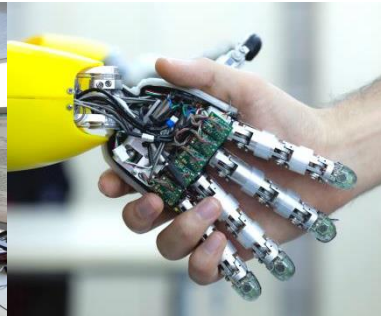




# IP evaluation and protection

Patent filing tactics and managing the patent life cycle



# 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

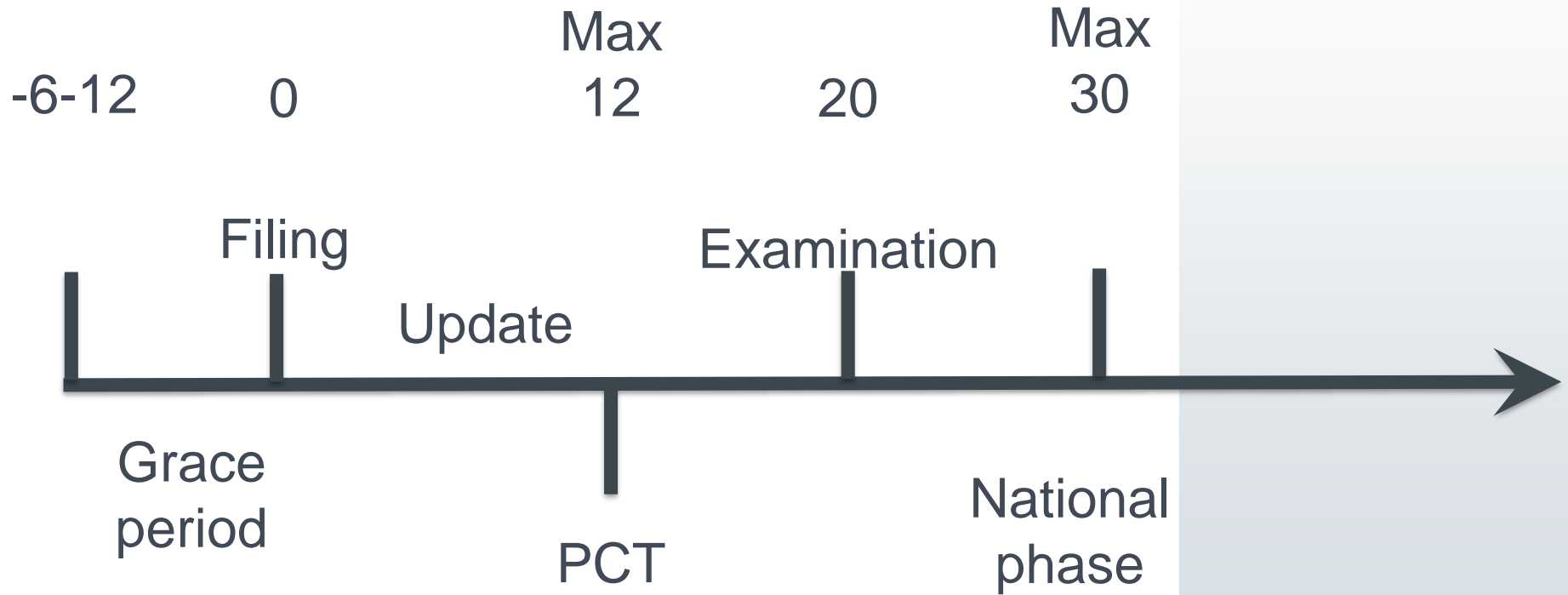
- Local Requirements
- European Patent Office
- National Patent Office

# Application - EPO



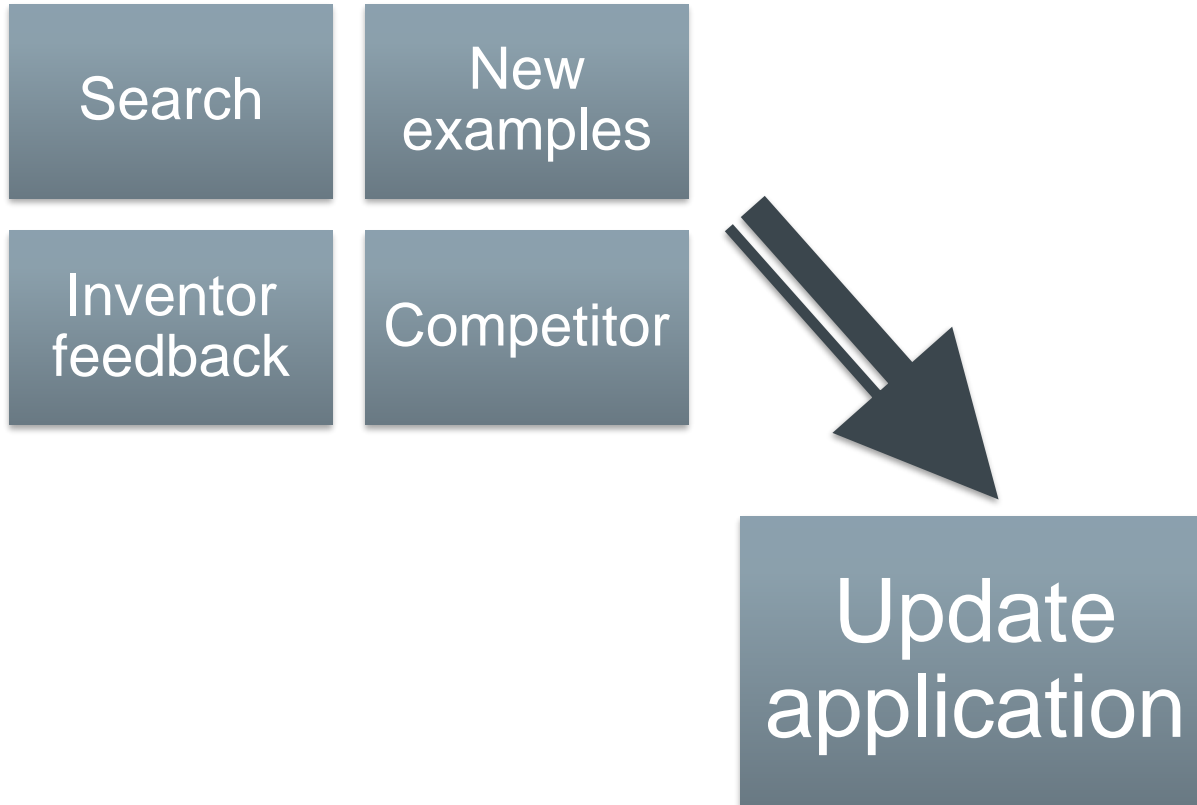
# Application - PCT

Months



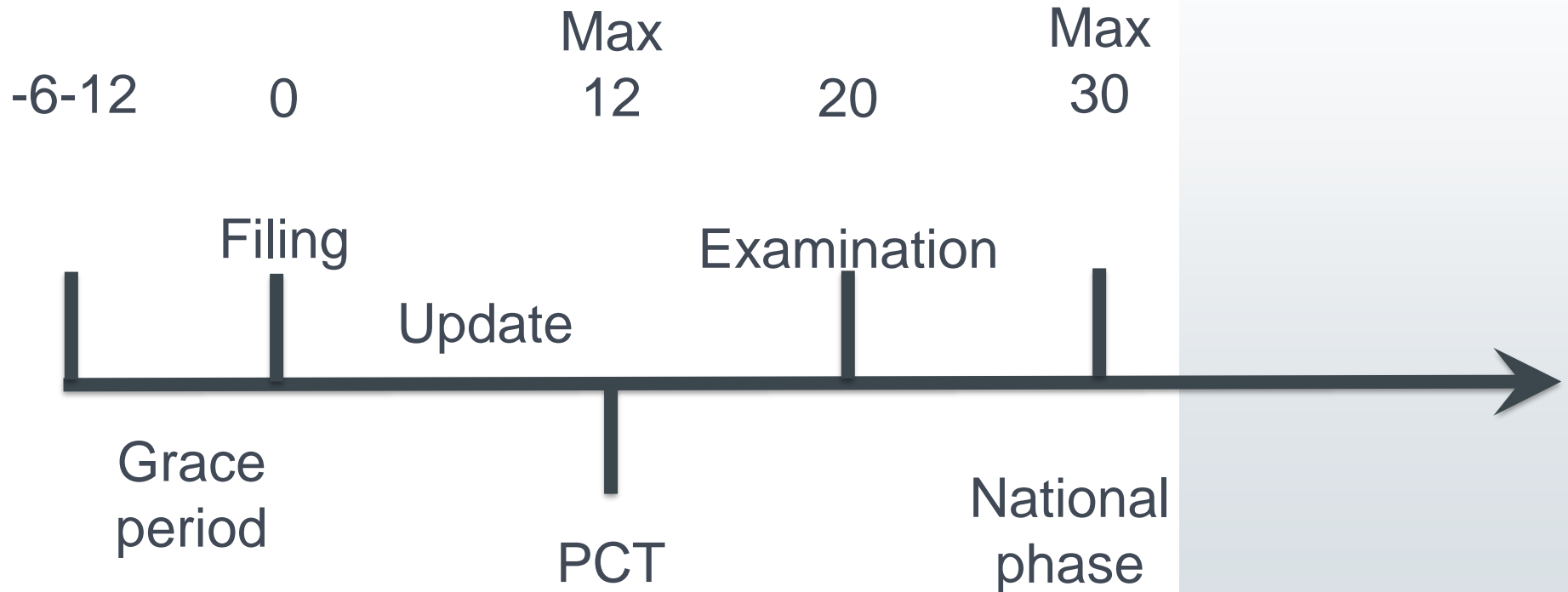


# Update Application



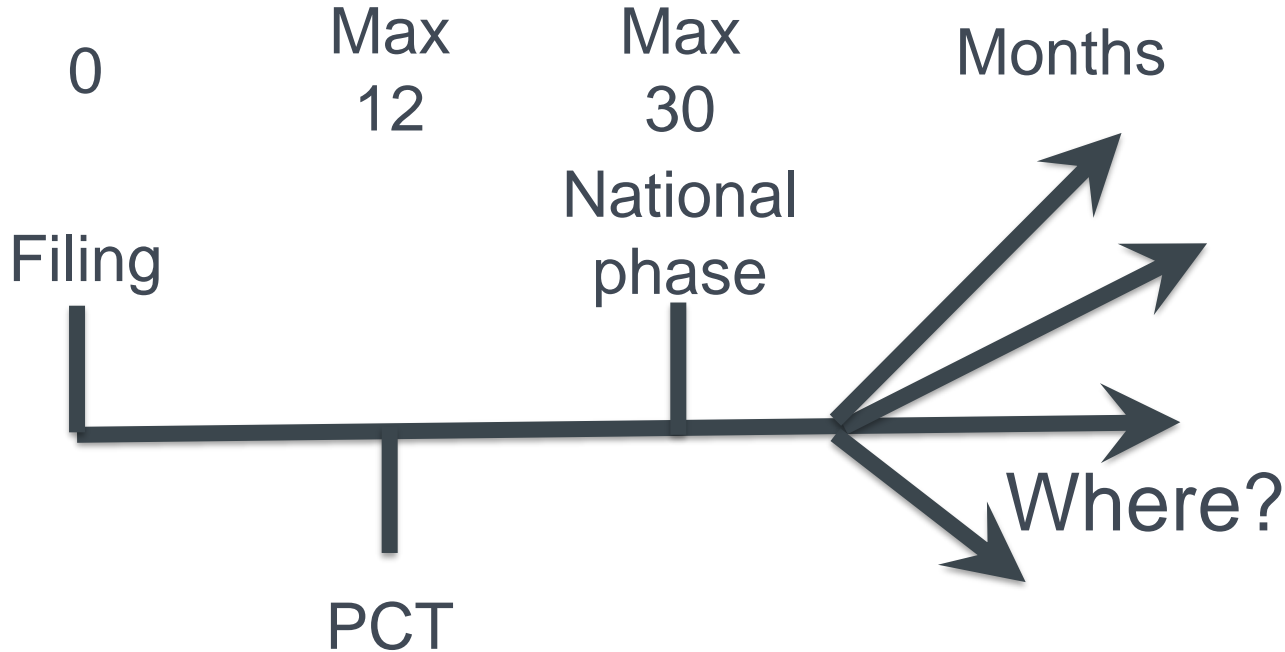
# Application - PCT

Months

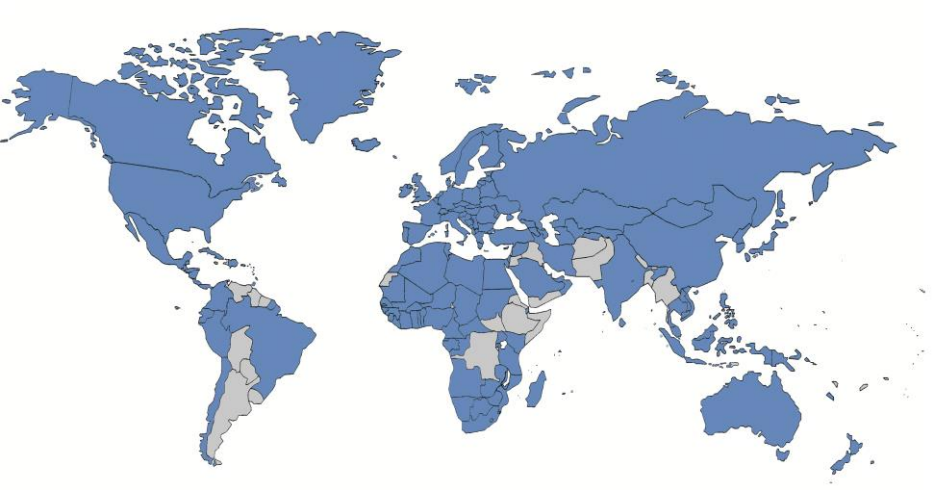


# National / Regional Phase

- Where do I file?



# National Phase?



## Sales

Europe – USA - Canada

## Manufacturing

China - Thailand

## Licensing

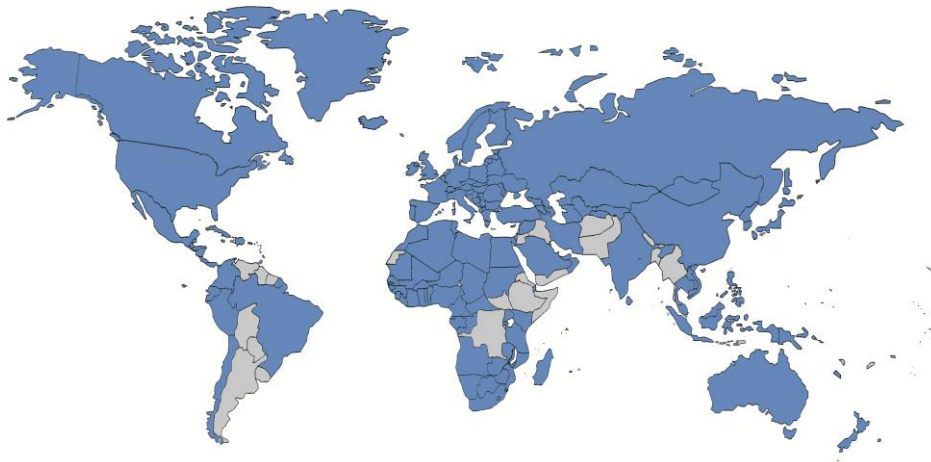
India

## Potential Markets

South Korea, Japan

# Case study - jackets

- Where would you file?



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

## 6 Months

- 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

## Divisional

Available in most countries

Only use subject matter from original application

## Continuation

Only in US

Only use subject-matter from original specification

## Continuation-in-Part (CIP)

Only in US

Add subject matter

# 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

**Thank you**

**Q&A**