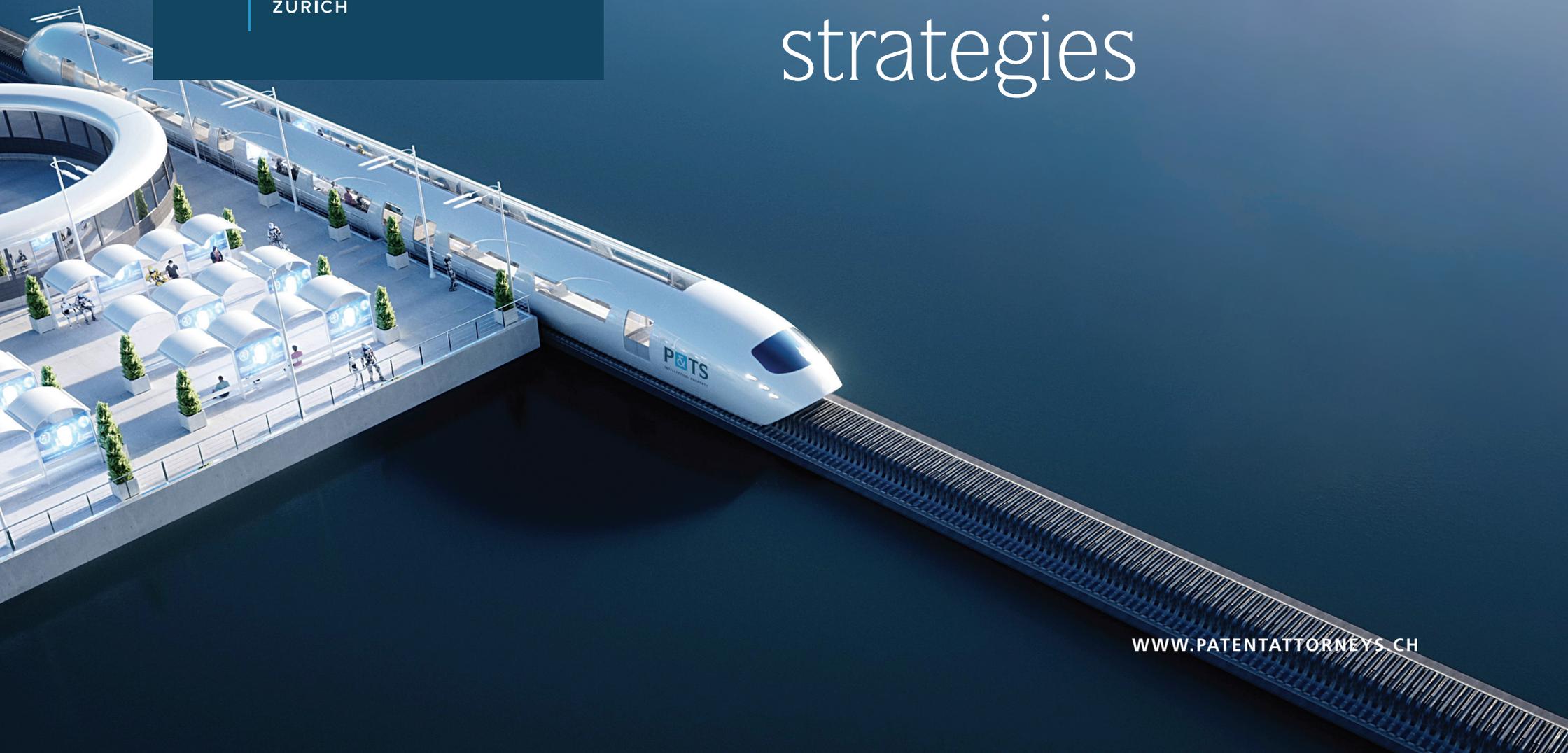


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Patent filing strategies



WWW.PATENTATTORNEYS.CH

Patent filing strategies

There are several strategies to choose from when filing patent applications in more than one State. However, the choice of strategy can have a considerable impact on costs and particularly on their distribution over time.

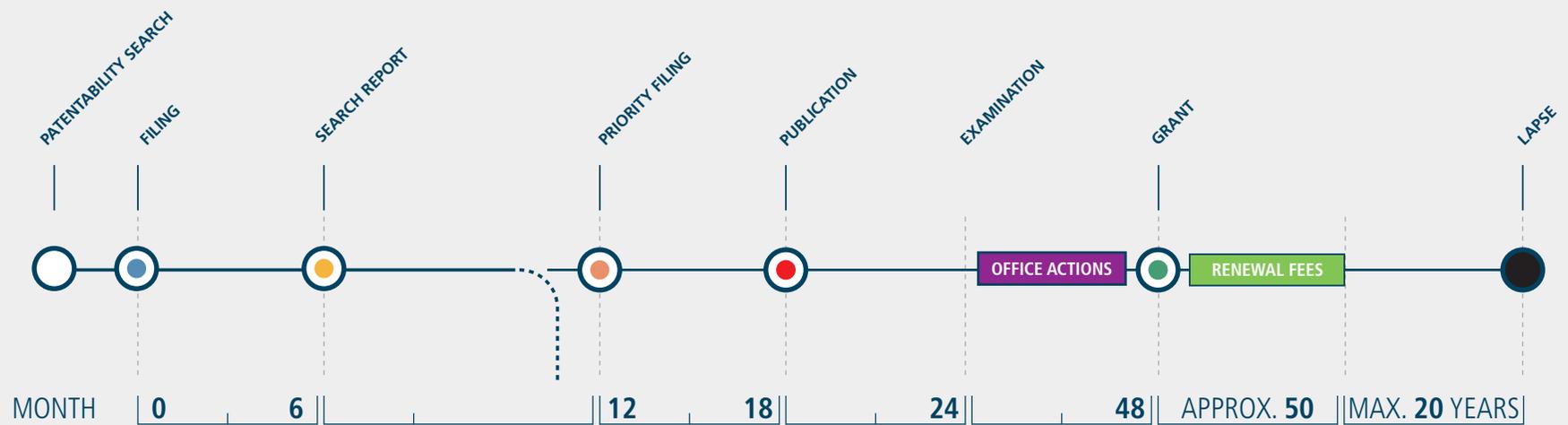
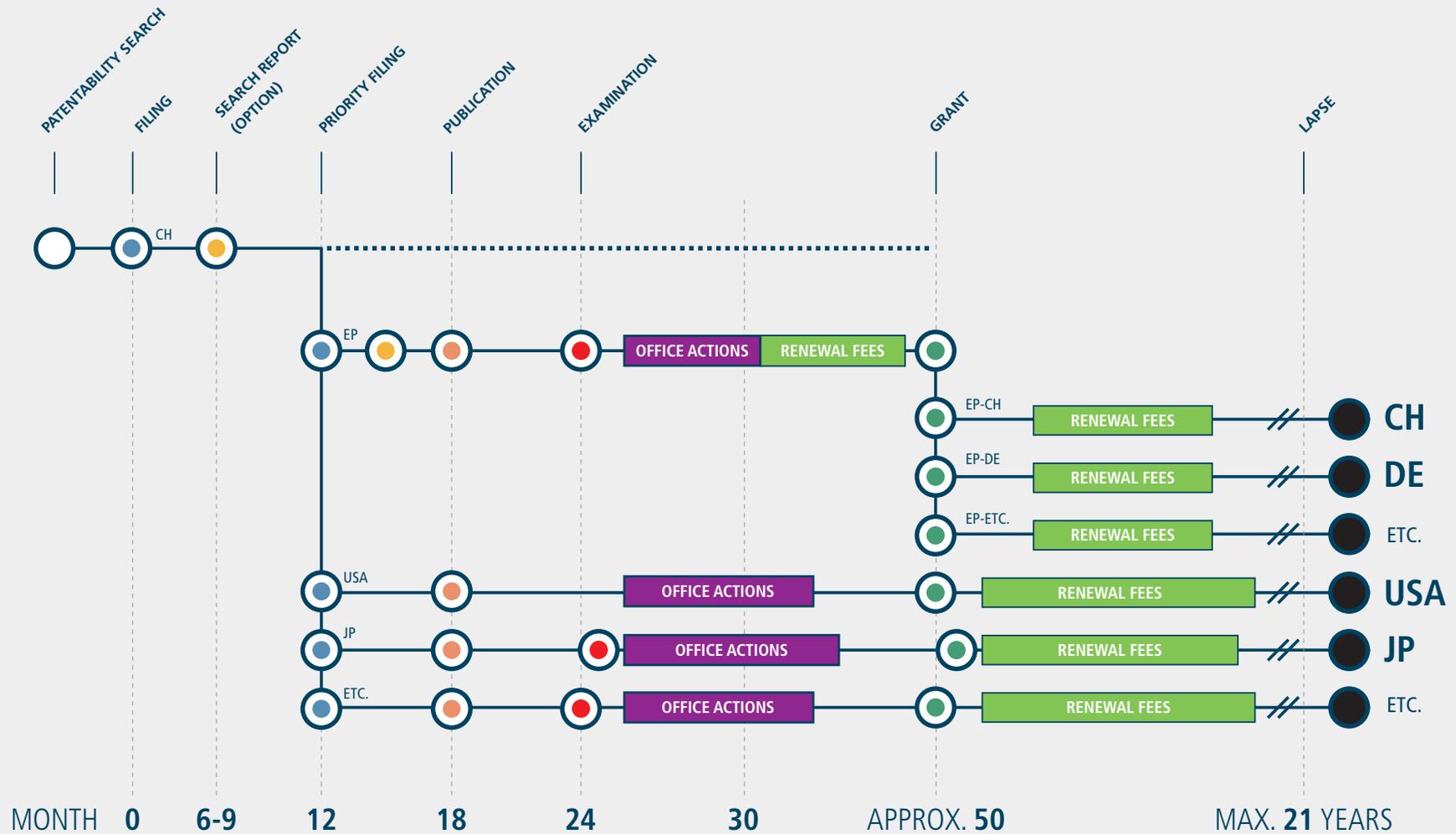


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Option 1: Swiss patent application



Option 1: Swiss patent application

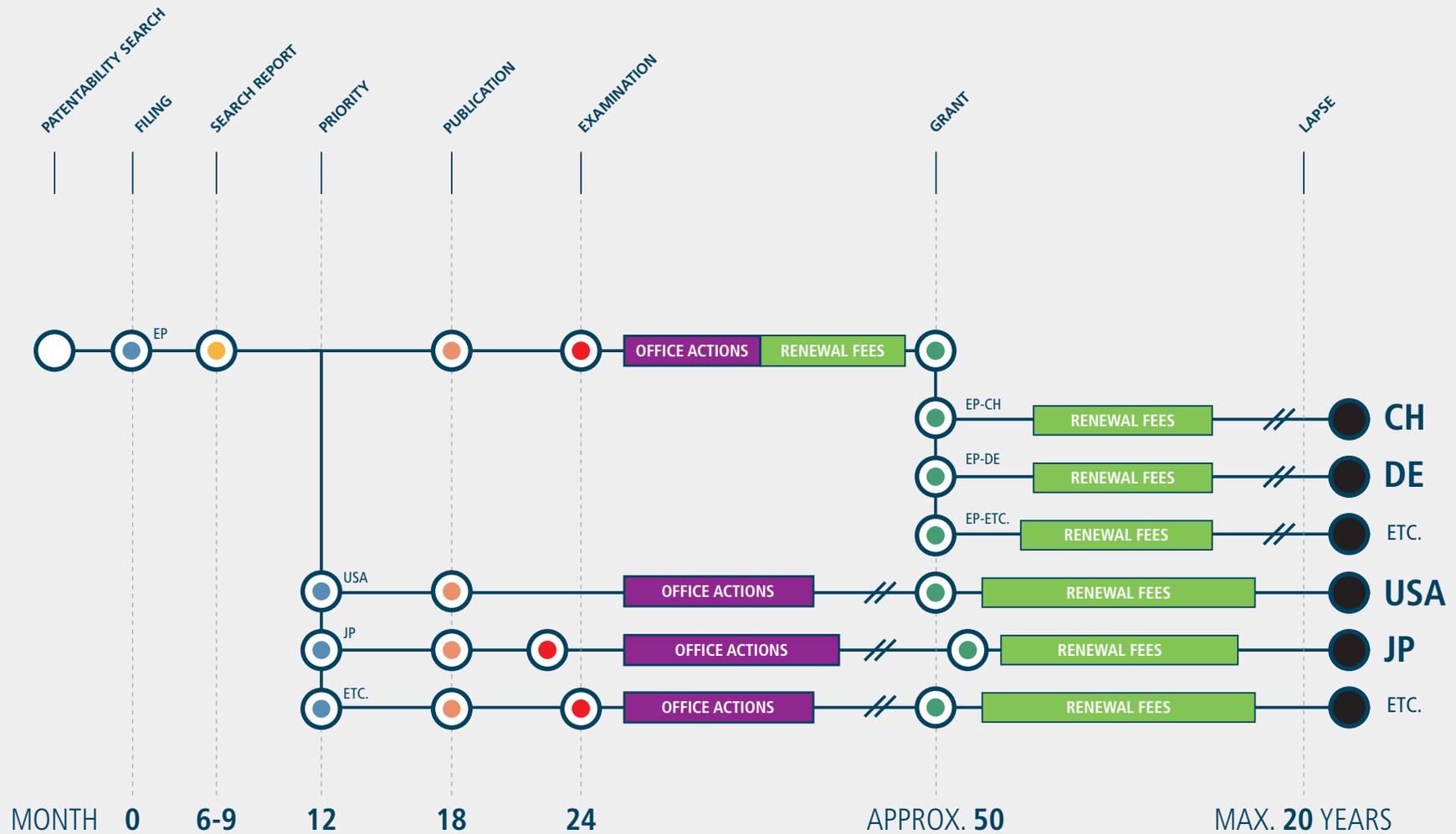
To be recommended if:

- Initial fees must be reduced
- The invention does not meet the stricter grant requirements of the European patent.
- An official EPO search report is required before deciding which states to protect.
- The invention could evolve considerably in the first 12 months; a final application should include these improvements.
- We would like to benefit from 21 years of effective protection.
- The Swiss market is important and it is essential to obtain the best possible protection in this market.

To avoid if:

- The total cost of obtaining a European patent must be reduced (the costs of the Swiss application are added to the costs of the European application, so that this solution proves, after 12 months already, to be more expensive than a direct European filing).
- It is almost certain that the invention will not evolve after filing.

Option 2: European patent application



Option 2: European patent application

To be recommended if:

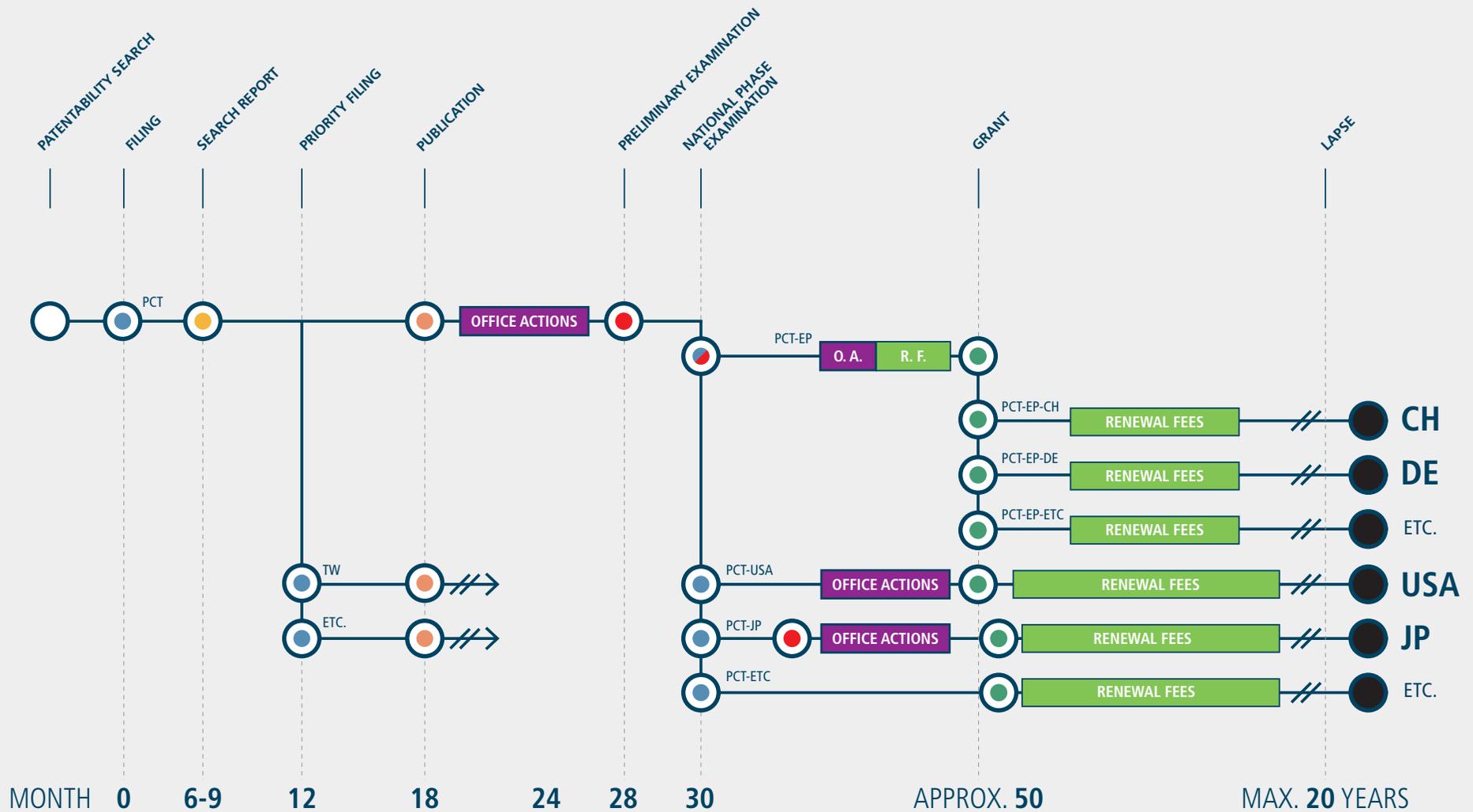
- The total costs of acquiring the patent should be kept to a minimum.
- The risk that the application will be abandoned quickly is low.
- The probability of the invention evolving significantly during the first year is low.
- It is clear from the outset that a patent limited to Switzerland will not suffice.
- Fast grant is an advantage.

To avoid if:

- Initial fees should be reduced
- The invention is likely to evolve after the initial filing
- The invention does not meet the rather strict European criteria for granting a patent.
- 21 years of protection instead of 20 is an advantage.



Option 3: Direct International application (PCT)



Option 3: Direct International application (PCT)

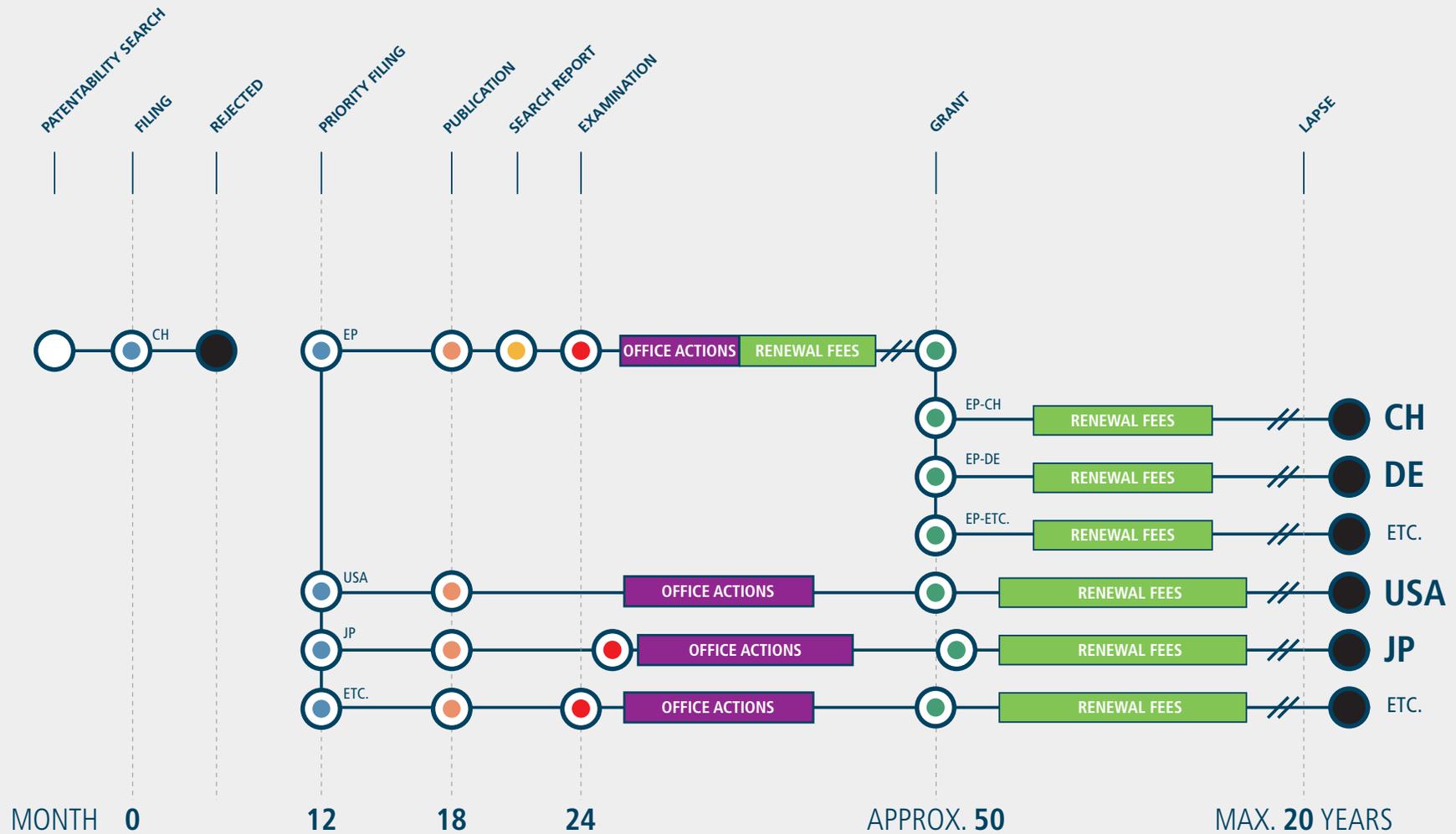
To be recommended if:

- The main costs should be postponed as much as possible.
- One wishes to avoid significant expenses during the first 30 months, without giving up the possibility of protecting one's invention in a large number of countries.
- The success of the product is difficult to predict.
- The risk of the invention being abandoned during the first 30 months is not negligible.
- One wants to wait as long as possible before deciding definitively on the countries in which the invention should be protected.
- One wishes to protect the invention in a large number of countries.
- It is important to be able to establish an accurate cost budget for 30 months.
- It is absolutely necessary to avoid rejection during the first 30 months.

To avoid if:

- Initial costs must be reduced.
- Total costs until grant must be reduced.
- The number of countries in which the invention has to be protected is limited.
- The invention is likely to evolve within 12 months after filing and the text may need to be completed.
- A fast grant is an advantage
- One is looking for 21 years of effective protection

Option 4: Provisional application



Option 4: Provisional application

To be recommended if:

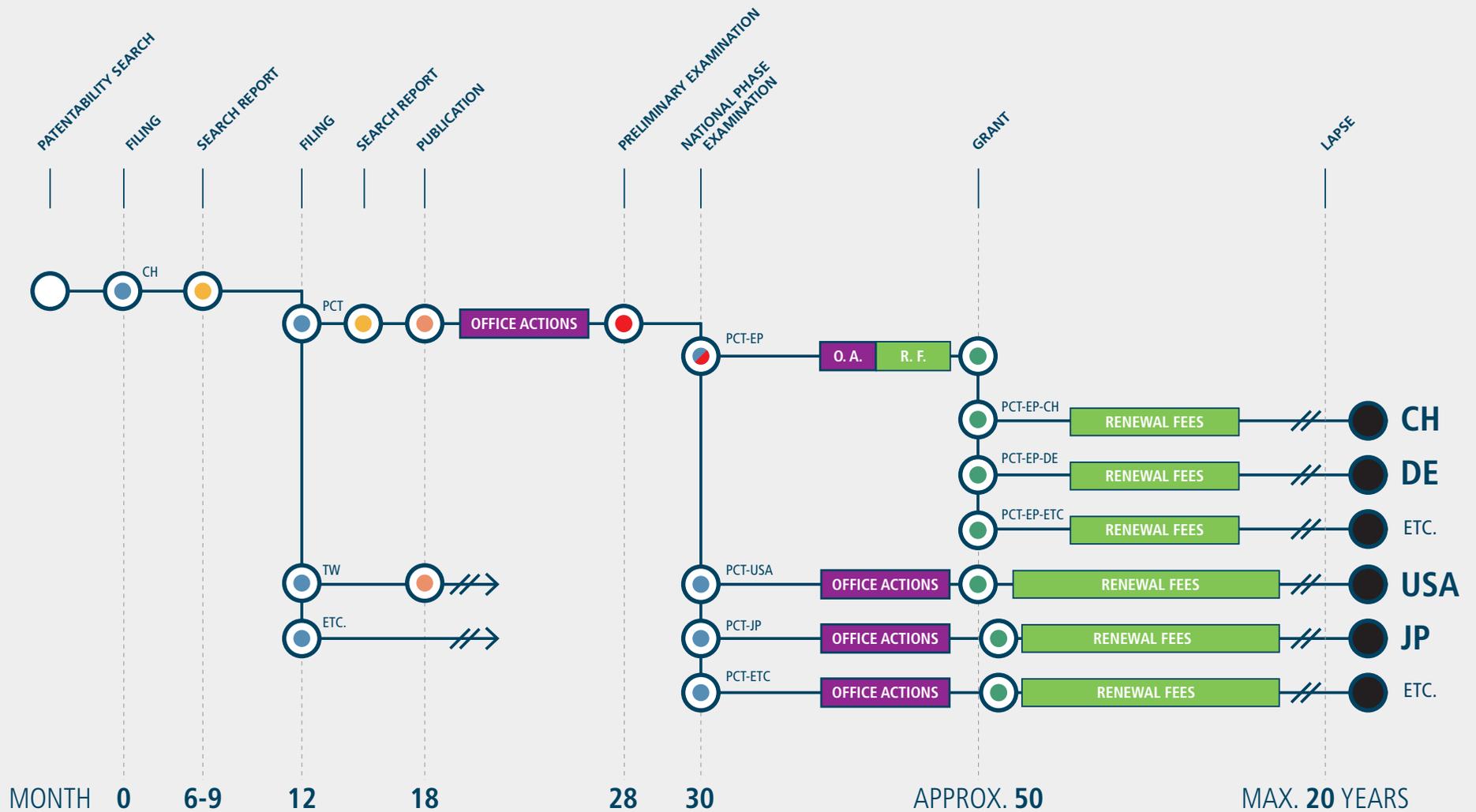
- Initial costs should be kept to a minimum.
- The time provided does not allow for the preparation of a final application.
- It is likely that the invention will continue to evolve after filing.
- The risk of dropping the application is important.
- One wishes to benefit from a maximum term of protection of 21 years.

To avoid if:

- The total costs must be reduced (the cost of the provisional application is added to the costs of successive applications, so that this solution is more expensive after 12 months already).
- The invention is already well developed, and the markets to be protected are relatively well known.
- A formal search report is desired, before deciding on the final strategy.
- A fast grant is desired.



Option 5: International Application (PCT) with priority



Option 5: International Application (PCT) with priority

To be recommended if:

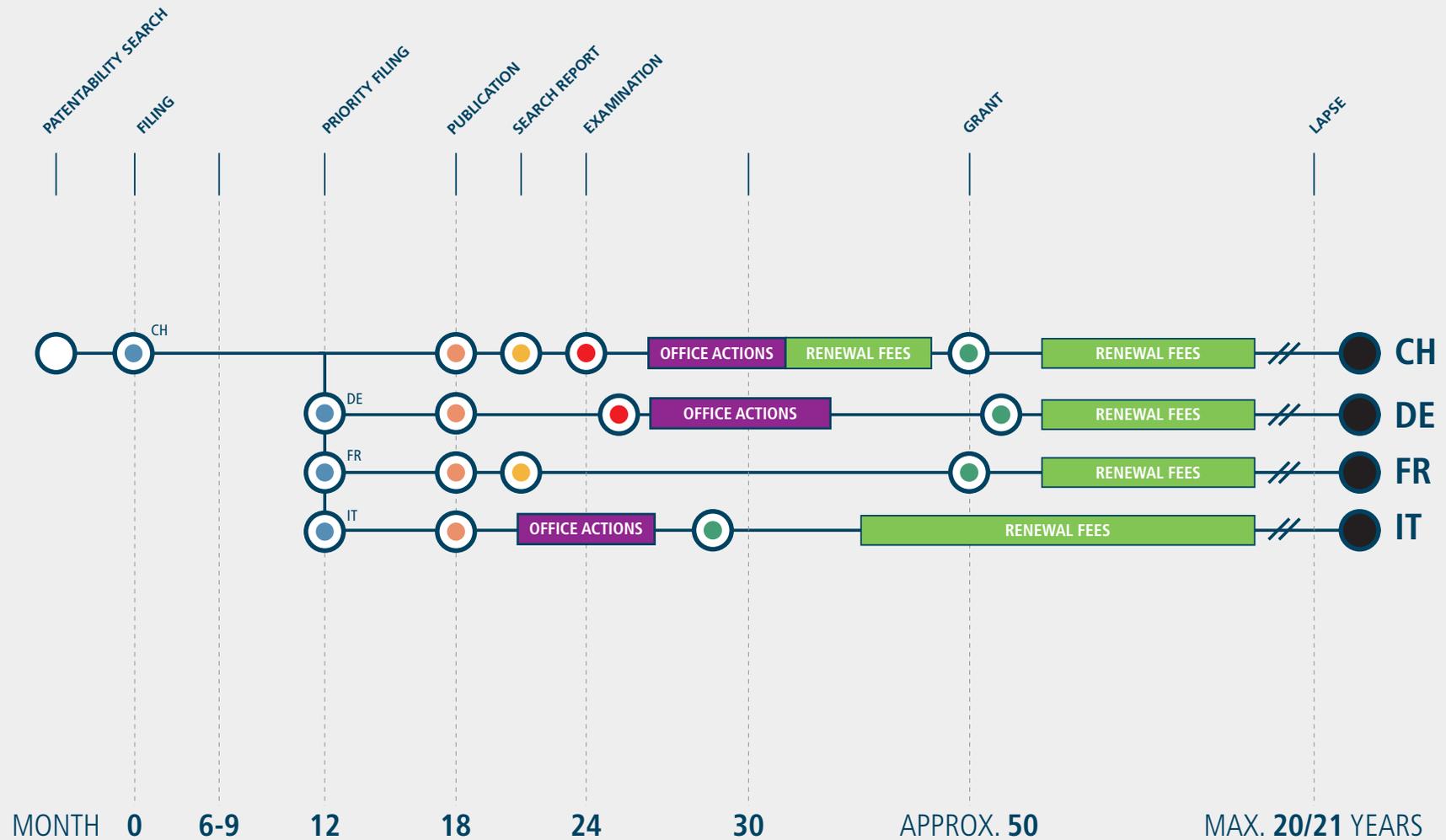
- All charges must be pushed back to maximum.
- Initial costs should be reduced, for example, by filing an initial application without fees.
- 12-month costs must be reduced.
- One wishes to avoid significant expenses during the first 30 months, without giving up the possibility of protecting one's invention in a large number of countries.
- The success of the product is hard to predict.
- The risk of the invention being abandoned during the first 30 months is not negligible.
- One wishes to wait as long as possible before deciding definitively on the countries in which the invention should be protected.
- It is likely that the invention evolves after the filing, and a final filing after 12 months should include variants and improvements imagined in the meantime.

- The Swiss market is important and it's essential to obtain the best possible protection in this market (only if initial filing in Switzerland).
- It is important to reduce costs during the first 30 months.
- One wishes an effective protection for 21 years
- One wishes to absolutely avoid rejection for 30 months.
- A high level of flexibility is essential.

To avoid if:

- Total costs up to grant must be reduced.
- One knows well the list of the countries in which to protect your invention.
- A fast grant procedure is an advantage.

Option 6: National route



Option 6: National route

To be recommended if:

- Protection in 2 to 4 European countries is sufficient.
- It would be difficult to obtain a European or international patent.

To avoid if:

- Protection in more than 4 European countries is required.



Main procedural steps

Patentability search

When an invention is submitted to us, we first start by checking its novelty by means of a patentability search. The aim of this search is to determine precisely the prior art that is closest to the invention. To complete the search, a report is established that contains a list of patents and articles published by third parties that raise concerns as to the patentability of the invention, as well as our advice for protection.

Should the procedure on the other hand continue with the drafting of a patent application, the patentability search makes it possible to ascertain which characteristics can be effectively protected and to optimize the drafting of an application to highlight clearly the differences between the new invention and the documents uncovered by the search.

The patentability search report is also accompanied by one or several suggestions as to the strategy for protecting the invention, taking into account the commercial prospects of the invention, the uncovered prior art and the applicant's budget.

Filing

If the conclusions of the patentability study are favourable, we prepare the text and drawings of the patent application on the basis of the applicant's documents and explanations. The text and the drawings of the patent application are then filed at the relevant Patent Office. The formalities department of the EPO checks formal aspects and gives the application an application number and a filing date.

From this date onwards, the invention described in the application may be disclosed publicly or commercialised without this publication being opposable to the patent. The applicant can furthermore indicate "EP patent pending" on the product and associated documentation.

Search report

Many patent offices prepare a report search engine that contains a list of documents deemed relevant to assess novelty and activity inventive application. This search is optional for Swiss patent applications.

The search report for European or PCT applications is accompanied by a notice about the patentability. The applicant is not required to respond. Otherwise, this opinion is generally taken up as the first notification during the review.

Publication

European patent applications are published approximately 18 months after the filing date or, if priority has been claimed, after the oldest priority date. The search report is attached to the publication if it is already available (publication A1), otherwise it will be published separately at a later stage (publication marked A3).

Examination

A request for examination must be paid in order to continue the procedure. In some countries, the examination fee is paid at the time of filing. In Europe, it must be paid within 6 months after publication of the search report and is accompanied by a designation fee. In Switzerland, the examination fee is paid upon invitation, usually about 2 to 3 years after filing.

Office actions

The Examining Division examines the application by comparing it notably to the documents cited by the search examiner in the search report. If the application displays irregularities, e.g. lack of clarity or if the claims lack novelty or inventive step over the prior art, the Examining Division sends a written notification to the applicant or his representative and sets a deadline for remedying the defects or for contesting the examiner's objections. The deadline is usually 4 months.

If the applicant's reply gives rise to new objections, a new office action must be issued. The procedure can thus theoretically imply a countless number of exchanges between the Examining Division and the applicant. In practice, however, the Examining Division will usually strive to force the applicant to respond fully to the office actions and to limit the number of necessary notifications.

Grant

When the examiner agrees with the latest version of the application proposed by the applicant, this agreement is notified to the applicant by sending a notification according to Rule 71(3) EPC, asking him whether he approves the text intended for grant. The patent cannot be granted without the applicant's agreement on the text proposed for grant.

In most States, the applicant is required to pay fees for grant and sometimes to provide translations or other arrangements.

Renewal fees

The validity of the European patent is 20 years maximum, starting to the date of departure, upon condition however that the annual maintenance fees are paid each year on the anniversary of the filing date. Depending on the State, the renewal fees must be paid only since the grant, or sometimes already for the patent application.

Lapse

The patent or patent application may cease to produce its effect in one of the following cases:

- in any case, 20 years after the filing date
- if the applicant or owner stops paying the renewal fees or any other required fee
- if the applicant fails to answer an office action from the EPO
- in case the application is rejected on the grounds that it does not comply with the requirements of the EPC
- in case of revocation by a competent court, by an Opposition Division or by an Appeals Board of the EPO

You invent the future,
we protect it.



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