



WIPO COMES TO UCLA

Patent Portfolio Management: Strategies, Considerations, and Best Practices

John H. Hornickel

PolyOne Corporation

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General Information

Contact Information:

John.Hornickel@PolyOne.com

(440) 930-3317 (Phone)

(440) 930-1179 (Fax)

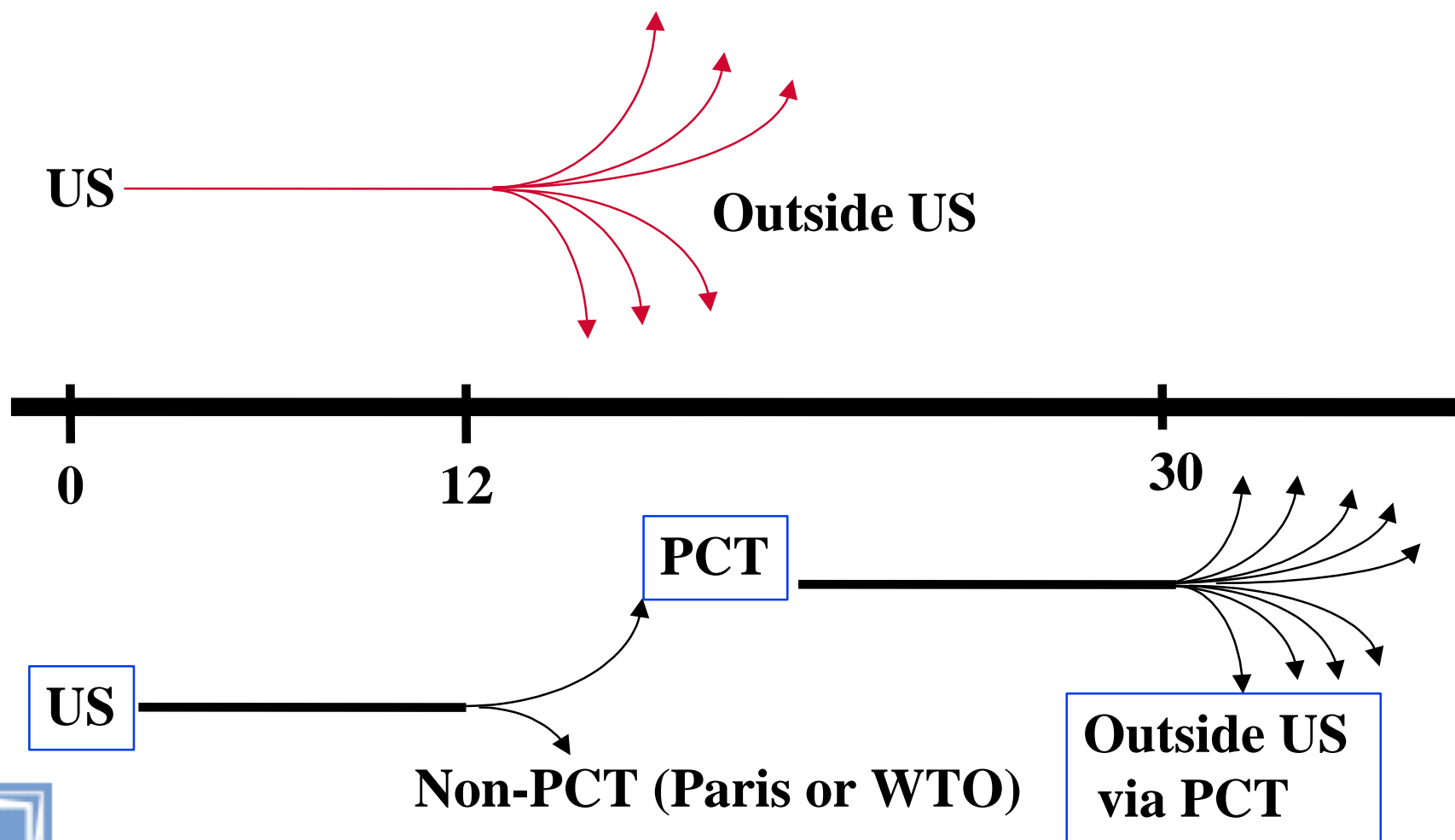
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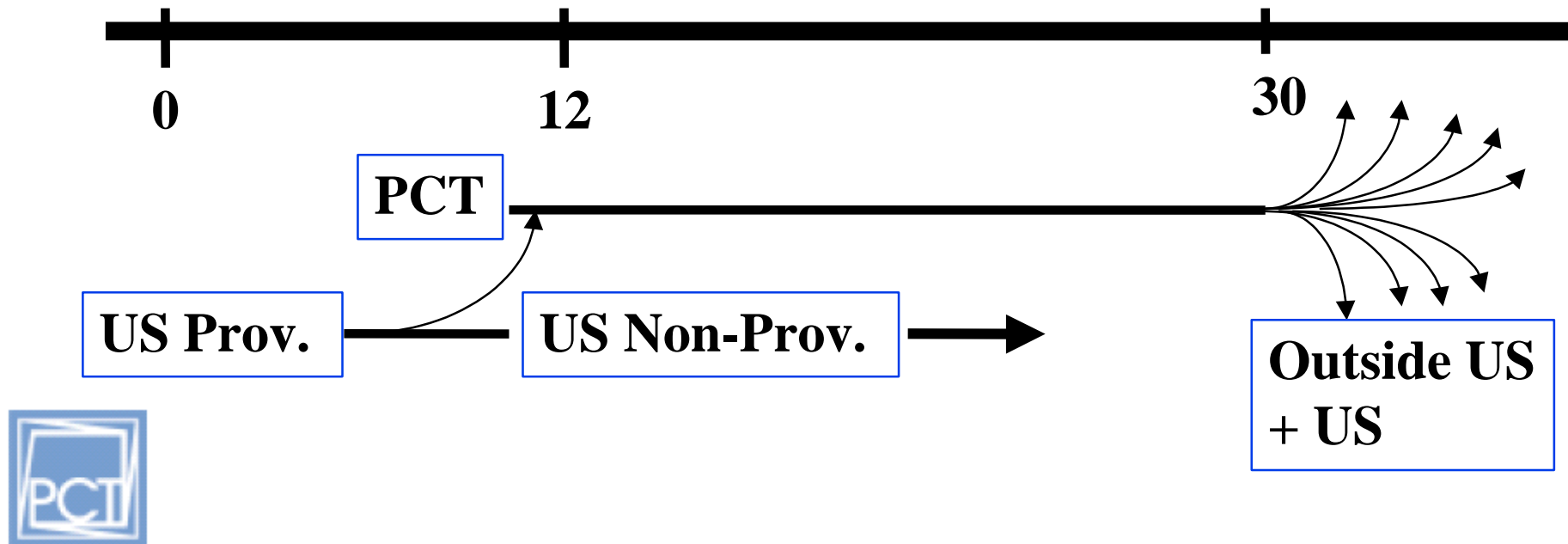


PCT Delays Costs and Preserves Options -- Good for All Applicants



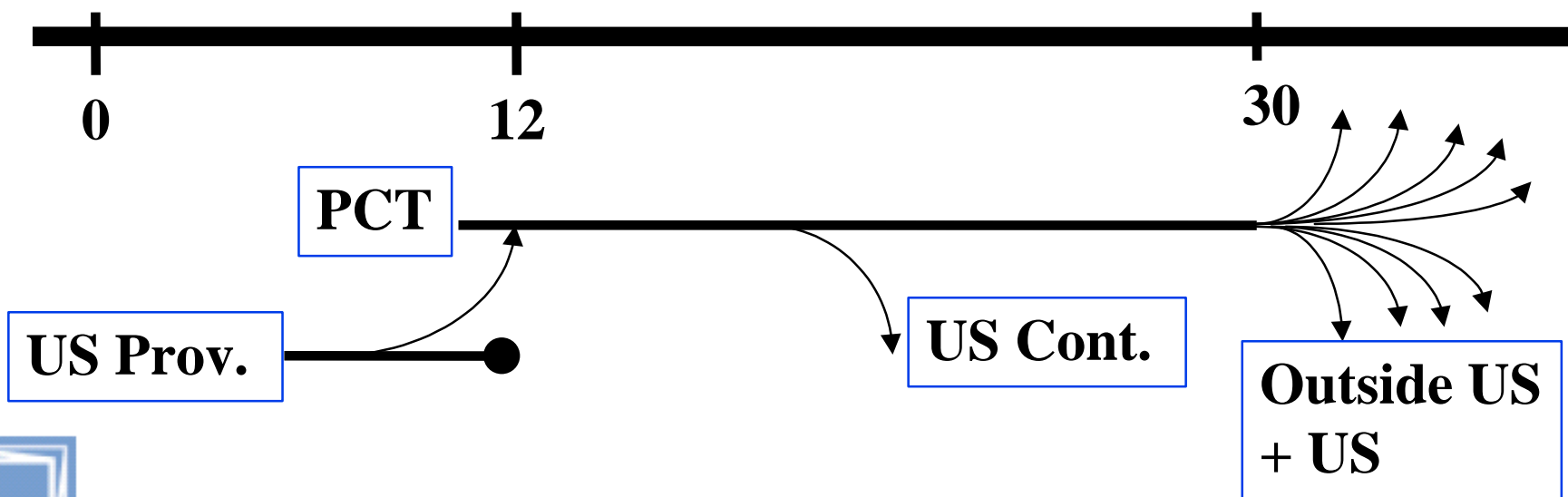
PCT – Timeline #1 – Using Provisionals

- **File US as Non-Provisional and via PCT**
- **Get PCT Search before Non-Prov. Exam**
- **Consider using two different claiming strategies.**
- **Disclose co-pending applications to USA examiner.**



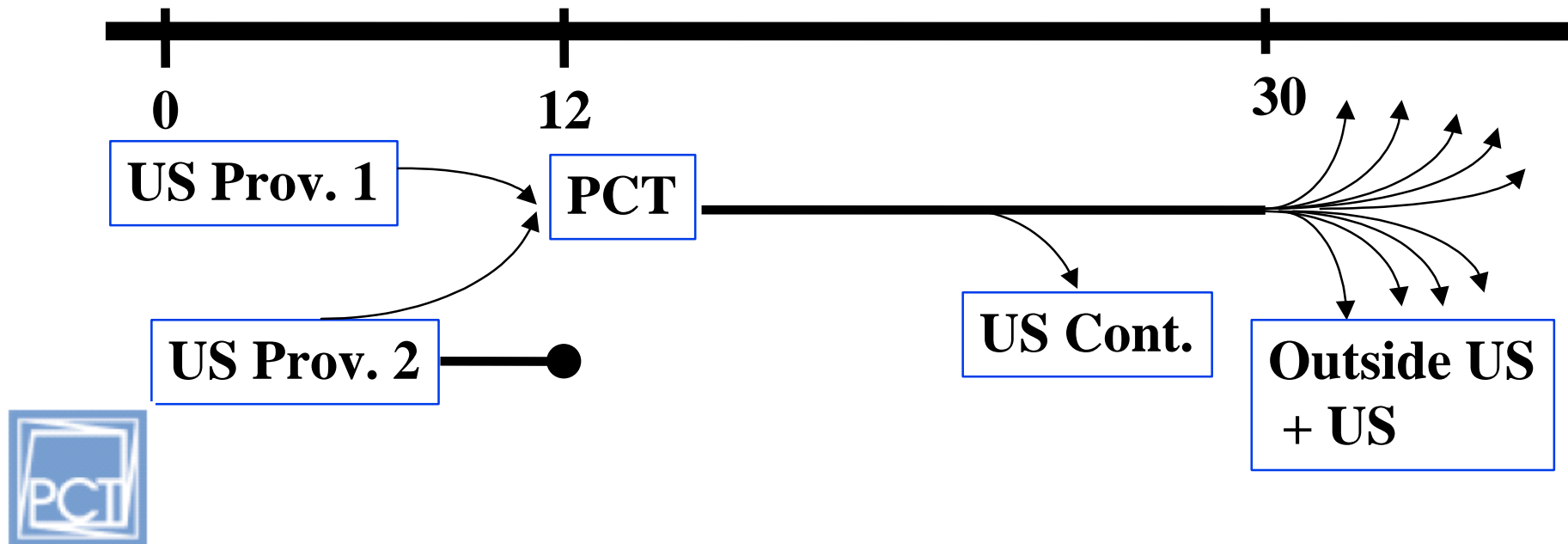
PCT – Timeline #2 – Using Provisionals

- **File US only via PCT: Bypass Continuation (Sec. 111) or Nat. Stage Entry (Sec. 371), or both.**
- **Consider using two different claiming strategies.**
- **Early By-Pass might minimize file history effect of PCT.**
- **Disclose co-pending applications to USA examiner.**



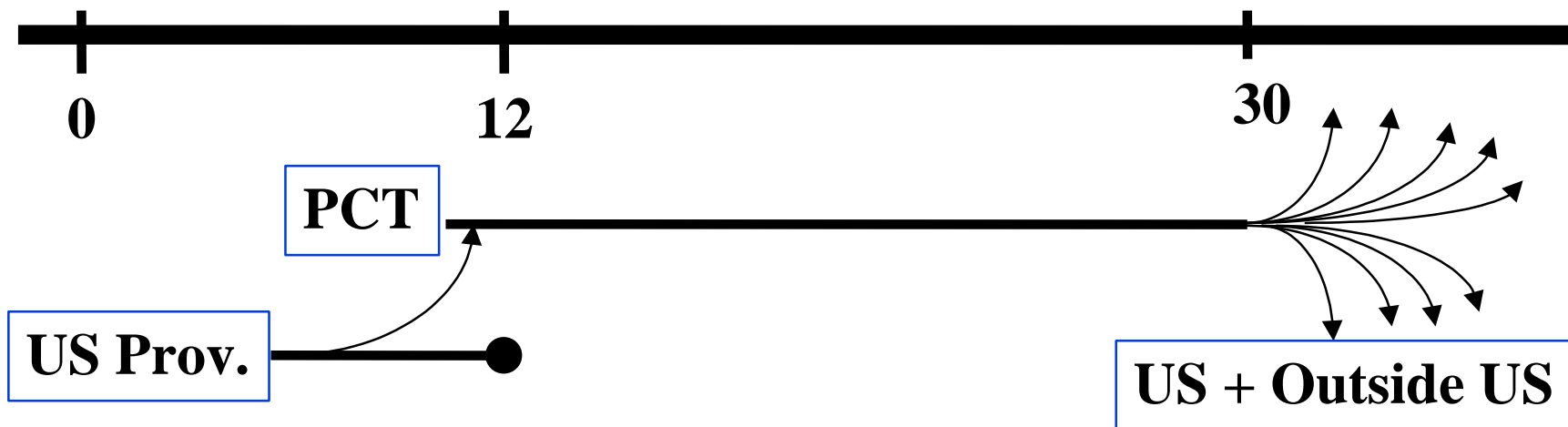
PCT – Timeline #3 – Using Provisionals

- **File Multiple US Provisionals; Save \$800/appln.**
- **File PCT at <12 Months; Claim Multiple Priority**
- **Publish via PCT in English language (102(e))**
- **Pursue US Continuation or US Nat. Stage or Both --
Decide Which Claims for Which Exam Time**



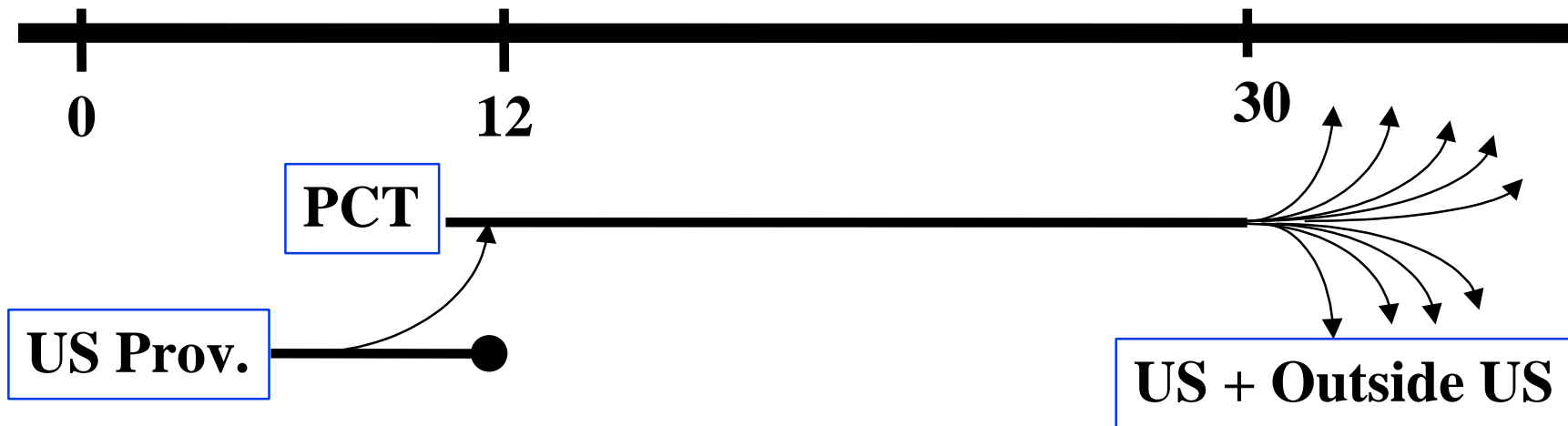
PCT – Timeline #4 – Using Provisionals

- **File US Provisional, Use PCT for USA, Delay USA Exam and Use PCT for Preliminary Examination**
- **Get Search from US or EP**
- **Publish via PCT in English language (102(e))**
- **Choose EP or US for Prelim. Exam. During Chap. II**



PCT – Timeline #5 – Using Provisionals

- **File US Provisional & PCT <12 Months**
- **Get Search from US or EP**
- **Publish via PCT in English language (102(e))**
- **Make NO Demand for Chapter II**
- **Examine US First Instance during National Stage**



PCT – National Stage Entry at 30/31 Months

Choosing Wisely

- PCT has preserved options. Now what?
- Year 3 is most costly year of patent application life -- translations, national stage fees, and associated law firms.
- Patent attorneys need to be economic futurists.
- Use macroeconomic country trends and microeconomic industry trends.



5-10-15 Maintenance Principle

- Preserve all patentable inventions for at least 5 years.
- Preserve only product line patent protection past 10 years.
- Preserve only technology platform patent protection past 15 years.
- Scope of patent protection affects horizon of economic prediction.



2005-2020 Big Economy Trends

- Big Countries Maintain Their Position
- Only China and India Join G8 by 2020

Big Rankings (Gross Domestic Product)				
Country	2005	2010	2015	2020
United States	1	1	1	1
Japan	2	2	2	2
Germany	3	3	4	4
France	4	5	5	6
U.K.	5	6	6	5
China	6	4	3	3
Italy	7	7	7	7
Spain	8	8	8	9
Canada	9	9	9	10
Mexico	10	10	10	11
India	13	12	11	8



2005-2020 Rich Economy Trends

- Northern and Western Europe + USA and Japan
- Hong Kong rises to top of the list by 2020

Rich Rankings (Gross Domestic Product Per Capita)				
Country	2005	2010	2015	2020
Switzerland	1	1	1	4
United States	2	2	2	3
Sweden	3	3	3	2
Denmark	4	5	6	6
Netherlands	5	6	7	10
Japan	6	4	5	5
France	7	8	8	8
U.K.	8	9	9	7
Austria	9	10	10	9
Germany	10	13	14	14
Hong Kong	12	7	4	1



2005 “Bang for Buck List”

Using “Global I.P. Estimator Software” and
Weighted Average 3:1 Big to Rich

- USA
- France
- U.K.
- Japan
- Germany
- Canada
- Spain
- Italy
- Switzerland
- Chile



Hard Reality of the Future

- Predictions are not guaranteed.
- Every decision is different because every patentable invention is different.
- A provisional patent application filed today will not expire as a patent family until 2026, 25% into the 21st Century. What will the world be like?
- Which patent application in which country will protect which product/product line/technology platform?