

INTELLECTUAL PROPERTY PORTFOLIO MANAGEMENT

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Lecture - 08

Welcome friends. So, we are discussing about foreign filing of intellectual property because we discussed two important questions what to keep in your portfolio and where to keep your portfolio. and as soon as we say this question, where to keep your portfolio from India, two possible answers are there to keep your portfolio in India or to keep your portfolio at all possible locations we discussed that it is not feasible It is not economically viable to keep your portfolio everywhere. So, you have to decide where to keep your portfolio.

And therefore, we discussed the selection of the country, its attractiveness of the country and return on investment. These are important criteria for deciding a particular country or group of countries or regions for your portfolio. IP portfolio management. So, going with this discussion which we started in our last session, we see that since there is no global system or there is no worldwide patent. So, we have to file the patent application in different countries separately to obtain protection for the invention.

It is a very very tedious process. Do you do business? or you go for filing the patents in different countries, or you take help of Form 26, give your power of attorney to a legal representative who will represent you in different countries, and then it becomes a full-time job for identifying, filing the patents in those countries. And it is not simply filing the patent, protecting your innovations, wherever you will file, And if there is a violation of your IP in those countries, you also need to follow the legal route to take proper action against those violators.

So, therefore, it is a complete process in itself. So, we need to be very very careful in not taking this direct route of obtaining production out of different countries. you need to take the benefit of some of the routes which are created as a result of some international

treaties. And one of the very common routes which the Paris Convention and one route which we slightly introduced in our previous discussion that is the PCT route. So, now this Paris Convention

which is the protection of industrial property and that industrial property is nothing but patent about which we are talking. It was started in 1883. So, you can consider that this is around 150 years old system which provides for 12 months time to file the patent application in the member countries from the date of filing the earliest applications. So, the earliest application means the application which you have filed in your domestic country in your home country and from the home country application filing within 12 months you can go for in all the member countries for filing your application. Now, what does it mean for 12 month period?

So, if you go to the basics of IP there are three important conditions you remember I have already given those conditions. novelty is one of them. Two other are patentability and the third is industrial application. So, inventive steps and industrial applications are not important in this the 12 month consideration, but the first factor novelty is important in this 12 month consideration. Meaning is if it takes more than 12 months

to file your application in other countries under this Paris Convention, you will not be getting the benefit of the novelty clause. That means, now it will be part of the literature if it is application which is 12 months old then it becomes part of your prior art. So, therefore if you want that your invention should not become the part of prior art you need to file the application in other countries within the 12 months. Otherwise, your own invention will become part of

prior art. So, therefore, we need to be careful that whenever this timeline is mentioned it is basically to give you the advantage of novelty protection when you disclose your invention. So, basically you are disclosing the novelty in front of the world and you have to be careful that you can take the benefit of your novelty for at least yourself. This question many times comes let me slightly digress here. many time it comes that as a researcher should I publish my research or should I patent my research?

What should be the sequence of research output? If you publish your research it means you have disclosed the novelty and then you want to go for patenting of that research. Now your own invention has become the part of prior art you will not be able to take the benefit of patenting your research because now you have disclosed through publication about your research. The right way is first you should file the application for patent that

means you have protected your novelty and after protecting your novelty then you can go for filing of a journal article you can go for publication.

this Paris Convention helps you protect the novelty for 12 months. After 12 months the novelty will not be protected that is the significance of this 12 months period. Other is Patent Cooperation Treaty which is very popularly known as PCT. Now, PCT is a system which allows applicant to file PCT patent cooperation treaty contracting states within 30-31 months from the priority date instead of 12 months.

Now, you get significant advantage. You have enough time around two and half times more time for file your application in the PCT contracting states and currently this number is more than 150. these 150 states which include nations and regions. are the member of this PCT signatory and therefore, you get a almost all the countries all the regions of the world where you can go possibly for your International Patent filing. Not only does the PCT enable extended time period because now from 12 months to 30 months it also simplifies filing procedure through a single application.

Now, we will be talking about that how this single application process simplifies the entire international filing. The PCT system also provides for publication of applications, international searches, international preliminary examination before entering the national phase. So, what is the meaning of all these things that will be clear to you in subsequent slides. There are basically two phases. International phase and another is national phase.

So, there are some of the activities some of the actions which we do in the international phase and then we go to the national phase. So, we will be talking about them in a more lucid manner in the coming slides. So, let me first go to this process of the PCT file. Now, in the process of PCT filing there are as I just mentioned few steps are under international stage and few stages few steps are under national phase. So, there are these five activities that are under international phase of PCT and then this national phase comes.

Now, out of these five Three stages are mandatory, these three and two are optional. So, first is filing, obviously, where you can file an international application with a national or regional patent office. or WIPO office complying with the PCT formality requirements in one language and you can pay one set of fee. So, there are different types of offices which are available to file your application when you are going for international application when you are going for PCT application.

Like in India you can submit this application In Indian patent office also or you can submit your application to the WIPO's office available in India. So it is up to you that where you want to go, whether you want to go for the national office or WIPO office. This is regional patent office is applicable in some cases where you have some of the countries which are coming together and making one region and the most popular are two. One is the European Union as a regional patent office and the second is African Union as a regional patent office.

Otherwise like in India's case we have IPO that is Indian Patent Office, no regional patent office but another office is of WIPO available in India. So, this is the obviously the first step and mandatory step. The second step is international search which is also the mandatory step. Now, in this international searching authority ISA one of the worst major patent offices, identifies the published patent documents and technical literature.

I just took this name prior art when I was mentioning about novelty. So, in that prior art plays very important role which may have because your novelty check will happen only on the basis of this prior art. Whether claims whether the invention disclosure which you are making is already available in the prior art it means it lacks novelty. So, you need to ensure that the prior art does not have the similar kind of description and your description your disclosure is ahead or different than the something which is available in the prior art.

So, prior art will have a wide coverage Because sometimes you may have directly those terms, sometimes those terms may not be directly used, their description is available. So, you require good amount of expertise in checking the prior art and you may take it positively or a challenge also. that these days this search etc is also happening with the advent of AI in our IP portfolio management system. So, lot of AI-based solutions are also coming which are helping you in doing the technical literature review of your invention.

So, different types of organizations are developing AI-based machine learning based solutions algorithms which can help you in doing the international search of your or the doing the prior art search for your inventions. And this prior art search will give you the idea whether your invention is patentable or non patentable and establishes a written opinion on your inventions potential patentability. Now somebody may ask. what is this international search, how is it different from when you are filing an application within the country.

In that also the same process is followed, we do proper search, technical search, prior art search, we check the novelty. So, how this international search is different than the search when you are going for a domestic patent. So, here the point is that because in some cases, as I mentioned already country to country the patent laws are different. In some countries something is patentable in some other countries something may not be patentable.

So, your invention your claims will get a detailed report that your invention may be patentable in country A but may not be patentable in country B. And if it is patentable in country A and not patentable in country B on the basis of prior art that is an international search. Because in our country, in host country I will only see from my host country's point of view. But here I will be seeing from all possible places where you may interested to getting your patent. So, that is how the scope of international search is much broader as compared to domestic search for patent.

Then third mandatory step is international publication. Like in India also when you are submitting your patent application. there is a publication of your application after some time. So, like in India's case, it is 18 months when we are publishing your application in the patent journal. You may know that every Friday in India, we issue a new volume of our patent journal.

Same thing happens in this international publication also. So, as soon as possible after the expiration of 18 months from the earliest filing date the content of your international application is disclosed to the world community. So, this is the publication which is done by the WIPO office because now it is available to the global communities. However, it is again important to note that when you are doing application in India you And as I mentioned that the journal is available every Friday evening.

And since it is all online, it is available on internet. So, even that national publication is also available to the world. So, it is not that Indian journal is not accessible to American citizens or not accessible to European Unions. So, it is just that it is published by WIPO office. Indian journal is published by the IPO office.

So, that is the only difference; otherwise, both are the same thing. So, these are the three common processes when you are going for PCT filing. These three things will automatically happen. Like these three things automatically happens in our case also. Now, the next two steps are optional. The Fourth step is supplementary international search.

Now, in this supplementary international search what is the difference between 2 and 4 because 2 is also international search and this is also international search. Now, this second ISA it identifies at our request published documents which may not have been found by the first ISA which carried out the main search because of the diversity of prior art in different languages and different technical fields. So, it is quite possible that you give your application in English and there are some keywords available in that, but it is quite possible that there may be some prior art available in other international languages also and there may be some prior art which may not be exactly found because of the keywords given by you. So, it requires more holistic search so the primary search is limited to the criteria given by you in your application but the supplementary search is a much broader search which is beyond the language constraint which is beyond the keywords suggested by you because something some innovation which you are doing in the field of let us say sports but it may find some

prior art in the field of physics because you are only mentioning the application part. So, our international search in the case of a new kind of issue will happen only in the field of sports or in the fields of the shoe technology. But when I go for supplementary international search it may also be in the field of material science because shoes may require different type of material. it may also be in the field of adhesives because there are lot of adhesives which are used and may be also in the field of physics because how shoes are giving you that type of push which can help you to accelerate at a faster rate. So, if you are making claims that are related to a better quality shoe

So, my international search will be initially limited to shoes and those surrounding areas, but the supplementary search will include many other things which may not be the part of my initial international search. So, this is optional option and something which is optional you can understand may come at extra cost. So, it is your duty and responsibility because when you are going for optional searches the chances of patentability of your invention become higher.

So, that is the benefit of going for a supplementary international search. But as a inventor if you are automatically satisfied because maybe you have some in-house resources available through which you can check about your patentability, novelty, prior art there may not be no need of this optional international search. So, you can take a call if you have resources do not go for supplementary international search, but if you do not have in house resources maybe the supplementary international search will improve the quality of

patentability in your application. And another thing that is international preliminary examination this is the fifth activity. So, as I mentioned four and five are optional.

1, 2, 3 these are mandatory. Now, preliminary examination. So, this international searching authority at our request will carry out an additional patentability analysis usually on a version of our application which we have amended in light of content of the written opinion. So, written opinion comes when we get international search. So, international search was done that is a mandatory activity.

we get written opinion of the ISA and based on that written opinion of the ISA, we can modify, we can respond to those opinion, those observations of ISA and based on those observations, we may request ISA for our primary examination of the application. So, these are the five stages, five activities which are part of our international phase. So, when we are filing PCT these five stages will be completed. Now, you get after this preliminary examination you get the examination report from PCT you get the examination report.

Now, after getting this examination report the second phase of this international filing starts that is the national phase. Now, the beauty of this PCT system is that that once you have done this first phase and you got this report you have this examination report and you can go to different doctors. So, it is kind of a pathology and in a reputed pathology you are getting your test done pathology has given you the reports. Now, it is your choice you want to go to hospital A, B, C, D pathology is not going to give you

Pathology is only going to give you examination of your body condition, blood report or other kind of test which you have gone through. So, the report of that is given by the pathology. But for the treatment, you need to go to a hospital. Same thing is in case of PCT. This international phase is like pathology where you got the examination report with you.

Now, with that examination report you will go to different countries patent office or regions patent office because the protection will be given by those country or region. So, it is like similar to treatment done by a hospital. So, national phase is after the end of the PCT procedure usually at 30 months from the earliest filing date of your initial application. from which your claim priority starts you start to pursue the grant of your patent directly before the national or regional patent offices of the country in which you want to obtain the patents. So, means is now you have this examination report.

So, the entire process of examination in the hospital is avoided directly your treatment will start. So, the process becomes much faster and cost effective. Now you can understand if you have done your initial blood examinations in a slightly inferior type of let us say lab which does not have credibility you must be knowing that hospital will say okay we are not accepting these reports we will do our test on our own. So this WIPO report now but if you come from a very reputed lab which is well established in the market. And if you have taken the report of that well established lab then in that case hospital will accept that report and will immediately start the treatment of the patient.

So, you can save lot of time in getting the examination of your patient. Same thing is in case of PCT once you get this examination report from WIPO from ISA then National phase will not do the entire literature survey, entire examination etc. That becomes the starting point for the grant of your patent. So, the process becomes much faster of granting the patent.

So, you can avoid multiple examinations of your application in different countries or different regions. Only single examination done by the patent this ISA. and that single examination is accepted among all 150 plus countries and regions which are right now the member of PCT. So, that is how PCT is becoming very popular in our international filing of the patents. But the Paris Convention is also there and you can see that how in India

the Paris Convention applications are moving in this case. So, like in 2013-14 India has around 3700 applications under the Paris Convention and only in 18-19 there was a surge in this number of application but continuously these numbers are declining continuously these numbers are declining and it is because of people are got more interested in PCT because now people are understanding that PCT is a better way and therefore, you can see that trend of PCT is continuously improving. When we see the Paris convention. Paris Convention is because you are directly going to a particular country for file the application.

So, when you want to have a limited spending plan and need the patent protection promptly. So, here in fact you are directly jumping into the national phase. In PCT we have international and then national. But in Paris Convention, since we are not following this international phase we are directly from my.

So, in fact, this international national sequence is very confusing for many of us you can consider it like this way host and after host international phase and after that national

phase. This should be the right sequence of mentioning your different stages in the international filing. but in the case of the Paris convention this stage is not needed. From our host domestic filing I can directly go to the national phase. So, that saves time because whatever time is taken and because I want to protect only in one or two countries therefore, there is no need of PCT kind of issues, but if I want to go for more countries

PCT is certainly advisable. So, Paris Convention and PCT you can compare on the basis of number of countries where you want to protect your IP. More countries you want to protect certainly PCT is advisable. If you want to protect in limited number of countries you can go for the Paris Convention. Since we are under the influence of globalization

Our companies are going not only to the USA, but they are going to African countries. Many, many Indian companies are now doing business in the African Union. And therefore, most of the organizations are looking for PCT filing. So, the trend of the PCT filing is increasing. we will discuss about the trends and some of the important statistics related to PCT in our next lecture where we will see that what type of trend Indian companies are following with respect to their international filing and that will give us lot of strategic inputs also that

what are the main outcomes, what type of portfolio management Indian organizations are following with respect to their foreign filing. With this, we come to the end of this video. Thank you very much.