

# Integrating International™ Patent Applications from Mirroring Provisionals™

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All material presented herein is contained in documents pending before the US PTO.

# Agenda

- Understanding the problem with International Patents for the US
- The Mirroring Provisionals
- Building Integrating Internationals from the Mirroring Provisionals
- Summary
- Glossary

# Understanding the Problem with International Patents for the US

- US Patent Application costs
  - are a fraction of International and European costs
- US companies and individuals
  - often file many US patent applications leading to many US patents but
  - few International and European applications leading to few foreign patents
- Consequence-
  - The whole world learns our hard earned discoveries by reading the freely published US Patents
  - US companies have little or no chance to generate revenue from their discoveries internationally.
  - Return On Investment (ROI) for US R&D is hampered because of this.

# The problem from the R&D Management Perspective

- How to pursue international patent protection without huge up-front expenses?
- The longer we can defer paying fees, the more time we have to learn about markets and competitors
  - We can pay some fees and not pay others
  - If a product or service proves worth protection, pay the fees
  - If the product or service does not prove out, don't pay those fees

# Introducing the Solution Components

- US Applications and their Mirroring Provisionals
  - A mirroring provisional is a provisional application that is filed shortly before its corresponding US Nonprovisional Application and includes (mirrors) everything in the nonprovisional except a cross reference to priority documents
  - The US Nonprovisional Application cites the Mirroring provisional
- The Integrating International Application
  - Minimizes International and EU Costs to 1 app/year
  - Cites the mirroring provisionals of the last year
  - Cannot cite any application more than a year old
    - This is important for European examination (to be discussed)
- Timeline walkthroughs
  - The problem vs The solution

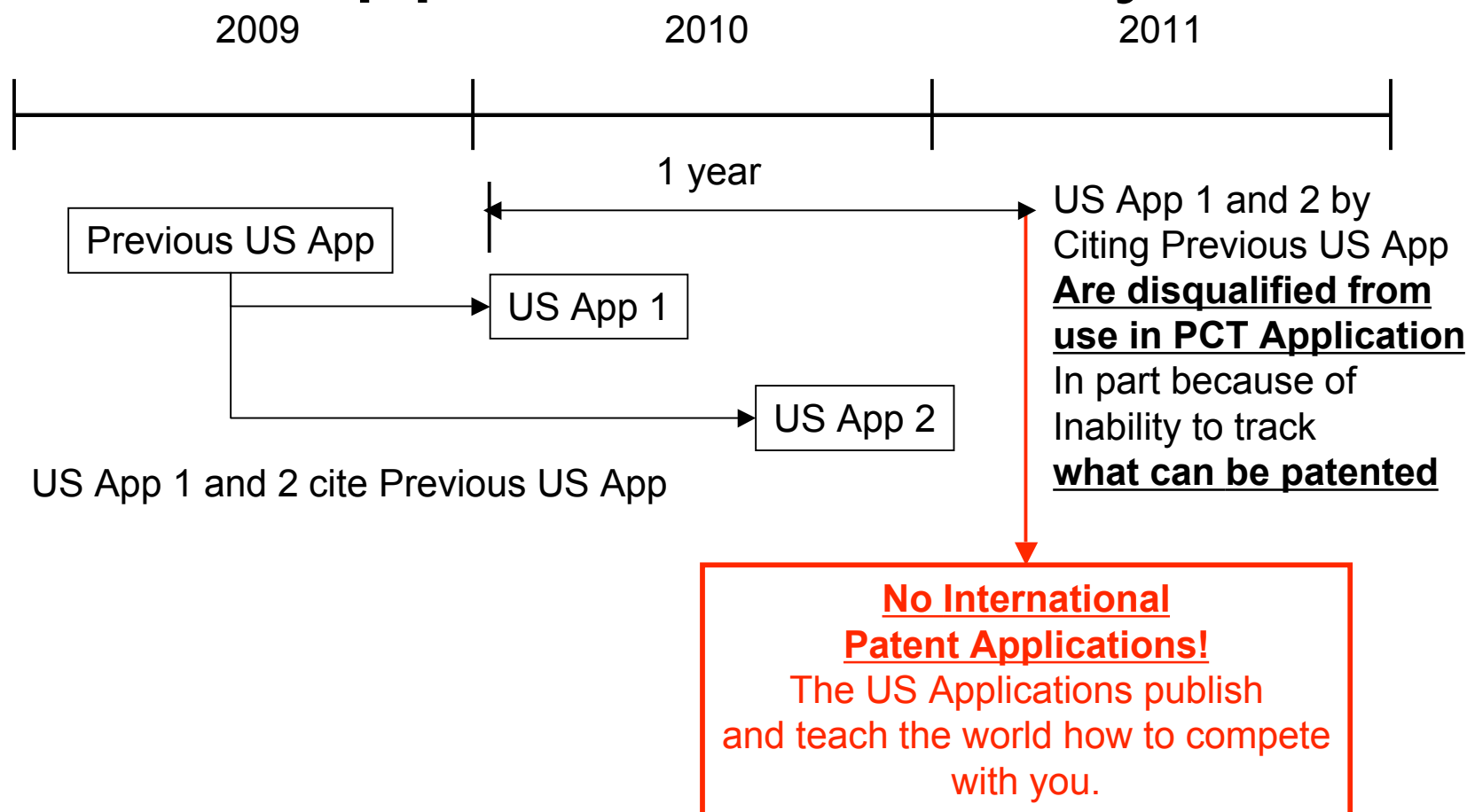
# International Patent: European Patent Office (EPO) Perspective

- Unless the international application provides
  - a clear assurance that nothing can be claimed from earlier than the 1 year window before the filing date of that application,
- The EPO patent examiner has to do a priority date calculation for each claim.
  - These calculations take away from the time the examiner has to find prior art and understand the patent application.
  - This degrades the examination quality.
  - It increases the chances that something gets overlooked, which may only be discovered after much more money has been invested.

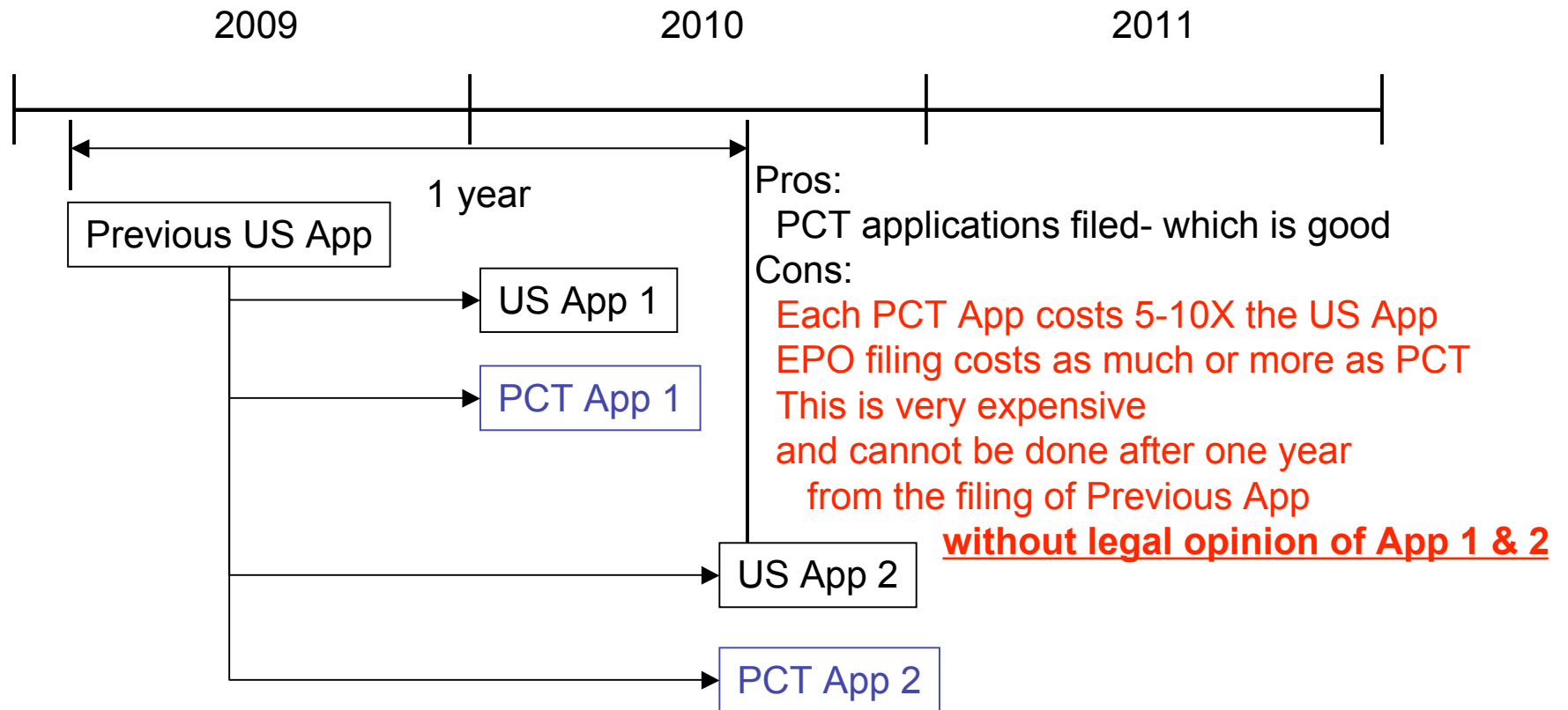
# Walk through of the time line into Europe

- What is done today
- A mirroring provisional and its relationship to the US Application
- Defining the integrating International Application
- Timeline to filing Integrating International Application
- Timeline from filing the Integrating International to EPO filing of all selected divisional patent applications

# Filing International Applications Today

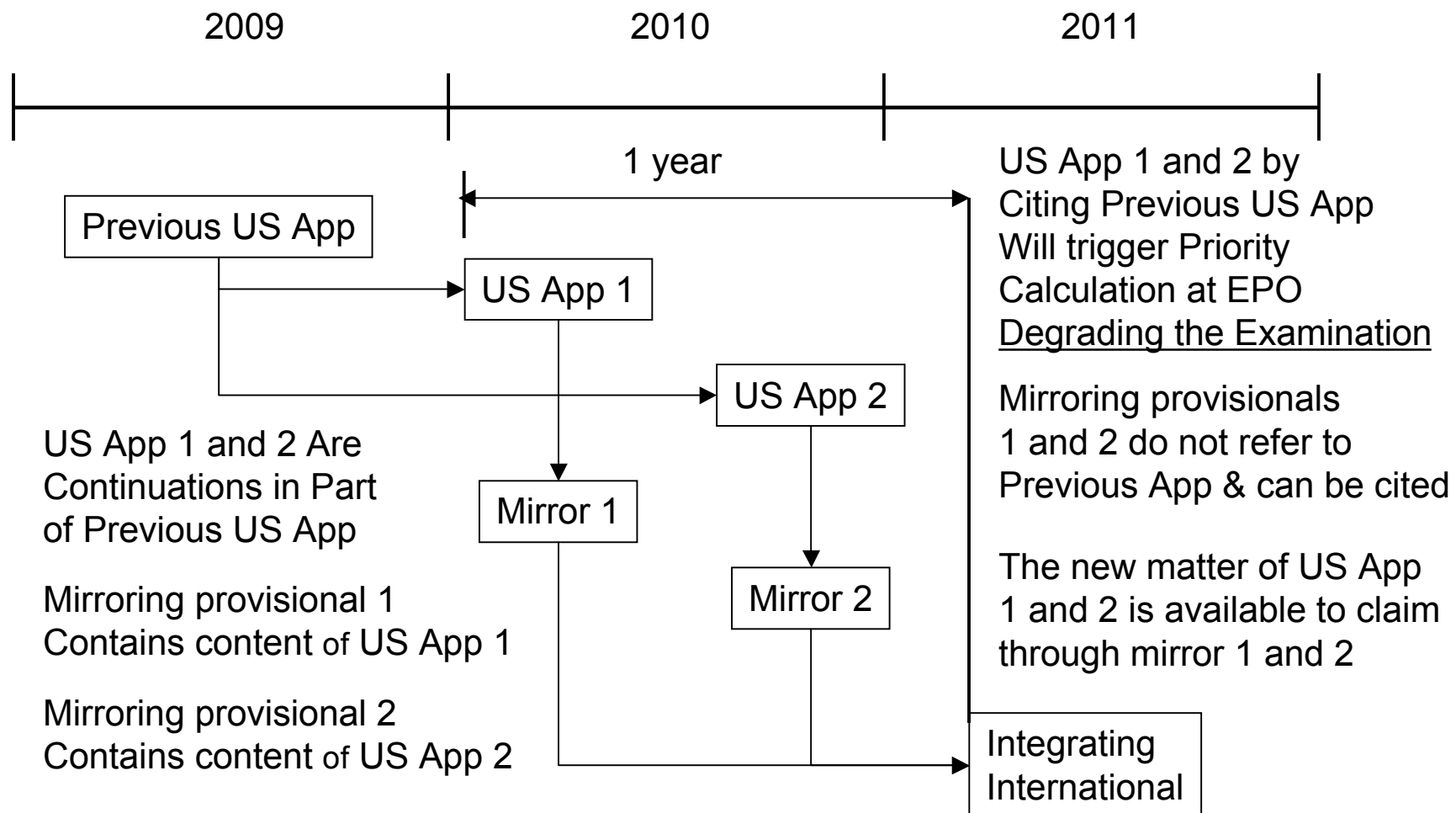


# Filing International Applications with every US Application

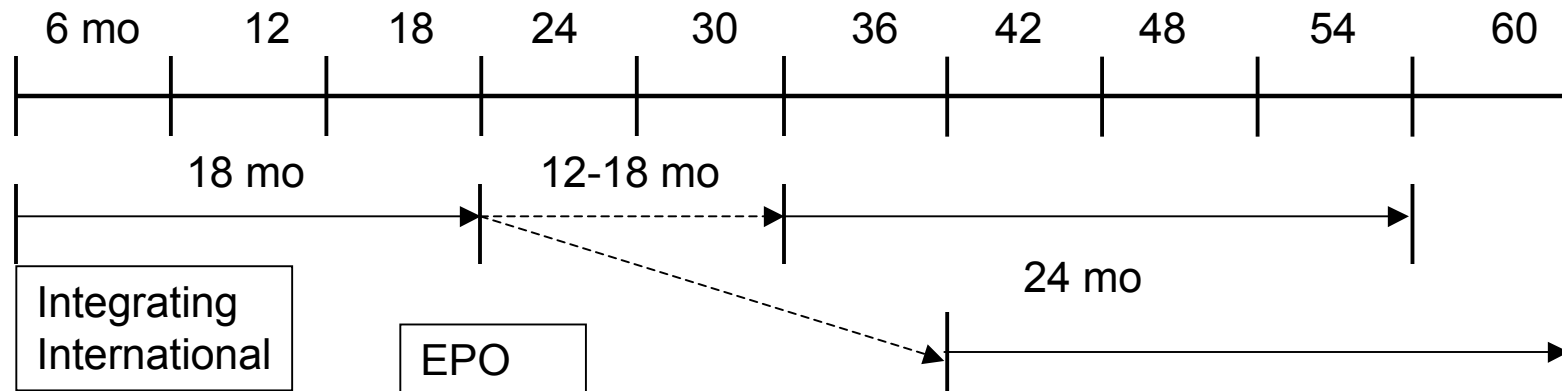


US App 1 and 2 cite Previous US App

# Timeline to Filing Integrating International



# Integrating International to EPO Divisional Deadline



Integrating International

EPO 1st App

EPO 1st Response

EPO Divisional Filing Deadline

Integrating International allows multiple Inventions to be processed with one PCT and EPO filing fees in 30 months from filing mirror 1 (or 18 months from filing Integrating International)  
Savings: \$8K × (number of US apps-1)

By 54-60 months  
Clients can make decisions based upon market and competitive knowledge and increased technical feedback from the field, not guesses, on which inventions to protect in Europe  
As divisional patent applications

June 14, 2011

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# Legal Mechanisms Involved:

- Mirroring Provisionals
  - Contains the content of a US patent application
  - But are filed first and referenced by the US patent application
  - Have no reference to earlier patent applications
- Integrating International Patent Applications
  - Cite the mirroring provisionals of the last year and
  - Include the content of those patent applications without triggering an analysis of claim priority to determine Paris Convention disqualification of each claim
  - By removing the need to analyze the claim priority, 1-2 hours of Examination is freed up to focus on whether the application is a sound investment, i.e. **patentable**
- EPO policies and practices
  - 12-18 months from EPO filing of integrating international application to first response from EPO
  - Companies have 24 months from first response to divisional filing deadline

# Summary of Overall Benefits

- Management can make educated decisions from the start of the process while minimizing expenses in the first few years
- International patent rights can be obtained where useful and most of the expenses avoided where they are not
- Patent portfolio management has a clear, low cost, and reliable way of tracking these opportunities

# The Business Advantages

- US Technology companies average spending over \$1M per year per R&D group
  - Most innovations are incremental improvements that are filed as CIP's
  - These improvements are frequently lost to International Patent Protection
- This method of patent development and prosecution
  - makes the R&D results of a year into an Integrating International application
  - It defers large expenditures on EU patents until products have proven their economic value

# Patent Glossary

- Citing a document claims patent priority to that document and its filing date
- EPO- European Patent Office
- Paris Convention- the central international patent treaty, signed in the 19th century and the legal basis for the PCT
- Patent Application includes a specification, drawings, and claims
- PCT- Patent Cooperation Treaty
  - This is the standard avenue to create a patent application filed outside the United States
- Priority is used in patent examination to determine what prior documents can be used to disqualify (reject) a patent application claim
- Provisional patent applications need only have a specification or drawings. They are not examined and provide a window of opportunity for citing them of one year.
- PTO- (US) Patent and Trademark Office