

Patent Application

The Road from an Invention Disclosure to a Patent

If you have made an invention, you have to report it to the Technology Transfer Office as the department dealing with inventions (see *Invention Disclosure*). Technology Transfer will evaluate the invention based on patent law and commercial criteria (see *Patent Searching, Evaluation of Inventions*). On the basis of this evaluation, the DKFZ will decide whether it will claim the invention or release it to the inventors.

Filing a Patent Application

If the DKFZ has claimed an invention, a patent application will usually be filed. The patent application will be drafted by an external patent attorney. You will be requested to contribute to this process by providing the attorney with your results and your expertise. The attorney will file the patent application in the name of the DKFZ, as a rule, with the European Patent Office (EPO) to start with. The costs are borne by the DKFZ.

Patent Granting Procedure

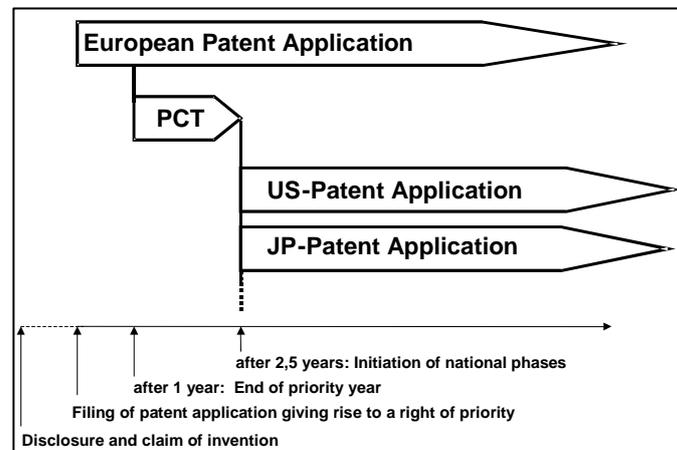
After a patent application has been filed, the patent office will examine the prior art and then review the invention using specific criteria (novelty, inventiveness, susceptibility to industrial application, clarity, feasibility and sufficient disclosure) to determine its patentability. A patent will eventually be granted only to the extent to which these criteria are fulfilled.

Following the first filing with the EPO, the DKFZ will usually also file an international (PCT) application and national applications resulting from it, such as in the US or Japan.

Decision on Patent Maintenance

Since patent application and maintenance are expensive, there are regular reviews to determine whether it still makes sense to carry on with these. Important cost-relevant milestones of a patent granting procedure are twelve and 30 months after filing:

For a period of up to twelve months after a first filing that has given rise to a right of priority (usually a European filing) it is possible to supply further unpublished data and to file patent applications for the same invention in other countries. Since the value of an invention is frequently still unclear after one year, it is possible to delay this decision by 18 months by filing an international patent application under PCT (PCT filing).



Prior to both milestones you will be contacted by the Technology Transfer Office. Key criteria for deciding on how to proceed further include office actions, whether or not the inventors are still DKFZ employees, how further development is proceeding, the resonance produced by marketing activities, whether or not a licensee has been found, whether there is a ‘freedom to operate’, how much the expected costs are and whether the invention has unity. If maintenance does not seem to make sense, the patent applications are released to the inventors. The inventors can subsequently seek continuation at their own expense.

Frequently Asked Questions

Why is the first year after filing a patent application so important for a patented invention?

In the first twelve months before an international (PCT) patent application is filed, it is possible to make additions and changes to the patent application. During this time, new results supporting the invention can still be inserted into the patent application. Therefore, it is important to coordinate with Technology Transfer all publications about the invention during this first year.

To what extent is patenting of software possible in Europe?

In its examination practice, the European Patent Office distinguishes between software “as such”, for which it is not possible to obtain patent protection, and software of a “technical character”. A software has a technical character if

- the software itself solves a technical problem (such as control and regulation systems) *or*
- execution of the software produces an *additional* technical effect. However, physical changes to the hardware as occurring during any software execution are not sufficient.