# **The Legal 500's IP Forum 500 Creating Profitable IP Strategies**

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AGENDA



12:00	-•	Registration   Lunch   Networking
13:15	-	SESSION 1: Obtaining patents
14:45	-	Coffeebreak
15:30	-	SESSION 2: What to do with patents?
17:00	_	Networking drinks on the rooftop terrace and at the lounge area

# The Legal 500's IP Forum "Creating Profitable IP Strategies" Key Speakers





#### Anna Bauböck

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BARDEHLE PAGENBERG

German and European Patent Attorney, Partner

## The Legal 500's IP Forum "Creating Profitable IP Strategies" Panellists Session 1





**Dr. Deborah Schmauß** Efficient Energy GmbH Patent Engineer



Dr. Jörg Dreyhsig

**Fresenius Medical Care** 

Global Head of Litigation and Opposition, Global Intellectual Property



#### **Thomas Bereuter**

**European Patent Office** 

Program Area Manager, European Patent Academy The Legal 500's IP Forum "Creating Profitable IP Strategies" SESSION 1: Obtaining patents



1. Extracting Inventions from R & D Departments

#### • Role of IP department

Receiving invention disclosure statement or active prosecution of inventions? Teaching engineers about patent law? Teaching patent people about the latest developments in the technology?

#### Fostering an innovative culture and environment

How do you create an atmosphere of innovation? Financial incentives (magnitude, milestones) Non-financial incentives (honour, career boost) The Legal 500's IP Forum "Creating Profitable IP Strategies" SESSION 1: Obtaining patents



- 2. Patent Prosecution
  - Inhouse vs. Outside
     What is the right "interface"?
     What can attorneys in law firms do better?
     What are the strength of inhouse patent attorneys / managers?

#### Cost control

Prioritization (e. g. gold, silver, bronze), territorial coverage, conscious reduction of portfolio over time.

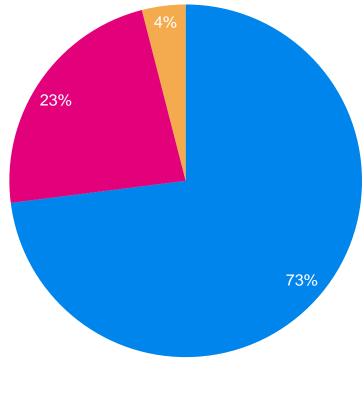


# The Legal 500 – Intellectual Property (IP) Research March 2018



# Almost three quarters have a defined strategy for building or renewing the company's IP portfolio



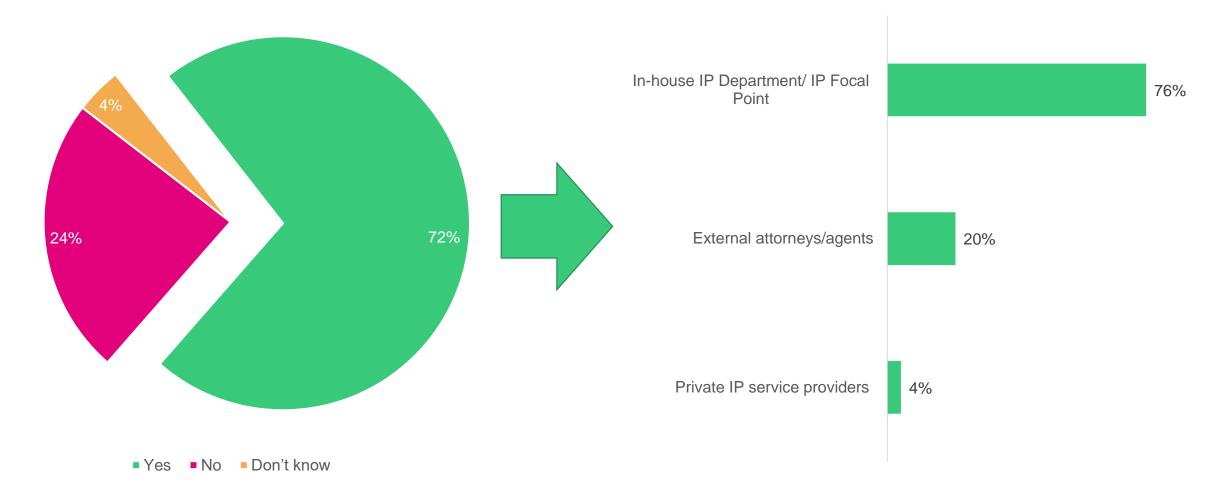


■Yes ■No ■Don't know

Q19 Does your company have a defined strategy for building/renewing its IP portfolio (generating own IP, acquiring IP rights, Base: 104 licensing in, etc.)?

### IP strategy is part of the company's corporate strategic planning for most. In-house IP departments tend to be in charge of IP strategy





Q23 Is the IP strategy part of your company's corporate strategic planning? Q24 Who is in charge of IP strategy (management, inside IP department, outside counsel, ...)? Base: 104 (Q23); 75 (Q24)

# Induction training and training sessions are the most common ways to ensure basic IP knowledge and awareness

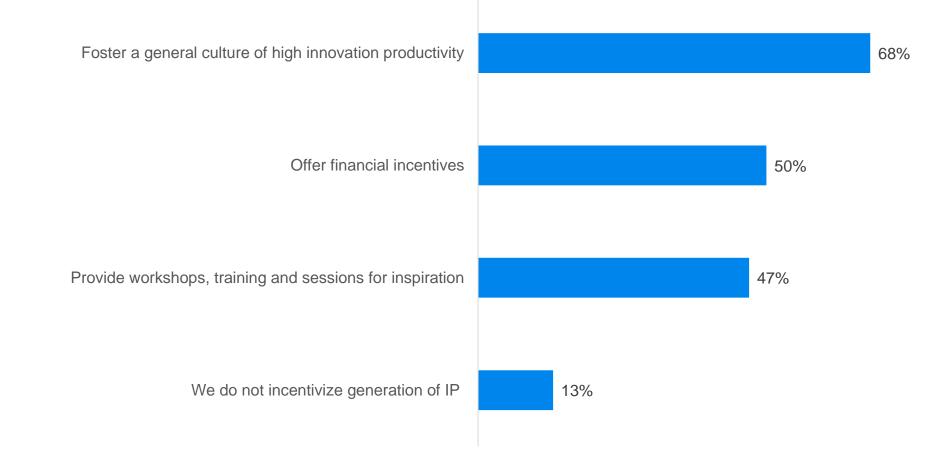




Q21 How does your company ensure basic IP knowledge and awareness in its R&D and product development teams?

Base: 104

Most companies foster a culture of high innovative productivity to incentivize IP generation, although half offer financial incentives and some provide workshops and training for inspiration

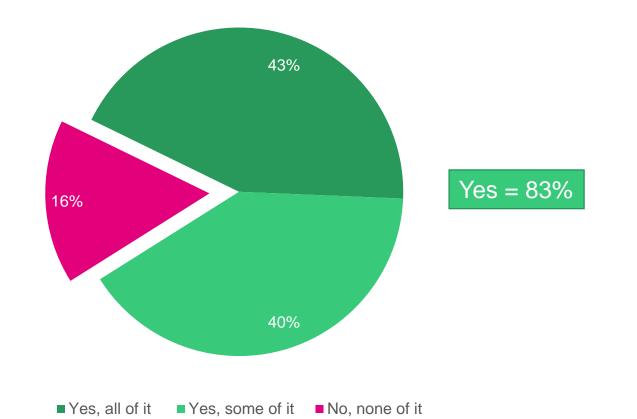


Q22 How does your company incentivize the generation of IP?

50

# The majority of respondents say they currently outsource at least some of their IP requirements to a law firm





Q2 Do you currently outsource any of your IP requirements to a law firm?

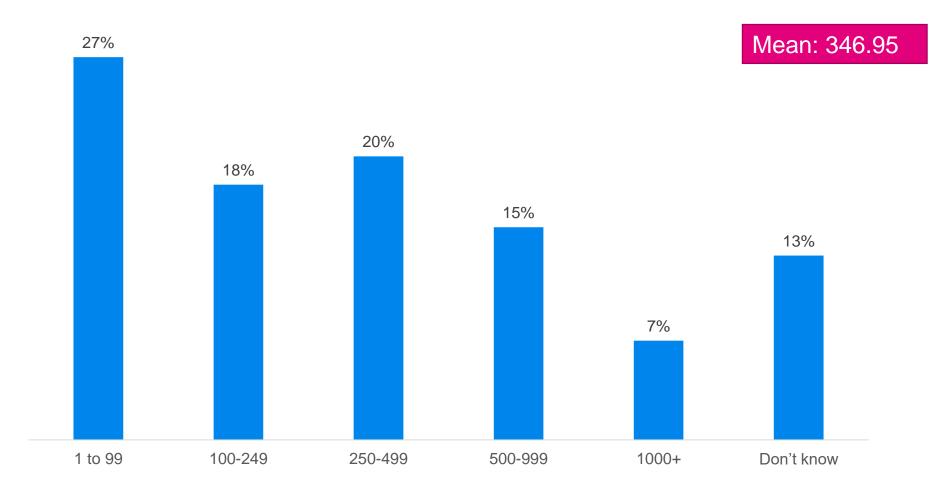
# Dedicated in-house roles are the most common way of coping with IP registrations in different countries





On average, IP protection applications would have to be at around 347 per year for a company to start using inhouse lawyers rather than a legal firm

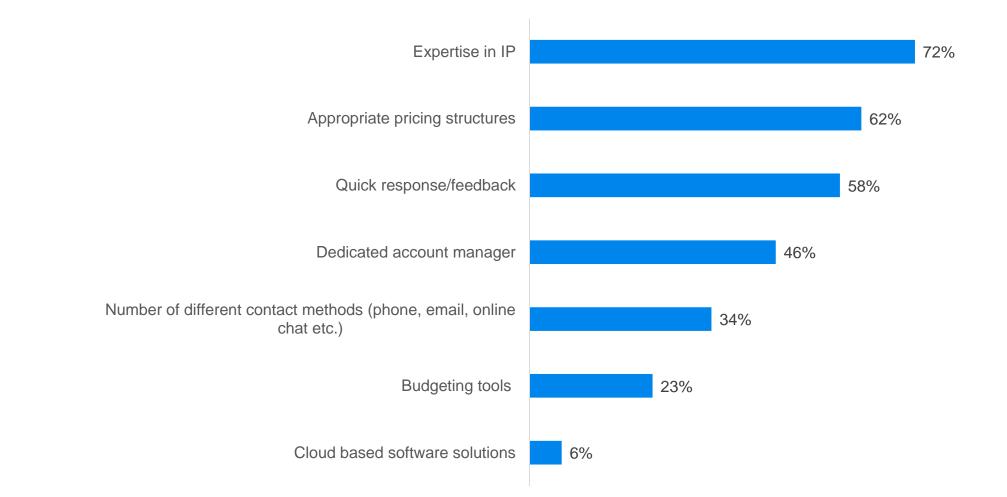




Q25 At what level of IP protection applications filed per year would your company start to use in-house lawyers, rather than a Base: 104 legal firm's expertise?

Expertise in IP is of course a key expectation of a firm that companies outsource IP work to. Pricing and responsive feedback are also in the top three expectations

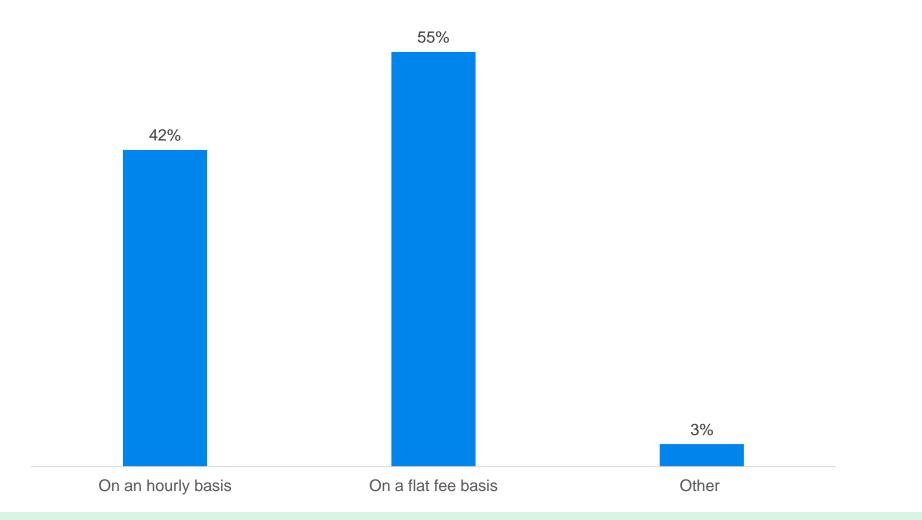




Q26 What are your expectations of a firm that you are outsourcing IP work to?

### A flat fee basis is used by over half





Q27 How do you pay legal firms you outsource IP work to?

## The Legal 500's IP Forum "Creating Profitable IP Strategies" Panellists Session 2









Dr. André Körtgen **THALES** Deutschland

Vice President Legal & Contracts



#### **Thomas Bereuter**

**European Patent Office** 

Program Area Manager, European Patent Academy

The Legal 500's IP Forum "Creating Profitable IP Strategies" SESSION 2: What to do with patents?



#### 3. Own patents

#### • Own use

Is patent coverage reviewed along the way?

#### Portfolio Management

Macro management - Considerations and strategies (Should 80 % of the patent portfolio cover 20 % of the profit?) Micro management - Comparison, evaluation (Should five patents on a technology be maintained, if three of them are weak?) The Legal 500's IP Forum "Creating Profitable IP Strategies" SESSION 2: What to do with patents?



#### 4. Competitors' patents

#### Infringement watch

Organisation (sales force knows the market, patent people know the patents), documentation, strategies (aggressive vs. non-aggressive, licensing considerations)

#### Handling of IP conflicts

Licensing-in, attacking third party patents or avoid "waking up sleeping dogs"?

#### Inspiration

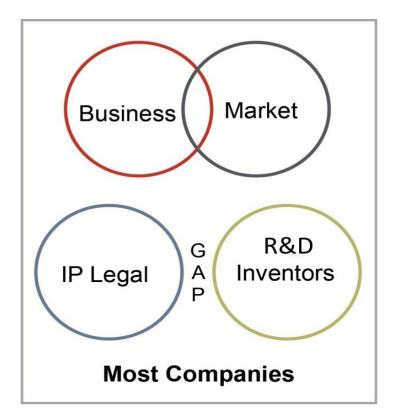
Feed-back to own R & D - How is this organized? Is this a "by chance" result or the result of a planned process?

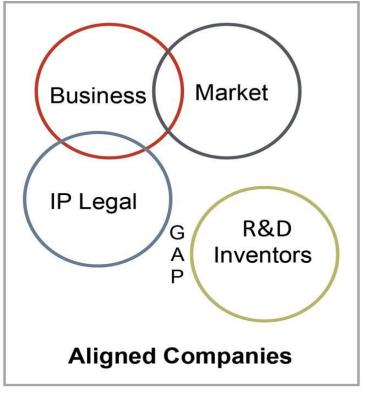
## The EPO SME case studies

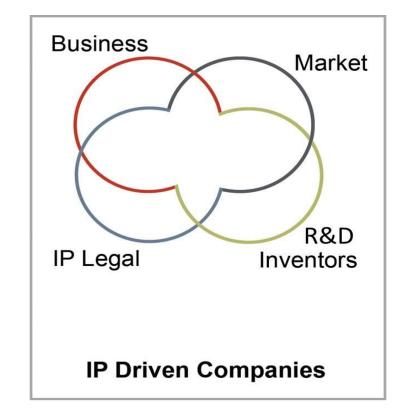




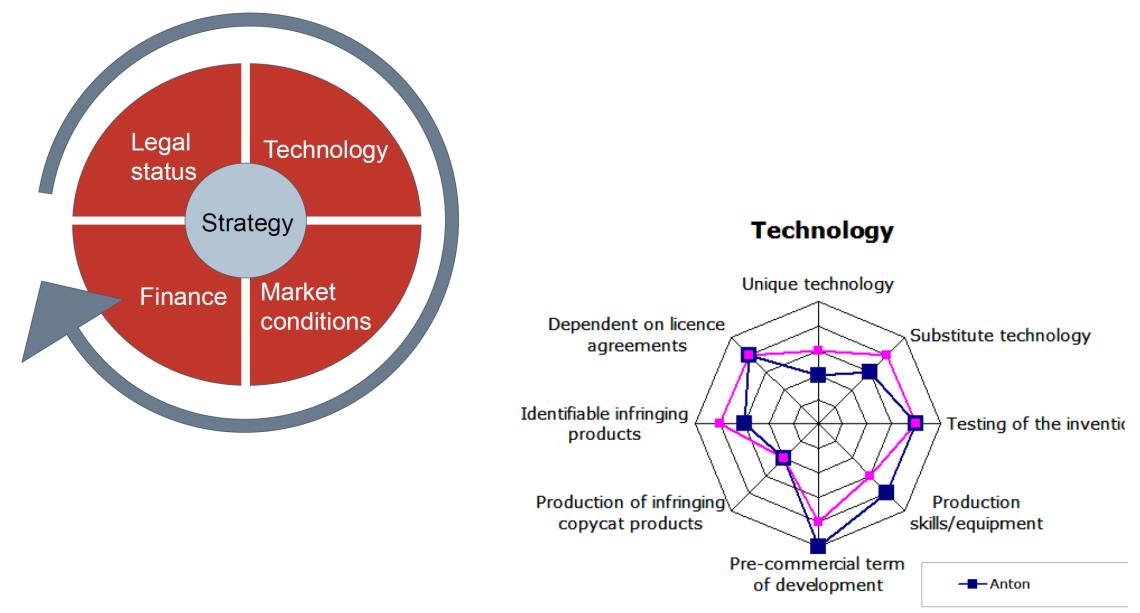
# The Right IP Strategy - Who



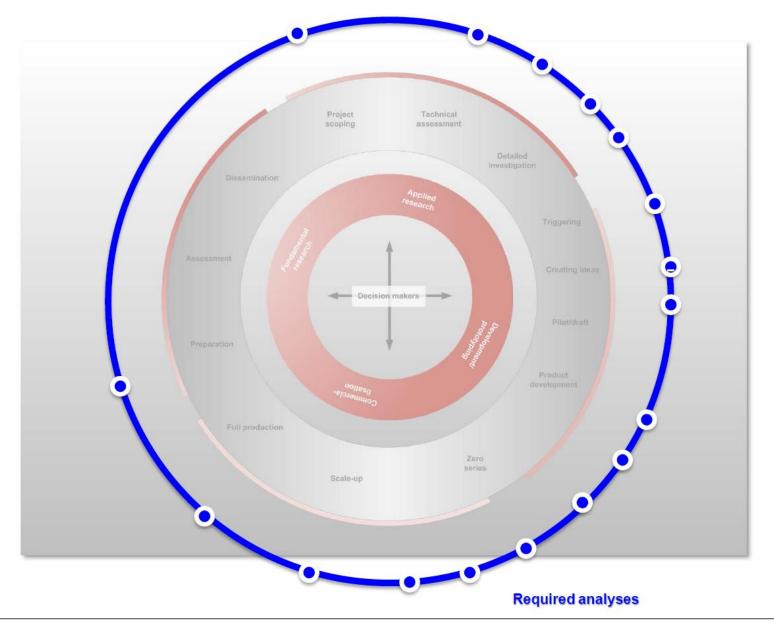




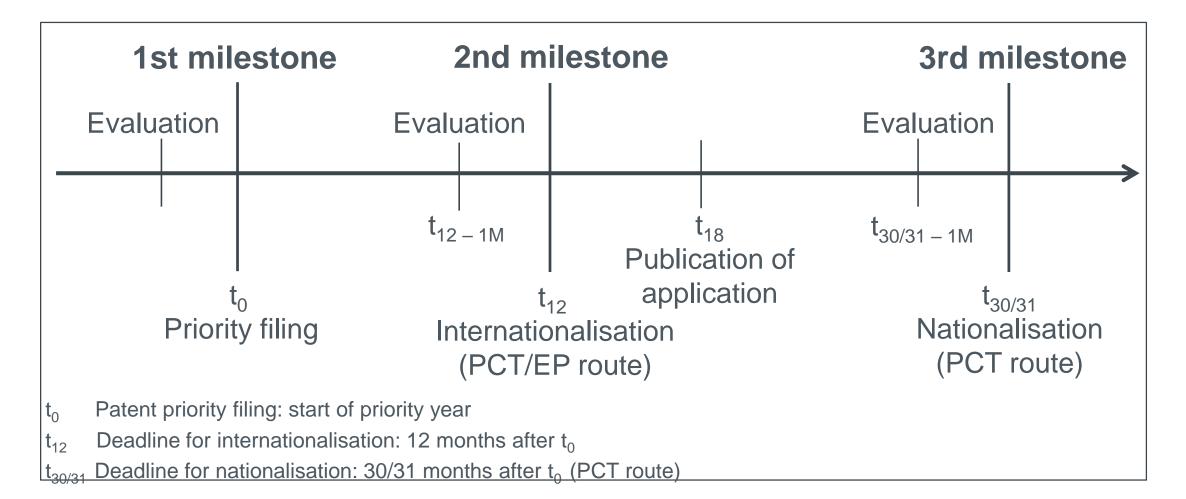
#### **Evaluation topics**



## The product development process



# **IP** evaluation process





#### https://www.qualcomm.com/invention/groniclesofinvention/index.html

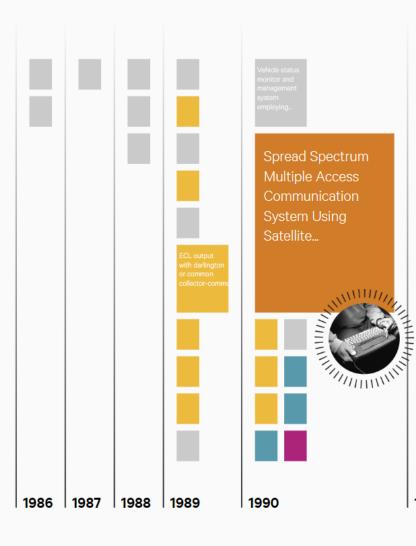




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suit of the next great idea, this ir ousands of Qualcomm's inventior y of the past, present, and future

#### CELLULAR

USPTO I

INVENTO

DATE

Spread Spectrum Multiple Access Communication System Using Satellite or **Terrestrial Repeaters** 

<b>b</b>	4901307
	2/13/1990
RS	Klein S. Gilhousen Irwin M. Jacobs Lindsay A. Weaver Jr.

#### **Global Reach**

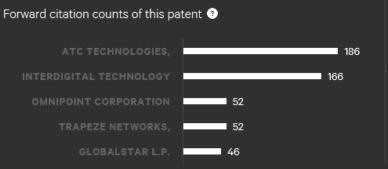
Countries where this patent is protected





#### **Citation Information**

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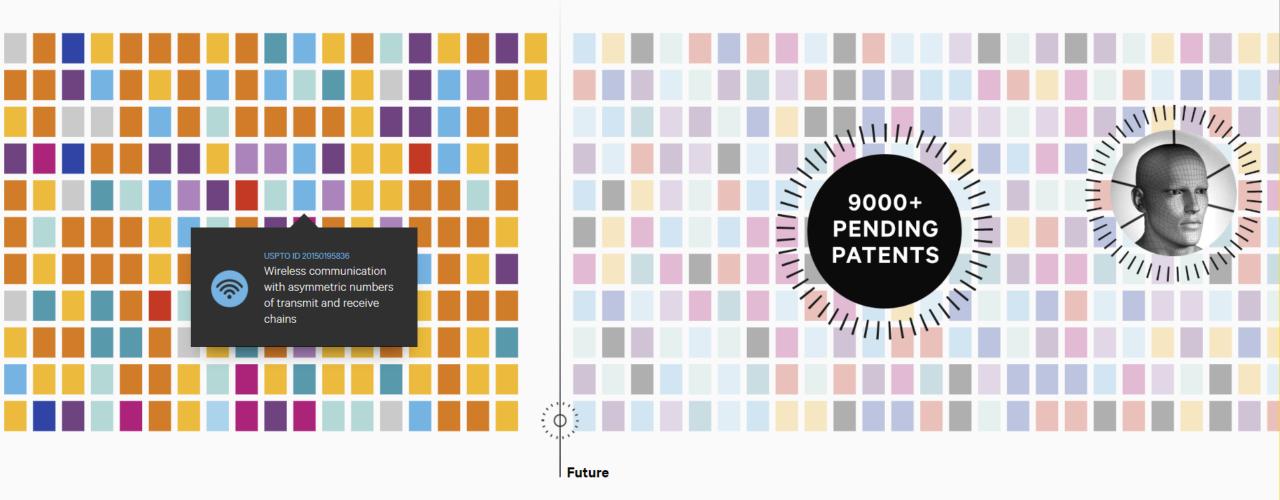




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