

IP operations and procedures

IP operations and procedures are critical for the effectiveness and quality of IP systems, and, therefore, for innovation. They vary by types of IP but for registered IP generally involve specific application procedures, examination as to the form and/or substance, registration or grant, and maintenance. There are several approaches that can help stimulate IP operations and procedures; in particular, the digitisation of processes is a key element for facilitating and speeding up IP registration procedures. More substantial international co-operation regarding IP operations and examination procedures also provides opportunities for cost-effective improvements.

IP operations and procedures and their relevance

Operations and procedures within the IP context are the steps and proceedings that applicants and IP offices need to follow in order to obtain/grant IP protection for creative and innovative works. Although there are some differences in the proceedings for obtaining each type of registered IP protection, they all generally involve at least one of the following: application, registration, examination, granting of the IP protection and maintenance fees.

The ways in which IP registration/granting procedures work in practice have consequences for innovation and can raise policy implications. If IP authorities fail to establish high quality IP operations and procedures, the rise in IP titles that do not meet legal standards would impose undue barriers to accessing knowledge and slow the innovation process. IP operations and procedures are a critical component of the [legal quality](#) [1] IP systems have to provide. Barriers to entry, including, for example, IP application [costs](#) [2], can create a more exclusive IP system, with impacts on innovation.

What specific processes are involved in IP operations and procedures?

Patents

The procedure for obtaining a patent has three basic steps: application, examination of the application, and granting.

First, the entity seeking patent protection files a patent application at a patent office. The date of filing is what determines the right of priority. Drafting practices and requirements differ from country to country, but there are three essential requirements common to all regimes:

- The requirement of “unity of invention”, which requires that the application should relate to one invention, or to a group of related inventions, which form a single inventive concept.
- The application shall contain a description that discloses the invention in a manner sufficiently clear, precise and complete for the invention to be understood, evaluated and carried out by a person having ordinary skill in the art.
- The application must contain one or more claims, which determine the scope of protection that the applicant demands. The claims must be clear, concise and fully supported by the description. The claims are very important for the patent owner and third parties, since they are essential for knowing the extent of protection that a patent has been granted.

Second, the application is examined as to the form, a novelty search is carried out, and the application is examined as to the substance:

- Examination of the application as to the form generally takes place soon after the date of filing of the application has been determined and usually covers the following: the representation by a patent attorney (if any), the contents of the application, the statement regarding inventorship, the physical requirements governing the description, the claims and the drawings, and the inclusion of an abstract.
- Prior to, or at the same time as, the examination of the application as to substance, the patent office appoints an examiner who conducts a novelty search. The objective of the search is to determine the prior art in the specific field to which the invention described in the application relates. In conducting the novelty search, the patent office checks its documentation collection to ascertain whether there are any existing documents describing a solution that is identical or similar to that described in the application. The patent document is then made public with a search report 18 months after the filing date. Applicants normally need to request substantive examination within a given timeframe after receiving the search report.
- The examination as to substance procedure ensures that the application satisfies certain conditions of patentability: the subject matter of the invention is not excluded from patentability, the invention is inventive (non-obvious) and industrially applicable, and the invention is sufficiently disclosed in a clear and complete manner in the documents filed.

Then, if the application is successful at the examination stage and opposition has not been filed or has been unsuccessful, the patent can be granted. In order to maintain the patent (usually for a maximum duration of 20 years from the filing date), a prescribed renewal fee usually has to be paid to the patent office.

In addition to renewal fees, there are other important costs associated with filing patents, including administrative fees, such as filing, search, examination, country designation and grant/publication fees; process costs associated with drafting of more complex applications; monitoring, which can be in-house or outsourced; or translation costs where applications are made abroad. Once granted, competitors can challenge patents in courts and they can possibly be amended or revoked, which may trigger important litigation and enforcement costs.

Trademarks

A trademark can be protected on the basis of either use or registration. However, although trademark protection based on use is still important, today almost all countries provide for a trademark register and full trademark protection is properly secured only by registration.

In general, the procedure for registering a trademark involves three steps: application, examination and grant.

Applications for registration of a trademark are filed with the competent government authority. It can be the same office that deals with patent applications, a trademark office, or an industrial/intellectual property office for all types of IP rights. The priority of the right is determined by the date of filing for registration.

In general, countries provide an application form that has to be filled with:

- The name and address of the applicant in the country of register.
- The sign filed for registration in the application form or in an annex to it. If the sign is to be registered in color, the colors must be claimed and a specimen in color or the description of them must be submitted.
- If a three-dimensional sign is filed for registration, it is necessary to claim protection of the sign in its three-dimensional form.
- A graphical representation of the sign in a manner that allows its reproduction.
- A list of the goods for which the sign is to be registered. The Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, which establishes an international classification of goods and services for the purpose of registration of trademarks, is relevant in this respect.

Once the application has been submitted, examination of the formal requirements takes place, which does not generally impose barriers to applicants.

Then, examination as to the substance is carried out. Trademarks may be examined for:

- Absolute grounds for refusal, in order to assess whether the signs are sufficiently distinctive, and terms that are not generic, not deceptive, not immoral, etc. At this stage, the signs are objectively examined and no other signs are considered in making a decision.
- Relative grounds for refusal, which looks at whether the signs contained in the application are identical or similar to prior rights that have been applied for or granted for identical or similar goods. Such examination may either be made ex officio and/or on the basis of an opposition procedure.

If the trademark application is finally granted, the office issues a certificate to the owner. Trademarks can be renewed in exchange for a renewal fee.

Copyright

In order to obtain copyright protection, it is not necessary to register the protectable works. Copyright protection arises automatically when a creative work is in a fixed form of expression. However, registration is also available (in exchange for a fee) and can be useful as i) it adds an author's copyright to the public record and gives a certificate of registration, which provides evidence of ownership and ii) registered works may be eligible for statutory damages and attorney's fees in successful litigation.

Industrial designs

Industrial design protection is usually granted pursuant to a registration procedure, although registration is not always required.

The application for registering designs generally contains the details of the applicant, a description and illustration of the design, and the class of products to which the design relates.

After submission of the application for registering the design, the registration procedure can involve examination as to the form and substance, or only examination of formal requirements:

- Examination of formal requirements looks at whether the application fulfills each of the formal requirements that are imposed by the relevant law, but no search of prior art is carried out in order to determine whether the substantive requirement of novelty/originality is satisfied. A system requiring only formal examination has the effect of shifting the burden of assessing novelty to third parties. Under this system, the registration of a design may be open to opposition before grant, or proceedings for the cancellation of a registration may be brought when a design is alleged to be invalid.
- On the other hand, substantive examination of a design entails a search of past designs and an examination of the design for which registration is sought, to ascertain whether it satisfies the required condition of novelty/originality.

Once a design is registered, the term of protection is generally 5 years, with the possibility of extending such protection in exchange for a renewal fee for a maximum period of 15 years.

Utility models

Utility models differ from patentable inventions in that the inventive step is smaller than the inventive contribution that patentable inventions provide. For this reason, the procedure for registering utility models (which is overall similar to the procedure for granting patents) does not involve substantive examination in most countries. Because of this, the registration process is usually simpler and faster.

What are the policy approaches regarding IP operations and procedures?

Having fast and efficient IP systems at reasonable costs is challenging and requires investing in opportunities for raising productivity. Therefore, adopting policies to enhance the quality of IP operations and procedures, and thus the overall effectiveness of the IP system, can take the following forms:

- Improvements can be made by using information and communication technology (ICT) systems to digitize and automate processes, and speed up the retrieval of relevant information for the examination process.
- IP offices may also consider outsourcing some of the examination procedures, or sharing examination results with other IP offices. This can increase productivity and improve the performance of IP offices. However, it is important to ensure that outsourcing does not compromise the quality of the examination procedures. International co-operation with other IP offices can support efficiency in IP examination procedures by sharing examination results where appropriate but also by learning about best practices applied in other institutions.

- IP authorities have to maintain the quality of the examination process to ensure that IP titles comply with substantive and procedural legal criteria, and that only a small number of IP titles are rejected in courts. Moreover, manuals disclosing the practice of IP offices are important in terms of transparency in the examination and granting process.
- Finally, prices charged for processing IP applications should not create access barriers for inventors whose contributions can be substantial. In the [case of patents](#) [2] (where application and renewal fees are higher than for other IP types), it is a reasonable approach to cross-subsidize low procedural and discount fees for certain categories of applicants, usually “small entities” such as universities and small firms, by raising renewal fees.

References

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