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Plattform Life Sciences

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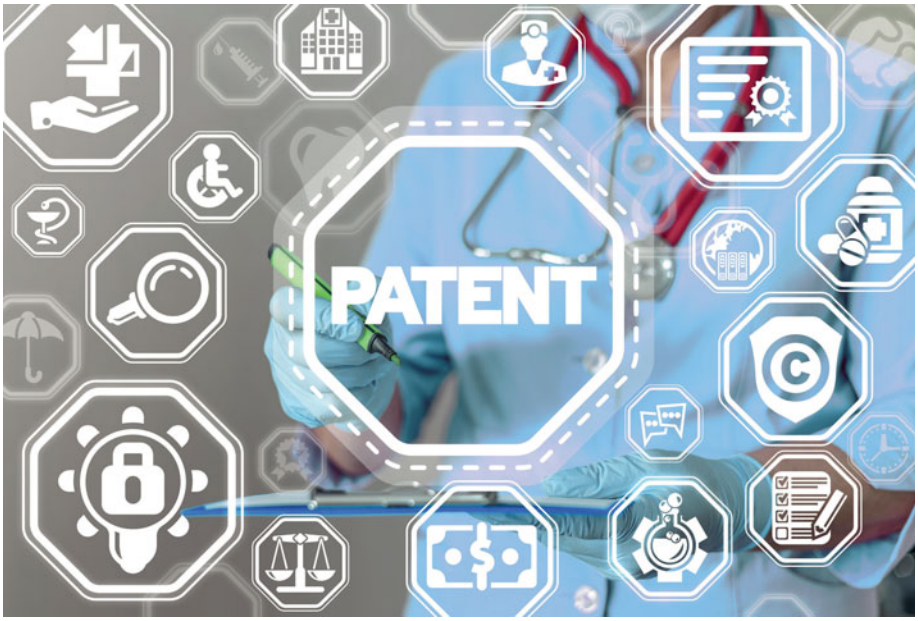
To patent, or not to patent, that is the question

"Hands-on" guidance to meet the challenges of becoming a patent proprietor

The major challenges posed by climate change and environmental pollution are nowadays motivating more and more scientists, governments, private investors, initiatives and, above all, start-ups to conduct or to promote corresponding research in the field of Green Techs. This enormous activity has also led to a huge and fast increase in the number of emerging patents. This implies that there is an increase in competition, and firms are experiencing a growing pressure to create IP to sustain and create value. But how can a tailor-made patent protection be achieved? **By Dr Christiane Maxien**



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The following "hands-on" tips can guide you through the decision-making process if it is worth patenting and how this can be done.

First things first: is my idea worth patenting?

Is my innovation "worth" applying for a patent? This important question has to be clarified even before filing a patent application. "Worth" has a two-fold meaning in this context: only technical inventions can be the subject matter of a patent (application). This basic requirement should be met by the vast majority of green/sustech companies anyway. On the other hand, the advantage of the time-limited protection – 20 years from filing – governed by a patent has to be weighed against the disadvantages that may occur by the inevitable disclosure (18 months after the application) of the invention to the public. In this regard, there are some practical considerations which can be made: has the invention been kept secret? Is the invention related to a product or a method?[1] Is it possible to prove patent infringement? What kind of patent policy do the competitors have? So, let's dive deeper into the matter ...

1) In some jurisdictions, like in Germany, there is another claim category, namely the "use" claim. In other jurisdictions, such a claimed use is translated into a method for use, i.e. the claimed use is regarded as method.

Speech is silver, but silence is golden

A patent application is only possible if the claimed subject matter does not belong to the "prior art" – meaning that everything that has been disclosed to the public, that is to third parties orally, in writing or otherwise, for example by providing analysable samples, without a secrecy agreement (e.g. Non-Disclosure Agreement (NDA)) is prior art. Therefore, be careful when you talk about your invention with others!

For success: product or process

There is a difference between the scope of protection of a patent claiming a product and a patent claiming a process (although

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ABOUT WR

Wallinger Ricker Schlotter Tostmann (WR) is an internationally active and well-established IP law firm that is consistently ranked in the top tier. Located at the heart of Europe's IP capital, Munich, it is close to the headquarters of both the EPO and DPMA, as well as the Federal Patent Court, the Munich IP litigation courts and the future Unified Patent Court. The firm's European and German patent attorneys and attorneys at law represent clients from all over the world and across the full spectrum of industries.

it is of course possible to claim both, for example a product and the corresponding manufacturing process in one patent (application)). A granted product claim gives the proprietor the right to prohibit any third party from using, selling, advertising, distributing and manufacturing (independently of the process claimed in the patent) the claimed product. In case of a granted process claim, the proprietor can only prohibit any third party from carrying out the claimed process (and in the case of a manufacturing process, from using, selling, advertising and distributing the directly manufactured product). A granted patent claiming a product thus gives the proprietor a broader scope of protection than a process claim.

When it comes to patent infringement, it is usually easier to prove infringement of a product claim rather than a method claim. For proving an infringement of a product claim, it is regularly only necessary to obtain the allegedly infringing product and analyse it. Proving an infringement of a claimed method, however, is often far more complicated: often claimed methods are methods which are conducted at "secured" places (e.g. in a manufacturing site). To prove infringement of a method claim, it would now be necessary to inspect the manufacturing site of a competitor, and this can only be done if an inspection order is granted by a court. Such inspections are governed by a EU Directive and thus available in all countries of the EU as well as in the UK, which has corresponding national regulations.

Be aware of competitors

As the above considerations make clear, it may make sense under certain circumstances to refrain from filing a patent application and instead keep the invention secret. However, before making a final decision, the patent strategy of the main competitors should be examined, in particular whether the competitors are very active in patenting inventions or if they also keep the inventions secret. It should also be investigated whether the competitors are rather "copycats" or truly innovative companies, which generally respect third party owned IP.

A good strategy is half the battle

If a decision to apply for a patent is made, the next challenge is to decide on the best patenting strategy: is the invention finalised? Is it worth filing more than one patent application at the same time? In which jurisdictions should a patent application be filed? And deeper we go …

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Are you ready to go?

Sometimes it is necessary to apply for a patent although the invention has not yet finalised. For such circumstances, the patent system provides what is known as a "priority year", meaning that it is possible to "supplement" the first filed application (priority application) within twelve months with additional information obtained during this period (e.g. additional experimental results, additional embodiments or the like).

Two applications are better than one … ?

Although this is not a typical approach, it may be worth thinking about filing more than one application at the same time, for example by focusing each application on another aspect of the invention (e.g. different ways of manufacturing or different embodiments of a product). The downside of such an approach is that more money needs to be spent for drafting and prosecution. On the other hand, there is the chance of getting two or more patents granted instead of "only" one. This has the effect that a competitor must challenge two patents instead of only one and objectively underlines that the own company is an innovative one.

National, regional, or worldwide – what else?

An important decision is in which jurisdictions a patent protection should be secured. Usually, the most important jurisdiction is the jurisdiction where the company is located and/or manufactures a claimed product. Other jurisdictions in which patent protection should be considered are the jurisdictions of the (most important) markets and jurisdictions where the (most important) competitors are located or sell their products. If the company is located here in Europe, there is not only the possibility of applying for a patent domestically (e.g. in Germany at the German Patent and Trademark Office, DPMA), but also at the European Patent Office (EPO). When applying for a patent at the EPO, the patent application covers during the prosecution all member states of the European Patent Convention (EPC) and, subject to the payment of additional fees, also validation and extension states outside of Europe (like Hong Kong or Tunisia).[2] In addition, the application can be filed in the French, German or English language. Drafting the application in English can save translation costs at a later stage (e.g. when applying for a patent in the US), balancing the higher official fees which have to be paid at the EPO compared to application procedures initiated domestically.

However, if it is planned right from the beginning to apply for an "International" PCT-application (i.e. an application "covering" jurisdictions part of the Patent Convention Treaty "PCT" worldwide for a certain time range),[3] the same official fees will have to be paid anyway. In case a PCT application is filed, the applicant has up to 30/31 months from the earliest application date to decide in which jurisdiction (e.g. China, USA, Japan, Europe, etc.) the national/regional phase should be entered (i.e. a prosecution procedure should be initiated). This is the point in time where real money needs to be spent.[4] However, the 30 months after filing the priority application allows an assessment of the chances of patentability and of commercialisation within the own company so that an informed decision on how to proceed can be made. For Europe, from early 2023 on a new Unified Patent will be available, which presently allows protection in 17 EU countries. For more details, please contact the author.[5]

Prosecution – half way there to become a patent proprietor?

Independently of where a patent application is filed, it will be examined by the respective Patent Office for formal requirements (i.e. the claimed subject matter must be clear and the invention must be sufficiently disclosed) as well as material requirements (i.e. the claimed subject matter must be industrially applicable, novel and based on an inventive step). Once these requirements are met, a patent will be granted.

It's all about money

Often, the most limiting aspect is money. For start-ups in particular, it is quite complicated to find a compromise between all the measures for which money has to be spent. Applying for a patent usually requires the involvement of a patent attorney, who is paid by hourly rates. But money can also be saved here if a good template is provided to the patent attorney.[6] Moreover, there is a limited, free service offered by patent attorneys available.[7] Furthermore, there are programmes available for which a company can apply. For example, the German Federal Ministry for Economy provides the WIPANO programme. Here, a company can get up to 16,600 euros for filing a patent application.[8]

The above list of considerations is not exhaustive and the "best of" of my FAQs collection. There are many more Q&As I would like to share, but that would go beyond the scope of this article. ■

2) www.epo.org/about-us/foundation/member-states.html
3) www.wipo.int/pct/en/pct_contracting_states.html
4) This highly depends on the application and the selected jurisdictions, but as a rule of thumb one can expected between 4,000 to 6,000 euros / jurisdiction. In addition, in certain jurisdiction translations are required (e.g. in the US into English or in Japan into Japanese).
5) www.consilium.europa.eu/en/documents-publications/treaties-agreements/agreement/?id=2013001
6) The DPMA has published quite a good summary of all aspects related to the filing of a patent application on its homepage: www.dpma.de/english/patents/application/tips/index.html
7) www.patentanwalt.de/en/chamber/advice-for-inventors.html
8) www.innovation-beratung-foerderung.de/INNO/Navigation/DE/WIPANO/wipano.html