

# PATENT FILING STRATEGIES

**SAMET SÖZEN**

PATENT ATTORNEY  
DESTEK PATENT







## What is a Patent?

- A territorial right that is granted by a government authority for an invention in a field of technology
- Right to prevent others from making, using, distributing, selling or importing the invention
- Invention is a product, process or apparatus that is novel, useful and non-obvious
- Provides protection for 20 years from the filing date of the patent application
- Provides public disclosure of the invention in exchange for patent protection
- Patent applications published at 18 months from the date of filing
- Accelerates and advances technological development
- Application for a patent is made with a national or regional patent authority, or alternatively, through the Patent Cooperation Treaty



# Patent Filling Strategy

- Which new ideas are worthy of a patent application?
- How should the applications be drafted and prosecuted?
- When should they be filed?
- Where in the world should they be filed?
- How long should applications and granted patents be maintained?



The development of a patent strategy must take into account the specific situation and circumstances of the business. It is, however, possible to set out some general considerations.



*Focus on your product*



*Focus on technology area*



*Focus on adding value to  
the business*



## Focus On Your Product

The simplest situation is where a company produces new products in direct response to customer requirements. Product development is driven by factors other than IP, and products will be made and sold whether or not they are patentable.





## Focus On Technology Area

The second, more complex situation is where your business strategy involves a deliberate attempt to build a proprietary position.





# Focus On Adding Value Technology to the Business

The third broad situation is more nebulous.  
It applies often to startups and to companies seeking alliances.  
Here the aim is not, or not solely, to protect specific products or even specific  
areas of technology around existing products.  
Instead the aim is to enhance the company's value or reputation.





A widely used strategy when protecting an invention in several countries is as follows:

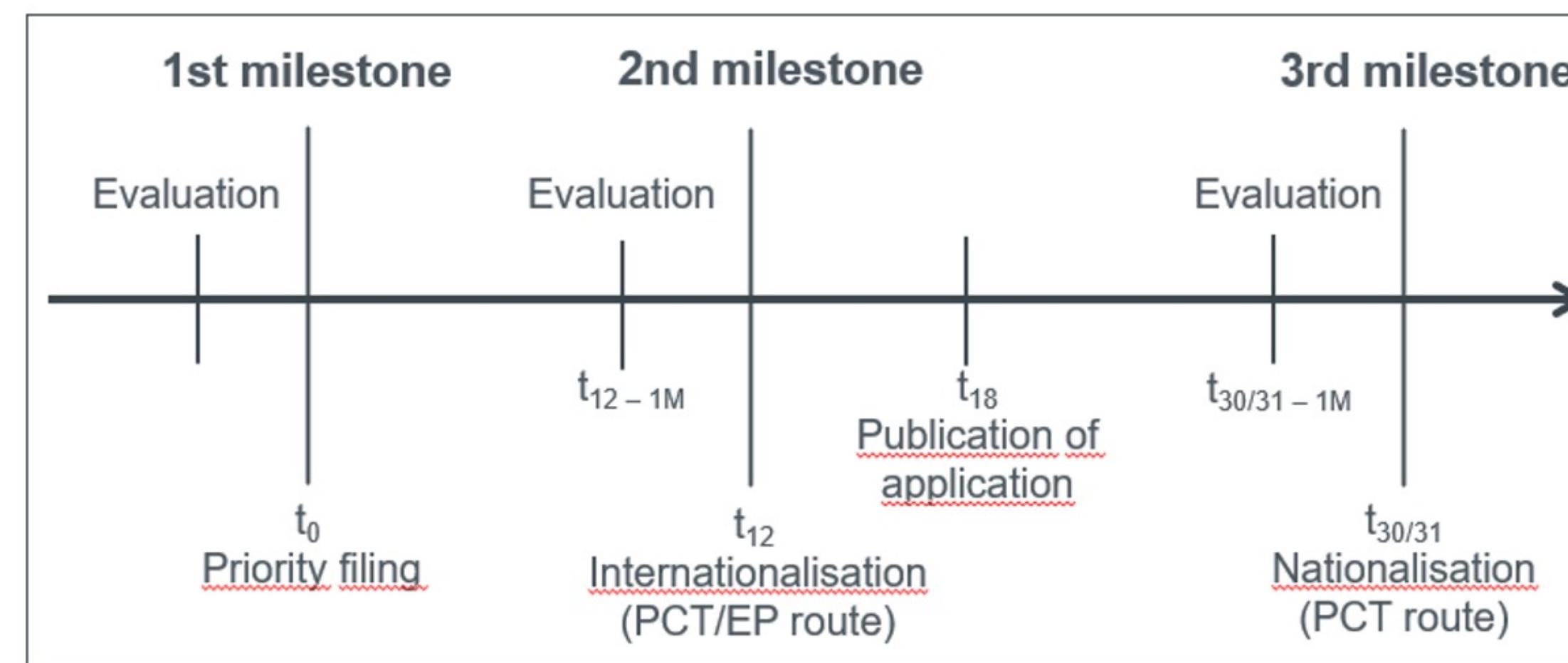
- 1) Submission of a priority application.
- 2) Filing of a PCT application at the end of the 12 months of priority.
- 3) Entry into national phase generally 30/31 months after the priority date.

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It is no surprise that this strategy is popular, as it brings several advantages to the applicant. Among them, these can be mentioned:

- Allows you to adjust the wording of the "final" application to the results of an official search and the examiner's opinion.
- The patent lasts longer, as it is 20 years from the application and not from the priority.
- Payments are delayed.
- The protection in force lasts longer in a larger territory.



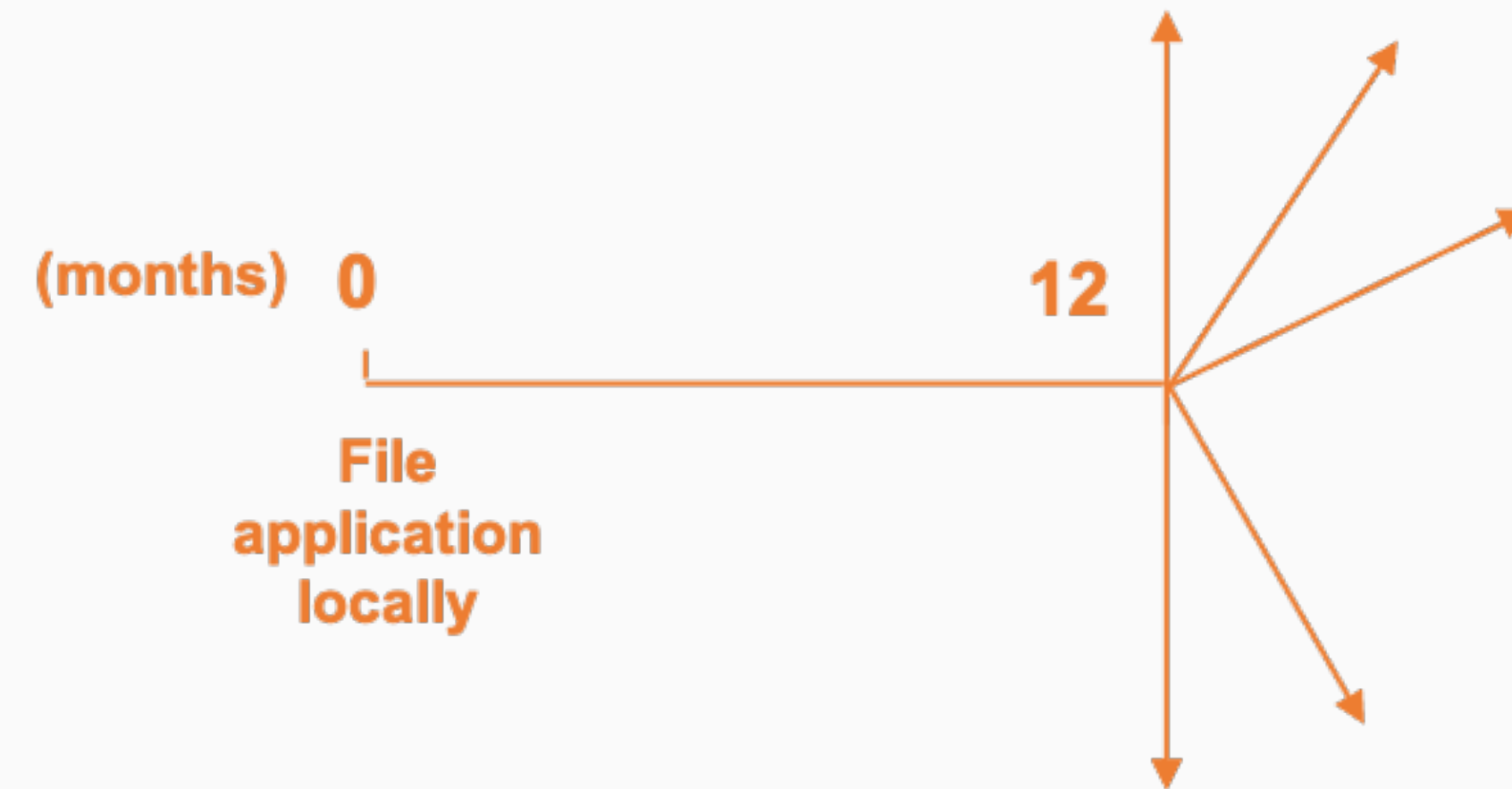


$t_0$  Patent priority filing: start of priority year

$t_{12}$  Deadline for internationalisation: 12 months after  $t_0$

$t_{30/31}$  Deadline for nationalisation: 30/31 months after  $t_0$  (PCT route)





- Local patent application followed within 12 months by multiple foreign applications claiming priority under the Paris Convention
- Multiple formality requirements, searches, publications, examinations, prosecutions
- Translations and national fees at 12 months



## ▶ What is the PCT?



- An international treaty facilitating the process of seeking patents internationally
- An efficient and advantageous procedure for users of the patent system and patent Offices
- Signed in June 1970 and became operational in June 1978 with 18 Contracting States



## ▶ What is the PCT?

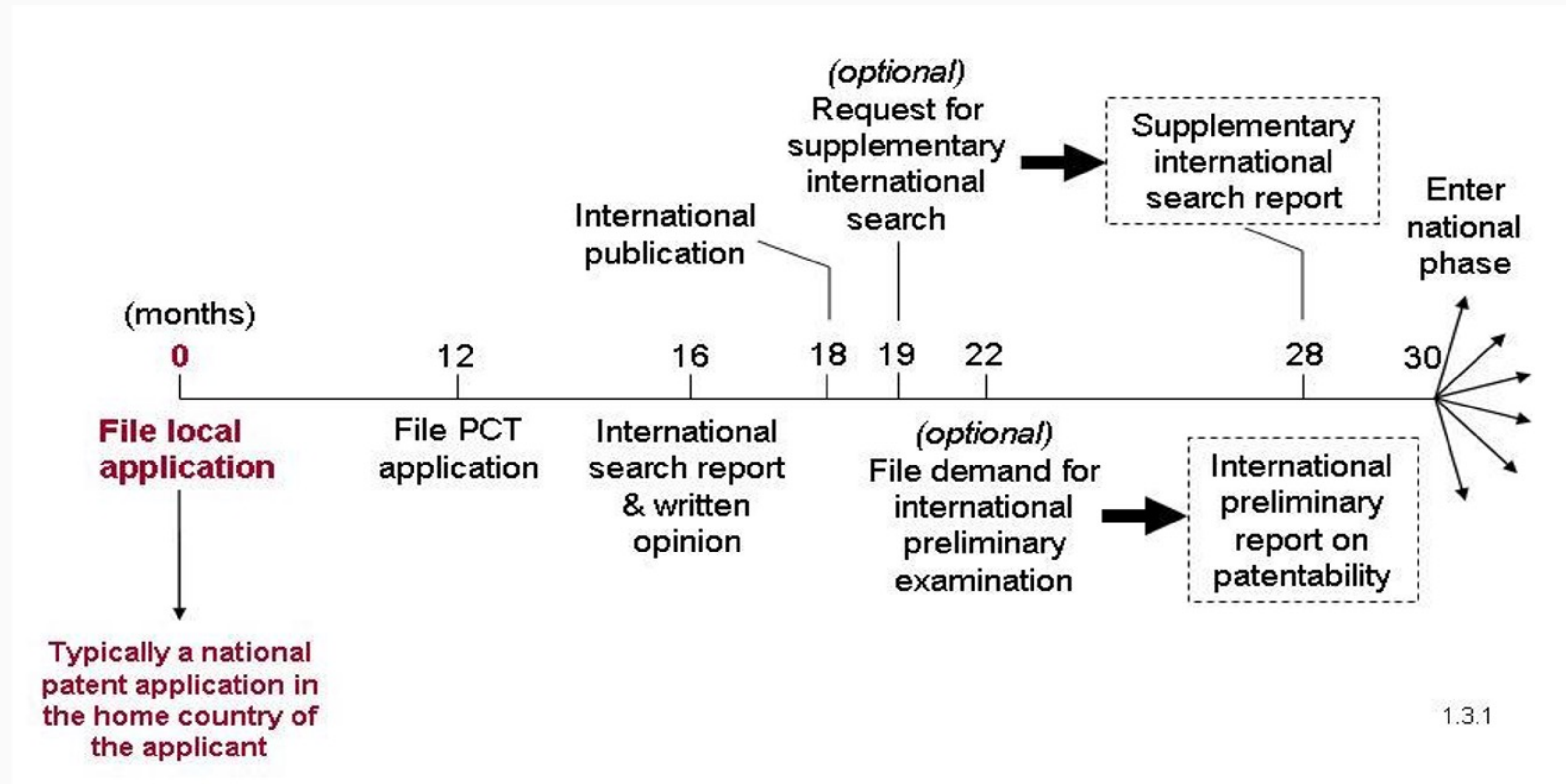


## General Remark on the PCT

- The PCT system is a patent “filing” system, not a patent “granting” system
- The PCT system consists of an international and national phase
- The decision on granting patents is taken exclusively by national or regional Offices in the national phase



## Typical PCT Timeline





## ▶ PCT International Phase



- Unified filing procedure consisting of the **filing** and **processing** of a single application with legal effect in all PCT Contracting States
- Information on the potential patentability of an invention prior to the start of national patent procedures ("national phase")
- Publication of the international application together with the International Search Report
- Time delay of at least 30 months before the start of the national patent procedure



## ▶ PCT National Phase

- After the end of the international phase (30 months)
- PCT is a gateway to national patent systems
- Leads to the grant (or refusal) of a patent by national or regional Offices



## Why Use The PCT?

- “Internationalization” of a single PCT application providing near global geographical coverage
- Time delay (additional time for decision making)
- Cost deferral
- Patentability assessment

## Cost Deferral

- Seeking patents in foreign countries requires a significant capital investment
- The PCT provides for the deferral of main initial costs associated with internationalization:
  - Cost of translations
  - Local patent agent fees
  - Local patent Office fees

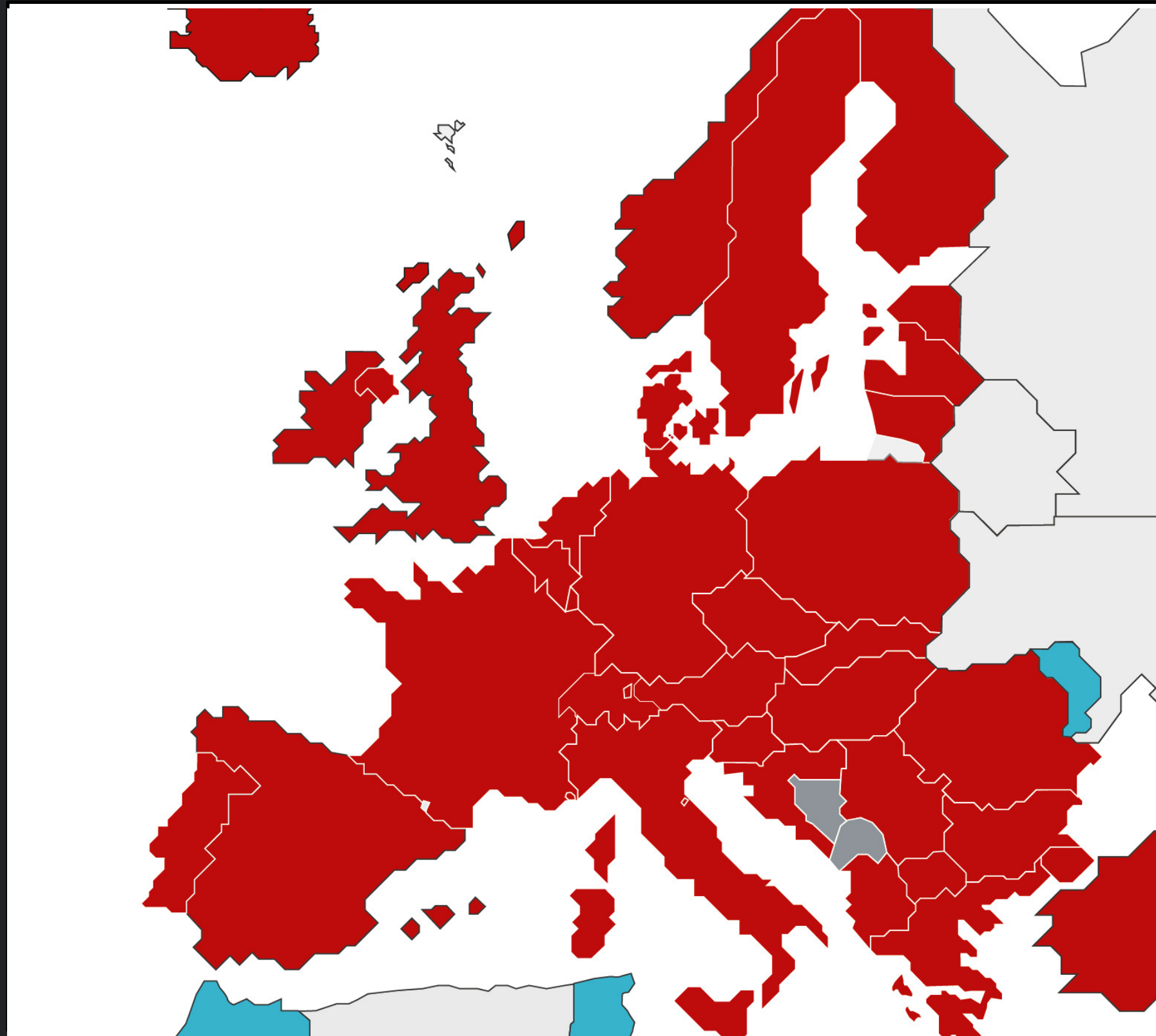


## Other PCT Advantages

- Amendment possibilities under the Chapter II procedure prior to entry into the national phase
  - Description
  - Claims
  - Drawings
- Electronic filing of PCT applications at reduced expense
- Centralized management of your PCT application in ePCT



## ▶ The European Patent System



- File European patent application at the European Patent Office (EPO)
- Grant of bundle of national patents by EPO
- Enforcement of patent rights by national courts



- The European Patent Convention (EPC)
  - provides the legal framework for the granting of European patents via a centralised procedure
  - establishes the European Patent Organisation
- 1973 – Diplomatic Conference in Munich ► signature of the EPC by 16 countries
- 1977 – Entry into force of the EPC in 7 countries – marked as follows





## ■ Member states (38)

- |                  |                   |                  |
|------------------|-------------------|------------------|
| - Albania        | - Hungary         | - Poland         |
| - Austria        | - Iceland         | - Portugal       |
| - Belgium        | - Ireland         | - Romania        |
| - Bulgaria       | - Italy           | - San Marino     |
| - Croatia        | - Latvia          | - Serbia         |
| - Cyprus         | - Liechtenstein   | - Slovakia       |
| - Czech Republic | - Lithuania       | - Slovenia       |
| - Denmark        | - Luxembourg      | - Spain          |
| - Estonia        | - Malta           | - Sweden         |
| - Finland        | - Monaco          | - Switzerland    |
| - France         | - Netherlands     | - Turkey         |
| - Germany        | - North Macedonia | - United Kingdom |
| - Greece         | - Norway          |                  |

## ■ Extension states (2)

- Bosnia and Herzegovina
- Montenegro

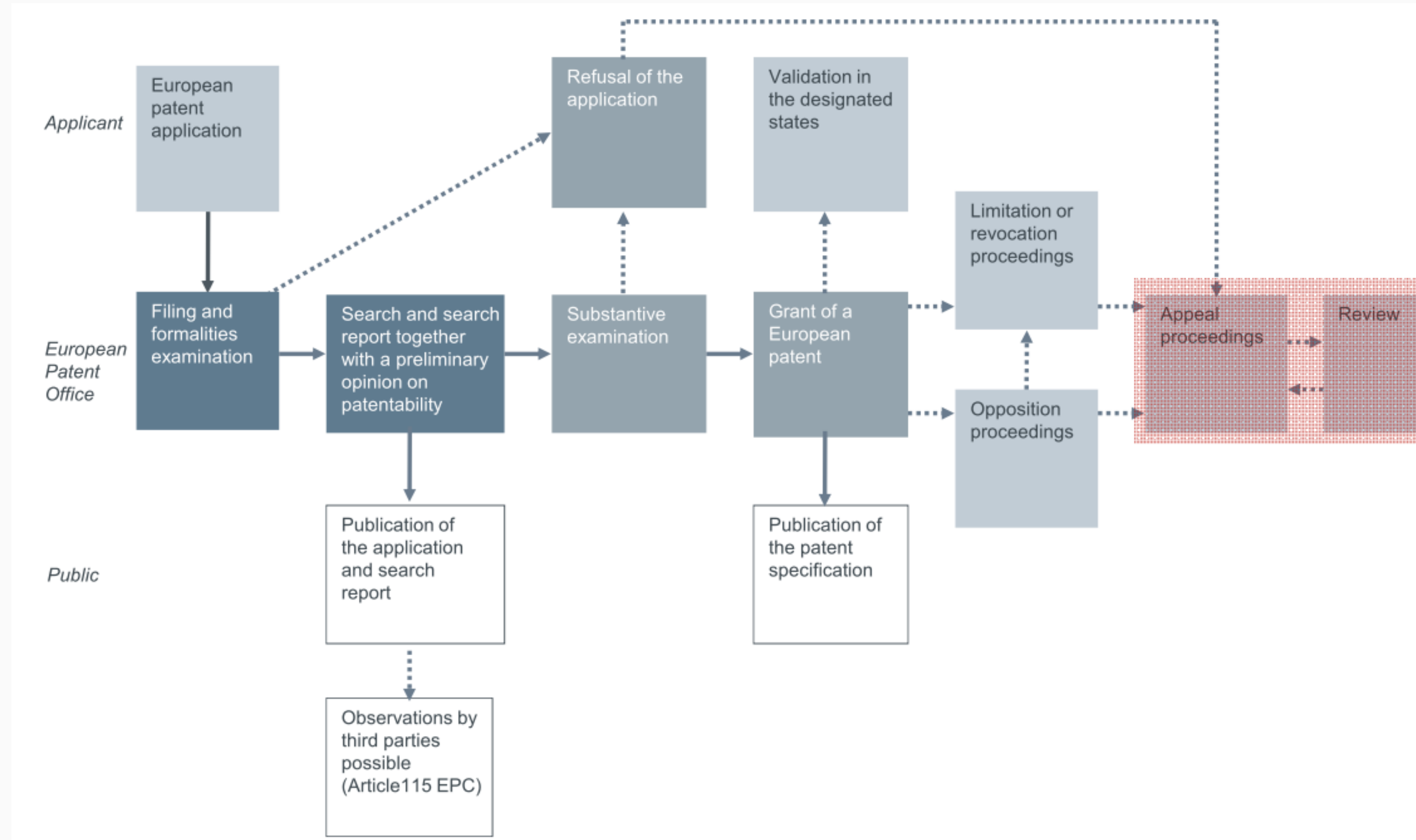
## ■ Validation states (4) *Agreement in force*

- Cambodia
- Republic of Moldova
- Morocco
- Tunisia

## ■ Future validation states (1) *Agreement signed but not in force yet*

- Georgia

# ▶ The European Patent System





# *Thank You*

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