IP evaluation and protection
Patent filing tactics and managing the patent life cycle

Robert Harrison          EPO Academy          5.7.2018
Your speaker – Robert Harrison

- BA Physics, Oxford University
- MSc Physics, Sheffield University
- PhD Semiconductors Sheffield University

- 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

- Patent drafting and filing strategies
- Using outside counsel
Overview

- Country of First Filing
- International Applications
  - PCT
  - Regional application
- Continuations
- Outside or in-house counsel
Drafting Patent Application

- English?
- Which office?
- 10-20 pages
- Simple language
- Avoid pronouns (it, this, that, the latter)
- Consistency of language
- Correspondence of description and claim
Office of First Filing

- Local Requirements
- European Patent Office
- National Patent Office
Update Application

- Search
- New examples
- Inventor feedback
- Competitor

Update application
National / Regional Phase

Where do I file?

Filing

PCT

Max 12

Max 30

National phase

Months

Where?
Case study - jackets

ß Where would you file?
Where to file

Where would you nationalise this patent application?
Jacket invention

Manufacturing: China / Indonesia / Thailand

Sales: North America / Europe / Australia

Licensing: ???
Grace period

12 Months

- Argentina (AR)
- South Korea (KR)
- Australia (AU)
- Malaysia (MY)
- Brazil (BR)
- Mexico (MX)
- Canada (CA)
- Peru (PE)

6 Months

- Chile (CL)
- Philippines (PH)
- Columbia (CO)
- Turkey (TR)
- Estonia (EE)
- United States of America (US)
- Japan (JP) - NEW

- Eurasia (EA)
- Albania (AL)
- San Marino (SM)
- Russian Federation (RU)
Grace period – Case Study

- Disclosure
  - Paper submitted to journal
  - On-line publication

- Patent search
  - Discovered in PCT search
  - Examiner: lacking novelty

- Claims
  - Broad set of claims in US and JP
  - Narrow set of claims in Europe
Challenges

- Opposition
  - Not all countries
  - European Patent Office
  - US: Inter partes review
- Revocation / Invalidity / Nullification
Responding to challenges

- Negotiate
- Agreement
- Defend to patent
- Revocation / Maintenance of patent / Amendment of patent
## Divisionals / Continuation

<table>
<thead>
<tr>
<th>Divisional</th>
<th>Continuation</th>
<th>Continuation-in-Part (CIP)</th>
</tr>
</thead>
<tbody>
<tr>
<td>Available in most countries</td>
<td>Only in US</td>
<td>Only in US</td>
</tr>
<tr>
<td>Only use subject matter from original application</td>
<td>Only use subject-matter from original specification</td>
<td>Add subject matter</td>
</tr>
</tbody>
</table>
Selecting an outside attorney

- Domain experience
- Language competence
- Interview
- Obtain recommendations
- Costs?
- Administrative support
Summing up

- Patent application strategies
- Patent filing strategies
- Continuations / Divisionals
- Working with outside attorney