

HØIBERG Patent School

Patenting 101

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Practical information

- **The webinar is recorded**
 - Available on our webpage within the next couple of days
 - All participants are kept anonymous in the recording
- **Please ask any questions in the “Q&A”- box**
 - Questions will be answered at the end of the webinar unless a specific question requires “immediate attention”
- **15-20 second time lag**
 - Questions are received in real-time but answers/comments will come with a delay

Speakers



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Agenda

- **What is a patent?**
 - When to patent?
 - What can be patented?
 - Inventor and owner
- **How to read a patent?**
 - Structure of a patent
 - Claim structure
- **The patenting process**
- **Q&A**

What is a patent?

Why is patenting the answer?

Patents:

Intellectual Property

- capture the "knowledge" component and permit value extraction

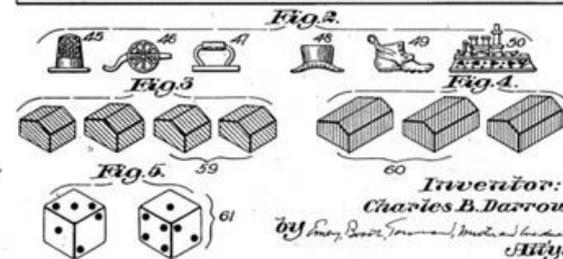
Commercialization

- are published for the common good

What is a patent?

- Monopoly
- Right to forbid others to exploit the invention
- No (automatic) right to exploit the invention
- Provides a description of the invention
- Lasts for 20 years

Dec. 31, 1935. C. B. DARROW 2,026,082
BOARD GAME APPARATUS
Filed Aug. 31, 1935 7 Sheets-Sheet 1



Patents are Intellectual Property

And as such are commercial products:

- They may be sold or licensed
- And may give rise to cooperation



Why should I patent?

The Story about PCR:

Kary Banks Mullis

10.000\$ (and the Nobel Prize, 1993)

Cetus Corporation

300.000.000\$

Kjell Kleppe & Har Gobind
Khorana

a publication



The moral of the story:

Think twice before publishing your ideas

Why only get **fame** when you can get **fame & fortune!**

When to patent and when not to patent

When to patent?

- When the technology is mature, that is
- When the invention can be supported by examples

but:

- Before publication
- Before the competitors patent or publish!

Publish - and Perish

- Never, never publish your findings before speaking to a patent attorney
- Never, never in an article point to what your new findings might be good for
- Anything you publish: posters, abstracts, homepages, sales brochures etc.

→ WILL BE FOUND



Publish or Perish vs Patent and Prosper

By Pernille Winding Gøjkovic, HØIBERG A/S

June 2015

Scientists are judged on their publication rate and the phrase *Publish or Perish* is the cliché often cited as a rule to live by. In this article we'll explain why scientist should also think *Patent and Prosper* instead of only *Publish or Perish*.

Imaging funding your own research! That is what a patent on your great invention can do for you.

Despite the existence of laws not only enabling but also in many instances requiring that publicly employed scientists commercialize their research, a deep wariness of patenting is still found in many academic environments. The wariness is often based on myths - the most common of which are dispelled in this article. Having a patent on your great invention may provide a source of income, count as a publication on your CV and establish collaborations with industry partners - that is why all scientist ought to consider patenting before publishing. When considering whether to publish or patent always keep in mind that if you even think about patenting, you need to wait with publishing until your patent application is filed. If you don't, your own article will make it difficult or even impossible to obtain a patent on your great invention.

The most common myths we hear as reasons for not patenting are:

If I patent, my science will be kept a secret

This statement reveals a complete misunderstanding of the patent system. The word "patent" comes from the Latin word "patere" which means "to lay open" - in other words to make what is disclosed in the patent available to the public. All patent applications are published 18 months from the date of filing and are publicly available in searchable patent databases. Furthermore, once you have filed at least your priority

founding patent application, you can publish a scientific article detailing your science. In other words: applying for a patent is a genuine two-for-one situation as it may give you two publications (with different scope) for the same research.

If I patent, I can't publish my science

This is a common misinterpretation due to the phrase many journals employ in their guidelines for authors, which often state that articles submitted must be *original research which has not been reported or submitted elsewhere*. This does not preclude patenting. You may however need to inform the journal of your financial interest in having your research published - the publication of your research article is likely to cause the value of your patent application to rise.

If I patent, my science is not benefitting the public

This only holds true if you do not make use of your patented invention. As a patent holder you have the right to forbid others to make or use your invention. You also have the right to license out the invention to interested parties, who can help you commercialize your invention - i.e. make it available to the public.

In fact, very often the opposite is true: if you do not have a patent on your invention nobody is interested in commercializing and making your invention publicly available. With e.g. pharmaceuticals there are many years of expensive trials before the product enters the market. Obviously, the companies who make these investments want to make sure - as far as possible - that an income will arrive, and they can only be sure of this if the drug is not copied and sold cheaply by everybody. The companies that make the investments can only be sure of this, if the drug is patented.

To patent or not to patent?

When NOT to patent

- When it doesn't pay off
 - Patenting too expensive compared to commercial gain
 - Fast moving product / first mover – don't “waste” time – push product
- When idea is more of an innovation than an invention
- When you risk publishing sensitive know-how

What can be patented?

Patentability - Requirements



Patentable subject matter



Novel



Inventive / non-obvious



Industrially applicable (useful)

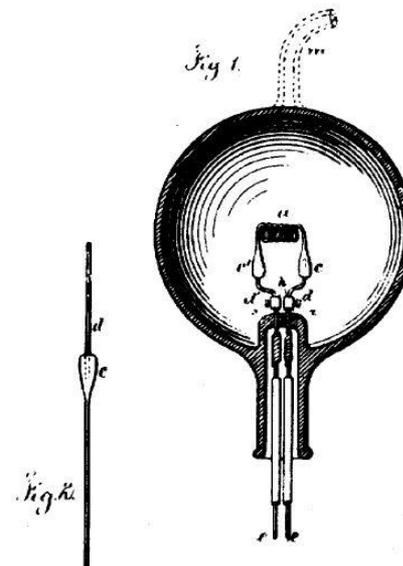


Sufficient description

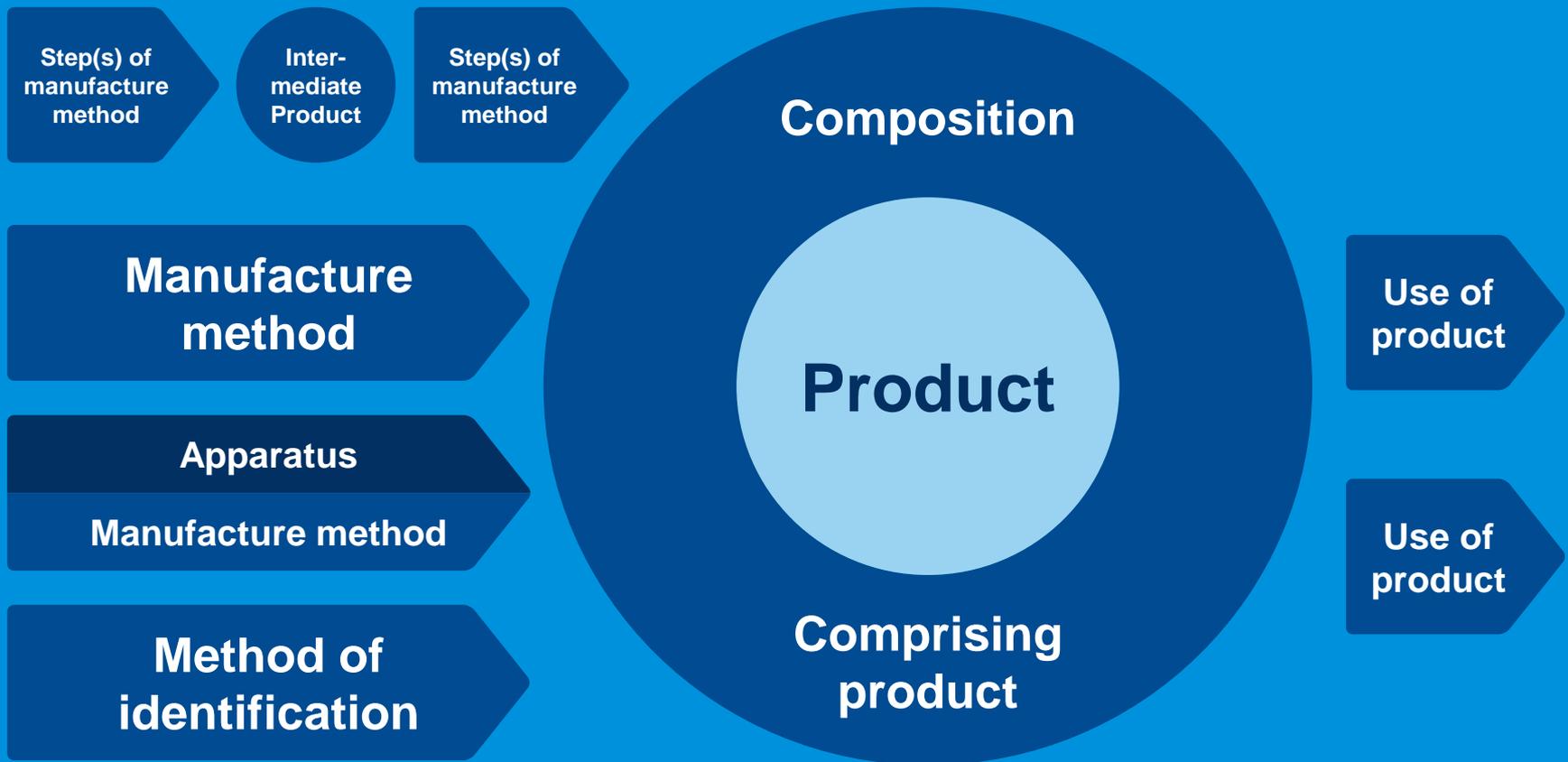
T. A. EDISON.
Electric-Lamp.

No. 223,898.

Patented Jan. 27, 1880.



Technologies to be patented



Who is inventor & who is owner of a patent?

What is an inventor?



An inventor is a person

The inventor is the person having conceived the idea

The invention may be conceived by two or more in conjunction

Inventor(s) has(ve) the right to be identified in the patent – and may ask to be anonymous

You are not an inventor if you:

Worked according
to instructions
from others

Conceived an idea –
without suggestions
to its solution

Provided
obvious parts
of the invention

Provides
financial
support

Merely tested
the invention

Is the leader
of the departe-
ment or lab

Inventors

- **Rules** for being an inventor correspond largely to the **Vancouver recommendations** for being an author
- The **Order** of names on a patent does not signal any importance of the contribution of the inventor
- **Errors** in designation of inventors may lead to an invalid patent in the USA
- The assignee is the owner of the patent
- The assignee can be the inventor or another person or company

How to read a patent?

The Patent Document

Background

Summary of Invention

Description of drawings

Detailed description

Examples

Claims

Drawings

EP 0 685 168 B1

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How to read a patent

- **To get a general impression of the patent**
 - Emphasis on the abstract, claims and the examples
 - If in the mechanical field also drawings
- **Freedom to Operate**
 - Focus on the claims – if matter is unclear consult the description
- **Patentability analysis**
 - Entire document

(12) INTERNATIONAL APPLICATION PUBLISHED UNDER THE PATENT COOPERATION TREATY (PCT)

(19) World Intellectual Property
Organization
International Bureau



WIPO | PCT



(10) International Publication Number

WO 2018/001882 A1

(43) International Publication Date
04 January 2018 (04.01.2018)

(51) International Patent Classification:

C12C 1/027 (2006.01) C12C 7/047 (2006.01)
C12C 1/047 (2006.01) C12C 1/02 (2006.01)

Søborghus Park 2, 1.th., 2860 Søborg (DK). MARRI, Lucia; Peter Bangs Vej 141, 3. th., 2000 Frederiksberg (DK). OLSEN, Ole; Holmbladsgade 102, 2.tv., 2300 Copenhagen S (DK).

(21) International Application Number:

PCT/EP2017/065498

(74) Agent: HØIBERG P/S; Adelgade 12, 1304 Copenhagen K (DK).

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WO = International application

EP = Europe

US = United States

Background, Summary and detailed description

- **Background**
 - Can be used to set the scene
 - Description of relevant prior art
- **Summary**
 - Can explain the invention – what problem does the invention solve?
 - Frequently includes copy of the independent claims
- **Detailed Description**
 - Describes the invention and possible variations of the invention

Types of claims

A method/process for manufacture, comprising the steps of:

1. XX
2. XX

Covers the method as well as products directly obtained by the method.

A method/process for other purposes, comprising the steps of:

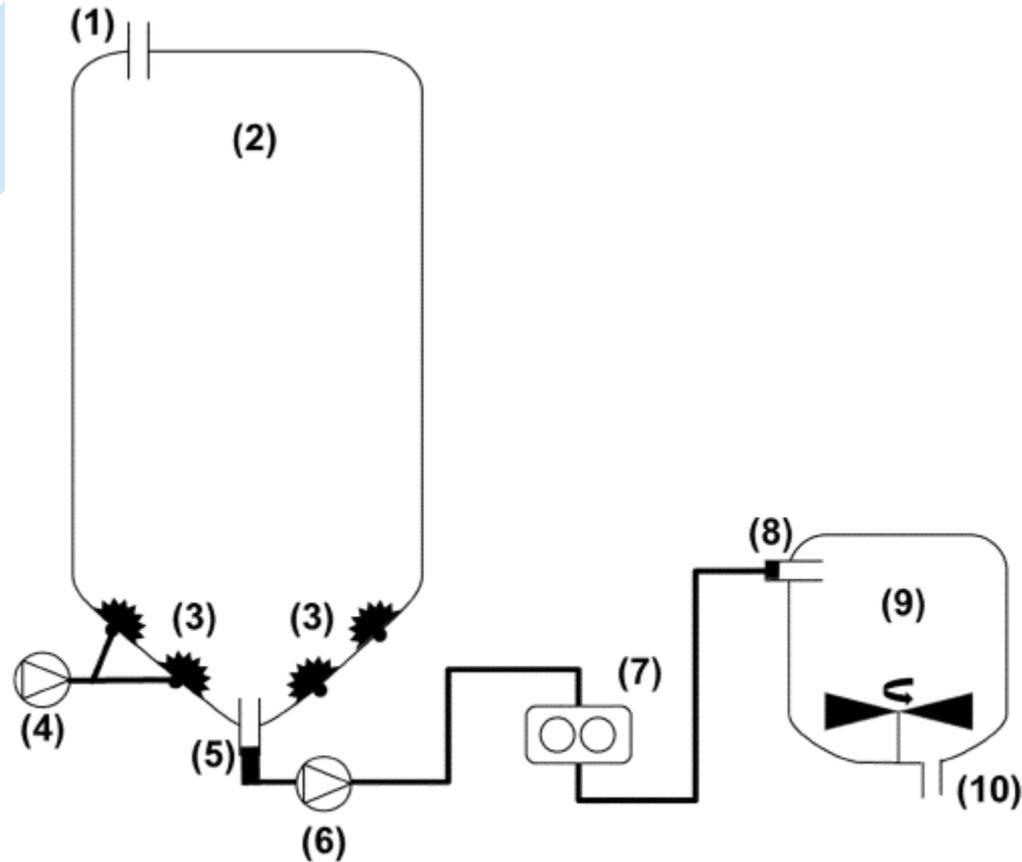
1. XX
2. XX

Covers the method

A product XX

Covers the product as well as all preparing the product and all uses of the product

Drawings can be used to describe the invention – Ex. Figure 1



The Monopoly = the claims

- The patent claims are written together with the inventors in a teamwork
- Strict legal language is required
- Must take national differences in law and practice into account

Claims

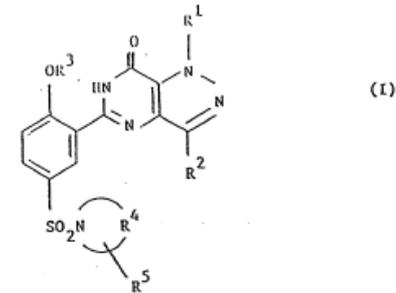
5 Claims for the following Contracting States : AT, BE, CH, DE, DK, FR, GB, IT, LI, LU, NL, SE

1. A compound of the formula:

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25 wherein

R¹ is H, C₁-C₃ alkyl, C₃-C₅ cycloalkyl or C₁-C₃ perfluoroalkyl;

R² is H, C₁-C₆ alkyl optionally substituted by OH, C₁-C₃ alkoxy or C₃-C₆ cycloalkyl, or C₁-C₃ perfluoroalkyl;

30 R³ is C₁-C₆ alkyl, C₃-C₆ alkenyl, C₃-C₆ alkynyl, C₃-C₇ cycloalkyl, C₁-C₆ perfluoroalkyl or (C₂-C₆ cycloalkyl)C₁-C₆ alkyl;

R⁴ taken together with the nitrogen atom to which it is attached completes a pyrrolidiny, piperidino, morpholino, or 4-N-(R⁵)-piperazinyl group;

R⁵ is H, C₁-C₄ alkyl, C₁-C₃ alkoxy, NR⁷R⁸, or CONR⁷R⁸;

35 R⁶ is H, C₁-C₄ alkyl, (C₁-C₃ alkoxy) C₂-C₆ alkyl, hydroxy C₂-C₆ alkyl, (R⁷R⁸)C₂-C₆ alkyl, (R⁷R⁸NCO)C₁-C₆ alkyl, CONR⁷R⁸, CSNR⁷R⁸ or C(NH)NR⁷R⁸;

R⁷ and R⁸ are each independently H, C₁-C₄ alkyl, (C₁-C₃ alkoxy)C₂-C₄ alkyl or hydroxy C₂-C₄ alkyl;

and pharmaceutically acceptable salts thereof.

40 2. A compound as claimed in Claim 1 wherein R¹ is H, methyl or ethyl; R² is C₁-C₃ alkyl optionally substituted by OH or methoxy; R³ is C₂-C₃ alkyl or allyl; R⁴ taken together with the nitrogen atom to which it is attached completes a piperidino or 4-N-(R⁵) piperazinyl group; R⁵ is H, NR⁷R⁸ or CONR⁷R⁸; R⁶ is H, C₁-C₃ alkyl, hydroxy C₂-C₃ alkyl, CONR⁷R⁸, CSNR⁷R⁸ or C(NH)NR⁷R⁸; and R⁷ and R⁸ are each independently H or methyl.

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3. A compound as claimed in Claim 2 wherein R¹ is methyl; R² is n-propyl; R³ is ethyl, n-propyl or allyl; R⁴ taken together with the nitrogen atom to which it is attached completes a 4-N-(R⁵) piperazinyl group; R⁵ is H; and R⁶ is H, C₁-C₃ alkyl or 2-hydroxyethyl.

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4. A compound as claimed in Claim 3 wherein said compound is selected from:

5-[2-allyloxy-5-(4-methylpiperazinylsulphonyl)phenyl]-1-methyl-3-n-propyl-1,6-dihydro-7H-pyrazolo[4,3-d]pyrimidin-7-one;

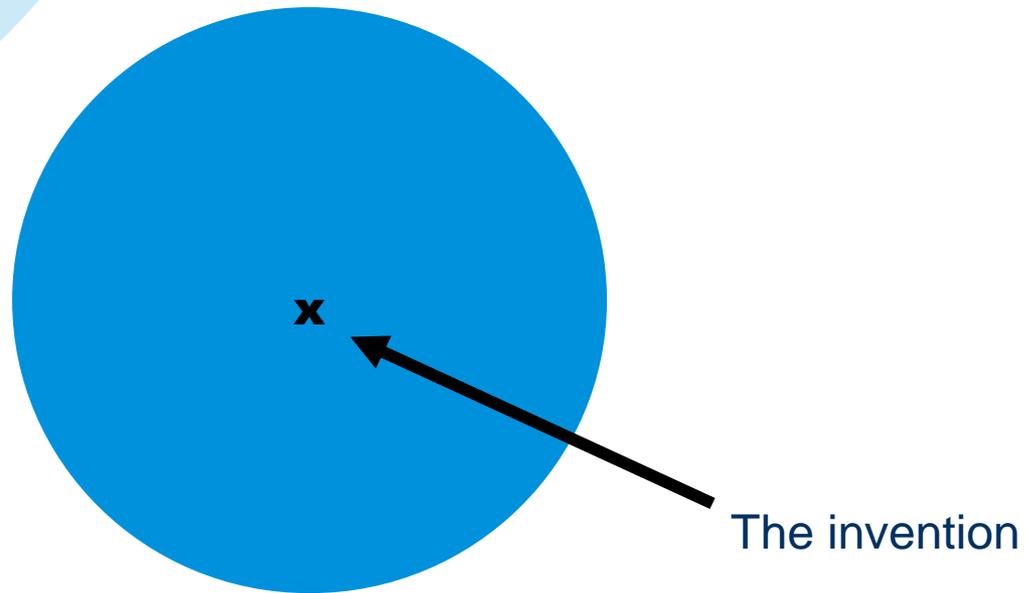
5-[2-ethoxy-5-(piperazinylsulphonyl)phenyl]-1-methyl-3-n-propyl-1,6-dihydro-7H-pyrazolo[4,3-d]pyrimidin-7-one;

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5-[2-ethoxy-5-(4-methylpiperazinylsulphonyl)phenyl]-1-methyl-3-n-propyl-1,6-dihydro-7H-pyrazolo[4,3-d]pyrimidin-7-one;

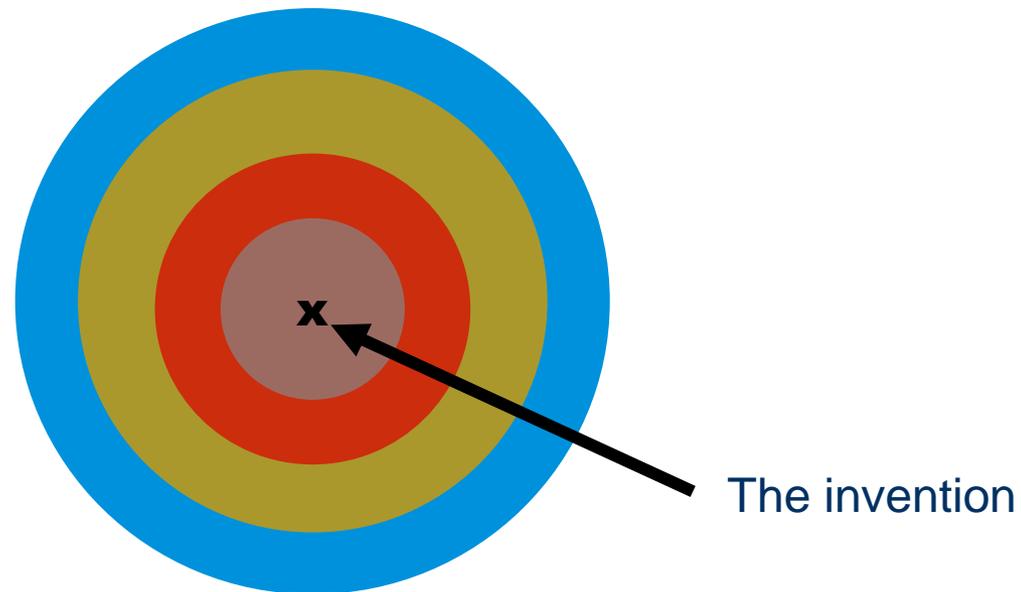
5-[2-ethoxy-5-[4-(2-propyl)piperazinylsulphonyl]phenyl]-1-methyl-3-n-propyl-1,6-dihydro-7H-pyrazolo[4,3-d]pyrimidin-7-one;

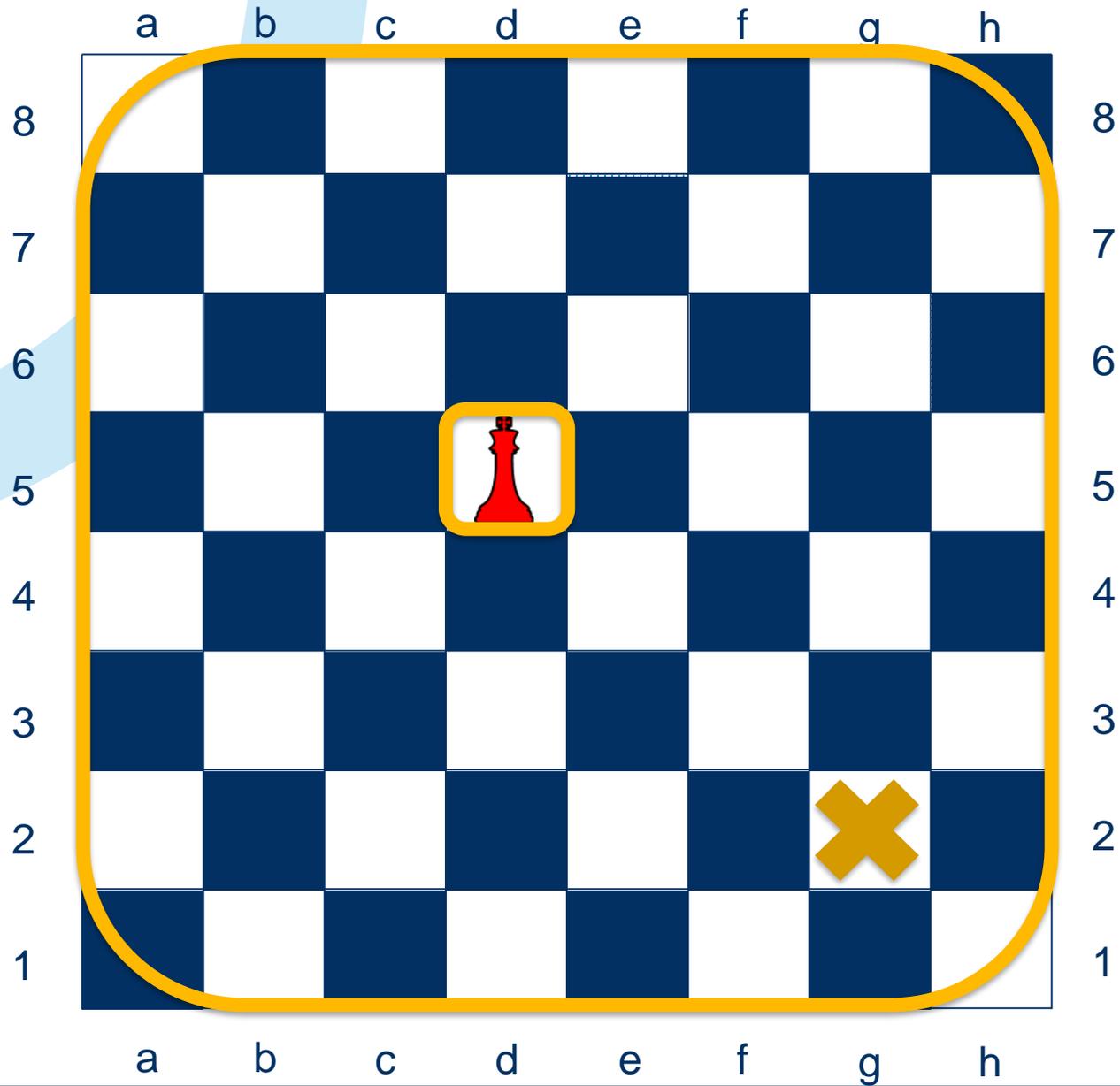
The scope of protection

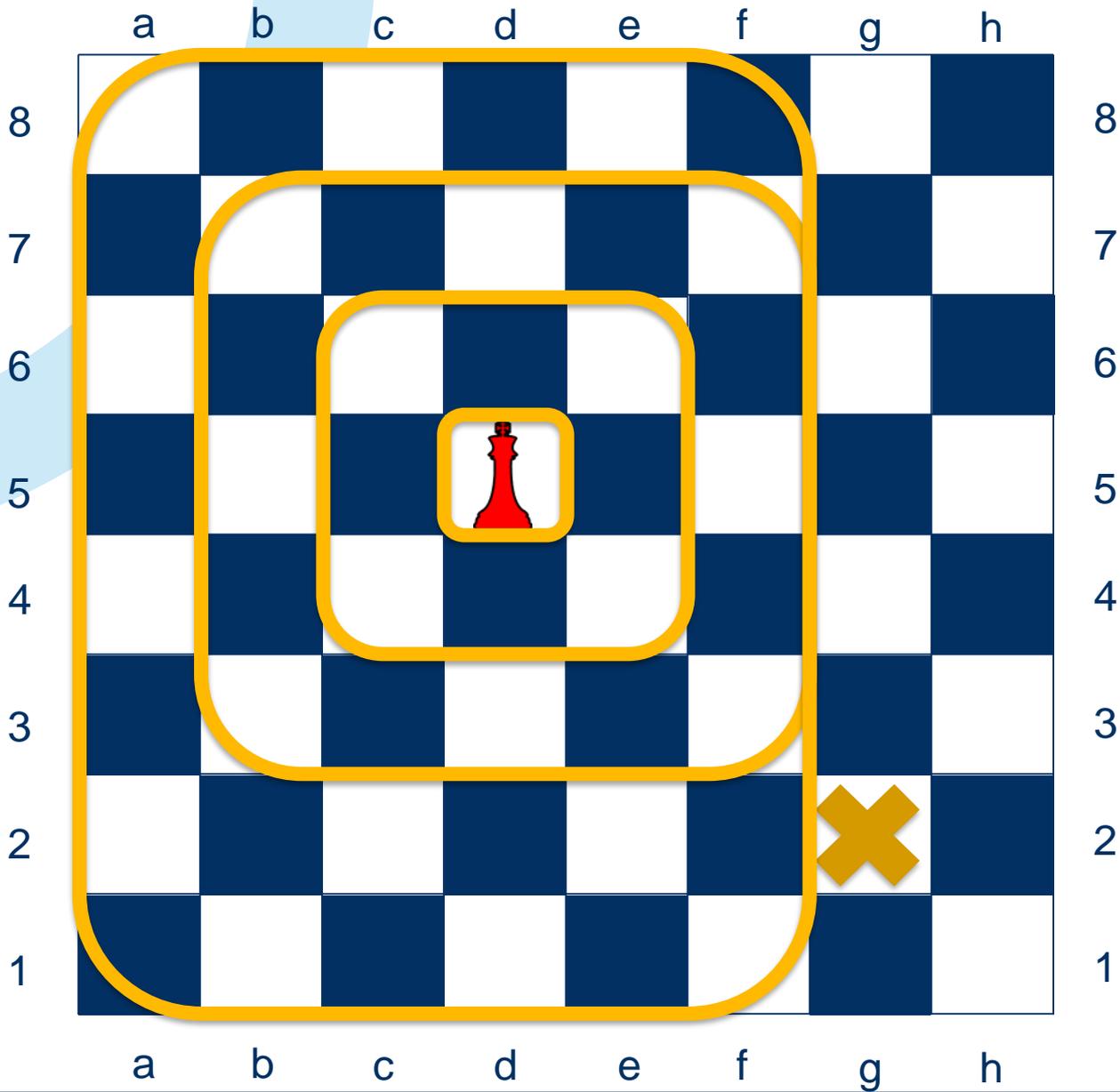


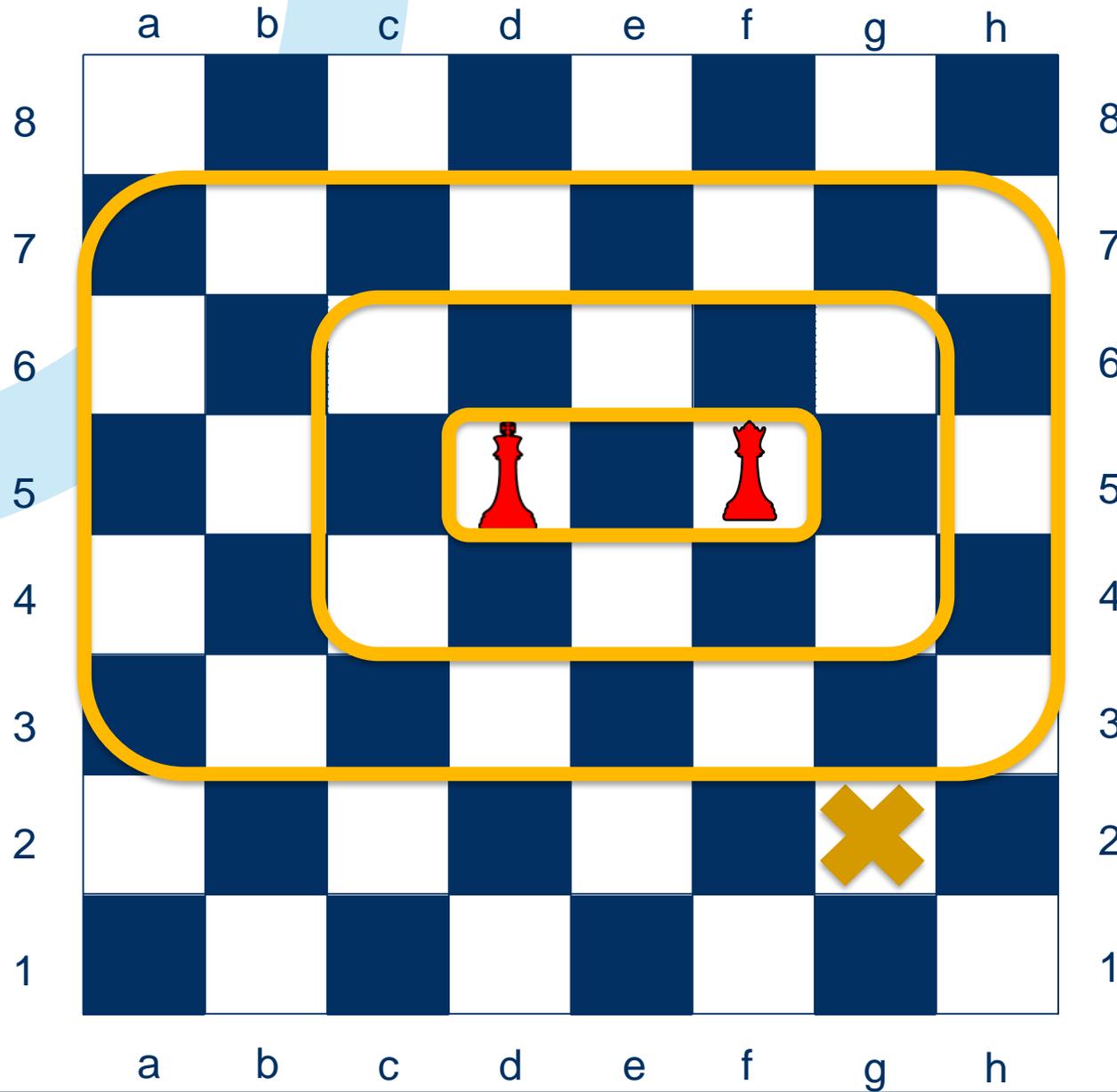
The scope of protection

- many layers of protection provides better certainty for a good patent









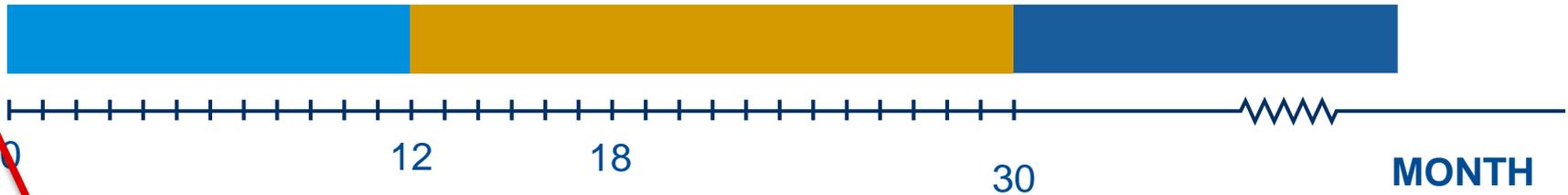
The patent process

Patent process

PRIORITY YEAR

PCT PHASE

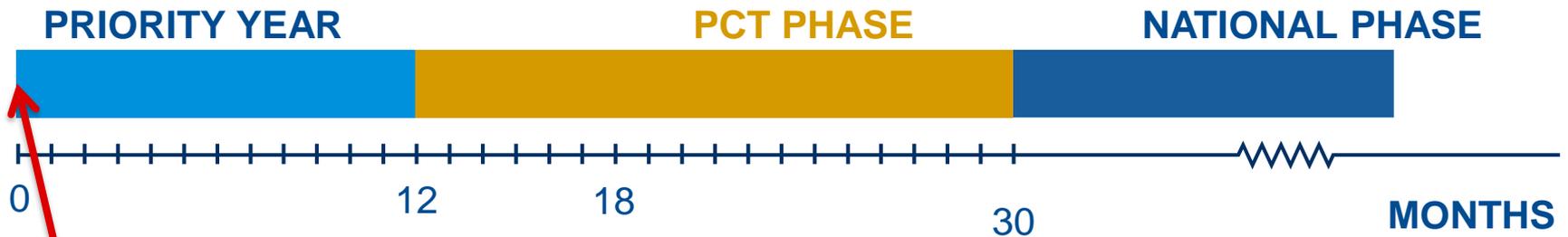
NATIONAL PHASE



Before we start

- Evaluate patentability of the invention – novelty search
- Evaluate the commercial relevance of the patentable invention
- Evaluate the possibility of supporting the invention with data

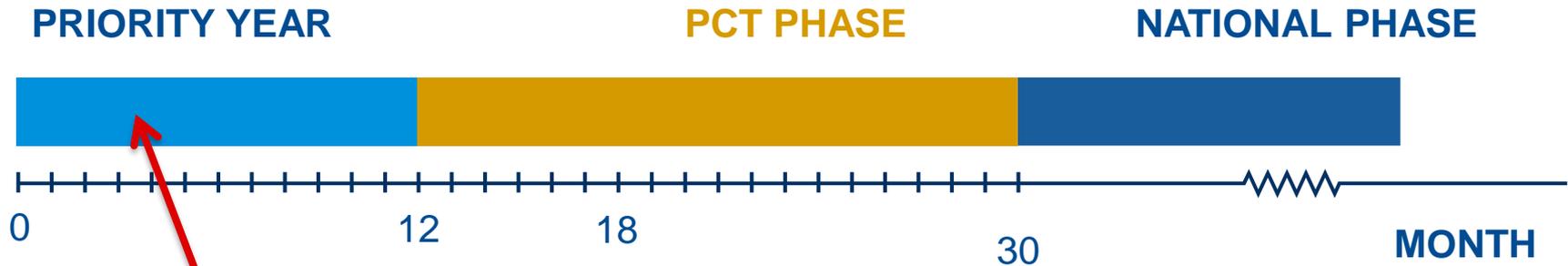
Patent process



Drafting and filing the patent application

- **Patent text and claims are drafted in cooperation with inventors**
 - **Scientifically correct description**
 - **Commercially relevant description**
- **Filing of the patent application**
 - **Foreign inventors?**
 - **Cooperation with other universities/companies?**

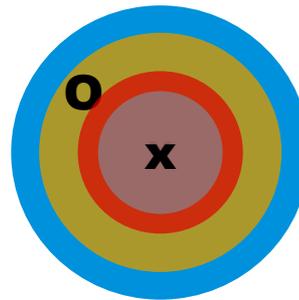
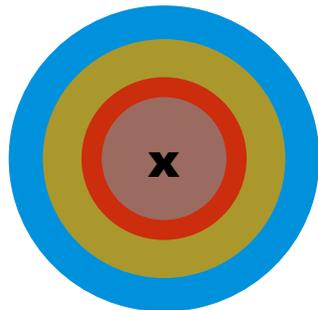
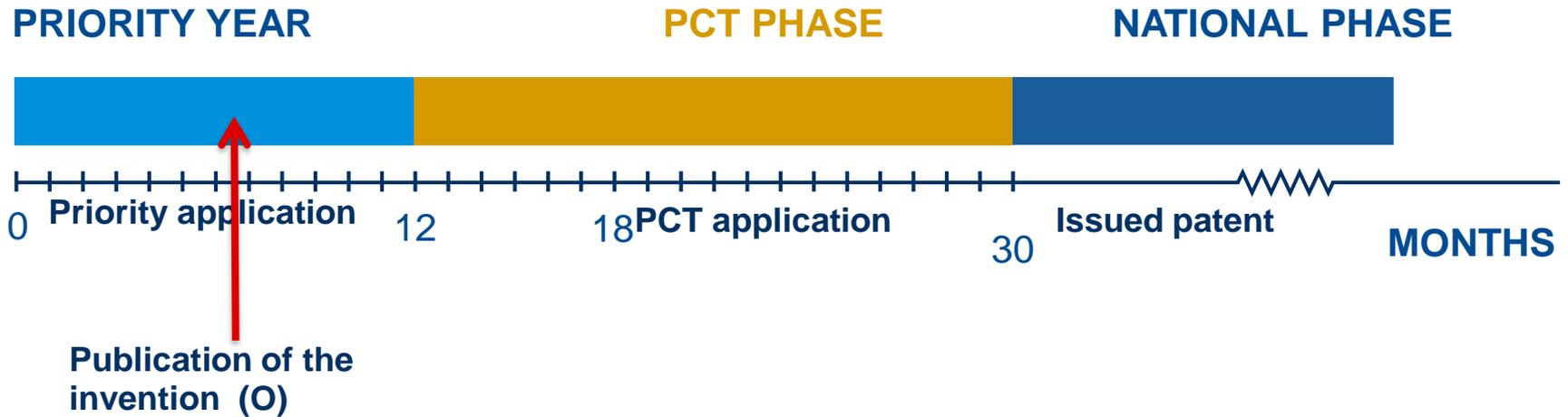
Patent process – the priority year



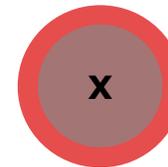
Priority year

- Review publications describing new ideas in the field from the inventors
- Update patent text if new ideas/new results

Patent process

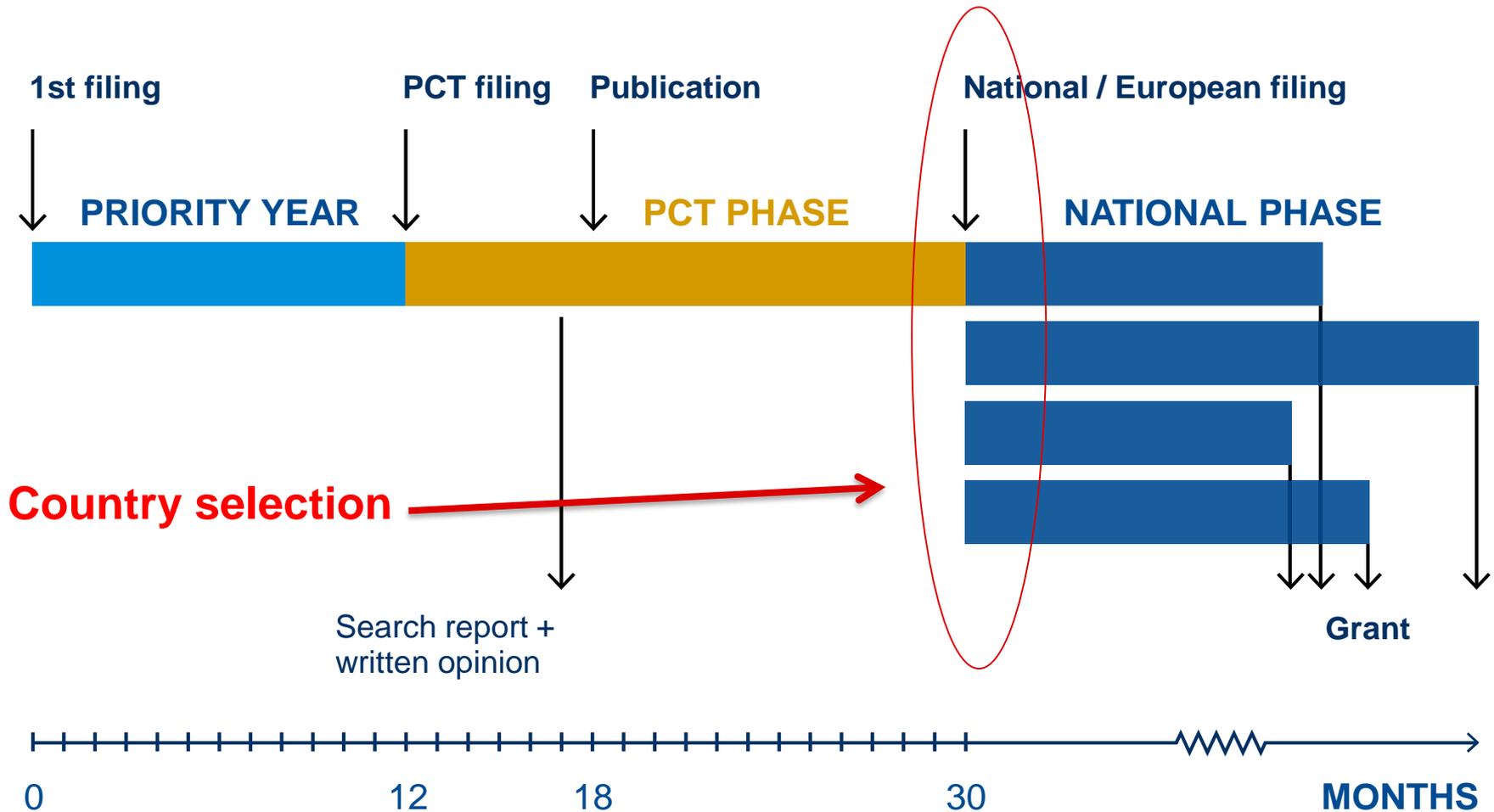


Patent

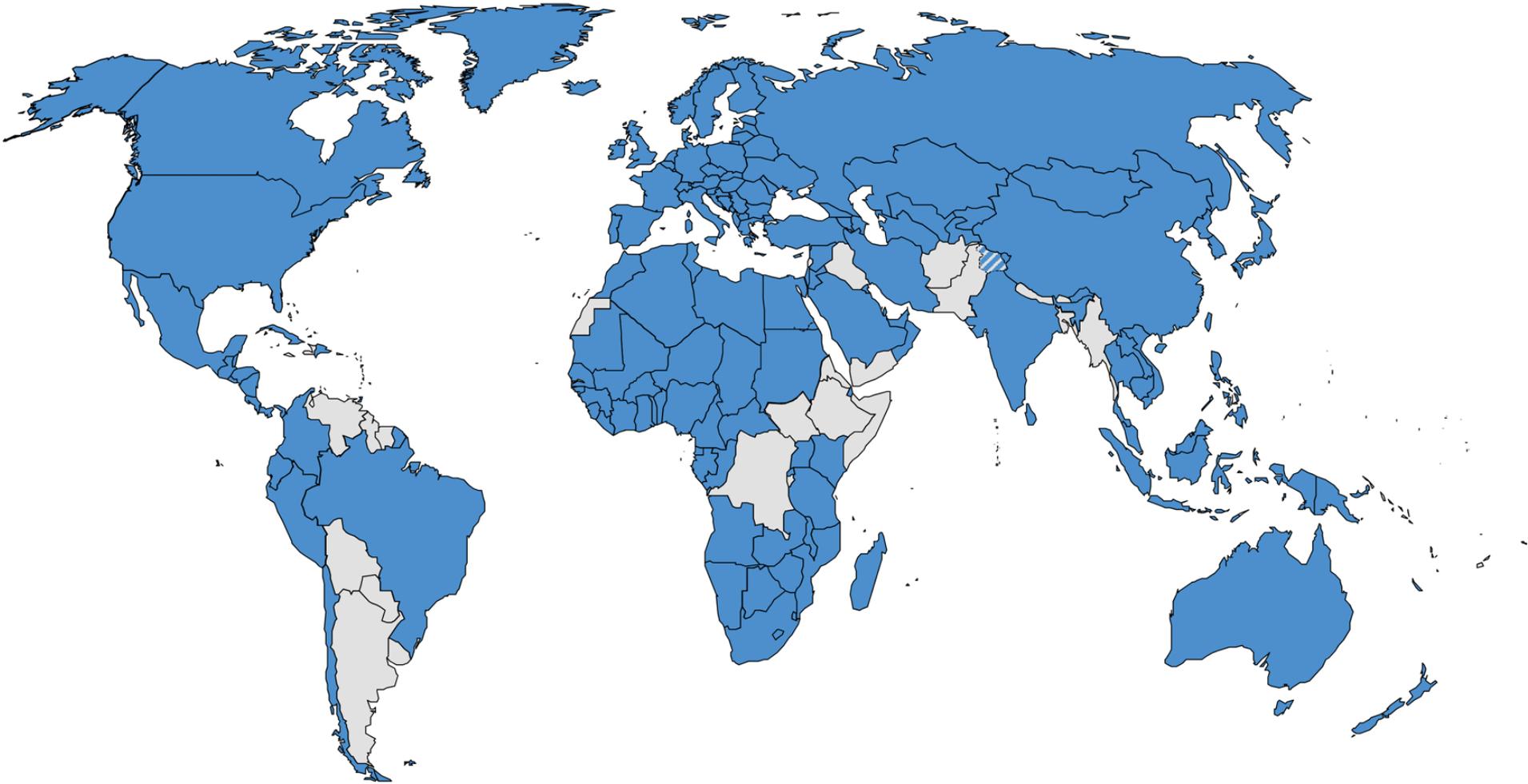


X= invention, O= prior art

One patent application strategy



PCT-countries



Q&A

Thank you!

A recording of this webinar will be available on <https://hoiberg.com>

The topic of the next HØIBERG Patent School webinar is:

"Patentability: Novelty and Inventive step"

January 20th, 2021

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