IP MANAGEMENT CHALLENGES IN OPEN INNOVATION ENVIRONMENTS

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Defensive Publication
Indispensable Tool for IP-Managers
IP-Managers do often ask if IP-protection is the only "true way" of satisfying the needs of their companies.

It is correct, that IP-protection for patents, designs and trademarks are useful to improve the position of companies in the market. However IP-rights provide only a right to stop others doing businesses in the protected areas.

These rights - at least from their filing days - do however not protect the companies from being attacked by foreign IP-rights. That means that IP-rights can only be used for a defense against competitors in a limited manner. Defensive publications fill an important gap and at the same time ensure that inventors will not be taken by surprise through late comers in the same field. The speaker will shade light on various types of defensive publications and on the worldwide practice of Defensive Publishers and IP-Offices.
Practical Example:

Creative department of a worldwide active advertising company
WE NEED A NEW GADGET TO SATISFY OUR CLIENTS NEED

WHAT SHALL WE DO?
Practical Example.

SOLUTION – IDEA!
HAND HELD VENTILATOR
Practical Example:

For this Example:
Assume today ventilators are known per se but hand held ventilators are not known in the prior Art.

1) How long will it take from today to find our great idea in our clients markets?
   How much manpower? 6,8,10,12,24… months?

2) Do we want to keep our idea secret until publication? YES/NO

3) Shall we file patent application? YES/NO

4) Are we the only one creative department who work on such ideas at this time? YES/NO
For this example assume, our decision was: Don’t file patent applications.

Reason: Too costly and the gadget will be only of short interest in the market.

CAN COMPETITORS EVENTUALLY STOP US, AFTER WE FINISHED OUR DEVELOPMENT AND ENTERED THE MARKET?-------
-If they file patent/utility mod./design application tomorrow? YES/NO

Would then our costs be sunken? YES/NO
Practical Example.

For this example assume, the Competitors not only will file patent/utility mod./design application tomorrow, but they will file an application for an even improved gadget.
No defensive publication: late coming competitor may stop client
Defensive publication field by client earlier may stop competitors patent
Example EPC

European Patent Convention (EPC):

Some main requirements for patents:

Novelty and Inventive step (non obviousness)
Relevant Points of Law.

Article 54\textsuperscript{42, 43}
Novelty

(1) An invention shall be considered to be new if it does not form part of the state of the art.

(2) The state of the art shall be held to comprise everything made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing of the European patent application.

(3) Additionally, the content of European patent applications as filed, the dates of filing of which are prior to the date referred to in paragraph 2 and which were published on or after that date, shall be considered as comprised in the state of the art.

Article 56\textsuperscript{48}
Inventive step

An invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art. If the state of the art also includes documents within the meaning of Article 54, paragraph 3, these documents shall not be considered in deciding whether there has been an inventive step.
Pat. appl. are secret until they are published (max. 18m)

Any publications earlier than patent applications may destroy the novelty or show lack of inventive step of the claimed invention.

Different patent applications filed in timely vicinity to each other with identical content influence each other in view of novelty (only).

Patent applications filed in timely vicinity to each other may have patent claims with different (but similar) content and may hence be validly granted, even if the earlier application takes away most of the features of the later claims.
Relevant Points of Business interest.

Relevance of IPR if:

\[
\frac{\text{Cost of Imitation and Replication}}{\text{Cost of Invention}} < 1
\]

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If costs for copying of a new solution are smaller than R&D of the same solution, then the party bearing the R&D-costs has a problem in view of return of investment!
Relevant Points of Business Interests.

If costs for R&D of a new solution are significant and other party get patent protection, then the party bearing the R&D-costs has a problem (lost R&D costs).

If costs for R&D of a new solution are significant and other party can copy freely, then the party bearing the R&D-costs has a problem (R&D costs in price calc.).

Similar Companies work on similar solutions at about the same time.

The later patent filer has often the better solution, because they often worked longer on R&D.
Definitions of Terms.

Defensiv!? Publication??
Definitions of Terms.

Publication is (was) publicly available Information
Examples:
- Newspaper
- Journal
- Book
- Doctor Theses
- Accessible Internet homepage
- Searchable database content
- Presentation in public, prior use in the public

Defensive Publication = Protective Publication
is (was) a publication with the intention to protect the publisher against later third parties IP-rights.
Examples:
- BOSCH Show Case in Stuttgart Feuerbach
- FirsttoDisclose.org (US-University Service)
- Utility Model application (Patent Offices)
- IP.com (US Commercial Service)
- Prior Art Disclosure (German Commercial Service)
- PROTEGAS.com (European Commercial Service)
- Research Disclosure Questel Ireland (Commercial Service)
Definitions of Terms.

Official Confirmation of Publication by German Patent Office

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**BUNDESREPUBLIC DEUTSCHLAND**

**DEUTSCHES PATENTAMT**

**Gebrauchsmuster**

**U1**

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Hauptklasse A01D 87/10
Anmeldetag 30.11.79

Eintrügungstag 30.04.81 Bekanntmachungstag in Patentblatt 11.06.81

Bezeichnung des Gegenstandes
Saugeinrichtung für das Entfernen von Laub, Mähut o.del.

Name und Wohnsitz des Inhabers
Wiedemann GmbH, 7901 Raminigen, DE
Definitions of Terms.

Official Confirmation of Publication is a Confirmation by an Independent State Office

Confirmation of availability

Lee Huber
Alte Landstrasse 3
9496 Balzers
Liechtenstein

Date: 28.10.2013

Liechtensteinische Post AG herewith confirms that the following publication has been found by entering the listed search terms at the said date on www.protegas.com and could be inspected.
Definitions of Terms.

Jones

[54] OPTICAL ALIGNMENT TOOL
[75] Inventor: Lee E. Jones, Richmond, Vt.
[73] Assignee: International Business Machines, Armonk, N.Y.
[21] Appl. No.: 378,979
[22] Filed: May 17, 1982
[51] Int. Cl. .......................... C01B 11/00
[52] U.S. Cl. .......................... 356/153

ABSTRACT
An optical alignment tool and method is described for setting a datum line in a copier. The datum line is used as the reference for aligning a plurality of copier components. The alignment tool includes a light source fixedly mounted to an adjustable support which is positioned at one end of the datum line. A cross-hair target comprising of two mutually perpendicular lines is attached to a fixed support at the other end of the datum line. The orientation between the fixed support and the adjustable support is such that when the light beam is positioned at the centerpoint of the cross-hair target, the datum line is established. The adjustable support is locked into place. The light source and target are removed and replaced with the copier components. Also disclosed is a calibration master "jig" for calibrating the light source. The jig includes a cross-hair target of two mutually perpendicular lines disposed at one end. The light source is mounted at the opposite end of the jig. The light source is adjusted until the beam is centered on the cross-hair target. The adjustable section of the light source is first locked into place and the light source is removed from the jig.

8 Claims, 4 Sheets Drawing.
15 Pages Specification

The file of this unexamined application may be inspected and copies thereof may be purchased (849 O.G. 2221, Apr. 9, 1968).
Similar Inventions protected by IP’s.

1st. Patent application A+B+C

2nd. Patent application A+B+C+D

A=hole for axle, B=rim, C=tread; D=tread made from rubber
Later filed patent application of client lacks novelty against earlier filed patent application of competitor (EPC Art54(3))
a) Defensive Publication field by client earlier may stop competitors patent if it is brought to the attention of Examiner.

b) Later filed patent application of client will lose also in most cases against its own earlier defensive publication in Europe.

c) However but not in USA or JP and not for utility models in DE or AT (grace period).

d) However but not, if defensive publication (according to a) is not known/invoked. In such situations client wishes to have a legally accepted/confirmed publication not known to competitors/Examiners.
Later patent application of competitor with improved content may block further development of clients product/device/process.
Later patent application of competitor with improved content may block further development of clients product/device/process.

However earlier defensive publication of client might stop later filed patent of competitor (EPC Art.56), without harm to clients earlier filing.
Time Line Bar by Defensive Publications.

1. Idea
2. Patent application filed by client
3. Foreign filing
4. Patent Office Publication by competitor

- Client + DP
- DP/DP
- Comp. A
- Comp. B
- Comp. C
- Comp. D
- DP 1
- DP 2

*1 novelty destroying (in Europe) unless not cited. Not novelty destroying in US (Grace period)
*2 prior Art against ABCD check for inventive step
*3 does not harm client and A
*4 client can stop B
*5 client can stop C

B will win on A+B+C+D over client and A unless 1st or 2nd DP invoked and ABCD has lack of inventive step
B will lose because client invoked Patent of A+B+C, unless 1st in motion
C might win on A+B+C+D over client and A unless 1st or 2nd DP invoked and ABCD has lack of inventive step however Patent will be destroyed because lacking novelty over B.

A+B+C+D:
- Published
- Patent application filed
- Foreign filing
- Patent Office Publication

A+B+C:
- Published
- Patent application filed
- Foreign filing
- Patent Office Publication

A+B:C:
- Published
- Patent application filed
- Foreign filing
- Patent Office Publication

A+B:
- Published
- Patent application filed
- Foreign filing
- Patent Office Publication

A+B:
- Published
- Patent application filed
- Foreign filing
- Patent Office Publication

A:
- Published
- Patent application filed
- Foreign filing
- Patent Office Publication

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Time Line Bar by Defensive Publications

- Idea
- Patent application filed by client
- Foreign filing
- Patent Office Publication

Client + DP
- Patent application filed by competitor
- A will win, unless 1st DP invoked

Comp. A
- Patent application filed
- A + B + C
- A + B + C + D
- B will win on A + B + C + D over client and A unless 1st or 2nd DP invoked and ABCD has lack of inventive step
- B will lose because client invokes Patent of A + B + C, unless 1st DP is invoked (Europe)
- *1

Comp. B
- Patent application filed
- A + B + C + D
- A + B + C + D veröffentlicht
- C might win on A + B + C + D over client and A unless 1st or 2nd DP invoked and ABCD has lack of inventive step however, patent will be destroyed because lacking novelty over B.
- *2

Comp. C
- Patent application filed
- A + B + C + D
- A + B + C published
- D will lose against all
- *3

DP 1
- novelty destroying (in Europe) unless not cited. Not novelty destroying in US (Grace period)
- *1

DP 2
- does not harm client and A
- prior Art against ABCD check for inventive step
- *2
- client can stop B
- *2
- client can stop C
- *2
Examples of Pages Related to Defensive Publication
Examples of Pages Related to Defensive Publication

BLIP Clinic
FirsttoDisclose.org

FirsttoDisclose.org is a community-powered online repository for inventors to disclose their inventions to the public. The use of FirsttoDisclose.org may help prevent another person or entity from claiming patent protection on your idea. While we understand and fully support the commercialization of intellectual property in our information economy, we also applaud those who are willing to make their innovations open to the public without charge.

Submit Disclosure

US-University tool free access available
Examples of Pages Related to Defensive Publication.

IP.com is a global leader in intellectual property management. It is our mission to connect today’s innovators, IP professionals, industries and academic leaders to a vast array of patent and non-patent literature. The world’s most innovative corporations entrust IP.com with defensive publication through IP.com’s Prior Art Database: an industry-recognized go-to source for patents examiners and searchers worldwide. Searching becomes discovery via the interconnected world of intellectual property at IP.com.

Biggest/oldest online tool, however without independent official confirmation.
Examples of Pages Related to Defensive Publication.

Questel is one of the biggest/oldest search-platform providers.
Examples of Pages Related to Defensive Publication.

• Inventions
• Technical teachings

• Designs
• Methods

• Utility models and registered designs
• Works of authors and artists

2. Publish innovation online or in the technical library

PROTEGAS offers to consider online and/or paper publications for having broader/different accessibility.
Examples of Pages Related to Defensive Publication.

- Inventions
- Technical teachings
- Designs
- Methods
- Utility models and registered designs
- Works of authors and artists

Watch out for independent confirmation to increase reliability in later disputes.
**Examples of Pages Related to Defensive Publication.**

<table>
<thead>
<tr>
<th>Inventions</th>
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</table>

PROTEGAS offers user account for managing/retrieving ones publications and user account for searchers.
Use of Defensive Publications by Patent Offices.

The EPO does search defensive prior Art databases, if the database providers offer a free access to the EPO.

IP.com and Prior Art Publishing do offer such free access to the EPO.

The Boards of Appeal of the EPO have decided in the famous decisions around the “test case” filed by AKZO, DSM, PHILIPS, SHELL in re of Internet-publications. (T1553/06 and T002/09)

SIPO and Chinese Courts are still more liberal today. They even accept publications on a single Internet URL for a single day, even if the URL as such was not publicly known.

In US the defensive publications play a smaller role, as the grace period of 12 months does allow inventors to freely publish their inventions before filing a US-Patent application.
Future Patent-Protection Environment.

Interest: Worldwide
Development of filing numbers of patent applications 2014 vs 2013

Example PCT:

Huawei Technologies Co., Ltd (CN) saw the largest growth in PCT-filings, with 1,332 more applications published than in 2013 (an increase of 63.1%), Tencent Technology (Shenzhen) Company Limited (CN) saw the second largest growth with 727 more (202.5% increase), followed by Microsoft Corporation (US) with 652 more (80.7% increase).

Among the top 10 PCT-countries, China was the only one to see double-digit growth in PCT filings in 2014, with an increase of 18.7%. The United Kingdom recorded the second fastest growth (+9%), followed by the United States of America (+7.1%).

In 2014, the use of the PCT continued to grow, with approximately 215,000 PCT applications filed. This represents a 4.5% increase over 2013. Source: WIPO
Thank You!

I further thank PROTEGAS AG for supporting me with materials.