



Intellectual Property Attorneys

Only Patents!

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Intellectual Property Attorneys

Who we are?

- Founded 1994
- IP Law Boutique – entire IP spectrum: trademarks, copyright, geographical indications, patents, designs
- National presence – six offices across India – Gurgaon, Bangalore, Hyderabad, Mumbai, Chennai and Delhi
- We are team of around 275 people



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Patent

- Legal tool to monopolize your invention
- Invention - Science and Technology
- Monopoly for 20 years
- Monopoly is country specific



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Process and Timelines (India)

- Around 3-4 years to obtain grant
- For startups, around 1 year

Definition of Startup – Law in India

- incorporated or registered within last ten years
- turnover for any of the financial years since incorporation/ registration has not exceeded INR 100 crores
- has not been formed by splitting up or reconstruction of a business that was already in existence
- working towards innovation, development or improvement of products or processes or services, or if it is a scalable business model with a high potential of employment generation or wealth creation



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Prerequisites to obtain patent

- Invention should be globally:
 - Novel/New
 - Inventive/Non-obvious
 - Industrially applicable/Useful



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Example

- Nanotechnology – reduce size to enhance bioavailability?
 - Novel?
 - Inventive?



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Example

- Nanotechnology – reduce size to provide for florescence?
 - Novel ?
 - Inventive ?

Patentability in India

- Medical Device – Yes
- Software – Yes
- Drug/Composition/Formulation - Yes
- Process of preparing Composition/formulation – Yes
- Method of treatment/diagnosis/surgery/prophylactic/agriculture/horticulture – No
- Recombinant Microbe – Yes
- Naturally occurring microbe – No
- Plant/Animal *per se* – No



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Ten Pointers



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Procrastination – missed opportunity!

- While innovation is the key differentiator in the marketplace, founders often end up procrastinating filing/registering IP
- Procrastination in registering Patent can be a deal-breaker
- Don't wait for investors to remind you



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Do you really own that IP?

- Founders may need processes to have all the IP owned by Startup
- Agreements with employees and contractors should provide clarity on who owns what
- Investors/strategic business partners/Grant Providing Govt Agencies, they all want to see IP ownership in the name of startup



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Not everyone who work on a project becomes an inventor

- Identifying inventor for a patent is not similar to identifying author for an article in a scientific journal
- Generally, the people who have contributed to the idea are the inventors
- People who have merely executed someone else's instructions generally don't qualify as inventors



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Disclosing – too little or too much – is a problem

- A good patent specification should be:
 - long enough to disclose the invention, and
 - short enough to protect trade secrets/know-how
- Long enough so that you establish enablement
- Short enough so that you don't donate your trade secrets/know-how to public



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Seek multilayer protection and single layer is usually inadequate

- Each layer is unique and can further strengthen your monopoly
- For example, a medical device can be:
 - patented for its technical advancement
 - design protected for its aesthetic value
 - have a brand equity protected by Trademarks, and so on!
- ❖ And, within patent field, different unique aspects of a medical device can lead to multiple patents



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Know thy market – both present and future

- Startups have to manage several uncertainties including identification of markets
- Since resources are limited, they need to make few difficult choices
- But investors are bullish when monopoly is available in all the key markets
- Especially when Startups pivot midway during their journey, having some flexibility to look at alternate markets is helpful



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Do you have freedom to practice/operate (FTO) your own patent?

- It is very important for you as a Startup to appreciate that owning a patent doesn't always mean that you have the freedom to practice invention sitting in that patent
- This is so because there could be a situation where one of the components of your invention is already patented by someone else
- Hence, you may need to take license from that person or knockoff that patent or employ some other strategy to practice your own patent



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Size does matter, but quality is more important

- Large-size IP portfolio can generally lead to greater competitive advantage and higher valuation
- However, one shouldn't lose sight of quality when expanding IP portfolio
- Otherwise, large size portfolio could simply be a white elephant



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Filing Strategies

Europe – around 45 Countries

Map showing the geographic coverage of European patents as of 1 March 2019

■ Member states (38)

- Albania
- Austria
- Belgium
- Bulgaria
- Croatia
- Cyprus
- Czech Republic
- Denmark
- Estonia
- Finland
- France
- Germany
- Greece
- Hungary
- Iceland
- Ireland
- Italy
- Latvia
- Liechtenstein
- Lithuania
- Luxembourg
- Malta
- Monaco
- Netherlands
- North Macedonia
- Norway
- Poland
- Portugal
- Romania
- San Marino
- Serbia
- Slovakia
- Slovenia
- Spain
- Sweden
- Switzerland
- Turkey
- United Kingdom

■ Extension states (2)

- Bosnia and Herzegovina
- Montenegro

■ Validation states (4)

- Cambodia
- Republic of Moldova
- Morocco
- Tunisia



Eurasian Patent Office (EAPO) – 8 Countries



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

African Regional Intellectual Property Organization (ARIPO) – 20 Countries



- Botswana
- Eswatini
- Gambia
- Ghana
- Kenya
- Lesotho
- Liberia
- Malawi
- Mauritius
- Mozambique
- Namibia
- Rwanda
- São Tomé and Príncipe
- Sierra Leone
- Somalia
- Sudan
- Tanzania
- Uganda
- Zambia
- Zimbabwe

Organisation Africaine de la Propriété Intellectuelle (OAPI) – 17 Countries



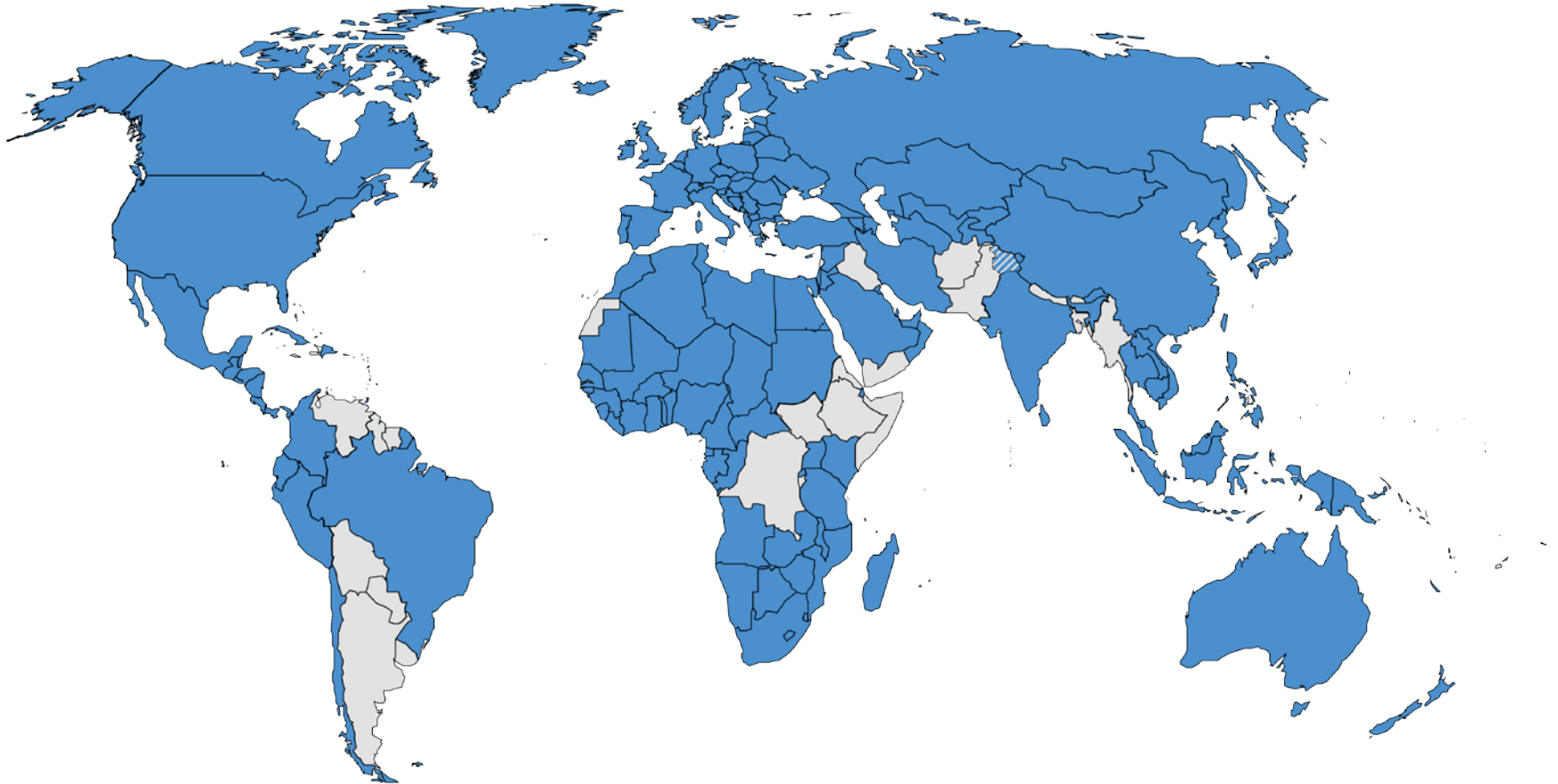
- Benin
- Burkina Faso
- Cameroon
- Central African Republic
- Chad
- Congo
- Ivory Coast
- Equatorial Guinea
- Gabon
- Guinea
- Guinea-Bissau
- Mali
- Mauritania
- Niger
- Senegal
- Togo
- Comoros

Gulf Cooperation Council (GCC) – 6 Countries



Gulf Cooperation Council is a regional intergovernmental political and economic union consisting of:

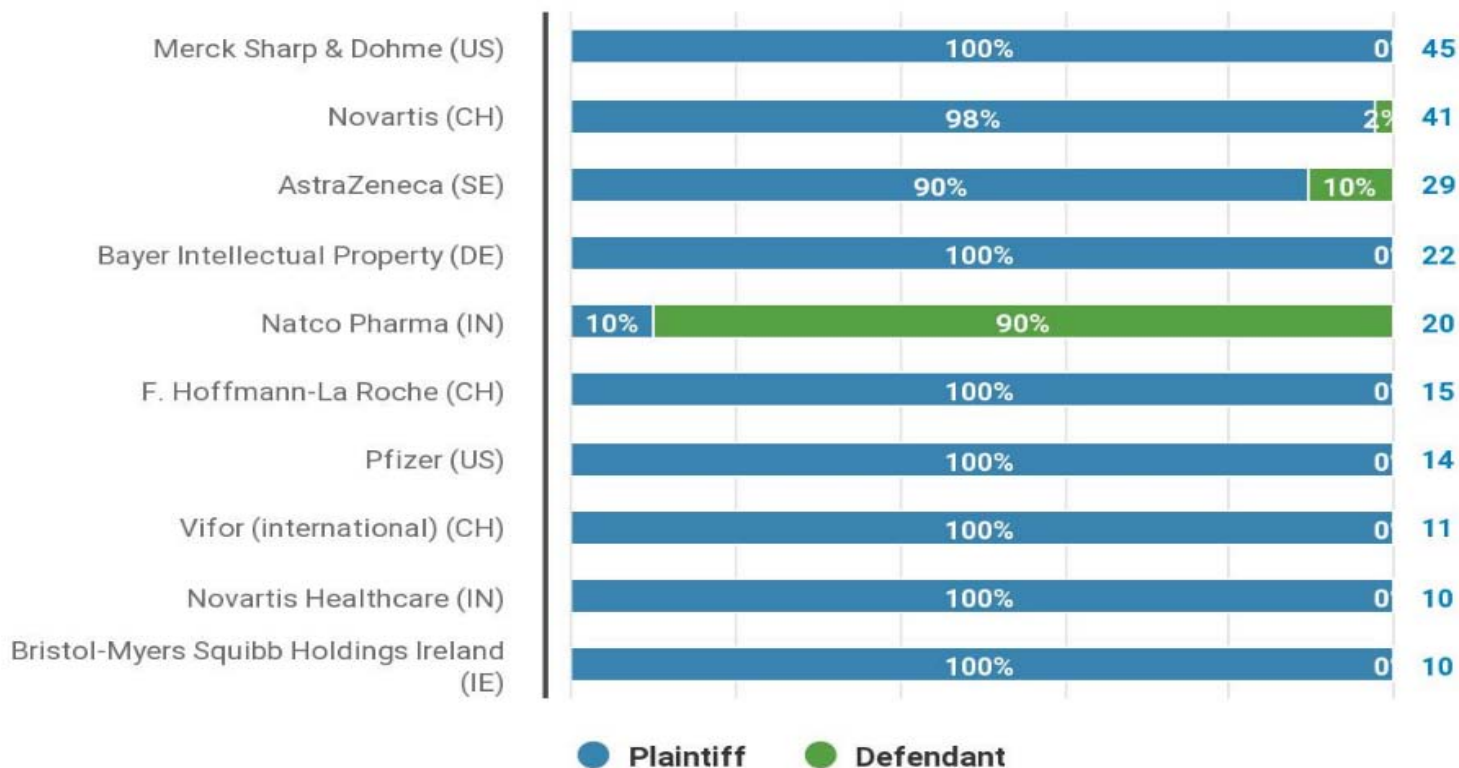
- Bahrain
- Kuwait
- Oman
- Qatar
- Saudi Arabia
- United Arab Emirates.



Most active patent enforcers (2010-20)

- Interestingly, all are in Pharmaceuticals space

Most Active Parties (Total Case Count)



(Source – Darts IP)



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Any Questions?

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