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Intellectual Property Attorneys

Safeguarding Intellectual Property Rights of Researchers

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Outline

Invention Disclosure

Invention:

Patents

Trade Secrets

Expression: Copyrights

Summary

Invention Disclosure

What? A confidential document written by a scientist or engineer or researcher to determine whether patent protection should be sought for the described invention

Test: Sufficient information to **ENABLE** a person of ordinary skill to carry out or duplicate the invention.

Invention Disclosure

- **Title of the Invention**
- **Inventor:** Name, Address, Phone Number
- **Circumstances and Date of Conception**
(when and how did you think of the invention?)
- **Description of the Invention**
- **Testing Results** *(if applicable, what were the results of testing the invention?)*

Description of the Invention

- Purpose (*What is the invention used for?*)
- Drawings (*drawings, sketches, or photos of the invention with parts labeled*)
- Description of the Parts (*Describe the invention using the drawings to point out each of the invention's parts*)
- Use (*How is the invention used?*)
- Novel Features (*What features of the invention are different from the prior art? How do these features provide superior results?*)
- Advantages (*What advantages does the invention have over the prior art?*)

Invention Disclosure

- Signed and dated by the inventor
- Signed by two trustworthy friends (not family) under the words 'Witnessed and Understood'
- The inventor and the witnesses to initial every page.
- The Invention Disclosure should be kept in a safe place in the event the need to prove the date of conception ever arises.

Source: <http://www.patentapplications.net/disclosure/index.html>

Invention Patent

- A product or process providing a technical solution to a problem (like cost, efficiency, performance, new feature, pioneering product, etc.)
- If it is **novel or new**, involves **inventive step** (not obvious) and has **industrial applicability**
- An exclusive **right to exclude or prevent** others from using the process or selling the product for a period of 20 years
- Utility Model or 'petty' patent: no inventive step required and term is 7 years only

Republic Act No. 9502: The Universally Accessible, Cheaper and Quality Medicines Act of 2008

- Allowing parallel imports of drugs and medicines (patents and trademarks)
- **Non-patenting of known substances (new use)**
- **Non-infringement of use for regulatory approval**
- Granting emergency power to the President to regulate prices of medicines

Invention Patent

Ownership:

- Inventor or Researcher
- Employer-Employee?
- Commissioned Work?

Patents

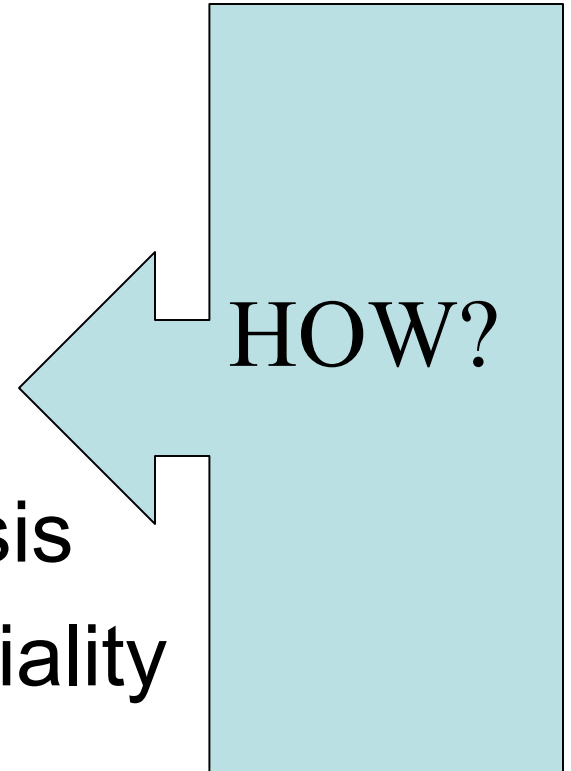
- To Patent or not?
- To Publish or Patent?
 - By publishing, inventor has grace period of 12 months to file a patent in the Philippines
 - By publishing, the invention is no longer new and not patentable in most countries.
- By publishing, you prevent others from patenting (prior art) – defensive publication

Trade Secrets

- Information
 - reasonable steps were taken to keep certain information secret
 - it has commercial value by virtue of being secret
- No law; protection by contracts and other practical means
- Art. 292, RPC: Revelation of Industrial Secret

Trade Secrets

- Employment Contract
- Office Memo
- Labels and Water marks
- Locks and codes/passwords
- Access on need to know basis
- Non-Disclosure or Confidentiality Agreements



Copyright

- Protection granted to authors, composers, artists, painters, programmers, etc. on their works of art
- Work must be **original** and with minimum amount of **creativity** or “expression”
- In research: publications, reports, case studies, experiment results, newsletters, manuals, product literature, labels or packaging, etc.

Copyrights

- Protection attaches from the moment of creation
 - No registration or formalities required
 - Copyright “registration” is NOT necessary
- Ownership:
 - Author or Creator
 - Employer or Employee?
 - Commissioned Work: Author
- Exclusive right to reproduce/copy + more

Summary

Research Output:

- Invention
 - Disclosure
 - Patents
 - Trade secrets
- Expression: Copyrights

Thank you

QUESTIONS?
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