

# Patents – a Global View

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# Patents – A Global View

- The Basic Application
- The First Year
- The End of the First Year
- PCT
- Foreign Filings
- What Happens – US, EPO, GB, JP

# The Basic Application

- ❑ Filed in the Indian Patent Office
- ❑ Free to Disclose to Third Parties
- ❑ No Further Action Necessary for a year

# The First Year

- Need to know whether worth filing overseas applications
- Consider filing early UK application
  - Search report within a few months
  - Cheap
  - Can not rely on search results from Indian, US or EP Offices

# Patent Co-operation Treaty

- ❑ Available to any Indian National or Company
- ❑ Single Application Designates up to over 100 countries
- ❑ Filed in English and searched and, optionally examined as a Single application

# Patent Co-operation Treaty

- Indian applicants can choose who performs search and examination
  - US, EPO, Australia and others
- Application Published after 18 months
- Split into separate national and regional applications after 30 months

# Advantages of PCT

- ❑ Defers cost for a further year and a half
- ❑ Allows a search to be made before deciding whether to proceed
- ❑ Gives more time to assess whether the invention is commercially viable

# Disadvantages of PCT

- ❑ Delays the patent granting procedure – not always welcome
- ❑ Not cost efficient if only small number of countries are of interest (IN, US, EP)

INTERNATIONAL SEARCH REPORT		International Application No. PET/GB2004/000339
<b>A. CLASSIFICATION OF SUBJECT MATTER</b> IPC 7 G06F 11/00		
According to International Patent Classification (IPC) to which national classification apply?		
<b>B. FIELD SEARCHED</b> Classification system used: Classification system (Inventory classification system) IPC 7 G06F		
Classification searched: Class (es) searched: Class(es) to which the search results are included: Class(es) searched:		
Electronic data base(s) searched during the international search: (Date of last search) (Date of present search) (Ref. No.) EPO-Interna1		
<b>C. DOCUMENTS CONSIDERED TO BE RELEVANT</b>		
Category*	Character of document, authorship, where appropriate, of the relevant passages	Relevancy class No.
A	WWW.DEALHUB.COM: "DealHub: BigData! Dealing Solutions" WWW.ARCHIVE.ORG 18 February 2003 (2003-02-01), pages 1-16. XP00228979 Retrieved from the Internet: URL (http://web.archive.org/web/20030210011411/http://www.dealhub.com/) 'retrieved on 2004-07-28' pages: 6-8, 11	1-26
A	US 2002/183732 A1 (GOLDFELD VLADIMIR ET AL) 1 August 2002 (2002-08-01) abstract: Figure 1 paragraphs: 0051 - 0073 paragraphs: 0078 - 0108	1-26
-/-		
<input type="checkbox"/> Further documents are listed in the continuation class C		<input type="checkbox"/> Patent family members are listed in class D
* Special categories of documents: <input checked="" type="checkbox"/> Document relating to priority claim of which is classified to the applicable subclass <input checked="" type="checkbox"/> Earlier document published prior to the international application <input checked="" type="checkbox"/> Document which is a translation of the international application into a language other than the language of the application <input checked="" type="checkbox"/> Document relating to an oral disclosure, use, exhibition or other means <input checked="" type="checkbox"/> Document which is a translation of the international application into a language other than the language of the application		
<input checked="" type="checkbox"/> Date of international search		<input checked="" type="checkbox"/> Date of making of the international search report
27 July 2004		12/06/2004
Class conducting office: office No. 1 European Patent Office, P. O. Box 1, 48300 Zaventem, Belgium Tel. +32-27461444, Telex 32141 EPO B, Fax +32-27461444		Conducted by: Ropper, E

(12) INTERNATIONAL APPLICATION PUBLISHED UNDER THE PATENT COOPERATION TREATY (PCT)

(19) World Intellectual Property Organization  
International Bureau



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1 August 2002 (01.08.2002)

PCT

(10) International Publication Number  
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- (71) Applicant: EBS DEALING RESOURCES INTERNATIONAL LIMITED (GB/GB); 55-56 Lincoln Inn Fields, London WC2A 3LJ (GB).
- (81) Designated States (national): AE, AG, AL, AM, AT, AU, AZ, BA, BB, BG, BR, BY, BZ, CA, CH, CN, CO, CR, CU, CZ, DE, DK, DM, DZ, EC, EE, ES, FI, GB, GD, GE, GH, GM, HR, HU, ID, IL, IN, IS, JP, KE, KG, KP, KR, KZ, LC, LK, LR, LS, LT, LU, LV, MA, MD, MG, MK, MN, MW, MX, MZ, NO, NZ, OM, PH, PL, PT, RO, RU, SD, SE, SG, SI, SK, SL, TJ, TM, TN, TR, TT, TZ, UA, UG, UZ, VN, YU, ZA, ZM, ZW.
- (84) Designated States (regional): ARIPO patent (GH, GM, KE, LS, MW, MZ, SD, SL, SZ, TZ, UG, ZM, ZW), Eurasian patent (AM, AZ, BY, KG, KZ, MD, RU, TJ, TM), European patent (AT, BE, CH, CY, DE, DK, ES, FI, FR, GB, GR, IE, IT, LU, MC, NL, PT, SI, TR), OAPI patent (BF, BJ, CF, CG, CI, CM, GA, GN, GQ, GW, ML, MR, NE, SN, TD, TG).

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**Published:**

— with declaration under Article 17(2)(a); without abstract; title not checked by the International Searching Authority

For two-letter codes and other abbreviations, refer to the "Guidance Notes on Codes and Abbreviations" appearing at the beginning of each regular issue of the PCT Gazette.



WO 02/059805 A2

(54) Title: CONVERSATIONAL DEALING SYSTEM

(57) Abstract:

Re Item V

1. The following documents are referred to in this communication:

D1: Dealhub, Digital Dealing Solutions. Former version of homepage  
www.dealhub.com, dated 10.02.03 and earlier. XP002289979.  
Retrieved via www.archive.org.

D2: US2002/103732 A1

2. Method Claims

2.1 Prior art

A system called "DealHub" (see description p. 2, line 28 - p. 3, line 10) is regarded as the closest prior art to the method (and system) of the application.

Conventionally (see description p. 1, line 23 - p. 2, line 21), every time a trade is completed a trading system of a bank generates a deal ticket and sends said ticket to the back office systems of the counterparties to the deal. Every trading system is allocated a so-called deal code which identifies the bank and the type of trading system (i.e. the type of data format used). Consequently, a bank requires a separate communication line to its back office for each trading system deployed within the bank.

It is further known in the the state of the art (see description p. 2, line 28 - p. 3, line 10) that a product called "DealHub" provides an improvement over the above conventional system regarding the number of communication lines. DealHub provides a physical interface for the processing of deal tickets which cuts the number of communication lines to the back office system to a single one. Thereby a server receives input data from multiple trading systems and provides a single output to the bank's back office system over a single communication line (see also D1: p. 6, para. 3; p. 7, para. 2, p. 8, para. 2; p. 9, para. 1).

- 2.2 The technical problem of the application is considered as to further facilitate the transmission of deal tickets from a plurality of trading systems to a bank's back office system deploying a single communication line between said plurality of

trading system and the back office system.

- 2.3 The application provides a solution to the above problem whereby a virtual deal code having an associated deal range is defined to which each of the deal codes of a plurality of trading systems is mapped.

2.4 Inventive Step

The differentiating features (see items 2.3 and 2.5) are disclosed in none of the other available prior art documents and are not obviously derivable from the available state of the art.

The disclosure of the prior art "DealHub" does not state how said single data feed to the back office system is implemented (cf. see description p. 2, line 28 - p. 3, line 10; and also D1).

D2 is concerned with the routing of orders within an automated trading system selecting a route among multiple paths (para. 4 - 7 and 28). In order to route said orders from a dealer system to the required market system a concatenated code used which comprises the dealer code, the market code and other codes specifying path parameters for the path selection (para. 80 - 83; Fig. 1). However, said concatenated code is not used in the context of mapping one code to another code and also serves a different purpose.

Thus, even by combining any of the prior art documents would not lead to the subject-matter of the method (and system) of the application. Therefore, an independent claim to such a method would meet the requirements of Article 33(2) and (3) PCT provided it comprises all the essential features (see item 2.5).

2.5 Essential Features

Claim 1 does not disclose all the essential features which are required to carry out the method of the application i.e. to distribute deal tickets generated by a plurality of trading systems, each deal ticket associated with a trade, to the back office systems of the banks associated with said trades. The mere definition of a "virtual deal code" would not be sufficient to perform this task.

# National Filings and National Phases

- Filed after 12 months (national filings) or 30 months (national phases)
- Applications are examined individually by separate Patent Offices
- We will look at UK, EPO, US and Japan

# UK

- ❑ Similar to the EP system but much simpler.
- ❑ Quick (compared to most patent offices) and cheap
- ❑ Search followed by publication and examination for novelty and inventive step

# UK

- ❑ Inventive step requirement is not onerous
- ❑ Probably more easy to protect borderline software inventions than in EPO
- ❑ No opposition but always open to revocation
- ❑ Enforcement is through the Patents County Court or the Patents Court



Application No: GB 0312952.5  
 Claims searched: 1 to 31

Examiner: Geoffrey Pritchman  
 Date of search: 21 October 2003

**Patents Act 1977 : Search Report under Section 17**

**Documents considered to be relevant:**

Category	Relevant to claims	Identity of document and passage or figure of particular relevance
X	1-7, 9, 12-22	WO 92/15124 A1 (MASSACHUSETTS INSTITUTE OF TECHNOLOGY)-see abstract, page 14 lines 7-9 and claims 1, and 19
X	1-7, 9, 12-22	US 5739796 (SECRETARY OF THE ARMY)-see abstract, figure 3 and column 7 lines 1-7 and 48-66
X	1-7, 9, 12-22	US 5689275 (GEORGIA TECH)-see abstract, figure 3 and column 6 lines 1-3
X	1-7, 9, 12-22	US 5600342 (HUGHES AIRCRAFT)-see abstract
X, Y	X: 1-7, 9, 10, 12-22 Y: 23	WO 95/30917 A1 (MASSACHUSETTS INSTITUTE OF TECHNOLOGY)-see abstract
X, Y	X: 1-7, 9, 12-22 Y: 23	WO 98/15858 A1 (SECRETARY OF STATE FOR DEFENCE)-see abstract, page 3 final paragraph to page 4 first paragraph and page 5 final paragraph to the paragraph bridging pages 8 and 9.

**Categories:**

X Document indicating lack of novelty or inventive step	A Document indicating technological background and/or state of the art.
Y Document indicating lack of inventive step if combined with one or more other documents of same category.	P Document published on or after the declared priority date but before the filing date of this invention.
A Member of the same patent family	E Patent document published on or after, but with priority date earlier than, the filing date of this application.

**Field of Search:**

Search of GB, EP, WO & US patent documents classified in the following areas of the UKC<sup>6</sup>:

Worldwide search of patent documents classified in the following areas of the IPC<sup>7</sup>:

The following online and other databases have been used in the preparation of this search report :

An Executive Agency of the Department of Trade and Industry

# EPO

- ❑ Single Application leads to a basket of national patents
- ❑ Applicant designates countries to be covered and, at grant, decides which of those to maintain
- ❑ Central Opposition for 9 months after grant
- ❑ Infringement and validity are national issues dealt with in national courts

# EPO – The Application Stage

- On filing
  - Pay filing, search and excess claim fees
- Publication at 18 months
- Publication of search report
- 6 months to pay examination and designation fees
  - 7 designation fees covers all contracting states

# EPO – The Application Stage

- Renewal fees for the third year onwards
- Substantive Examination
- How to deal with objections
  - Written responses
  - Interview by phone or in person
  - Oral proceedings
  - Examiners set out detailed reasoning for objections

# EPO – The Grant Stage

- Acceptance of Application
  - Minor amendments
  - Pay Grant fees
  - File Translations of Claims into FR + DE
- Grant – Opposition tem commences
- 3 Months to record grant in each country to be covered

# EPO – The Grant Stage

- What must be done in each country
  - Address for service in that country (most countries)
  - Translation of entire specification
    - Some countries can share e.g. FR + BE or DE + AT
  - Can be expensive depending of length of spec.
  - Renewal Fees in each country
  - National Infringement and Revocation

# How to Handle the Grant Stage

- ❑ Select the countries of interest carefully to reduce cost
- ❑ Many applicants only go for UK, FR, DE
- ❑ IT, ES, NL are next most common
- ❑ Where are the major competitors
- ❑ Where are infringements most likely

# Appeals

- ❑ Applications and Oppositions can go to Oral Proceedings
  - Examining Division/Opposition Division of 3 examiners
- ❑ Appeals to the Technical or Legal Board of Appeal
- ❑ No Further Appeal
- ❑ Enlarged Board of Appeal for cases where the convention is not clear

# Oppositions

- ❑ Filed up to 9 months after grant
- ❑ Central Opposition covers all designation
- ❑ Can lead to amendment of patent
- ❑ Or total revocation
- ❑ Amendments need to be filed in all designated states

# USA

- ❑ Combined Search and Examination
- ❑ Duty of Disclosure
  - All relevant prior art must be submitted
  - Otherwise patent may be unenforceable
- ❑ 18 Month Publication
- ❑ Continuation and Continuation-in-part applications
- ❑ Final rejections and Requests for continuing examination (RCEs)

# USA

- Appeal to Patent Office appeals tribunal
- No opposition as such but developing re-examination system
- Renewal fees every 3.5 years
- High presumption of validity of issued patent
- Very complex litigation system

# USA

- ❑ Court of first instance is a district court at state level
- ❑ Judge may have no experience of patents
- ❑ Trial is before a jury
- ❑ Who will have no experience of patents
- ❑ Appeal is to the Court of Appeal for the Federal Circuit – a Federal Court

# USA

- US Litigation is extremely expensive
- But
  - Damages awards can be very high (\$M10s)
- Triple Damages for wilful infringement

# Inventorship

- ❑ Most countries require details of the inventors
- ❑ In USA the inventor is the applicant
- ❑ Important to check that company actually owns the invention
- ❑ Is ownership dealt with in contract of employment

# Inventorship

- Are there any external inventors?
  - Do we need assignments
- Inventors will need to sign papers up to 30 months after application is filed
  - Do we need an agreement with the inventor