Best Patent Prosecution Practices for Damages and Licensing Purposes

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Patent Evaluation
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Quantify situation
Quantification process informs practical best patent prosecution practices
First Factor – Commercial Threat

Learn from Defense
Defensive Evaluation

High Score -- Direct infringement risk for several independent claims implicates material product revenue

Medium Score – Direct infringement risk for small number of independent claims implicating peripheral product revenue

Low Score – Indirect or divided infringement for independent claims implicating peripheral product revenue for feature that will be phased out in time
Commercial Threat Practice Points

• Understand the key commercial features of your client’s technology
  • Impressive revenue vs. impressive technology

• Understand territorial issues

• Understand your client’s competitors

• Large patent counts do not necessarily trump small numbers of strategic patents
Second Factor – Commercial Opportunities

Learn from Offense
Second Factor – Commercial Opportunities

- Commercial opportunities
- High Score – Patent applicable to a large commercial market or multiple industries
- Medium Score – Patent applicable to a medium commercial market or a few industries
- Low Score – Patent applicable to a single market with small market size
• Understand the uniqueness of the problem
  • Push inventors beyond the problem they solved
• Multiple embodiments for multiple industries
  • Consider bringing in additional inventors to flesh out applications for different industries
Third Factor – Divided Infringement
Third Factor – Divided Infringement

- High Score – No divided infringement in any independent claims (and most dependent claims)
- Medium Score – No divided infringement in at least one independent claim and some of its dependent claims
- Blackball? – Divided infringement in all independent claims
Divided Infringement Practice Points

• Don’t go there
• Client-server figure
• Flow chart for server operations
• Signal exchange figure with server as hub
• Coordinating server is typically your target
• Third-party server coordinated with may be of interest
• Client side may be of interest if it is running a delivered script
Fourth Factor – Indirect Infringement
Fourth Factor -- Indirect Infringement

- High Score – No indirect infringement in any independent claims (and most dependent claims)
- Medium Score – No indirect infringement in at least one independent claim and some of its dependent claims
- Low Score – Indirect infringement in some claims, but publicly available information evidencing intent
- Blackball? – Indirect infringement for all claims and no publicly available information evidencing intent
Indirect Infringement Practice Points

- Claim smaller parts
- Company literature
Fifth Factor – Ease of Detecting Infringement
Fifth Factor – Ease of Detecting Infringement

- High Score – Infringement can be detected from publicly available information
- Medium Score – Infringement can be detected from testing or reverse engineering
- Low Score – Infringement cannot be confirmed without discovery
Infringement Detection Practice Pointers

- Beware the back end
- Beware evolving algorithms
- Throw-away broad claims
- Write claims with observable elements
  - specified input parameters
  - output parameters
  - well-defined analytics
Sixth Factor – Claim Quality
Sixth Factor – Claim Quality

- This assessment is an art
- High Score – Varying claim scope amongst multiple independent claims; value add dependent claims
- Medium Score – Some varying scope amongst at least two independent claims; value add dependent claims
- Low Score – All independent claims very similar
The hex of tight budgets

We all tend to be too redundant with our claims

Each dependent claim should have support in specification that explains significance of feature

Nice to have language in specification that tracks claim language, but it is also nice to go off script to have other ways to characterize the invention to perform a pivot during prosecution

Ease of design around considerations

§ 101 issues
Seventh Factor – Specification Quality
This assessment is also an art

High Score – Short background, minimal references to “the invention”, “preferred embodiment”, detailed figures, meaningful alternative embodiments

Medium Score – “Poor person’s” high score

Low Score – Essentially a document from the client, single characterization of the invention, simple figures, narrow language tracks
Let’s all agree on a short background

Own at least the “legal part” of the specification

Drop in the client work at the end, if need be, but clean it of all the bad language (e.g., “the invention”, “preferred embodiment”, “must have”, “works when”, etc.)

Press for meaningful alternate embodiments

Push for detailed figures, even if you do not have time to explain them in depth; the details usually speak for themselves (i.e., a picture is worth a thousand words)
### Eighth Factor – Prosecution History

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Eighth Factor – Prosecution History

• High Score – First office action allowance or office action with limited rejections
• Medium Score – A reasonable number of substantive office action responses, minimal problematic estoppel
• Low Score – A significant number of substantive office action responses and/or poorly executed prosecution
Prosecution History Practice Pointers

- Luck involved here
- Is it just me?
- Pre-appeals
- Supervision
Ninth Factor – Citation of Prior Art

Daddy, what's "prior art"?

Depends on how good the patent attorney is.
Ninth Factor – Citation of Prior Art

- High Score – At least some threshold number of references cited by applicant
- Medium Score – Prior art submitted by applicant below threshold
- Low Score – Only prior art was cited by Examiner
• Push inventors on topic
• System issue, not going to blow through your caps
  • related cases
  • foreign cases
  • patents by same inventors
Tenth Factor – Related Cases

- High Score – At least one related pending patent application
- Medium Score – Related issued patents
- Low Score – One-off case
Related Cases Practice Pointers

- Suggest evolving strategies
- Be aware of likelihood of litigation
- Relatively low cost approach to pad count and keep competitors guessing
A self-congruaneous apparatus having a simulated human hand carried on a pivoting arm suspended from shoulder-supported member. The hand is manually swingable into and out of contact with the user's back to give an amusing or an important pat-on-the-back.

4 Claims, 2 Drawing Figures
Questions?