



Patent Filing Options and Strategies from a Commercial Perspective

WIPO Patent Drafting Course for Patent Agents from the ARIPO Member States and Observer States

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The Main Issues

- Cost
- Certainty



Other Factors

- Seeking Investor Interest
- Requirement stipulated by Investors
- Early Insurance
- Belt and Braces approach
- Patentability of Technology
- Uniqueness of Technology
- Commercial Potential of the Invention
- Protection against Patent Trolls – USA
- Creating a patent arsenal
- Strengthening of position during negotiations



Budget

- Provisional patent application in country of origin (cost: USD 2,000 – USD 3,000)
- PCT (cost: USD 6,000 – USD 10,000)
- National Phase Entry filing fee and preliminary amendments (excluding prosecution)
- EPO USD 8 000
- Other countries: Average of USD 5 000



Certainty

A number of different strategies can be followed if certainty is required.

- Filing a United Kingdom (UK) Complete Application in the First Instance
- USA Filing in the First Instance
- File PCT as the first filing



Filing a United Kingdom (UK) Complete Application in the First Instance

- Cost: USD 7,000
- Get first search report after 3 months.
- Can make amendments and likely to get a 2nd search report before 1 year.
- May have certainty about obtaining a valid UK patent within 12 months.
- Can then follow the PPH and file in countries where protection is required.
- Alternatively 1st file a PCT application at the end of 12 months(cost: USD 6,000 – USD 10,000).
- For certain technologies can ask for accelerated examination, e.g. Green Tech (no additional cost).



Certainty – USA Filing

- As an alternative a 1st filing can also be made in the United States.
- Not as quick as the UK but should have a 1st examination report within 12 months.
- Can ask for accelerated search and examination (cost: USD 2,000).



PCT as first filing

- Get Search Report and IPRP
- Can abandon PCT and refile before publication
- Not always acceptable to investors
- But provides a good indication on novelty



Software

- Australia is more lenient and quick.
- USA is lenient but slower.
- EPO is not lenient but quicker than the US.

International search authority during PCT

- For software Australia is a good option.
- Austria provides a 75% discount on the search and examination fee for applicants from developing countries.
- EPO is fast but expensive.
- Benefit of EPO is large discount on search and examination fee if European patent application is filed.



General

- Normally various factors play a role and should be considered together.
- Various options should be discussed in some detail with client.



Thank You

- Questions?



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