

Strategic Patent Prosecution

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strat·e·gy

/ˈstrədəʒi/

noun

a plan of action or policy designed to achieve a major or overall aim.

"time to develop a coherent economic strategy"

synonyms: master plan, grand design, game plan, plan (of action), action plan, policy, program;

[More](#)

- the art of planning and directing overall military operations and movements in a war or battle.

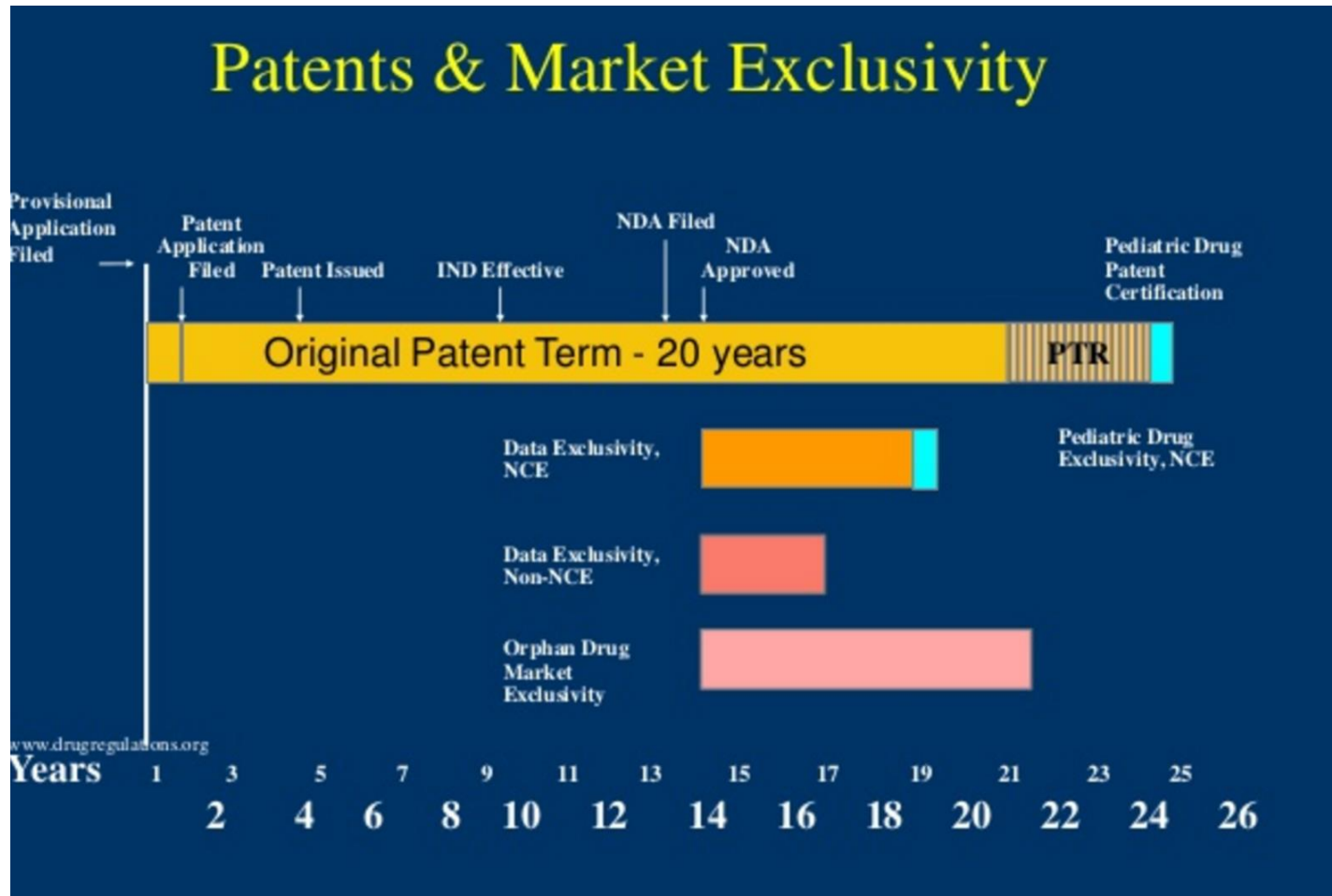
synonyms: the art of war, (military) tactics

"military strategy"

- a plan for military operations and movements during a war or battle.

"nonprovocative defense strategies"

General timeline of events



Strategies relating to filing



Strategies relating to filing

Questions

- Timing
 - Too soon v. not soon enough
 - Beat the competition v. adequacy of disclosure
 - Adding additional disclosure after priority filing
- Claims strategy
 - Broad claims v. narrower claims
 - Inventorship determinations

Where to file?

Based on a 2014 survey of life sciences companies ...

- Top foreign filing 'destinations' are:

Small companies

Europe -- ~80%
China – 64.9%
Canada – 62.2%
Japan – 62%
Australia – 48.7%
Brazil – 43.2%
India – 39.2%
South Korea – 35.1%
Israel – 21.6%
Mexico – 20.3%

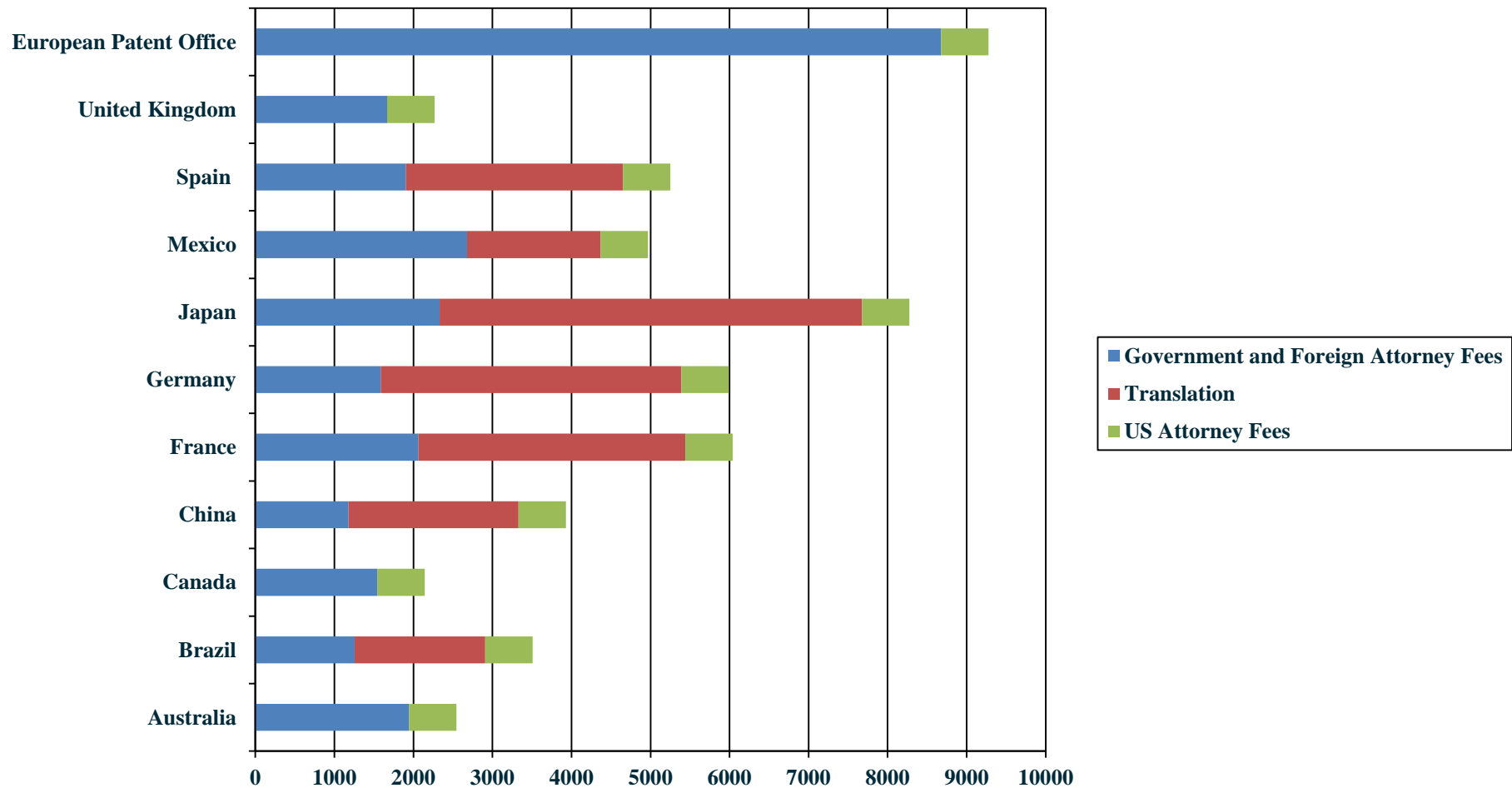
Medium sized companies

Europe -- ~85%
China – 78.4%
Canada – 77%
Japan – 75.7%
Australia – 62.2%
Brazil – 62.2%
India – 56.8%
South Korea – 37.8%
Israel – 35.1%
Mexico – 41.9%
+ Argentina – 31.1%
+ Russia – 33.8%
+ New Zealand – 40.5%

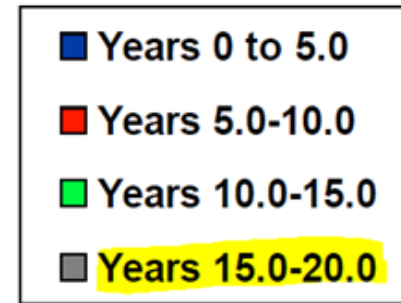
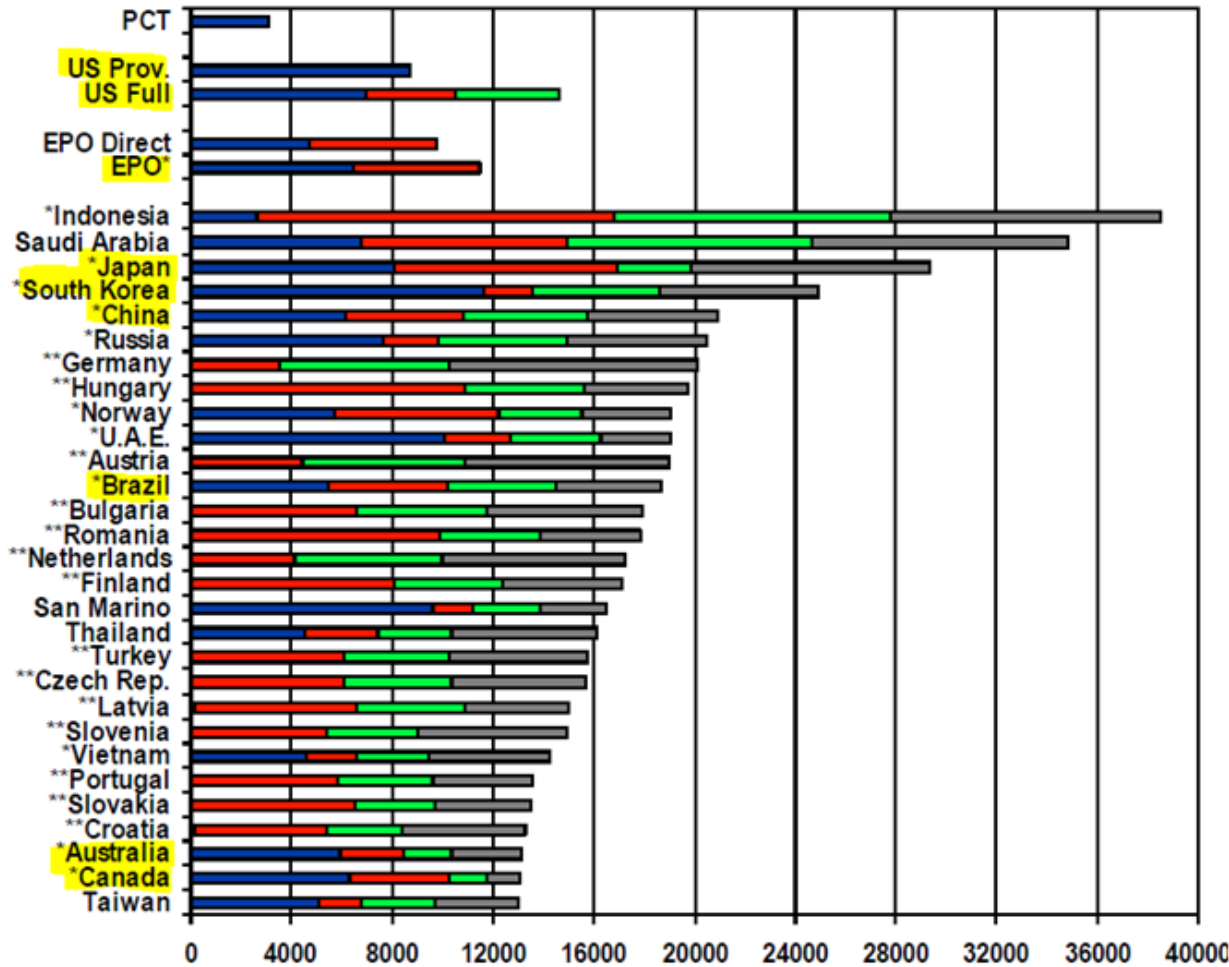
Large companies

Europe -- >90%
China – 89.2%
Canada – 85.1%
Japan – 81.1%
Australia – 74.3%
Brazil – 77.7%
India – 75.7%
South Korea – 44.6%
Israel – 51.4%
Mexico – 58.1%
+ Argentina – 58.1%
+ Russia – 52.7%
+ New Zealand – 51.4%

2013 data on foreign filing costs/fees



2013 data on overall costs over life of patent



Accelerating prosecution?

Many options to expedite allowance

- Pre-filing
 - Track 1
 - PPH
- After-final programs
 - Post-Prosecution Pilot (P3) Program
 - After-Final Consideration Pilot (AFCP) 2.0
 - Pre-Appeal Brief Conference Pilot Program

Post-issuance actions

Life-cycle management

- Follow-on applications
 - Timing
 - Issues
 - Coordination

Post-grant challenges

- Planning in advance for IPR/PGR
- Prosecution strategies

Contact Fish & Richardson

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Contact us with your questions and comments.



Gwilym Attwell
Principal
Fish & Richardson
attwell@fr.com
302-778-8458



Teresa Lavoie
Principal
Fish & Richardson
lavoie@fr.com
650-839-5110



Martina Tyreus Hufnal
Principal
Fish & Richardson
hufnal@fr.com
302-778-8471



Andrea Dorigo
Of Counsel
Fish & Richardson
durigo@fr.com
858-678-4794