

Best Patent Prosecution Practices for Damages and Licensing Purposes

Bill Galliani

Advanced Patent Law Institute

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attorney advertisement

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Five Palo Alto Square, 3000 El Camino Real, Palo Alto, CA 94306

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Patent Evaluation



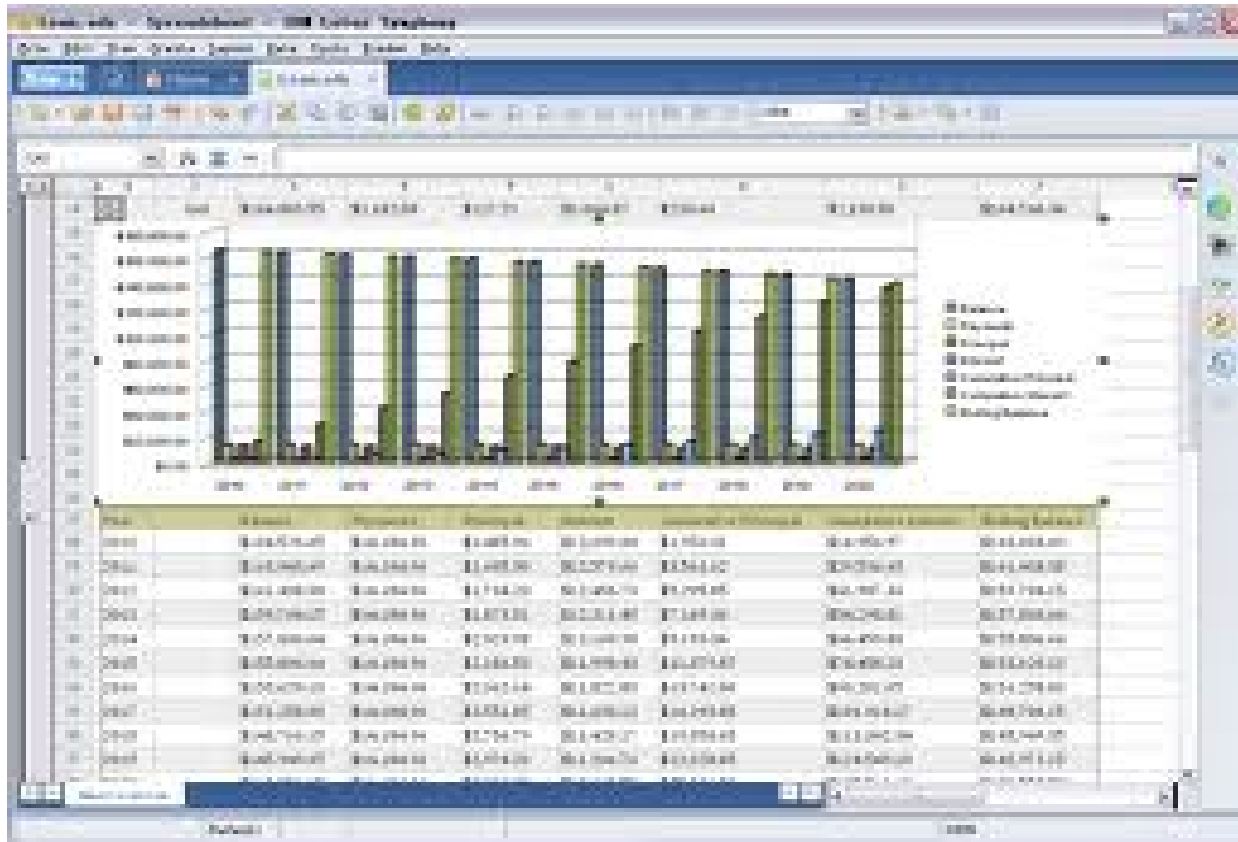
Patent Evaluation



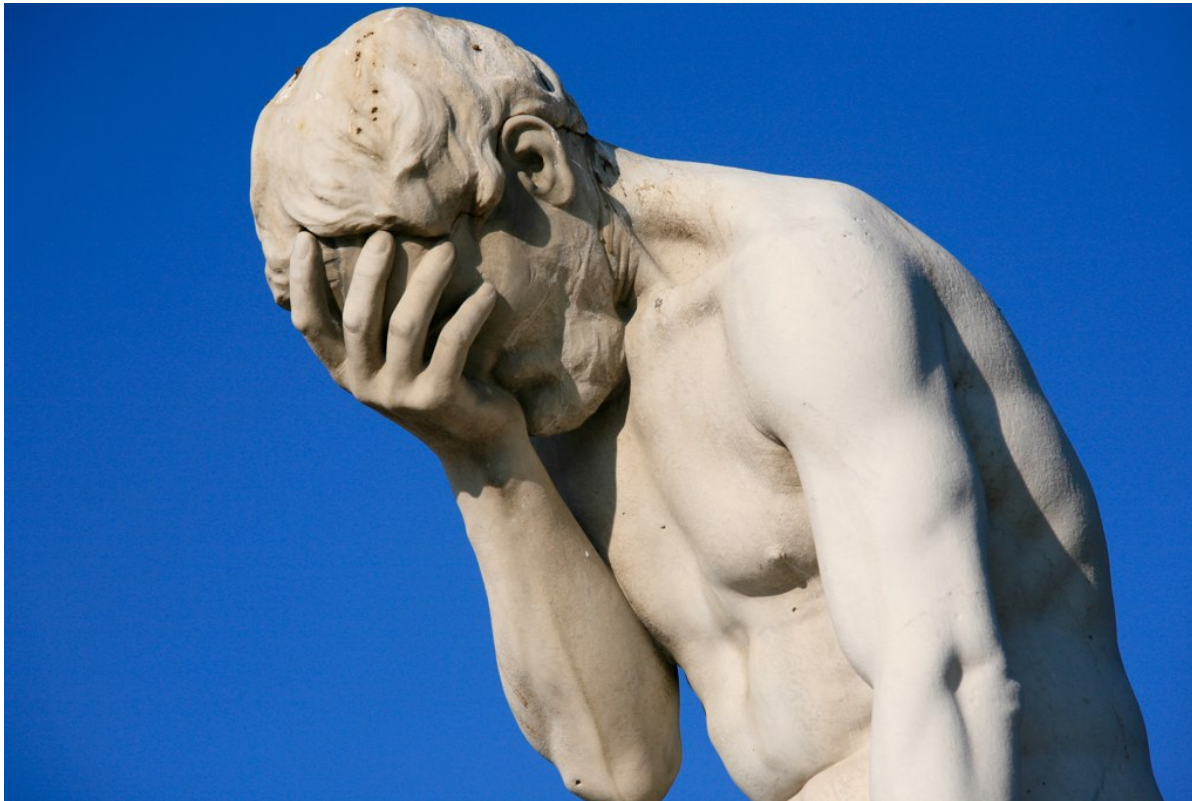


Patent Evaluation

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

- 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

- 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

- 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

Poor
Satisfactory
Good
Excellent

☐
☐
☐
☒



Rating	Selected
Poor	<input type="checkbox"/>
Satisfactory	<input type="checkbox"/>
Good	<input type="checkbox"/>
Excellent	<input checked="" type="checkbox"/>

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

[illegible]

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

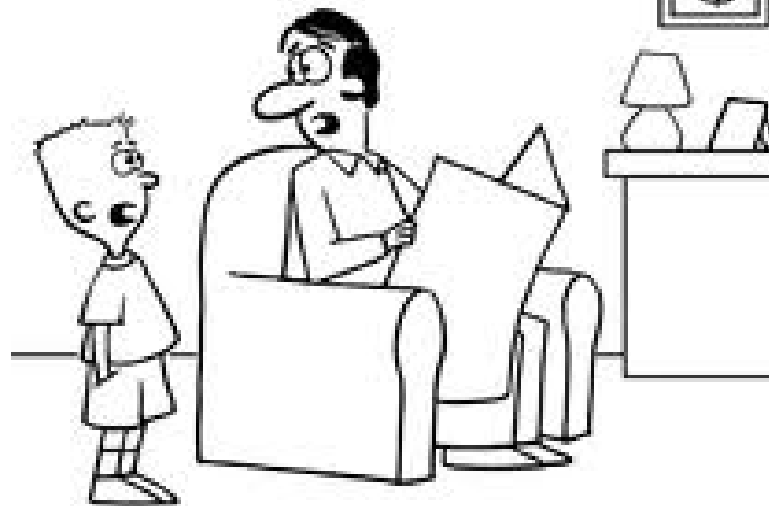
Stu's Views

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Daddy,
what's
"prior
art"?

Depends
on how good
the patent
attorney is.

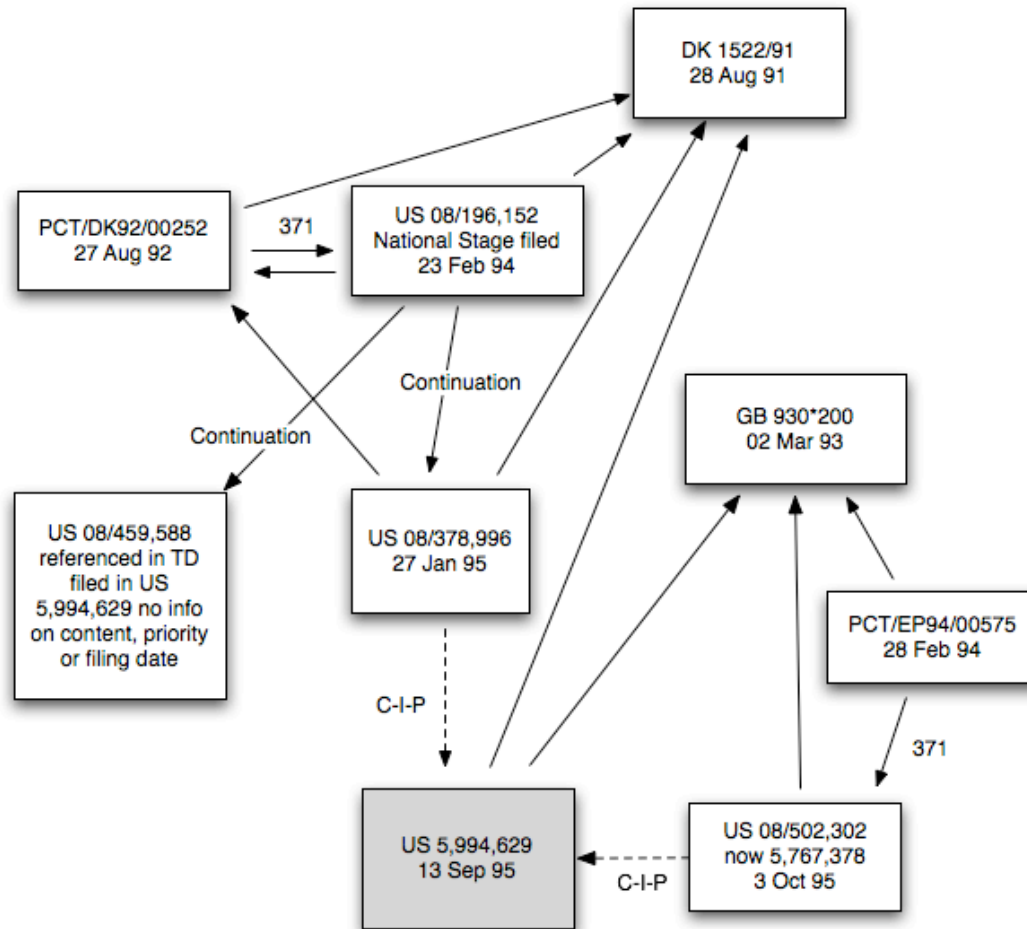


Ninth Factor – Citation of Prior Art

- 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



Tenth Factor – Related Cases

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

- Suggest evolving strategies
- Be aware of likelihood of litigation
- Relatively low cost approach to pad count and keep competitors guessing

United States Patent [19]

Piro

[11] Patent Number: 4,608,967

[45] Date of Patent: Sep. 2, 1986

[54] PAT ON THE BACK APPARATUS

[76] Inventor: Ralph R. Piro, 676 Centre Ave.,
Lindenhurst, N.Y. 11757

[21] Appl. No.: 739,669

[22] Filed: May 31, 1985

[51] Int. Cl.⁴ A61H 7/00

[52] U.S. Cl. 128/61; 4/559;
15/143 R; 15/210 R; 224/265; 269/3; 272/1 R;
272/76; 446/26; 128/67

[58] Field of Search 128/24.2, 24 R, 24 A,
128/25 B, 28, 32-40, 45, 46, 47, 50-53, 56, 57,
59, 61, 62, 65, 66, 67, 272/96, 8 N, 8 R, 76, 27
R, 27 N, 1 R; 15/28, 29, 210 R, 143 R, 144 R,
145; 4/559; 2/44, 45; 269/3; 224/265; 446/26,
28

[56] References Cited

U.S. PATENT DOCUMENTS

1,537,464 5/1925 Hummel 128/65
1,999,799 4/1935 Beck 4/559
2,168,975 8/1939 Clarke 128/62 R
2,642,863 6/1953 Gordon 128/38

3,679,107 7/1972 Perrine 224/265
3,856,002 12/1974 Matsumoto 128/62 R
3,881,470 5/1975 Glorie 128/55
4,266,536 5/1981 Casares 128/57
4,411,421 10/1983 Hershberger 128/57

FOREIGN PATENT DOCUMENTS

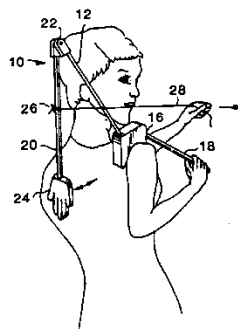
2527295 11/1977 Fed. Rep. of Germany 224/265
603405 1/1926 France 272/1 R
36643 10/1935 Netherlands 224/265
21411 5/1900 Switzerland 128/62 R

Primary Examiner—Clyde I. Coughenour
Attorney, Agent, or Firm—John J. Byrne, Bradford E.
Kile, Kevin M. O'Brien

[57] ABSTRACT

A self-congratulatory 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?