



DEFENSIVE PUBLICATION IN FRANCE

A SURVEY ON THE USAGE OF THE IP STRATEGY DEFENSIVE PUBLICATION

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I - INTRODUCTION

What is defensive publication?

Defensive publication is the purposeful publication of an innovation, creating prior art to block future patents on the same concept.

Defensive publication is not a new strategy; it has been used by major organisations in conjunction with patent filings to protect Intellectual Property (IP) portfolios since the 1960s. A study in Germany in 2008 concluded that more than two thirds of the respondents had already implemented a defensive publication strategy¹.

The same study concluded that defensive publication is likely to be increasingly adopted by companies in the coming years.

Today, the risk of being involved in patent infringement litigation is growing. Firstly, increasing filing rates have naturally lead to a greater chance that any innovations left unsecured will, sooner rather than later, be patented by a third party. Secondly, patent owners are more likely to identify infringements and bring litigation action.

Until recently when infringement actions were brought, the typical defence has been to counter sue. The emergence of Non Practising Entities (NPEs, aka Patent Trolls), large scale patent ownership transfers and a leap in patent analysis software standards has changed this. Counter suing is therefore often no longer an effective defence.

“Patent troll is a pejorative term used for a person or company who enforces patents against one or more alleged infringers in a manner considered aggressive or opportunistic with no intention to manufacture or market the patented invention.”²

In this climate, guarding freedom to operate is key. Seeking patent protection on every single innovation is one solution. However, the specialist staff costs required for drafting, negotiating grants and enforcement are significant. Many innovations, while useful, simply do not warrant the investment.

Defensive publication, used in conjunction with patent protection, can provide a cost-effective method for securing freedom to operate and reducing litigation risk.

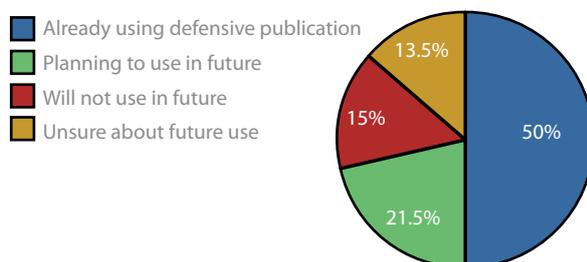
Defensive publication strategy is based on the following principle: when the estimated value of exclusive rights divided by the estimated chance of patent grant exceeds estimated costs, patent. When it does not, publish.

This study

This study sought to provide an insight into the current and future usage of defensive publication in France. It draws upon the results of a survey that was conducted throughout July and August 2012. Thirty major French companies were interviewed, largely from the chemical and manufacturing sectors. The interviews were targeted at patent engineers, IP managers and in-house patent attorneys.

The results (figure 1) show that 50% of the companies interviewed have already integrated defensive publication into their IP strategy. Of those who had not, 43% (representing 21.5% of the complete data set) are considering doing so in future.

Figure 1. Current and future use of defensive publication amongst interviewees



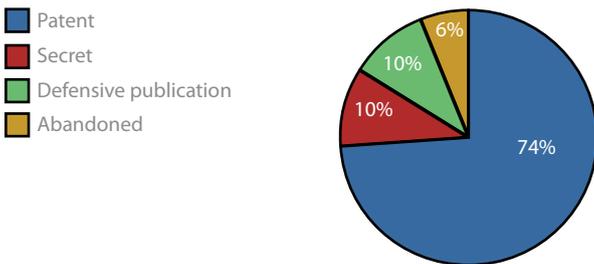
¹ “Defensive publishing: An empirical Study” Joachim Henkel and Stefani Pangerl – May 2008. <http://www3.druid.dk/wp/20080004.pdf>

² Alexander Poltorak. “On Patent Trolls and Injunctive Relief”, ipfrontline.com, May 12, 2006

II – WHEN DO COMPANIES CHOOSE PUBLICATION?

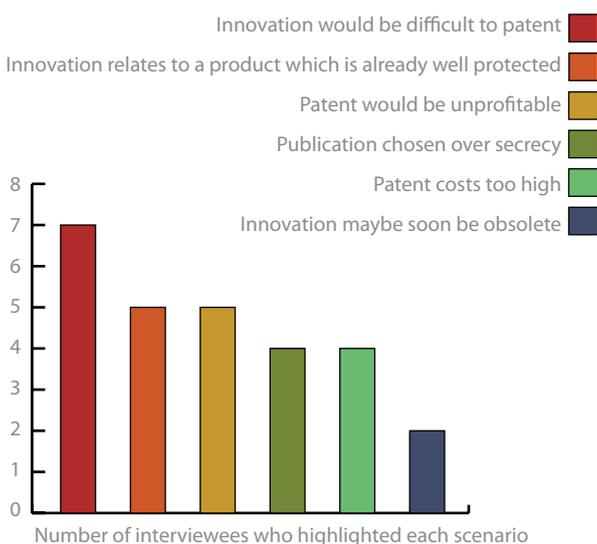
Amongst the interviewed companies who had already implemented a defensive publication strategy, most innovations were still patented (figure 2). However interviewees identified that an average of 60% of their patents are of low profitability.

Figure 2. Destination of inventions in the interviewed companies already using defensive publication strategy



With retrospect it is often clear which innovations justified the patent expenditure and which could have been published. Identifying this in advance is more challenging. The interviewed companies identified several scenarios in which they recognised defensive publication as particularly appropriate (figure 3).

Figure 3. Scenarios in which interviewees found defensive publication particularly appropriate



The four most commonly cited strategies are explained below.

- ***The innovation would be difficult to patent***
This tends to be the case when there is close prior art, obviousness concerns or when the innovation fits within a technology area of questionably patentability e.g. business methods, processes etc.
- ***The innovation relates to a product which is already well protected***
Often because of unique manufacturing ability or existing patent rights already secure the market.

“Is it worth the trouble to add an additional protection to 11 patents that we already have on our product?”³

- ***Patent would be unprofitable***
The combination of fees and specialist staff costs or external council budget are likely to exceed the expected value of exclusive rights.
- ***Publication chosen over secrecy***
In situations when patent protection is not viable and but the risk of losing freedom to operate is to high to rely on secrecy.

As well as the scenarios detailed above, several interviewees highlighted the role of defensive publication in wider strategies, such as:

Inventor reward schemes

Interviewees reported using non-anonymous defensive publications as a method to reward inventors who had submitted useful innovations that did not warrant patent expenditure.

Anticipating the official patent publication

An emerging strategy where a defensive publication is used in combination with a patent application. A defensive publication exposing the same innovation is made shortly after the filing date creating prior art which can block other filing on the grounds of obviousness as well as novelty (unpublished patent applications only block subsequent third party applications on the grounds of novelty).

³ “Defensive publishing: An empirical Study” Joachim Henkel and Stefani Pangerl – May 2008. <http://www3.druid.dk/wp/20080004.pdf>

III - WHERE DO COMPANIES CHOSE TO PUBLISH?

In theory a defensive publication can be made in any publicly available location. However in practice the method of publication will make a great difference to its effect. Figure 4 below compares the advantages of different publication methods identified in the survey.

The survey asked the interviewees which factors determine their choice of publication method. The factors are listed below in order of importance as selected by the interviewees:

- 1 - Cost (fees and staff costs)
- 2 - Speed
- 3 - Accessibility to patent examiners
- 4 - The option of anonymous publication
- 5 - Reliability in courts

The benefits of cost, speed and the ability to rely on a publication in court are clear. Further details follow on the importance of accessibility to examiners and the option of anonymous publication.

Accessibility to patent examiners

Why is this important?

Defensive publications can be used to block subsequent patents at two points:

- 1 - By examiners during their initial examination
- 2 - Through opposition or invalidity proceedings

There are numerous examples of both options proving successful, but clearly the second option is significantly more expensive and time consuming.

See the appendix for a practical example.

Patent examiners only have limited time to perform each prior art search. Unless a defensive publication is published in a location which examiners regularly search the chance of it being identified at this first low cost stage is low.

Figure 4. Relative strengths of the publication methods identified by the interviewees

Characteristics	Publication methods				
	Commercial defensive publication services	Conference presentations	Industry journals	Abandoned patent apps.	Internet sites
Fees	Low	Low	Low	Low	Low
Required staff time	Low	Medium	High	Medium	Low
Speed of publication	Fast	Slow	Slow	Slow	Fast
Reliability in court	Strong	Medium	Strong	Strong	Weak
Anonymous option	Yes	No	No	No	No
Accessibility to examiners	Strong	Weak	Weak	Strong	Medium
Inc. in PCT Minimum Documentation List	Some ⁴	No	Some	Yes	No

⁴ Research Disclosure service is the only commercial defensive publication service included in the PCT Minimum Documentation List <http://www.researchdisclosure.com>

How to judge whether a publication location is being searched by patent examiners?

The PCT Minimum Documentation List⁵ is a good starting point. This document covers the non-patent literature which the International Search Authorities (ISAs) are required to search as a minimum.

See appendix for citation analysis of Research Disclosure⁶.

Another effective approach is to identify whether the chosen publication has been frequently cited in examiner search reports. If the citation rate for the publication is high (number of examiner citations / total number of records) it is clear that it is being regularly searched by examiners.

Anonymous publication

Commercial defensive publication services often provide the option to publish anonymously.

Under most circumstances this is preferable: it creates the same patent blocking prior art whilst making it is considerably harder for competition to identify the publication.

Anonymous publication is proving increasing popular. For example in 2012 (January – August) 67% of the defensive publications included in Research Disclosure⁶ were published anonymously, up from 50% in 2011.

IV - CONCLUSION

The IP landscape is changing dramatically, with large scale patent ownership transfers, the emergence of NPEs and a leap in patent analysis capabilities. In this climate, maintaining freedom to operate is key and yet mass patenting is becoming an increasingly less attractive solution.

This study has indicated that industry is increasingly recognising the role that defensive publication can play in reducing litigation risk, driving down costs, and securing freedom to operate. Of those companies interviewed who have already implemented a defensive publication strategy, 53% expected to see an increase in usage, none expected a decrease. Amongst those not already using defensive publication, 43% are considering doing so in future.

⁵ PCT Documentation Minimum Documentation List <http://www.wipo.int/standards/en/pdf/04-02-01.pdf>

⁶ Research Disclosure defensive publication service <http://www.researchdisclosure.com>

V - APPENDIX

Legal basis

Patent protection is only available for innovations which are novel and non-obvious.

Defensive publication is the purposeful publication of an innovation, creating prior art to block future patents on the same concept.

Novelty and non-obviousness are judged against the prior art i.e. all literature which was available to the public before the given patent application's priority date.

A single defensive publication limits global patentability of a concept by expanding the body of prior art against which the patent application must be judged for novelty and non-obviousness.

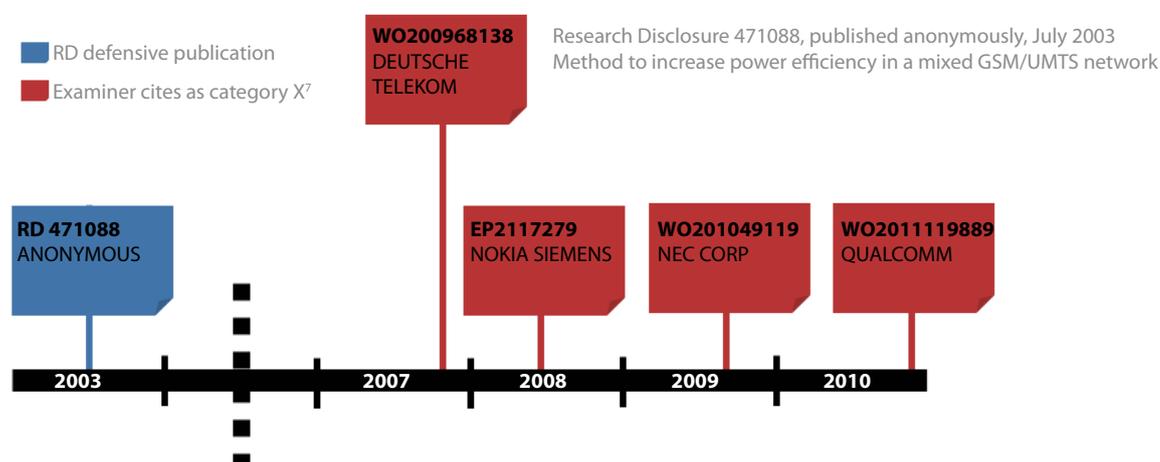
Defensive publication in practice

Below is an example of a defensive publication being used by patent examiners to block / restrict subsequent patent applications. This innovation was published in July 2003 via the Research Disclosure defensive publication service⁷. It has since been cited by examiners against 10 patent applications of which 4 were prior art category X⁸.

Research Disclosure citation analysis

More than 13% of Research Disclosure publications have been cited by a patent examiner against at least one patent.

Figure 6. Illustration of a defensive publication being used by patent examiners to block / restrict subsequent patent applications



⁷Research Disclosure defensive publication service <http://www.researchdisclosure.com>

⁸Category X; document that, taken alone, anticipates the claimed invention, as a result of which the claimed invention cannot be considered novel or cannot be considered to involve an inventive step