



# **Topic 5: Strategy for Filing Patent Applications (Particularly at the International Level)**

National Intermediate Patent Drafting Course

Kuala Lumpur, Malaysia

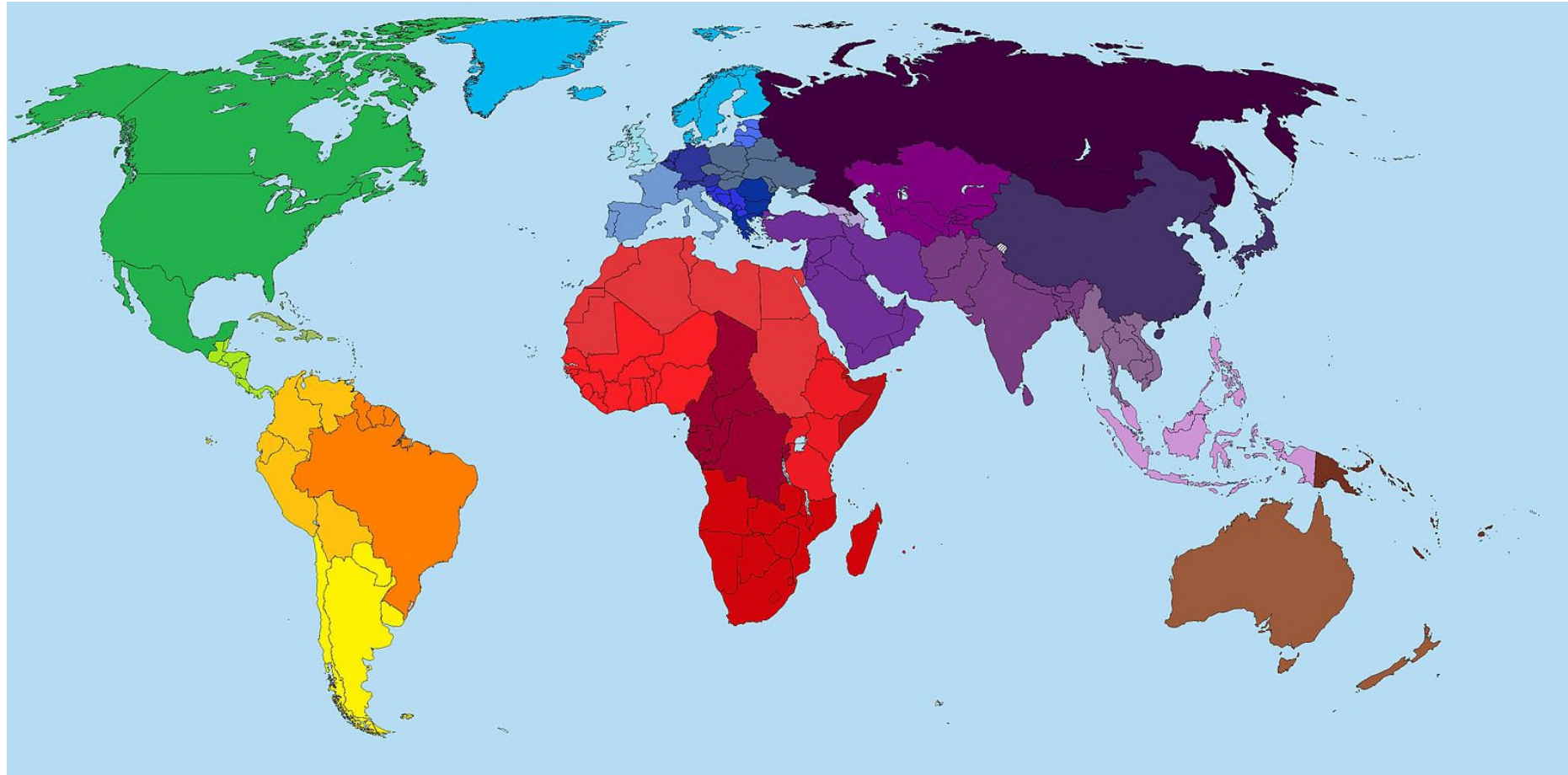
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**Where?**

Where to file?



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# The Malaysian start-up enterprise

- Assume you are the founder of a start-up company in Malaysia that produces a new and more efficient type of solar cells
- You have 5 great inventions, but only a budget of US-\$ 50,000 for patents
- If one filing costs about US-\$ 5,000 - would you rather
  - a) file only the 2 most important inventions, each invention in 5 countries, or
  - b) file all 5 inventions, each invention only in 2 countries?

## The Malaysian start-up enterprise (cont'd)

- Making decisions on where to file, is an expensive bet on the future
- In practice, the most important considerations are:
  - Product market – Where will the revenue be generated?
  - Production site – Where will the product be produced?
  - Competitor's locations – Where are the main competitors?
  - Enforcement – Which court system should handle infringement actions?

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**When?**



# When should an application be filed?

- Prior to any public (written/oral) disclosure of the invention
  - Many countries (including all EP countries) do not have grace periods that protect against prior disclosure
  - If you want to file globally, do not talk about your invention before the day you file the applications
- File early, but not too early
  - No need to wait for the final product
  - Usually, applications are filed on the basis of prototypes
  - No need to exhaustively test your invention

# When should an application be filed?

“My research team is meeting with a big company next week to discuss an investment and the option to start a new option. They want to learn about our new algorithms A and B before deciding on the investment”



- Is there an NDA in place?
- Has the client considered filing patent applications on A and B before the meeting?
  - Note that national filings are often inexpensive
- Make detailed notes of the meeting.



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How?

# First Filing Requirement



*“Malaysia first”*



# The Malaysian first filing requirement

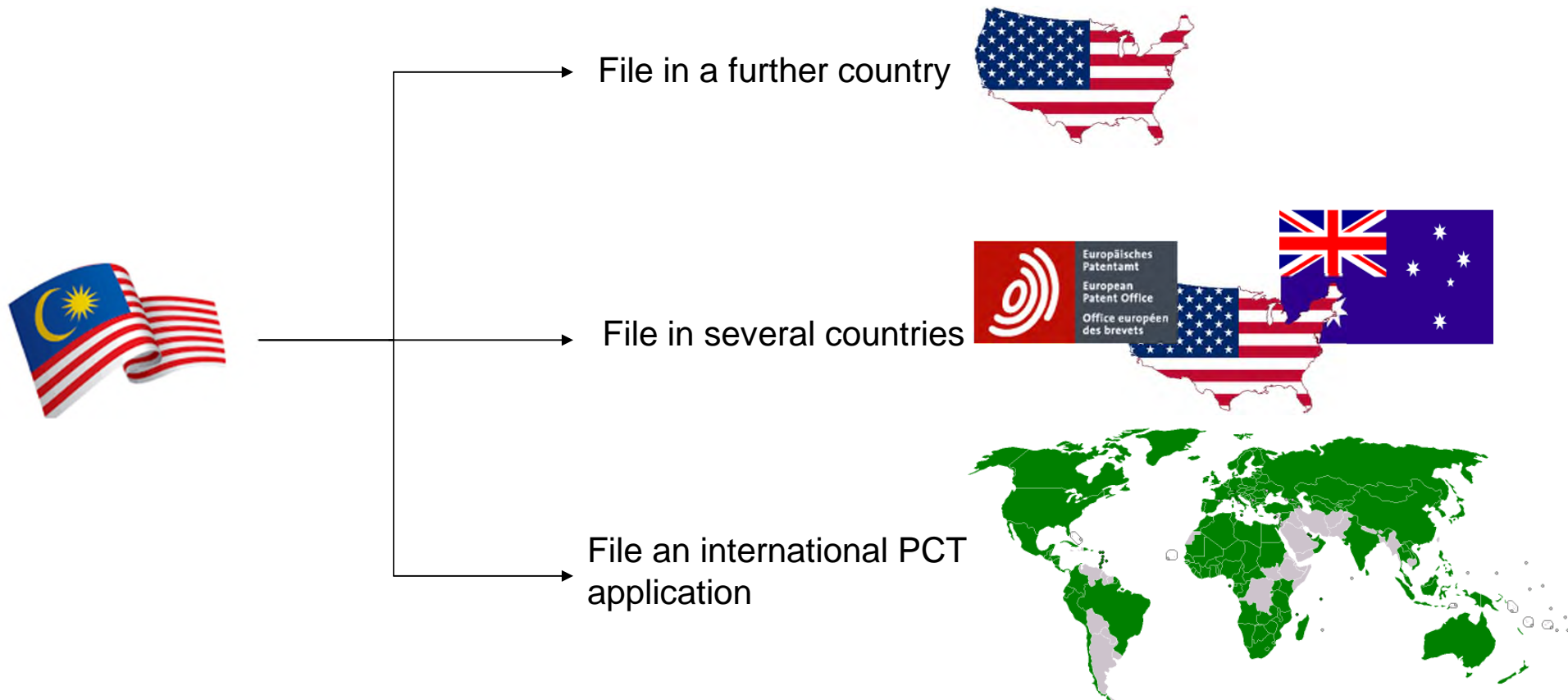


Matter	Comment
<b>Restrictions on First Filing</b>	No person resident in Malaysia shall file or cause to be filed an application for a patent outside Malaysia
<b>Exception 1</b>	A first patent application has been filed in Malaysia and a period of 2 months has lapsed without any prohibition on publication
<b>Exception 2</b>	Written permission to file overseas has been obtained in advance from the Registrar of Patents – so-called Foreign Filing Licence
<b>Qualifying person - interpretation of who is covered</b>	Natural or legal person, based on residence not nationality On a cautious interpretation, this provision extends to an inventor and not merely an applicant resident in Malaysia
<b>Application for Foreign Filing Licence</b>	Straightforward process, takes about 1~2 weeks Requirements: Name and address of applicant Name and address of inventor Country of proposed filing Title of invention Specification
<b>First Application via PCT</b>	May be filed with MyIPO as Receiving Office together with a request for written permission filing Filing via ePCT is not possible
<b>Non-Compliance</b>	Criminal offence, punishable by fine and/or jail sentence upon conviction

# Which routes to go?



- Typical: File nationally first, enhance within the 12 months priority period



# Alternatives



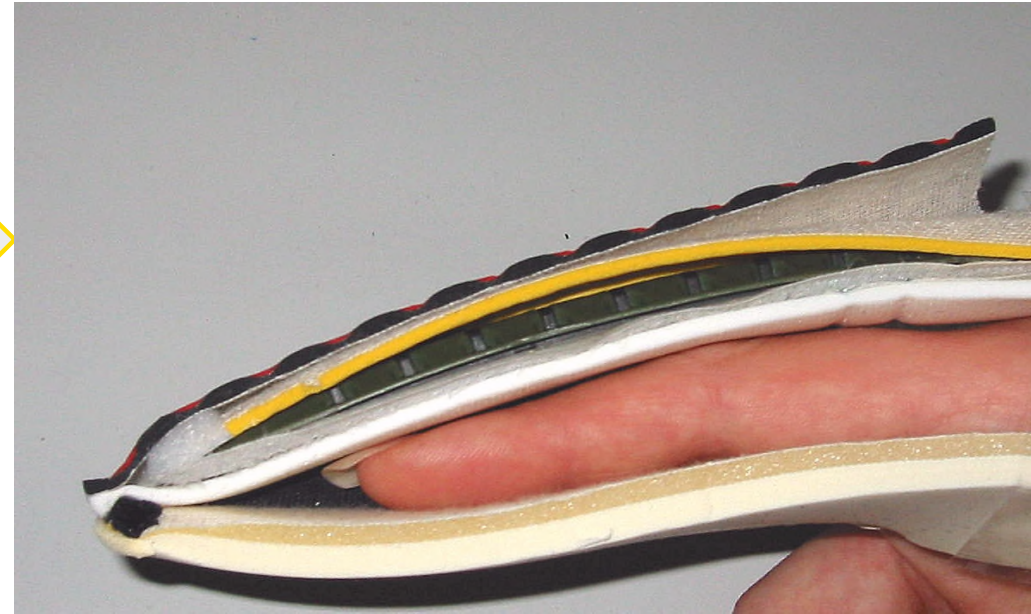
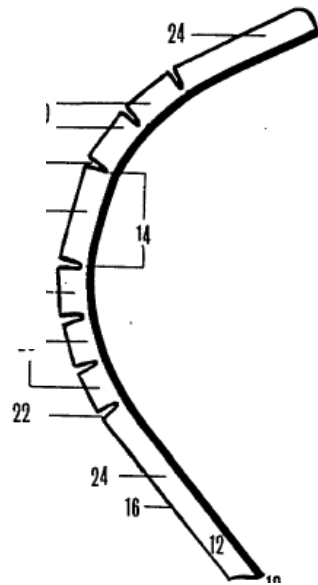
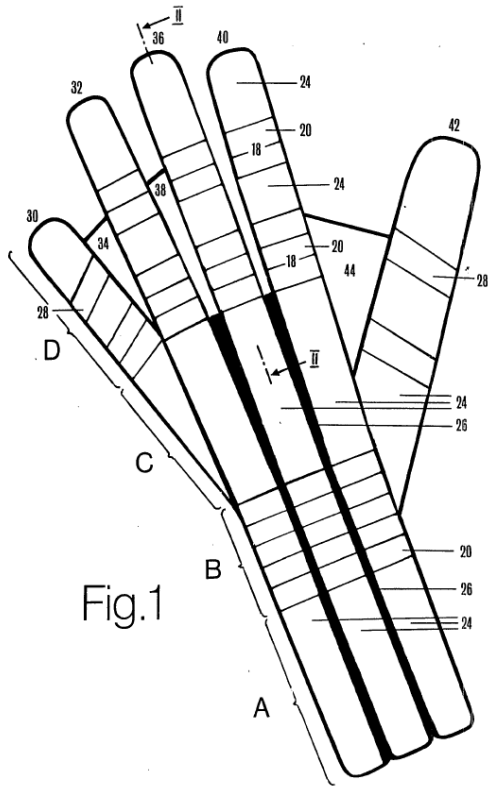
- Request Foreign Filing permission and file first in EP/AU/US/CN/...
  - Usually motivated by time and costs considerations
  - Think about filing in Singapore – search report after 60 days
- File PCT first (via MyIPO, including written permission)
  - Question: Is it then still possible to file a 2<sup>nd</sup> PCT application after 12 months?



## How to handle improvements

# Market developments are often unpredictable

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# Which options are available?

- Up to 12 months after 1<sup>st</sup> filing: File new application and claim priority
  - Domestic priority usually possible
- 12 to 18 months after 1<sup>st</sup> filing: Withdraw and re-file with improvements
  - Note: No entitlement to earlier priority date
- After 18 months:
  - Amend claims in pending application
    - Note that some jurisdiction – including EP – will not allow you to change direction
  - File a divisional application (in the US often: continuation application)



# What is a divisional application?



12 months



Claim 1: Glove



Claim 1: Glove



Claim 1: Glove

Claim 1:  
Reinforcement element

# Limits of Divisional Applications

- Usually only available until grant of the patent
  - Additional restrictions in some jurisdictions
- No added matter
- No extension of life time
  - Domestic priority usually possible
- Rather expensive in some jurisdiction
  - Annuities may be calculated back to the original filing date



**Thank you very much!**