



# European IP Helpdesk

Stay ahead of the innovation game.

## IP Assessment

Dr. Christian Hackl

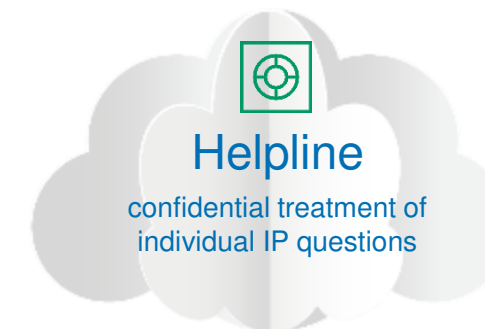
Senior IP Advisor

September 2023



# European IP Helpdesk

- Service initiative of the European Commission
- Addressing **current and potential beneficiaries of EU-funded projects, researchers and EU SMEs**
- Free-of-charge first-line support on intellectual property (IP)
- Hands-on IP and innovation management support
- International pool of IP experts from various thematic fields
- Unique cooperation scheme with the Enterprise Europe Network: 44 ambassadors from 27 EU countries



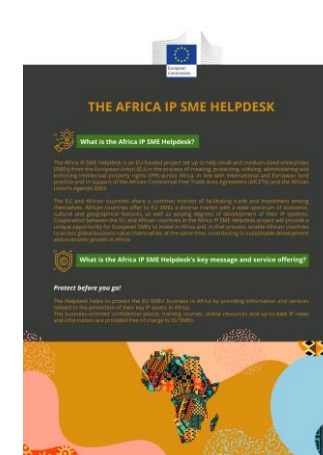
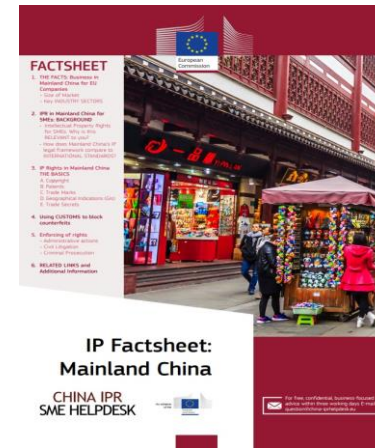
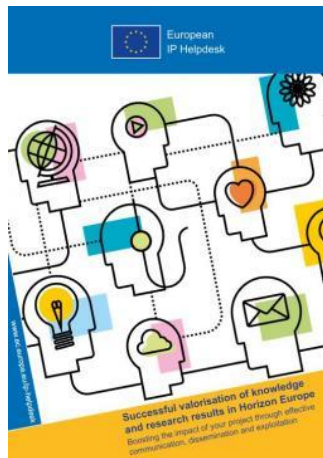


# The EC IP Helpdesks





# EC IP (SME) Helpdesk Hub – Gateway to Information

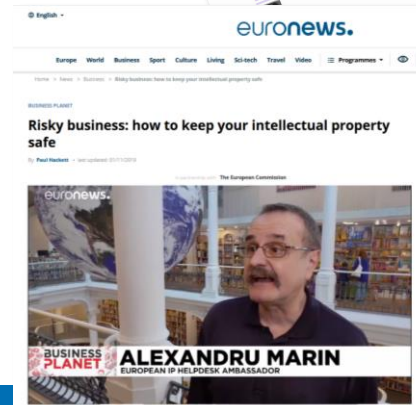
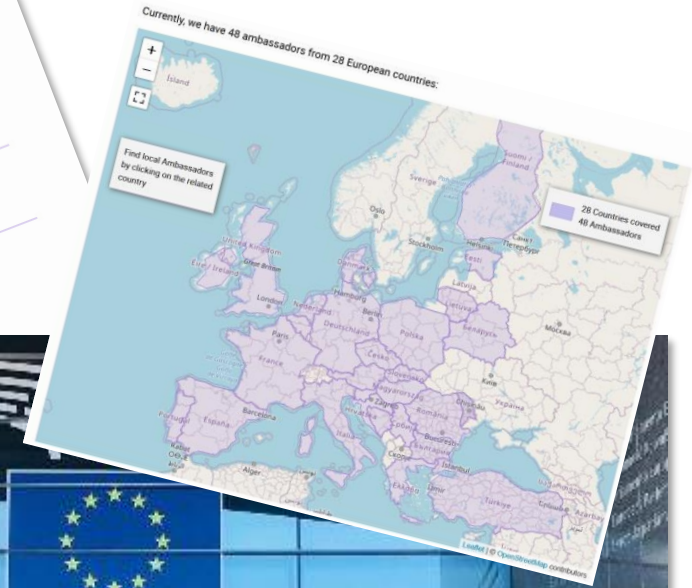
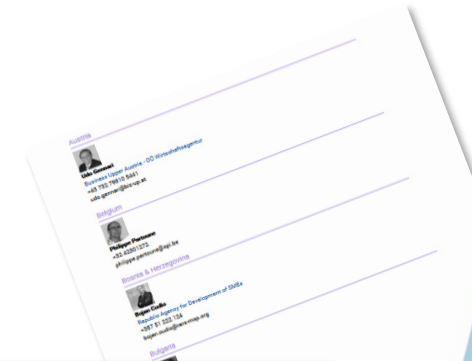


- E-learning modules & more
- Guides / Topic, country, sector-specific factsheets / Infographics
- Case studies



# Ambassador Scheme

- **Cooperation scheme** with the Enterprise Europe Network (EEN): 44 ambassadors – 27 countries
- **Building IP capacities** among European SMEs
- **Overcoming language barriers**
- Making the topic **more accessible**
- Exchange and feedback from ambassadors on **needs of SMEs**
- Local **awareness** and **training events**





- [www.ec.europa.eu/ip-helpdesk](http://www.ec.europa.eu/ip-helpdesk)
- [helpline@iprhelphdesk.eu](mailto:helpline@iprhelphdesk.eu)
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# Today's speaker

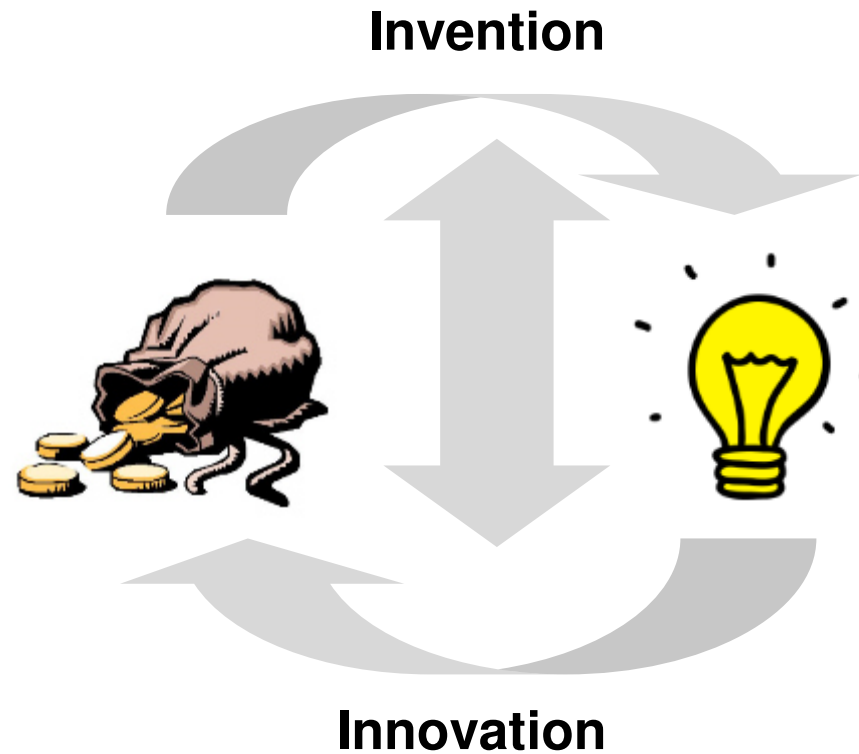
***Dr. Christian Hackl***



- Managing Director of TUM-Tech GmbH
- Assistant Professor at the Chair for Technology and Innovation Management (Technical University of Munich: TUM)
- Senior IP Advisor for the EU-IP Helpdesk
- Author of several publications, e.g. case studies on usage of IPR by companies
- Co-Founder of a start-up (renewable energy)



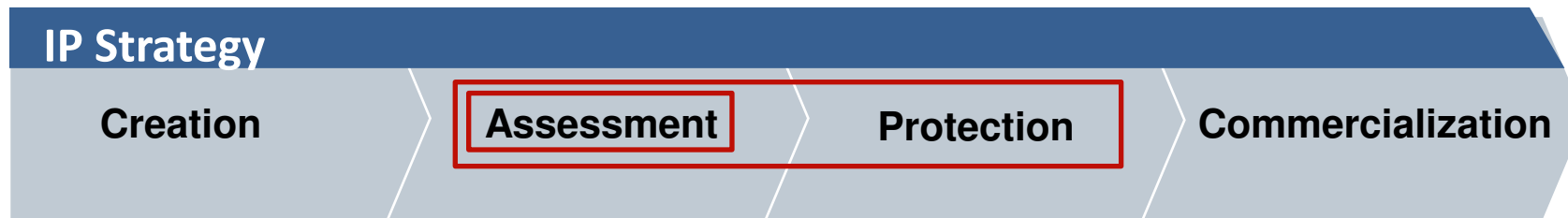
# Invention versus Innovation







# Innovation – Value Chain





## Two Basic / Important Questions ...

... when thinking about filing a patent for most promising ideas



## Two Important Questions

1. **Is it possible** to file a patent application?

2. **Does it make sense** to file a patent application?



# 1. Can a Patent Application be Filed?

Is the invention

- **New?**
- Inventive?
- Industrial applicable?

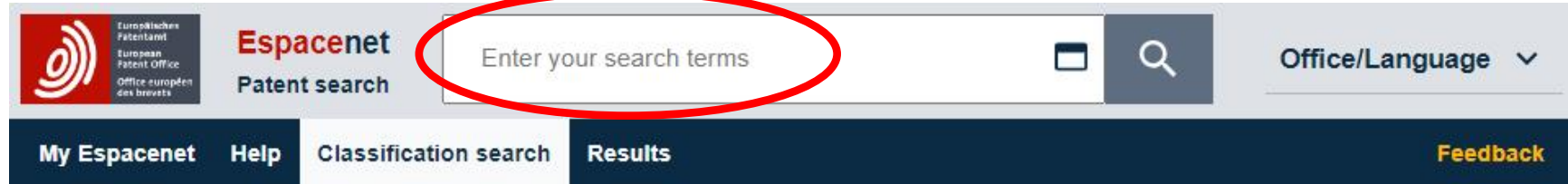
**New** to the world!

- **No** publication
- **No** presentation
- **No** poster
- **No** trade fair
- ...



# The Espacenet database (over 140 million docs)

<https://worldwide.espacenet.com>




**Espacenet: free access to over 140 million patent documents**

**Also for identifying  
potential partners**





# The Espacenet database (over 140 million docs)

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Related links

## Advanced search

Select the collection you want to search in

Enter your search terms - CTRL-ENTER expands the field you are in

Enter keywords in English

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Title or abstract:

Enter numbers with or without country code

Publication number:

Application number:

Priority number:

Enter one or more dates or date ranges

Publication date:

Enter name of one or more persons/organisations

Applicant(s):

Inventor(s):

## Quick access

[Discussion forum](#) [Classic Espacenet](#)



# The Espacenet (n docs)

The screenshot shows the Espacenet search interface. At the top, there is a search bar with the text "Enter your search" and a search button. Below the search bar, there is a navigation menu with the following items: "My Espacenet", "Help", "Classification search", "Results", and "Advanced search". The "Advanced search" item is highlighted with a red circle and a toggle switch is turned on. Below the navigation menu, there is a breadcrumb trail: "Home > Results". Below the breadcrumb trail, there is a dropdown menu for "Query language: en de fr". Below the dropdown menu, there is a search query structure. The query structure is organized into two main sections: "AND" and "OR". The "AND" section contains two sub-sections, each with a "Title" field and a "Title or abstract" field. The "OR" section contains three sub-sections, each with a "Publication number", "Application number", and "Priority number" field. Each field has a dropdown menu for "All" or "Any" and a "Group" button. Each field also has a red "X" button to remove it from the query.

Espacenet Patent search

Enter your search

My Espacenet Help Classification search Results **Advanced search**

Home > Results

Query language: en de fr

AND + Field

AND + Field

Title All → Group

Title or abstract All → Group

OR + Field


Publication number Any → Group

Application number Any → Group

Priority number Any → Group



# The Espacenet (on docs)

 **Espacenet**  
Patent search

Enter your search

[My Espacenet](#) [Help](#) [Classification search](#) [Results](#)  [Advanced](#)

[Home](#) > [Search](#)

Query language: en de fr

OR + Field

OR + Field X

Title or abstract All → Group

Title or abstract All → Group

AND + Field X

Description Proximity → Group

< 3 words away from

Description Any → Group





# 1. Can a Patent Application be Filed?

Any additional consideration?

Does the applicant (university or company) have the rights to own the invention?



## Two Important Questions

1. **Is it possible** to file a patent application?

2. **Does it make sense** to file a patent application?



## 2. Does it Make Sense to File a Patent Application?

"Will people spend money to buy my product?"

- What is the USP (Unique Selling Point) of my product?
  - Advantages of my product over existing offerings?
  - Better price, functionality, handling ...?

It is not about science/technology (for itself)!  
(totally different criteria for success)

**Assessment!**



## **But Before You Can Start the Assessment: You Need Inventions**

Sometimes challenging (especially in Academia)

- First time (invention disclosure)
- Second time ?



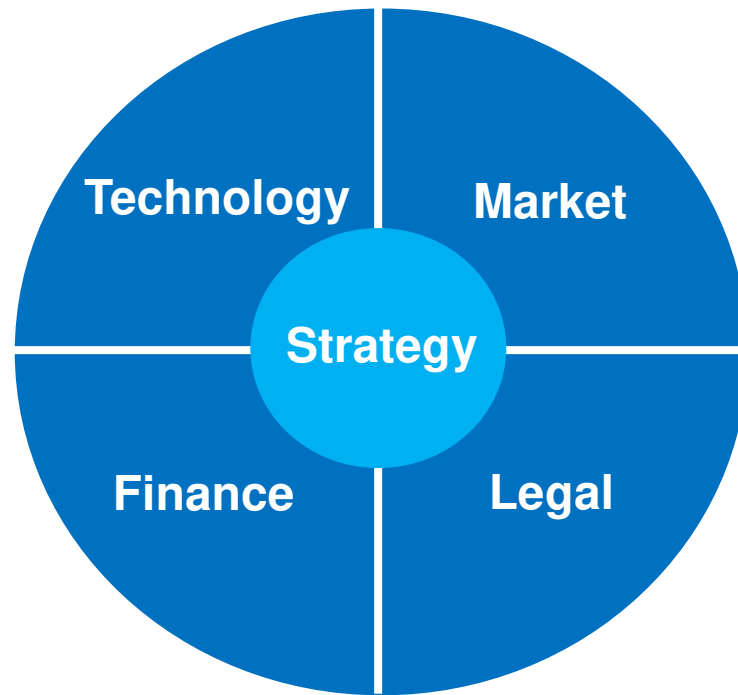
# Does it Make Sense to File a Patent Application?

Let's assume you would like to do an assessment for a new invention...

What are the most relevant categories for assessment:

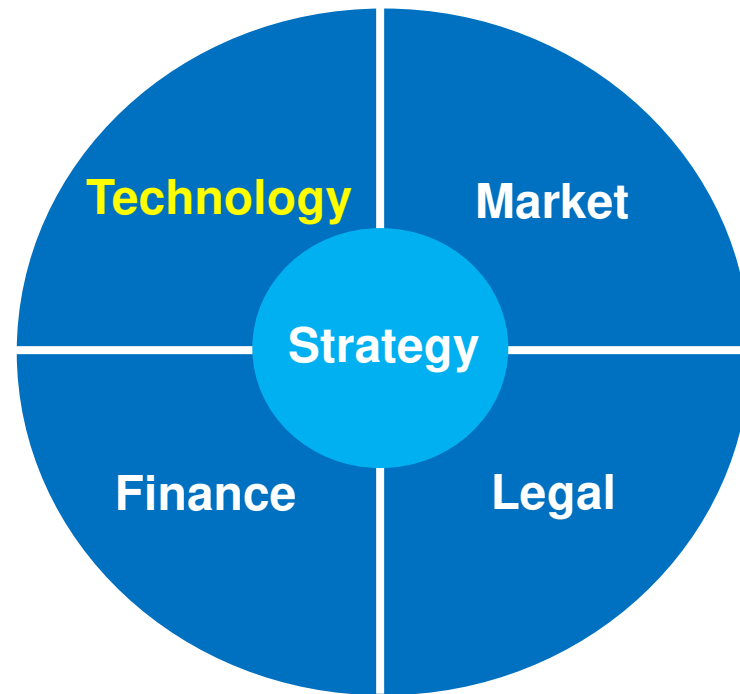


## Relevant Categories for Assessment:





## Relevant Categories for Assessment:





## Assessment – Technology

Relevant questions (examples):

- Benefits for user (functionality, price, handling, ...)?
- USP?
- Similar technologies?
- Market readiness (idea or prototype), time to market?
- Market readiness (e.g. robustness)?
- Barriers for adoption (e.g. easy of use)?
- Other areas of applications?
- ...





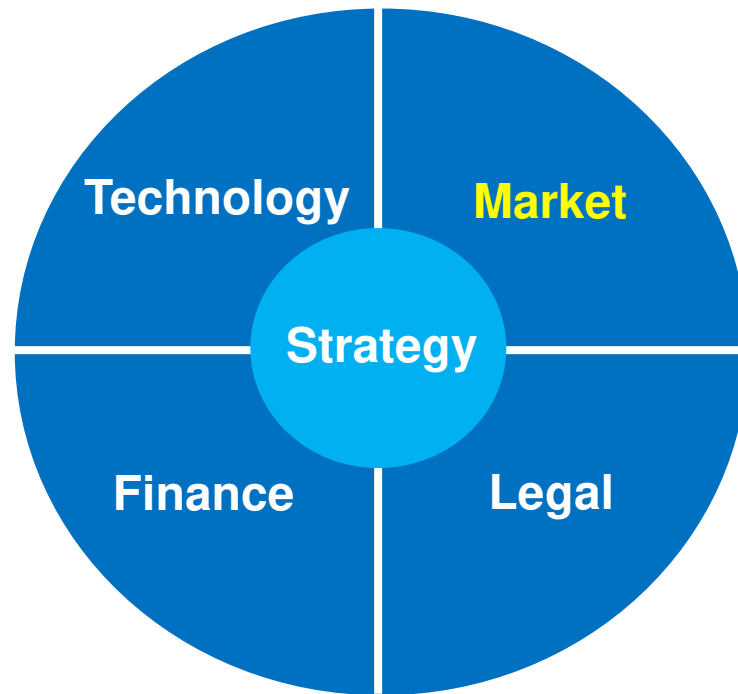
# Platform Technology: Spider Silk



BioShield-S1 for improved implants and SanaSilk OTC wound care products >	Implant Coatings & Medical Devices
Medical Devices for OTC Wound Care >	Medical Devices for OTC Wound Care
Cosmetics products with functional silk for improved skin care >	Functional Cosmetics
High-performance fibers for technical and medical textiles >	Biosteel Spidersilk Fibers



## Relevant Categories for Assessment:





## Assessment – Market

Relevant questions (examples):

- Is there a market for the invention?
- Is there a market need for the invention?  
(Market Pull vs Technology Push)
- How big is the potential market(s)? Any new markets?
- How sustainable/growing is the market?
- How strong are the competitors (pricing, SWOT)?
- Ease of market entry?
- ...



## Relevant Categories for Assessment:





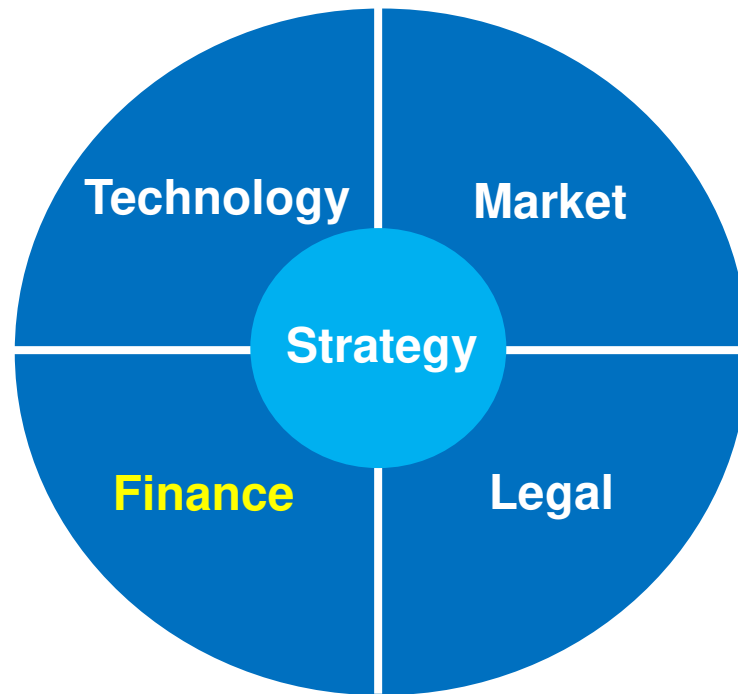
## Assessment – Legal

Relevant questions (examples):

- How strong is the patent?
- Easy to circumvent?
- Easy to police?
- Broad claims (platform technology?) or just minor variation of existing technology?
- Does the applicant (company or university) own all rights? (e.g. contracts with partners, inventors, open innovation)
- ...



## Relevant Categories for Assessment:





## Assessment – Financial

Relevant questions (examples):

- Potential revenue stream?
- Time when revenue will come?
- Risk associated with potential revenue stream?
- Necessary investments?
- Cost / benefit ratio?
- ...
- Possible tax deductions



# Relevant Categories for Assessment







## Assessment – Strategy

Relevant questions (examples):

- Fit between invention (and possible products or services) and business strategy?
- Does invention help to secure existing or win new markets?
- Enhancing reputation of company/institution?
- Allowing for differentiation?
- Ensuring Freedom to Operate?
- Blocking competitors?
- Potential partners?
- ...

**Add-on  
benefits**



## Does it Make Sense to File a Patent Application?

- Any reason why you would not like to pursue a patent application?
- Any (better) alternatives to patenting?



## Challenges (at time of invention)

- When doing first assessment: often far away from any market
- Difficult to understand market needs
- Difficult to see possible potential to solve market needs
- Sometimes biggest potential in very different markets than original invention
- Difficult to estimate market potential
- Don't forget possible (strategic) add-on benefits
- ...



# Patent Strategy

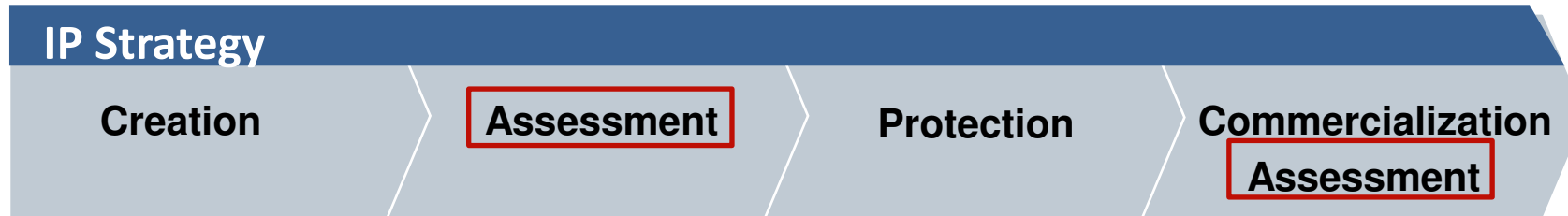
Relevant questions (examples):

- When to file the application?
- How broad should the claims be?
- Which countries (incl. tax considerations)?
- Which route (national vs international)?
- Is a partner involved (e.g. company)?
- Alternatives to patenting (e.g. utility model, secret know-how or publishing)?

**In-line with  
Business  
Strategy**

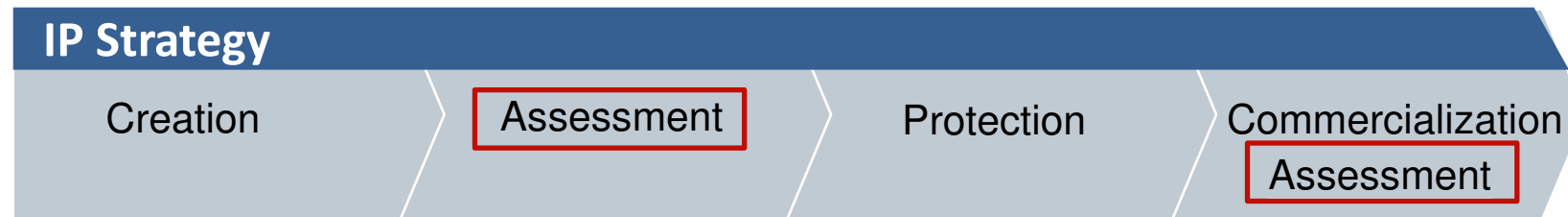


# IP – Value Chain: Ongoing Assessment





# IP – Value Chain: Ongoing Assessment



## Stage-Gate Process

Internal  
Ideation  
Programs



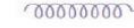
DISCOVER



SCOPE



DESIGN



DEVELOP



SCALE UP



LAUNCH

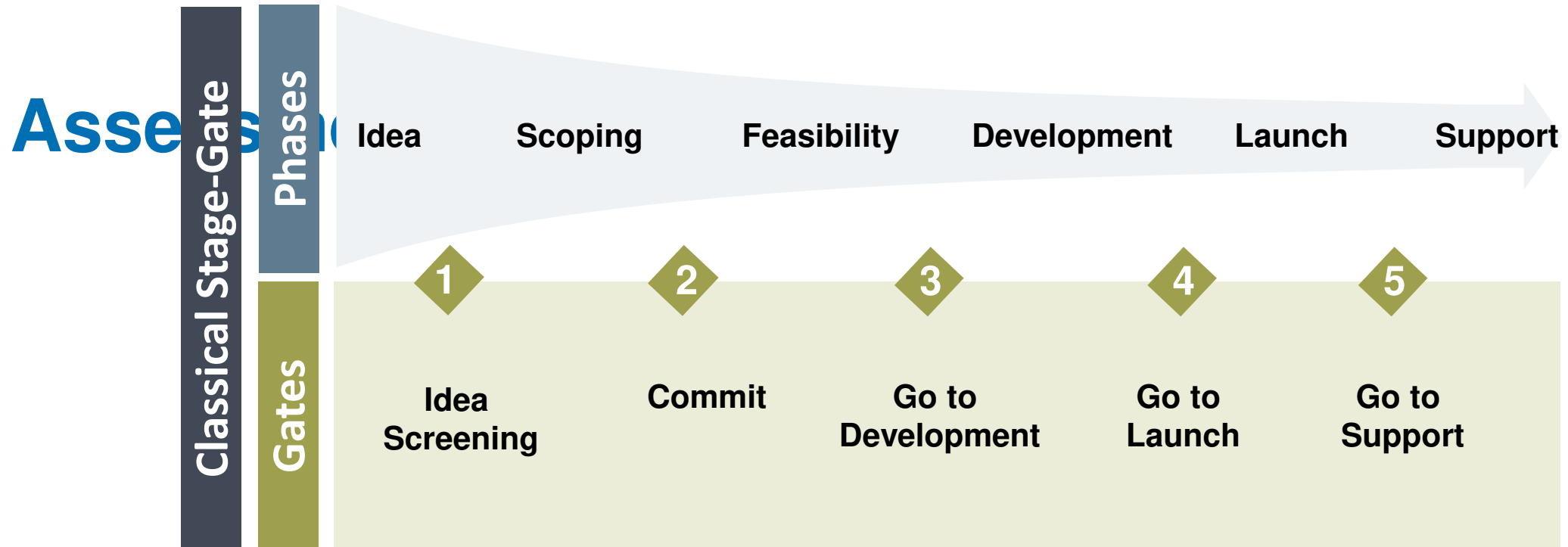


External Idea  
Networks and  
Programs



Continuous Customer or User Interface

[www.stage-gate.com](http://www.stage-gate.com)





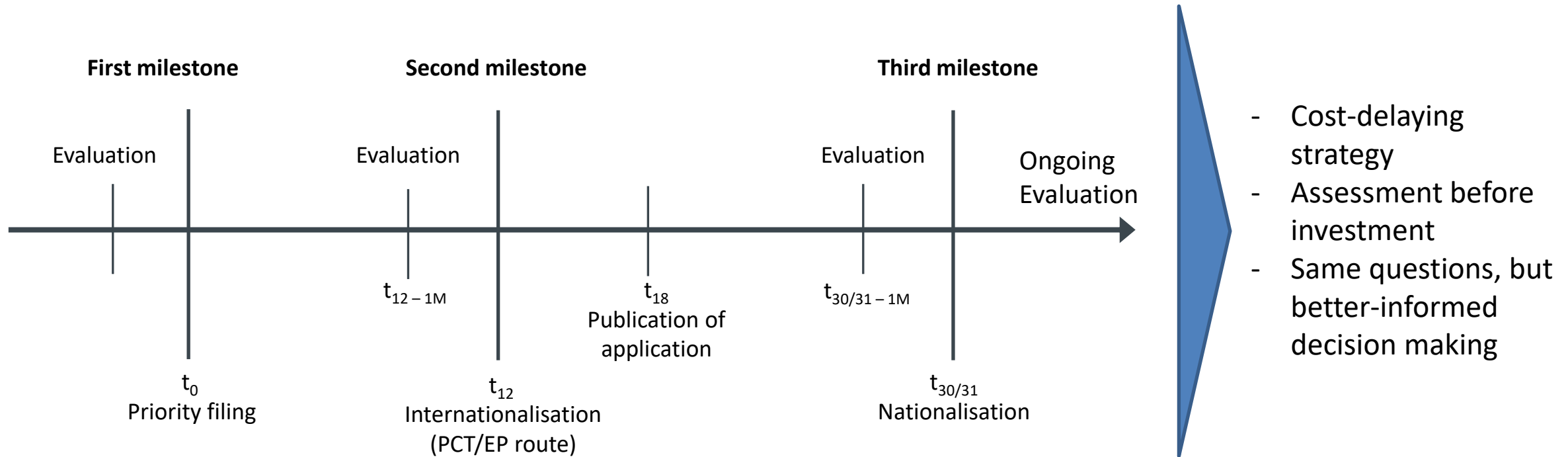
# Assessment during (early) patent life







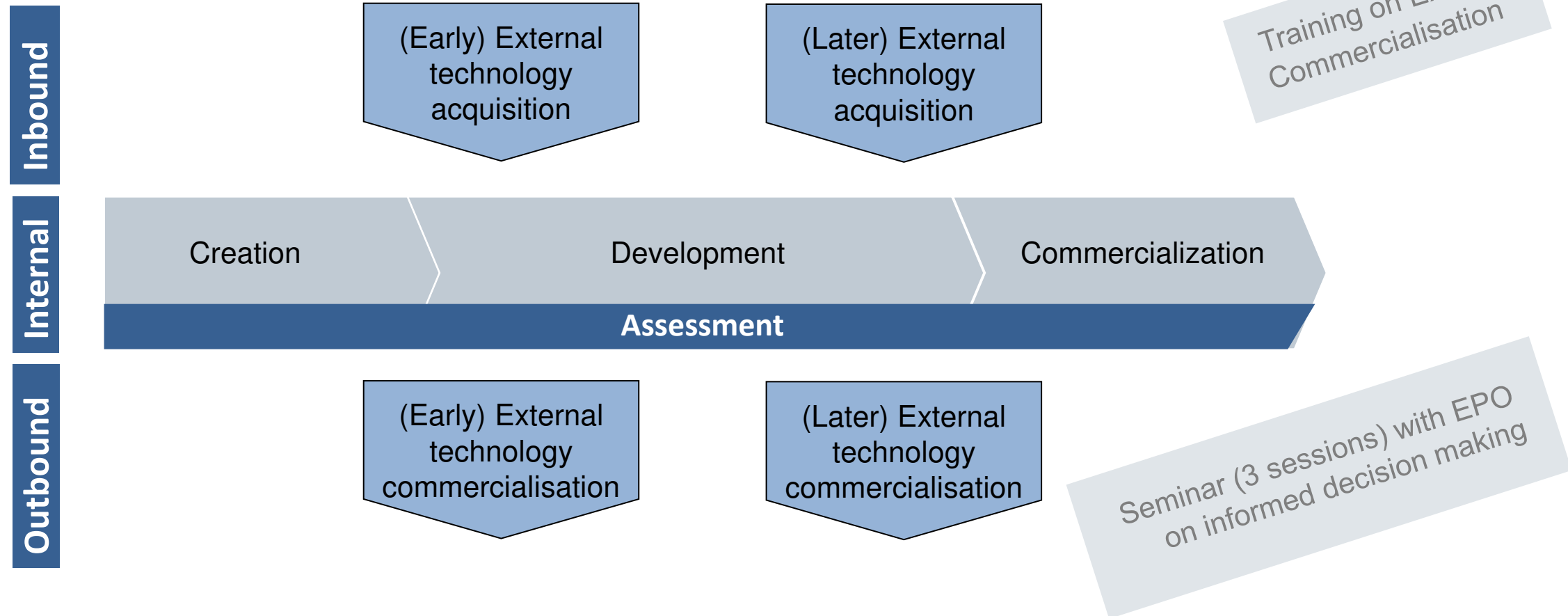
# Assessment during (early) patent life



$t_0$  Patent priority filing: start of priority year  
 $t_{12}$  Deadline for internationalisation: 12 months after  $t_0$   
 $t_{30/31}$  Deadline for nationalisation: 30/31 months after  $t_0$



# Ongoing Assessment – Open Innovation

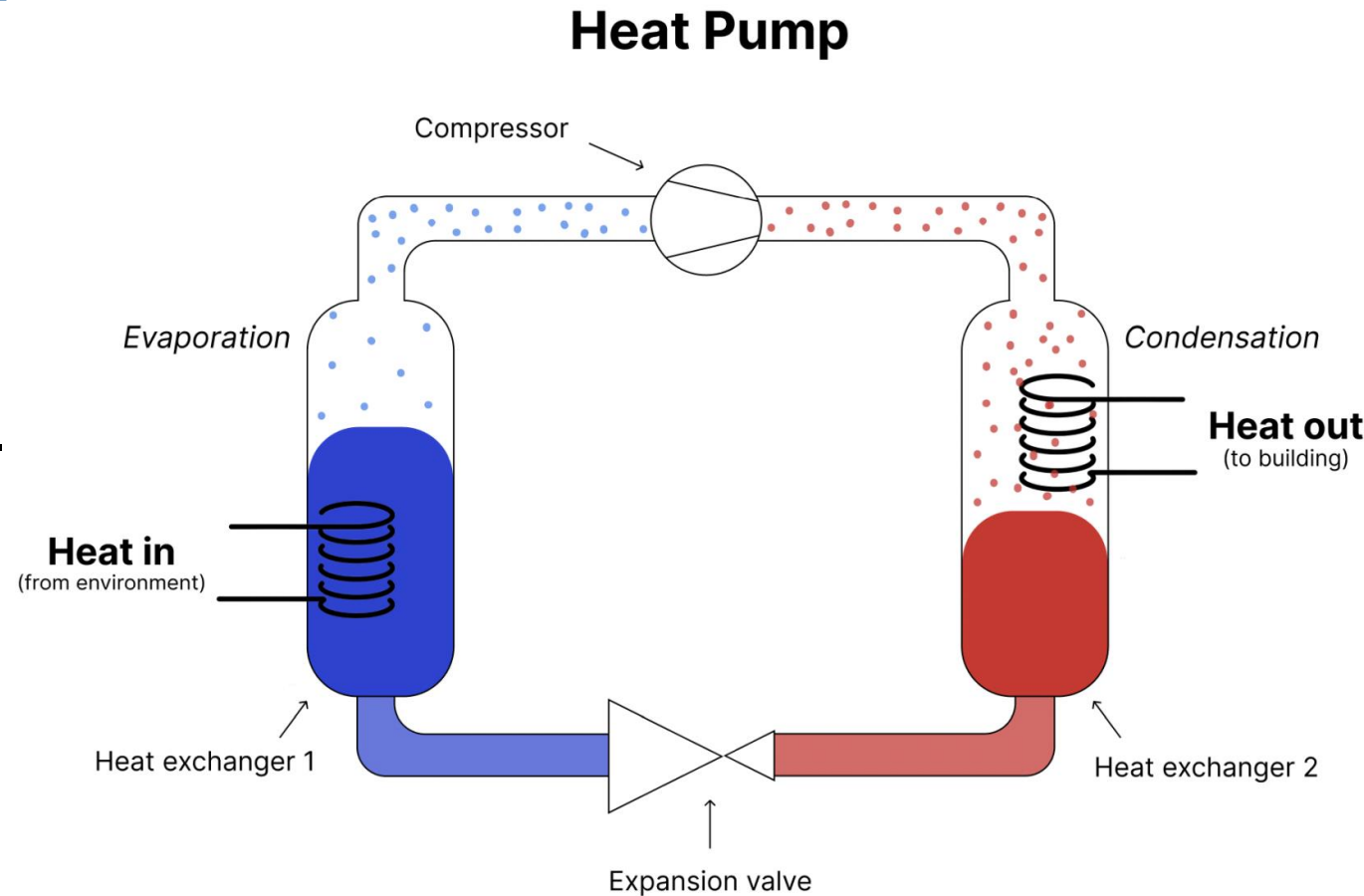




# Case Study “Heat Pumps”

Case Study  
“Heat Pump”

- You are working for a company producing heat pumps.
- Heat pumps are devices for heating of buildings... by transferring thermal energy from the outside into the building.
- You would like to find a technical solution to prevent possible adverse environmental effect when a leakage occurs.





# Leakage Detection

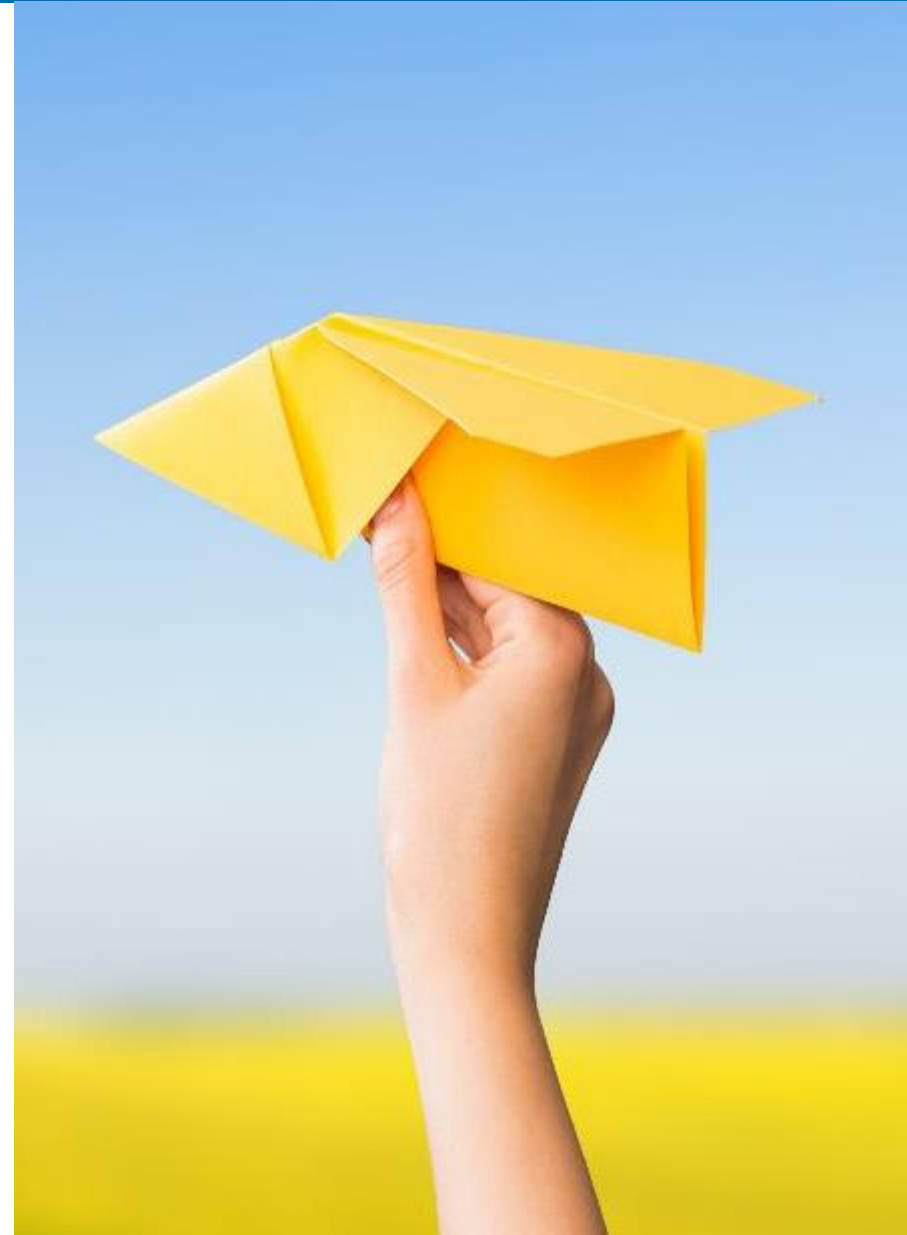
- There are two commercially available technical solutions for the detection of such a leakage, both with considerable disadvantages (e.g. complicated setup, cost).
- You found a patent describing an innovative technical solution (for a different application) – but you think it might be a good solution for your need.
- How would you evaluate this innovative solution before suggesting it to your boss??
- Different tools for evaluating ideas/technologies
- Tool from EPO: IPscore ([www.epo.org/lpscore](http://www.epo.org/lpscore))

Seminar (3 sessions) with EPO  
on informed decision making



## Contact us!

- [www.iprhelphelpdesk.eu](http://www.iprhelphelpdesk.eu)
- [service@iprhelphelpdesk.eu](mailto:service@iprhelphelpdesk.eu)
- Twitter [@iprhelphelpdesk](https://twitter.com/iprhelphelpdesk)
- LinkedIn [/european-ipr-helpdesk](https://www.linkedin.com/company/european-ipr-helpdesk)





# Thank You!

## DISCLAIMER

The European IP Helpdesk provides free-of-charge first-line support on IP-related issues aiming to help current and potential beneficiaries of EU-funded projects, as well as EU SMEs, manage their Intellectual Property assets.

The European IP Helpdesk is managed by the European Commission's European Innovation Council and SMEs Executive Agency (EISMEA), with policy guidance provided by the European Commission's Directorate-General for Internal Market, Industry, Entrepreneurship and SMEs (DG Grow).

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