



Start-up, chercheurs : comment protéger au mieux mon innovation ?

Energypolis Sion

Rencontre de l'incubateur



- Electrical Engineer (EPFL)
- Swiss and European Patent Attorney
- Technical Judge at the Swiss Federal Patent Court
- Director and founder of P&TS

Patent Law Firm

Based in Neuchâtel and
Zurich

26 employees

www.patentattorneys.ch

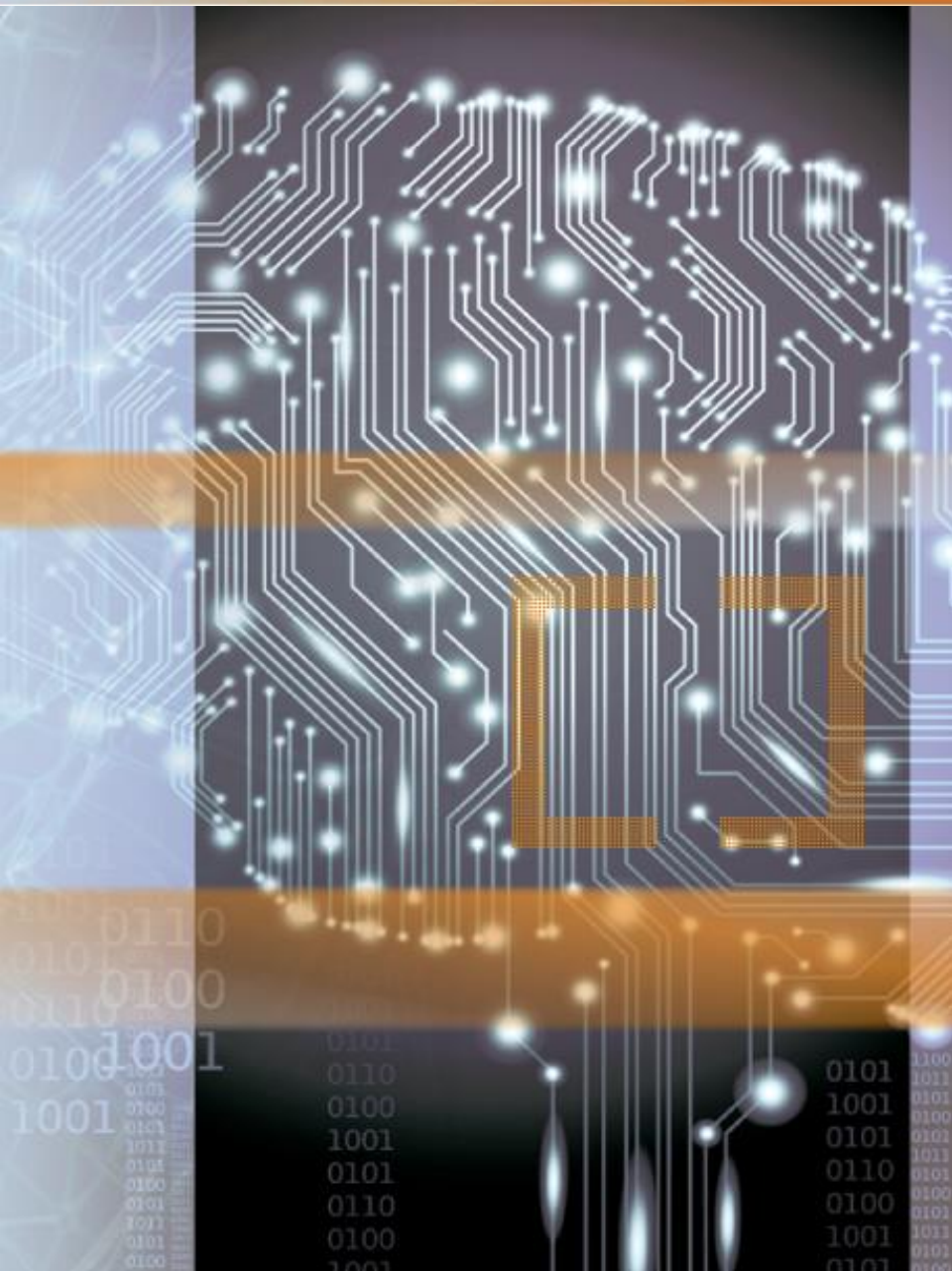


Swiss Patent Law Firm of the year in 2014, 2015 and 2016



Traditional purpose of patents:

To protect your innovative market from competition



Start-ups usually don't have any significant market worth a protection

Why should they care about IP?



Investors



IP Ownership



Marketing



Licensing



«We don't invest in people – they can leave at any time

We don't invest in previous sales either – most of our early stage companies don't have any significant

The only things that really matters are IP, IP and IP, because it is a promise of higher margins»

(Statement from a VC)

Non-patenting start-ups receive an average funding of 374'000 CHF

Patenting start-ups receive 954'000 CHF on average

investments

A hand holding a blue pen, drawing a white arrow that curves upwards from the word 'investments'. The arrow starts as a horizontal line and then curves sharply upwards and to the right, ending in a white arrowhead. The background is a dark, blurred image of a person in a suit.

Source: Swiss Start-up monitor, based on 164 Swiss startups.

Who owns the inventions?



In Switzerland, inventions made by employees belong to the employer.

However, inventions used by start-ups often have external contributors who are not employees:

- Invention made by the founders before the incorporation
- Academic partner, for example in a CTI project
- PhD, students, ..
- Freelancers

Patents clarify the IP ownership situation



Filing a patent application is a strong statement:

«We are an innovative company»

- For your investors
- For the media
- For your employees
- For your environment



Many start-ups can't fully exploit their inventions:

- Geographic limitations
- Use of a technology in a different field
- Integration of the technology in a complete product

Patents could be licensed in order to get revenues from those hard to reach markets

Over the last 15 years,
we have studied the IP
strategies of more than
500 start-ups in
Switzerland

All kind of technologies, all
types of start-ups.

We observed many
successes and many
failures



Our observations have shown that successful start-ups more often:

1. Match the IP strategy with the overall strategy
2. Understand the requirement of the investors in terms of IP
3. Combine various forms of IP protections
4. Clarify IP ownership issues
5. Perform FTO to reduce risks of patent infringement
6. Follow creative patent filing strategies, such as « guerilla patenting »

Your IP strategy should match your overall business strategy

No « one size fits all »

Too much patents is a waste. Not enough is useless

Understand the needs of your investors in term of IP.

(After all, they will pay the invoices..)

Don't think of patents as awards for scientific breakthroughs. Rather, they are weapons to protect your USPs.

Try to have clearly drafted patents that you can also pitch to your investors and explain in your business plan

Combining various forms of IP protection

Patents

Designs

Trademarks

Copyright

Trade
secret



Trademarks:

- Very low value at the beginning
- Raises with time
- Even for high tech companies, the value of trademarks eventually often exceed the value of patents



Some criteria to choose a trademark

- Non descriptive.
- No confusion with existing trademarks
- Emotional, easy to remember

Clarifying IP ownership issues:

- Negotiating with TTOs
- Assignment of inventions from the founders to the company
- Development contracts with externals



- Monitoring the patents filed by the competitors
- Focusing on the real risks
- Risk mitigation strategy
- Use public sources like www.espacenet.com, and then specialists

« Guerilla patent filing »

- Cost of a Swiss patent: about 5'000 CHF
- Cost of an EP + US patent; about 50'000 CHF
- Sometime, it is most effective to file 10 national patents (in Switzerland, Germany, France, ..) rather than to patent a single invention in EP +US

« Guerilla patent filing » - 2

- If the budget is tight, consider to start with a provisional patent application.
- After 12 months, file a PCT application in order to delay the costs for interational protection

Thank you!