

File or fail in the age of publish or perish

When is the right time to file a patent?

The decision of when to file a patent application depends on a combination of business and legal factors and is often the decisive element between achieving product protection and an inadvertently forfeited opportunity.

Choosing when to plan a patent filing is a critical decision for startups and can be distorted by procrastination, half-knowledge, or expert legal knowledge that is disengaged from the business impact. In the light of these challenges, it is important to be aware of a few central factors that can help establish when to consult a patent attorney using a business-oriented approach for developing a filing strategy that is appropriate for your specific situation.

Optimal patent protection:

- Starts before publication of any documents relating to the invention.
- Is based on an application that sufficiently discloses the invention.
- Effectively protects the actual desired business activity, e.g., the product.

During the planning of the patent protection, the following questions typically arise:

File or publish?

The filing of a patent application should always be done **before** any publication. Of note is that oral presentation, public investor pitches, study protocols, abstracts, and preprints are also considered publications.

A patent application should optimally also be filed before a relevant publication is published by a competitor or the competitor files their own application. Such prior publication or application filings can dramatically limit or even destroy subsequent potential patent protection. Accordingly, in dynamic fields and on hot topics, early filing is particularly critical.

What if I have already published my invention?

If the publication discloses all aspects of and is “enabling” for the invention, i.e. the publication explains how to put the invention into practice, the invention will likely no longer be patentable in one or more jurisdiction, including Europe. Even if the publication is not enabling, the invention may nevertheless become obvious because of the publication, which may also **prevent patentability**. Nevertheless, for

many jurisdictions, again including Europe, a publication published on the same day as the patent application is filed will not be prejudicial to its patentability. At least the European patent office only considers publication from the day before and older.

Additionally, some jurisdictions, such as the US, have what is known as a grace period with respect to what will be considered a publication prejudicial to a subsequent patent application. In such countries, publications of the invention by one or more inventor or applicant may potentially be removed from consideration. However, these grace periods are normally limited to specific time periods, e.g. 6 to 12 months prior to the filing date depending on the country, 12 months for the United States.

When is my invention ready to be filed?

Filing requires a different mindset. When working on an invention, scientists tend to plan with the goal of perfection, e.g. having all questions answered, rather than speed. However, it must be emphasized that the evidentiary hurdle for a patent is lower than that for a scientific paper. In particular, the description of the invention in the application need only achieve plausibility; there is no requirement for statistical significance. Therefore, preliminary data is in most cases satisfactory, and no prototype device or final drug candidate is needed. Additionally, for most jurisdictions, the application only has to provide (at least) **one possible way** to put the invention into practice.

What if I have to publish earlier?

In some situations, a mandatory publication date is scheduled before the implementation of the invention is known. For example, study protocols potentially underpinning a patentable invention may need to be published before any results are known.

In such cases, options include the inclusion of “prophetic examples”, which contain no results (or necessarily even detailed protocols), and/or the filing of a **priority establishing application** (filed for the sole purpose of establishing a filing date).

Can I add or remove experimental data?

Additional data can be added during the drafting process and before filing. However, with the exception of very restricted and limited circumstances, the application cannot be amended once it is filed, in particular, to add or delete experimental data. Where a priority establishing application is used (as mentioned above), a subsequent application that will be examined and prosecution before the patent office is filed within 12 months of the priority filing. This subsequent application can differ from the priority application, including the addition of new data. Caution is advised, however, as where the additional information shifts the invention, the priority filing date may be lost.

Accordingly, additional data should only be introduced during the drafting process if acquiring the data does not delay the filing date. It is typically difficult to appropriately patent a “moving target”. Subsequent applications claiming the earlier priority may allow additional time to finish experiments and are an opportunity to add subject matter, e.g., the actual study results of prophetic examples (with the caveat noted above). Removal of experiments is typically not beneficial, because the priority applications are published together with the subsequent application (and, thus, the removed data nevertheless becomes publicly available).

When should I file from a business perspective?

Apart from the legal factors and the state of the invention, the resources that are needed or enabled by a patent require equally consideration. A patent typically facilitates fundraising or grant acquisition, and can serve as a marketing tool. Costs for application drafting and official filing fees are typically relatively manageable in the first two years. If many countries are targeted, translation and nationalization can be substantial and are typically due 30 months after the first filing. A patent can provide a protection of 20 years and this time period may be delayed by later filing in niche fields if no direct competition is to be expected.

The impact on funding, budget and required protection time depends on the situation, business field and goals, but should in any case be planned early. At Vossius & Partner we provide our expertise in a free initial consultation to aid in developing a filing strategy that is appropriate for your specific situation.

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