

The legal and technical framework for patents

What types of patent are there?

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 over the next six modules.

In this series, we firstly look at the different types of patent that might be filed. We'll then be looking at the patent numbers themselves, so what do they mean, how are they assigned and what are 'kind codes'. We'll be examining the various legal statuses that can apply to patents, as well as exploring the notion of patent families. Next, we consider the different classification systems and their application. And then finally, we'll tackle the thorny issue of intellectual property ownership.

But let's now return to the first topic in hand: what types of patent are there?

The first point to note is there are many differences around the world in terms of how the patent system is structured, depending on the jurisdiction – so in this case, let's start with the United States and then work from there...

In the US system, there are three types of patent: utility, design and plant.

Utility patents cover products, processes or machines and there are two types of utility patent. In the US system, there is what's known as a provisional patent application and then there is the non-provisional patent. Provisional patent applications are important in an environment in which being the first-to-file is key. It enables inventors to effectively 'buy' 12 months of time, without having to commit to a full non-provisional application process and is vital for that all important priority right.

The next type of patent is the design patent. This covers the configuration or shape of an article, or 'ornamental features.' It's a patent that gives 15 years' worth of protection. As Mark Nowotarski explains in his article, "Strong Design Patents: The Power of The Broken Line," Design patents claiming a shape typically have line drawings showing various views of that shape. Solid lines in the drawings are the claimed features of the shape. Broken lines in the drawings show what the rest of the object might look like. To determine infringement, it's only necessary to compare the solid lines. The broken lines don't count." He continues: "Ironically, this means that the fewer solid lines in a design patent, or conversely, the more broken lines in a design patent, the stronger the patent."¹

So here we have an example of a design patent, with the broken and unbroken lines, and an example of one that was successfully defended in court by Apple in its case against Samsung. As Nowotarski's article points out: "The jury returned a verdict that the Galaxy S 4G and two

¹ <http://www.ipwatchdog.com/2013/07/30/strong-design-patents-the-power-of-the-broken-line/id=44215/>

other accused models infringed this patent. The total damages were over \$163 million. Not bad for a design patent.”² But, as an article by IntellentLaw also explains: “it is best to use broken lines for as many aspects of the invention as possible without reading too much on the prior art. During examination, changes that narrow the scope of the patent application are allowed, but it is impossible to broaden an application; amendments broadening the patent by converting solid lines to broken lines will be rejected except in exceptional cases.”

Alright, back now to our patent types. Just one more to cover off as far as the US is concerned, and this is the ‘plant’ patent, which covers exactly what it says on the tin. Well almost. The official definition is, it: “Covers invented or discovered and asexually reproduced, distinct and new varieties of plant, other than a tuber propagated plant or a plant found in an uncultivated state.” I’ll leave that to the experts, however the structure is the same as a utility patent – there is the provisional application option and the non-provisional patent.

Alright, let’s leave the United States now and go further afield...

So in other jurisdictions, much of the same principles apply, in terms of utility patents, which are granted for 20 years and are generally designed to cover products, processes or machines. And design patents, which, depending on the jurisdiction, afford at least 10 years protection for what can be described as the configuration or shape of an article, or indeed ‘ornamental features’. Just a note on terminology, though, you’ll find all sorts of different terms for ‘Utility patents,’ such as invention patents and standard patents, among others. For design patents, these can be referred to as industrial design, industrial design rights, or variants thereof.

OK, now a deviation from the US model – and **not** to be confused with ‘Utility patents’ in the US, there is the ‘Utility model,’ which is used in a number of jurisdictions such as Australia, China, France, Germany, Italy, Japan and South Korea, among many others.

Now the idea of a Utility model patent is to cover an incremental improvement to a product, process or machine, but in those cases where it does not warrant a full patent. The WIPO presents some good bullet points regarding the differences between a patent and a utility model.

The main differences between utility models and patents are the following:

The requirements for acquiring a utility model are less stringent than for patents. While the requirement of "novelty" is always to be met, those of "inventive step" or "non-obviousness" may be much lower or absent altogether. In practice, protection for utility models is often sought for innovations of a rather incremental character which may not meet the patentability criteria.

The term of protection for utility models is shorter than for patents and varies from country to country (usually between 7 and 10 years without the possibility of extension or renewal).

² <http://www.ipwatchdog.com/2013/07/30/strong-design-patents-the-power-of-the-broken-line/id=44215/>

In most countries where utility model protection is available, patent offices do not examine applications as to their substance prior to registration. This means that the registration process is often significantly simpler and faster, taking, on average, six months. Utility models are therefore much cheaper to obtain and maintain.

In some countries, utility model protection can only be obtained for certain fields of technology and only for products, but not for processes, so again local laws need to be checked.³

Just like the other types of patent, utility model patents can be referred to by all sorts of different names, depending on the jurisdiction. This includes, for example, petty patent, small patent, innovation patent, short-term patent and other such terms.

It is possible to refine searches in patent databases based on these different types of patent. For example, in PatSnap, you'll see that down the left-hand side of the main search menu, you can opt to include or exclude utility patents (referred to here as Patents), Design patents, utility model patents (referred to here as utilities), and of course applications.

It is also possible to differentiate certain types of document using what are known as Kind Codes, which are letters that get appended to the patent number, an area we'll cover in the next module of this course.

In the meantime, thanks for watching and we look forward to you joining us on module 2.

³ http://www.wipo.int/sme/en/ip_business/utility_models/utility_models.htm