

International Patents Group

*Filing, prosecution and counselling*



EVERSHEDS

*Your inventions can be your most valuable assets. However, protecting them cost-effectively in all the jurisdictions where you do business can be a real challenge. The procedure for obtaining a patent, the requirements of patentability, and the extent of the exclusive rights bestowed by a patent differ from country to country. Also, the protection available for trade secrets and confidential know-how varies widely. This means that development of a patent portfolio requires careful assessment and skilful implementation*

Put your inventions in the hands of our expert patent attorneys. Our International Patent Services team is experienced in advising clients on identifying valuable inventions and protecting them appropriately as trade secrets or by obtaining patent protection. Our patent attorneys are based in Munich, close to the European Patent Office. They handle patent prosecution before the European Patent Office and national patent offices on a daily basis. Driven by our own commitment to excellence in the delivery of portfolio development and management services, we have developed an innovative model that can significantly reduce the costs of your patent portfolio and gives you complete transparency over the status of the portfolio.

## Filing, prosecution and counselling services

Our patent attorneys are based in our Munich office, close to the European Patent Office and the Deutsches Patent- und Markenamt. They focus on:

- providing strategic advice on protection of inventions, portfolio development and maintenance;
- filing and prosecution of patent and utility model applications at the European Patent Office and national patent offices in Europe; obtaining supplementary protection certificates for pharmaceuticals and plant protection products;
- conducting opposition proceedings at the European Patent Office and other national patent offices in Europe;
- IP portfolio management (including acting as an in-house patent department);
- carrying out patent research, patent landscaping and monitoring of third party rights;
- advising on employee inventions;
- providing pre-action opinions on validity and freedom to operate;
- conducting invalidity proceedings.



## Our other patent services

Our patent attorneys are part of our wider International Patents Group, which provides the full range of patent-related services. In particular, we have experienced lawyers across Europe who specialize in:

- resolving technology disputes involving patents, utility models and trade secrets;
- commercial exploitation of your inventions through licensing and other ventures.

Led from our offices in London and Munich, the two key jurisdictions in Europe for patent litigation, we work with our local offices in other jurisdictions across Europe and best friend firms in order to deliver a complete solution for you. If you need to stop unlawful use

of your inventions, we will help you to develop an enforcement strategy to meet your commercial aims. Where necessary, we are fierce litigators, skilfully using the court procedures available in the various specialist patents courts across Europe to achieve your aims. However, our enforcement strategies also make full use of alternative dispute resolution, customs seizures, criminal proceedings and preliminary injunctions to maximize cost-effectiveness. We are also experienced in helping you to resist unjustified allegations of infringement, with substantial experience of opposition proceedings, challenges to validity and antitrust defences.

## We understand you

Our patent attorneys are educated in a wide range of technical fields up to Ph.D. level. Our clients come from various sectors, although we have an in-depth understanding of the telecoms, pharmaceutical, bio-science, consumer electronics, and automotive sectors.



*"The Chief Patent Counsel of a US-based multinational with multiple R&D facilities across the US and the rest of the world was under pressure to reduce the costs of its international patent portfolio. He was also frustrated by his lack of visibility and control over patent prosecution by his external patent counsel. Our International Patent Services team developed an innovative model to rationalize patent prosecution internationally for this US-multinational, dramatically reducing costs and improving visibility over the status of the portfolio without disrupting its relationships with its key external patent counsel. Key features of the model are:*

- *drafting and filing of the first patent application for an invention by the client's existing external patent counsel, who will be in close contact with the relevant R&D facility;*
- *handling and co-ordination of all subsequent international PCT filings by our International Patent Services Group using the European Patent Office (EPO);*
- *using the network of selected foreign associates which we have developed (subject to approval by the client) to deal with the later national phase;*
- *provision of an extranet which allows the client online access to the patent files. We have negotiated discounts and fixed fees with these foreign associates.*

**The advantages of this model are:**

- *significant cost savings from rationalizing the handling of the client's non-US filings in this way. Reduced administration costs, together with the fixed fees and discounts, which our foreign associates offer as part of this model led to a reduction in portfolio cost of 30%;*
- *increased visibility for the client over the status of its portfolio by centralizing all information about the non-US filings in a single extranet;*
- *increased predictability and control over future costs, as much of the work is carried out on a fixed-fee basis;*
- *more effective early searching for prior art, since both the USPTO and EPO will carry out independent international searches on each case. This allows us to judge reliably, at an early stage, the chances of successful patenting, and helps the client to make further cost savings by taking prompt decisions on claims amendments or abandonments;*
- *a single point of contact within our International Patents team for the client for all its non-US patent issues.*

## Our approach

At the heart of Eversheds' service is the principle of accountable relationships. That means looking after your interests as if they were our own. We want you to view us as a trusted adviser. We will spend time getting to know you and what you want to achieve, and will then use all the necessary resources to help you achieve it.

Moreover, our innovative model for handling international patent cases (see the case study) offers cost savings and improved control over your portfolio of foreign patents, regardless of the country in which you are based.



To find out more, please get in touch  
with your usual contacts or contact



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