4x4 Patent Tactics

(„outside of the US“ version, with remarks about why it does not work in the same way for the US)

Patents must follow R&D, not vice-versa.

Johnny Haypee • 1st
I am Johnny Haypee, aka IPmemes, and I post memes about IP.
7h •

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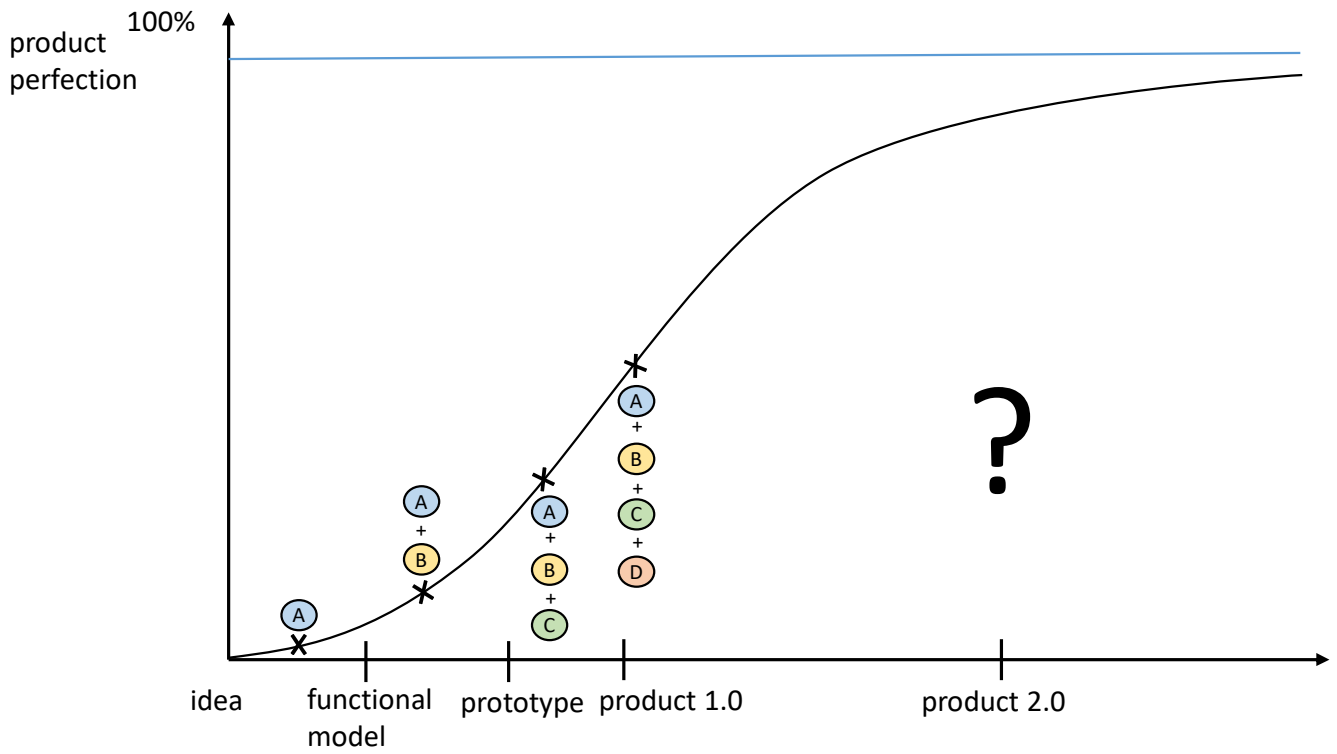
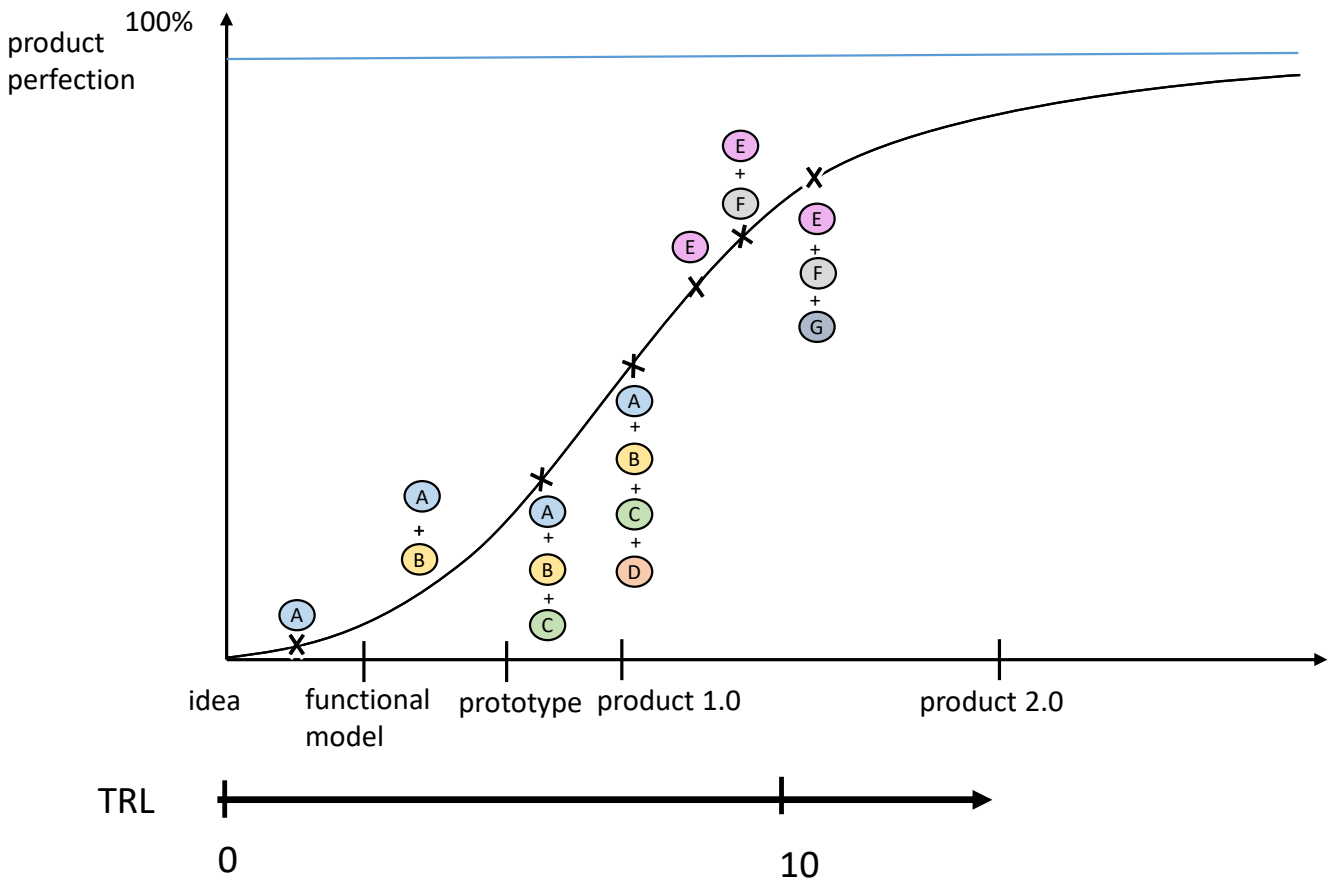
Jeremias Gromotka • 1st
Chief Intellectual Property Officer @ Cryomotive
1h •••

Yup. Been there...

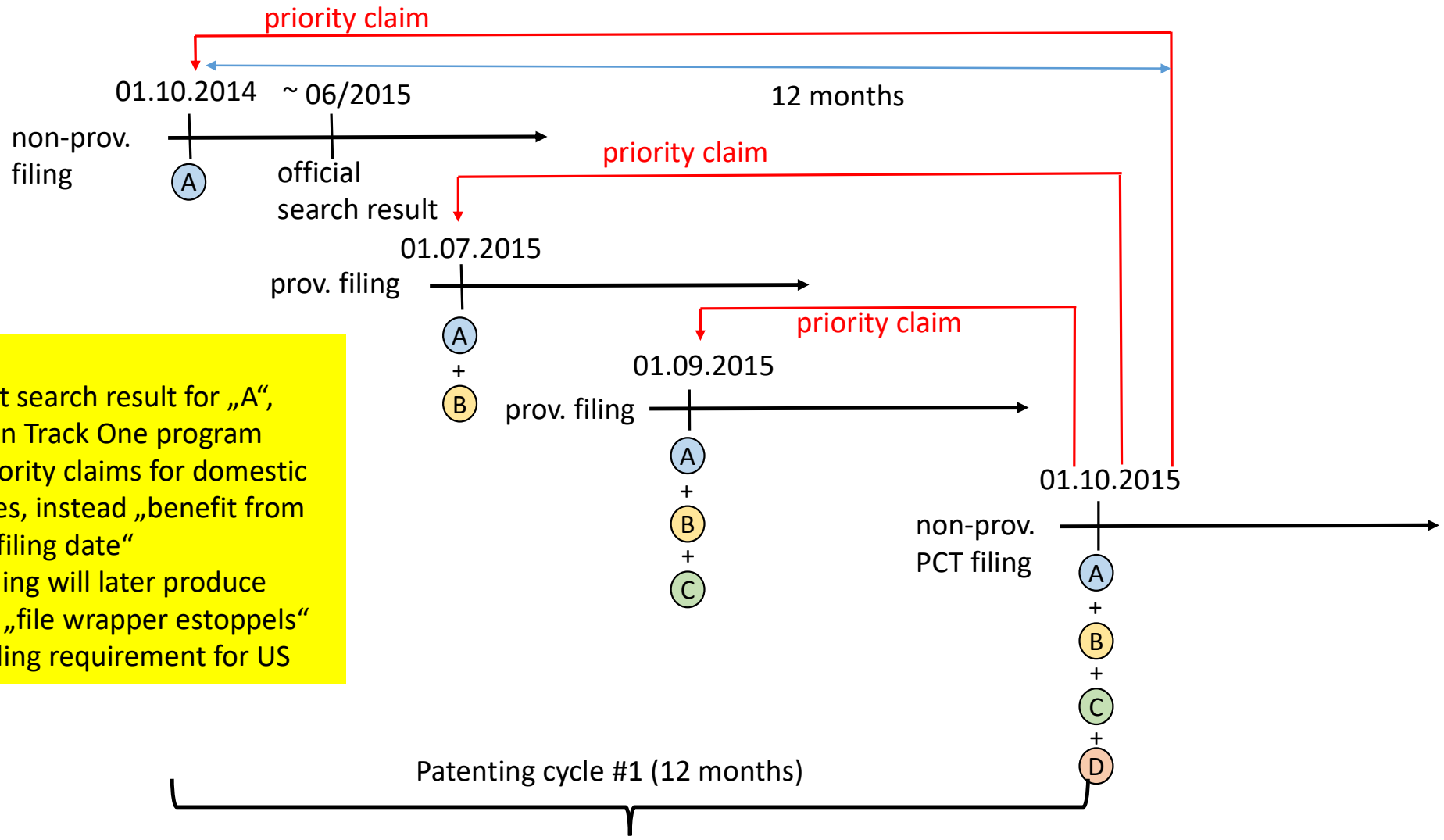
How to use a priority claim for adding subject matter to a patent application



How to use a priority claim for adding subject matter to a patent application, beyond product 1.0



How to use a priority claim for adding subject matter to a patent application



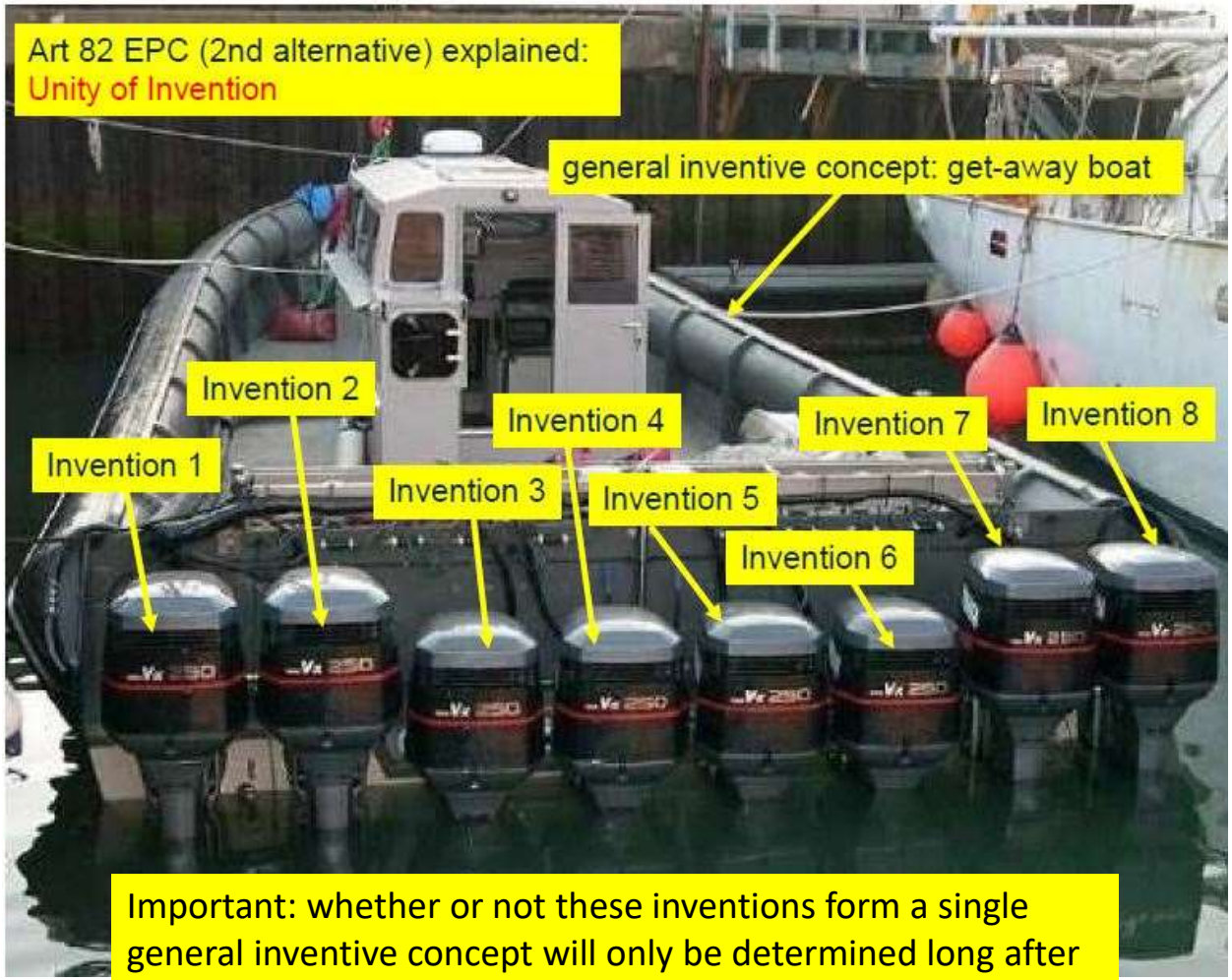
US:
- no fast search result for „A“, unless in Track One program
- no priority claims for domestic priorities, instead „benefit from earlier filing date“
- PCT filing will later produce foreign „file wrapper estoppels“
- first filing requirement for US

Is it legal to file many inventive aspects in one single patent application?

Yes!

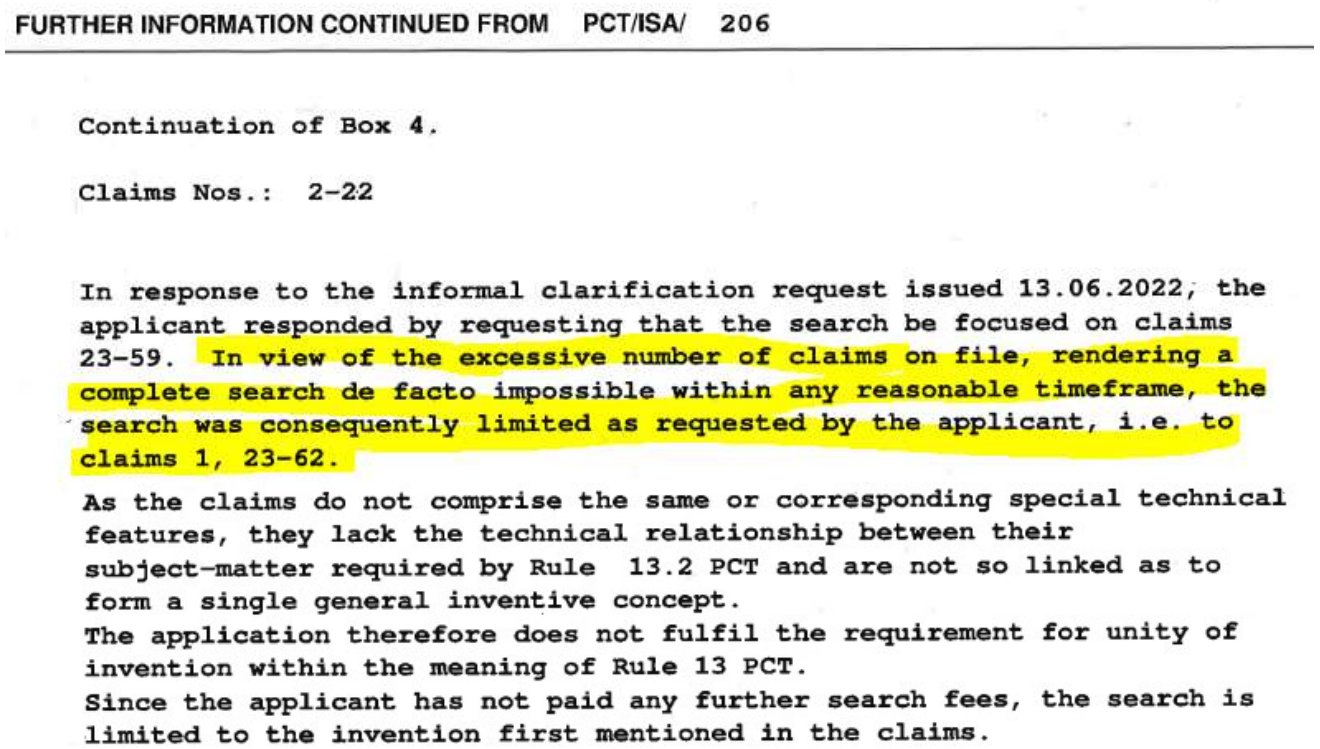
Art 82 EPC (= PCT Rule 13):
The European patent application shall relate to one invention only OR to a group of inventions so linked as to form a single general inventive concept.

Article 27 (PCT) National Requirements:
(1) No national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided for in this Treaty and the Regulations.



Consequences of having several inventive aspects in one single patent application that do not form one single inventive concept

- payment of extra search fees if search for more than one single inventive concept is wanted
- clarification of what inventive concept should be searched
- examiners may openly complain in search reports and office actions:



FURTHER INFORMATION CONTINUED FROM PCT/ISA/ 206

Continuation of Box 4.

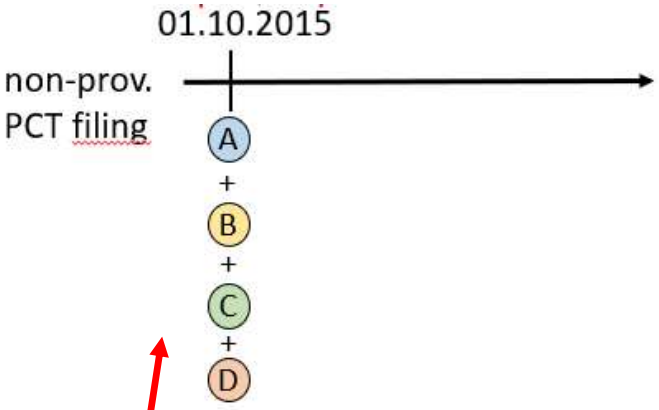
Claims Nos.: 2-22

In response to the informal clarification request issued 13.06.2022, the applicant responded by requesting that the search be focused on claims 23-59. In view of the excessive number of claims on file, rendering a complete search de facto impossible within any reasonable timeframe, the search was consequently limited as requested by the applicant, i.e. to claims 1, 23-62.

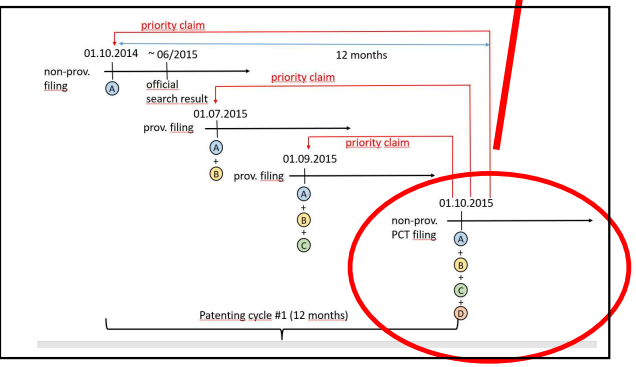
As the claims do not comprise the same or corresponding special technical features, they lack the technical relationship between their subject-matter required by Rule 13.2 PCT and are not so linked as to form a single general inventive concept.
The application therefore does not fulfil the requirement for unity of invention within the meaning of Rule 13 PCT.
Since the applicant has not paid any further search fees, the search is limited to the invention first mentioned in the claims.

- filing of divisional/continuation patent applications at a later time may be required

How to use a priority claim for adding subject matter to a patent application



from the slide before:



Patenting cycle #1 (12 months)

How to use a priority claim for adding subject matter to a patent application

01.10.2015

non-prov. PCT filing

A + B + C + D

6 months

Publication 18 months after earliest priority date (= 01.10.2014)

US:
- special definition of unpublished prior art for non-obviousness!

priority claim

01.11.2015

prov. filing

E

priority claim

01.02.2016

prov. filing

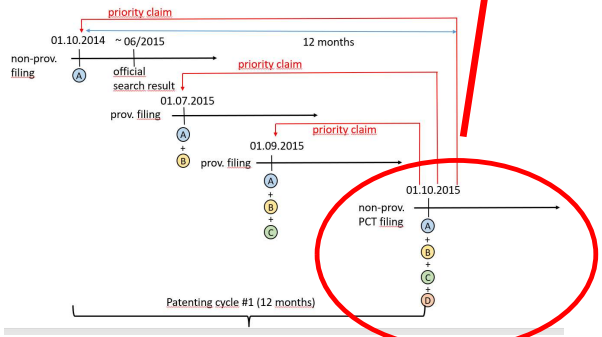
E + F

01.04.2016

non-prov. PCT filing

E + F + G

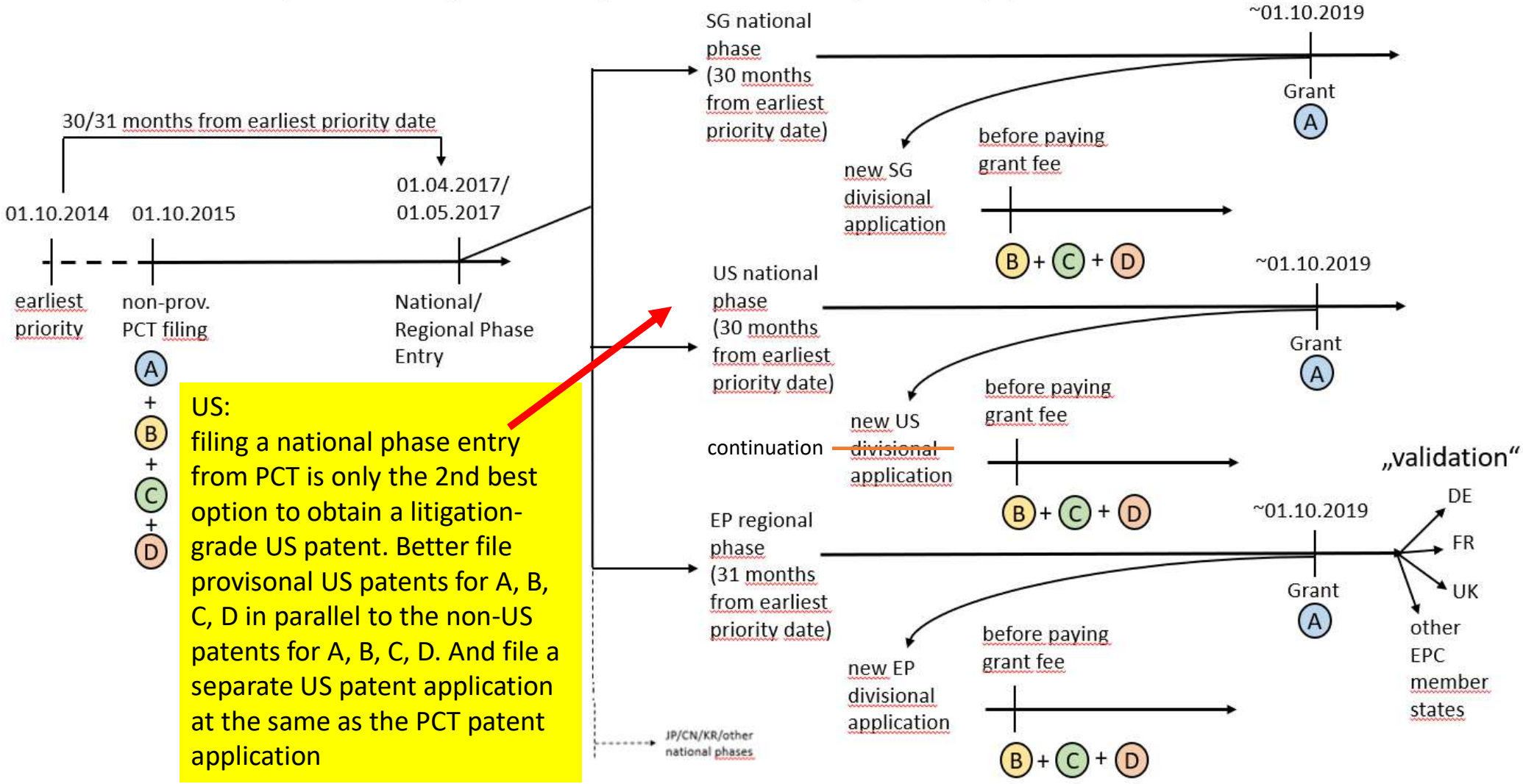
from the slide before:



Patenting cycle #1 (12 months)

Patenting cycle #2 (6 months)

How to further prosecute your non-provisional PCT patent application?



US:
filing a national phase entry from PCT is only the 2nd best option to obtain a litigation-grade US patent. Better file provisonal US patents for A, B, C, D in parallel to the non-US patents for A, B, C, D. And file a separate US patent application at the same as the PCT patent application

Advantages of the 4x4 Patent Tactics, as compared with conventional patent application filing tactics ("conventional" = "one single invention in one patent application")

- simplify administration of your patent portfolio
- delay prosecution costs + renewal fees
- better use of the budget because only those inventions are prosecuted to grant that can be found in your current products
- improved patentability because of early filing dates of the various inventions
- keeping multiple divisional/continuation patent applications allows for adapting patent protection to more recent developments of your competition
- keeping multiple divisional/continuation patent applications allows for adapting patent protection to achieve better KPI results in 3rd party patent portfolio evaluation tools
- There is nothing more frightening than a granted patent with a pending divisional patent application with a large multitude of additional inventive aspects: this creates extra-protection because FTO for competitors is more complex: "loitering patents", "division-able patents", etc.

Loitering Drones ("LDs") can be defined as drones **with an integrated warhead in the frame that can fly autonomously or under control by an operator, then hit their target with their body mass**. If necessary, LDs can loiter over the target area to wait for their intended target to appear.

Loitering Patents ("LPs") can be defined as pending patent applications **with a multitude of inventive concepts, then hit their target with a granted patent that is tailored to a new product of a competitor**. Grant is only initiated after the new product is seen on the market.

Black Hat: „But my product is not yet ready”

“We internally discussed the strategy to see how this could fit in for this invention. We also reanalyzed the invention as it currently stands, and its likely growth in maturity in the next 12-18 months. We unfortunately think that the invention is not mature enough to fit into this filing strategy (or to any kind of filing at all). Therefore, please consider the current matter closed from our end.“

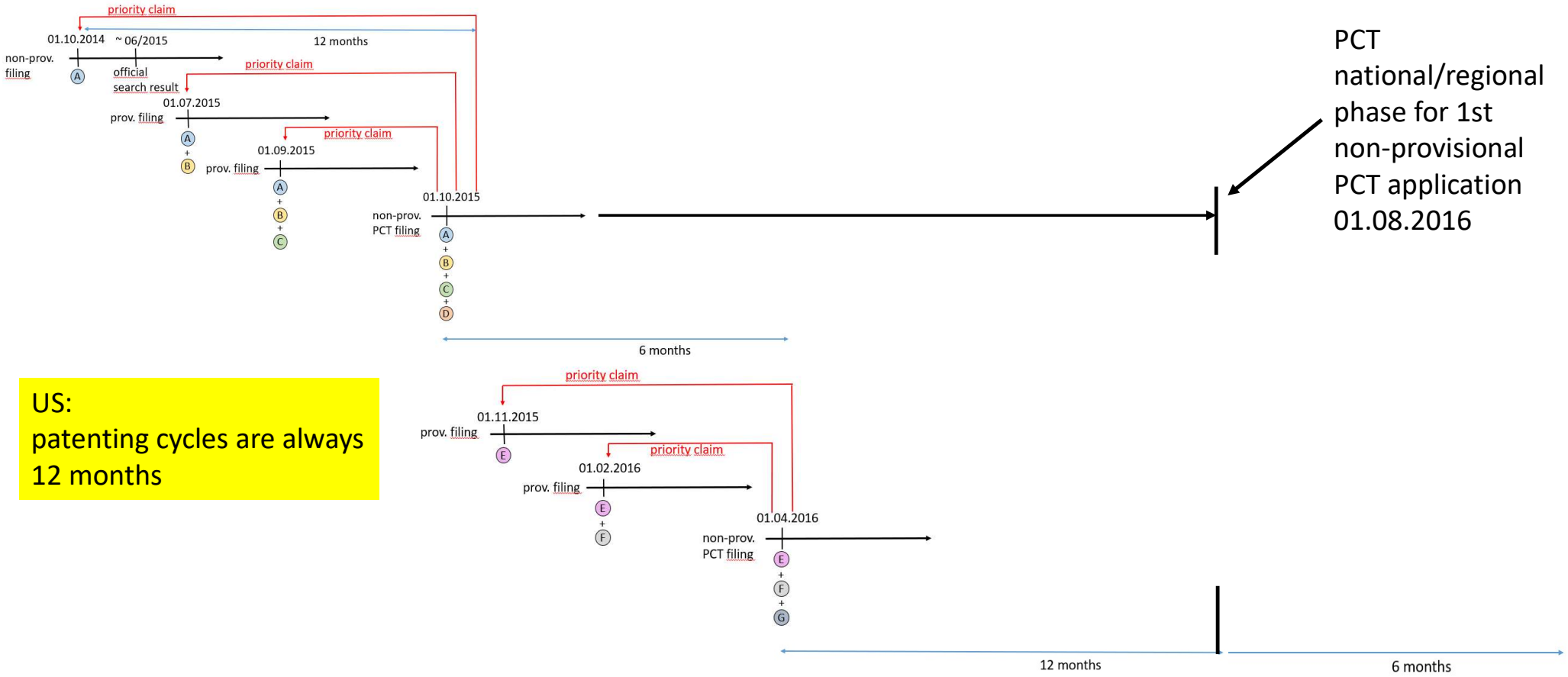
I am lacking words for replying.

Potential pitfalls when applying the 4x4 Patent Tactics

- some countries do not allow **multiple** divisional/continuation patent applications: filing of a divisional/continuation patent application from an earlier divisional/continuation patent application
- double-patenting
- confusion for patent administration and management staff (software needed for matching products, inventions, inventors, and patents/patent applications, Excel does not work)
- you are producing your own early prior art for your inventive concepts, thereby making it difficult to get a patent at a later time for further developments of the same inventive concept. Worst case is to take up an inventive concept into an ABCD patent application and not disclosing it in such detail that it is not enabling so that it cannot get patented.

Advanced part:

How to cope with extended product cycles


priority claim
01.10.2014
~ 06/2015
12 months
non-prov. filing
A
official search result
priority claim
01.07.2015
prov. filing
A + B
priority claim
01.09.2015
prov. filing
A + B + C
01.10.2015
non-prov. PCT filing
A + B + C + D
6 months
PCT national/regional phase for 1st non-provisional PCT application 01.08.2016
US:
patenting cycles are always 12 months
priority claim
01.11.2015
prov. filing
E
priority claim
01.02.2016
prov. filing
E + F
01.04.2016
non-prov. PCT filing
E + F + G
12 months
6 months
Patenting cycles #1 + #2 (18 months)
Patenting cycles #3 + #4 (18 months)

inventions
A B C D E F G of
patent cycle #1 + #2

Patenting cycles #1 + #2 (18 months)

inventions
A B C D E F G of
patent cycle #3 + #4

Patenting cycles #3 + #4 (18 months)

inventions
A B C D E F G of
patent cycle #5 + #6

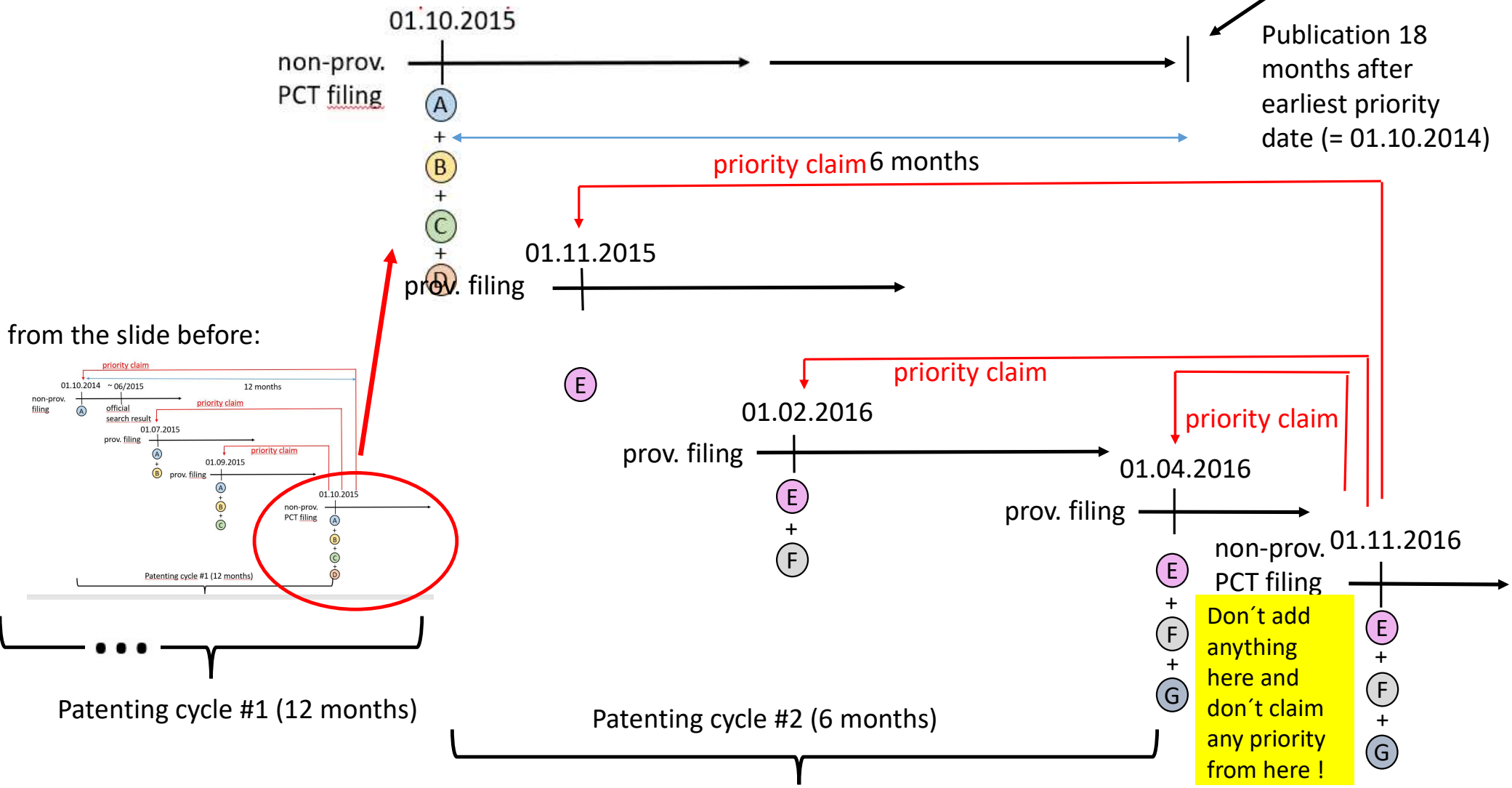
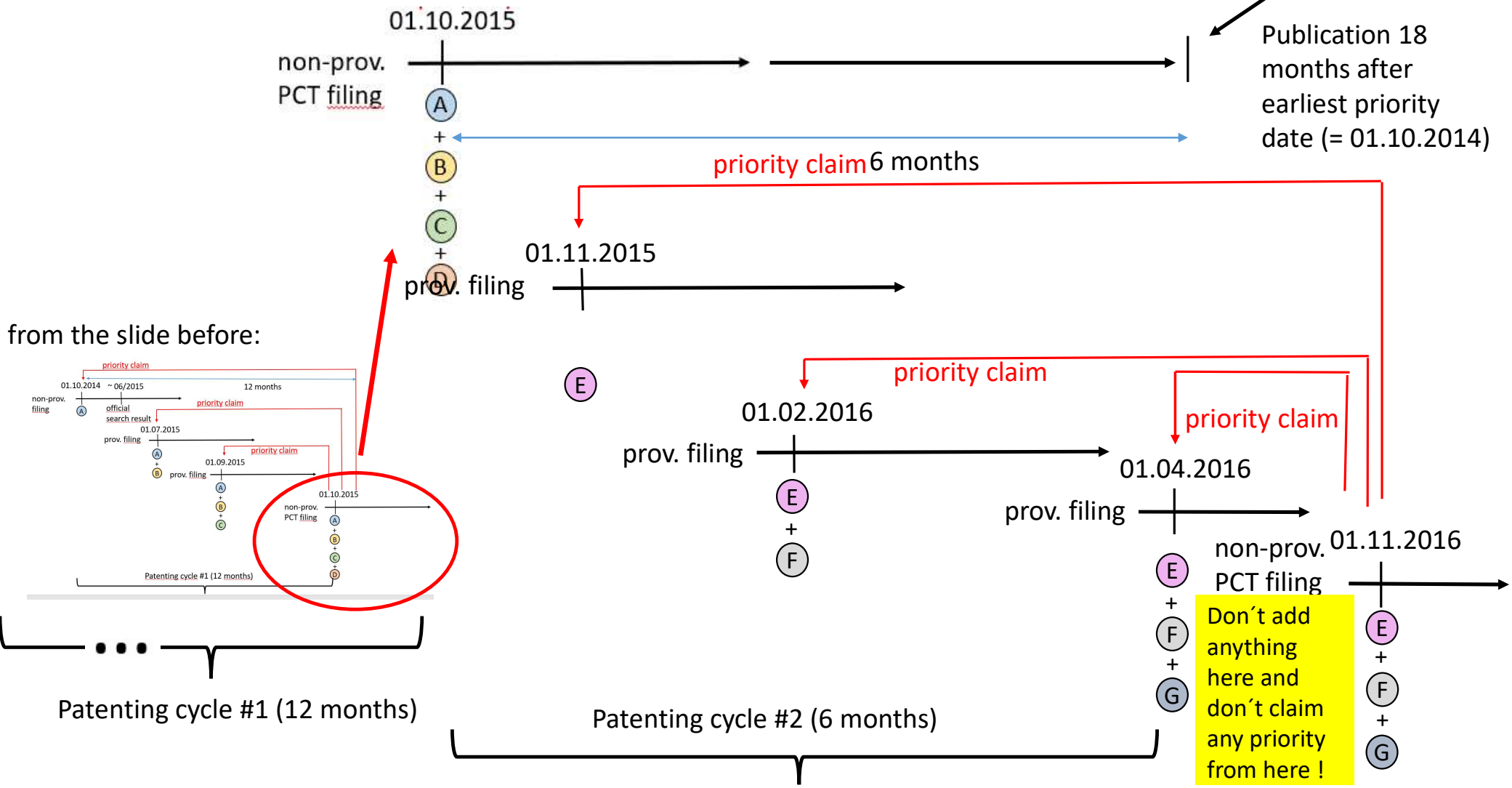
Patenting cycles #5 + #6 (18 months)

inventions
A B C D E F G of
patent cycle #7 + #8

Patenting cycles #7 + #8 (18 months)

• • •

How to use a priority claim for adding subject matter to a patent application (procrastinator version)



How to use a priority claim for adding subject matter to a patent application (procrastinator version)