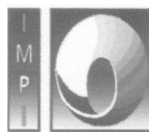


WIPO/INV/MTY/02/7

ORIGINAL:English

DATE:April2002



MEXICAN INSTITUTE OF
INDUSTRIAL PROPERTY



WORLD INTELLECTUAL
PROPERTY ORGANIZATION



INSTITUTE OF TECHNOLOGY AND
SUPERIOR STUDIES OF MONTERREY

**INTERNATIONAL WORKSHOP ON
MANAGEMENT AND COMMERCIALIZATION OF INVENTIONS
AND TECHNOLOGY**

organized by
the World Intellectual Property Organization (WIPO)
in cooperation with
the Mexican Institute of Industrial Property (IMPI)
and
the Institute of Technology and Superior Studies of Monterrey (ITESM)
Monterrey (Mexico), April 17 to 19, 2002

TECHNOLOGY MANAGEMENT EXPERIENCES AND LESSONS LEARNED
(RESPECTIVE PRACTICAL COUNTRY EXPERIENCE (USA))

*Document prepared by Mr. John H. Hornickel, Chief Intellectual Property Counsel,
Bridgestone/Firestone Americas Holding, Inc., Akron,
Ohio, United States of America*



Why Are We Here?

- Serve the Inventor *and* the Investor
- Promote the Progress of Arts and Sciences
- Build Borders Around Ideas



The Inventor

- Can Be Anyone, Anywhere
- Needs Legal Assistance
- Needs Time to Find The Investor



The Investor

- Needs Information
- Needs Results
- Needs Time to Decide



The Market

- Supply Seeks Demand
- Demand Seeks Supply
- Government Influences the Market
- But the Market Extends Across Governments
- New Products and Processes Form Markets



The Market (Continued)

- Needs Products and Processes
- Seeks Out New Products and Processes
- Needs Inventors and Investors to Make Available New Products and Processes
- Needs a Strong Patent System to Promote the Arts and Sciences



International Patenting Goals

- Excellent, Corroborated Records
- No Public Disclosures Until Application Filing Date
- Assistance of Patent Counsel
- Complete “Best Mode”, Enabling Patent Application in International Style
- Consistent Patent Prosecution in Each Country to be Protected



The Patent System

- A Government Grant
- Exchange of Rights for Information
- Limited Time Advantage in the Market
- Rewards for the Inventor and the Investor
- Each Government Has Its Own Patent System



The Patent System (Continued)

- Inventors and Investors Seek An Efficient, Strong Patent System
- A Patent System That Protects Inventors
- A Patent System That Informs Investors
- A Patent System That Forms Markets



Global Patent Decisionmaking

- Patent Cooperation Treaty (PCT)
- Regional Patent Offices
 - Europe
 - Eurasia
 - Africa (Two)
- National Patent Applications



PCT v. Other Routes

- **Pros:**
 - **Preserve the Option for Pursuing Patent Protection in 100+ Member Countries**
 - **Delays Costs for Filing Fees, Translations, and Associate Fees in Each Country**
- **Cons:**
 - **Can Add to Cost of Patent Protection**
 - **Can Extend Time to Obtain Patents**



Effective Patent Protection==

- Legal Considerations+
- Technical Considerations+
- Business Considerations



Invention Disclosure

- Summary of Problem
- Explanation of Solution
- Closest Prior Art
- Detailed Examples of Proof of Solution
- Facts, Not Opinions.
- Who was involved: Investigators vs. Inventors



Managing CostGrowth

- FilingCosts--IncludingTranslations
- ProsecutionCosts--IncludingIssueFeesand
DefendingOppositions
- AnnuityCosts--ProgressiveFee
ScheduleasPatentAges



Filingand MaintenanceCriteria

- UltimateQuestion--Willthe *patent* provide
effectiveprotection thatwarrantsthe *futurecost*
ofobtainingandmaintainingit?



Consolidated Checklist

1. Forecasted Sales > \$5,000,000
2. Where Competitors Manufacture
3. Whether Competitors are National or Multi-National
4. Willingness to Enforce Patents
5. Patentability of Subject Matter
6. Ability to Detect Infringement



Consolidated Checklist Continued

7. Whether a valuable product differentiation feature is being protected
8. Estimate of the product/technology lifecycle.
9. Whether patent licensing is anticipated.
10. Relative difficulty of designing around claimed product feature.



**Total Projected Costs of
Bednarik's List* Using *Global P. Estimator***

1. USA	\$18,000
2. India	4,000
3. United Kingdom	10,000
4. Canada	6,000
5. Japan	23,000
Germany	24,000
Brazil	9,000
8. France	14,000
9. South Africa	6,000
10. Australia	10,000

*Bednarik, "Planning a Global Patent Strategy to Maximize Value" *JPTOS* Vol. 77, No. 5, Pages 381-390 (May 1995)



That is Why We are Here!!
Thank you.



BRIDGESTONE/FIRESTONE

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