

Patent Rules and Scenarios

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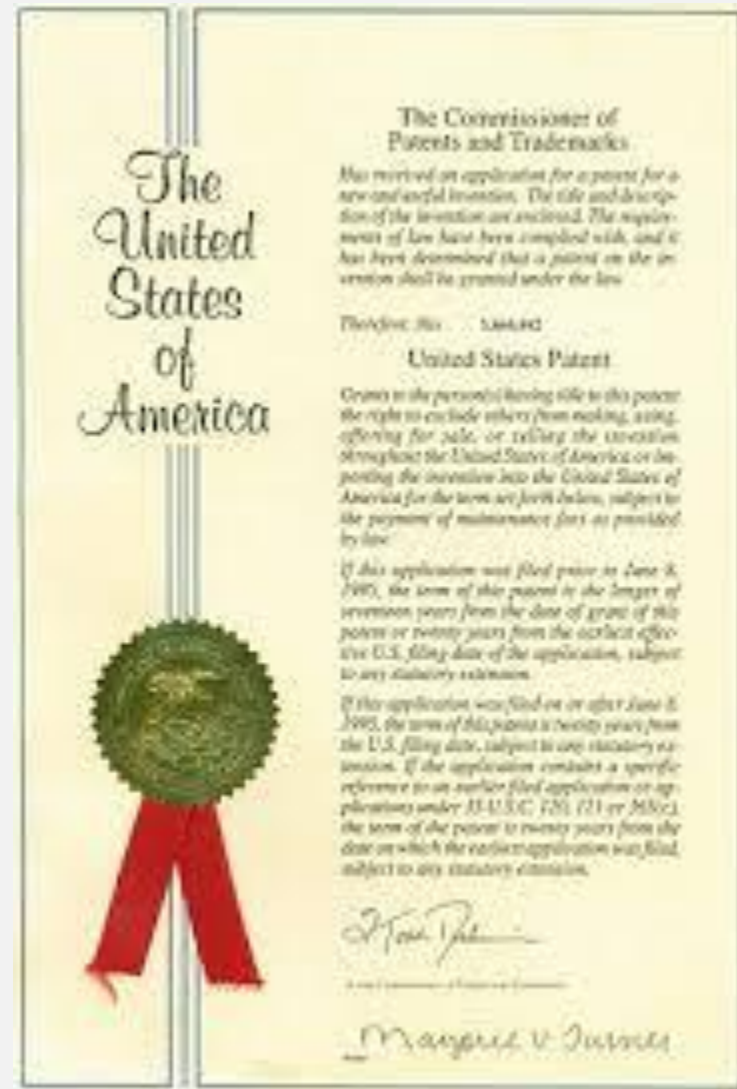
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What is a Patent?

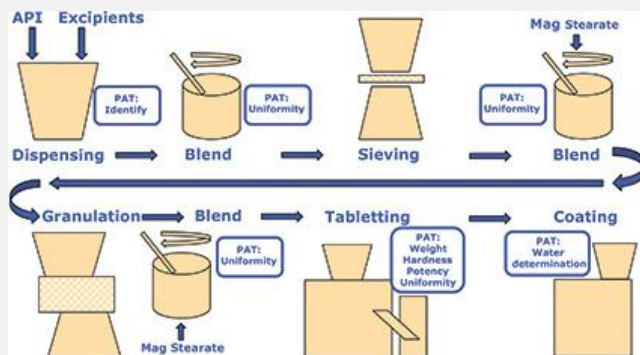
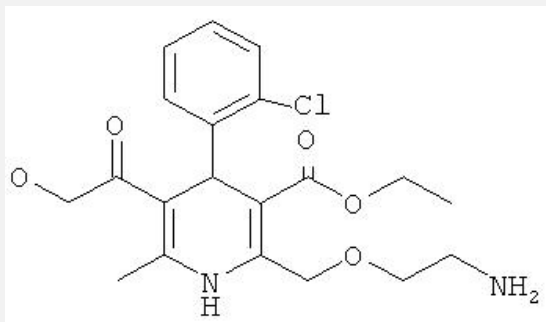
- A patent is an official document given to an inventor by a government.
- This document generally gives owners the right to prevent anyone else from utilizing the invention without their permission.



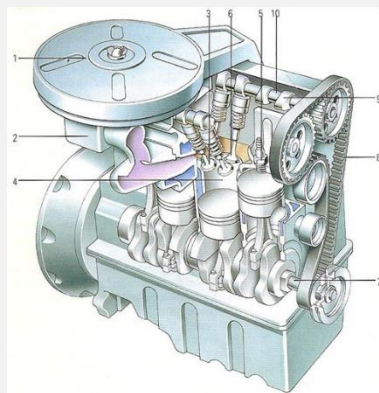
Characteristics of Patents

- ❑ An “Invention” is a new product or process that solves a technical problem.
- ❑ Term of protection is 20 years from filing date, in some jurisdictions priority date.
- ❑ Patents could be granted to amendments on existing products or processes.
- ❑ Patentable subject matter differs according to jurisdiction.

Examples on Patentable Subject Matter



USE



Conditions for Patentability

Novel

- not disclosed in any way anywhere prior to filing.

Inventive

- not obvious to a person with moderate experience in the field
“person skilled in the art”.

Industrially Applicable

- can be applied in the industry (has some kind of utility).

Novelty and Inventiveness

In order to assess novelty and inventiveness, a prior art search should be done prior to filing.

Prior art is basically anything disclosed anywhere in the world in form of publication, use, or oral disclosure.

Definition of prior art varies according to the jurisdiction.

Prior art search has two steps: General search and specialized patent search.

Specialized Patent Search

Can be conducted in free and commercial patent databases.

Free patent databases include Google Patents, Espacenet, Patentscope, and USPTO databases.

Commercial patent databases may provide results of reviewed publications.

Espacenet gives the user the ability to search using keywords and/or classifications.

Searching Using Google Patents

- www.google.jo/patents
- Searches automatically full-text.
- Uses the conventional search method of Google search engine.
- Provides the status of patents granted by the USPTO and the EPO.

Google Patents Operators

Boolean/Logic

Phrase

Character(s) wildcard

Boolean/Logic Operators

AND or space or (+)

OR or (|)

NOT or (-)

AND Operator

- Is used to obtain search results that include the connected terms.
- Connects two consecutive terms only. For including more than two terms, use AND operator to connect between each two consecutive terms.
- The AND operator can be replaced by a space, and the results will be similar.

OR Operator

- Is used to obtain search results that contain either of the connected terms.
- Connects two consecutive terms only. For including more than two terms, use OR operator to connect between each two consecutive terms.
- Can be used to obtain search results including alternative terms.

NOT Operator

- Is used to obtain search results that does not include the term following the operator.
- Indicated by the minus sign (-).
- Excludes one term only.
- A space should precede the minus sign, but there should be no spaces after the sign.

Phrase Operator

- Represented by quotation marks “”.
- Is used to include results that contain the exact terms in the exact order as indicated between the quotation marks.

Character(s) Wildcard

- Is represented by the star (*) sign.
- Is used when you are sure about the beginning of the term but not the whole term.
- No space should be used before the operator.
- Is used to obtain search results that include terms that begin with letters preceding the operator.

Google Advanced Patent Search

https://www.google.com/advanced_patent_search



Google Advanced Patent Search Interface



Find results

with all of the words

10 results ▼

Google Search

with the exact phrase

with at least one of the words

without the words

Patent number

Return patents with the patent number

Title

Return patents with the patent title

Inventor

Return patents with the inventor name

First name, last name, or both

Original Assignee

Return patents with the original assignee name

First name, last name, or both

Current U.S. Classification

Return patents with the current U.S. classification

Comma separated list of one or more classification codes.

International Classification

Return patents with the international classification

Comma separated list of one or more classification codes.

Cooperative Classification

Return patents with the cooperative classification

Comma separated list of one or more classification codes.

Patent type/status

Return patents with type/status

Date

Return patents anytime

Return patents between and

e.g. 1999 and 2000, or Jan 1999 and Dec 2000

Restrict date by

Restrict by filing date


Restrict by issue date

Searching Using Espacenet

- Launched in 1999 as a cooperative project between the EPO and its member states.
- Enables the user to search full-text for publications in EN, FR and DE (i.e. the EPO's three official languages).
- Provides a direct link to review the status of EP patent/application centrally at the EPO (EP register).
- Allows user to search using classification search.



<https://worldwide.espacenet.com>



Europäisches Patentamt
European Patent Office
Office européen des brevets

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Patent search

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Smart search
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Quick help ▹

- How many search terms can I enter per field?
- How do I enter words from the title or abstract?
- How do I enter words from the description or claims?
- Can I use truncation/wildcards?
- How do I enter publication application, priority and PCT reference numbers?
- How do I enter the names of persons and organisations?
- What is the difference between the IPC and the CPC?
- What symbols can I use for the publication date?
- How do I enter a date range for a publication date search?
- Can I save my query?

Related links ▹

Advanced search

Select the collection you want to search in:
Worldwide LON - collection of published applications in English

Enter your search terms - CTRL-ENTER expands the field you are in

Enter keywords

Keyword(s) in title, abstract and full text:
satellite receiver

Enter numbers with or without country code

Publication number:
WO/2008/14520

Application number:
DE 100/71031698

Priority number:
WO 1998/015926

Enter one or more dates or date ranges

Publication date:
2014-12-31 or 20141231

Enter name of one or more persons/organisations

Applicant(s):
Infotel Peugeot

Inventor(s):
Smith


Enter one or more classification symbols

CPC:
F 03G 7/10

IPC:
H03M 1/12

Clear Search

Sitemap Accessibility Legal notice Terms of use Last updated: 05.03.2016 Worldwide Database 6.0.12 50p



Espacenet Advanced Search

Advanced search

Select the collection you want to search in

Worldwide - collection of published applications from 90+ countries

Worldwide - collection of published applications from 90+ countries

Worldwide EN - collection of published applications in English

Worldwide FR - collection des demandes publiées en Français

Worldwide DE - Sammlung veröffentlichter Anmeldungen auf Deutsch

Enter keywords

Title:

plastic and bicycle

Title or abstract:

hair

Enter numbers with or without country code

Publication number:

WO2008014520

Application number:

DE19971031696

Priority number:

WO1995US15925

Espacenet Advanced Search

Enter one or more dates or date ranges

Publication date:

2014-12-31 or 20141231

Enter name of one or more persons/organisations

Applicant(s):

Institut Pasteur

Inventor(s):

Smith

Enter one or more classification symbols

CPC

F03G7/10

IPC

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[Clear](#)



Cooperative Patent Classification (CPC)

Cooperative Patent Classification

Search for

View section **Index** | A | B | C | D | E | F | G | H | Y

A »

Classification and description		Symbol
HUMAN NECESSITIES		A <input type="checkbox"/>
PERFORMING OPERATIONS; TRANSPORTING		B <input type="checkbox"/>
CHEMISTRY; METALLURGY		C <input type="checkbox"/>
TEXTILES; PAPER		D <input type="checkbox"/>
FIXED CONSTRUCTIONS		E <input type="checkbox"/>
MECHANICAL ENGINEERING; LIGHTING; HEATING; WEAPONS; BLASTING ENGINES OR PUMPS		F <input type="checkbox"/>
PHYSICS		G <input type="checkbox"/>
ELECTRICITY		H <input type="checkbox"/>
GENERAL TAGGING OF NEW TECHNOLOGICAL DEVELOPMENTS; GENERAL TAGGING OF CROSS-SECTIONAL TECHNOLOGIES SPANNING OVER SEVERAL SECTIONS OF THE IPC; TECHNICAL SUBJECTS COVERED BY FORMER USPC CROSS-REFERENCE ART COLLECTIONS [XRACs] AND DIGESTS		Y <input type="checkbox"/>



Espacenet Operators

- Same as Google Operators, but with different representations.
- The (+), (-), and (|) are not used.
- The representations are AND, OR, and NOT.

Parts of Patent Specification

- Title of invention
- Technical field
- Background
- Summary
- Brief Description of Drawings
- Detailed Description
- Claims
- Abstract
- Drawings

Title of the Invention

The title should be brief but indicative of the subject of the invention. In some Jurisdictions such as SA, the title should not exceed seven words.

Examples of patent titles include wind turbine, system and method for verifying identity, kinase modulators, method for treating acne.

Technical Field

The technical field states the specific field to which the invention relates, this could help the patent office in distributing the pending applications that are ready for examination to the correct examiner.

Background

In the background, the current status of the state-of-the art is discussed and all close prior art solutions to the technical problem that lead to the invention are described.

The background ends by the drawbacks of the cited prior art solutions.

Summary

The summary briefly describes the objectives of the invention.

Some attorneys like to rephrase the claims and insert them in the summary.

The summary may include a description about the features of the invention without referring to the drawings.

Some attorneys do not include this section in the specifications they draft.



Brief Description of the Drawings

Some inventions, especially the mechanical/electrical ones, are hard to understand without referring to a set of drawings.

This section, as the name depicts, includes description of drawings, such as: FIG. 1 illustrates a perspective view of a wind turbine configured in accordance with embodiments of the invention.

Detailed Description

In this part, the description is done in detail with reference to the accompanying drawings.

In general, every feature of the invention must be described in detail both individually and in combination with other features and how would those feature operate with each other.

How Much Info Should be Disclosed in the detailed Description?

- ▣ The invention should be described in a detailed level that allows a person skilled in the art to reproduce or make the invention.

Claims

The most important part of the patent specification.

Form the legal boundaries of protection.

Should not be broader than the description.

Terminologies should be consistent with those used throughout the description.

Abstract

Provides a summary of the invention and its features.

Some attorneys derive the abstract from the independent claim(s).

Drawings

Should be in black and white lines of good resolution.

Show every feature of the invention.

Every part in the claims should be illustrated in the drawings.

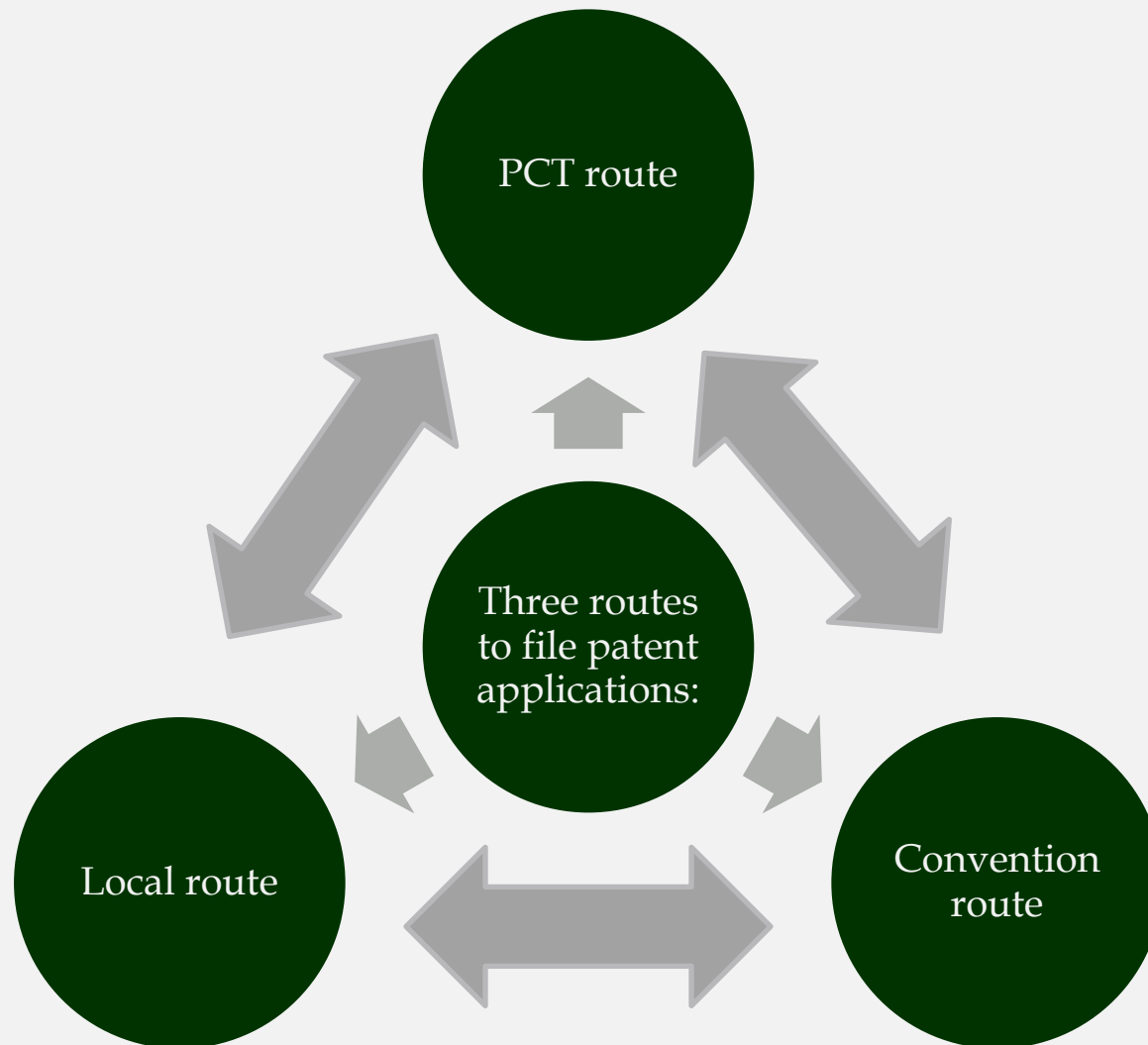
Some Patent Offices, such as SA, prevent using words on Drawings.

May include some drawings of the prior art solutions to make it easier to understand the inventive concept easier.

Example of a granted patent

- <https://patents.google.com/patent/US9243556?q=abazid>

Patent Applications Filing Options



Local Route

- Filing all patent applications in jurisdictions of interest prior to any publication.
- All costs are incurred at the early stages.
- Cost ineffective, as the applicant may lose interest in prosecuting any of the filed applications.

Convention Route

- Filing a first application at a Paris Convention member states (176 countries).

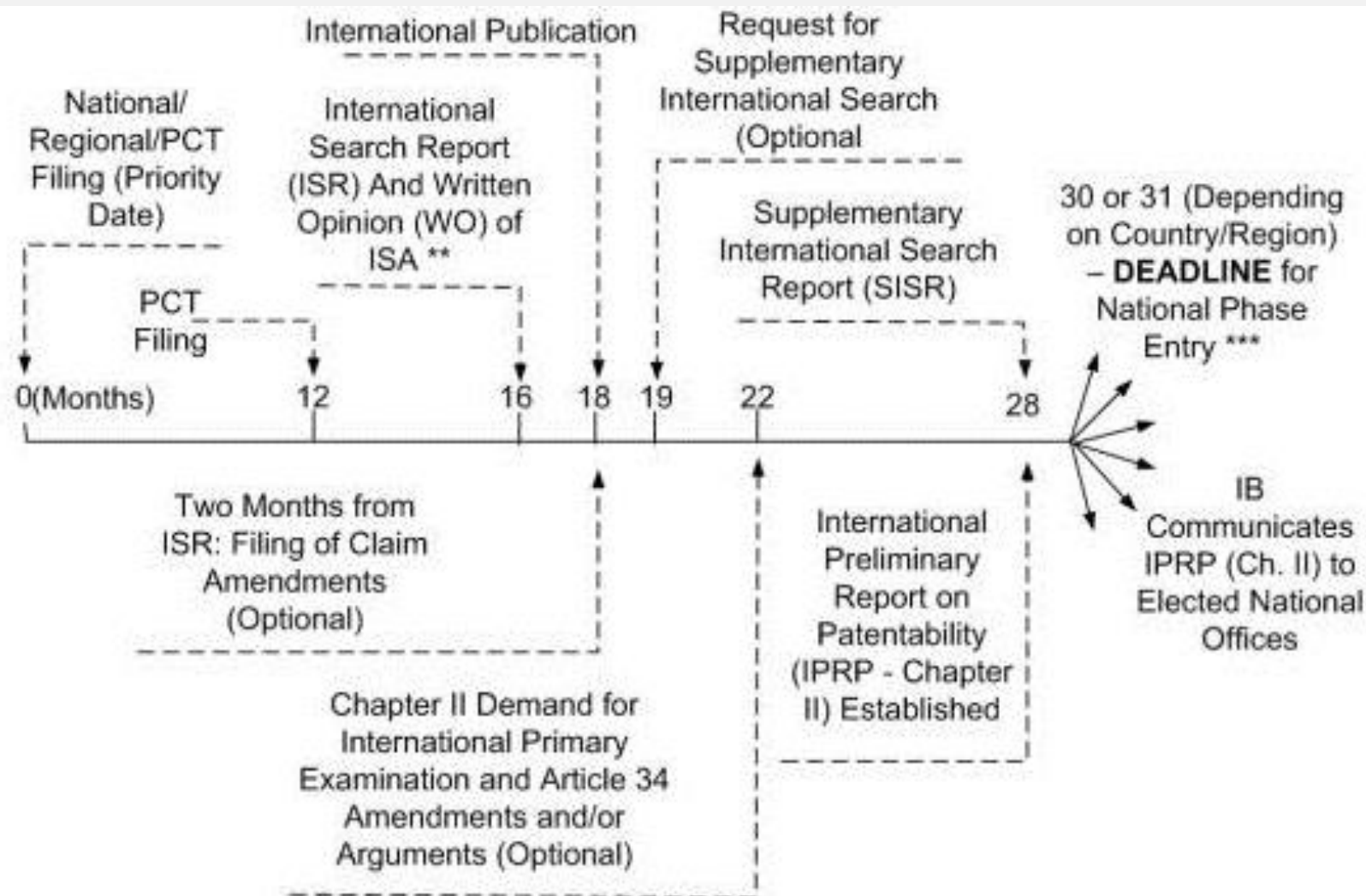
http://www.wipo.int/treaties/en/ShowResults.jsp?treaty_id=2

- Within 12 months after the first filing date, the filing is extended to other Paris Convention member states, **claiming the priority of the first filed application.**
- Term of protection for the invention may be extended up to 12 months.
- Majority of costs are deferred up to 12 months.

PCT route

- PCT refers to Patent Cooperation Treaty.
- 150 member states
http://www.wipo.int/pct/en/pct_contracting_states.html
- Jordan is not a PCT member state yet.
- Filing system, not a patenting system.
- The applicant files an international **application** (international phase) that ends up with a bundle of national/regional applications/patents (national/regional phase).
- The applicant should be a resident or national of a PCT member state (Article 9/a).

PCT Timeline



PCT Characteristics

- The application is filed at a Receiving Office (RO).
- This receiving office may be either the International Bureau (IB) of the WIPO or the national patent office of the applicant's country.
- The applicant has the ability to choose the ISA and/or the IPEA.
- The selection is made from a list of ISAs designated for each RO.

PCT Benefits

- Majority of filing costs related to national filing is deferred up to 31 months.
- The applicant receives an International Search Report (ISR) and written opinion from International Searching Authority (ISA).
- However, the opinion of the ISA is not obligatory to other Patent Offices.
- The applicant can file an international application claiming priority of an earlier filed application.

Patent Filing Options

Which Option is Best?



Patent Filing Options

The answer merely depends on the strategy of the assignee and the markets of the invention.

Example 1

JO application

August 9,
2016

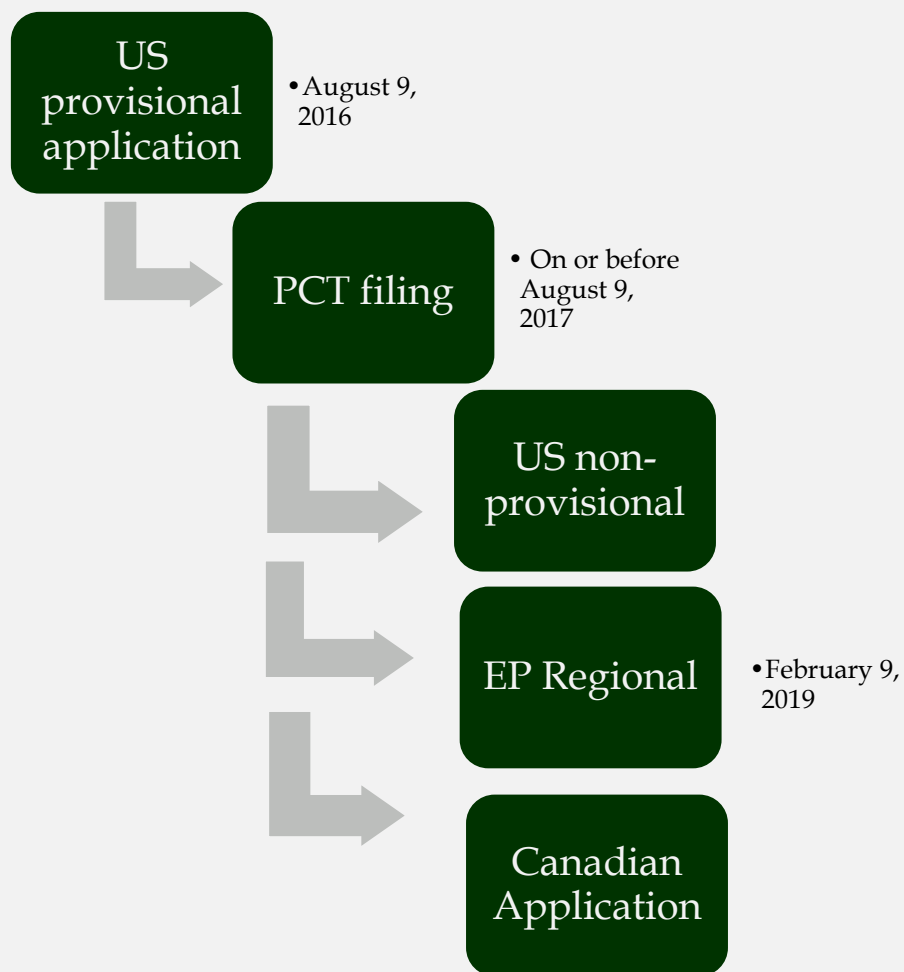
US application

August 12,
2016

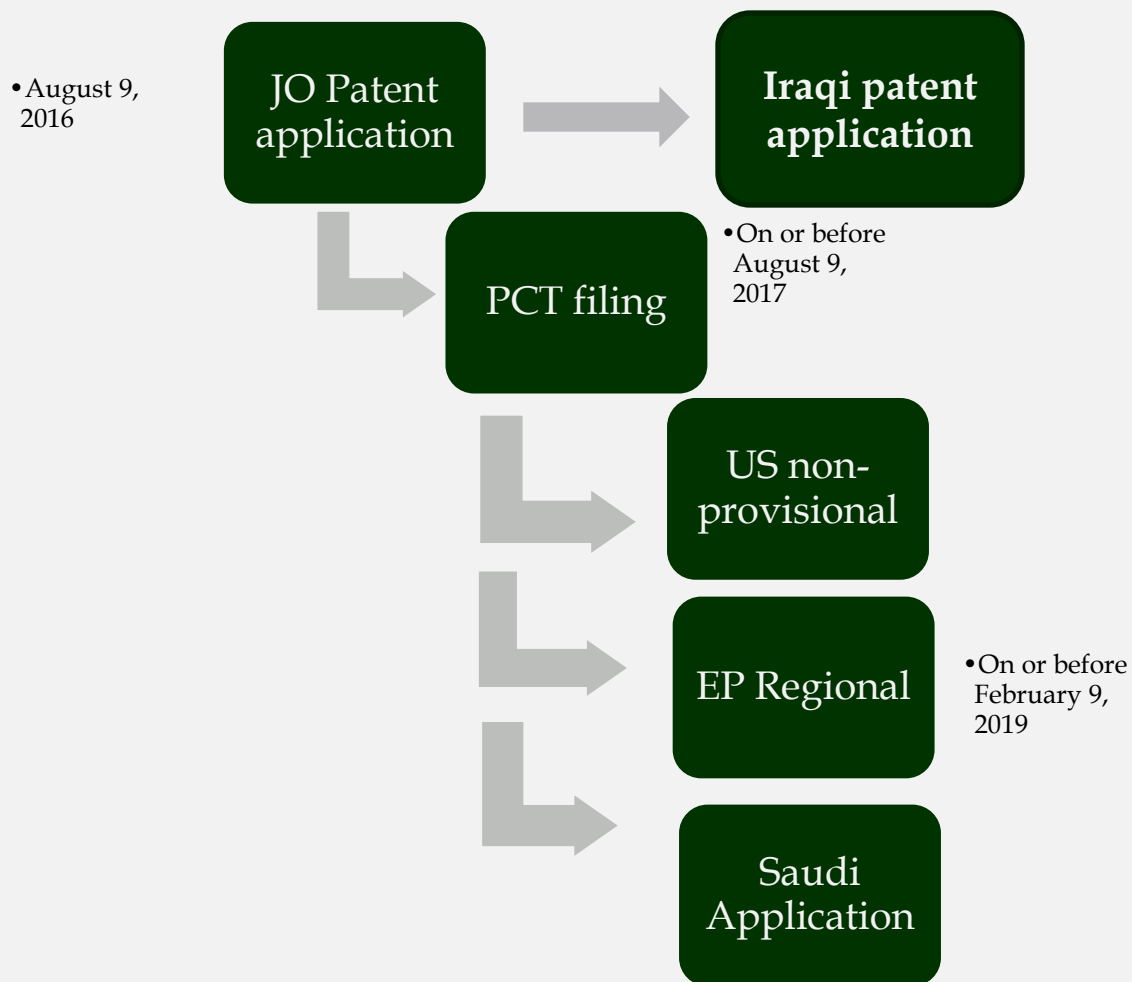
AU application

December 12,
2016

Example 2

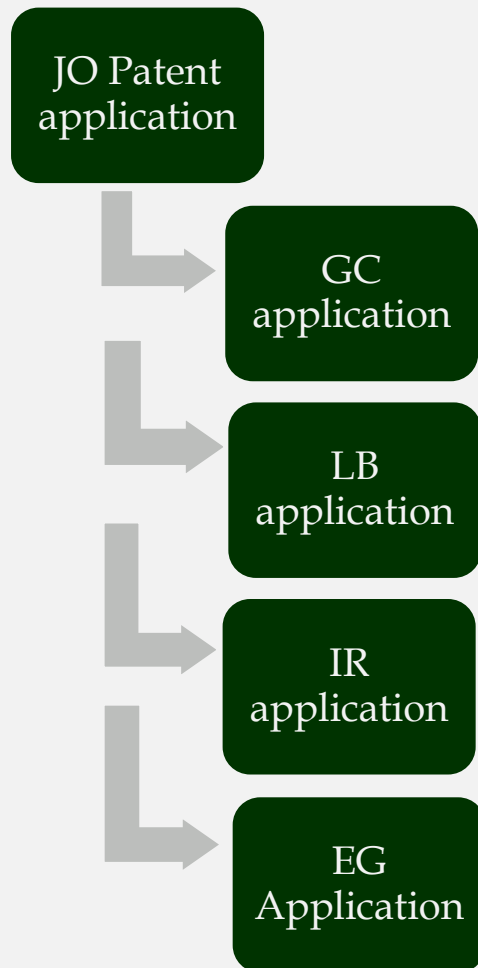


Example 3



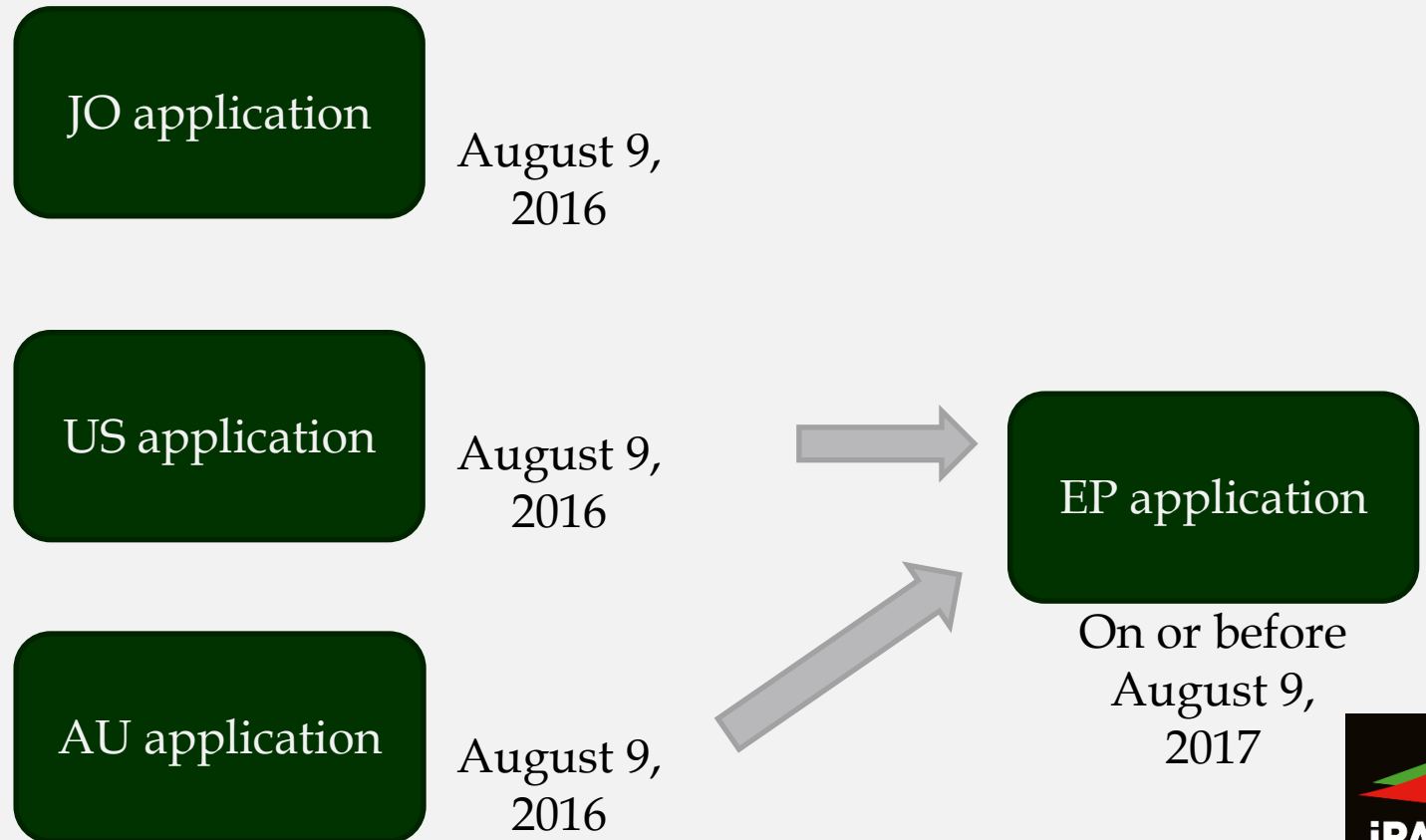
Example 4

- August 9, 2016

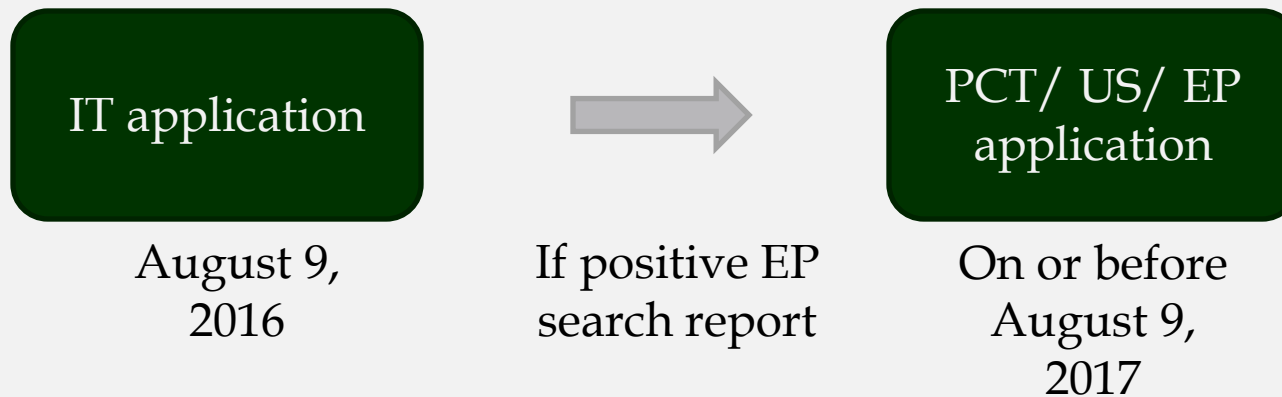


- On or before August 9, 2017

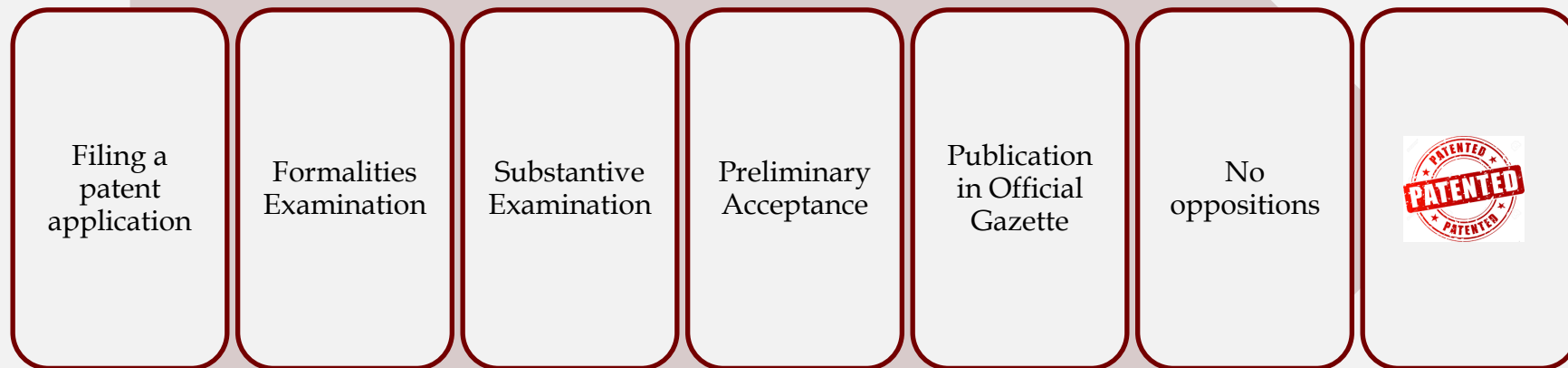
Example 5



Example 6



Patent Application Procedures in Jordan



Jordanian Patent Office

- Is a part in the Industrial Property Directorate at the Ministry of Industry and Trade.
- Includes patent examiners, department head and the registrar of patents.
- Receives a majority of applications from foreign applicants.

Substantive Examination for Applications by Local Inventors with no priority

- Benefits from the WIPO's ICE (International Cooperation on Patent Examination) service to conduct prior art search, which is outsourced to another patent office that has the infrastructure and capability to conduct such a search (such as the Austrian Patent Office), the search is accompanied by an opinion of the examiner; however, in this case the Jordanian Patent Office may consider the opinion or not.
- In some cases, the search is conducted in house by the patent examiners.
- In all cases an office action stating the objection (if any) or allowance of the patent application will be issued by the Jordanian Patent Office.
- The time frame ranges between about two to five years.

Freedom-to-Operate

- Also called as “clearance search”.
- Conducted on patents and patent applications only, in order to check that the product is not infringing any patents in force or any applications yet to be granted.

Freedom-to-Operate

Which patents/patent applications are of interest to the searcher?

Freedom-to-operate is territorial.

Prior art search vs. Freedom-to-operate

Prior art

- Patent and non-patent search.
- Worldwide publications.
- The whole disclosure is assessed.

Freedom-to-operate

- Only in force patents and applications.
- Territorial patents/applications.
- The whole disclosure is assessed with focus on the claims.