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LLP

PATENTS • TRADEMARKS • DESIGNS • COPYRIGHT

VALUE IN INTELLECTUAL PROPERTY



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4th May 2011

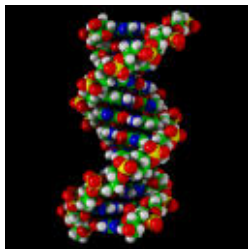
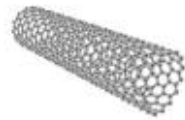
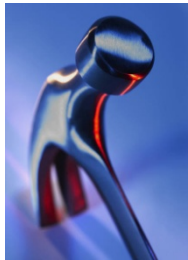
Outline

- Protecting your Ideas
- Intellectual Property Rights overview
- Focus on patents
- Strategic patent prosecution
- How can we help ?
- Questions

An idea!



How do I protect it?



Types of Intellectual Property

- Patents protect how something works
- Designs protect how something looks
- Copyright protects expression of ideas, literary works, computer programs
- Trade marks protect “designation of origin”, reputation – ‘brand’
- Confidential information protects trade secrets

IPRs are not alternatives...

Portable blood pressure monitor:



- Patent key technical features
- Trade secrets for the 'black box' in the middle
- Copyright in software
- Design rights to protect the outward appearance
- Trademarks to protect your name and logo.

Automatic

- Confidential information
- Copyright
- Unregistered design right
- Unregistered trade mark rights



TM

Action needed

- Patents
- Registered designs
- Registered trade marks



Focus on patents

- Protects idea or discovery with **technical application**
- Invention must be **new, not obvious**, and must be capable of being **used in industry**
- Right to stop others making or using commercially
- Deal with the government – monopoly right in return for disclosing an invention
- It is a **territorial** right...no world patent!
- It can be a **long-term, expensive** process
- Enforce, assign, licence, or use as a deterrent

Strategic invention capture and patenting



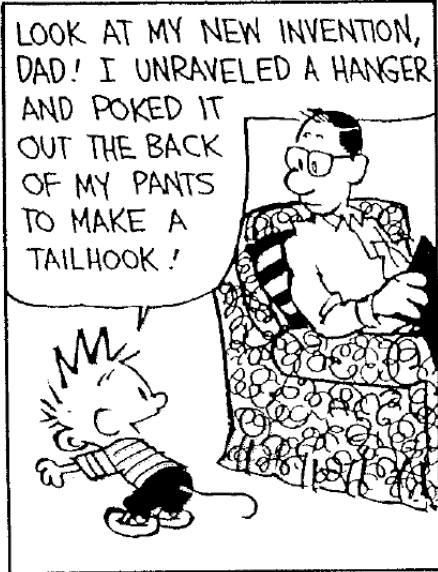
- Is my idea patentable?
- Has it been done before?
- How do I get a patent ?
- Who invented it, who owns it?
- What is a typical patent filing strategy ?
- Where can I protect it ?
- Costs and value - is it worth patenting?
- A few worked Examples

Is my idea patentable?

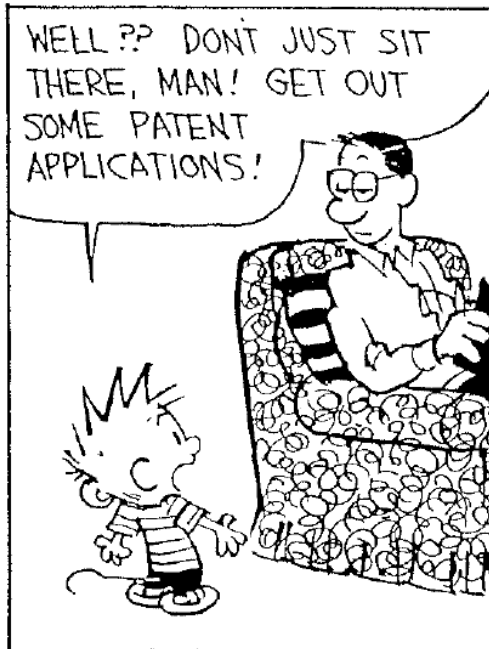
- Generally:
 - Device / apparatus / material / substance
 - Process of making
 - Method or use
- But what about:
 - Business methods
 - Software
 - Method of treatment, diagnosis, surgery

Has it been done before?

- Ultimately the patent examiner decides
 - New?
 - Not obvious?
 - Properly disclosed ?
- Formal search gives an indication
 - Clearing the way
- Search service providers
 - Watching the IP filing activity of known competitors
- Do your own search !
- Patentability opinion



NOW, WITH A ROPE STRETCHED ACROSS THE DOORWAY, I CAN BLAST INTO A ROOM AT TOP SPEED, AND THE HOOK WILL GRAB THE ROPE AND STOP ME BEFORE I CRASH OUT THE WINDOW ON THE OPPOSITE WALL!

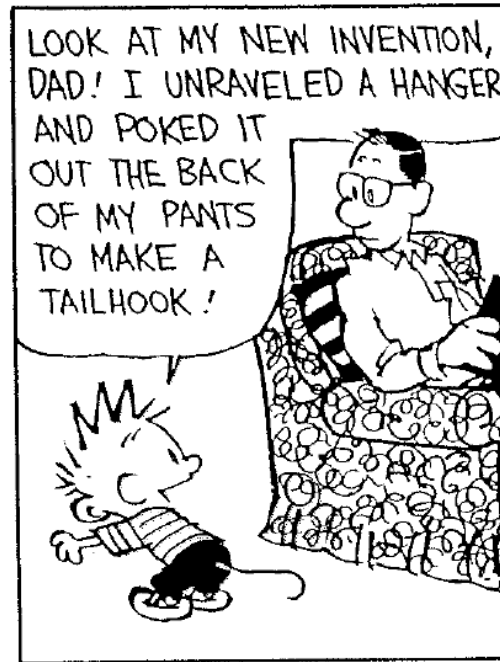


© 1996 Bill Watterson

Patenting Calvin's invention ?

What would we claim –

- Product ?
- Method ?
- Technical ?
- Patentable ?
 - Novelty ?
 - Top Gun ?
 - To Calvin's dad ?
 - In the strip ?
 - Inventiveness ?
 - Disclosure ?
- Other IPR ?
 - Design ?
 - TM ?



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How do I get a patent. . .?

- Write the patent specification (“Application”)
- Send it to a patent office (“File”)
- Search report – ‘Knock out’ prior art?
- Examination report – Any objections?
- Overcome objections - Argument / amendment
- Examiner allows case
- Patent grants
- (European) Opposition and Appeal – Hearings
- Patent survives
- Enforce against infringers / Invalidity attack

Who invented it...

- “... one of the muddiest concepts in the muddy metaphysics of the patent law”

Mueller Brass Co. v. Reading Indus Inc., 1972

- “Deciding on inventorship will ... involve assessing the ... nature of the inventive concept and who contributed to it. In some cases this may be quite complex because the inventive concept is a relationship of discontinuity between the claimed invention and the prior art. Inventors themselves will often not know exactly where it lies.”

Lord Hoffman, Yeda v. Rhone-Poulenc [2008] RPC 1

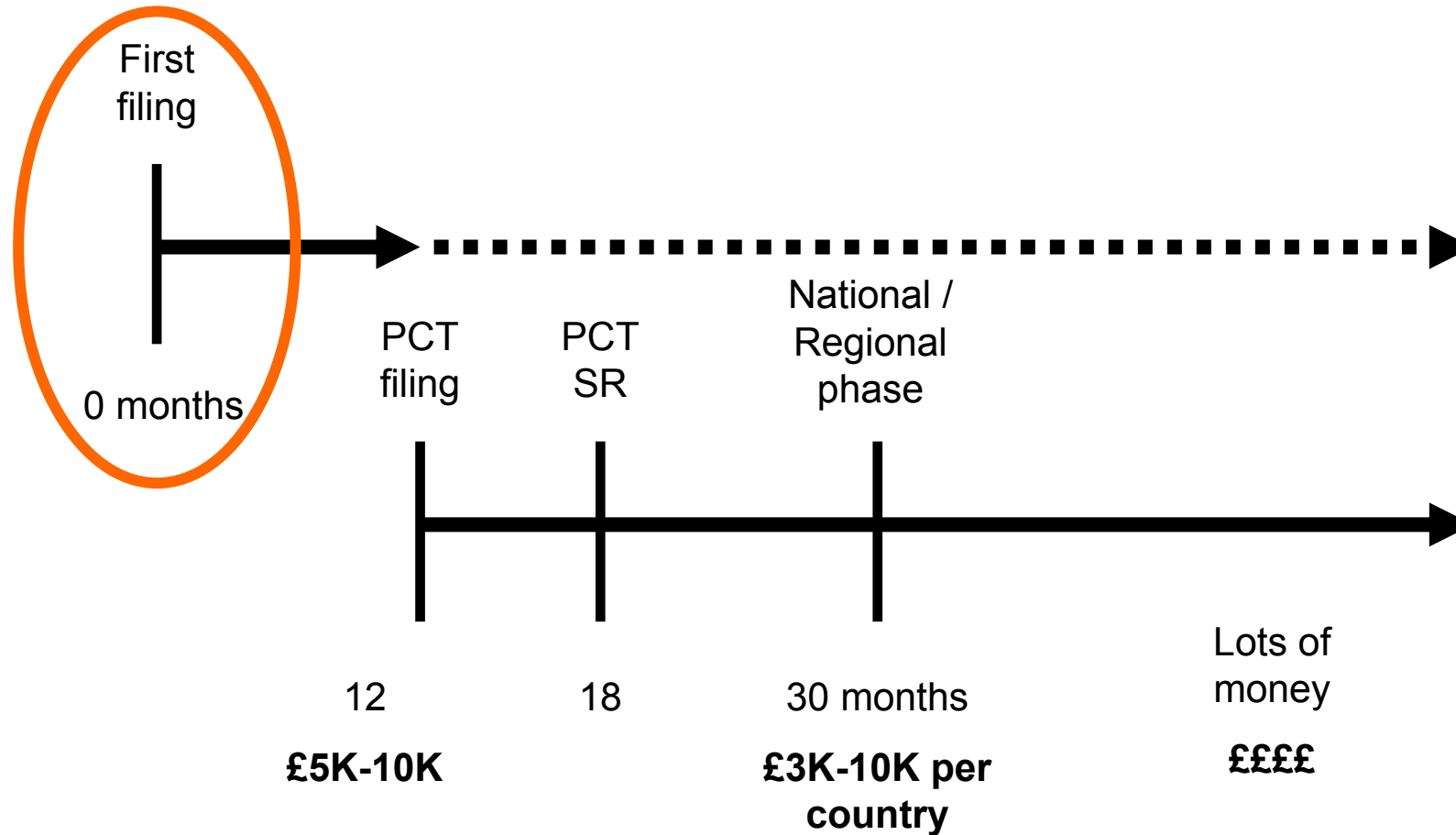
Is it even yours ?

- Inventor = First owner
- But. . .
 - Employer owns employee inventions made in the course of normal work role
 - Work commissioned by a client?
 - depends on contract

Filing strategies...delaying the costs

- Preparing a first patent application can cost between £2K and £15K
 - But this is not the stage to skimp on
 - If an application has been poorly prepared
 - This will be apparent if there is due diligence, devaluing the asset
 - Lead to objection during examination, increasing the cost and difficulty of obtaining useful protection
 - Lead to inherent intrinsic weakness in the patent over its life
- After the first filing costs can be kept low for 30 months, but then...

The traditional filing time line



Where to file ?

- Territorial rights – “Swiss cheese?”
 - Use regional patents e.g. EPO, ARIPO
 - Protection in some countries (the ‘cheese’) but not in others (the ‘holes’) to reduce cost without reducing the effectiveness of the protection.
 - Seek protection in key markets and specifically where competitors operate (e.g. manufacture)
 - Automobile...
 - Pharmaceuticals...
 - Diagnostic tests...

Keeping costs down...

- Talk to your attorney about discounts
- Take advantage of fee reductions
 - Small entity status
- Give clear instructions and answers
- Avoid taking expensive extensions of time
- Impartial scrutiny at key time points by individual in the company who has the authority to say “no” or “why” !

Why bother ?

Your intellectual property strategy must be informed by your business strategy !

- Ask yourself “If my patent attorney mailed me the patent grant certificate tomorrow, what would I do with it ?”
 - Ultimate value hard to predict
 - What is short, medium, long term aim ?
 - Vanity ?
 - PR ?
 - Deal-facilitator ?
 - Diplomacy (internal, collaboration)
 - Feasibility of enforcement ?
 - Will the patent timeline match your business timeline ?
 - Will affordable territorial coverage even be useful ?
 - What are the other options ?

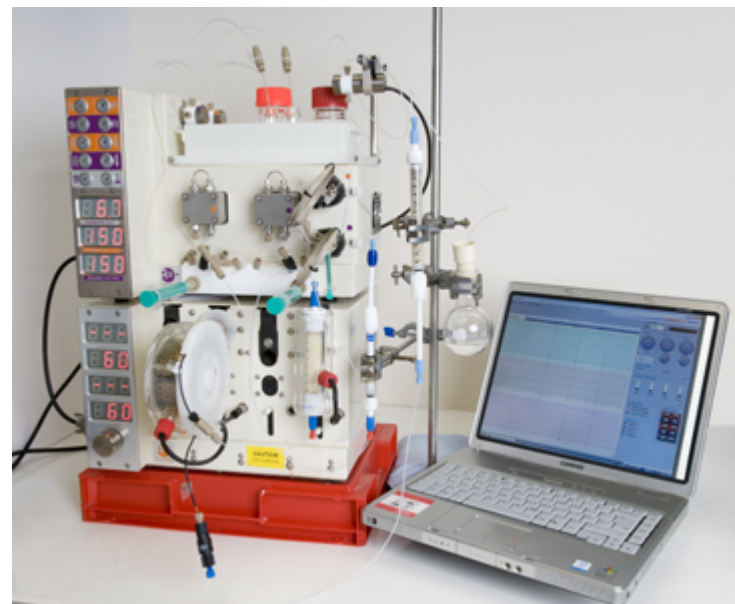
DNA Research Innovations

- “The DRI founder had invented a novel, patented technology which provides a highly simplified and elegant approach to the preparation, extraction and purification of DNA enabling the process to be completed 20 times faster than conventional methods.”
- “Having launched its first product in the beginning of 2004, Advent led the exit process which resulted in the **company's acquisition**, in October 2004, by the US company Invitrogen, Inc. The total consideration was \$65 million in cash...”
 - “A management team, patent agent and lawyer were essential to have in place at an early stage - Matthew Baker, RSC Chemistry World Entrepreneur of the Year 2005.



Vapourtec, Cambridge

- Invented the V-10 evaporation technology, which substantially reduces sample-drying time for pharmaceutical chemists, meeting the need to relieve a major bottleneck in chemistry and drug development.
- After UK and PCT invention was licensed **before national/regional phase** to Biotage (amount rising to £2.3m).



ALLEN DAVIES & COMPANY

- “According to this invention there is provided a display card and a set of bagged articles attached thereto, the said card having a plurality of tongues formed by cuts within the body of the card, the said tongues being spaced apart from each other and each tongue having a pointed tip facing downwards, said bags being of the kind made of soft pliable material and having elongate neck portions, each with its neck portion engaged between a said tongue and the adjacent region of the rest of the card, the end of the neck portion lying at the back of the card. Preferably the tongues are spade shaped.”
- With Mewburn Ellis Adopted a successful ‘**policing-engagement-non-exclusive licensing**’ policy in the 70’s and 80’s leading to multiple revenue streams...

1600047 COMPLETE SPECIFICATION
1 SHEET This drawing is a reproduction of the Original on a reduced scale

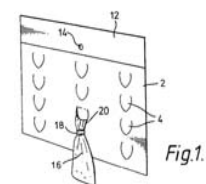


Fig. 1.

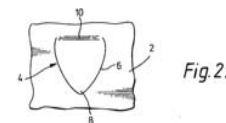


Fig. 2.

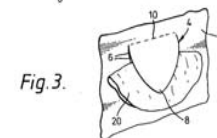


Fig. 3.

How can we help?

- Identify patentable ideas
- From idea to granted patent . . . and beyond
- Due diligence (vendor, buyer)
- Freedom to operate
- Initial contacts, agreements and licences

THANK YOU FOR LISTENING !

QUESTIONS?

