



AVENIR



HELLEVIG·KLEIN·USOV LLC

attorneys at law

Protecting Innovation Some Basics about Patents

Daniel Klein, JD, MBA,
B.S.Mech.Eng.

US Patent Attorney 33,721
HELLEVIG·KLEIN·USOV LLC





A V E N I R



HELLEVIG • KLEIN • USOV LLC
attorneys at law

Seeking Investors or Buyers for Your Company

Tangible Assets

- Real Estate

- Plant & Equipement

- Stocks

Intangible Assets

- Accounts Receivables

- Trademark/Brand/Reputation

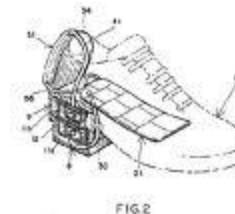
- Customer Lists and Customer Loyalty

- Technologies (patents & trade secrets)

- Know How

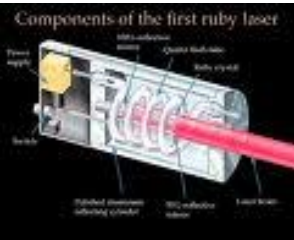
Patents v. Trade Secrets

- Patents easier to obtain, defend and exploit than trade secrets
- Trade secrets, although cheaper to obtain, very difficult to defend and exploit



What is a patent?

- A negative right
- Right to exclude others from using
- Not a right to use a technology at all
 - Example: Lasers and Laser Improvement patents
 - A laser is a pioneer invention from 1960
 - Improvement laser patents include lasers to clean
 - The improvement patentee who discovered that lasers can clean not able to use that patent (unless the original patent expired)
 - The original laser inventor has no right to use laser cleaning patents
- A patent = a right to hire a lawyer and walk into court...and in the case of Russia to go to the police





Conditions of Patentability

- Novel (as compared to the state of the art in the world; not just in Russia)
- Patentable Subject Matter; like chemical processes
- Must be an inventive step
 - Is the subject matter “obvious to one skilled in the relevant art?”



AVENIR



HELLEVIG·KLEIN·USOV LLC
attorneys at law

Types of Patents in Russia

- Utility Models and Industrial Designs
- Inventions
 - Processes
 - Products



When is a patent of value?

- A very small % of patents have any commercial value
- Criteria to consider
 - Is the patent issued in any country?
 - Is the patent issued in a Western jurisdiction?
 - Are the inventors from a Russian university?

Is the patent/technology of value?

- A patent can be invalidated for dozens of reasons and is delicate like a balloon that can be burst with a pin from many different points
- A patent validity opinion might be advisable
- A commercial analysis might be advisable



Filing a PCT Application

- Need to designate countries where the patent might be exploited
- Foreign filings can be very costly



Patent Protection Issues

- Russia has a 6 month grace period for intentional disclosures
 - If the invention has been disclosed more than 6 months prior to filing it is theoretically not valid for want of Novelty
 - Other countries with 6 month grace periods include:
 - Japan, Germany, Austria, Hungary, and the Czech Republic
 - US & Canada have 12 month grace periods
 - For Russian applicants the 6 month grace period would apply in Russia and other jurisdictions just referred to; but when filing PCT extensions in other countries, pre-filing disclosure invalidates an application as it destroys the inventions novelty.
 - Many countries also apply a grace period for unintentional disclosures: for example when a third party breaches a non-disclosure obligation or a renegade employee makes improper disclosure

Patent Protection Issues

Recommendations

1. If you can file before you publish, demonstrate, or offer for sale - then by all means file your patent application first.
2. When you cannot file first - then take precautions:
 - if you have to give a private presentation or speech - do not provide handouts. A private presentation is not considered a public disclosure.
 - if you must publish before filing - limit your description of the actual invention - talk about the benefits, not the invention.
 - if you need to make an offer of sale - present it as a solution to a problem - without describing the actual invention.
 - when dealing with business partners - always work through NDA's - always.



AVENIR



HELLEVIG·KLEIN·USOV LLC

attorneys at law

Contacts

Moscow

Bolshaya Sadovaya str., 10,

Tel.: +7 (495) 225 30 38, fax: +7 (495) 225 30 39

www.aveniraccounting.com

www.hkupartners.com

www.adapttochange.ru

St.Petersburg

Moika 37, office 10N

Tel.: +7 (812) 244 7549, fax: +7 (812) 244 7548

Tver

Tchaikovskogo avenue, 28/2, of. 502

Tel/fax: +7 (495) 225 30 38

Yekaterinburg

Tel.: +7 (495) 225 30 38

Helsinki

Annankatu 34, 00100 Helsinki

Tel.: +358 (0) 40 766 9591



AVENIR



HELLEVIG·KLEIN·USOV LLC

attorneys at law

Thank you