

10 things you should know about Industrial Property



What is Industrial Property?

Industrial Property is the set of exclusive rights protecting innovation shaped as new products, procedures and designs as well as the business activity carried out through the exclusive identification of products and services offered in the market.

There are several types of Industrial Property rights in Spain:

- **Industrial designs:** protect the external appearance of products.
- **Distinctive signs (trademarks):** identify the products and services of a certain entity.
- **Patents and utility models:** protect products and procedures for industrial use.
- **Topography of semiconductor products:** protect the layout of the elements and layers in an integrated circuit, its three dimensional disposition and interconnections; this is, the topography of the product.

Which requirements must the patent meet?

Three main requirements are to be met:

- **Novelty**: the invention cannot be included in the state of the art, so it must have not been available to the public in any part of the world by means of a written or oral description, a use or any other method. Hence the importance of not publishing it until the patent application has been filed.
- **Inventive step**: the invention must not be evident to an expert in the field in view of the status of the technique.
- **Industrial application**: the invention must be apt for manufacture and use in any kind of industry.



Can all kinds of results be protected by a patent?

Not all the results meeting the previously mentioned requirements can be protected by a patent.

Some non patentable results are:

- ✓ creations with a specific industrial property right: aesthetic creations protectable by a design as well as literary creations and software, whose protection is carried out by means of intellectual property.
- ✓ inventions without an industrial application, such as surgical and therapeutic treatment methods for humans and animals or diagnosis methods applied to the human body or to animals.
- ✓ inventions against the public order such as human cloning procedures or genetic identity modification methods.



What is the difference between a Patent and a Utility Model?

According to article 143 of Patents Law, “new inventions entailing an inventive activity to configure, shape or constitute an object from which a visible advantage in its use or manufacturing will arise are protectable as Utility Models”.

Utility models can only be obtained with a view to protecting product inventions and can never be applied to procedures. Moreover, they are suitable to protect inventions of a lower inventive status than patents and the novelty requirement is only applicable at a national level.

The validity of a utility model is 10 years, while patents remain in force for 20 years.

Who is the owner of a university patent?

According to article 20.2 of Patents Law, the University owns the inventions made by professors in the carrying out of their research functions at the University within the scope of their teaching and research activities.



Is an Industrial Property right granted in Spain valid abroad?

Industrial Property rights are of a territorial nature, thus the protection is only applicable in the territory or country where it is registered.

In order to protect industrial property rights abroad it is necessary to apply for registry of the invention in each of the countries where protection is requested. There are international agreements and treaties to facilitate the application and granting of industrial property rights at a Union or an international level:

- ✓ European Patent
- ✓ International Patent Application according to PCT

What is Priority Right?

Whenever a Patent application is filed in a signatory country of the Paris Convention for the Protection of Industrial Property, a Priority Right is generated.

According to the Paris Convention, a **Priority Right** implies that *“Anybody who duly files an application for patenting an invention or a utility model in Spain will have 12 months to extend its protection to the rest of the countries, maintaining the date of the first application”*.



How long does the patent protection last and how can it be extended?

Patents are valid for a maximum of **20 years** from the moment they are applied for. Once that period is over, inventions are considered to be public property and anyone can freely use them.

After the 20-year period, patents cannot be renewed.

For pharmaceutical and phytosanitary products only, it is possible to request a Supplementary Protection Certificate (SPC) which extends the protection of the patent after its expiry date for a maximum period of five years.



Which are the formal requirements for patent applications?

According to article 21 of Patents Law, a patent application must include:

- A request addressed to the Director of the Spanish Patents and Trademark Office
- A description of the invention for which the patent is requested
- One or more claims
- The drawings the claims or the description refer to
- A summary of the invention



How long can the patent application process last?

Normally, 26 to 36 months elapse between the patent application and its awarding.

However, it is important to take into account the fact that the owner of the patent holds the following rights in the period between the filing of the application and its granting:

- ✓ **Priority right:** gives its holder the right to request the patent in other countries within the 12 following months, keeping the initial application date in all of them.
- ✓ **Provisional Protection:** from the publication of the patent application and as long as it is finally awarded, the applicant is entitled to request reasonable redress to anyone who infringes the patent.
- ✓ **“Time is bought”** by preventing the applicant from paying a significant sum of money at the beginning of the process. The applicant only enters the next stage if the patent is likely to be traded and implemented into the market.
- ✓ **Obtaining a financial profit from the patent application:** it is permitted by law to assign, pledge and license both requested and granted patents.

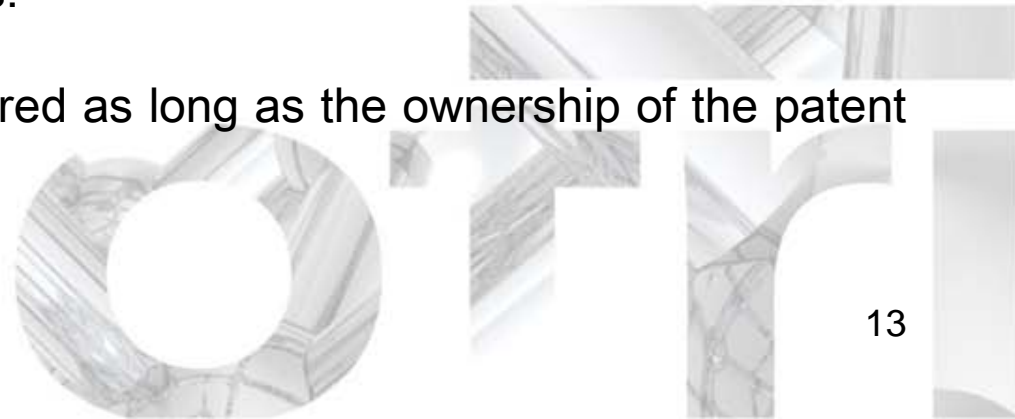
What are the benefits of patenting results for the inventors?

Patents can be key to turning innovative ideas and inventions into competitive products with benefits at different levels:

- **Career level**: being listed as an inventor in a patent is an acknowledgement taken into account in professional promotion evaluation standards.
- **Financial level**: income can be obtained from royalty fees by granting licenses on patented inventions to companies with the capacity to market them, as stated in article 20.4 of Patents Law.

What happens if inventions are not patented?

- No exclusive rights are held on the invention. Therefore, as soon as the patent is used or spread it is regarded as a public property and can be used by anyone.
- The invention may be patented by a third party. If it is not patented and somebody else has developed the same invention or an equivalent one and wishes to patent it, the use of the first invention may be banned under penalty of payment of royalty fees.
- Technology transfer will be hindered as long as the ownership of the patent is not explicitly acknowledged.



Is publishing in scientific journals incompatible with patenting an invention?

It is not incompatible, but certain specific steps must be followed.

With a view to fulfilling the novelty requirement, the content of the patent cannot be published or made public through any means before protection is requested before the corresponding authorities.

Once the request is filed, the content of the invention may be published without waiting for the patent to be awarded.



What should I do if I have obtained a result which I deem capable of generating a patent?

You should inform OTRI of the research result and, above all, you should NOT publish anything until it has been protected.

At OTRI we will guide you through procedures to protect your invention and give you advice you on the most suitable protection modality.



What are the advantages of patent documents as sources of information?

- They include information that is not usually made public in any other kinds of documents
- They keep a relatively standard format including a summary, bibliographic information, a description of the invention and, in most cases, explanatory drawings.
- They are classified per technical fields according to an international patents classification
- They cover practically all fields of technology

Why can information on patents be useful?

Patents are a great source of unique technical information that can be really useful when it comes to starting a research since:

- ✓ they help knowing what already exists, thus avoiding unnecessary expenses on investigating something that is already known and infringement of third party patents
- ✓ they allow to discover alternative technologies
- ✓ they provide an update on the latest technologies within a specific field of specialization
- ✓ they help solving technical problems
- ✓ they provide ideas to keep innovating
- ✓ they make it possible to assess the patentability of own inventions

Where and how can information on patents be obtained?

The creation of patents databases on the Internet has made the access to information considerably easier and reduced the costs.

The following are some of the information sources on patents:

- WIPO's Intellectual Property Digital Library: <http://www.wipo.int/ipdl>
- Single searches in patent centres or national patent offices. Example: www.oepm.es (Spanish patents office), www.epo.org (European office) and www.uspto.gov (American office)
- Retrospective searches and technological reports issued by the Spanish Patent and Trademark Office on payment of a fee.

CONCLUSIONS

10 THINGS YOU SHOULD KNOW ABOUT INDUSTRIAL PROPERTY (I)

- New inventions with an inventive step and industrial applications can be patented.
- Not all results can be patented. In some cases, they can be protected by means of another type of industrial property right or copyright.
- The University is the owner of the inventions made by professors in due course of their research function.
- Patents have a maximum validity period of 20 years from the application date. The validity of utility models is 10 years.



CONCLUSIONS

10 THINGS YOU SHOULD KNOW ABOUT INDUSTRIAL PROPERTY (II)

- Industrial Property rights are territorial, so inventions are only protected in the territory where they are registered.
- Patents generate FINANCIAL and CAREER benefits.
- PATENTING must be done before PUBLISHING.
- If a result is not patented, it is considered as a public property as soon as it is spread and can therefore be used by anybody.
- Patents are a source of technological information allowing us to know what already exists.
- Whenever you obtain a research result YOU MUST CONTACT OTRI.