

Webinar: Overview of the WIPO Guide on Using Inventions in the Public Domain

Questions and answers

IP rights have been used as a measure to protect intellectual property, and capitalize on such property. Should Covid-19 vaccination be kept in the public domain? How will it help the developer?

The patent system is built around two key aspects: (i) protection; and (ii) disclosure. Disclosure of new inventions ensures that people can learn from and build on a patented invention. Protection is also limited notably geographically (to those countries in which protection has been sought and granted) and in time (to the period during which a patent holder maintains and is able to maintain protection, usually up to 20 years). Finally, many patent holders choose to allow their patented inventions to be used without payment, e.g. under royalty-free licenses.

In an era post-Covid19, how will innovation and entrepreneurship work?

Innovation is likely to remain relevant for society whatever circumstances we face, helping us overcome existing and emerging problems people encounter on a daily basis and allowing us to improve people's lives.

Patent documents must sufficiently disclose the specific claimed features of the invention, but unclaimed features of the related technology may not be disclosed and kept as a trade secret. How can a product developer handle undisclosed information, which is not in the public domain?

Product developers can use trade secrets to protect their innovations in many countries, though they should be confident that they can keep the innovations secret and that these innovations would be difficult to reverse engineer. Since these innovations are secret, it would be difficult for others to benefit from the knowledge that has been created, which is one of the benefits of the patent system.

A patent could disclose many ways to make the invention (including best mode). How can a product developer find out what is the best mode of implementing the invention?

The "best mode" requirement does not apply in all countries, however many applicants do choose to disclose the best mode of implementing their invention. The best mode is often outlined in the abstract of a patent application and often indicated by the phrase "preferably" in a patent document.

If I use some features of an invention in the public domain, can the new invention derived from it be registered as a new patent?

An invention that has been previously disclosed to the public can generally not be patented subsequently by someone else. However, if you make further improvements on a previously disclosed invention, you may be able to get a patent for these improvements. Much of the innovation made in the world (and protected by patents) is incremental in nature!

Do patents guarantee that the invention will work? What risk is there to rely on patents?

Inventions disclosed in patents are not tested by the patent office to determine whether they work, however the patent applicant has an incentive to ensure that the invention works (otherwise it has little or no technical value from which the patent holders could gain value for themselves). Moreover, the "industrial applicability" requirements is often used to exclude "outlandish" inventions (e.g. those that appear to violate laws of nature like perpetual motion machines) from patentability.

Referring to channels of distribution, what advice would you have for entrepreneurs (especially at the micro level) for using the IP system of protection (patents, trademarks etc) as we move to more online channels?

When thinking about different distribution channels, one should think about the uniqueness of online channels versus other channels. How does the fact that you are going to distribute your product through online channels affect you, in particular in terms of new geographical markets, taking into account the territoriality of IP rights? The third part of the Guide contains a number of tools and frameworks that are intended to help inventors and entrepreneurs consider such factors as well as local challenges and opportunities that might impact the distribution of their product in other markets.

What is the best model for IP commercialization?

There is no single "best model" for IP commercialization, but an "optimum" way based on your strategy and your market context. Effective paths for commercializing an invention will depend on many factors, including the nature of the invention and the capabilities and context in which the inventor or institution is operating. The Guide provides some ways of thinking about these factors to decide how to gain value from inventions, in particular inventions in the public domain.

When is the safest time to market your creative product concept, shortly after the temporary or non-provisional application has been filed, or after the patent has been granted?

This depends on the jurisdiction and the rules of the particular country in which you seek to protect your invention and market your product. In most countries, a patent application should be filed before the invention is disclosed to the public (e.g. in the context of a trade show) or the

invention is marketed. Some countries such as the United States of America have legal provisions that allow for a grace period between the disclosure of an invention to the public and a patent application. A useful source of information is WIPO Lex, a global database that provides free of charge access to legal information on intellectual property-related treaties, laws and regulations of the Member States of WIPO, the United Nations and the World Trade Organization.

When I do a search for patent documents, how can I find out if these technologies are in public domain?

The companion publication *Identifying Inventions in the Public Domain: A Guide for Inventors and Entrepreneurs* discusses how to determine whether specific inventions are protected by enforceable patents or may be in the public domain, using a three-stage process for searching and analyzing published patent documents. To download the Guide, please go to:

<https://www.wipo.int/publications/en/details.jsp?id=4501>.

A webinar on this Guide will be held on July 16, 2020. Details (including the presentation slides and recording of the webinar once the event will have taken place) can be found at:

https://www.wipo.int/meetings/en/details.jsp?meeting_id=57889

If you want to transfer a technology that is useful and necessary for the solution to a specific technical problem, do you have to inform the inventor that you will use their technology if it is in the public domain, or can you apply the knowledge without prior authorization?

It is very tempting to assume that if knowledge of a technology is in the public domain, it can be used without prior consent from its original right holder. Patent documents that are rich in technology know-how are documents that can be readily accessed through online patent databases. The companion WIPO publication *Identifying Inventions in the Public Domain: A Guide for Inventors and Entrepreneurs* discusses specifically how to determine whether specific inventions are protected by enforceable patents or may be in the public domain, using a three-stage process for searching and analyzing published patent documents. To download the Guide, please go to: <https://www.wipo.int/publications/en/details.jsp?id=4501>

It is important to be aware of the fact that, as explained in the Guide, “Public domain information can only be exploited as you wish where there are no associated IP rights covering the making, use, selling, etc. of the invention disclosed in the patent. [...] Trademarks, trade dress, copyrights and trade secrets are other notable regimes of IP protection that may inhibit unauthorized use, imitation and/or misappropriation/infringement”.

For more on this topic, see Module II “Finding opportunities to leverage inventions and public domain knowledge” (pages 17 to 26 of the Guide).

Could you provide more information about technology risk management?

Technology risk management is significant as an important step to consider while developing a new product or service. As stated in the guide “If done right, technology risk management leads to avoiding, or at least mitigating, future legal problems. This step allows for filing for patents to protect technology and allows exploiting the protected technology by selling it yourself or licensing your IP rights to third parties. The latter makes sense where the market response to a technology is positive and the patent holder cannot meet supply on their own.” There is also discussion on how various IP regimes such as copyrights, trademarks, trade secrets along with patents can thwart threats from competition.

For more discussion on this topic, see Module III, section 9.4 "Design for manufacturing and technology risk management" (pages 64 to 68 of the Guide).

Where can we get a copy of the Guide and of the recording and presentation slides of this webinar?

The Guide can be downloaded free-of-charge at:

<https://www.wipo.int/publications/en/details.jsp?id=4502>

The presentation slides and recording of the webinar can be accessed at:

https://www.wipo.int/meetings/en/details.jsp?meeting_id=57888