

***Luxinnovation ICT Cluster at KPMG
Present Yourself***

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Senior Associate

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09 July 2019

Marks&Clerk



who is Marks & Clerk (Luxembourg)?



Beijing (China)	Hong Kong (China)	Kuala Lumpur (Malaysia)
Singapore	Ottawa (Canada)	Toronto (Canada)
Paris (France)	Sophia Antipolis (France)	Luxembourg
Aberdeen (UK)	Birmingham (UK)	Cambridge (UK)
Edinburgh (UK)	Glasgow (UK)	London (UK)
Manchester (UK)	Oxford (UK)	

- Est. 1887 Birmingham, UK
- Est. 1989 Luxembourg
- Historically, Luxembourg = group EP validation centre, 2nd/3rd largest in EPC
- 2017: Luxembourg to become full-service practice, focused on CII & Bio

who am I?



- **Registered Irish Patent Agent**
- **Registered Irish Trademark Agent**

Irish professional qualifications



- **Chartered Patent Attorney**

British professional qualification



- **European Trademark & Design Attorney**

(via Irish quals-registrations)



- **European Patent Attorney**

EPO-EPI professional qualification



- **Software Patent Specialist**

2000 to date

local competences



Legal:

- Patents
- Trademarks
- Designs
- Copyright(s)
- Trade secrets

Jurisdictional:

- National (LU, GB, IE)
- Supranational (EU, EPC)
- International (WIPO)
- RoW via group & associates

Technical:

- software engineering
- networks (mobile, wide, local) & distrib
- user interfaces
- audio/image/video processing
- cryptology
- e-payment & other 'business methods'
- mechanical and electronics

Commercial:

- interfacing at boardroom/CEO level
- [change into jeans & t-shirt] interfacing with coders & assorted other rocket scientists

relevance to software field



- **Patents:** reduction to practice of software functionality (-ies), from a technical point of view (algorithm(s), APIs, UI, messaging, etc.) [*what an app does for an end user, is rarely technical – how it does it, can be*]
- **Trademarks:** identification of the company and/or platform in the marketplace
- **Designs :** organising/appearance/characteristics of a (each) user interface
- **Copyrights:** preparatory docs, code constituting the app, image/graphic/audio assets, icons, textures, pre-recorded alphanumerical-audio-video data, file structures, 3D assets, <...>
- **Trade secrets:** e.g. data encoding techniques impossible to reverse-engineer without specific knowledge, e.g. from app usage or decompile

~~name-dropping~~ conflict-check time



IP services provider : added value?



Value added by legal specialisation: get to know what you don't know, early
where is the value in your business? discrete knowledge/skills = IP!
who contributes that value to your business?

Value added by subject-matter specialisation: don't waste time/money

"software can't be patented" (when it can) > opportunity loss

"software can/might/may be patented" > claims result to be achieved > rejection

Example: 'a user interface adapted to input a personal identifier code' (rejectable)

> adapted how? what features? which feature does what? implemented how? <...>

Value added by experience and commercial awareness: maximise return on IP spend

"software can't be patented" (when really it can't) > saves rejection €€€ price tag

"software this aspect of the software can be patented" > is it worth the expense?

"this aspect of the software can be patented here, but not there" > does it matter?
do geo & timescale factors need to match dev path? if so, can/will they?

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