

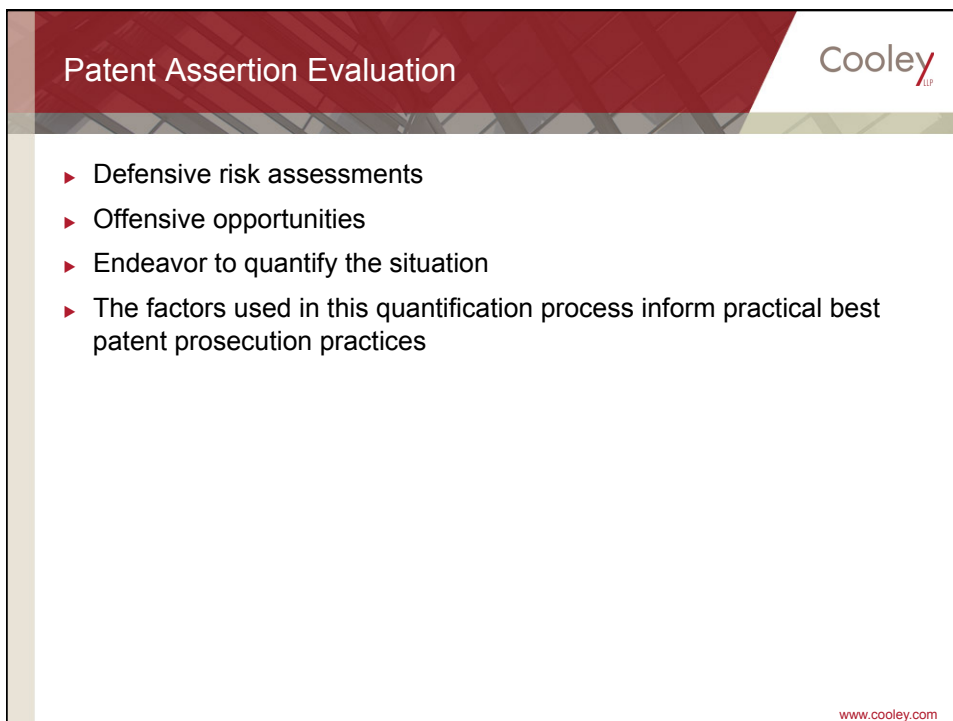
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**Best Patent Prosecution
Practices for Damages and
Licensing Purposes**

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attorney advertisement

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Patent Assertion Evaluation

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- ▶ Defensive risk assessments
- ▶ Offensive opportunities
- ▶ Endeavor to quantify the situation
- ▶ The factors used in this quantification process inform practical best patent prosecution practices

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First Factor -- Commercial Threat



- ▶ 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

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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

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Second Factor -- 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

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Commercial Opportunities Practice Pointers



- ▶ 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

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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

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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

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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

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Indirect Infringement Practice Points



- ▶ Divided infringement practice points
- ▶ Act performed outside system is a red flag
- ▶ Articulate as a received action, e.g., receive a command specifying action X

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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

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Infringement Detection Practice Pointers



- ▶ Beware the back end
- ▶ Beware evolving algorithms
- ▶ Write claims with observable elements
 - ▶ specified input parameters
 - ▶ output parameters
 - ▶ well-defined analytics

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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

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Claim Quality Practice Pointers



- ▶ 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

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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

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Specification Practice Pointers



- ▶ 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)

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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

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Prosecution History Practice Pointers



- ▶ Luck involved here
- ▶ Is it just me?
- ▶ Pre-appeals
- ▶ Supervision

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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

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Prior Art Practice Pointers



- ▶ Push inventors on topic
- ▶ System issue, not going to blow through your caps
 - ▶ related cases
 - ▶ foreign cases
 - ▶ patents by same inventors

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Tenth Factor – Related Cases



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

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Related Cases Practice Pointers



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

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