

# GENERAL CONSIDERATIONS ON INDUSTRIAL PROPERTY RIGHTS AND THE ROLE OF PATENT ADVISOR

Associate professor Ph.D. **Gabriel I. NĂSTASE**  
„Dimitrie Cantemir” Christian University, Bucharest, Romania  
[gabriel.i.nastase2013@gmail.com](mailto:gabriel.i.nastase2013@gmail.com)

Ph.D. Student **Bogdan PASCU**  
The Bucharest University of Economic Studies, Bucharest, Romania

Ph.D. Student **Carmen Georgiana V. BADEA**  
The Bucharest University of Economic Studies, Bucharest, Romania

## Abstract:

*Patent advisor must have extensive experience in industrial property activity in order to analyse together with the inventor of all aspects related to the invention, both during drafting documentation and during its review by the Office of Inventions, and then, throughout the period of validity of the patent.*

**Key words:** research, development, innovation, patent, patent advisor, technology transfer, recovery.

**JEL classification:** K11, K42, O34

## INTRODUCTION

Valuable and useful technical solutions, the result of creative work, need legal protection on the territory of a country or by its prospects of marketing, in other states too. Scientific and technical creative activity involves a series of concrete actions related to inventions law of that country, but especially to the way in which technical solutions are analysed in view of selecting patentable elements and drafting documentation for patent application for the Office of Inventions.

A basic document in this sense is the description of invention that represents the main element, embodying all technical creation of the inventor (Năstase, 2013). This document should be written according to the rules issued by the Office for Inventions of a country, must present clearly and precisely the elements of the invention and, especially, contain a chapter of claims including all new patentable elements so as to not allow a third person (natural or legal) to develop a so-called "bypass" patent.

## CONTENTS

A well written description of the invention, with novelty claims filled in, shall avoid during the term of the patent application and then during the patent life (in case of granting the patent), a number of complications. We consider both pre-screening process and substantive examination, and also in case of disputes on novelty elements, in case of infringement of rights, or for license invalidation or in other situations relating to a patent. And as always in life, the inventor must have an advisor, a support and counsellor in this activity to protect his invention.

And this is more as in general inventors are thinkers in the technical field and sometimes with less knowledge and less practice in industrial property protection legislation. This need to support the inventor has determined the occurrence of **patent advisor**, or as it is called in some countries **patent agent** who is the first advisor to the inventor. This should have a solid technical background and be well acquainted with the laws of inventions.

**Patent advisor** must have extensive experience in industrial property activity in order to analyse together with the inventor of all aspects related to the invention, both during drafting documentation and during its review by the Office of Inventions, and then, throughout the period of

validity of the **invention patent**. This paper presents the entire flow necessary for obtaining an invention patent, since the emergence and development of the invention, the preliminary submission to the Office of the invention, the patent application being examined and the validity of the patent.

This paper presents also comments on special circumstances occurred either because of provisions of national law on inventions, or by other causes. At the same time, it highlights the role of **patent advisor** involvement as first counsellor of the **inventor** and **patent owner**. Apart from drafting clear and complete description of the technical solution, **patent advisor** is one that, from the beginning, throughout the flow of patenting shall consult with the **inventor** or **patent applicant** on how would be best to exploit the invention.

If marketing shall be abroad, it is also the **patent advisor** who is aware of international regulations and conventions to which Romania is a party, and shall analyse the patent procedure abroad, the number of countries on which territory the technical solution should be protected and shall decide how the technical solution to be protected with minimum expenditure from the inventor. In the same time, the **patent advisor** is someone who, as shown in the paper, must support the inventor or patent owner to draw up the contract of sale of the invention, whether it is sold partially, totally or on limited periods.

In case of disputes or during the examination, the **patent advisor** is the one who, together with the **inventor** or **invention owner** will explore all aspects of these processes and will produce a response as required by law and in the same time, very well technically substantiated.

This paper includes and exemplifies these activities of **patent advisors**, that we believe represent new elements in our country, as this specialty is relatively recent. A **patent advisor** must be, in some cases, the counsellor of **inventor** or **invention owner**. These cases generally refer to paternity disputes, compulsory licenses, etc. or litigation between the parties that shall be heard in a legislative body.

In other words, a **patent advisor** must be a lawyer representing the client and pleading in court.

This work will be the guide, first for **inventors**, indicating how a technical solution should be analysed and especially on how to deal with different situations arising during the life of a patent. It must also be a guide for those working in the field of industrial property as direct "advisors" to **inventors** - **patent advisors** - and indicate their optimum way to be followed for complete protection of the invention and for the best possible marketing thereof.

In our country the law regulates inventions and inventions issue is completed and cleared by the Application Regulations of the Law on invention patents.

The paper uses the **patent advisor** name instead of **industrial property advisor** in order to emphasise that the work is limited only to advisors' activities and tasks in protecting inventions, which is only part of **industrial property protection**.

The concept of property is quite large and is discussed in detail in the science of law, but we will use a few items to decide on the concept of industrial property, which includes the invention too. A direct link is between the concepts of property and owner, which is the rightful owner of material and intellectual assets.

The owner has the exclusive right to use such property without authorization of someone else and has the right to sell or leave as inheritance to his successors. Such material assets may be household goods, animals, cars, land, houses etc.

These achievements are the result of intellectual effort of the expert in that field of activity. Here the notion of property indicates the ownership of work created, its real author, the one who made it, no matter whom the right is transferred to, on one way or another, in order to exploit it or turn it into value.

These achievements are not limited to art, painting, music, literature, and art but also to technical field, where the creator can provide new solutions to eliminate all or part of existing gaps in global state of the art, in a particular field.

Thus, two main branches of intellectual property are outlined, namely:

- Literary and artistic property;
- Industrial property.

In **literary and artistic property** are included all work in this area, regardless of the mode or form of its expression. Examples would be books and other writings, lectures, musical, choreographic works, dramatic works, achievements in the video field such as cinema, television works, photography, applied art, paintings, sculptures and more. In the field of literature can be included translations or other transformation of literary works and literary collections.

Protection of these creations or copyright is governed by the laws of the respective countries and refers to the fact that, in general, certain uses of works are considered illegal if they are made without the authorization of the copyright owner.

Examples of copyright infringement can be mentioned: copying or reproduction of works of art without the author's consent, development of films adapted from literary or musical work, the right to translate literary works and others.

Protection of these achievements is done both by legislative provisions of those countries and international conventions such as the Berne Convention for the Protection of Literary and Artistic Works, signed on 9<sup>th</sup> of April 1886 has been revised successively which over the years, being in force at present.

Romania is a member of the Convention and it is good to note that in accordance with the provisions of this Convention each of the member countries shall be granted the same copyright protection to nationals, in accordance with the law of each country. The Convention establishes the duration of copyright protection and contains special provisions for developing countries.

### ***Industrial property***

As mentioned previously, industrial property is part of the Intellectual Property and includes within its sphere, in the first place the "invention" that will still be the main subject of this paper. Also, at "Paris Convention for the Protection of Industrial Property" it was considered that part of the industrial property objects beside the inventions are also utility models, industrial designs and models, trademarks, factory marks and service marks, commercial denomination, indications of origin and original denominations, as well as repression of unfair competition, and by the treaty of Washington DC on 26<sup>th</sup> of May 1989, in the field of industrial property was also integrated the Protection of Integrated Circuit Topography.

### ***Patentable invention***

The invention is considered as the main engine of science and technology development and is the one containing the most advanced notions of human intelligence, representing the main link to the introduction of technical progress in economic and social life. It is generally observed that in countries with highly developed industry, the number of inventions is particularly high as compared with other countries, such as those under development, where the number of inventions is lower, being directly correlated with the degree of technical development.

It is necessary for an **inventor** to have a rich experience and a better knowledge of specialized issues in the field. These two conditions allow a specialist with inventive spirit, to achieve truly new and valuable things and not to work for things that were already done by others, before him. Therefore, the work of invention is a particularly laborious one and generally requires many hours of hard work by the **inventor**.

The concept of the invention has been defined somewhat differently by the laws of states and therefore we seek to outline the elements contained within the sphere of this concept.

Thus, in 1979 the World Intellectual Property Organization (WIPO) has developed a model of law for inventions in developing countries, not mandatory, where invention was defined as a solution of an inventor, that applied, allows approaching a specific problem in the field of technics.

Japanese law, which is considered as compared to other countries, superior to the laws in the field of inventions, defines invention as very advanced creation in technical field, by which a law of nature is used.

It is appropriate to point out that national legislation of 1974 on inventions and innovations defined inventions as a "scientific or technical creation," presenting novelty and progress over the prior stage of world technics, which has not been **patented** or **made public** in the country or abroad, represents a **technical solution** and can be **applied** to **solve problems** in the economy, science, health care, national defence or any area of economic and social life.

Finally, the current law defines a patentable invention as **new solution, result of an inventive activity** which is **susceptible of industrial application**.

In this definition, we observe an approach to the definition proposed by WIPO.

The invention as object of industrial property is protected by invention patent, called in other countries as patent. It should be emphasized that sometimes instead of the invention the object of industrial property is presented as the invention patent. It should be understood that the patent is only a document, issued by the Office of Inventions in most countries, in the name of the government of the country for the establishment of an invention protection.

The fact that the invention is object of industrial property and not the invention patent, which is only a document, is highlighted by the majority of the laws on invention of different countries, including law on inventions in our country (Condratov and Hapenciuc, 2012).

The defining elements of an invention, disclosed in the various definitions of the invention mentioned in the laws of some countries, can be materialized by some elements that are found in all laws.

Thus, a first element is the *novelty* at the world level. This means that by the time the patent application to the Office of Inventions nobody else has published a technical solution similar to that for the patent (Mehlig Sweet and Eterovic Maggio, 2015). By making public a technical solution means either the publication of a patent application for a similar solution before or the publication in a magazine or in any other publication or presentation in an exhibition or television or even in a case study news. Therefore, it is recommended that for a new technical solution, to submit as quickly as possible the documentation at the Office of Inventions to protect it by a patent.

Therefore it is clear that the date until which the novelty condition of a technical solution is the date the patent application was filed with the Office of Inventions.

However, there is a situation when the date by which the novelty of technical solutions is examined, for those who demanded protection through an invention patent, to be prior to submission at the Office of Inventions, i.e. the date of filing the application.

This solution is governed by the Paris Convention to which our country is a party of. Thus, an innovation patent was requested for a technical solution at an Office of Inventions of a country member of the Paris Convention and then within 12 months a patent for the same technical solution was requested at another Office invention of another country, member of the Paris Convention, in the request indicating the priority of the first filing, the research and technical documentation will be made at the second office only until the first filing is considered as deposit legally constituted.

Thus, no technical solution that became public between the date of the deposit and the second deposit cannot be regarded as destructive of novelty for the second, because date of depositing is considered the date of first depositing.

Moreover, if in this period between the establishment of the first depositing in the first country and the establishment of the second deposit in a second country invoking the first depositing in the second country, a third party requests a patent for a technical solution similar to the application submitted before the end of the second deposit that was set as priority, this request will be rejected, because according to the priority given by the provisions of the Paris Convention, to which priority is claimed, the date of depositing the two patent applications is the date of first depositing.

These situations will give rise to many analyses in this paper, analyses directly related to the activity of the **patent advisor**.

Inventions patents granted for technical solutions generally fall into two groups, namely: product patents and process patents. For example, a patent for a product may refer to an extraction pump or a new chemical substance, and the patent for the process relating to a process for the

manufacture (for example, of a chemical substance). Often, we find patent relating to a process and device or a new material and process for its manufacture.

In fact, when asking for a patent for a new product, it is mandatory to indicate the manufacturing process of this product.

In general, both the product and the manufacturing process being new, the patent is granted for both product and process.

If an inventor will create later a new manufacturing process of the product in terms of purity or higher simplifying the technological process, he or she will be granted the patent only for the process that is new, the product is no longer new, as it was done previously and is no longer a novelty.

A second condition found in the laws of other countries, as well as in inventions legislation of our country is that the technical solution to present progress in relation to the known solutions worldwide in the field. In some cases this condition is called inventive step or as Japanese calls it, a "more advanced technical idea".

This notion of "more advanced" is met also in the case indicated by World Intellectual Property Organization (WIPO) above.

Let us consider then why in some laws of invention, as is the case of our country, it is specified only "*new solution resulted from an inventive activity and that is susceptible of industrial application*". If we analyse this text, we observe that the element of technical progress is contained in the concept of "**inventive activity**", meaning a better solution than that found in the prior known technics. This is not merely because it is new, but by the fact that it embodies the inventive spirit. If this notion is reinforced by the fact that a new solution must have industrial application, technical progress is evident.

## CONCLUSIONS

In the examination of the application for invention patents many cases were encountered when, although the technical solution itself was new, meaning unprecedented in bibliographic materials, it did not have an industrial application, or the product obtained for example by a new process had lower characteristics of the product obtained by the method already known, inferiority embodied by the degree of purity, reliability or other conditions of existence of a competitive product on the market.

From here, the applicative value of an invention begins to take shape, whose industrial applicability presents far superior characteristics. Surely, by competition with other technical solutions that will meet the best conditions, there will be the most sought after in the market by manufacturers.

New technical solutions, patentable, must solve effectively problems that were created, generating technical, economic effects and other of effects in order to justify intellectual and material efforts made to obtain them.

## BIBLIOGRAPHY

1. Condratov, I., Hapenciuc, C.V. (2012), Study regarding the use of multimedia technologies in tourism sector of Suceava county, *Revista de turism*, 14 (14), pp. 60-65.
2. Mehlig Sweet, C., Eterovic, D.S. (2015), Do stronger intellectual property rights increase innovation?, *World Development*, 66, pp. 665-677.
3. Năstase, I. G., Lorent, A. (2008), *Managementul inovării. Inventatori și consilieri de brevete*, Editura AGIR, București
4. Năstase, I.G. (2013), Innovation and industrial property rights, *Quality – Access to Success*, 14, S3, pp.101-109.
5. [www.wipo.int](http://www.wipo.int)