

From Your Story to Protection Strategy

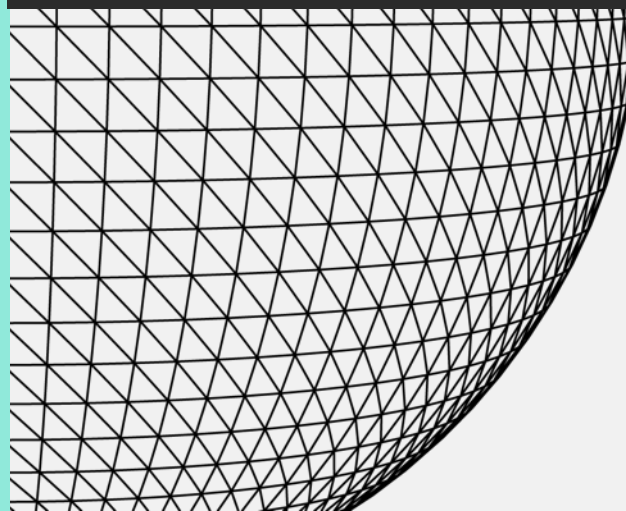
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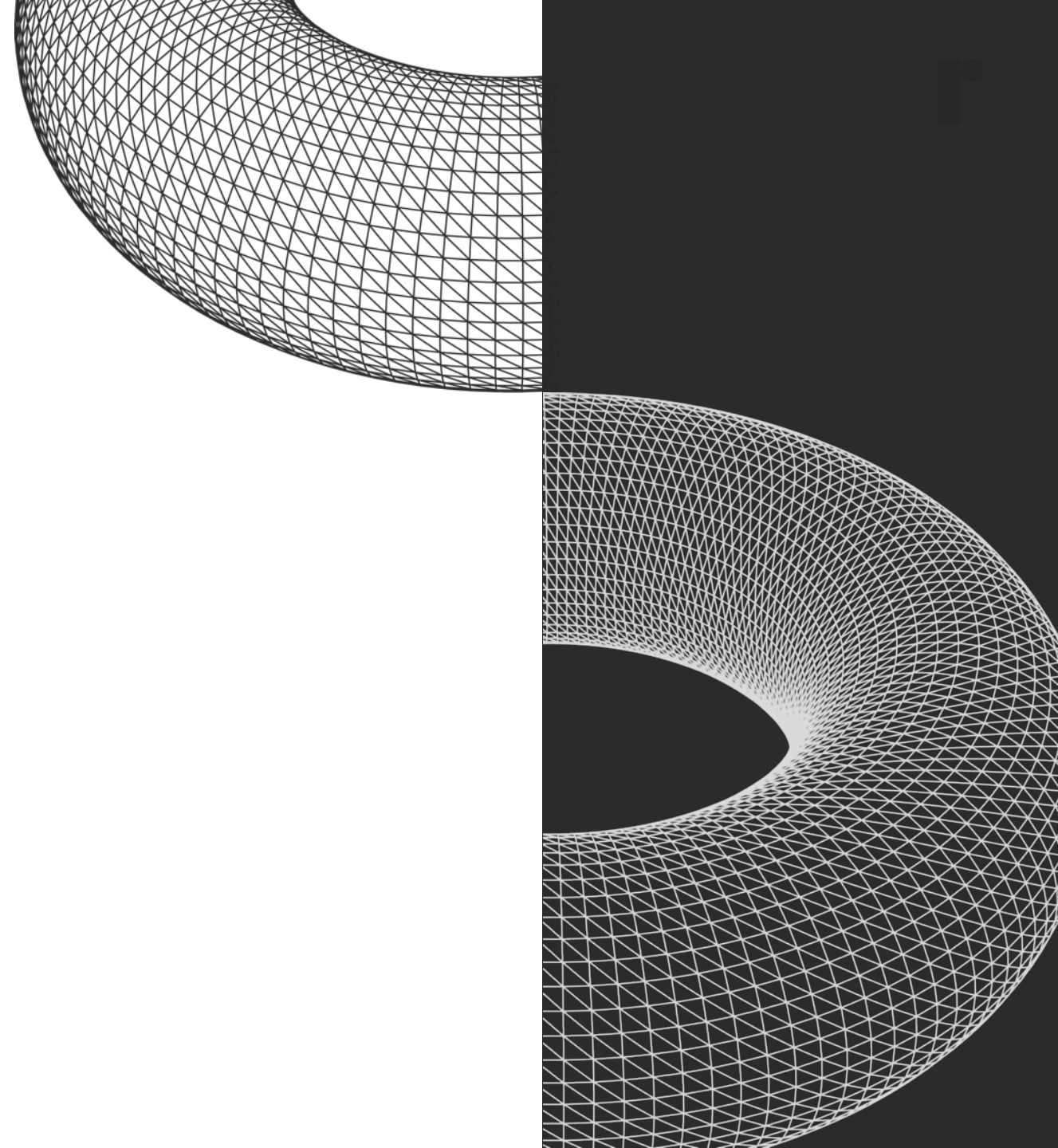
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Your Story – 1ST Pillar

Technology-related information

- Your technology/product & state of the art
- How was the technology/product conceived/developed:
 - What was the original motivation/problem?
 - Was there any technological challenge to solve the problem?
 - How the challenge was (re)solved/solution was found?
- What can be done differently in your solution?
- Alternative solutions to the problem
- Has a search been performed and what the search strategy was?*
- Is there a third-party involvement in the development of technical solution?

Your Story – 2ND Pillar

Business-related information

- What you expect to gain from the protection of the technology
- How will the company make money from the technology
- Who are the competitors and how can they make money from the technology
- Who are the players in the chain from production to end users and what is the company's place in that chain
- Expected shelf-life (short/long)
- Time/efforts needed for bringing an infringing product to the market
- Territories of interest (considerations: market, manufacturer/competition, investor/buyer)

Your story – 3RD Pillar

Your company's plans associated with the technology and its IP protection

- **Short-term, e.g.**
 - Mechanics: exposure to 3D parties – exhibition, presentation to potential customers/investors, early marketing, close tender)
 - HT: a near fund raising round, POC within X months, etc.
- **Long – term, e.g.**
 - Mechanics:
 - offensive protection – keep competitors away from your market in territories of interest;
 - defensive protection in a crowded field
 - HT:
 - become a world leader in XXX technology;
 - become a business partner of YYY MNC,
 - introduce to the market a disruptive solution ZZZ within X years
 - M&A with MNC, SPAC

From Your Story to Protection Strategy:

- If/how to protect: patents, designs, know-how (trade secret), defensive publication
- Patents & designs:
 - Scope-of-protection relating strategy – depending on the business model
 - Patents – what to claim (different categories; each claim - single infringer, broad/narrow scopes*)
 - Designs – what to show and how to show (solid lines, computer generated images, photos; disclaimers)
 - Filing strategy – depending on the business model and plans:
 - Quick grant/registration (e.g. for easy to copy and/or short shelf-life technology) in a territory of interest (patents with narrow claims, UMs with broader claims, designs)
 - patents: accelerated examination, e.g. for PPH,
 - designs: all inclusive multiple application/a number of single design applications; International filing
 - No acceleration (e.g. for technology that requires efforts for bringing infringing product to market)

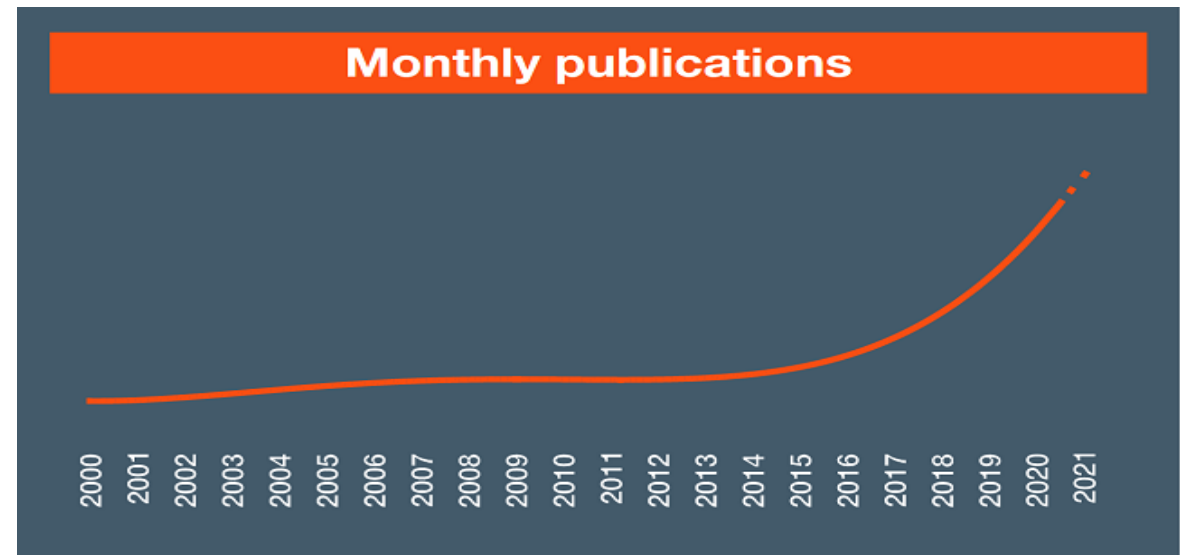
From Your Story to Protection Strategy:

- Publication strategy, if any
 - accelerate publication (patents – earlier than 18 months)
 - postpone publication:
 - non-publication during pendency for patents - US only,
 - postponing publication for designs, where available;
 - withdrawing priority application and priority claim (e.g. PCT)
- Patent examination strategy per territory: accelerated/delayed/continuation practice

From Your Story to Protection Strategy: Typical HT Example

- AI solution for Healthcare application story-
- Business model: R&D in Israel, competitors – expected “down the road”, sales B2B
- Short-term plans: POC vis-à-vis blood testing labs for validating the technology, exhibition within XX months;
- Long –term plans: Sales worldwide + exit SPAC: (specializing in health care)

Patent application numbers (at the EPO) for AI inventions



Source: Marks&Clerk , Jan 2021

From Your Story to Protection Strategy: Typical HT Example (cont.)

- Protection means: patents
- Scope-of-Protection relating strategy:
 - Patent: broad claim for each aspect + narrow claim for the entire product
- First-stage patent filing: IL with first OR US Track 1 at least with narrow claims
- Further filings and examination strategy: PPH with IL/US accepted claims + succession of cont/divisional apps.
- In case of “SPAC” business scenario:
 - Consult SPAC sponsor: for Spac-driven decisions: File “tactical” applications that meet SPAC considerations (e.g. file X applications: US non –publications including those covering ML “hidden” aspects)

From Your Story to Protection Strategy:

Typical Example for Consumer Goods

Consumer Product Manufacturer' story

- Business model: R&D in Israel, manufacturing in CN; competitors – expected to immediately copy as is, later infringement by designing around, sales via internet
- Short-term plans: first non-public exposure to CN in X months, exhibition in DE in XX months;
- Long –term plans: sales worldwide with aggressive measures against infringers

From Your Story to Protection Strategy:

Typical Example for Consumer Goods (Cont.)

- Protection means: patents, UMs & designs
- Scope-of-protection relating strategy:
 - **Patents**: broad claim for each aspect + narrow claim for the entire product
 - **Design**: the product as is and with different combination of disclaimed features (e.g. accessories)
- First-stage patent filing: IL/US with accel. exam. at least with narrow claims & CN/UM + DE/UM with broad claims
- Further patent filings: succession of divisional/continuation applications for different aspects + keeping pendency to adjust the scope of the claims to competitor's design-around attempts
- Patent examination strategy - PPH where available; accelerated examination in Europe
- Optional: request early patent publication
- Design filing: CN (to get registration asap); IL and/or US or International filing (if more than 2 territories of interest are member states of Hague Agreement)

From Your Story to Protection Strategy:

Mechanics - Examples for Specific Business Models



- Cheese package – a claim directed to intermediate infringer



- Diamond mapping & laser marking system – a claim covering both a system as a whole and a part thereof



- Medical device – strategy suitable when bringing an infringing product to the market requires substantial efforts



Quality Measures

Claims

- Claims – suiting your Story and protection strategy agreed on
 - HT: single client server, territories, data carrier
 - Mechanics: correct infringer, different categories and scopes, suitability for different jurisdictions
- Description
 - Correctness of technical description;
 - Support for claims (definition by result - 35 U.S.C. 112(f); Art. 84 + Guidelines; Art.13b)

Updates: Key Office Practices

USPTO

Claims- Preamble: is it binding for claims construction purposes? Yes, it may. (Elli Lilly VS. Teva CAFC)

- In contrast to apparatus and composition claims, claims to methods of using such apparatuses or compositions are not directed to what the method “is,” but rather they typically rely entirely on what the method “does.” And what a method does is usually recited in its preamble
- After this heavy emphasis on the treatment of vasomotor symptoms throughout the written description, the claims also reference such treatment, but only in the preambles. Thus, the preambles are the portions of the claims that embody the essence of the claimed invention methods for treating vasomotor symptoms.



Updates: Key Office Practices

EPO

New Guidelines came into force on the 1st March 2021, which include among *inter alia* the following:

Embodiments contained within an application, which are no longer covered by amended claims, should be deleted unless they can be deemed useful for demonstrating or highlighting aspects of the invention.

If such embodiments are retained, they must now be prominently marked as “*non-claimed embodiments*” or “*embodiments not covered by the invention*”.



Recommendations

Don't be biased by a pre-decided strategy before preparing your Story and meeting your IP advisor

Thank you!

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