

PATENTBÜRO PAUL ROSENICH AG

PATENTS

TRADEMARKS

DESIGNS

LICENSES



Bureau
d'économie
théorique
et appliquée
(BETA)
UMR 7522



I³PM

International Institute for IP Management



IP MANAGEMENT CHALLENGES IN OPEN INNOVATION ENVIRONMENTS

Strasbourg, March 23, 2015

FSEG
STRASBOURG



Faculté des sciences
économiques et de gestion

UNIVERSITÉ DE STRASBOURG



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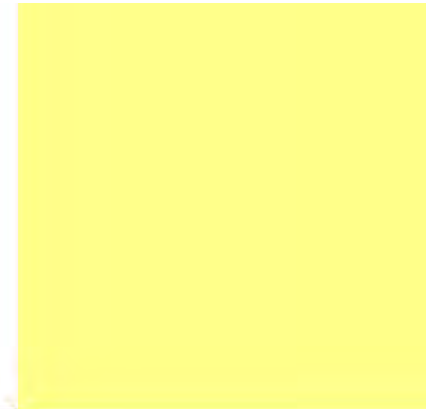
I³PM

International Institute for IP Management



Paul Rosenich (I3PM, CEIPI, epi)

Defensive Publication Indispensable Tool for IP-Managers



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

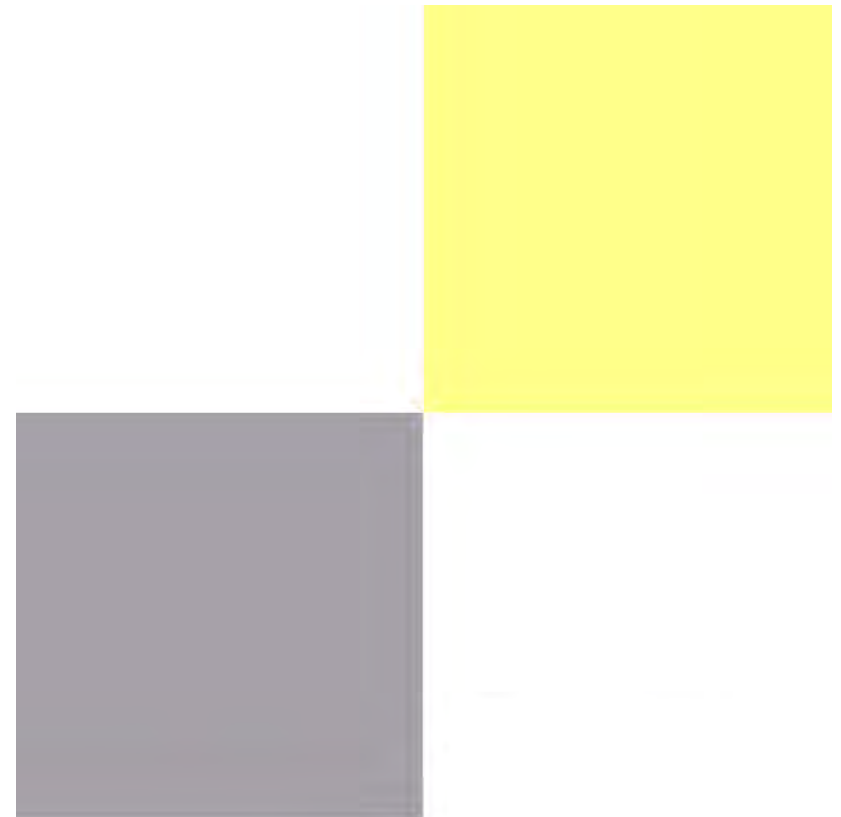
It is correct, that IP-protection for patents, designs and trademarks are useful to improve the position of companies in the market. However IP-rights provide only a right to stop others doing businesses in the protected areas.

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?

SOLUTION – IDEA! HAND HELD VENTILATOR



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?

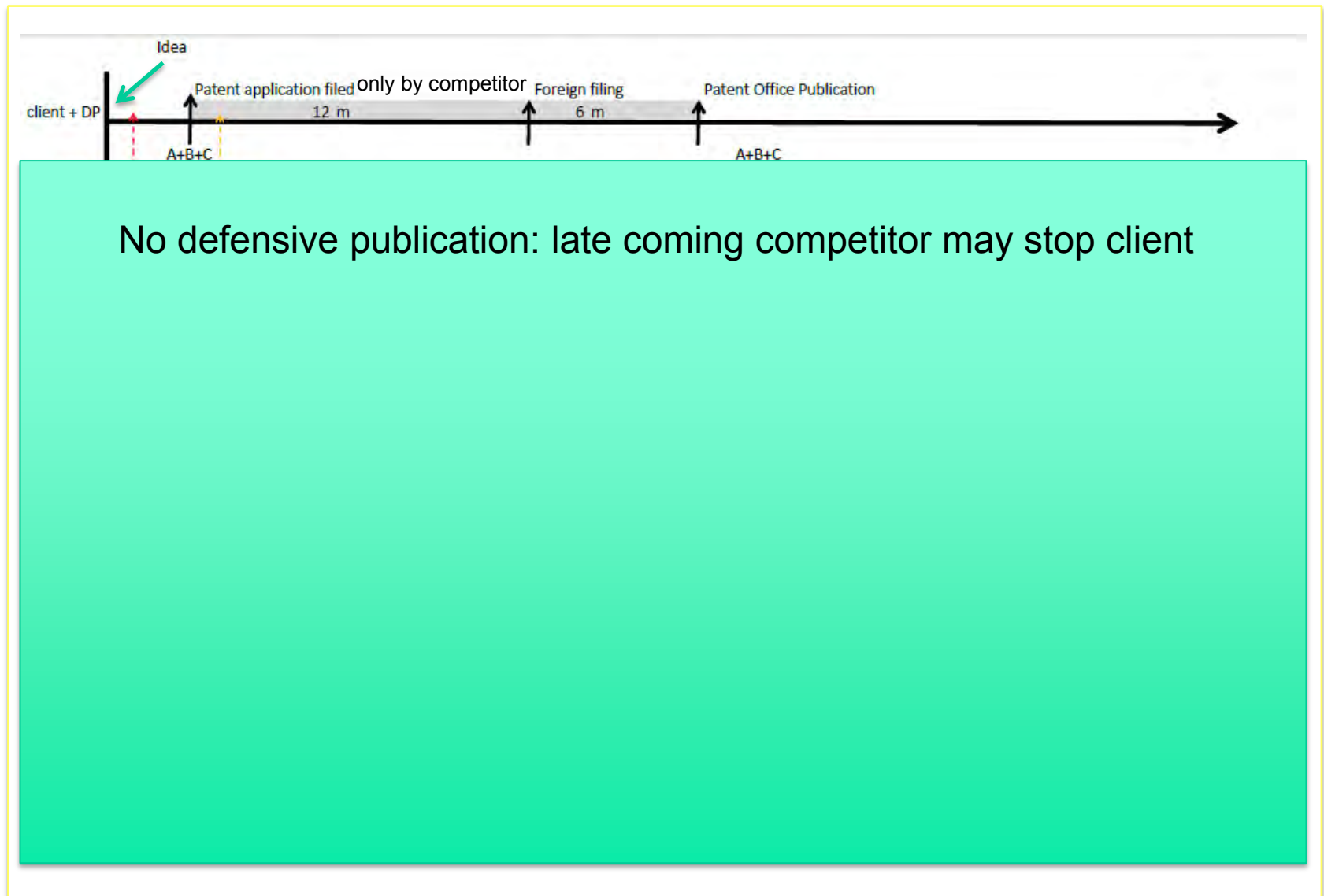
YES/NO

Would then our costs be sunken? YES/NO

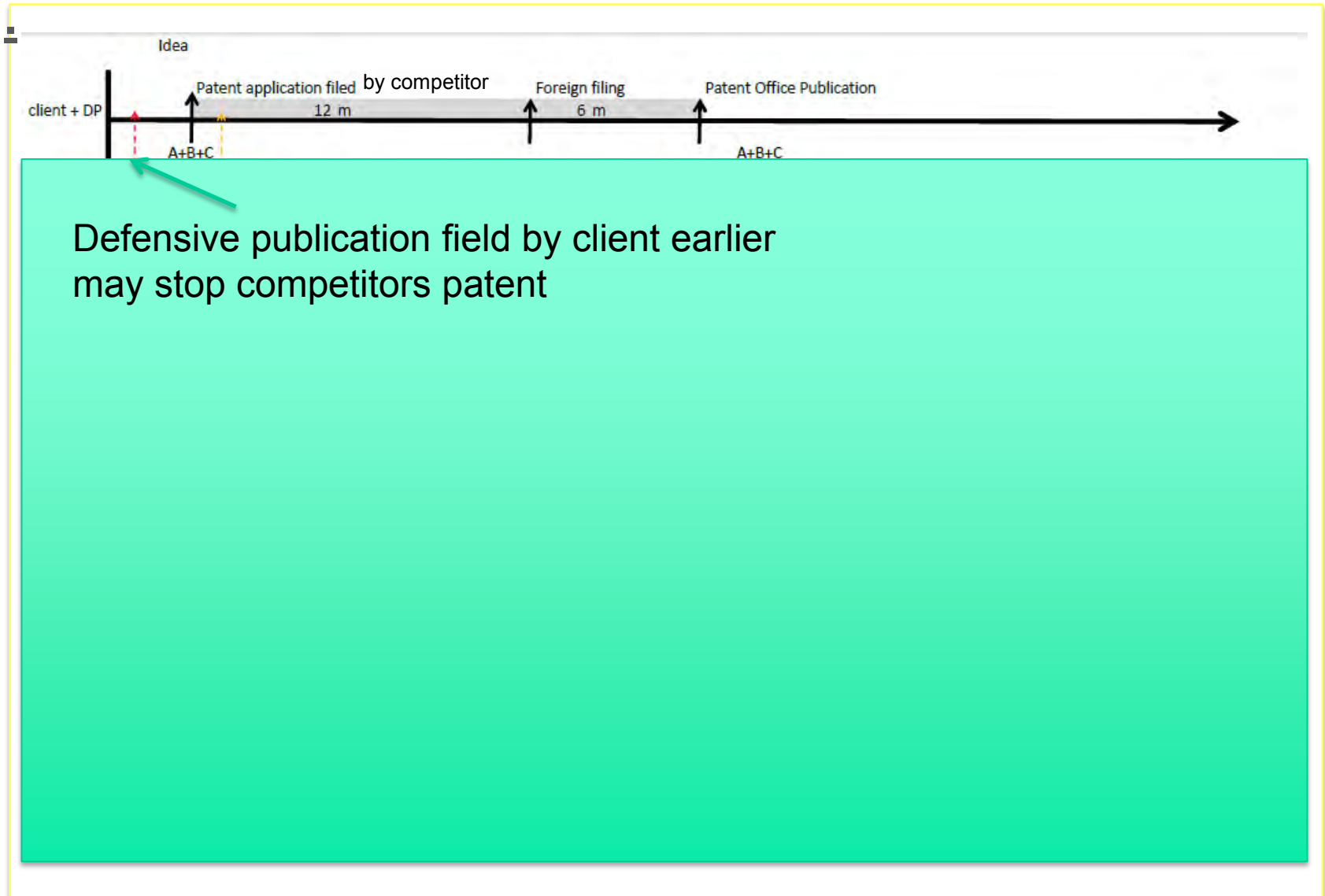
For this example assume, the Competitors not only will file patent/utility mod./design application tomorrow, but they will file an application for an even improved gadget



Time Line Bar by Defensive Publications .



Time Line Bar by Defensive Publications .



Example EPC

European Patent Convention (EPC):

Some main requirements for patents:

Novelty and Inventive step (non obviousness)

Article 54^{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 56⁴⁶

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.

Relevance of IPR if:

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

© 2004-07 STI-IPM, Munich, Prof. Dr. Alexander J. Wurzer

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)

IBM Technical Disclosure Bulletin (1958-1998)

IP.com (US Commercial Service)

Prior Art Disclosure (German Commercial Service)

PROTEGAS.com (European Commercial Service)

Research Disclosure Questel Ireland (Commercial Service)

US Defensive Publication (1968-1985)

⑩ BUNDESREPUBLIK DEUTSCHLAND



⑫ **Gebrauchsmuster**

U 1

Official
Confirmation of
Publication by
German Patent
Office

⑬
Rollennummer 6 79 33 024.2

Hauptklasse A01D 87/10

Anmeldetag 30.11.79

Eintragungstag 30.04.81 Bekanntmachungstag im Patentblatt 11.06.81

Bezeichnung des Gegenstandes
Saugvorrichtung für das Entfernen von Laub,
Mähwerk e.dgl.

Name und Wohnsitz des Inhabers
Wiedemann GmbH, 7901 Rommelsen, DE

Definitions of Terms .



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

POST
Bestätigung, Verfügbarkeit

protegas
protective publication service

Lee Huber
Alte Landstrasse 3
9496 Balzers
Liechtenstein

Date: 28.10.2013

Confirmation of availability

POST
protegas
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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.

United States Defensive Publication [1970] (11) T109,201
Jones [43] Jul. 5, 1988

[54] **OPTICAL ALIGNMENT TOOL**

[75] **Inventor:** Leo E. Jones, Richmond, Va.

[73] **Assignee:** International Business Machines, Armonk, N.Y.

[21] **Appl. No.:** 378,979

[23] **Filed:** May 17, 1982

[51] **Int. Cl.:** _____ CSIC 11/40

[52] **U.S. Cl.:** _____ 356/153

[57] **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 secured 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.

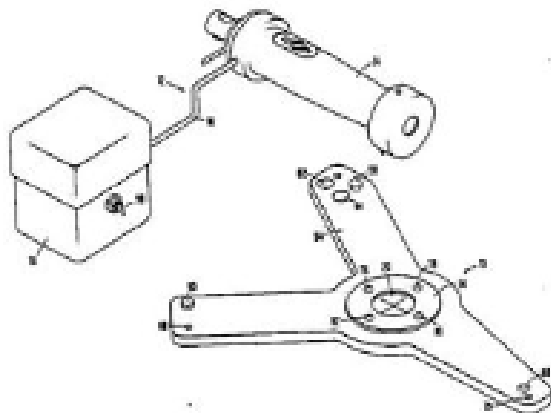
Also disclosed is a calibration master "jig" for calibrating the light source. The jig includes a cross-hair target of two mutually perpendicular lines disposed at one end. The light source is mounted at the opposite end of the jig. The light source is adjusted until the beam is centered on the cross-hair target. The adjustable section of the light source is first locked into place and the light source is removed from the jig.

3 Claims, 4 Sheet Drawing.

18 Page Specification

This file of this referenced application may be reviewed and copies thereof may be purchased (845 O. O., 222), Apr. 9, 1988)

Official
 Confirmation of
 Publication by US-
 Patent Office



Similar Inventions protected by IP's .

1st. Patent application A+B+C 2nd. Patent application A+B+C+D

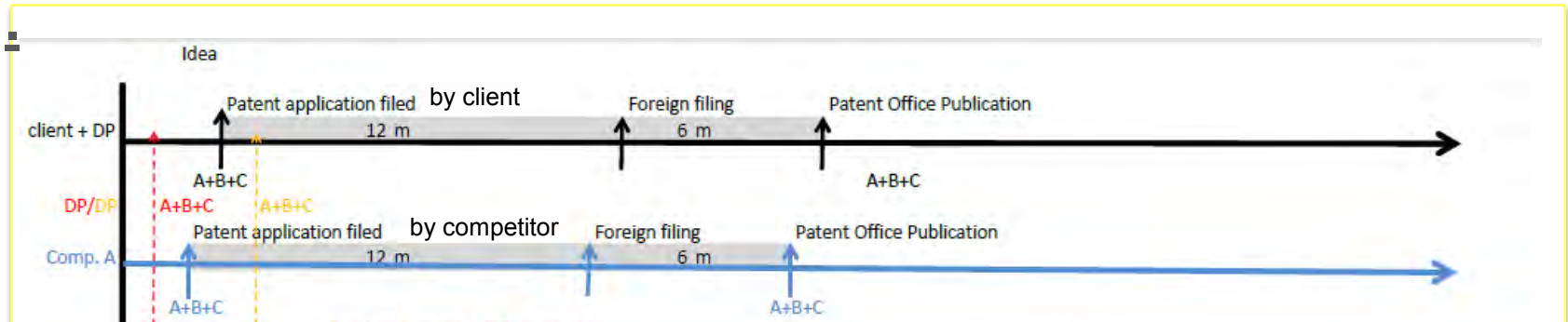


A=hole for axle, B=rim, C=tread;



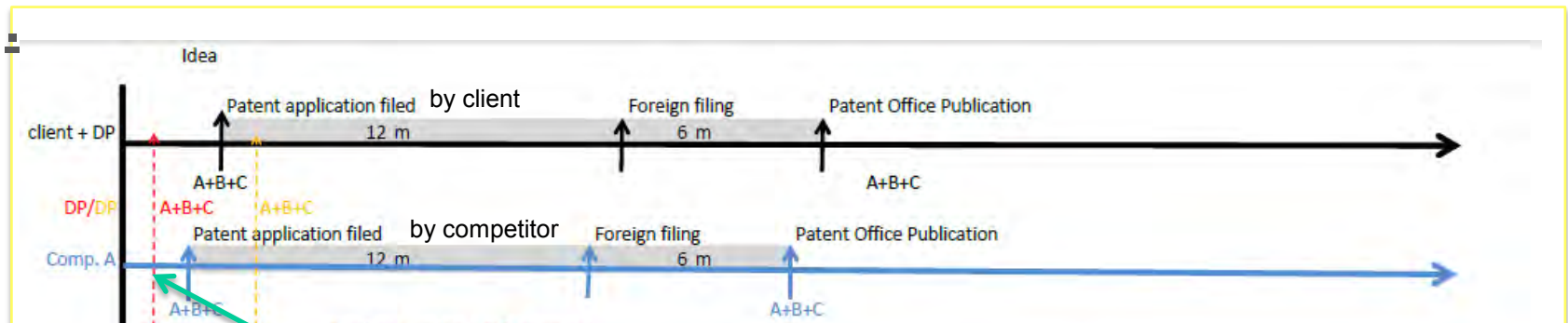
D=tread made from rubber

Time Line Bar by Defensive Publications .



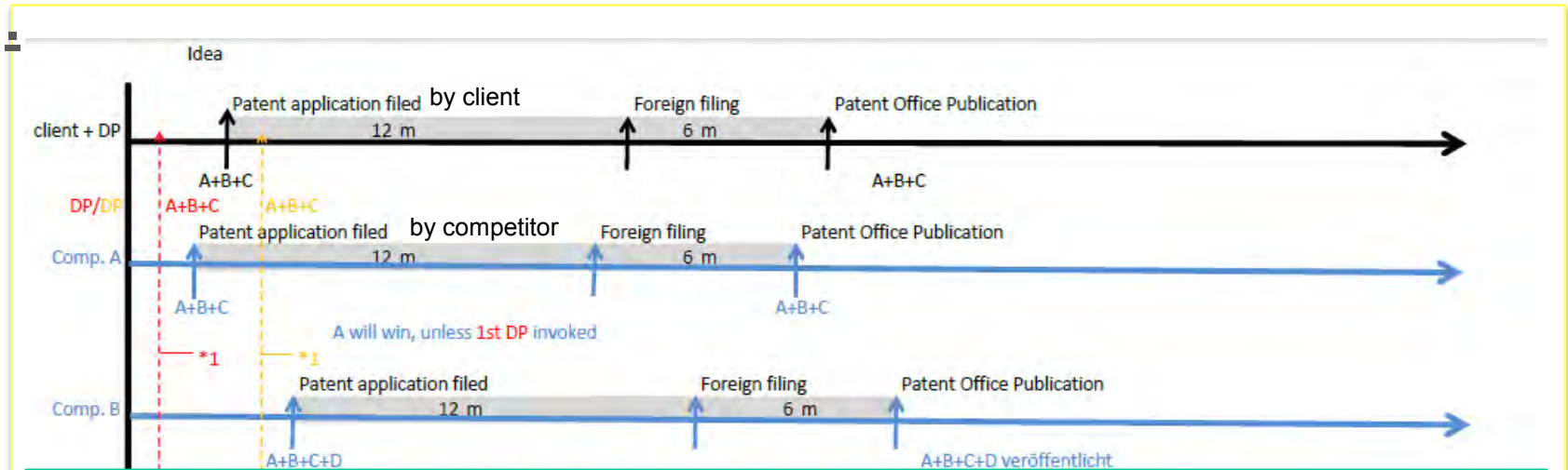
Later filed patent application of client lacks novelty against earlier filed patent application of competitor (EPC Art54(3))

Time Line Bar by Defensive Publications .



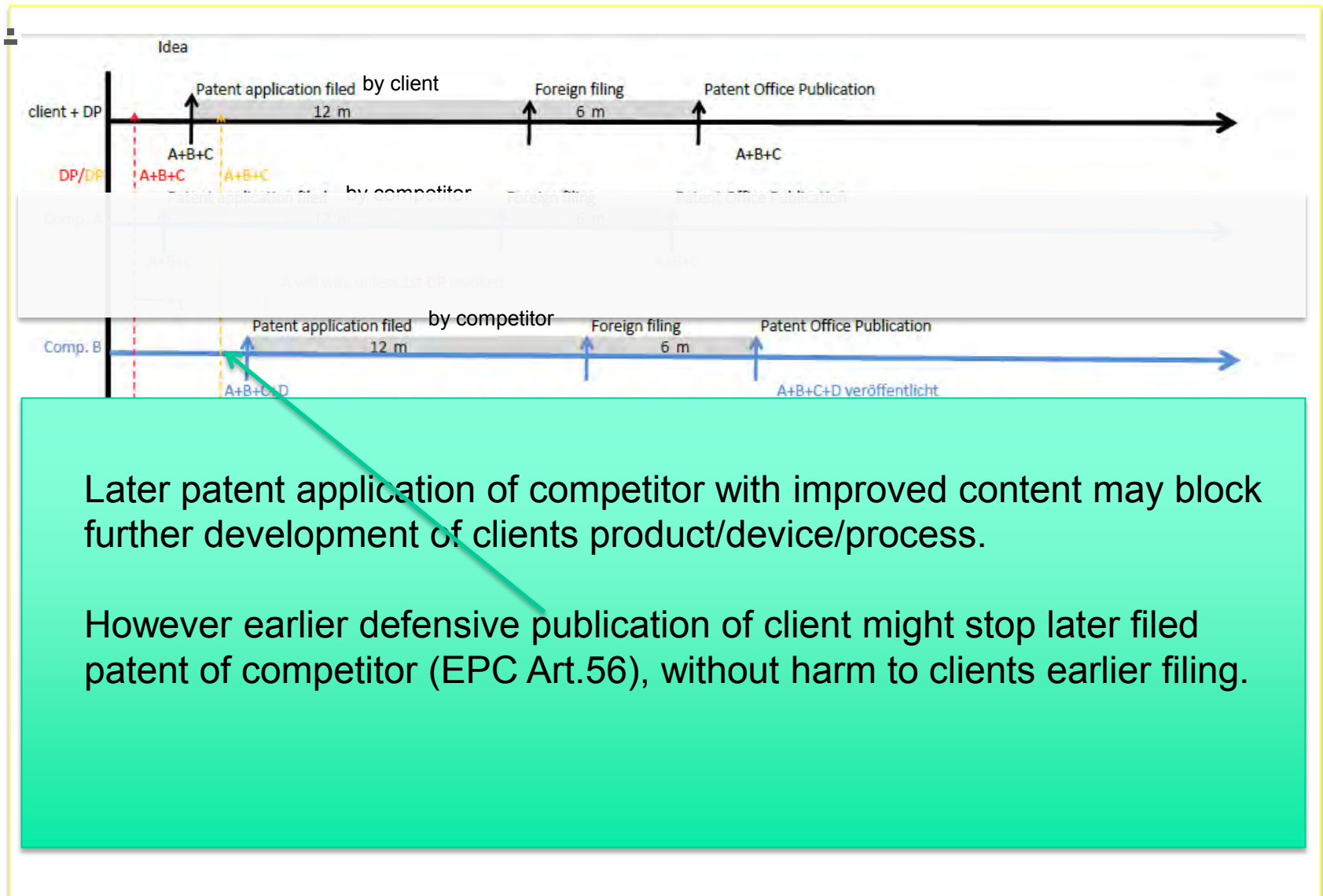
- a) Defensive Publication filed by client earlier may stop competitors patent if it is brought to the attention of Examiner.
- b) Later filed patent application of client will lose also in most cases against its own earlier defensive publication in Europe.
- c) However but not in USA or JP and not for 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.

Time Line Bar by Defensive Publications .



Later patent application of competitor with improved content may block further development of clients product/device/process.

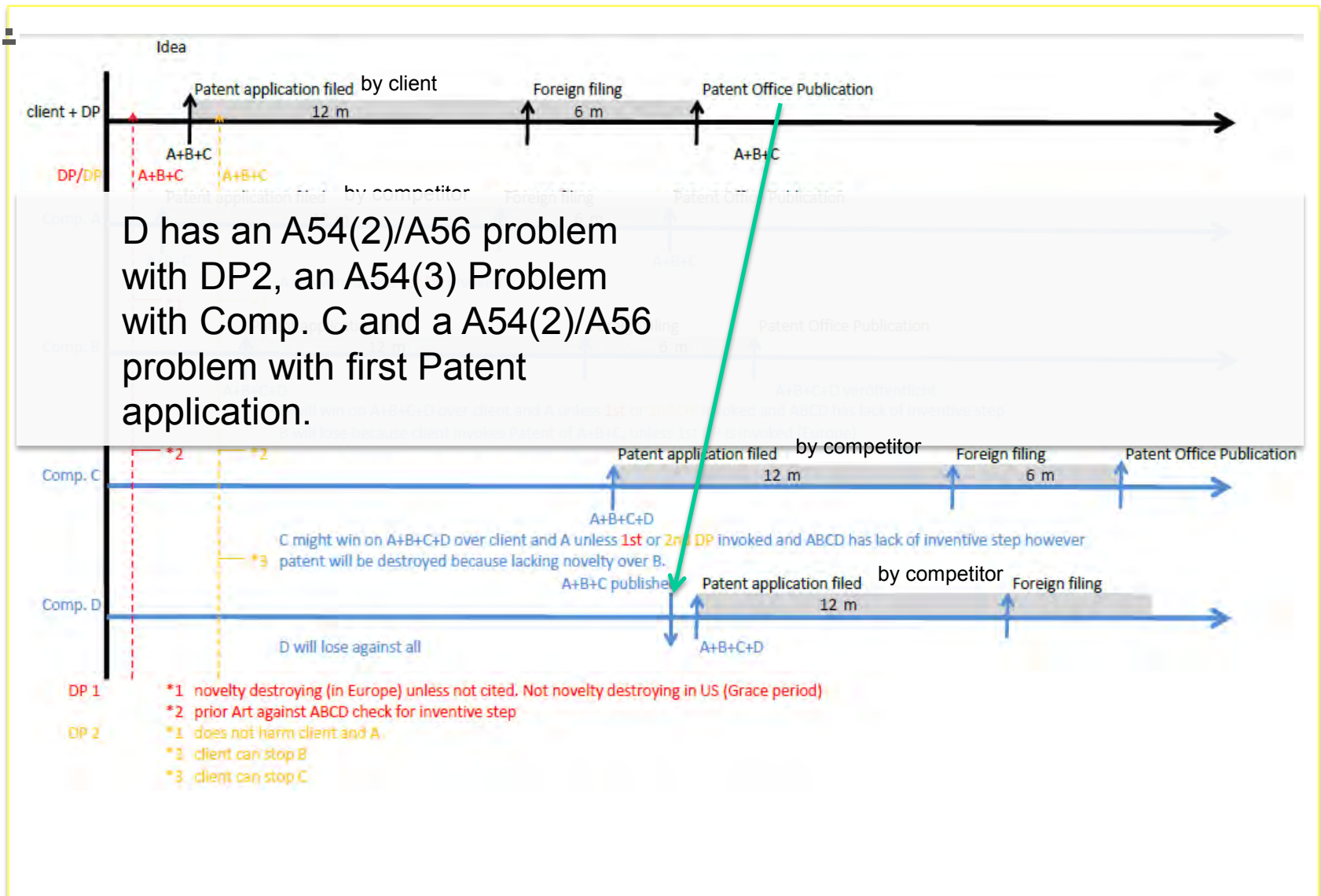
Time Line Bar by Defensive Publications .



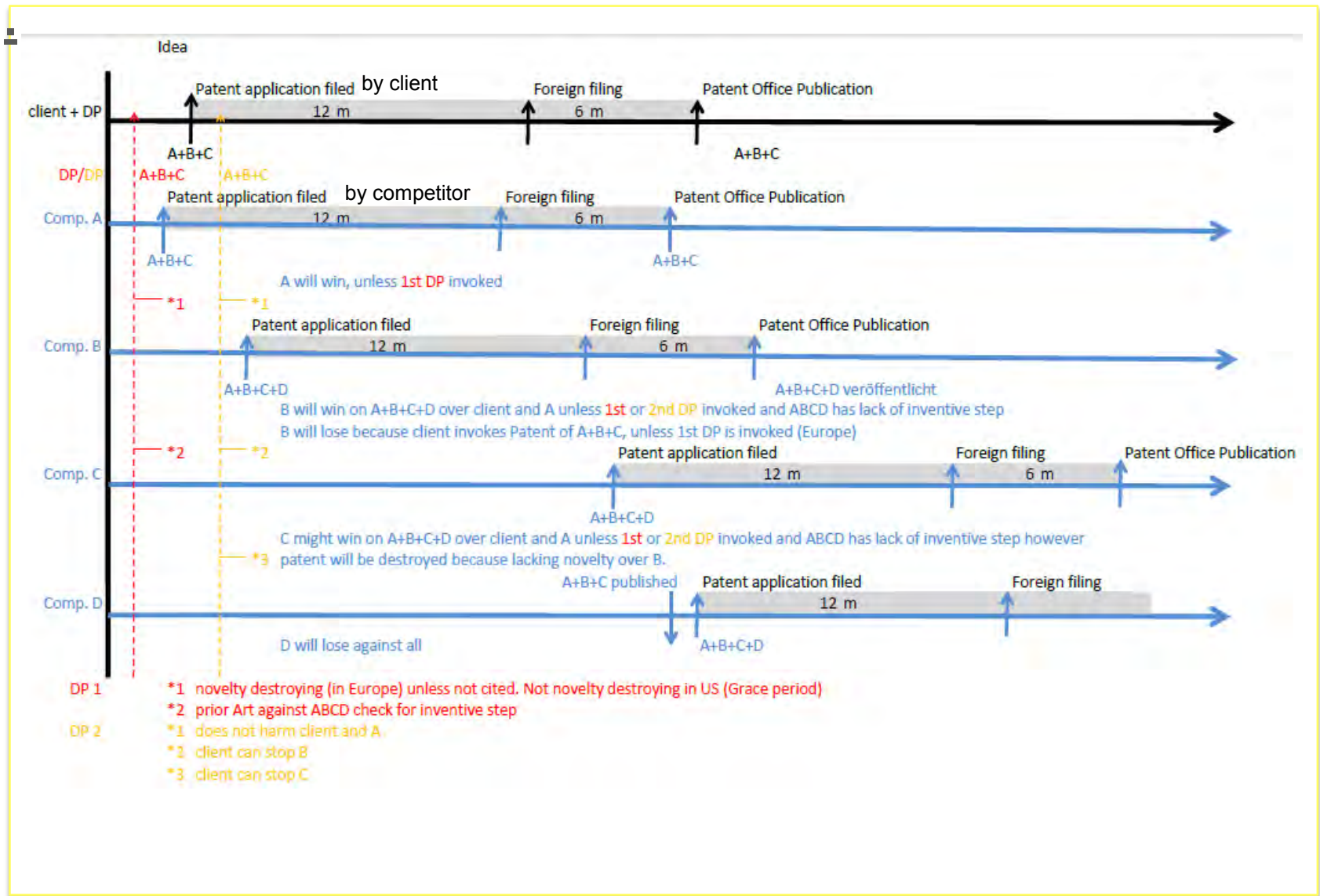
Later patent application of competitor with improved content may block further development of clients product/device/process.

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

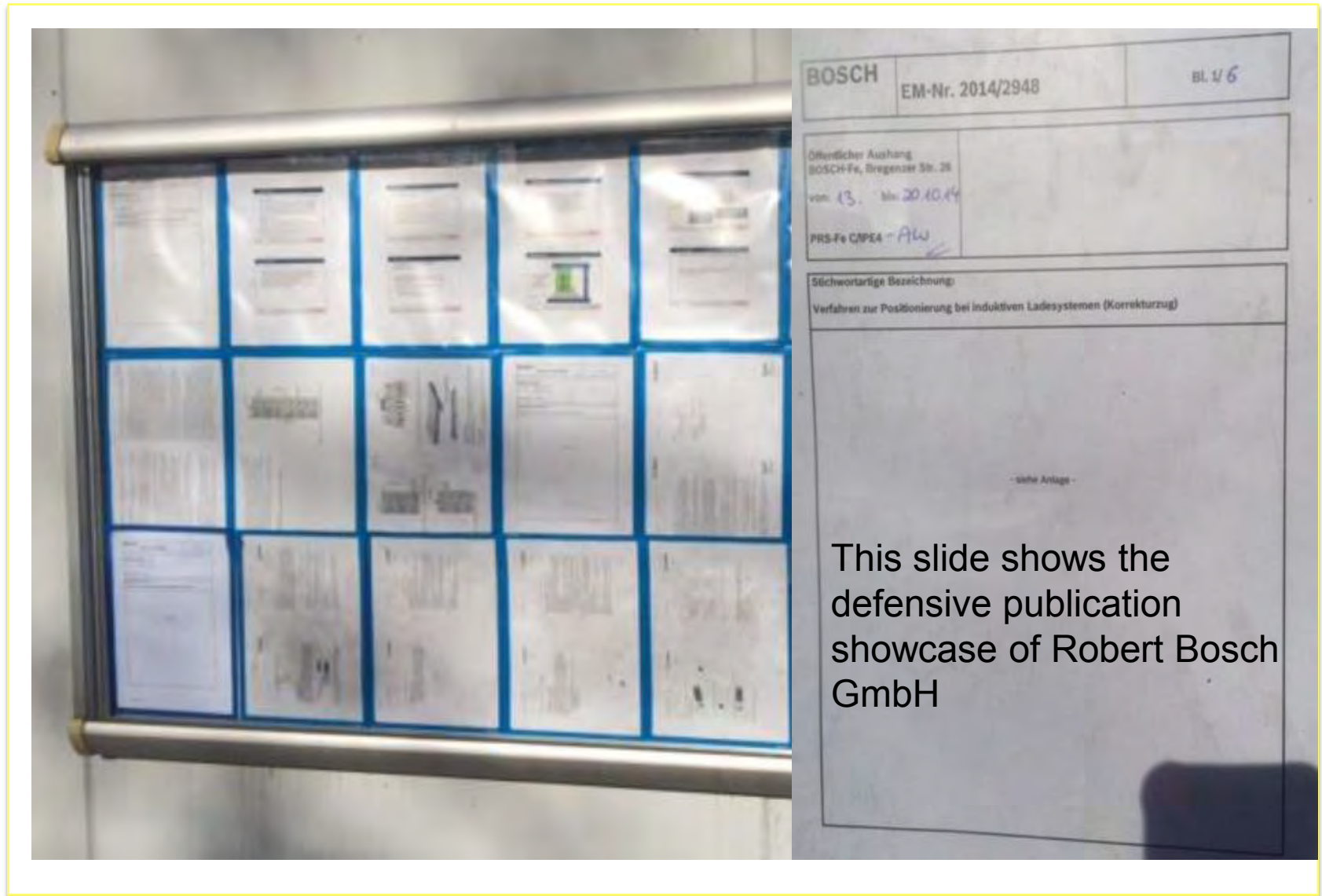
Time Line Bar by Defensive Publications .



Time Line Bar by Defensive Publications .



Examples of Pages Related to Defensive Publication

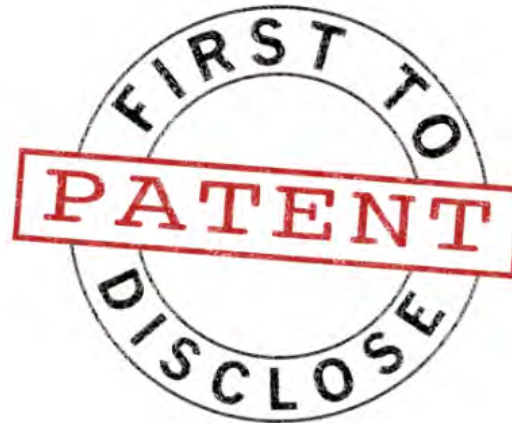


BLIP Clinic

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](#)



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Technology Partners



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.



The image shows a presentation slide from Questel. On the left is a blue lightbulb icon. To its right, the text reads "Defensive Publication" in a large, bold, black font, followed by "Advanced strategy" in a smaller, grey font. At the bottom of the slide, there is a dark blue footer bar containing the Questel logo (a stylized globe) and the text "Questel Freedom by Operation" on the left, and the website "www.questel.com" on the right. Below the slide, a video player interface is visible, showing navigation icons (back, forward, home, download), a progress indicator "1 of 28", and a share icon.

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



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.

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



1. Register user account

PROTEGAS offers user account for managing/retrieving ones publications and user account for searchers.

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.

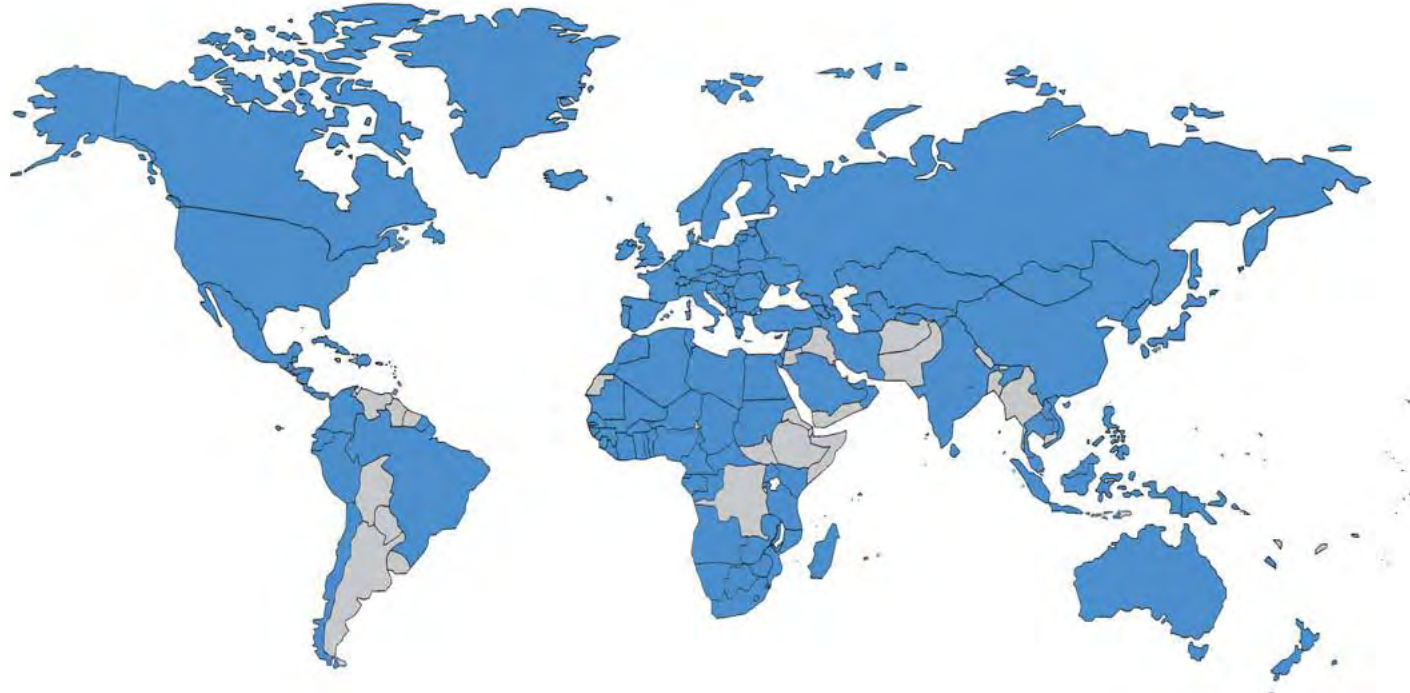
(T1553/06 and T002/09)

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.