

My Company is in Brazil. How Do I Manage Patenting Worldwide?

This Patent Stuff and My Semiconductor Business – Part 20

Welcome to this post about patents and chips. Not a lot has been written about this combination, but there is a lot to know, especially for the innovators and entrepreneurs themselves. In this three-weekly series, I talk about various aspects, from my dual points of view of a patent agent and a semiconductor entrepreneur. If you like the article and read it on LinkedIn, give it a thumbs up, and/or click on Follow. If you like to work with us for your next patent, "contact us" info is on www.icswpatent.com. You can also subscribe/unsubscribe for short email alerts when the next post is available.

Brazil, it could be any country of course, but Brazil is a great example. I love its people, its creativity, and its spirit. Brazil itself would not be a prime target for chip patents by companies from abroad. Nevertheless, chip designers in Brazil (yes, there are good and very experienced ones!) have a need to protect their inventions in strategic countries abroad. Their national patent scene may not offer all services they need. Patent lawyers do not need to be engineers or scientists, and they rely on technical writers to write technical patent applications ("I have a really good guy to work with you. He may be a mechanics engineer!"). With a relatively small volume of chip patents in the country, there really aren't any technical writers supporting the lawyers with knowledge about semiconductors, chip architectures, or mixed-signal electronics. Very few know anything about wireless communication.

Of course, this situation exists in more countries that have only a couple of relevant participants in the semiconductor industry. They face a double challenge: how to get a high-quality application that is not full of holes, and once you have one, how to defend it in the countries abroad where you file it?

Without local support, you have two options. One is to work with a local IP lawyer (Brazil has many excellent lawyers) to find the right partner or associate abroad. The other is to directly find a patent firm abroad that is specialized in the subject matter. My firm is one, and I know others that are both competent and enthusiastic. I will also involve my Brazilian associate when needed. Typically, patent firms have a global network of associates who are active in the same markets. When you defend a patent application in multiple countries, examiners may come up with the same or similar objections and rejections, and your responses must be knowledgeable, coordinated and consistent. It is not enough to just send the original application document to a bunch of capable folks worldwide – you need one party to manage the responses, and all parties to ensure that the applications, their claims, and responses to local patent offices meet the local requirements.

With this in mind, your course of action is as follows.

- Find a patent firm in a country where you are certain you will have to file patents. If the most important jurisdiction to file is the US, then (of course) drop me a line. If your home country is the most important place to file, then let your local law firm decide if they want to work with me or with somebody else.
- Make sure the firm understands your technology and can communicate with your inventors. It helps if their practitioner(s) visit your country once or twice per year, so that you and some of your inventors can develop a personal relationship.
- Define your IP protection strategy. A good patent practitioner can help. You may also read my earlier posts about developing an IP protection strategy for your semiconductor company (TPS02 and TPS03), which help you to create a priority list of countries. Talk the strategy through with your practitioner.
- When an invention comes along, ask the practitioner to make a cost estimate for the selected countries. The costs add up fast when you're dealing with multiple countries, and it is easy to get surprised. You need to know roughly when to have which budgets available.
- Talk with your practitioner about the Patent Prosecution Highway (PPH) and if faster prosecution in the first country could help you save costs in the other countries.
- Once ready to start, let the practitioner lead in working with your inventors to get the innovation in a proper application. Make sure the inventors read through and understand the drafts.
- Make your inventors sign the appropriate documents while they are still in your employment. Since employees move along from time to time, you should have the declarations and assignments signed early to prevent possible hiccups later.
- Let the practitioner lead the international process. There may be a lag of close to a year between the initial work and the start of activities in further countries. The practitioner can manage this and he or she will work it out with the right associates globally. Once examination results come in, the work gets interesting. In some cases your practitioner can handle responses alone. In other cases, your practitioner will want to check with you if a response is technically correct, and if it addresses your highest priorities.

Always remember that your practitioner, wherever he or she is in the world, must understand both your technology, your innovations, and your business objectives. Then you can get first-class service.

Upcoming:

21. Why Are Patent Claims So Weird, Anyway?
22. They Don't Understand My Invention!!
23. Do I Really Need to Spend So Much Time to Get the Patent?
23. Can I check if my patent guy/gal is doing a good job? (How Do You Know If Your Patent Practitioner is Doing Your Invention Justice?)
24. I Can't Wait for the Patent Office for 3 Years, Can I?

Published so far (find the articles on www.icswpatent.com or #ThisPatentStuff):

1. So You Got This Great Idea That Will Wipe Out Competition. Now What?
2. Developing an IP Protection Strategy for Your Semiconductor Company – PART I
3. Developing an IP Protection Strategy for Your Semiconductor Company – PART II
4. In What Countries Should I Patent, Anyway?
5. Choosing the Right Patent Person for Your Inventions
6. How is a Chip or Firmware Patent Different than Other Patents? What About a Software Patent?
7. Woohoo! I Invented a Huge Improvement over My Competitor's Invention!
8. I'll Be A Billionaire Soon Enough. But Now I'll Just Buy This Book on Patent Writing on thriftbooks.com.
9. My CTO Can't Explain His Invention to Me. But He Is the Smartest Guy in the World.
10. Should I Do a Provisional, Non-Provisional, Or a PCT?
11. What Makes an Inventor, and How Can I Stimulate Innovation?
12. My Invention is Vital for My Business Plan. But I Don't Have Much Money Yet. How Can I Save?
13. I Want to Protect It Now, But Am Still Working Out Architecture Details. Can I Add Those Later?
14. I Want to Use an FPGA Before an ASIC. Can It Be One Patent?
15. How Do I Know If My Invention Is Patentable?
16. How Do I Screen My Employee's Invention Before Deciding on a Patent?
17. A Prior Art Search Before Filing the Application
18. Should I Pay Extra to Get the Patent Faster?
19. How Many of Those Patent Office Actions Should I Budget For?
20. My Company is in Brazil. How Do I Manage Patenting Worldwide?

Disclaimer

Please do not construe anything in this article as legal advice: it isn't. The article contains my private opinions, with where possible the point of view of a semiconductor industry entrepreneur and/or a patent agent fighting for the inventor and the entrepreneur. If you need a strong patent on your circuit and/or system, I might be your guy.

© 2021, Andy Grouwstra

www.icswpatent.com