Protective Rights in a Globalized Environment

Risks and Opportunities

Innotesting 19. Feb. 2015
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Physics (Diploma) at TU Berlin
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German Patent Representative – Deutsches Patent- und Markenamt
Master of Laws (LL.M.) in European Intellectual Property

3 children
Motivation

German Patent: Protection only in Germany
Including:
• Use in Germany
• Manufacturing in Germany
• Export from Germany
• Import to Germany
• Delivery of parts important to carry out an invention
Motivation

Patentability only for inventions which are new:

No publication means
• No sales and profits
• No licenses
• No use
before filing
Motivation

Foreign Patent possible and requires:

• Representative
• Translation of Application
• Official Fees
• Carrying out Examination Proceedings
• Paying Annuities

Some 10,000 Euros

IN EACH COUNTRY???
Patenting Strategy

National Filings

DE  GB  FR  US  CN
Prüfung  Examination  Examen  Examination  kaoshi
Example National Patent Application

Harris Corporation, US

„Wireless Engine Monitoring System With Multiple Hop Aircraft Communications Capability and On-Board Processing of Engine Data!"
Adixen Vacuum Products, FR

„Procede et installation de detection pour le controle d’étancheite d’emballage de produits scelles“
Motivation

Strategic Target:

• Reduce risks (lack of patentability, economic risks...)
• Select countries to obtain optimum geographic coverage at minimum costs
• Delay costs and options as much as possible
Patenting Strategy

Reduce Risks regarding **patentability** avoided by:
- In-House Searching (Inventor)
- Private Searcher (Searcher, Patent Attorney)
- Early Search Request

Reduce **economic** risks:
- Use and test invention
- Find licensee/investor
- Present invention to experts
- Keep patenting options open as long as possible
Patenting Strategy

Select Countries:
• Countries with (main) competitors
• Most important markets
• Combination if still too many countries
• (Consider if litigation is realistic)

Note
• exotic country is more expensive and has smaller protective benefit (80-20-rule)
• Complex products with much know-how require less patents than simple products
Patenting Strategy

Delay Costs:

• International Contract „PVÜ“ from 1883 enables foreign filings within one year from the first filing
Patenting Strategy

National Filings within Priority Year

0 M

12 M

GB
Examination

FR
Examen

DE
Examination

US

CN
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Airbus Operations (SAS), FR
„Method and Device for Detecting a Failure on an Aircraft“
Filed 17. June 2014
Example: National Filing claiming Priority

(30) Foreign Application Priority Data

Jun. 17, 2013 (FR) ................................. 1355665
Patenting Strategy

Delay Costs:

- International Contract „PVÜ“ from 1883 enables foreign filings within one year from the first filing.

- International Application „PCT“ from 1970 enables coverage of 148 countries in one application until 30 months from the priority date of the first filing. No granting of an „international Patent“, but National Phase
Patenting Strategy

PCT Application within Priority Year

- 0 M
- 12 M
- 30 M

- GB: Examination
- FR: Examen
- US: Examination
- JP: kaoshi
Example: International Application

Turbomeca, Fr

„Method and System for Monitoring The Health of an Aircraft Turbomachine“

Filed: 6.March 2014

Patenting Strategy

Delay Costs:

• International Contract „PVÜ“ from 1883 enables foreign filings within one year from the first filing.

• International Application „PCT“ from 1970 enables coverage of 148 countries in one application until 30 months from the priority date of the first filing. No granting of an „international Patent“, but National Phase.

• European Patent since 1973 enables protection with one Office, one language (DE, EN or FR) one representative and one examiner for 36 countries.
Patenting Strategy

PCT Application within Priority Year

0 M

12 M

30 M

DE

PCT

EP

Prüfung

DE  GB  FR

US

Examination

CN

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Air China Limited, CN

“"A system and method for detecting an aircraft jitter”

Filed 24.July 2014

Priority 24.July 2013
Example: Euro-PCT

Airbus Operations SAS, FR

„Device for carrying out tests on at least one fluid circuit of an aircraft“

Priority 17. Sept. 2010

Filed 13. Sept. 2011

National Phase: 14. March 2013
Example: Euro-PCT

Airbus Operations SAS, FR

„Device for carrying out tests on at least one fluid circuit of an aircraft“

Priority 17. Sept. 2010

Filed 13. Sept. 2011

National Phase: 14.March 2013
Patenting Strategy

Delay costs (cont.)

- London Protokoll from 2000: Validation in European Countries without filing translations
Patenting Strategy

Delay costs (cont.)

• London Protokoll from 2000: Validation in European Countries without filing translations

Patenting Strategy

PCT Application within Priority Year

- 0 M
- 12 M
- 30 M

DE
  ↓
  PCT
  ↓
  EP
  ↓
  Prüfung
  Unified Patent

DE
  ↓
  PCT
  ↓
  US
  ↓
  Examination

DE
  ↓
  PCT
  ↓
  CN
  ↓
  kaoshi
Patenting Strategy

Delay costs (cont.)

• London Protokoll from 2000: Validation in European Countries without filing translations


• Future: Cooperation of large Patent Offices will provide „global file“ enabling the entering of a national phase with a few clicks.
Patenting Strategy

Global File

0 M
12 M
30 M

DE

PCT

Global File

EP
Prüfung
Unified Patent

US
Examination

CN
kaoshi
Patenting Strategy

Risks:
• Patents are granted late
• Less damages for infringement

Opportunities:
• Include improvements within 12 months
• Keep options worldwide for 30 months
• Keep geographic options europewide for years until patent is granted
Resources

Find latest Patents at

www.depatisnet.de
„Expertenrecherche“


35 Hits
More

• German Patent Office
  www.dpma.de

• European Patent Office
  www.epo.org

• World Intellectual Property Organisation
  www.wipo.org

• Patent Attorney Weisse with further links
  www.weisse-patent.de
Erfindungen, Patente, Lizenzen
Ratgeber für die Praxis
4. Auflage
The End

Thank you for your attention