

## **Patent Filing Strategies - 6 Reasons for Taking Action Between Priority Application and PCT Application**

In patents there is no doubt that technical work is the most creative. Making a thorough search, finding the best possible approach to defend the inventive step of an invention, or correctly assessing a possible infringement by equivalence requires experience, knowledge and, of course, creativity.

The choice of the best patent filing strategy is also of vital importance to patent holders, but it is not always studied in enough detail. A widely used strategy when protecting an invention in several countries is as follows:

1. Submission of a priority application.
2. Filing of a PCT application at the end of the 12 months of priority.
3. Entry into national phase generally 30/31 months after the priority date.

It is no surprise that this strategy is popular, as it brings several advantages to the applicant. Among them, these can be mentioned:

- Allows you to adjust the wording of the "final" application to the results of an official search and the examiner's opinion.
- You can ~~add~~ include new data obtained during the priority year.
- The patent lasts longer, as it is 20 years from the application and not from the priority.
- Payments are delayed.
- The protection in force lasts longer in a larger territory.

However, sometimes this same pattern is repeated without assessing whether it is the most appropriate for each invention or business model. The following, although not intended to be exhaustive, lists some situations where the above strategy is not in the best interests of the applicant.

### **Lack of experimental data**

Sometimes there is great pressure to submit the priority application as soon as possible. There are fields in which several competitors are known to be working on the same lines (e.g. combinations of active pharmaceutical ingredients) and a few days may make the difference between holding a monopoly for a product or not being able to market it because of a third party patent.

Patent applications with virtually no experimental data may be a solution in such cases. However, the absence of this data is a major weakness, and may prevent you from getting a strong patent. Patent offices are increasingly reluctant to accept data at a later stage in order to remedy the lack of experimental data in the application as filed (see for example EPO decisions T1329/04 Factor 9/John Hopkins, and T950/13 and T0488/16 relating to Dasatinib).

Thus, filing a new patent application as soon as experimental data is available, without waiting for the end of the priority year, is a good solution. There are two good strategies for this. The first is to bring forward the filing of the PCT application, but this implies a

shorter patent protection term and the impossibility of making adjustments at the end of the priority year. The second is to file a new application, in this case without paying fees (the search and opinion of the examiner would be had with the first application), and at the end of the priority year, claim both priorities and make further adjustments, if necessary, when filing the PCT application.

### **Errors in the priority application**

There are many reasons why an application may not be drafted optimally. Sometimes, the job has just been done wrong. At other times, there is a supervened cause, such as the location of an intermediate disclosure, that can make good drafting deficient. In some of these situations, waiting 12 months to adjust the PCT may pose too great a risk to the applicant.

As in the previous case, it may be advisable to advance the PCT application or file a second patent application that would also serve as a priority for the subsequent filing of the PCT application.

### **Completely deficient priority application**

It seems difficult to understand, but sometimes we find patent applications so poorly drafted that their claims do not offer effective protection, nor does the content of their specification allow new claims to be drafted that are minimally acceptable. These applications have obviously not been prepared by a patent expert. Generally, these priority documents have been drafted by the inventors, without including any generalizations and with problems of clarity.

In many cases the best solution to this problem, if there has been no publication, is to withdraw the patent application completely and start the protection process again with good drafting.

### **Evolution of the invention**

The patent application is structured by offering broad protection and fallback positions, through dependent claims, which converge on the product that is expected to be commercial. However, inventions are often not static, and the ultimately commercial product may be outside the focus of the claims, or not even be protected by the patent application.

Given the above, whenever the PCT application is prepared, it is advisable to check whether the protection is adequate for the invention at that time and, if not, to adjust it accordingly.

In some situations, it may not be appropriate to wait for the priority year, but rather to advance the filing of the PCT application or to file a second patent application which will also serve as a priority for the subsequent filing of the PCT application.

### **Self-disclosure of the invention**

From a strict patent point of view, it is best not to make any disclosure of the invention until the patent application is published. Any prior publication entails risks and foregoing certain possibilities, such as the filing of applications without priority once the priority year has been exhausted.

However, it is frequent that disclosures of the invention are made to meet other needs of the applicant, such as the sale of the product itself or its presentation at conferences. If these disclosures are within the priority year, filing a new patent application previously must be assessed, or advance the filing of the PCT application, since, if disclosure occurs, it will later be practically impossible to solve errors in the wording of the patent or redefine the scope of protection of the patent.

### **Need to accelerate the grant**

In certain situations, it is desirable to accelerate the granting of a patent. For example, if the applicant foresees infringements of the patent, the sooner a patent is granted, the sooner legal actions can be taken.

Seen from another point of view, when an infringement suit is presumed based on third party patents, having a patent granted for one's own product can be a good argument against an infringement by equivalence. Obviously, the defensive patent should be granted by the patent office before infringement actions are initiated.

Rapid response to official actions may speed up the prosecution, but the filing strategy itself may have even more influence. Thus, in these situations it may not be appropriate to file the PCT application, which delays the examination and grant of patents. After the priority year you can enter directly into the territories of interest, or even initially submit applications in several countries simultaneously. In any event, it is usually advisable to wait at least for the examiner's opinion before filing in other territories, in case of new state of the art or unexpected objections requiring modification of the application.

Various strategies can also be combined. For example, a quick entry into the main territories, even using utility models, and the filing of a PCT application at the end of the priority year. This accelerates some grants and, at the same time, there is more time to decide the territories where there will finally be protection. In addition, this strategy makes it possible to replace the patents or utility models initially granted with those that could be granted from the PCT, which would expire later and could incorporate more experimental data and drafting improvements.

While it is not exactly a patent filing strategy, but a prosecution strategy, the use of PPHs to speed up grant procedures, and even facilitate grant procedures in complicated offices such as the USPTO, can be a good strategy.

### **Conclusion**

Each of the actions in relation to patents must be assessed in a specific way, and the filing patent strategy is no exception. Knowing the invention, its evolution and the patent holder's business model is essential to provide a good filing strategy, and to properly draft and defend patent applications.