

The University of Macau

Guidelines on Administrative Procedures and Evaluation of Patent Applications

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Associate responsible unit: FO

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Article 1 Introduction

1. The basis of this document is the *Regulation of Management of Intellectual Property for University of Macau* (hereinafter referred to as “IP Regulation”), and the *Rules of the Management of the Intellectual Property for University of Macau* (hereinafter referred to as “IP Rules”).
2. These guidelines set out the details of administrative procedures and evaluation of patent applications of University of Macau (hereinafter referred to as “UM” or “the University”).

Article 2 Composition and Functions of Review Panel for Patent Applications

1. According to the technical field of each patent application, a Review Panel for the application (hereinafter referred to as “Review Panel”) will be formed. The composition of the Review Panel shall be as follows:
 - (1) The Director of Research Services and Knowledge Transfer Office (hereinafter referred to as the “RSKTO”), shall be the Chair;
 - (2) Two academic staff relevant to the technical field of the concerned patent application should be selected from internal expert database as the Ad-hoc Members.
2. For consulting the related issues of the internal expert database, RSKTO may contact the concerned Faculty/unit.
3. In case the Chair of the Review Panel presents a conflict of interest towards the evaluation of the patent application, his/her position in the Review Panel shall be substituted, preferably by a senior academic staff of another Faculty/unit in relevant technical field.
4. Secretariat support to the Review Panel shall be provided by RSKTO.
5. The main functions of the Review Panel shall be:
 - (1) To evaluate patent applications and provide technical comments;
 - (2) To recommend inventions, which are fully or partially owned by UM, for patent applications;

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(3) To assist in handling relevant matters at the request of the Vice Rector (Research).

6. The Review Panel shall provide fair and objective comments and recommendation to the University regarding patent affairs.
7. Each member of the Review Panel is required to sign a non-disclosure form to ensure that the confidential information obtained during the review process of the patent application will not be disclosed or used.

Article 3 Evaluation of Patent Applications

1. In general, each patent application will be evaluated by the Review Panel anonymously based on the application materials submitted by inventor(s).
2. The application materials submitted by inventors include but not limited to:
 - a. *Confidential Invention Disclosure Form for Patent Application;*
 - b. *Patent Application Review Form for Patent Review Panel;*
 - c. *Manuscript regarding the invention;*
 - d. *Prior-art search regarding the invention;*
 - e. *Supporting evidence related to the further commercialization of the invention.*
3. The contents of the submitted *Patent Application Review Form for Patent Review Panel* must focus on the fulfilment of the criteria of patentability and commercialization. Other information such as background information and methodology should be minimized.
4. The evaluation is based on the following criteria, and the relevant information must be included in the application materials submitted by inventor(s).
 - (1) **Patentability** – Two of the most important criteria of patentability are the degree of novelty and inventive step of the invention. Thus, inventor(s) shall conduct a search regarding any previous prior-art that shows similarity to the proposed invention. The inventor shall provide the search results and summarize areas of difference and areas where similar inventions may already exist in the submitted application materials. The term ‘Prior-art’ refers to information and/or knowledge already existed in the public domain, prior patents, published applications, publications available to the public, items on sale *etc.* Prior-art search maybe performed using any web search engine and/or the UM Library Patent Information Service, and should not be limited to the intended jurisdiction of the patent application.

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- (2) **Claims** – The most important part of any patent is patent claims, which define the protection scope conferred by a patent. Thus, the inventor(s) should list out the subject-matters to be protected in this patent application, which are not covered by any prior-art.
- (3) **Commercialization** – Assessing the potential commercial value is the primary focus during the evaluation. Therefore the inventor(s) is/are expected to provide majority of the contents in the *Patent Application Review Form for Patent Review Panel* on the topic of commercialization and should contain (but not limited to) the following information:
- (i) Stage of invention development
 - (ii) Potential commercial applications of the invention/technology – The inventor(s) should have a clear understanding of the market and commercial value after the patent has been granted. The inventor should demonstrate how the invention will bring about economical and/or social benefits. The inventor should demonstrate to the Review Panel the intended use of the invention and its patent. In addition, the inventor should provide a basic market analysis to describe where the invention will be used, hence the reasoning behind the chosen jurisdiction for the patent application. This may include information such as geographical market share, competitive products, on-going developments within the industry *etc.*
 - (iii) Potential invention/technology acquirers – The inventor(s) should provide supporting evidence related to the further commercialization of the invention after the patent has been granted. This should include at least one of the following:
 - Intention and an outline plan for a start-up company;
 - Interest from venture capitalist for investment;
 - Letter of intent - a letter from a company which expresses interest to commercialize the invention;
 - Industry outreach - refers to email exchange with at least two companies for commercialization.

Article 4 Administrative Procedures of Patent Applications

1. All administrative duties related to patenting shall be handled by RSKTO. Therefore the first point of contact regarding all patent-related matters shall be addressed towards RSKTO.

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2. One Corresponding Inventor should be indicated for each patent application, preferably UM regular staff. The Corresponding Inventor will be the point-of-contact between the inventor group and RSKTO.
 3. The workflow for a patent application is outlined below:
 - (1) **Application submission** – Inventor(s) should submit an original signed *Confidential Invention Disclosure Form for Patent Application* and *Patent Application Review Form for Patent Review Panel*, together with all relevant supporting documents to RSKTO, regardless of the funding source for the patent application or the need of patent evaluation.
 - (2) **Formality check** – RSKTO conducts a preliminary document checking of the application. If there are any materials necessary for modification or supplementation found, the application will be sent back to the inventor(s) for the appropriate amendments in 3 working days. Inventor(s) shall then respond to the comments and send back the revision to RSKTO. It may take a few rounds depending on the complexity of each case.
 - (3) **Arrange for review** – A Review Panel will be formed in around 3 working days. In case an application falls into the conditions of internal review exemption defined in Article 6 of IP Rules, RSKTO will docket the application.
 - (4) **Patent evaluation** – RSKTO sends the application materials to the members of the Review Panel for evaluation. In general, it takes 12 working days for Review Panel to conduct patent evaluation.
 - (5) **Notification** – RSKTO notifies the Corresponding Inventor of the comments and recommendation from the Review Panel. In case the application is not recommended, the inventor(s) may still pursue the patent under the condition governed by the IP Regulation and IP Rules.