IP evaluation and protection
How do we scrutinise the invention and get the best IP?
Your speaker - Robert Harrison

- BA Physics, Oxford University
- MSc Physics, Sheffield University
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- EPO Examiner – The Hague
- IBM Germany – Patent Engineer
- W.L.Gore & Associates – European IP Counsel
- Partner, 24IP Law Group
- Advisory Board Member
- IP strategy
Goals of this module

- Identifying the best inventions
- Defining the technical problem
- Searching the invention
- Business strategy
Overview

- Legal basics
- Business evaluation
- Identifying the opportunity
- Searching
- Defining the technological innovation
- Prosecuting the patent
- Evaluating commercially
Legal basics

**Patent**

- **Novel**
- **Industrial application**
- **Inventive step**
Invention disclosure

Description

Prior art (known)

Novelty
Question?

How do you identify relevant prior art? Why?

Use comment function to let us know
Searching

Invention
- Novelty

Search
- Patents
- Literature

Claims
- Search again
Search tools

Which search tools do you use?

Use comment function
Searching the Invention

- Numerous search tools

Patents

- Espacenet; PatentScope; Google Patents
- DerwentInnovation (formerly Thomson)

Non-Patent Literature

- Scientific Papers; general internet search
- Google scholar
Limitation of search

- No search can ever by complete
- Don’t forget documents in foreign language
- Synonyms
- Be careful of “false friends”
  - Translation in English is not translation in French;
  - Isolation in German is not isolation in English;
  - Silicon is not the same as silicone
Search strategy

- Semantic searching
- Cooperative / International Patent Classification
- Keyword

Result

Identify 3-4 documents
Some people do not search

Why?

Comment?
Search concerns

- Tracking of search strategy
- Willful infringement
  (discover a patent that you might infringe)
Invention and prior art

Disclosure  Search  Grant

Novelty
Novelty

Non-patentable

β Business methods (e.g. auctions)
β Algorithms
β Computer programs as such
β Methods of Treatment / Diagnosis
Invention and prior art

Disclosure | Search | Grant

Novelty
Business interest

Patentable

Good patent

Business interest
What is a good patent for a business

- Not necessarily broad
- Pinch point

Pinch point

- Composition
- Algorithm
- Interface
- Indication
Product concept

Innovation theory teaches us to write a product concept statement

e.g. „the only ….“ or “the most ….“

claim language
The claims

It's all about the claims

Claims
  • New
  • Inventive
  • Cover Product (pinch point)

Not a mixture of method and apparatus features.
Summary of today

- Searching
- Pinch points in business
- Product concept statement
- Claims