

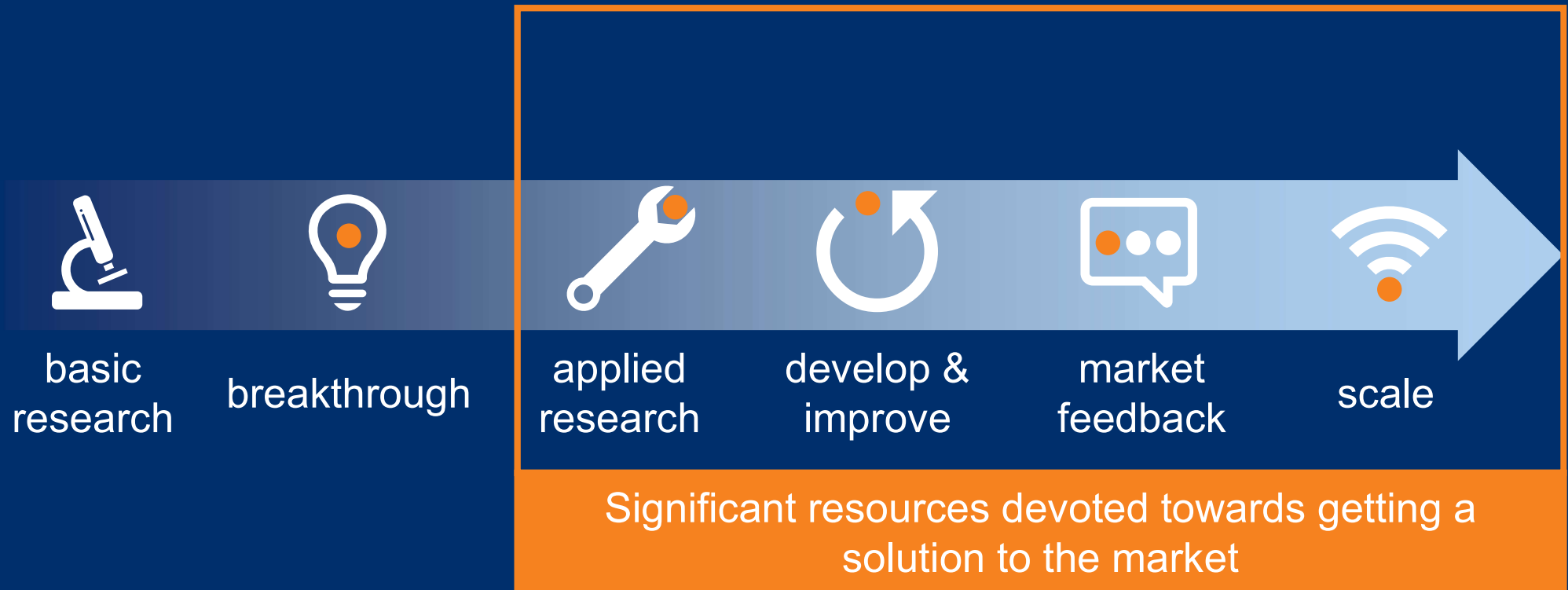
Preparing a commercially relevant patent application

June 1, 2021

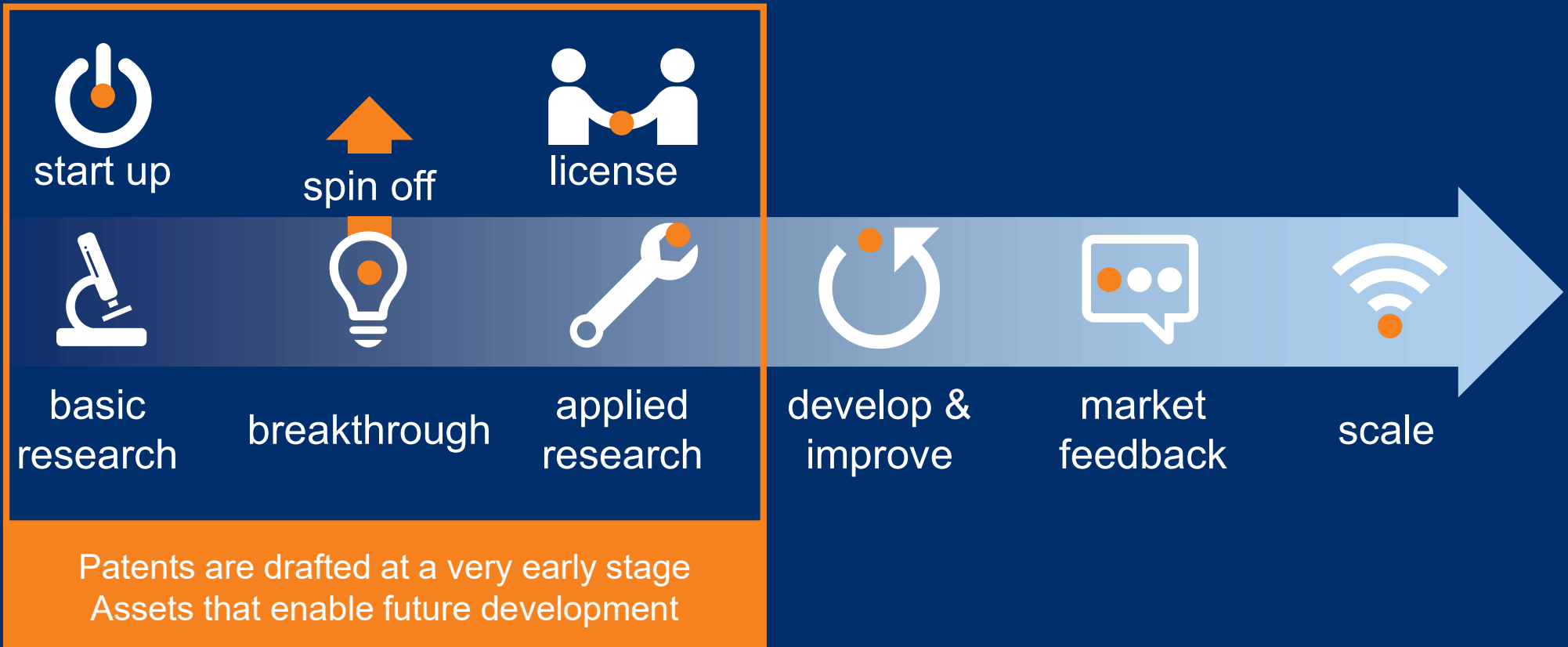
Marta Díaz
Associate Legal Officer
IP for Business Division



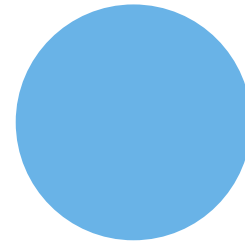
Transforming ideas into innovations



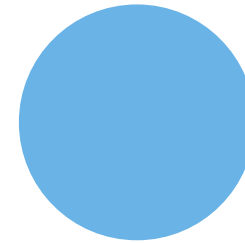
Transforming ideas into innovations



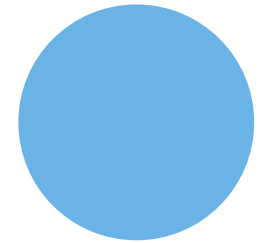
Main steps in making a patent relevant in the market



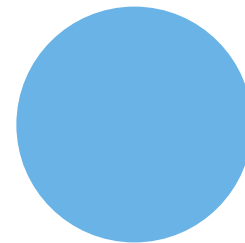
Strategic patent protection



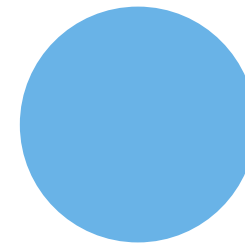
Patent valuation and decision making



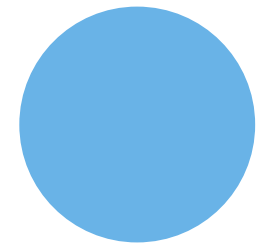
Obtaining return for investment



Organization (in-house / outsourcing)



Enforcement



Use it for business development

Are patents the right tool to protect your invention?

Is it really
a new
invention?



try a prior art
search to
find out

Is it easy
to learn
or design
around?



potential
commercial
value of the
patent

How will
you bring
it to the
market?



a valuable
asset when
working with
others

Is it a fast
moving
technology?



a patent
lasts up to
20 years

Can I
afford it?



consider
costs to file
and maintain

Objectives when drafting patents



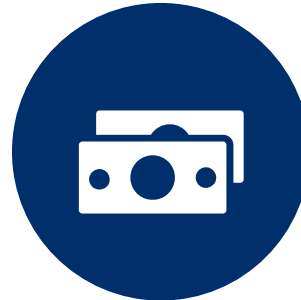
Protect the inventive concept (set the scope of protection)



Show a solution to a technical problem



Avoid the prior art



Protect something potentially valuable in the market

Reinventing the wheel? Evolution over time + the “prior art”



Inventive concepts

A vehicle, two wheels, a frame and handlebars for steering.



Inventive concepts

A vehicle, two wheels, a frame and handlebars for steering.

A vehicle, two wheels, a frame, handlebars for steering and pedals for rotating the wheels.



Inventive concepts

A vehicle, two wheels, a frame and handlebars for steering.

A vehicle, two wheels, a frame, handlebars for steering and pedals for rotating the wheels.

A vehicle, two wheels, a frame, handlebars for steering and a motor for rotating the wheels.



Patent claims

A vehicle comprising at least two wheels, a frame and handlebars for steering.



Patent claims

A vehicle comprising at least two wheels, a frame and handlebars for steering.

*A vehicle comprising at least two wheels, a frame, handlebars for steering **and pedals for rotating the wheels.***



Patent claims

*A vehicle comprising at least **two wheels**, a **frame** and **handlebars for steering**.*

A vehicle comprising at least two wheels, a frame, handlebars for steering and pedals for rotating the wheels.

A vehicle comprising at least two wheels, a frame, handlebars for steering and a motor for rotating the wheels.



Patent claims

Independent claim:

A vehicle comprising at least two wheels, a frame, handlebars for steering and a motor for rotating the wheels.

Dependent claim:

Embodiments, alternatives, specifications, materials...



Main parts of the patent application

bibliographic data (front page)

description


figures


claims

To back up the claims sufficiently and represent the invention

Define something new, inventive and industrially applicable

Defines the scope of protection sought

(19)  **European Patent Office**
Office européen des brevets

(11)  **EP 3 108 786 A2**

(12) **EUROPEAN PATENT APPLICATION**

(43) Date of publication: **28.12.2016** Bulletin 2016/52 (51) Int. Cl.: **A47L 9/06 (2006.01)**

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17.06.2009 GB 0910456

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(71) Applicant: **Dyson Technology Limited**
Malmesbury
Wiltshire SN16 0RP (GB)

(72) Inventors:
• **GELL, Ian**
Malmesbury, Wiltshire SN16 0RP (GB)

• **ILES, Jean-Paul**
Malmesbury, Wiltshire SN16 0RP (GB)
• **ASHBEE, Giles**
Malmesbury, Wiltshire SN16 0RP (GB)
• **FOLLOWES, Thomas**
Malmesbury, Wiltshire SN16 0RP (GB)
• **COURTNEY, Stephen**
Malmesbury, Wiltshire SN16 0RP (GB)

(74) Representative: **Hobday, Duncan Stuart et al**
Dyson Technology Limited
Intellectual Property Department
Tetbury Hill
Malmesbury, Wiltshire SN16 0RP (GB)

Remarks:
This application was filed on 11-07-2016 as a divisional application to the application mentioned under INID code 62.

(54) **A TOOL FOR A SURFACE TREATING APPLIANCE**

(57) A tool (10) for a surface treating appliance comprises a main body (12) connected to a conduit (14). The main body (12) comprises a first suction channel (22) and a second suction channel (24) in fluid communication with the first suction channel (22) and located between the first suction channel (22) and an outlet from the main body (12). In use, a relatively low vacuum is generated in the first suction channel (22) which draws a first dirt-bearing fluid flow into the main body (12), and a relatively high vacuum is generated in the second suction channel (24), which draws a second dirt-bearing fluid flow into the main body (12) and receives the first dirt-bearing fluid flow from the first suction channel (22). To maintain the pressure differences between the suction channels (22, 24), the main body (12) comprises flexible surface engaging means (32, 34) located about the suction channels (22, 24), and between the first suction channel (22) and the second suction channel (24).

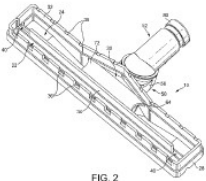


FIG. 2

EP 3 108 786 A2

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Make a list of technical “features” and questions

Write down all you know about the invention

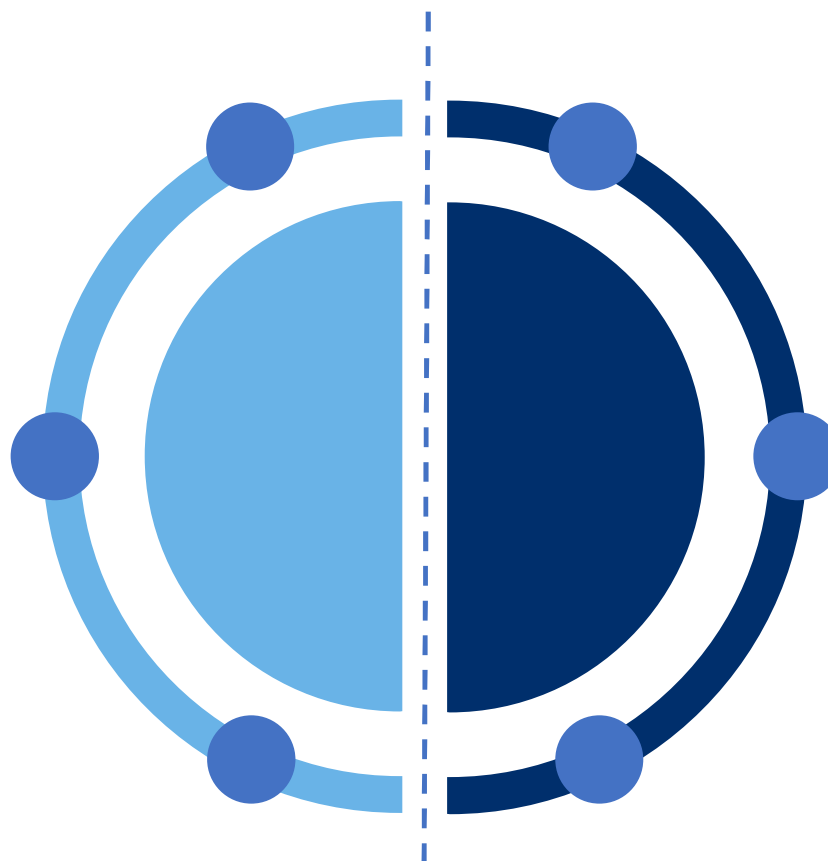
Structure
Movement
New function

Advantages and alternatives

Identify them

Differentiate from prior art

What is different, improved or better in your invention?



What does the invention do?

And how?

Is it new, inventive and industrially applicable?

Check patentability requirements

Try to explain the subject matter

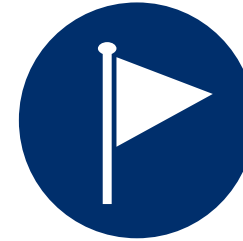
Put yourself in the shoes of the examiner

Patent Information

a resource for competitive intelligence
<https://patentscope.wipo.int/>



can you secure
protection?



flags rights you
need to access



identifies
potential partners



identifies similar
approaches



helps optimize
R&D decisions



gives a snapshot
of the technology
landscape

Confidentiality: Non-disclosure agreements and beyond



protection may be needed discussing technology with potential customers, developers, or partners



TERM

long enough based on technology and purpose of disclosure



LIMITS ON USE

control more than just the disclosure, but how it can be used



WHAT IS SHARED

make it clear and consider limiting unnecessary sharing

WHAT NOT PROTECTED?

Information that is

- publically available
- known before
- learned from an appropriate source
- independently developed

Where to file for patent protection?



Where will you
(or your partners)
make your offering?



What markets
will you sell
your offering?



Where will your
competitors
make and sell
your offering?

IP rights are an investment in your future. Think about where your business will be in the near and long term future.

Ownership may need to be assigned

WHO

SOME OPTIONS

employee
inventions

employment contracts or
operation of law

contractors

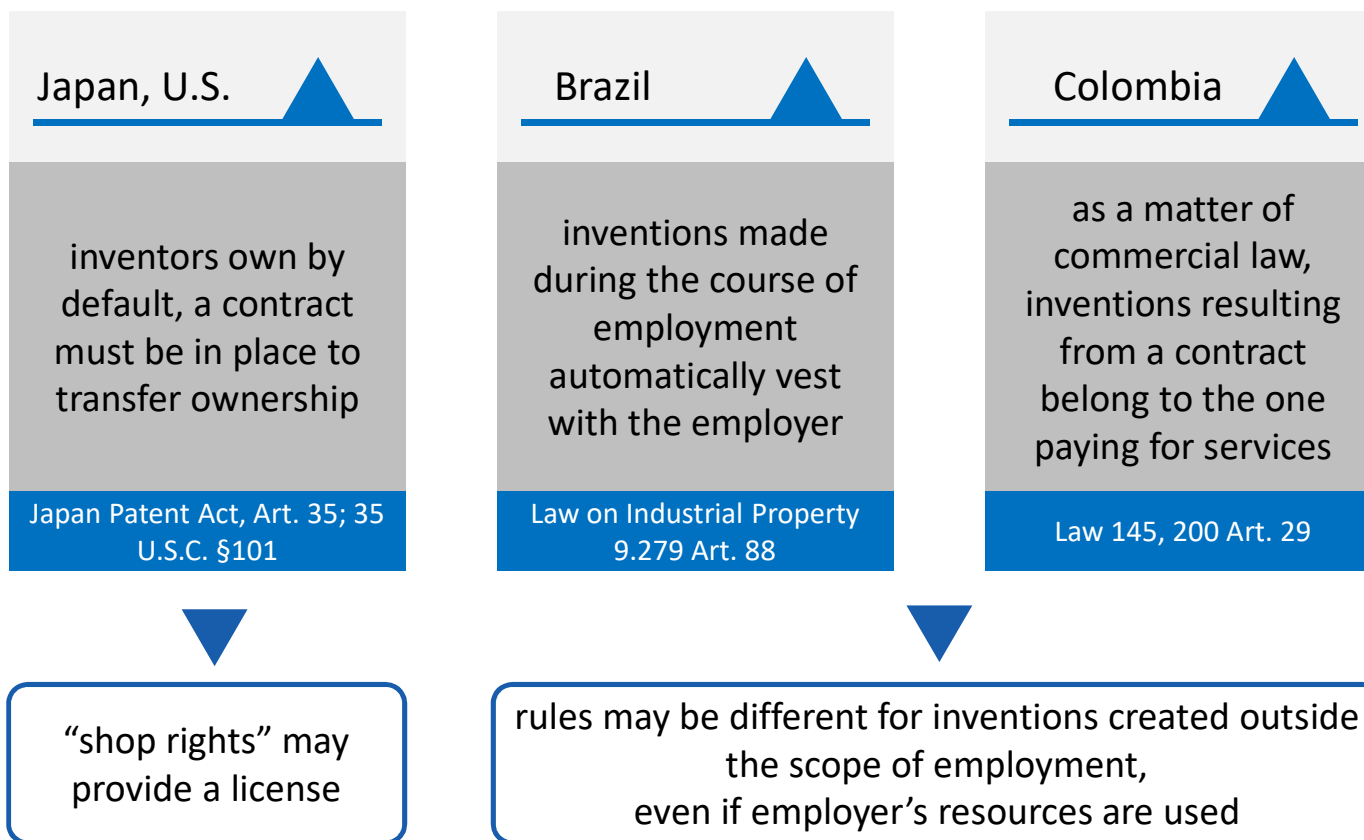
service agreements or
operation of law

partners

development agreements

if patent ownership is not covered, you need an assignment
you may also want/need a separate document
for recording purposes

Who owns an employee's invention?



Partners and Funders = potential obligations



Governments

- Obtain government approval for assigning rights
- Require local manufacturing
- Provide license to government
- Government may also require license to third parties (“march-in rights”)
- Development milestones (failure to meet may result in revocation)



Standards

- May require assignment of patent, royalty-free license, or license on reasonable and nondiscriminatory terms
- May also require forgoing injunctive relief
- Required disclosure of patents and patent applications

Other options to protect an invention

patent or (utility model)



- lets you control who can make, use or sell an invention
- must be new (and inventive)
- lasts up to 20 years (7-15 years)
- protection is country specific

trade secret



- keeps others from unfairly using your confidential “information”
- must take reasonable steps to protect it
- does not protect against independent creation
- laws vary significantly by country

What value does your IP have?

1

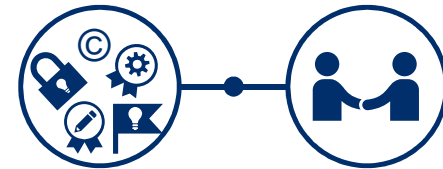
What patents does the business have?



- includes contracts, especially predictable royalty streams
- granted rights might be valued differently than pending or unregistered ones

2

What is the connection between the business and the assets?



- Do the patent help the business have a sustainable competitive position?
- What's the market size and the company's market share?

Three main approaches to IP valuation

Cost

- How much would it cost to reproduce the assets
- Cost of replacing the assets

1

Market

Typical for tangible assets, but more challenging for IP
often sold as part of a business

2

Income

What value will the IP generate in the future?
What has it generated before?

3

Opposition and Enforcement

**Opposition
(pre-post- grant)**

*Administrative
procedure, less
expensive, early
stage*

**Cease and desist
letter, arbitration,
inter partes
agreement**

*“Friendly” approach, lawyer
involved?, interim step*

**Court or
administrative
enforcement**

*Lawyer involved,
expensive, long, risk,
appeal*

Another company wants to buy your intangible assets

01

What IP assets are you using?
Do you own them? Can you prove it?



02

Will a buyer be able to use the IP assets?
Many agreements limit transferability or require permission



03

Will the buyer be able to use the IP in other products?
If the IP is licensed to you, there may be limitations on your rights



04

Are you infringing someone else's IP rights?
Acquisition by a larger company can compound risk



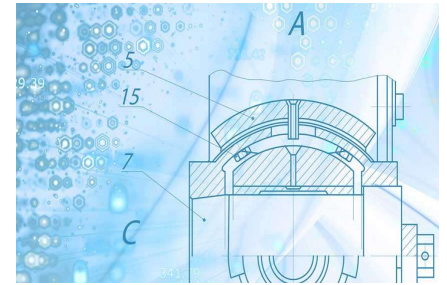
05

Do you have IP rights in key markets?
IP rights are only valid in the markets where you've secured protection



WIPO International Patent Drafting Training Program

Improving skills and techniques in patent drafting through comprehensive international training that leads to a WIPO Certificate



Launching in 2022

Who should attend?

Any persons who meet the eligibility requirement. In particular:

- Patent agents and patent agent candidates with limited training; and
- Staff of institutions dealing with technology support – such as TTOs of universities and public research centers or TISCs.

Eligibility

- General knowledge on IP and patent law; and
- Educational background in the field of science and technology or a minimum of one year of professional experience related to patent applications.

For more information, visit: https://www.wipo.int/patents/en/drafting/training_program.html

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GET MATCHED

inventor is matched with a volunteer to navigate the local patent system

GO BEYOND

inventor can also be matched with volunteers in selected countries and regions

Making a Mark
An Introduction to Trademarks
for Small and Medium-Sized Enterprises



Industrial Property
for Small and Medium-Sized Enterprises
Number 9



Making a Mark
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Number 8



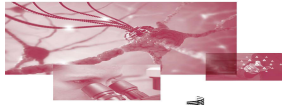
Looking Good
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Industrial Property
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Number 7



Inventing the Future
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Industrial Property
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in Marketing



Industrial Property
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In Good Company
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https://www.wipo.int/ip-outreach/en/ipday/2021/ip_journey.ppsx

Thank you

Marta Díaz Pozo
marta.diazpozo@wipo.int

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