

Patent Prosecution Through the Eyes of a Patent Litigator

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Patent Prosecution Is Tough

- I have never seen a perfect patent.
- Clients often cannot predict which applications will be subject to litigation.
- Good patents claim “good” inventions.
- Good prosecution does improve litigation outcomes.
- But what is “good prosecution”?

Know the Real Invention

- Applications for significant inventions warrant:
 - Prior art searches done in advance
 - Disclosures written in English
 - Clear drawings
 - Multiple and differing claim sets
 - Interviews to overcome rejections
 - Continuation applications

Background of the Specification

- Rarely helpful, so keep it short
 - “Admitted prior art”
 - Avoid specific criticisms
 - *Gart*, 254 F.3d 1334 (Fed. Cir. 2001)
 - Use terms like “frequently” and “generally”
 - *Schindler Elevator*, 593 F.3d 1275 (Fed. Cir. 2010)

Means-Plus-Function Claims

- Use means-plus-function limitations.
 - Equivalents is a question of fact. *Applied Med. Res. Corp.*, 448 F.3d 1324, 1335 (Fed. Cir. 2006)
- But also use other claim types so precisely disclosed structure does not become “the invention.”
 - On remand, *Applied* jury found no infringement.

Is assembly required?

- Draft claims with potential defendants in mind with goal of direct infringement
 - *Cross Medical*, 424 F.3d 1293, 1306 (Fed. Cir. 2005) (“operatively joined”)
 - *Innova/Pure Water*, 381 F.3d 1111, 1118 (Fed. Cir. 2004) (“operatively connected”)
 - *Kinetic Concepts, Inc.*, 2012 WL 3264508 (Fed. Cir. 2012) (“operatively associated”)
- Determine if a “kit claim” is possible

Is mere capability enough?

- Draft claims knowing the states of the infringing device.
 - *Fantasy Sports*, 287 F.3d 1108, 1117 (Fed. Cir. 2002)
 - *Ball Aerosol*, 555 F.3d 984, 994 (Fed. Cir. 2009)
 - *Typhoon Touch Technologies, Inc.*, 659 F.3d 1376 (Fed. Cir. 2011)

Divided Infringement

- Draft claims that are directed to the operations or actions of a single entity.
 - *BMC Res., Inc.*, 498 F.3d 1373, 1380 (Fed. Cir. 2007)
 - *Muniauction, Inc.*, 532 F.3d 1318, 1328 (Fed. Cir. 2008)
 - *Golden Hour Data Sys.*, 614 F.3d 1367 (Fed. Cir. 2010)
- Inducement available, but that requires intent.
 - *Akamai Technologies, Inc.*, 2012 WL 3764695 (Fed. Cir. 2012)

Claimed Ranges

- Need to know the art
- Avoid arbitrary numerical ranges
- Explain the significance of claimed ranges
 - “Blaze marks” cases. Compare *Purdue*, 230 F.3d 1320, 1326 (Fed. Cir. 2000) with *In re Wertheim*, 541 F.2d 257, 265 (C.C.P.A. 1976).
 - “Negative pressure between .1 to .99 atm.”
 - *Kinetic Concepts, Inc.*, 2012 WL 3264508 (Fed. Cir. 2012)
- Enable full scope of claimed range
 - *MagSil Corp.*, 687 F.3d 1377 (Fed. Cir. 2012) (claimed at least 10% but specification only disclosed up to 11.8%).

Disclaimers and Estoppels

- Recognize what may become a disclaimer or estoppel
 - *Heuft Systemtechnik GmbH*, 282 Fed. Appx. 836 (Fed. Cir. 2008)
 - *Computer Docking Station Corp.*, 519 F.3d 1366 (Fed. Cir. 2008)
- Need to rescind prior arguments?
 - *Hakim*, 479 F.3d 1313 at 1316-18 (Fed. Cir. 2007)

Inequitable Conduct

- Highly unlikely to succeed
 - Clear and convincing evidence of:
 - (a) But-for materiality; and
 - (b) Specific intent to deceive.
 - *Therasense, Inc.*, 649 F.3d 1276 (Fed. Cir. 2011) (en banc)
- Often bartered away in exchange for willfulness

Inequitable Conduct Is Not The Concern

- Disclose everything!
 - Related prosecution; Ongoing litigation.
 - *McKesson*, 487 F.3d 897 (Fed. Cir. 2007)
 - *Mallinckrodt, Inc.*, 147 Fed. Appx. 158, 180 (Fed. Cir. 2005); M.P.E.P § 2001.06(c).
- Goal is not to avoid inequitable conduct
 - Goal is to strengthen validity
 - So non-disclosure is not a trial theme
 - So jury not instructed per *Microsoft v. i4i*.

Use of Continuation Applications

- **Maintain continuations!**
 - See *Mallinckrodt, Inc.*, 147 Fed. Appx. 158, 164 (Fed. Cir. 2005)
- **But never remove subject matter.**
 - *Lockwood*, 107 F.3d 1565 (Fed. Cir. 1997)

Final Thoughts

- Describe multiple embodiments
- Avoid “present invention”
- Some issues are simply panel dependent
 - *E.g.*, Claim construction: Reading claims “in light of specification” (*Lourie*) v. ordinary meaning (*Radar*)
- PTO does not always strictly apply Federal Circuit law
 - Analogous art post-*KSR*
 - Patentable subject matter

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