



## *Trinidad and Tobago Intellectual Property Office*

# Patent Application Manual

### What is Intellectual Property?

Intellectual Property (IP) refers to the expressed creation of the human mind; inventions; literary and artistic works; and symbols, names and images used in commerce. Like all types of property, IP is owned and can generate income, hence for this reason IP is considered an asset.

### Types of Intellectual Property:

Intellectual property is divided into two categories:

1. **Industrial property** which includes;
  - Industrial Design
  - Trademarks and Service Marks
  - Geographical Indications
  - Integrated Circuits Designs
  - New Plant Varieties
  - Trade Secret
  - Patents
2. **Copyright and Related Rights** which covers literary works (such as novels, poems and plays), films, music, artistic works (e.g., drawings, paintings, photographs and sculptures) and architectural design.

## OVERVIEW OF THE PATENT SYSTEM

### What is a Patent?

A Patent is an exclusive right granted for an invention, which is a product or a process that either provides a new way of doing something, or offers a new technical solution to a problem. It provides protection for the invention, preventing others from manufacturing, using, offering for sale, selling or importing the patented invention.

## How society benefits from patents

- The owner is required to disclose technical information to the public sufficient for persons with average skill in the art to manufacture and use the technology. Society gains disclosure of the invention and free use of it after the patent expires.
- Innovation is encouraged – better products can be made and improved production methods can be used for the benefit of all since engineers and scientists can learn the details of the invention.
- New innovative companies are protected – they can compete with large established companies, in order to maintain a competitive economy.
- Technology transfer is promoted, for example from universities to industry.

## Conditions for obtaining a Patent

An invention must first meet several criteria if it is to be eligible for patent protection. These are:

- **Novelty** – it must be new, with nothing like it in existence in the world or in the literature, including other patent documents.
- **Inventive step** –it must be non-obvious to someone with average skill in that particular field.
- **Industrially applicable** – it must be useful or have a technical effect. In short, it must work and comply with the laws of nature.

## What cannot be patented?

Patents are open to most areas of science and technology but some areas are excluded from patentability. These are: -

- Ideas, hypotheses, discoveries (of things already existing in nature), scientific theories and mathematical methods.
- Rules of games, lottery systems, methods for performing mental acts, teaching methods and organizational procedures.
- Diagnostic, therapeutic and surgical methods used on the human and animal body.
- Literary, dramatic, musical or artistic works or any aesthetic creation whatsoever.
- The presentation of information.
- Inventions, the exploitation of which would be contrary to public order or morality, also cannot be patented.

## **Relevant Patent Laws and Treaties**

Patent legislation is in force in Trinidad and Tobago: The Patents Act, 1996, (Act No. 21 of 1996). The Patents Rules, 1996. The required forms are in the Rules. International Treaties to which Trinidad and Tobago is a party, related to patents, are:

1. The Paris Convention for the Protection of Industrial Property (1883). Trinidad and Tobago joined on 1st August 1964.
2. The Patent Corporation Treaty (PCT) (1970). Trinidad and Tobago joined on 10th March 1994.
3. The Strasbourg Agreement concerning the International Patent Classification (1971). Trinidad and Tobago joined on the 20th December 1996.
4. The Budapest Treaty of the International Recognition of the Deposit of Microorganisms for the Purpose of Patent Procedure (1977). Trinidad and Tobago joined on 10th March 1994.

## **Patent Information Services offered by the office**

At this Office one can find what granted patents are in force in the country, who owns and the details therein. Conversely, one can find what patents are not in force and therefore may be public domain due to expiry or simply not registered here. The IPO has a collection of patents dating back to 1902.

In addition to the nationally registered patents, the IPO also has collections of CD-ROMs and DVDs containing abstracts and/or full texts of international applications made under the PCT from 1978 to the present. There is also a collection of US full-text granted patents from 1790 to present as well as the Japanese Patent Abstracts from 1994 to the present. The IPO also has access to numerous online patent information sources via the internet.

There is a vast quantity of obvious information in patent documents as well as that which can be derived:

- Enough up-to-date, first-hand and often only technical data to inform and provide solutions to someone in that field of technology
- Avoiding possible infringement of someone else's patent
- Opportunities for seeking expertise, licensing partners, consumers of your technology and the number of players in the field to better inform negotiating positions
- Monitor competitor's activities
- Obtaining patent family data, seminal patents and their owners

## **When to file a patent application**

Filing should be done as soon as possible, most importantly, before public disclosure of the invention. In Trinidad and Tobago, disclosure of the subject matter of the invention will not be taken into consideration if such disclosure occurred not more than one year before the filing date and the disclosure was due to acts committed by the applicant or predecessor or by an abuse committed by third parties.

Therefore, if you are thinking of applying for a patent you should not, as far as possible, publicly disclose the invention more than a year before you file an application because this could be counted as prior publication of your invention. Any type of disclosure (whether by word of mouth, demonstration, advertisement or article in a journal), by the applicant or anyone acting for them, could prevent the applicant from getting a patent. It is essential that the applicant only make any disclosure under conditions of strict confidence.

## **Who can file for a patent at the IPO**

An applicant is any party or parties entitled to file a patent application. This includes:

- Inventor(s) – a person or persons who made the invention;
- Employer of the invention (depends on the legislation and contractual arrangement with the employee);
- A person who owns the rights to the invention (assignee).

## **How long does registration offer protection?**

The patent will be valid for 20 years from the date of filing, if annual fees are paid and if not, the application may be withdrawn or revoked.

# **APPLICATION PROCEDURE FOR A PATENT**

## **Where do I apply?**

Applications may be filed at the Intellectual Property Office; 3rd Floor, Capital Plaza, 11-13 Frederick Street, Port Of Spain, Trinidad & Tobago.

## **Patent Application Processing Steps:**

1. Reception of the application
2. Payment of fees
3. Formalities Examination
4. Substantive Examination
5. Grant and Publication

6. Certificate issued
7. Patent Maintenance (Payment of Annuities)

### **1. Overview of the Patent Application**

When a national or resident of Trinidad and Tobago files a patent application the formal requirements under the Patent Rules and Regulations are:

- 1) The Patent Request Form No. 1.
- 2) A disclosure of the invention must accompany the application. This is the specifications of the invention, which include: Descriptions, Claims, Abstract & Drawings (If necessary).

This gives details about the invention such as the technical field to which the invention relates and also gives information relating to the background art which can be regarded as useful for understanding, searching and examining the patent applications. This is followed by the claims which define the invention in terms of the technical features of the invention. The abstract then follows and this is a summary of the disclosure contained in the description. Any drawings mentioned in the description are placed behind the abstract.

The application must be submitted in triplicate on A4 size paper as outlines in Rule 16 of the Patents Rules and Regulations together with the application fee of \$2000. Once these formal requirements have been met, the person in the receiving office will stamp the application and a filing date will be issued, a file number will be issued and the processing of the application will begin.

### **2. How are payments made to the Intellectual Property Office?**

Once an application is made, the prescribed application fee (\$2000) must be paid. Maintenance fees (annuities) must be paid yearly from the filing date, commencing on the start of the second year.

All payments are due in advance, payable by certified cheque with the Payee as the Controller, Intellectual Property Office or by Linx or through the District Revenue Office, upon presentation of the prescribed voucher issued by the Intellectual Property Office.

### **3. Formality Examination**

- The application will undergo Formalities Examination as set out by the Patent Act 1996 and Patent Rules 1996. This is the preliminary examination that begins at the time that a filing date is issued to the patent. Formal examination concerns the requirements that the applications must meet in order to proceed to substantive examination.
- The tasks of the formalities examiner include ensuring that the application has been correctly made (reference to Form No. 1), checking such items as dates and inventors'

details, ensuring that the description and any drawings are correctly presented according to the rules so that they can be published, checking priority details, and so on.

- If the application does not comply with all formalities requirements as set out by the Patent Act 1996 Section 23 and the Patent Rules 1996, the applicant will be notified and given the opportunity to correct any deficiency, so as to further process the application.
- If the application does not comply with all formalities requirements, the applicant will be asked to amend the application. Amendments must be accompanied with the prescribed fee.
- Once in compliance, the applicant will then be asked to pay Search and Examination fees.

#### Formal Requirements for an application

- The local patent application may be filed by the applicant himself or through his attorney. If it is filed by his attorney, the attorney will also be required to file an 'Authorization of Agent' signed by the applicant.
- If the applicant is not the inventor he will need to file a 'statement justifying his right' to the application. This can take the form of an assignment document or a statutory declaration.

#### **4. Substantive Examination**

- The document will be examined for patentability based on the Patent Act and Rules. The 3 criteria of novelty, industrial applicability and inventive step must be met.
- If any amendments are required, the applicant will be asked to do so. Amendments must be accompanied with the prescribed fee.
- Once the application complies with the Act and Rules the application will be granted.

#### **5. Publication**

- Once the application complies with the Act and Rules, and is granted, the applicant will be requested to pay the grant and publication fee within 3 months.
- If the applicant fails to respond within the 3 months, the application will be taken to be withdrawn under Section 25(2), and the applicant would be so informed.
- If the fee is paid, then under Section 28(1) and (2), as soon as is practicable, a notice of grant should be published in a periodical and the granted patent should be published.
- The notice of grant will proceed for publication in the Newsday Newspaper. The cost of publication must be paid by the applicant.

## **6. Issuance of Certificate**

- The certificate of grant and register will be prepared by the office.
- Under Section 25(5) the patent shall be deemed to have been granted on the date that the notice of grant is published under Section 28(1).
- The certificate is issued and together with the granted specifications, it will be given to applicant.

## **7. Patent Maintenance (Payment of Annuities)**

Maintenance fees or annuities are fees that are paid to retain a patent and such fees increase in amount during the course of the patent term. It must be paid yearly from the filing date, commencing on the start of the second year. The patent would be valid for 20 years from the filing date once annual fees are paid. However, if it is not paid, the application may be withdrawn or revoked. A listing of the annual fees for each year can be seen in the fees section of this manual.

## **Routes for international application:**

### **Paris Convention**

- Trinidad and Tobago is a member of the international treaty called the Paris Convention for the Protection of Industrial Property.
- One of the articles of the Paris Convention allows nationals and residents of member states to file a patent application in their home country and within **Twelve 12** months of the initial application. This is known as the right of priority.
- Similar to the local application, the requirements for application are the Request Form 1 accompanied by a disclosure of the invention, submitted on A4 size paper in triplicate together with the application fee. Once the basic formal requirements have been met, the person at the Receiving Office will receive the application, issue a filing date and processing of the application will begin.
- Applications must be filed through a local attorney as all applicants outside of Trinidad and Tobago must have a local address for service and must therefore appoint a representative.
- A certified copy of the priority application must be submitted to the office together with an authorization of agent and a statement justifying the applicant's right.

## Patent Corporation Treaty (PCT)

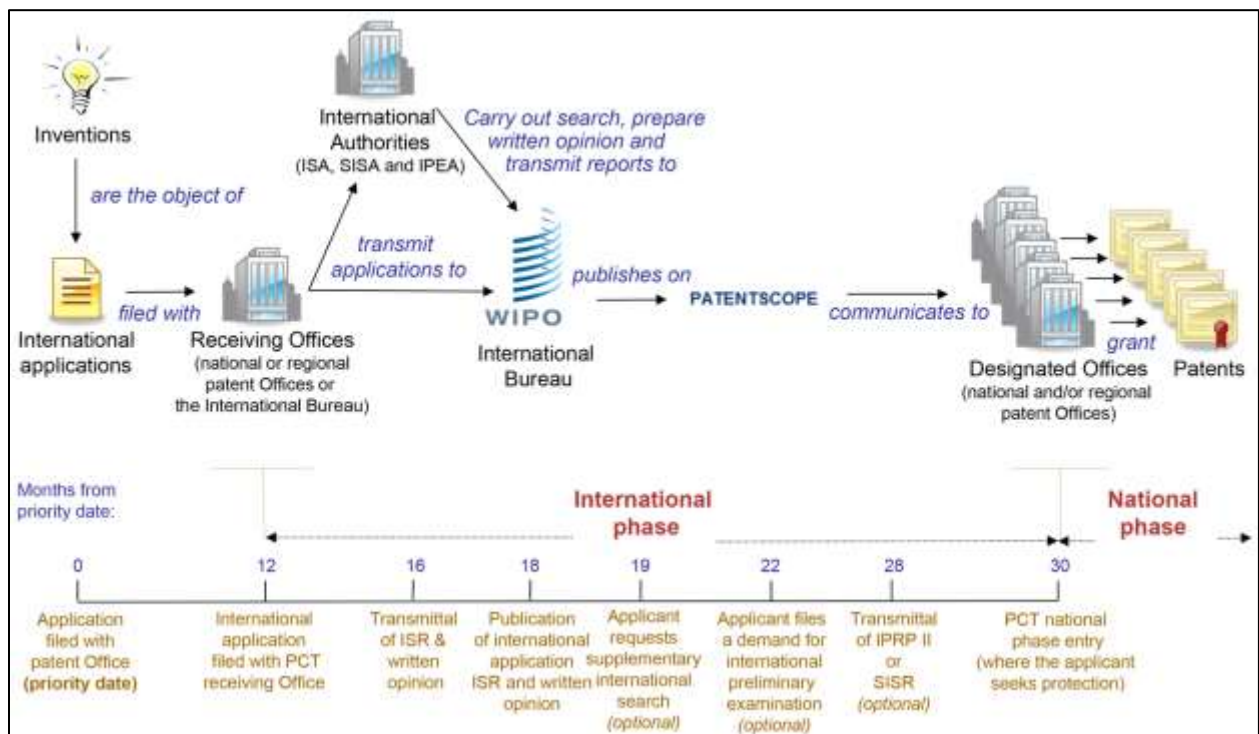
- The Patent Corporation Treaty offers the possibility to simultaneously seek patent protection for an invention in a large number of countries by filing a single international application.
- Trinidad and Tobago is a member of the Patent Cooperation Treaty, an international treaty administered by the World Intellectual Property Organization (WIPO).
- The PCT is an international filing system geared towards applicants who want to obtain patent protection in several countries. Before the PCT, such an applicant would have to file individual applications in each of the countries where he wanted patent protection. But the PCT has made filing an application in several countries easier in that nationals of PCT member states can file one patent application under PCT and designate as several or all member states of the PCT where he wants the application to be effective in.
- An application can be made into the national phase *Thirty (30)* months from the priority date through PCT.
- This office is the Receiving Office for PCT International Applications filed by nationals and residents of Trinidad and Tobago. The applicant will also have the option to file his application directly at the WIPO (International Bureau) rather than with the Office.
- Each individual state that an application is made will be required based on their laws, to decide on whether it will grant a patent to the applicant for his invention.

It offers several benefits to those seeking broad protection in their target markets:

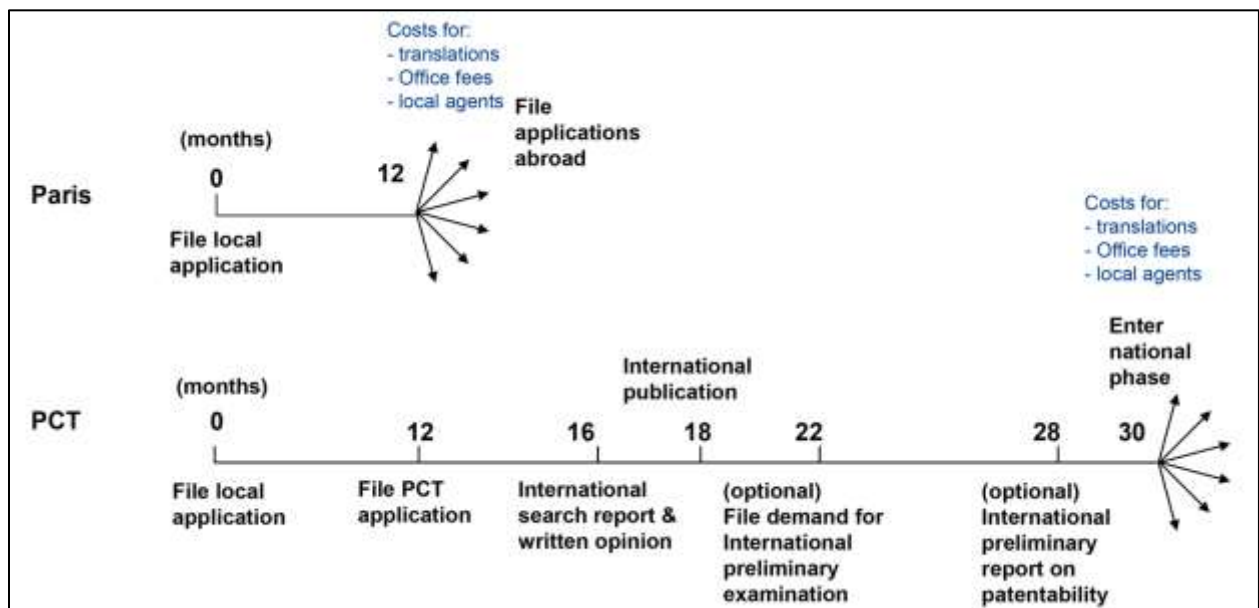
- Evaluate chances of being granted a patent before incurring major costs with an International Search Report which contains a list of relevant prior art documents
- Option of receiving an International Preliminary Examination Report where an examination is done, much as it would be for a direct application, and an opinion is given as to whether or not it meets the examining criteria
- Options can be kept open for a longer time during which, markets, conditions and agents can be sought

It has become the preferred means of application for those seeking international coverage. Roughly 86% of the patent applications entering Trinidad and Tobago are PCT applications.





**Figure 1: Overview of the PCT System**



**Figure 2: Comparison of Paris and PCT Route**

## **Patent drafting**

A patent application should be written in consultation with a patent expert, namely a patent attorney or a patent agent who has a good knowledge of understanding technical aspects of a technology and has had experience in drafting applications. It should be carefully written so that an individual skilled in the same field would know how to reproduce the invention.

### **Details of the patent document**

#### **Abstract**

- This contains a concise summary of the disclosure to allow a clear understanding of the technical problem.
- It should not contain statements on the alleged merits or value of the invention or its speculative application
- When appropriate, the abstract should be accompanied by an indication of the figure or exceptionally more than one figure of the drawings.

#### **Title**

- The title of the invention shall be short (preferably from two to seven words when in English or translated into English) and precise.
- The title must clearly state the technical designation of the invention.

#### **Technical field**

- Usually defined by reproducing the first ("prior art") portion of the independent claims in full or in substance or by simply referring to it.

#### **Background Art**

- Any background art of which the applicant is aware, and which can be regarded as useful for understanding the invention and its relationship to the prior art; identification of documents reflecting such art, especially patent specifications, should preferably be included.

#### **Summary of the Invention**

- A very short recap of the invention, many times referring to the independent claim(s).

#### **Disclosure of Invention**

- Disclosure in such a way that the technical problem, or problems, with which it deals, can be appreciated and the solution can be understood.

- Must include the substance and language used in the claims with extra explanation if necessary.

### **Best or any mode of carrying out the invention**

- At least the best mode contemplated by the applicant (or depending on applicable law – any mode) for carrying out the invention claimed; this should be done in terms of examples.

### **Brief Description of Drawings**

- If drawings are included they should be briefly described,
- The description and drawings should be consistent with one another, especially in the matter of reference numbers and other signs.

### **Claims**

- The claim(s) defines the subject matter for which protection is sought, in terms of the technical features of the invention.
- The extent of the protection conferred by the patent is determined by the terms of the claims.
- The description and drawings are used to interpret the claims.
- The claim(s) must be clear and concise.
- It must be fully supported by the description.
- It must include technical feature(s) necessary for the definition of the claimed subject-matter that distinguishes from the prior art.
- It must relate to one invention or to a group of inventions which are so linked as to form a single general inventive concept.

## Fees:

Application for a patent [section 18(1) and (2); rule 9]	<b>\$2,000.00</b>
Correction of application to comply with formal requirements [section 23(3); rule 25(2)]	<b>\$250.00</b>
Amendment of application at instance of applicant (Voluntary Amendment) [section 26(1)]	<b>\$500.00</b>
Amendment of application on invitation of Controller [section 25(1); rule 26(2)]	<b>\$250.00</b>
Fee for search and examination carried out by an examining authority [section 24(1); rule 26(1)]	<b>\$1,500.00</b>
Grant & Publication fee (Rule 27)	<b>\$500.00</b> plus amount payable to publisher (determined by Newsday Newspaper)
Request for conversion of a patent application into an application for a utility certificate and vice versa [section 68; rule 43(2)]	<b>\$200.00</b>
Request for recordal of change in ownership (section 35; rule 33)	<b>\$150.00</b>
Inspection of register (for every quarter of an hour or part thereof) (rule 34)	<b>\$20.00</b>
Certified copies of documents (rule 35)	<b>\$50.00 plus \$5.00 per page</b>
Request for correction of an error (rule 36)	<b>\$150.00</b>
Request for extension of time limit (rule 48)	<b>\$150.00</b>
Request for hearing (rule 46)	<b>\$150.00</b>

### **Annual fees for patents: [sections 29, 30(1)]**

2nd year	\$200.00
3rd year	\$400.00
4th year	\$400.00
5th year	\$600.00
6th year	\$900.00
7th year	\$1,200.00
8th year	\$1,600.00
9th year	\$2,000.00
10th year	\$2,400.00
11th year	\$3,200.00
12th year	\$4,200.00
13th year	\$5,200.00
14th year	\$6,200.00
15th year	\$7,200.00
16th year	\$8,400.00
17th year	\$9,600.00
18th year	\$10,800.00
19th year	\$12,000.00
20th year	\$13,200.00

*\*Surcharge for late payment of annual fee according to section 30(1) would result in an additional 10% of the overdue fee.*

## **UTILITY CERTIFICATE**

### **What is a Utility Certificate?**

A second form of protection for inventions is the patent for a "utility certificate". In fact, they are sometimes referred to as "petty patents" or "innovation patents." If an invention cannot meet all the requirements of a patent, an applicant can apply for a utility certificate if the invention can be shown to have an inventive step and can be industrially applicable.

### **Difference between a patent and a utility certificate**

Utility certificates differ from patents mainly in three respects:

- The inventive step required is smaller
- The maximum term of protection provided by law is generally much shorter (ten years in Trinidad and Tobago)
- The fees required for obtaining and maintaining the rights are generally lower

The procedure for obtaining a utility certificate is generally shorter and simpler than the procedure for obtaining a patent. Other than those points, the rights under the utility certificate are similar to those under a patent.

### **Requirements for a Utility Certificate**

Utility certificate applications are usually filed by local applicants and the formal requirements are the same as that of a local patent application;

- The Request Form 1
- A disclosure
- Authorization of Agent, if filed through an attorney
- Statement justifying the applicant's right if the applicant is not the inventor
- Application fee (\$1000)

**ISSUED BY**  
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