

We will begin momentarily at 2pm ET



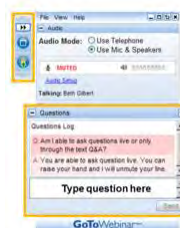
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Have Questions?



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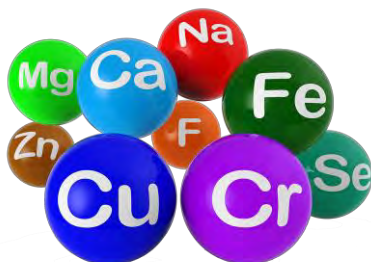
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Committee on Patents and Related Matters



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The screenshot shows the header of the ACS International Center Global Chemistry Newsletter. It features the ACS logo (Chemistry for Life) and a globe icon. Below the header is a navigation bar with links: ACS International Center | International Careers | Science and Human Rights | Regional News | Archives.

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Session 6 of the 2016 Drug Design and Delivery Symposium

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Global Patents: An Introduction to International Intellectual Property



Sadiq Shah
Chair, ACS Committee of Patents
and Related Matters



Kazim Agha
Partner and Patent Agent,
Ridout & Maybee LLP

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Global Patent Protection

it all starts somewhere

Kazim Agha



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Agenda

- Patent
- Filing Strategies
- Prosecution



it all starts somewhere

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Patent

“**Bargain**” made between government (aka
“**society**”) and an individual with an invention

Tell us what you’ve got
in exchange,

We’ll give you a time-limited monopoly right



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What is a patent?

- **An exclusionary right**
 - The ability to prevent others from making, using, or selling your invention as claimed
 - NOT a right to use the invention

- **Time limited monopoly: 20 years from the filing date**



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What is a patent?

- **Rights limited to claims in the patent**
- **Right limited by country and/or jurisdiction**
 - Separate patents are required in US, Japan and Canada for protecting an invention
 - No such thing as “World Wide Patent”
 - Patent in China doesn’t protect invention in Australia



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Why patent?

- Deter infringing activities (actively or unknowingly)
- Generate revenue by licensing
- Generate revenue by selling the patent
- Increase the value and profile of the company
- Deter lawsuits



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What can be patented?

- Patents granted for an **"invention"**
- In simple terms, an invention is
a solution to a problem
- **Subject matter exemptions:** scientific principle/abstract theorem, methods of medical treatment, life forms, games and methods of playing games

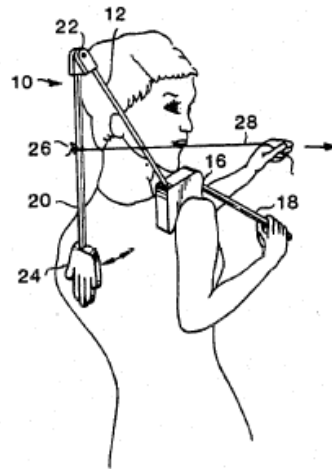
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US Patent 4608967

"Pat on the Back Apparatus"



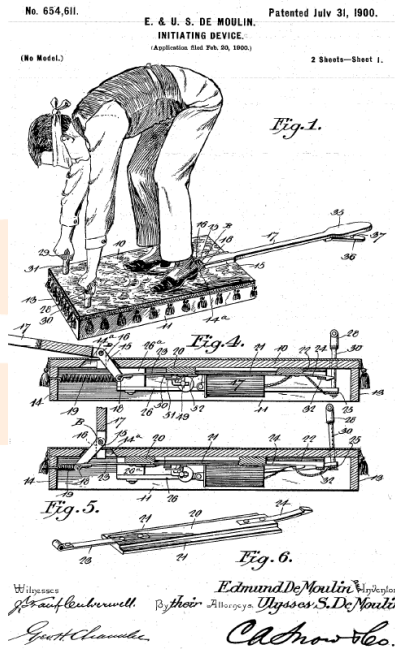
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US Patent 654,611

"Initiating Device"



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Requirements for obtaining a patent?

- **New** (Novelty)
- **Not Obvious** (Inventive)
- **Useful** (Utility)
- **Full disclosure**



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Audience Survey Question

ANSWER THE QUESTION ON BLUE SCREEN IN ONE MOMENT



Which of the following can be patented?

(Select multiple correct answers, total percent will be greater than 100%)

- **A)** A new chemical entity (NCE)
- **B)** A device someone saw 2 years ago at a trade-show in Japan
- **C)** A new process for preparation of a known compound
- **D)** A new theory on cold fusion

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CANADA'S INTELLECTUAL PROPERTY AND TECHNOLOGY LAW FIRM

Filing Strategies

- **Paris Convention** ^{1, 2}
- **Patent Cooperation Treaty (PCT)** ^{3, 4}

Note: Don't delay filing of a patent application

¹ <http://www.wipo.int/treaties/en/ip/paris/>

² http://www.wipo.int/treaties/en/text.jsp?file_id=288514

³ <http://www.wipo.int/pct/en/>

⁴ <http://www.wipo.int/pct/en/texts/articles/atoc.htm>



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Paris Convention

- Introduced international framework for industrial property rules for the first time
- Total contracting parties: 176
- Each contracting state must grant same protection to nationals of other contracting states as it grants to its own nationals



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Paris Convention

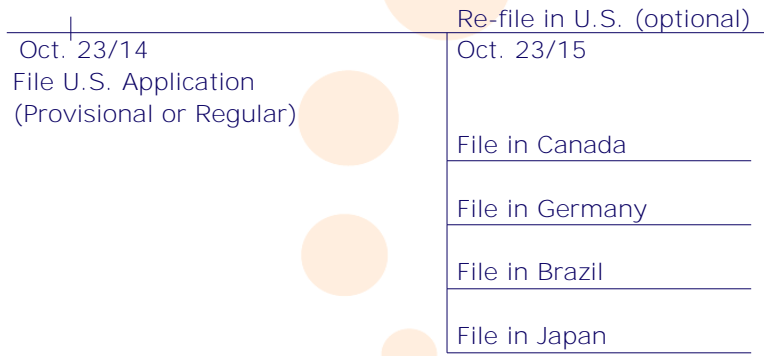
- **On the basis of a first application** (priority application) **filed in one of the contracting states, the applicant may:**
 - within a certain time period (12 months for patents)
 - apply for protection in any of the other contracting states;
 - these later applications will then be regarded as if they had been filed on the same day as the first application



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Paris Convention



- extension of time?

* NO!
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Patent Cooperation Treaty (PCT)

- Treaty allows filing of a single application in each contracting state
- Total contracting states: 149
- At 30 months (31 in some jurisdictions) from the first filed application, an application must enter the national phase in each country or region of interest
- Notable exceptions: Taiwan and Argentina (not part of PCT)

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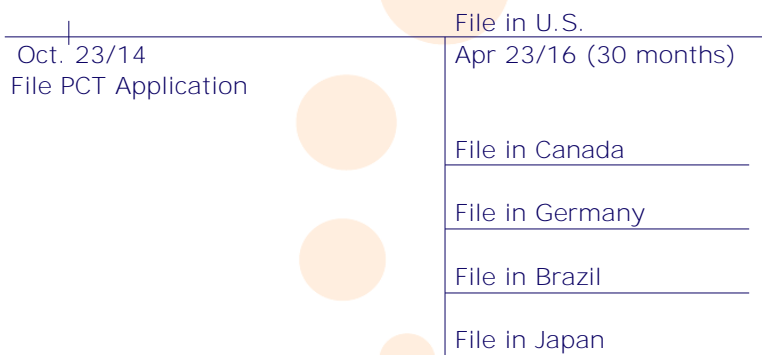
PCT Contracting States



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Patent Cooperation Treaty (PCT)



Extension of time?

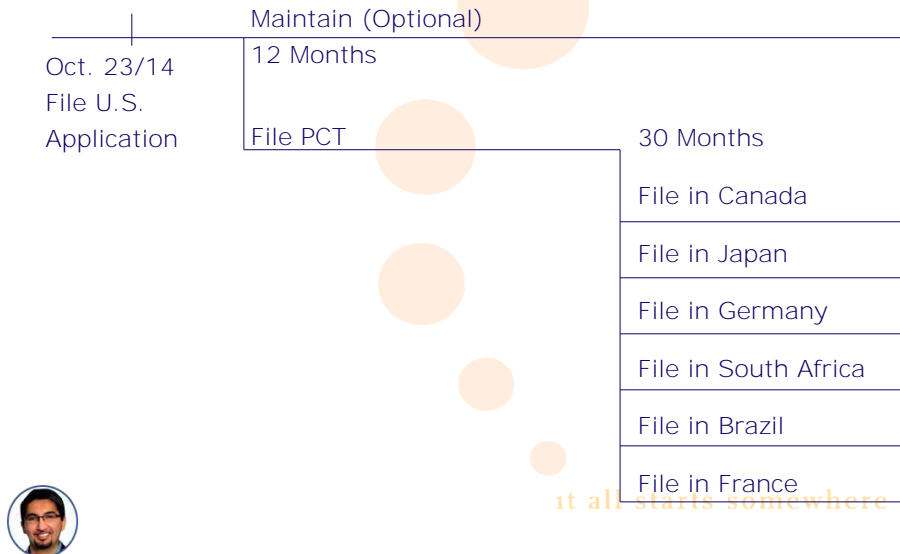
Available in some jurisdictions



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Paris Convention and PCT



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Advantages of PCT

- **Cost deferral**
- **Decision deferral**
 - is it valuable?
 - is there better technology available?
 - is it patentable?
 - which countries are of interest?



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Audience Survey Question

ANSWER THE QUESTION ON BLUE SCREEN IN ONE MOMENT



Why would one wish to file a PCT application?

(Select multiple correct answers, total percent will be greater than 100%)

- **A)** Once published, it gives a worldwide patent
- **B)** A single application for obtaining a filing date in multiple jurisdictions
- **C)** Only way to file a patent application
- **D)** Defer translation costs

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CANADA'S INTELLECTUAL PROPERTY AND TECHNOLOGY LAW FIRM

Prosecution

- **Separate prosecution in each jurisdiction**
- **Patent Prosecution Highway (PPH)**
 - Initiative for accelerating prosecution
 - Bi-lateral and tri-lateral agreements between different patent offices
 - Participating patent offices can benefit from work previously done by another patent office



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"I'M SORRY, WE ALREADY HAVE A TIME MACHINE PENDING BUT, IF YOU'D LIKE TO COME BACK LAST YEAR, YOU'LL GET YOUR APPLICATION IN FIRST."

Thank you!

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