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# Prioritizing Your Patent Filings: Business & Legal Considerations

Life Sciences At Home & Across the Globe  
San Francisco Bay Area Life Sciences CLE Conference  
Association of Corporate Counsel  
May 12, 2022

# The Panel

- Briana Barron, Vice President, Intellectual Property, Arcus Biosciences
- Alok Goel, Senior IP Counsel, Cepheid
- Wesley Jackson, Chief Executive Officer, Valitor, Inc.
  
- Moderator: Alex Trimble, PhD., Member, Mintz

# The Value of Patents

- Protect market share
- Protect revenue stream
- Create company value in the absence of a revenue stream
- Protect innovations and product-focused technology
- Existing patent protection is expiring
- Defensive publication of non-inventions

# When to File: Motivations for *Earlier Filings*

- Publication dates of company patents
- Protect ideas prior to conference presentations → file prior to presentations to preserve foreign rights
- Protect ideas prior to meetings with collaborators or investors
- After presentation or publication, US rights still available by filing within 1-year grace period (35 USC 102(b)(1))
- Often pursued by earlier stage companies

# When to File: Additional Motivations

- Promote company via publications
- Position the company for investment
- Satisfy goals of internal collaborators (scientific teams, business teams, board of directors)
- For pharmaceutical and biotechnology patents, maximize potential Patent Term Extension (PTE) award by maximizing overlap with clinical trials

# When to File: Motivations for *Later Filings*

- Preserve patent term, as later filings have later expiration dates
- Delay publication to delay disclosure to competitors
- Allow research and development to advance further and strengthen initial patent filing
- Larger, more mature, companies are often better placed to prioritize these factors

# Where to File: An Investment in the Company

- Market size
- Likelihood of manufacturing or copycats
- Shipping venues (Hong Kong, Singapore)
- Investor sources
- Strengthen interest from investors
- Tax & corporate considerations
- Balanced with cost



# Where to File: Notable Non-PCT Countries

- Must be entered at the 1-year mark when the PCT application is filed:
  - Argentina
  - Bolivia
  - Lebanon
  - Paraguay
  - **Taiwan**
  - Uruguay
  - Venezuela
- Gulf Cooperation Council (GCC) no longer accepting new applications, but member countries (Bahrain, Kuwait, Oman, Qatar, Saudi Arabia and United Arab Emirates) can still be entered directly via the PCT
- **Hong Kong** → entered via China or Europe



# Regional Patents: Europe Patent Office

- European countries
- Can be extended to Bosnia & Herzegovina, and Montenegro
- Can be validated in Morocco, Moldova, Tunisia and Cambodia
- Unified Patent is likely to change the calculus of where to validate

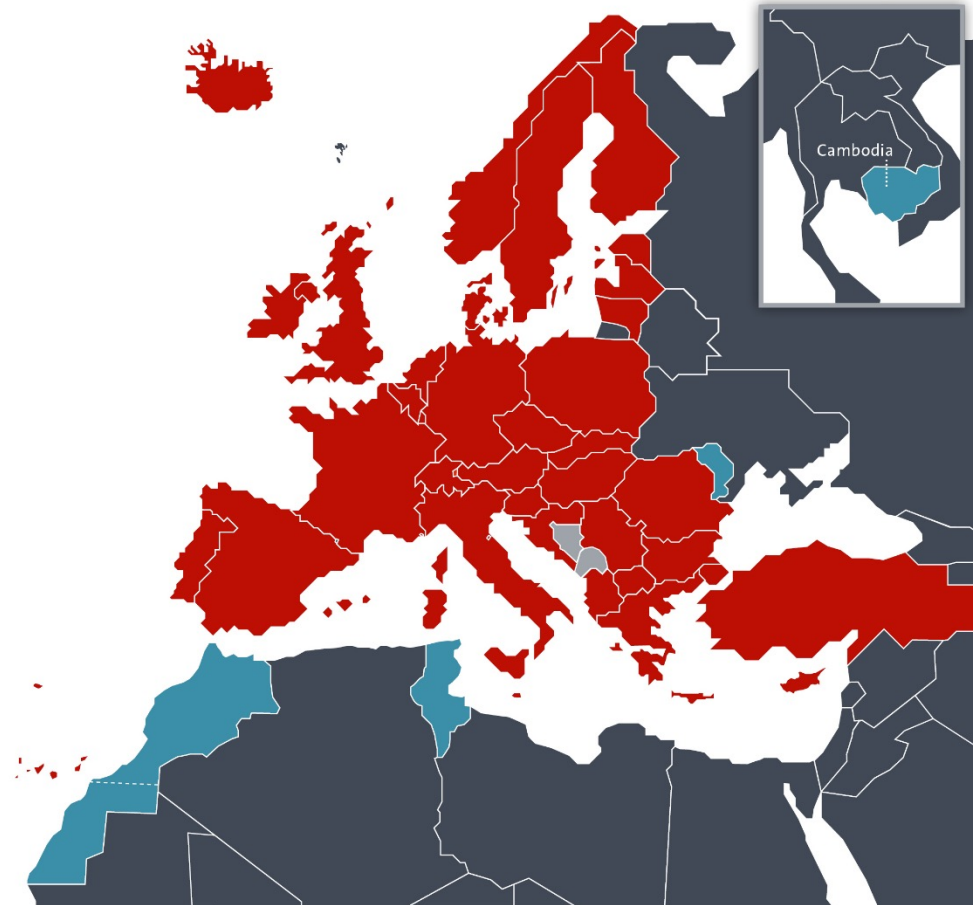


Image courtesy of EPO website

# Regional Patents: Eurasia

- Armenia
- Azerbaijan
- Belarus
- Kyrgyzstan
- Kazakhstan
- Russia
- Tajikistan
- Turkmenistan



# Regional Patents: ARIPO

- Botswana
- Ghana
- Gambia
- Kenya
- Liberia
- Lesotho
- Malawi
- Mozambique
- Namibia
- Rwanda
- Seychelles
- Sudan
- Sierra Leone
- Sao Tome and Principe
- Tanzania
- Uganda
- Zambia
- Zimbabwe

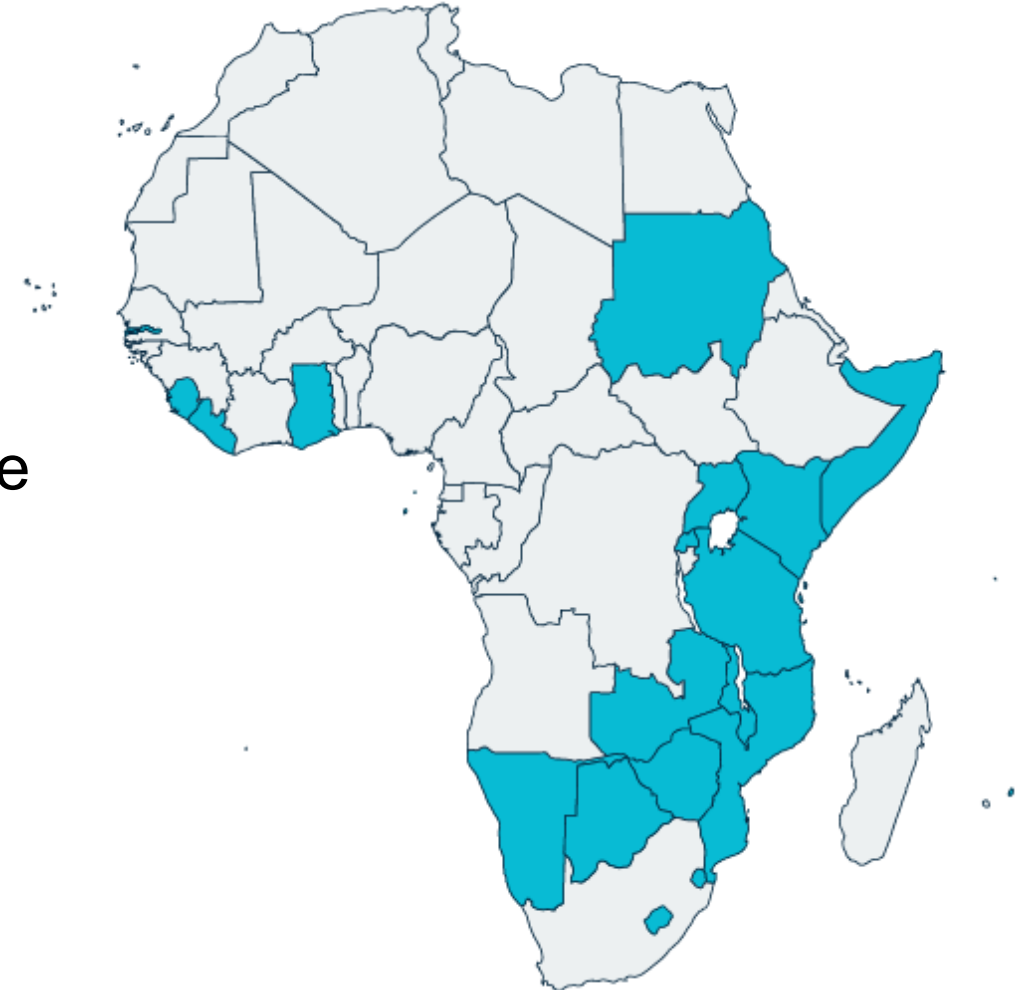


Image courtesy of ARIPO website

# Regional Patents: OAPI

- Benin
- Burkina Faso
- Cameroon
- Central African Republic
- Chad
- Republic of Congo
- Ivory Coast
- Equatorial Guinea
- Gabon
- Guinea
- Guinea-Bissau
- Mali
- Mauritania
- Niger
- Senegal
- Togo
- Comoros



Image courtesy of Adams & Adams website

# Prioritizing Jurisdictions, a Biotech Perspective

Region	Category 1	Category 2	Category 3
North America	United States	Canada, Mexico	
Europe	Europe	Eurasia, Ukraine	
Asia	China, India, Japan	Australia, Korea, Singapore, Taiwan	Indonesia, Malaysia, New Zealand, Philippines, Thailand, Vietnam
Central & South America		Brazil	Argentina, Chile, Colombia, Costa Rica, Panama, Peru
Africa		South Africa	ARIPO, OAPI, Egypt
Middle East		Israel	Lebanon, Saudi Arabia, United Arab Emirates

# Divisional/Continuation Filings

- Maintain the US families for as long as is reasonable
- Pursue divisional applications in important foreign jurisdictions
- In secondary jurisdictions, focus claims on aspects of the contemplated product to avoid/minimize divisional filings
- What is the suitable default?
  - No divisional needed if the claims cover the product/invention
  - File divisional unless all subject matter already claimed

# Reducing the Portfolio

- Maintain the patents as long as the prosecution and annuity fees can be maintained
- Annual or semi-annual patent portfolio reviews should consider reducing patents that no longer provide value
- Newer patent filings can render older patent families less valuable
- New technology can render patented technology obsolete
- Clinical trial data not sufficient
- More relevant for more mature portfolios and companies

# Process

- Educate scientists to identify potential inventions → even small improvements may be inventive
- Establish checkpoints for the following:
  - Preparing and filing application
  - PCT filing
  - National phase filings
  - Continuation/divisional filings with grant of parent patent
  - Reducing the portfolio
- Engage with other company stakeholders (scientists, business, sales, marketing, regulatory)





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**Thank you!**

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