

THE SCIENCE OF VALUABLE IP

Patent Strategies – how early is too early?

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Britten Sessions

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Lincoln Law School of San Jose**

Disclaimer



The information presented in this presentation does not constitute legal advice.

Summary



1. What type of strategies can be implemented?
2. How to integrate strategies into a patent application?
3. How do strategies directly influence the value of your patent?
4. What are alternatives to patent development?
What other portfolio strategies exist?

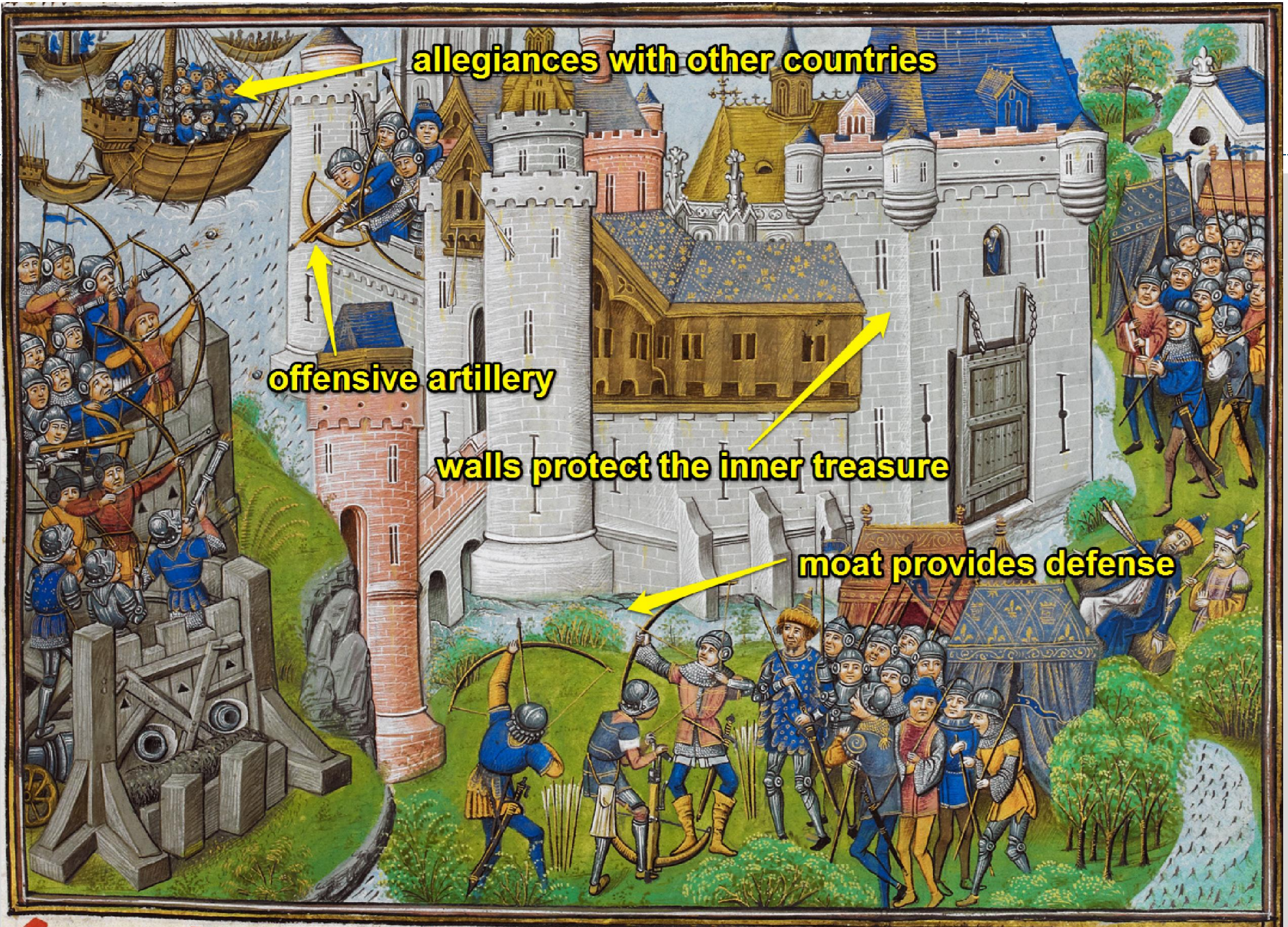
What type of strategies can
be implemented?

Patent Strategies



RULE #1: Simplicity Wins

- make sure that you communicate any and all of your patentable ideas (even the complex ones) in such a way that anyone can understand
- a lay jury will one day be the judge of your patent – keep that in mind as you describe your invention



alliances with other countries

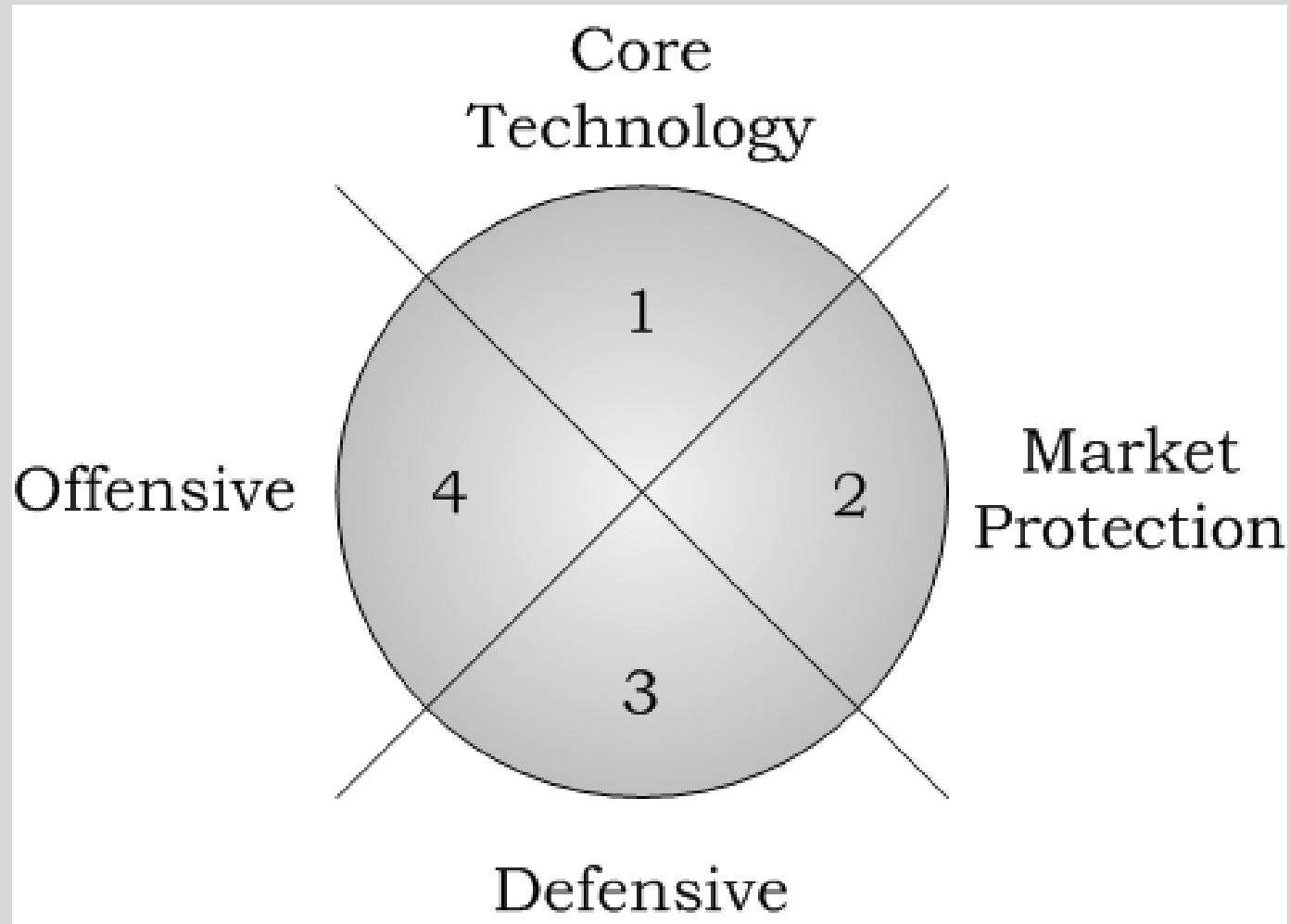
offensive artillery

walls protect the inner treasure

moat provides defense

http://upload.wikimedia.org/wikipedia/commons/8/88/Mortagne_siege.jpg (edited)

Types of Patent Strategies



Core Technology Patents

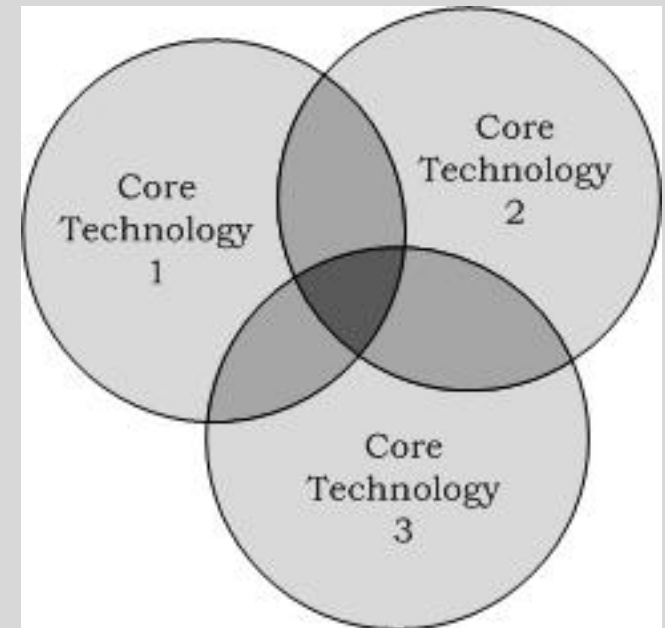


- Focus?
 - Protect the core invention
- How?
 - File multiple applications, each targeted at a different aspect of the core technology
 - File one main application, and spin off multiple continuations, each directed to a different aspect of the core technology
- Breadth of claim sets?
 - Narrow claims sets that protect the most core technology

Core Technology Patents



- Examples:
 - Mechanical invention
 - ✦ Windshield wiper
 - ✦ Parts to protect – 1) overall structure; 2) mechanical features; 3) novel process of construction
 - Software invention
 - ✦ Online application
 - ✦ Parts to protect – 1) specific algorithm; 2) user interface; 3) client-side interactions; 4) server-side interactions



Market Protection Patents



- Focus?
 - Describe where the market will be in 10 years
- How?
 - Think outside of the box
 - ✦ Would your invention work in a different environment?
Interaction with other devices? Network connectivity?
 - Very in depth specification

Market Protection Patents

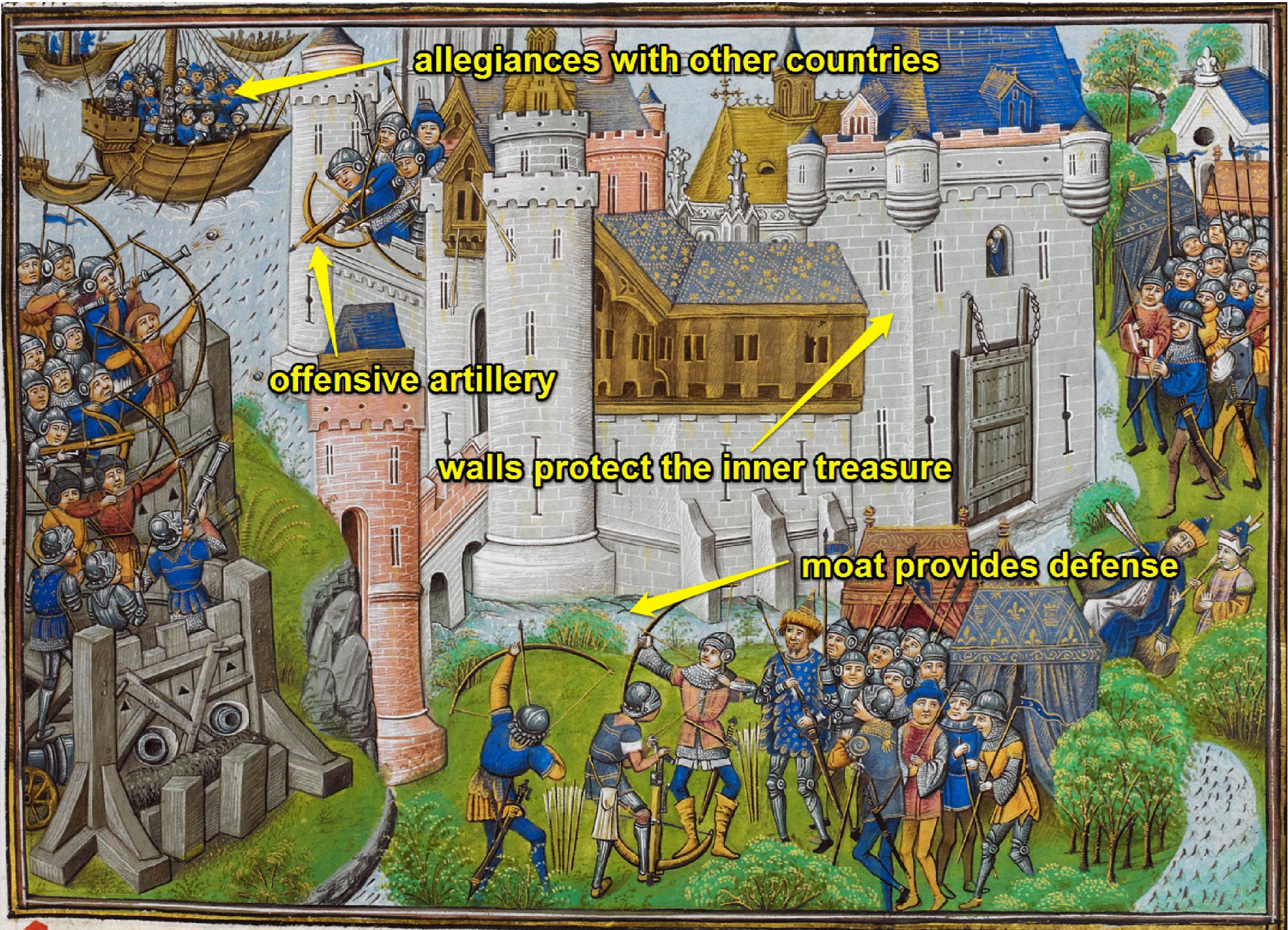


- Types?
 - Fence patents
 - ✦ fence in your competition OR extend your own fence (substitute or alterations of the original patent)
 - ✦ If your competitor has invented device A, file a patent that limits how the device may be function in the alternative OR, if you originally filed a patent on invention A, file one or more patents targeting alternatives of your invention
 - Design around patents:
 - ✦ If the competition has disclosed a circuit board with element A, a design around may include designing a similar circuit board but with element B
 - Keep at least one family member alive

Offensive/Defense Patents



- Focus?
 - Allow you to target infringing products
 - Allow you to protect yourself against assertions
- How?
 - Broad claims but sufficiently narrow
 - Broad specification



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Recap



- Core technology – protect the core invention
- Market protection – forward thinking
- Offensive – used by asserting
- Defensive – protect against competitors

- Takehomes:
 - A patent application can combine many of these strategies into one application
 - Claim sets provide you with the diversity of strategies

How to integrate strategies into a patent application?

Implementing Strategies



- Patent strategies focus on the USE of the patent
- Nonetheless, patent strategies influence HOW a patent specification and claims are written

Implementing Strategies

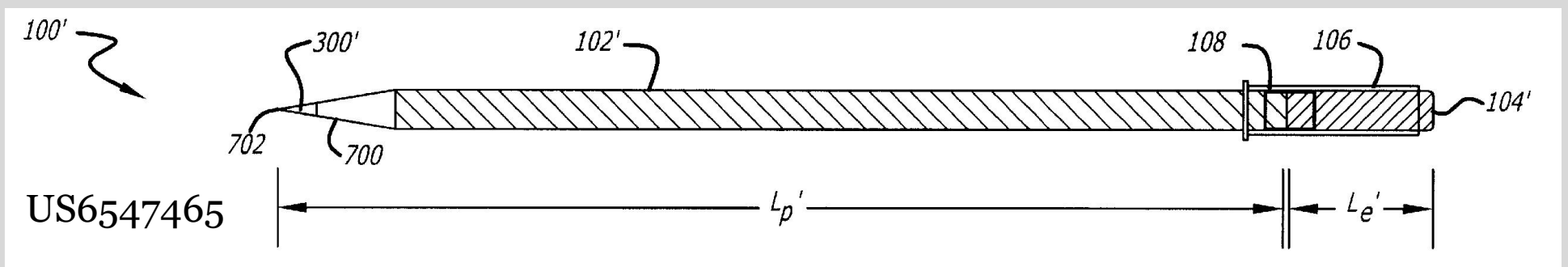


- **Claims**
 - A variety of claim sets
 - Narrow and broad; alternative designs
 - Clear language with good support in the specification
- **Specification**
 - Broad and deep specification which is forward thinking
 - Simple terminology with clear embodiments/examples
- **Keep your patent alive so that claims can be amended if needed**

Example



- How would you claim a pencil?
 - What are the parts or classes of your invention?
 - How do the parts connect?



Core Technology Claiming



- Strategy #1: Core Technology
 - Elements:
 - ✦ Writing instrument
 - ✦ Elongated cylindrical rod of graphite
 - ✦ Elongated hexagonal cylindrical rod of wood surrounding the graphite
 - ✦ Cylindrical aluminum cylinder extending from one end of the hexagonal rod, with a hollow interior portion
 - ✦ Cylindrical rubber erasure located inside the hollow interior portion
 - Remember to focus on a narrow claim

Core Technology Claiming



A writing instrument, consisting of:

- an elongated cylindrical rod consisting of graphite;

- an elongated hexagonal rod consisting of wood, the hexagonal rod surrounding an outer diameter of the cylindrical rod;

- a cylindrical aluminum cylinder extending from one end of the hexagonal rod and defining a hollow interior volume; and

- a cylindrical rubber erasure positioned in the hollow interior volume.

Offensive/Defensive Claiming



- How would we broaden the claimset?
 - Can we broaden the form (e.g. shape, structure, etc.)?
 - Can we broaden the composition (e.g. material, etc.)?

Offensive/Defensive Claiming



- “an elongated cylindrical rod consisting of graphite;”
 - Form: cylindrical, pyramidal, rectangular, star-shaped, elongated rods OR avoid the shape and focus on the form with respect to the structure (e.g. inner portion)
 - Composition: is it even needed?

Offensive/Defensive Claiming



- “an elongated hexagonal rod consisting of wood, the hexagonal rod surrounding an outer diameter of the cylindrical rod;”
 - Form: cylindrical, pyramidal, rectangular, star-shaped, elongated rods OR avoid the shape and focus on the form with respect to the structure (e.g. outer portion)
 - Composition: wood, metal, clay; is it even needed?

Offensive/Defensive Claiming



- “a cylindrical aluminum cylinder extending from one end of the hexagonal rod and defining a hollow interior volume; and a cylindrical rubber erasure positioned in the hollow interior volume.”
 - Form: does the shape matter?
 - Composition: what types of material can be used?
- Question:
 - Is the element even necessary?

Offensive/Defensive Claiming



A product, comprising:
an inner portion; and
an outer portion coupled to the inner portion;
wherein the inner portion is configured to mark
a surface in contact therewith.

Comparison of Claiming



CORE TECHNOLOGY CLAIM


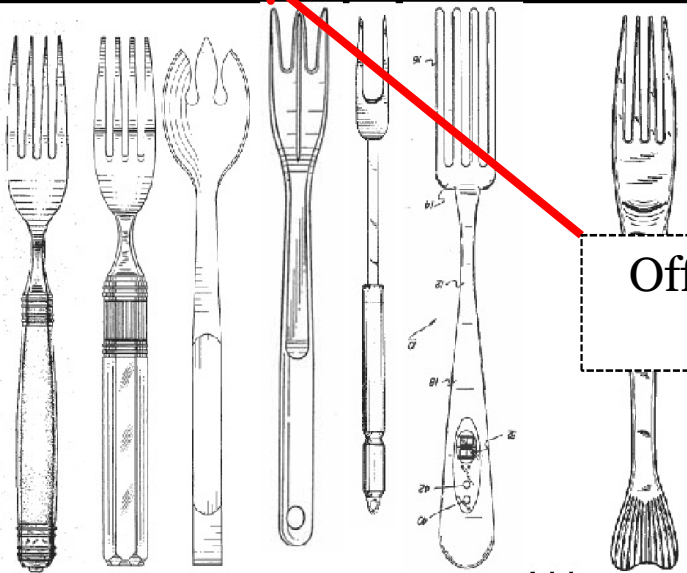
A writing instrument, consisting of:
 an elongated cylindrical rod consisting of graphite;
 an elongated hexagonal rod consisting of wood, the hexagonal rod surrounding an outer diameter of the cylindrical rod;
 a cylindrical aluminum cylinder extending from one end of the hexagonal rod and defining a hollow interior volume; and
 a cylindrical rubber erasure positioned in the hollow interior volume.

OFFENSIVE/DEFENSIVE CLAIM

A product, comprising:
 an inner portion; and
 an outer portion coupled to the inner portion;
 wherein the inner portion is configured to mark a surface in contact therewith.

Claim Strategies – Central v Peripheral



	Central Claiming	Peripheral Claiming
Claiming by Exemplar []		
Claiming by Characteristic	An instrument made out of sterling silver and having a handle attached to four prongs for piercing and carrying food	“An implement [having a handle attached to] two or more prongs,” used “for eating or serving food” or “for raising, carrying, piercing, or digging” ³⁵

Core Technology Claiming

Offensive/Defensive Claiming

Jeanne C. Fromer, “Claiming Intellectual Property,” The University of Chicago Law Review, Vol. 76 (2009), available at http://lawreview.uchicago.edu/sites/lawreview.uchicago.edu/files/uploads/76.2/76_2_Fromer.pdf.

Specification Strategies



- What have you invented?
 - Simply a wood writing device with graphite?
 - What if you used lead instead? What if you used ink?
 - What if you used it as a stylus on an input device?
- The specification should describe not only the core invention, but also all of the other ways in which it could be potentially implemented

Recap



- In implementing strategies, focus on:
 - Claim diversity
 - A deep, well thought out, and clearly described specification
 - Keep a family member alive if necessary

How do strategies
directly influence the value
of your patent?

Patent Value



STRATEGIES ARE PLANNED
APPS/CLAIMS ARE INFLUENCED



Portfolio Strategy

Breadth of the claims

Depth of prosecution process

File Wrapper Considerations

Live family members

STRATEGIES ARE IMPLEMENTED



Clear Showing of
Infringement

+

= Monetary Value