

The legal and technical framework for patents

What are the legal statuses of patents?

Hello everyone and welcome to our course covering the basics in terms of the technical and legal framework for patents. My name is Duncan Clark and I'll be guiding you through this topic in this six-part series of modules. In this module, we'll take an introductory look at the various 'legal statuses' that can apply to patents and how these are used.

As the World Intellectual Property Organization points out: "The availability of up-to-date, reliable, and understandable legal status information on IP rights is necessary if individuals are to be able to avoid IP right infringement."¹

They go on to state: "IPOs currently provide this information in various formats and languages, inconsistently, and in an untimely manner due to the difference of national and regional patent laws and practices."

For this reason, the WIPO is proposing a standard, which "aims at improving worldwide availability, reliability and comparability of patent legal status data in a timely manner." As a starting point, they use what's called the Prosecution model and in this webinar, it's this model from the WIPO that we'll use as our foundation.

So here it is and - as we can see from the chart - the legal framework is indeed extremely complex. However, in its simplest form, we can see that there are three main legal 'top level' statuses, as described by the WIPO.

Firstly, there is active. This means that the application is pending or the IP right is in force. Then, we have the events that create a 'Not active' status: This means that the application is discontinued or the IP right is not in force.

Finally, there is 'Terminated': In this case, the discontinued application or the not-in-force IP right cannot be revived. The WIPO explains that exceptionally this state may return to "Active" or "Not active" due to a change in IP legislation, although this only applies to some jurisdictions.

It is possible to refine a search according to these different statuses. Now, let's just illustrate this with an example in PatSnap. So, I'm just going to take an application date of whenever to today and run that search.

Now if I hit 'More filters' and scroll down to legal status, we can see the different statuses, which we could use to refine our search. For example, in PatSnap, the green and orange fields (granted, pending and published) will equate to the active status in the Prosecution Model we saw a moment ago.

¹ http://www.wipo.int/edocs/mdocs/cws/en/cws_5/cws_5_8_rev_1.pdf

Meanwhile, the legal events in grey are all non-active patents – and these events include patents that have expired, that have non-payment status, that have been abandoned, withdrawn, rejected or revoked. The double status is another type of patent rejection, where the patent is believed to be a duplicate of an already patented invention.

If you are not interested in the detail, but simply want to find active versus inactive patents, you can use a simple legal status search instead. Here, in PatSnap, for example, we can see that the statuses that were in grey in the more detailed version are aggregated into 'inactive.' Active and pending are in green and orange respectively.

So if we just return to the Prosecution model briefly, we can see the search filters and how they map to this model. However, as we can also see, there are a number of other possible additional legal events that can take place during the whole process, and some of these are denoted by an 'E' on the chart. Some of these can also be tracked using patent databases, so again if we return to our filters and open up legal events, you'll see these events listed here, including for instance 'Transfer,' which will impact ownership, a topic we cover in a later module.

So in summary, it is important to know the status of a patent, whether it is active, inactive or terminated, to determine whether a specific invention or technology is protected or not. And patent pending is worthy of note, as legal services experts, Upcounsel, explains: "Holding patent pending status is important because it allows you to begin marketing your product on the commercial market while you pursue patent status.

It also provides some control over the use of your product while warning others against attempting to file patents for substantially similar products. In order to use the patent pending notification is to apply for a provisional patent.

It's important to note that the words "patent pending" carry no formal legal significance. The term just communicates that you are pursuing a patent and have filed a provisional patent or a patent application. It is this provisional patent or application that protects you for a brief period of time, with protections similar to a regular patent."²

So there we have it, a brief introduction to the legal framework surrounding patents. In the next module, we'll turn our attention to the notion of patent families.

But in the meantime, thanks for watching.

² <https://www.upcounsel.com/difference-between-patent-and-patent-pending>