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PATENTBÜRO PAUL ROSENICH AG

PATENTS | TRADEMARKS | DESIGNS | LICENSES

PATENTS AS COMPLIMENTARY ASSETS OF IP-HOLDER

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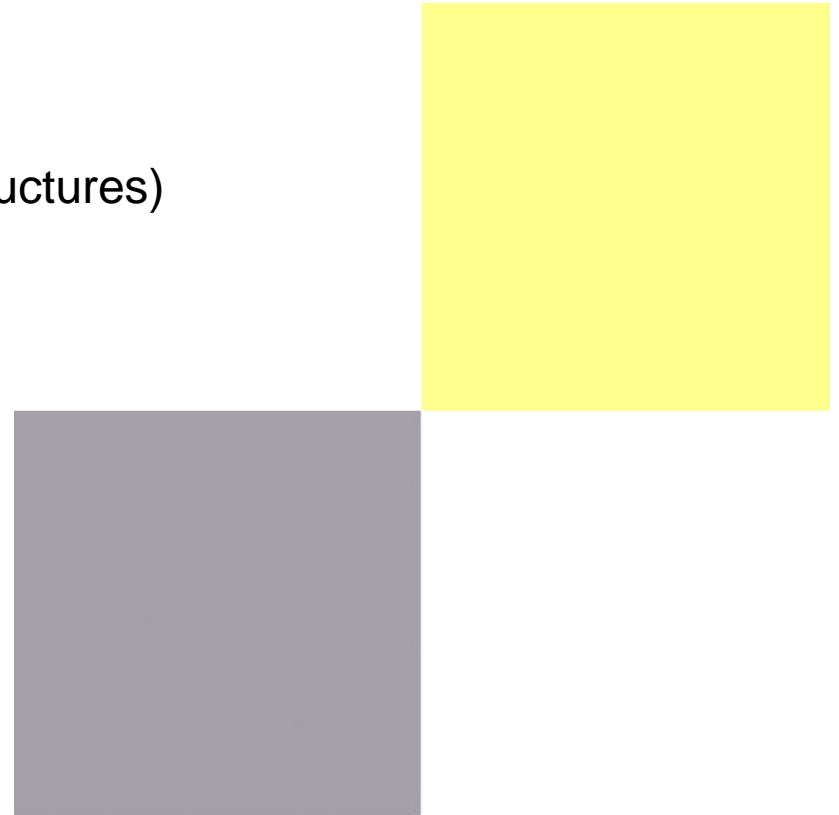
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Patentbüro Paul Rosenich AG

Overview of Intellectual Property Rights

- Patents
- Utility Models
- Designs
- Trademarks
- Protection of topographies (chip structures)
- Copyrights
- Trade Dress (only in certain states)
- Trade Secrets
- Domainnames (URL)
- Defensive Publications



Patents

- An invention in the legal sense solves a technical problem with the means of technology
- Patents are protective rights granted by the Patent Office for technical inventions for any inventions in all fields of technology, provided
- that they are new, involve an inventive step and are susceptible of industrial application.
- Patents are typically available for inventions of a process or a method, a device, a machine, a compound, a composition, a drug, plants, software with technical effects and improvements thereof.
- The patent owner has the exclusive right to prevent or stop others from commercially exploiting the patented invention. In other words, patent protection means that the invention cannot be commercially made, used, distributed, imported or sold by others without the patent owner's consent.
- Patent application at the respective Patent Office in the desired country OR territory (e.g. European Patent)
- Period of Protection: 20 years (in most of the countries)

Conditions of Patentability

- Novelty, Inventive Step and Industrial Applicability

Novelty: the invention is not part of the state of the art - Secrecy before filing.

Inventive Step: the invention must not result (for the person skilled in the art) in an obvious way from the prior art (obvious combination of known teachings = lack of inventive step).

Industrial Applicability: the invention must be commercially (including agricultural) realizable, reproducible and usable.

Patent Application

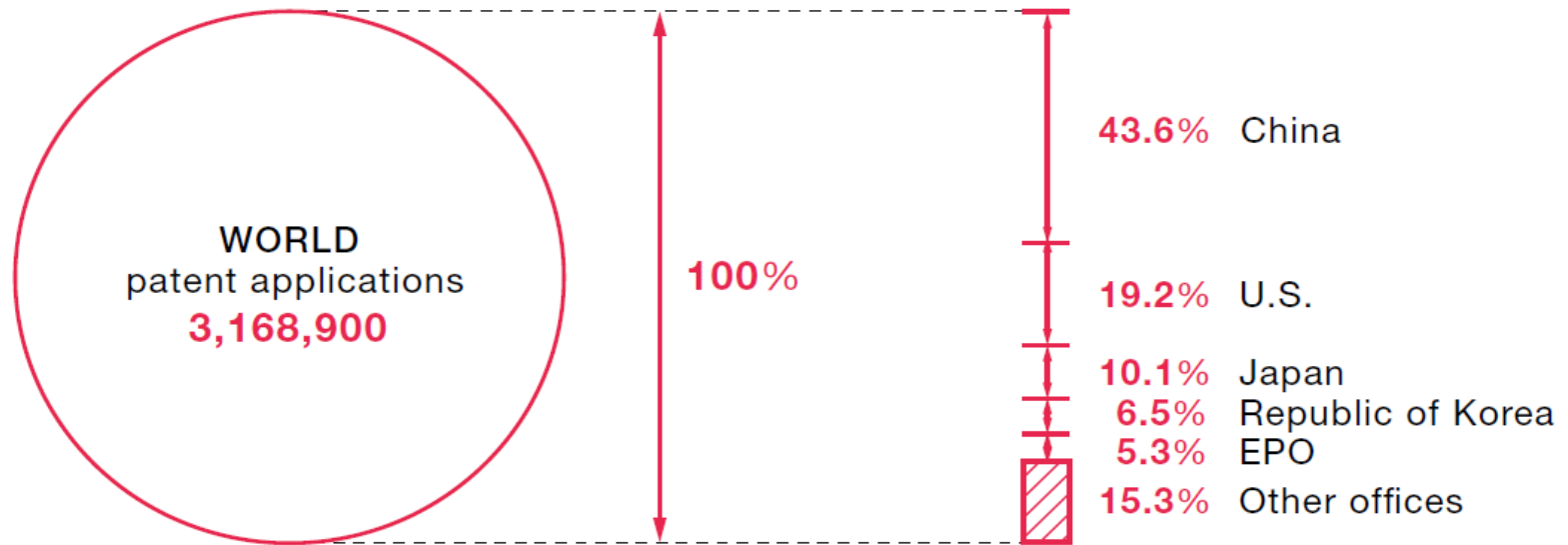
- Important considerations before filing a patent application:
 - Where is your market
 - Market size
 - Where are the producers (competitors)
 - Where is a huge market
 - Barrier to entry
 - Costs vs. Profit

- Where to file the patent application
 - National filing
 - Foreign filing
 - PCT filing

- Large companies register most frequently in the following countries
 - Must have: CN, EP, JP and US
 - Very large economy: IN
 - Important Economies: BR, KR, MX, RU and TR
 - English speaking countries: CA, AU, NZ, UK and ZA
 - South East Asia: ID, MY, PH, SG, TH and VN

The top five offices accounted for around 85% of the world total

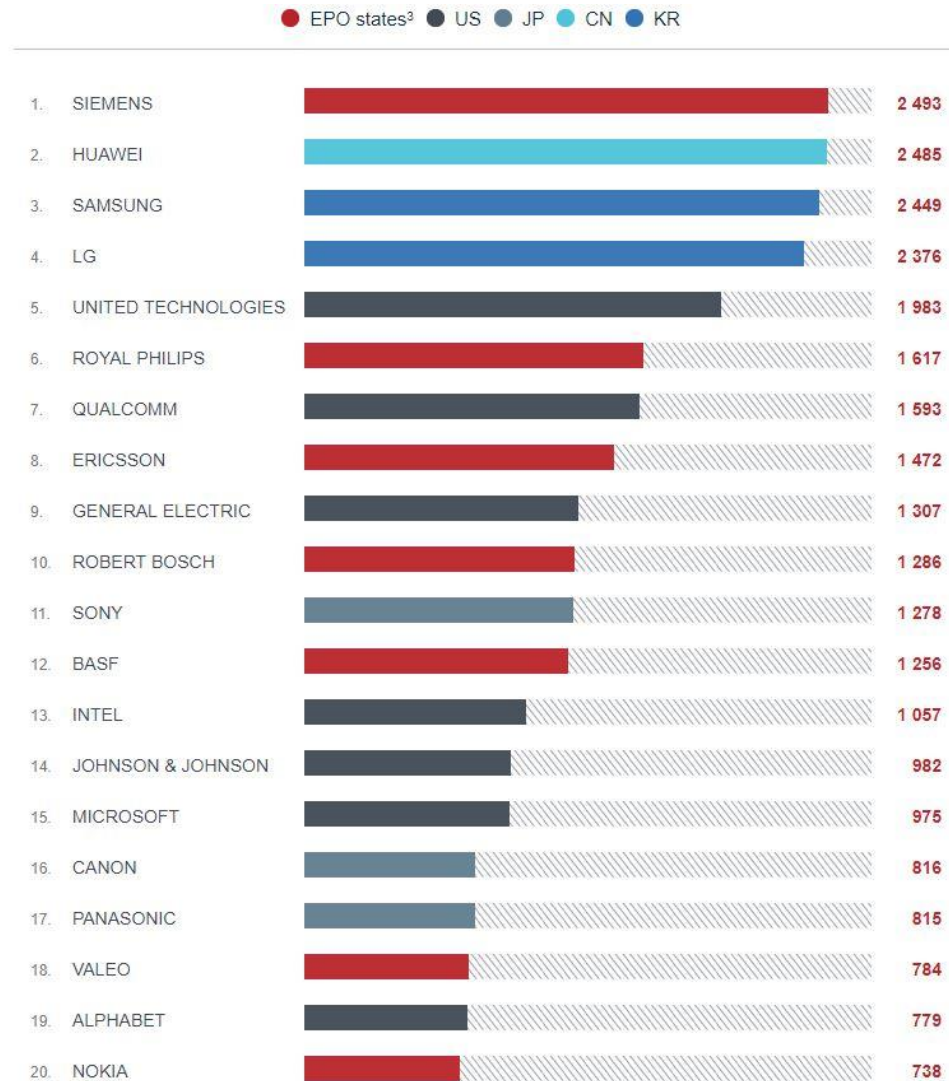
4. Percentage shares of total patent applications by the top five offices



EPO is the European Patent Office.

Source: WIPO Statistics Database, September 2018.

European Patentapplications 2018 .



Source: EPA

National filing

- Filing before the national patent office
- Regional (EP, EA ,AR OA) filing before the regional patent office

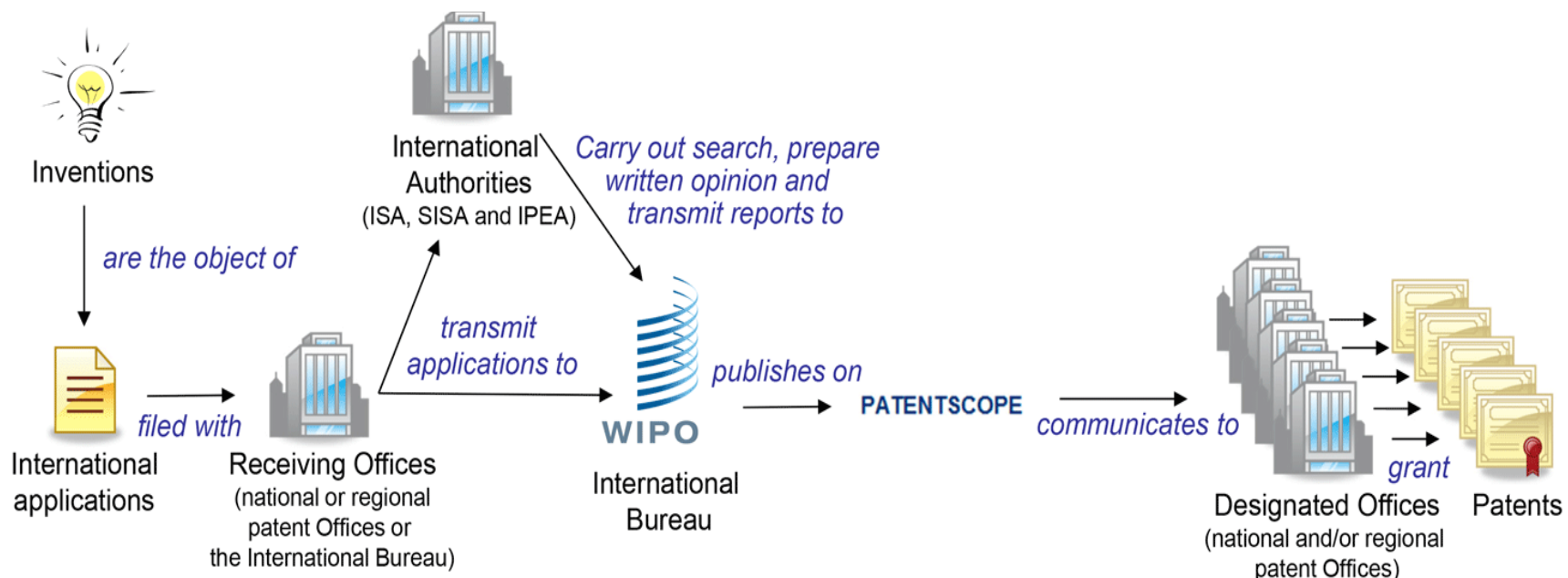
Foreign direct patent filing

Let you assist by a local patent attorney

International PCT patent filing

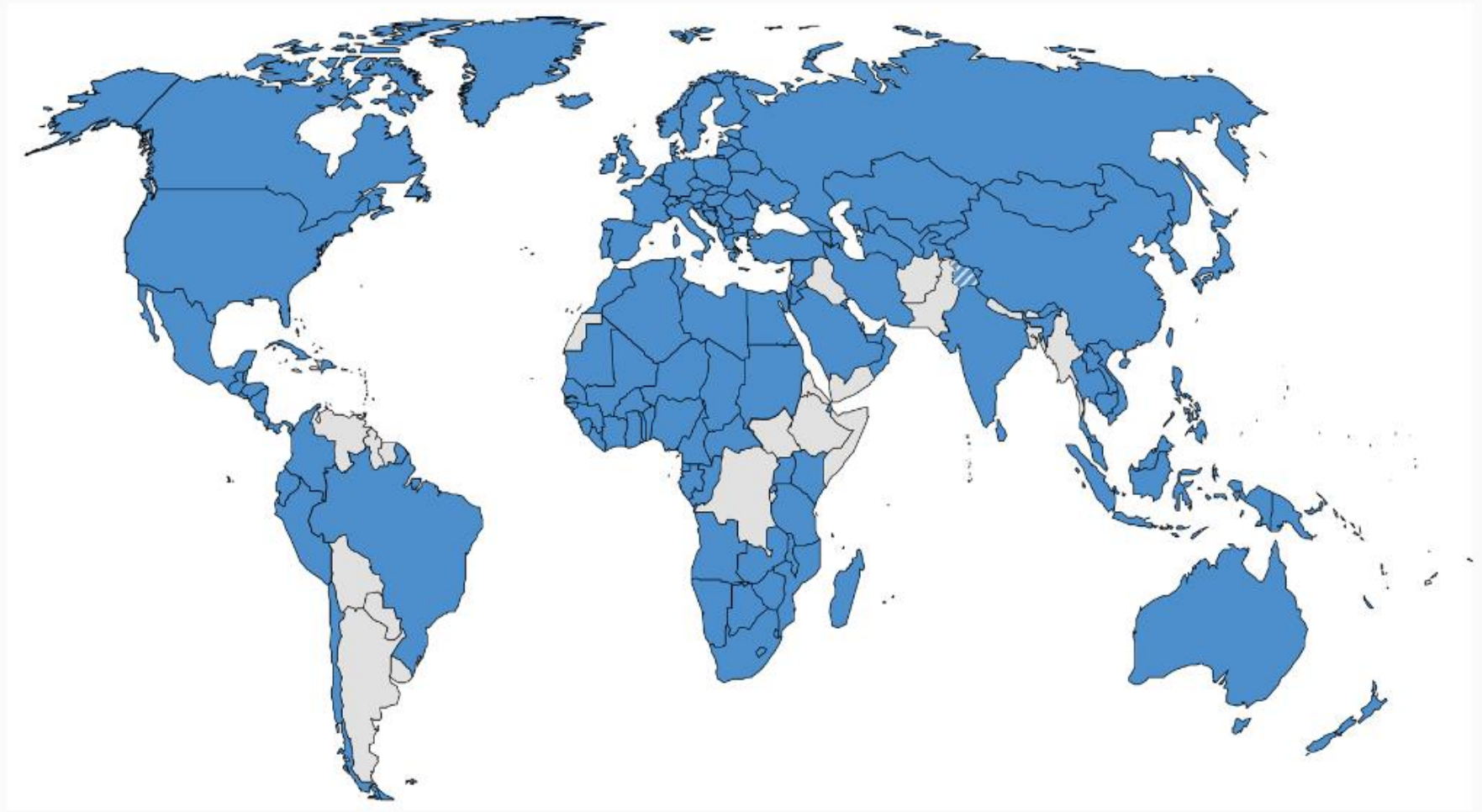
- Any resident or national of a PCT Contracting State may file an international application
- The application can be filed either at your national patent office or directly at WIPO
- The application can be filed on paper or electronically (if accepted by the competent receiving Offices)
- The language in which an international application must be filed depends on the receiving Office
- The international publication is possible in 10 languages: Arabic, Chinese, English, French, German, Japanese, Korean, Portuguese, Russian and Spanish

PCT Patent Application



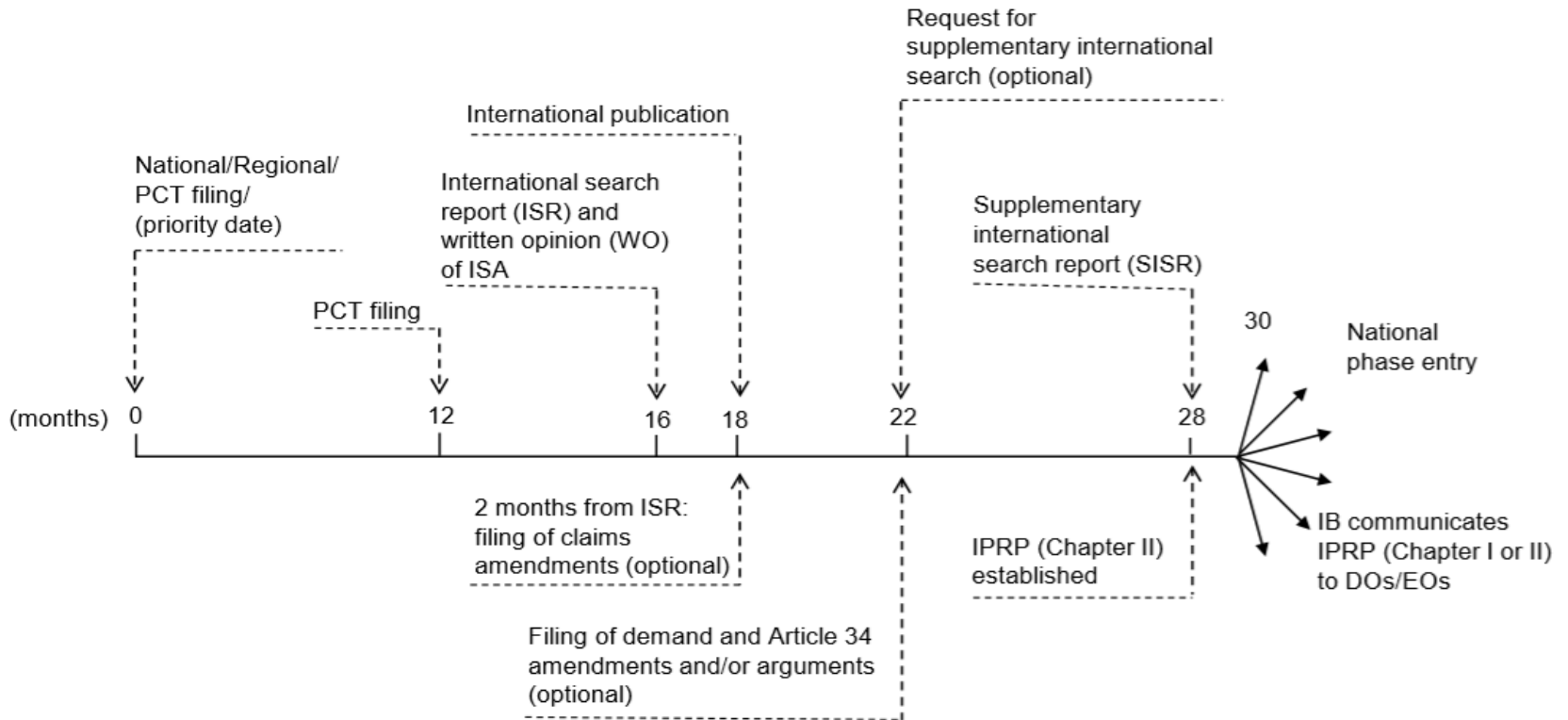
Source: WIPO

The PCT now has 153 Contracting States



Source: WIPO

PCT TIMELINE



Timeline-1
19.09.2018

WIPO | PCT
The International
Patent System

Advantages of a PCT (WO) patent filing

- PCT application = Legal effect of a regular national patent application in all PCT States
- Allows you to apply securely and easily online, and to save money by doing so
- Postpones the major costs associated with filing a patent application worldwide
- Up to 18 months time to consider whether it is desirable to seek protection
- The claims can be amended during the international phase
- International publication
- Provides a strong basis for patenting decisions
- Is used by the world's major corporations, universities and research institutions when they seek international patent protection

Reasons for Patenting your Inventions

- **Exclusive rights** - patents provide the exclusive rights to stop other people from using and exploiting your invention for twenty years from the date of filing
- **Strong market position** - through the exclusive rights, you are able to prevent others from commercially using your patented invention, thereby reducing competition and positioning yourself on the market as an important player
- **Higher returns on investments** - having invested a considerable amount of money and time in developing innovative products, you could, commercialize the invention in order to obtain higher returns on investments
- **Opportunity to license or sell the invention** – in case you chose not to exploit the patent, you may sell it or license the rights to commercialize it to another enterprise which will be a source of income for you
- **Increase in negotiating power** - your patent portfolio will enhance your bargaining power (e.g. in case of negotiation about licensing)
- **Positive image for your enterprise** - patent portfolios can be seen as proof of the high level of expertise and technological capacity in your company. This can be useful to raise money, find business partners and increase the market value of your company

Reasons for NOT Patenting your Inventions

- **Interest to keep secrecy** A patent application will be published and everybody may learn the content of your ideas
- **Avoid teaching the Competitor about possible patent infringement**
A published patent application may teach the competitor about your constructions or methods and hence might eventually point them to potential infringement.
- **Avoid disclosing your own Know How** e.g. products being either customer-tailored or difficult to reverse-engineer.
- **You want a fast proliferation of a certain technique** patents provide the exclusive rights to stop other people from using and exploiting your invention for twenty years from the date of filing, hence it might bar a fast development.
- **In such cases to be on the safe side you should consider at least a defensive publication!** - through this you can avoid others getting those exclusive rights, you are not choosing. See 22.

Utility Model

- Keyword: "The small patent"
- Protection for technical inventions: Only devices and objects (e.g. CN) also processes (AT)
- Duration of protection: usually max. 10 years
- Application at the national patent office or via EP/WO branch
- Formal examination only: in case of dispute comparable criteria to patent
- Entry in the register of the national patent office
- Possible also to get Utility Model protection also via WO
- Possible also to get Utility Model protection by using the possibility to branching it off from a national part of a WO-application or of a national part of an EP-application. Often used to strengthen the protection.

Designs

- Protection for aesthetic creations (e.g. colours, shapes, fabric patterns, clothing, automobiles, etc., two- or three-dimensional)
- Term of protection max. 25 years (in 5-year periods)
- Novelty: Must not be a part of the known form
- Application at the national patent office or international (WIPO) or regional (EU) EUIPO (in EU limited even without application)
- Often only formal examination rarely also novelty examination
- Entry in the Register

Trademarks

- Protected sign by which an undertaking distinguishes its goods or services from those of other undertakings
- Attention: Trademark protection is not intended to prevent competition, but primarily to enable the consumer to recognize and choose from a variety of similar products and services of a certain manufacturer / supplier - (recognition and quality, identification function, goodwill function)
- Graphically representable characters (colours, word, logo, combination...)
- Three-dimensional marks, slogans or sequences of sounds
- Currently 45 classes of goods and services
- Application in national patent trademark offices, EU EUIPO, Int. IR WIPO
- Protection results from entry in the register: ®...versus ™
- Unlimited term of protection, in renewable 10-year periods
- Must be used within 3-5 years (different from country to country) for the goods/services

Trade Dress

- Protected appearance to offer own products/services, with which a company differs from other companies due to its appearance
- Attention: The protected trade dress - like trademarks - does not serve the purpose of preventing competition, but primarily to enable consumers to identify a specific manufacturer/provider based on the presentation of the products and services - (recognition and quality identification function, goodwill function)
- Everything around the product (packaging, presentation, presentation of a shop etc.) (examples: Apple Store, Mc Donalds, Coca Cola refrigerators, Media Markt, Lidl, Hofer etc.)
- Above all also three-dimensional
- Application in some national patent trademark offices, e.g. USA
- Protection is obtained by registration in the register of the trademark office or via UCL
- Period of protection "unlimited/renewable" as for trademarks

Copyright

- Protection of works which constitute a personal intellectual creation, in particular works of literature, music, fine arts, but also linguistic works, drawings, paintings, plans, maps, sketches, films, photographs, plays, computer programs, brochures (in some states also products)
- Term of protection: typ. 70 years from the death of the author
- For films: typ. 50 years from publication
- Computer programs: 50 years after the death of the copyright protection, the computer program is created from the completion of the work: © year owner
- In principle no registration in an official register necessary, but possible in some countries (e.g. China)

Trade Secret

- No property right in the narrower sense, which would establish a right of its own, but with increasingly IP-like character.
- Protection of know-how Directive 2016/943/EU
- The national states have to implement this directive, creating for the first time a basic right for this protection. Until now, the standards for the protection of trade secrets have been codified in various laws (e.g. in DE Art. 17,18 UWG and CH Art. 5 UWG)
- However, even one misconduct should be enough to be allowed to divulge certain secrets

Domains (Domain Names = URL)

- No property right in the narrower sense, which would create a right of its own
- The domain has primarily no distinguishing function, but only an address function.
- First-time registrants and trademark owners are legally preferred and have advantages in use
- The importance of domains in connection with property rights is largely limited to being able to eliminate disruptive domains with the help of property rights
- Domains are increasingly protected as trademarks, e.g. "STARfn.COM", "MYAIR.com" or "www.Au-Bouquet-Romain.com". This is a trademark protection right, which additionally indicates the availability of the trademark owner

Protective Publication Services

- Protective Publication Services = Defensive Publication Services
- There is no property right in the narrower sense, which would establish a right of its own
- A Protective Publication primarily has an insurance function
- The first publisher and owner of a Protective Publication is legally privileged in that he can prevent others from obtaining property rights to the same object
- Protective Publications are often filed at the same time as patent applications
- Sometimes Protective Publications are filed as an alternative to patent applications
- Especially good address (easy to use and efficient): www.protegas.com

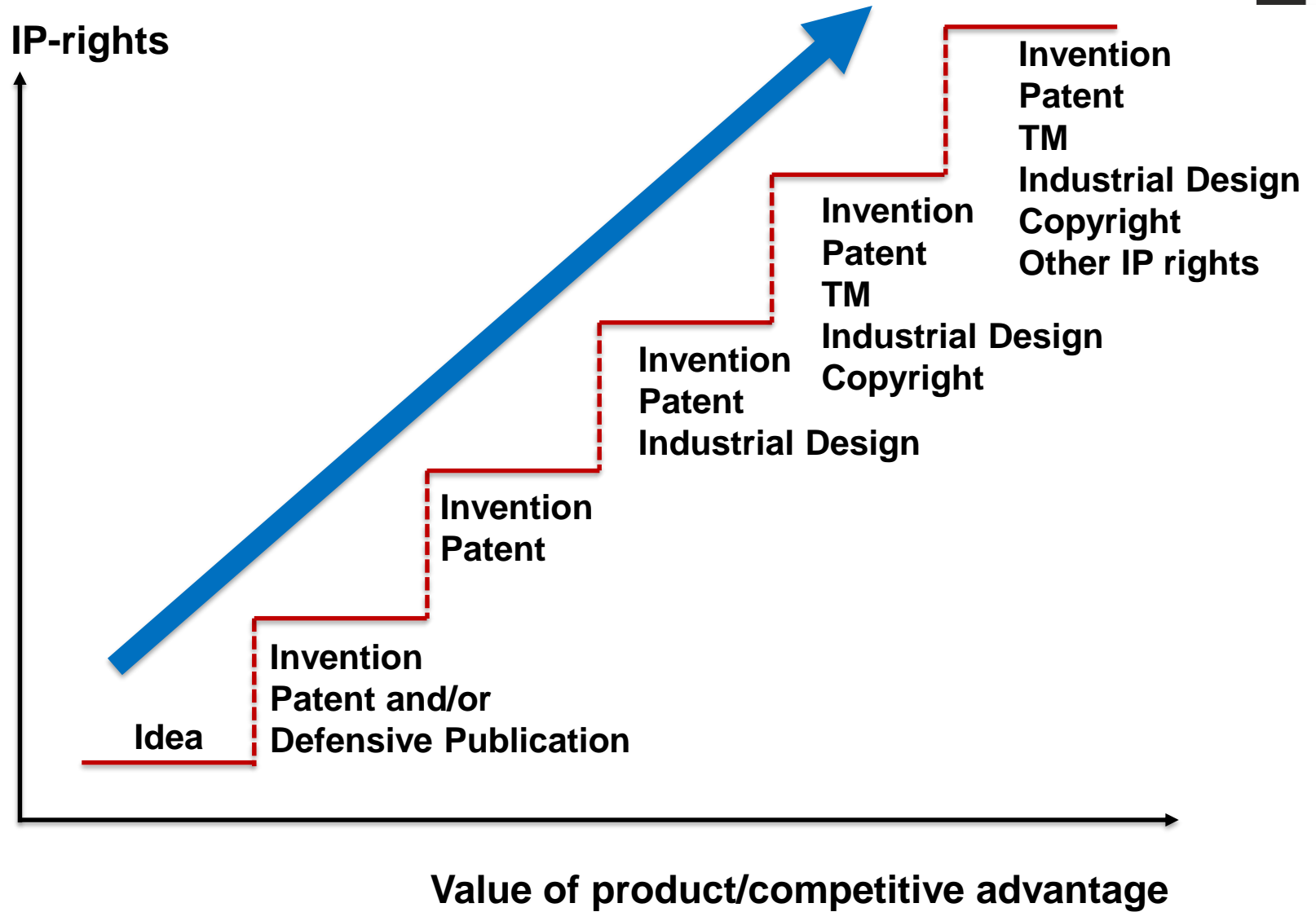
Developing Inventions with follow up IP's .

1. Patent



2. Patent





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Thank you for your attention



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