

APRIL 2018

ISSN 2052-6474

LAWYER

CONNECTING THE LEGAL & BUSINESS PROFESSION, GLOBALLY

MONTHLY



LET US FORGET

CAN LAW COVER UP THE HOLOCAUST?

NEWS • MOVES • INSIGHT • LEGAL UPDATES

PATENTS

Rainer K Kuhnen, Partner at KUHNNEN & WACKER Intellectual Property Law Firm | E: rkj@kuhnen-wacker.com
Prinz-Ludwig-Str 40A, Freising/Munich 85354, Germany | T: +49 8161 608 0 | F: +49 8161 608 100 | W: www.kuhnen-wacker.com

There would be numerous points to raise in order to help innovators to be successful with patents, but one point seems striking to Rainer Kuhnen:

'For innovative companies, it seems that the most difficult part is to keep secrecy of their innovations. This is because once the idea of the invention has gone public - which is if only one other person who is not obliged to confidentiality has become knowledge of it - obtaining a respective patent is no longer possible.'

'Hence, in order to take business advantage by patenting, one should follow the golden "First to file" rule: "First file an application for your invention with the patent office and then start with marketing your invention!"'

How have you seen the electrical engineering sector change over the years and how has this affected your line of work?

Over the years, there have been many changes in connection with progressing digitalisation and increasing network connectivity often summarized with the buzzword "Internet of Things" (IoT). Though IoT clearly fuelled the patent activity in the recent years, in particular in the field of smart sensors, it also provides for new challenges in patent prosecution and enforcement.

Besides legal questions of who is owing the collected data, how to ensure privacy and cybersecurity, one of the biggest challenges for established innovative companies lies in the licensing regime under the prevailing standardisation in the telecommunication field. Though holder of standard essential patents (SEPs) are obliged to provide licenses under FRAND (fair, reasonable and non-discriminatory) conditions, negotiations with hundreds of SEP holders are simply neither practical nor affordable.

On the other hand, it is often overlooked that the fact that

a patent is regarded standard essential does not per se guarantee its validity. Hence, we experienced a growing number of patent disputes with newcomers in the market who were able to successfully invalidate SEPs. Another growing field in our work was helping SMEs in countering infringement assertions of non-practicing entities or patent assertion entities - pejoratively considered as "patent trolls" - based on outdated SEPs that have been cheaply purchased from telecommunication firms.

What do you think is the most difficult aspect of ensuring a patent is unique?

A valuable patent is one that provides a broad scope of protection. However, this goal is inherently in contradiction with the validity of the patent. In other words, a valuable patent is worth enforcing, but resistant to invalidation.

Hence, to obtain a valuable patent, the art is to find the balanced wording for a claim that legally provides a market advantageous and technically meets the requirement of novelty and inventive step in view of the existing prior art.

As European and German patent attorneys, we are legally and technically qualified and trained for this art and, at Kuhnen & Wacker, you benefit from over 40 years of experience in IP.

How has technology affected your field and how do you think it will evolve in 2018?

With the growing implementation of an "Internet of Things", several technology fields that had its own markets in the past are coming together. This trend will continue in 2018. Therefore, IoT is requiring the companies and patent attorneys alike to work more interdisciplinary and to understand risk and challenges of entering the standardised telecommunication field. As one of the long-standing and larger patent law firms in Germany, our patent attorneys are covering all main technical areas allowing interdisciplinary working as needed.

Do you have a new year's resolution that will enable you to develop yourself for the betterment of your clients?

Today's fast communication has led to a fragmented working day and does often not



About Rainer Kuhnen

Rainer Kuhnen is partner with the renowned IP law firm KUHNNEN & WACKER. As a German and European patent attorney, he specialises since over 20 years in patent prosecution and litigation proceedings, especially in the fields of electrical engineering, electronics and physics. Mr Kuhnen holds a master's in electrical engineering and information technology from the Technical University of Munich and an LL.M. in European IP law.



leave enough room for deep thinking. However, to provide not only a quick work-around but a well-founded IP strategy tailored to the need of the client, sufficient time is essential.

Hence, my new year's resolution is to delegate more of my managing tasks as partner, to free up more of my working time for providing legal and technical expertise and establishing successful IP strategies. LM