


Presentation

ATPi Workshop
Menzies Library, ANU

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Experience & Size

- 220 total staff
- 27 Patent Attorneys
- 25 Lawyers
- 16 PhD graduates
- Members of more than 30 professional associations
- Many Principals are office holders in industry and related professional associations

Patent attorneys

- Required to have qualifications in science or engineering
- Must pass a professional course of study in IP law and practice.
- Write patent specifications (technical writers)
- File, prosecute, assert and defend patent rights for clients

Traditional IP rights (the slide of death!)

- Patents – inventions
- Designs – shape and appearance of articles
- Copyright – literary or artistic works
- Trade marks – symbols of trade origin
- Confidential information/know how
- (Integrated) Circuit layouts – mask works
- Domain names – internet P.O. Boxes

The patent marketplace I

- 1.7 million new patent applications filed worldwide in 2007
- Estimated 3.5 million unexamined (pending) patent applications in the world at present

Why patent?

Patents provide:

- Opportunity to prevent third parties using your technology
- Opportunity to prevent third parties from excluding you from your technology
- Generate revenue
 - Assignment (sale)
 - Licensing
 - Joint ventures

Why patent? (cont'd)

- Pharma - US\$ 800(?) million from bench to market
- Potential returns are linked to market exclusivity
- Patent provides an incentive for innovation, without which industry would be unwilling to invest time and money in R&D.

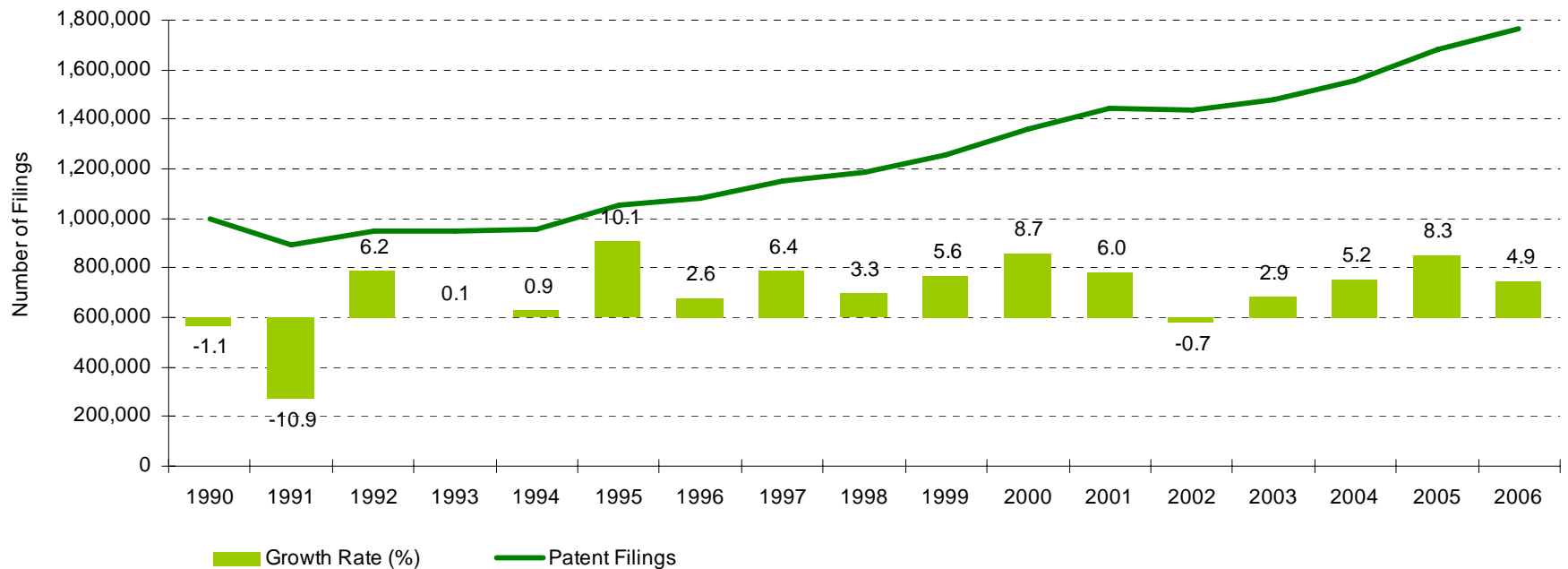
Why patent? (cont'd)

Patents cover more than they did 10 years ago

- Biotechnology – microorganisms, genes, antibodies, processes etc
- Software
- Business processes
- Medical device
- Most discoveries with a technical application

Why patent? (cont'd)

- There's more IP around



The patent marketplace II

Top 10 Patent Awards in 2006:

	Award	Winner	Loser
1.	\$307 million	Rambus	Hynix Semiconductor
2.	\$133 million	Z4 Technologies	Microsoft, Autodesk
3.	\$112 million	Texas Instruments	GlobespanVirata
4.	\$78.9 million	Finisar	DirecTV Group
5.	\$74 million	TiVo	EchoStar Communications
6.	\$65.2 million	Ariad Pharmaceuticals	Eli Lilly
7.	\$53.4 million	LG Philips LCD	Tatung
8.	\$52.5 million	LG Philips LCD	Tatung
9.	\$38.5 million	MuniAuction Inc.	Thomson
10.	\$34 million	Power Integrations	Fairchild Semiconductor

Patent specifications

- General background description
- Detailed description, sufficient to put the invention into practice.
- Claims defining the scope of protection

Patents 101

- Rights are obtained, with limited exceptions on a country-by-country basis
- Steps:
 - Filing
 - Prior art search and examination by Patent Office (narrowing of scope)
 - Refusal or grant

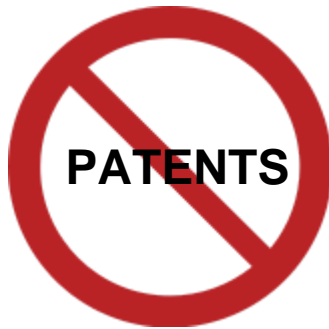
Examination

The claimed invention must be:

- Novel, and
- Inventive/non-obvious.

over the prior art

What are the other approaches?



- Open source
- Confidential information/know how

Search the patent literature too!

- Free, full-text searching is available at:



<http://ep.espacenet.com/>



<http://patft.uspto.gov/netahtml/PTO/search-adv.htm>
<http://appft1.uspto.gov/netahtml/PTO/search-adv.html>

Golden rules

- Do not disclose an invention to anyone before a patent application is filed
- Think about ownership at the outset
- Document the research rigorously
- Document any searches of the technical and patent literature

A salutary tale

- *Cohen, Boyer, and colleagues at Stanford and UC San Francisco wrote three landmark papers in 1973 and 1974 which demonstrated the method's use in cloning the DNA of both lower and higher organisms, such as Xenopus, the African horned frog.*

(Source: <http://bancroft.berkeley.edu/Exhibits/Biotech/25.html>)

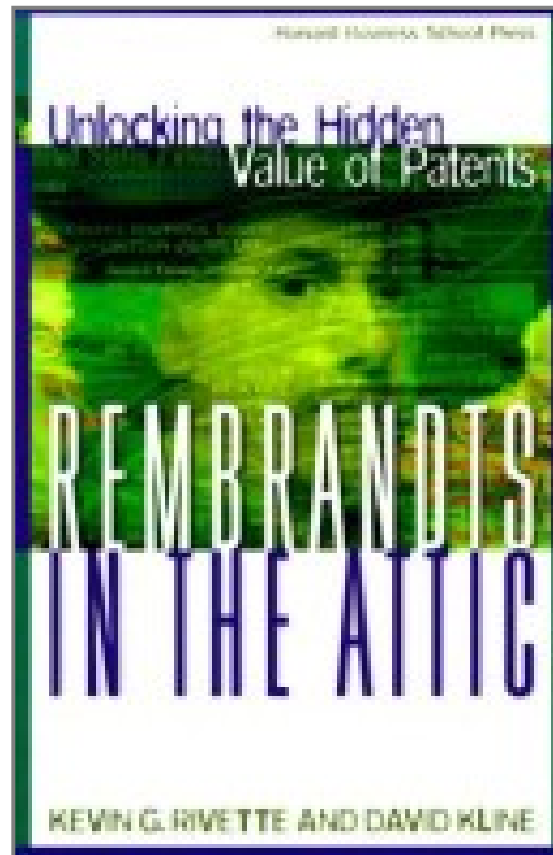


A salutary tale (cont'd)

- Niels Reimers, manager of Stanford's Office of Technology Licensing saw the potential of the rDNA technology after reading an article in the New York Times, and 'persuaded' Cohen and Boyer to patent the technology.
- The US patent application was filed on 4 November 1974, just one week short of the 12 month grace period available under US Patent law.
- The subsequent family of three patents:
 - US4,237,224 for the process
 - US4,468,464 for the Prokaryotic product and
 - US4,740,470 for the Eukaryotic producthave generated royalties of around US\$250 million.
- Too late for the rest of the world!

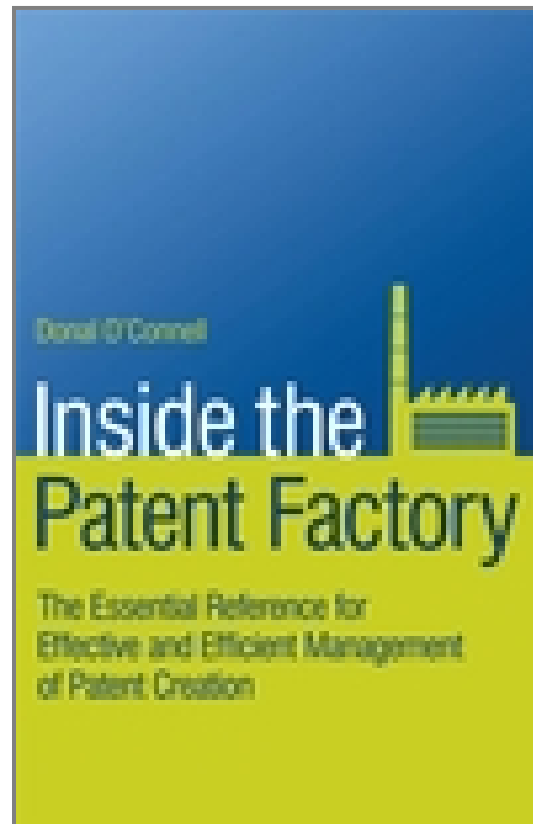
For more: http://www.druid.dk/wp/pdf_files/Feldman_Colaianni_Liu.pdf

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