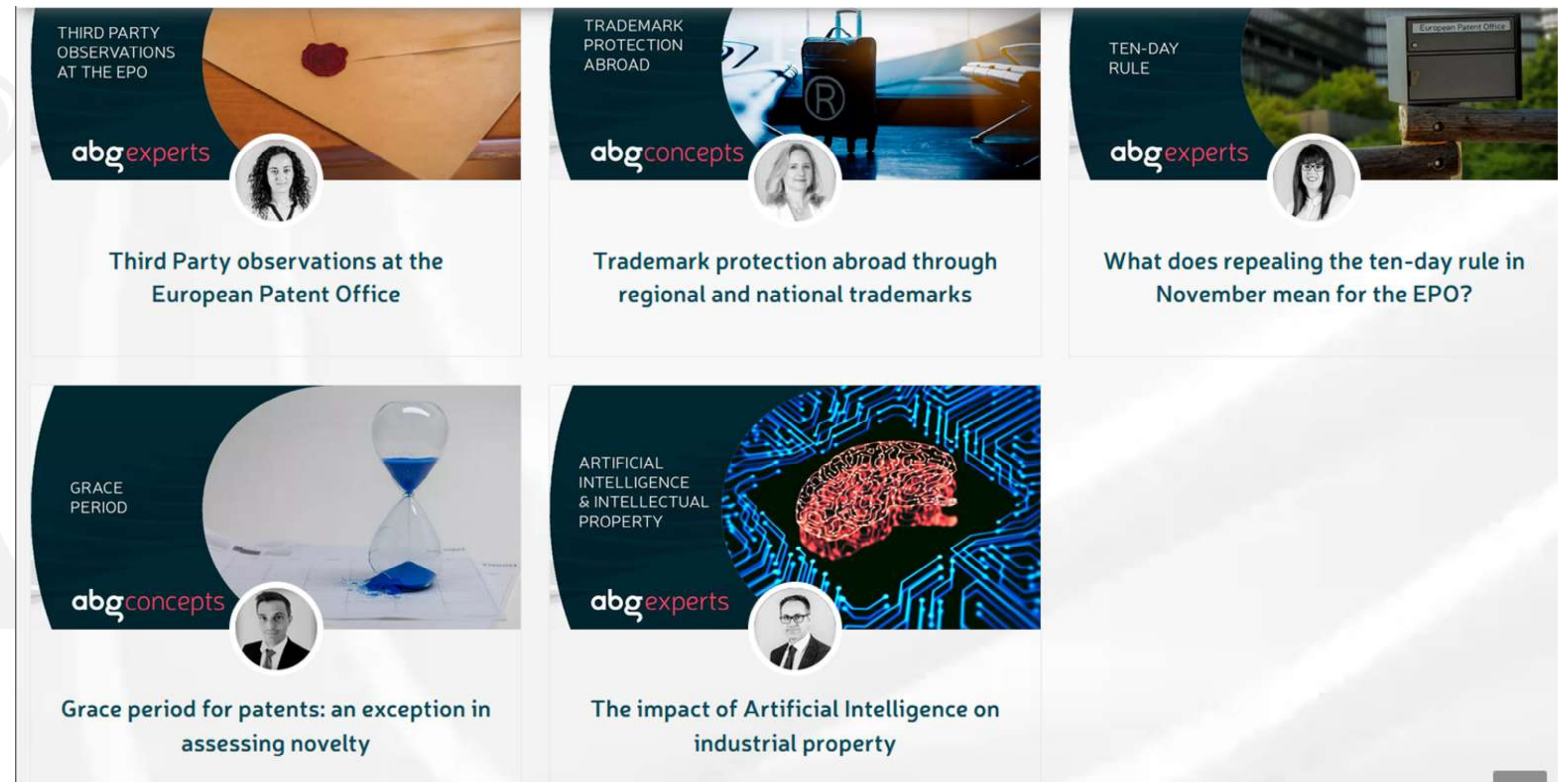


- ❖ It is estimated that about 70% of the technical information found in patents is not disclosed in papers
- ❖ Patent databases are available and are easy to use, e.g. **espacenet** (EPO database) has worldwide coverage

Search a patent database before entering a project!

DO YOU WANT TO KNOW MORE?

Check out our website :
<https://abg-ip.com/knowledge/>



DO YOU WANT TO KNOW MORE?

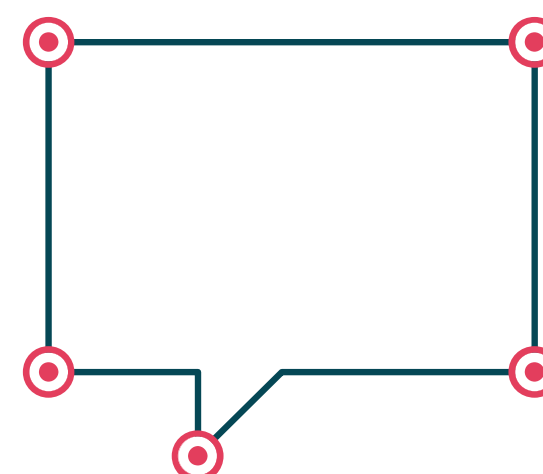
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ANY QUESTION?

Thank you





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