European Intellectual Property Teacher's Network

Fourth annual workshop. Theme: "Teaching across boundaries"
24-25 June 2010. University of Alcalá, Spain

Session 1: "Creating an IP teaching culture in universities"

PATENTS - What every scientist and engineer should know: A five-year successful IP teaching experience at Spanish universities and other research centres

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These slides are downloadable from:
http://www.pcb.ub.es/centredepatents/doc_cursos.htm
Our limited target audience: professors/researchers/students in Science and Engineering (not Law, Business, Economics, etc.)
Some Previous Teaching Experience (and opinions)

For three years (1998-2000) an official optional subject entitled "PATENTS in Chemistry, Pharmacy and Biotech" was offered to UB undergraduates, along 10 consecutive full days of July, involving 60 hours and granting 6 credits.

It was very successful (ca. 80 enrolled students per year), but for undergraduates patents was just another topic to get credits from.

As students were too far away from applying patent concepts in research or at work, we quitted from offering the subject.

cont.
We, the authors, became aware of the importance of patents for every researcher during our own PhD research. We realized that university professors, researchers and graduate students did not know that patent documents represent a source of information that can be critical to the success of their (pure or applied) research.

On the other side, they should know that patents could represent:
- a source of prestige (and the concomitant promotion)
- a potential source of extra income (in case they are exploited)

However, research staff is very busy and they would not attend a very long session.

Thus we thought that 4 hours (usually from 10 to 14 h) was the maximum they would attend.
TTOs cooperation in organization and logistics

All sessions were organized in cooperation with the respective Technology Transfer Offices (TTOs) of the university or the research centre, because their personnel: knows the people who may be interested; makes efficient advertising, and could take care of logistics (documentation, room, coffee-break, etc.)

Besides, someone in charge of patents at the TTO was involved as speaker to deliver a short speech at the end of the session, entitled "Who should be addressed at [the University] for patent-related issues". Here local rules and practices were explained.

Attendance was 50-300 persons, with an average of ca. 100.

There was full subsidy from

paying for travel, accommodation and maintenance of the speakers.
The program
[including some 'hot' topics for academics]

1. What is the role of Intellectual Property Rights (IPR) -particularly patents- in today's World.
2. How a discovery gives rise to a patentable invention.
3. First things to do when you think you have a patentable invention.
4. What can be patented.
5. Which are the requirements that an invention must fulfill to get a valid and enforceable patent.
6. How to facilitate the work to patent application drafters.
7. How to make money from inventions by private inventors or academic researchers [ownership, inventorship and reward issues]
8. How to get and enforce patent rights.
9. How to use patent documents as a source of technological information [by the OEPM speaker]
10. How to find patent information [by the OEPM speaker]
11. Who should be addressed at [Univ.] for patent related issues [by the TTO speaker]
12. Colloquium
<table>
<thead>
<tr>
<th>Main IP Rights</th>
<th>Protection of:</th>
</tr>
</thead>
<tbody>
<tr>
<td>copyright and allied rights</td>
<td>creative works, including computer programs and databases</td>
</tr>
<tr>
<td>trademarks</td>
<td>distinctiveness</td>
</tr>
<tr>
<td>geographical indications</td>
<td>distinctiveness by origin or process protect. against <strong>unfair competition</strong></td>
</tr>
<tr>
<td>industrial design</td>
<td>non-functional shape or appearance</td>
</tr>
<tr>
<td>trade secrets (know-how)</td>
<td>confidential technical information</td>
</tr>
<tr>
<td>patents and utility models</td>
<td>technology (inventions)</td>
</tr>
</tbody>
</table>

Some non-patent IPRs were briefly mentioned
Real examples were widely used as illustration (here on the concept of 'famous trademarks')
Design patents bolstered by the Federal Circuit

Press cuttings were widely used (here on the importance of designs)

The Federal Circuit has overturned a ruling by the International Trade Commission that said that shoe designs mimicking the popular Crocs footwear did not infringe the company’s design patent.

Lawyers say that the decision could encourage more IP owners to protect their innovations with design patents.

The case involved Crocs’ appeal from an ITC decision that shoes manufactured by Double Diamond Distribution, Effervescent Inc and Holey Soles Holdings did not infringe Crocs’s US design patent number D517,789 and that its US patent number 6,993,858 would have been obvious to a person of ordinary skill in the art.

In his opinion, Judge Randall Rader of the Court of Appeals for the Federal Circuit applied the Egyptian Goddess standard for determining design patent infringement. He criticised the ITC for its "excessive reliance on a detailed verbal description in design infringement cases", saying that the written claim description in this case "distorts the infringement analysis by the ordinary observer viewing the design as a whole".

Design Patent US D517,789 "Footwear"
Documentation included two OEPM booklets on designs and trademarks.
... plus an EPI booklet on EP patents, and a UB one on valuation-licensing
Other course programs were used (here to illustrate how a patent value would be assessed)
3. **First things to do when you think you have a patentable invention**

- **Search prior art** in databases of scientific publications (Medline, Excerpta Medica, Biosis Previews, Science Citation Index...) and of patents (SciFinder-CAS, Derwent-WoK, Esp@cenet, OEPMnet, USPTO or Google-Patents, etc.).

- **Avoid self-destruction of novelty or inventive step** through publication of abstracts or posters in conferences, lectures of PhD thesis, public access to papers on the Internet or on paper, use, sale, etc., **before** an priority patent application has been filed.

- **Talk with an expert** (TTO personnel, patent attorney, knowledgeable person, etc.).

**Slides with text were self-explanatory, to be useful as reference**
References to online training were made (here on what can be patented)
Cartoons were widely used (here on typical inventor mistakes, borrowed from EPO)
7. How to **make money** from inventions by private inventors or academic researchers

**Book covers were used** (here on the exploitation of academic technology) **to give a sense of reality and provide bibliography**
'Hot' issues on inventorship, ownership and participation in benefits were dealt with in detail.

The boss of the lab or the company.

Technicians merely doing routine supervised work.

Those merely using their hands, without contribution to conception.

Sorry, but they are not inventors.
8. How to **get** and **enforce** patent rights:
Explained in detail in the booklet "**Una introducción a las patentes en Europa**" (Spanish translation of "**An introduction to Patents in Europe**" from EPI), enclosed as supplementary material, with permission of copyright owners (source of these drawings).

As complex procedures are involved, we advised to look for professional support (e.g. at drafting) when exploitation is **expected**. Patent applications for mere CVs were not recommended.
9. How to use patent documents as a source of technological information

10. How to find patent information

These parts were delivered by the speaker from Oficina Española de Patentes y Marcas (OEPM)
Patent information ... What is it for?

**LEGAL GOALS**
- Assessing *patentability* of R&D results
- **Drafting** of own patent appln.
- Deciding to extend patent protection (e.g. via PCT)
- Filing **oppositions**
- **Nullity counter-attacking** in an infringement action
- Assessing *freedom to operate*

**TECHNOLOGICAL GOALS**
- Avoid research duplication
- Solve specific problems
- Detect new technologies
- Find new uses of known technol.
- Know the prior art

**INDUSTRIAL-TECHNOLOGICAL PROSPECTIVE**
- Competitive intelligence
- Most active companies
- Technological watch
- Market analysis

**TECHNOLOGY TRANSFER**
- Technology valuation
- License negotiations
- Public-domain technol.
- Partner finding

Many schemes were used
Local examples were always used
Searches were focused on the use of free-of-charge patent databases on the Internet

European Patent Office

World Intellectual Property Organization (WIPO)

Patent offices from USA, Japan, China, Spain...

Others...
Search examples on real R&D were often used

Documents from the EPO:
- from 81 patent offices
- more than 70 million documents
- legal status of EP documents
- European Patent Classification
- Automatic translations

http://ep.espacenet.com/
Esp@cenet use was explained in detail
A security document according to the invention comprises substrate means 2 and security means 5 for authentication provided on a predetermined area 4 of said substrate means. The security means comprises means selectively reflecting visible light depending on the temperature and means changing the temperature depending on the application of a magnetic field. The means selectively reflecting light and the means changing the temperature are arranged so as to form said security means exhibiting different colors depending on a magnetic field applied to the substrate means. In a
Searches using classification were strongly recommended
“Documental” added-value services of OEPM

**retrospective searches**

- **National scope**
  - 18.66 euros/1 day

- **World wide**
  - 85.86 euros/3 days

**Made-to-measure technological watch**

**Search Reports for Technological**

- **World wide**
  - 440 euros/3 weeks

**references and recommendations**
Summary

Since 2006 the Spanish Patent & Trademark Office (Oficina Española de Patentes y Marcas, OEPM) and the Patent Centre of the University of Barcelona (PC-UB) carried out a series of workshops on IP -mainly on patents- at ca. 50 academic institutions, in cooperation with the corresponding technology transfer offices (TTO), that took care of publicity and logistics. A very focused program was developed along four hours (10-14h), comprising 'hot' topics for academics (by a speaker from PC-UB), patent information (by a speaker from OEPM), a brief presentation of TTO patent activities, and a colloquium. Attendants were staff, postdocs, graduates and (few) undergraduates.

Results were so satisfactory that it is planned to continue this IP training with virtually the same features.
Conclusion

IP in general, and particularly patents, should be taught better at universities and research centres.

All on-going projects, including the [difficult] modification of university curricula, would be very welcome.

E-learning projects are surely very useful, but not for a first contact with the subject, due to the lack of motivation of researchers.

For this reason we think that we should continue offering our limited-in-scope 4-hour workshops because they are useful and much appreciated ("Patent issues will never be the same at our university, after you have been here", they keep telling us).

**Waiting for 'doing something better' should not be detrimental to 'doing something well enough'.**
AVAILABLE TIME WAS VERY SHORT
STILL WE HAVE A FEW MINUTES FOR QUESTIONS OR COMMENTS
THANK YOU FOR YOUR ATTENTION!

Please remember that these slides are downloadable from:
http://www.pcb.ub.es/centrederepatentes/doc_cursos.htm
ANNEX: Universities and research centres visited so far

(2006) Universidad Complutense de Madrid (Facultad de Matemáticas)
- Universidad de la Rioja
- Universitat Autònoma de Barcelona, Facultads de Ciències
- Universitat de Barcelona, Facultat de Química
- Universitat Politècnica de Catalunya, Escola de Telecomunicacions
- Universitat de Barcelona, Facultat de Biologia
- Universidad Autònoma de Barcelona, Escola d'Engyneria
- Universitat de Barcelona, Facultat de Física
- Universitat Politècnica de Catalunya, Escola d'Engyners Industrials
- Centro Nacional de Investigaciones Cardiovasculares (CNIC)

(2007) Universidad de Navarra (Pamplona)
- Instituto de Investigación del Hospital Universitario Vall d'Hebron (Barcelona)
- Universidad de Valladolid
- Universidad Carlos III de Madrid (Parque Científico Leganés Tecnológico)
- Agencia de Innovación y Desarrollo de Andalucía IDEA (Sevilla)
- Universidad de La Laguna (Tenerife)
- Universidad de Córdoba
- Universidad Ramon Llull (Barcelona)
- Universidad Rovira i Virgili (Tarragona)
- Universitat de Lleida

(2008) Universidad de Las Palmas de Gran Canaria
- Universidad de Zaragoza
- Universidad Complutense de Madrid (Facultad de Medicina)
- Universidad de Alcalá de Henares
- Universidad de Alicante
- Universidad Politécnica de Valencia
- Parc Científic de la Universitat de Barcelona
- Institut de Investigació Biomédica de Bellvitge (IDIBELL), de Barcelona
- Corporación Sanitaria Clínic (Fundació Clínic, IDIBAPS) de Barcelona
- Universidad de Jaén
  (2009) Universidade da Coruña
- Universidade de Santiago de Compostela
- Universidad Politécnica de Madrid
- Instituto Nacional de Investigación y Tecnología Agraria y Alimentaria (INIA)
- Universitat de València (Parc Científic de la UV)
- Universidad del País Vasco - EHU (San Sebastián)
- Universidad del País Vasco - EHU (Bilbao)
- Universidad de Extremadura (Cáceres)
- Universidad de Extremadura (Badajoz)
- Fundació Parc Taulí (Sabadell)
  (2010) Instituto de Salud Carlos III
- Universidad Rey Juan Carlos
- Universidad Autónoma de Madrid
- Universidad Carlos III de Madrid
- Universidad de Almería
- Universidad de León
- Universidad Católica de Valencia
- Universidad de Mondragón
- Universidad de Castilla-La Mancha (Albacete)
- Universidad de Castilla-La Mancha (Ciudad Real)