



Filing a Patent Application

Who, When, Where, What and Why

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Why file a patent application?

- Reputation
- Licensing income
- To protect against copying
- To attract investment
- Leverage against 3rd party patents

What can be protected by a patent application?

Wide variety of things can be patented as long as they are

- New
- Industrially applicable (e.g. useful)
- Inventive

Can be a product (apparatus), method (process), use

What can be protected by a patent application?

In some countries, there are exceptions to patentability:

For example, the following inventions are excluded:

- Inventions against ordre public (e.g. landmines)
- Diagnostic, therapeutic and surgical methods
- Plants, animals and biological process for producing plants and animals
- Discoveries, scientific theories and mathematical methods
- Aesthetic creations
- Business methods
- Computer programs

When to file a patent application?

- Before any public (written/oral) disclosure
- Some countries have grace periods that protect against prior disclosure
- But most countries do not have grace period

→ If you want to file globally, do not disclose your invention publicly before the day you file your patent application

When to file a patent application?

Watch out for situations where:

- The inventor(s) are attending a conference and giving a talk
- The inventor(s) are submitting an article for publication
 - If the subject matter should be protected, file an application immediately
 - Get a copy of the manuscript/article
 - Discuss what will be disclosed
- The inventor(s) are meeting with a company/other parties
 - Is an NDA in place?
 - Consider filing an application before the meeting
 - Make detailed notes of what was discussed at the meeting

When to file a patent application?

File early, but not too early

- No need to wait until the product is finalized
- Can file an application on the basis of prototypes
- No need to exhaustively test your invention
- But good idea to file when you have data

Who can file a patent application?

- Depends on national law
- Distinction between inventor and applicant

Inventor

- Natural person(s) who conceive the invention

Applicant

- Natural or legal person(s) that own the application/patent

Who can file a patent application?

The inventor

- Usually the person who contributes to the claims of an invention
- There may be multiple inventors (joint or co-inventors)
- Often complete set of inventors will not be known until the claims are drafted

- Must be natural persons

Who can file a patent application?

The applicant

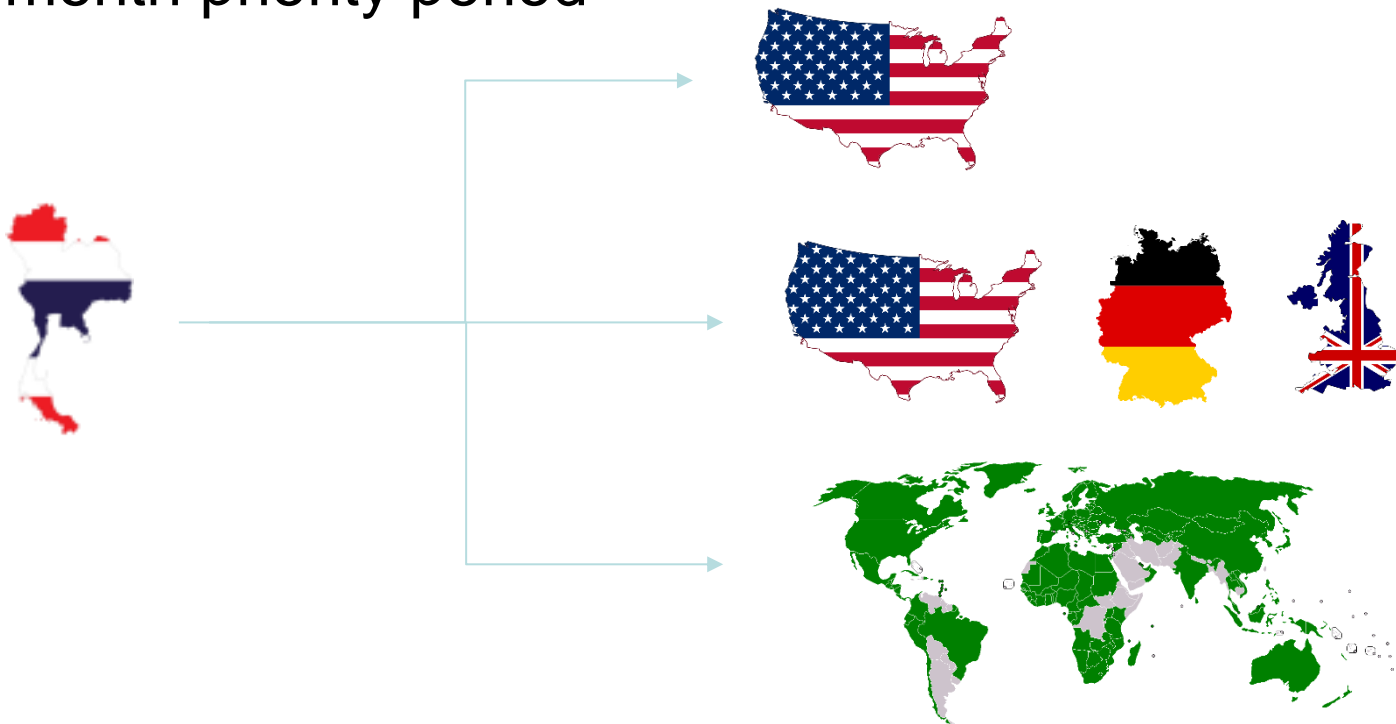
- In most jurisdictions, right to a patent belongs to the inventor or his successor in title
- Most patents are filed by companies, research organizations, etc.
- All natural or legal entities
 - Individual inventor(s)
 - Company
 - University
 - Research institution
 - Government
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Where to file a patent application?

- Depends on national law and the applicant's strategy
- National law
 - Some countries (US, CN) require that the application is filed there if the invention was made in that country
 - Other countries will not have such restrictions unless the invention relates to military technology or national security (UK, Germany)
- Applicant's strategy
 - Single filing or multiple filings
 - How much resources are available?
 - Is the prior art known?

Where to file a patent application?

- Generally: first national filing, then further filing within the 12 month priority period



Where to file a patent application?

Practical points

Consider the following questions to evaluate where an application should be filed:

- Product market – where will the product be sold/method used?
- Production site – where the product be produced/method used?
- Competitor's location – where are the main competitors production sites/markets?
- Enforcement – which courts will handle infringement actions?

Practical Points

- Information mining (1)
 - Use an information disclosure form

Practical points

- Information mining (2)

- Important to understand the commercial background of the invention

Consider the following points:

- What will the patentee sell?
- What does the patentee make?
- What aspect of the invention will be licensed?
- What might third parties do/design arounds?

Thank you!

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