

Claas Junghans, Adam Levy

Intellectual Property Management

A Guide for Scientists, Engineers, Financiers,
and Managers

*With Contributions By
Rolf Sander, Tobias Boeckh, Jan Dirk Heerma,
and Christoph Regierer*



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Contents

Preface XI

Authors XV

Abbreviations XVII

1 Terminology 1

Claas Junghans

1.1 The Terms of Patenting 1

1.1.1 The Patent 1

1.1.2 The Process of Patenting 2

1.1.3 The Value in a Patent 6

1.1.4 Anatomy of a Patent Document 9

1.1.5 Patentability of an Invention 13

1.1.6 Inventors and Applicants 15

1.2 Business Brief 16

2 The Economic Objectives of Protection 19

Claas Junghans

2.1 Filing Strategy 20

2.1.1 When to File? 20

2.1.2 Where to File: National Offices and International Treaties 20

2.1.3 Where to First File? 24

2.1.4 Follow-up Filings and the Territorial Extent of Protection 24

2.2 Claim Breadth: The Scope of the Desired Protection 25

2.3 Factors Influencing Filing Strategy and Claim Breadth 25

2.3.1 The Invention, the Product and its Market 25

2.3.2 Market Economics 26

2.3.3 Technology Density 28

2.3.4 The Commercialisation Plan 29

2.3.5 The Competition 31

2.4 Financial Resources and Attitude Towards Risk 32

2.5	Business Brief	33
-----	----------------	----

3 Patenting 35 *Claas Junghans*

3.1	Preparation	35
3.1.1	Planning	36
3.1.2	Assembling Material	36
3.1.3	Researching the Literature	38
3.2	Drafting the Patent Application	44
3.2.1	Attorneys	44
3.2.2	The Initial Filing as a Basis for Amended Claims	46
3.2.3	Non-Obviousness	50
3.2.4	Unity	52
3.3	Prosecution	53
3.3.1	Formalities	53
3.3.2	Representation	54
3.3.3	The Process	55
3.4	Strategy	58
3.4.1	Overview	58
3.4.2	Patenting an “Invention in Progress”	58
3.4.3	Patent Deadlines Driving Development	63
3.5	Conflict	64
3.5.1	Opposition	65
3.5.2	Revocation	65
3.5.3	Infringement	66
3.6	Business Brief	67

4 Ownership 69 *Rolf Sander*

4.1	The Rights of the Inventor	69
4.1.1	What is an Applicant?	70
4.1.2	Applicants in the United States of America	70
4.1.3	Joint Applicants	70
4.2	Disputed Ownership	72
4.2.1	Interference Procedure in the United States of America	72
4.3	Employee or Service Inventions	73
4.3.1	Germany	74
4.3.2	United Kingdom	75
4.3.3	France	76
4.3.4	Spain	76
4.3.5	Russia	77
4.3.6	USA	77
4.3.7	Japan	77
4.3.8	Korea	78

- 4.3.9 China 78
- 4.3.10 Hungary 78
- 4.3.11 Czech Republic 79
- 4.3.12 Poland 79
- 4.3.13 Sweden 80
- 4.3.14 Conclusion 80

5 Trademarks and Designs 81

Tobias Boeckh

- 5.1 Protection of Distinctive Marks 81
 - 5.1.1 Trademark Protection 82
 - 5.1.2 Internet Domains/e-Commerce 90
 - 5.1.3 Trade Names, Company Names and Titles 91
 - 5.1.4 Appellations of Origin 91
 - 5.1.5 Enforcement of Rights 91
- 5.2 Designs 92
 - 5.2.1 What is a Design? 92
 - 5.2.2 National and International Protection of Designs 93
 - 5.2.3 How and Where are Designs Registered? 94
 - 5.2.4 Implementation of Design Rights 95

6 Licensing 97

Jan Dirk Heerma

- 6.1 Licence Agreements – an Overview 98
 - 6.1.1 Introduction to Licensing 98
 - 6.1.2 Subject 98
 - 6.1.3 Scope 99
 - 6.1.4 Exclusivity 101
 - 6.1.5 Term and Termination 101
 - 6.1.6 Consideration 103
- 6.2 Sub-Licences 106
- 6.3 Up-Front Payments 107
- 6.4 Milestone Payments 108
- 6.5 Non-Cash Consideration 108
- 6.6 Taxation of Consideration 108
- 6.7 Representations and Warranties 109
 - 6.7.1 Ownership 109
 - 6.7.2 Third Parties' Rights 109
 - 6.7.3 Other 110
- 6.8 Maintenance and Prosecution of IP Rights 110
- 6.9 Confidentiality 111
- 6.10 Competition Law 111
 - 6.10.1 General Principles 111
 - 6.10.2 European Competition Law 112

- 6.10.3 US Competition Law 114
- 6.11 Governing Law and Dispute Resolution 114
 - 6.11.1 Governing Law 115
 - 6.11.2 Dispute Resolution 116
- 6.12 Negotiating Licence Agreements 117
- 6.13 Business Brief 118

7 Starting up and Financing Your Venture 119

Adam Levy

- 7.1 Risk, Return and Control 119
 - 7.1.1 What is the Return? 120
 - 7.1.2 Understanding Risk 121
 - 7.1.3 Managing Risk 122
 - 7.1.4 Control 123
 - 7.1.5 Inventive Myopia 125
- 7.2 Strategy 126
 - 7.2.1 Strategic Alignment 126
 - 7.2.2 Flexibility and Commitment 127
 - 7.2.3 The Extent of Product Development 127
- 7.3 Company Formation 128
 - 7.3.1 Assignment of IP 129
 - 7.3.2 Ownership Structure 130
- 7.4 The Business Plan 130
 - 7.4.1 People 131
 - 7.4.2 Invention 131
 - 7.4.3 Market 131
- 7.5 Financial Forecasting and Valuation 132
 - 7.5.1 Revenue Modelling 133
 - 7.5.2 Cost Modelling 133
 - 7.5.3 Net Present Value 133
 - 7.5.4 Real-World Valuation 135
- 7.6 Financing the Venture 136
 - 7.6.1 Start-up Funding 136
 - 7.6.2 Angel Investors 136
 - 7.6.3 Venture Capital 137
 - 7.6.4 Shareholder Structures and Agreement 138
 - 7.6.5 Working With Investors 139
- 7.7 Negotiation 140

8 The Importance of Business Structures to the Exploitation of IP 143

Christoph Regierer

- 8.1 Legal Forms of Transferring IP Ownership 144
- 8.2 Intellectual Property and Financial Reporting 146
- 8.3 Tax Aspects 149

8.3.1	Tax Considerations on the Company Level	149
8.3.2	Tax Considerations on the Shareholder Level	150

9 List of Annexes 151

Annex 1	Paris Convention for the Protection of Industrial Property (January 3 rd , 2005)	152
Annex 2	PCT Contracting States (as of July 7 th , 2005)	154
Annex 3	EPO member states and extension states as of July 2005:	157
Annex 4	Nice Classification of goods and services (8th edition) – Headings Goods and Services	158
Annex 5	International Classification for Industrial Designs under the Locarno Agreement – Headings Goods and Services	161
Annex 6	European Community Member States	162
Annex 7	Member countries of the Madrid Agreement and Madrid Protocol	162
Annex 8	ARIPO member states	162
Annex 9	OAPI member states	163
Annex 10	Country Codes	163

Index	167
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Preface

To the uninitiated, the world of intellectual property often appears an impenetrable collision of legal, scientific and economic themes. Indeed, the study of intellectual property draws from these three disciplines in a way that our educational and philosophical systems struggle to reconcile. Technically-expert lawyers, scientists and economists find it equally difficult to adopt a holistic overview and to look beyond their specialised field.

Whilst Patent Offices have recently intensified their efforts to be more accessible, publishing readable introductions to the very basic terms of intellectual property, and guides to initial patent application, these laudable efforts fail to penetrate the heart of the problem as we see it: the connection of legal procedure, beyond its mere application, with technological development and the business strategy that drives it.

“Intellectual Property Management” provides an introduction to the world of creating value through inventions. This book is written by international experts who from their day-to-day experience are able to position the technical and legal nature of patents within an economic and commercial framework. Readers are given a clear view of patents as a rational business process, and are presented with a toolbox with which to make careful assessment of the time and money that inventions warrant, concentrating on an assessment of risk, and within this framework, on maximising both value and personal return. From these carefully elaborated fundamental principles, we progress to address more complex and sophisticated issues of intellectual property strategic planning and wider corporate strategy.

The first four chapters of this book treat the aspects of patenting that both an inventor and a manager of an invention-intensive business will need to understand to make meaningful decisions on the subject. In doing so, the authors have concentrated on the underlying principles of the process, which are similar to almost all countries, rather than on precise definition of local regulations. Indeed, readers may note a certain European bias in the book. The European Patent Convention is both the largest judicial entity in the world of IP, and its law, in its synthesis of both Anglo-Saxon and French-German legal influences, presents a paradigm for most other patent systems in this world. The great exception to this rule is the USA, which treats many problems differently from all other systems.

Important differences are highlighted wherever necessary. Moreover, where easily readable literature exists in the English language on patenting, it is likely to concentrate on the US system, and the reader desiring to learn specifically about this system will find literature easily. Nevertheless, we hope that such readers will benefit from our specific treatment of the economic perspective.

Chapter 1, “Terminology”, defines the patent landscape, providing an elementary terminology and foundation upon which the remainder of the book builds. Readers already familiar with the world of patents may refer to this chapter as reference whenever needed.

Chapter 2, “The Economic Objectives of Patenting”, sets the economic framework in which patents reside, with an emphasis on the formulation of a basic patent strategy and a comprehensive explanation of patent routes and of patent scope and claim breadth. The authors have debated extensively the position of this chapter within the book. We have finally opted for moving it before the technical chapters on patenting, authorship and licensing. This position follows our conviction that in order to make a meaningful use of the legal tools that IP offers, one must define the economic objectives that drive the patenting process. All too often, resources are spent unwisely because the applicants did not consider their motives in submitting the application until far into the patenting process.

Chapter 3, “Patenting”, is the most technical chapter of the book. It discusses patent searching, drafting and application, and at what point, and how, to hire an attorney. The chapter concludes with an explanation of patent strategy in a dynamic research environment, and the exploitation of patent families. It must be emphasized that this book does not pretend to be a “do-it-yourself” guide to successful patent applications. Although there are cases where inventors have successfully patented and marketed their inventions, we do not encourage the reader to do so. Nevertheless, the cost and satisfaction of collaborating with a professional patent attorney can, in our view, often be improved substantially if the client, the inventor or applicant, has a good basic knowledge of the process and the variables of patenting.

Chapter 4, “Ownership”, takes a step backwards to identify the personal, legal and corporate issues around the ownership of patents, particularly those made by employees, whether or not related to their work.

Trademarks, design rights and other non-patent intellectual property rights are highlighted in Chapter 5. While most chapters address themselves mainly to readers interested in technical innovation, this book’s focus on the economic perspective of protection requires the complementary treatise of these “soft” non-technical rights in this context. This protection, which is often more effective in the market and easier to enforce in court, is not of the inner technical “idea” or inventive essence of a product, but of its name and design. Capturing value through product innovation requires the protection of both marketing and technical elements.

Chapter 6, “Licensing”, takes a corporate perspective, discussing the licensing of technology IP, exposing the reader to the complexity of commercial and competition law. In doing so, the reader will be prepared to address the key aspects of license drafting and to work fully and successfully with professional advisors.

Chapter 7, “Starting Up”, revisits ideas around risk and return, and relates these carefully to the inventor or entrepreneur, outlining how to establish a start-up company around an intellectual property portfolio. Assuming that the inventor takes the advice of the previous chapters, Chapter 8 discusses the real-life application of tax laws around IP for both the individual and corporation. As becomes apparent, consideration of these parameters may have a profound influence on the overall financial balance of the inventive process.

“Intellectual Property Management” covers the spectrum of the patent world, from basic patenting to corporate taxation. This breadth is somewhat unusual, but reflects the authors’ conviction that the effective and competitive management of innovation is dependent on an integrated and considered strategy. Engineers and scientists today must be encouraged to think about the commercial applicability and, more specifically, patentability of their inventions. Only with the careful definition of the economic drivers behind an invention, will such patenting create value for its inventors, and more widely, make a meaningful contribution to the broader economy. Poorly written and badly planned applications congest the legal and patent systems, lead to poor resource allocation and are an impediment to economic and technical development.

Well-written, granted patents, on the other hand, that respond to the commercial profile of the applicant, that can be licensed, and which are optimally adapted to the competitive landscape, will have fulfilled their potential, and that of the invention. That is the goal of this book.

Adam Levy and Claas Junghans
October 2005

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Abbreviations

CTM	Community Trademark
ECLA	European Classification System
EP	European Patent, country code for the EPO
EPC	European Patent Convention
EPO	European Patent Office
IP	Intellectual Property
IPC	International Patent Classification
IR	International Registration
PCT	Patent Cooperation Treaty
USPTO	United States Patent Office
WIPO	World Intellectual Property Organization