

US Utility Patents - Part 2: Best Practices

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Notices and Disclaimers

- Patent Kinetics specializes in Intellectual Capital Management including patent portfolio strategies and evaluating patent enforcement opportunities
- Link to [Part 1: US Utility Patents – The Basics](#)
- Bob Weber its Managing Director is not an attorney
- Nothing in this presentation is or shall be construed under any circumstances, by implication or otherwise, as giving legal advice and/or the practice of law.
- Always consult a registered patent attorney

Best Practices: How To Build Patent Value



Six Reasons Why Most Patents Are Worthless

1) Market didn't go there

2) Claims badly drafted or not drafted with damages in mind

1) Wrong targets (e.g., users rather than competitors), wrong type of claims, divided infringement, overly-broad claims

3) Leaving the prior art searching to the Patent Office

4) Failure to search the patent prior art

5) Failure to search the non-patent prior art

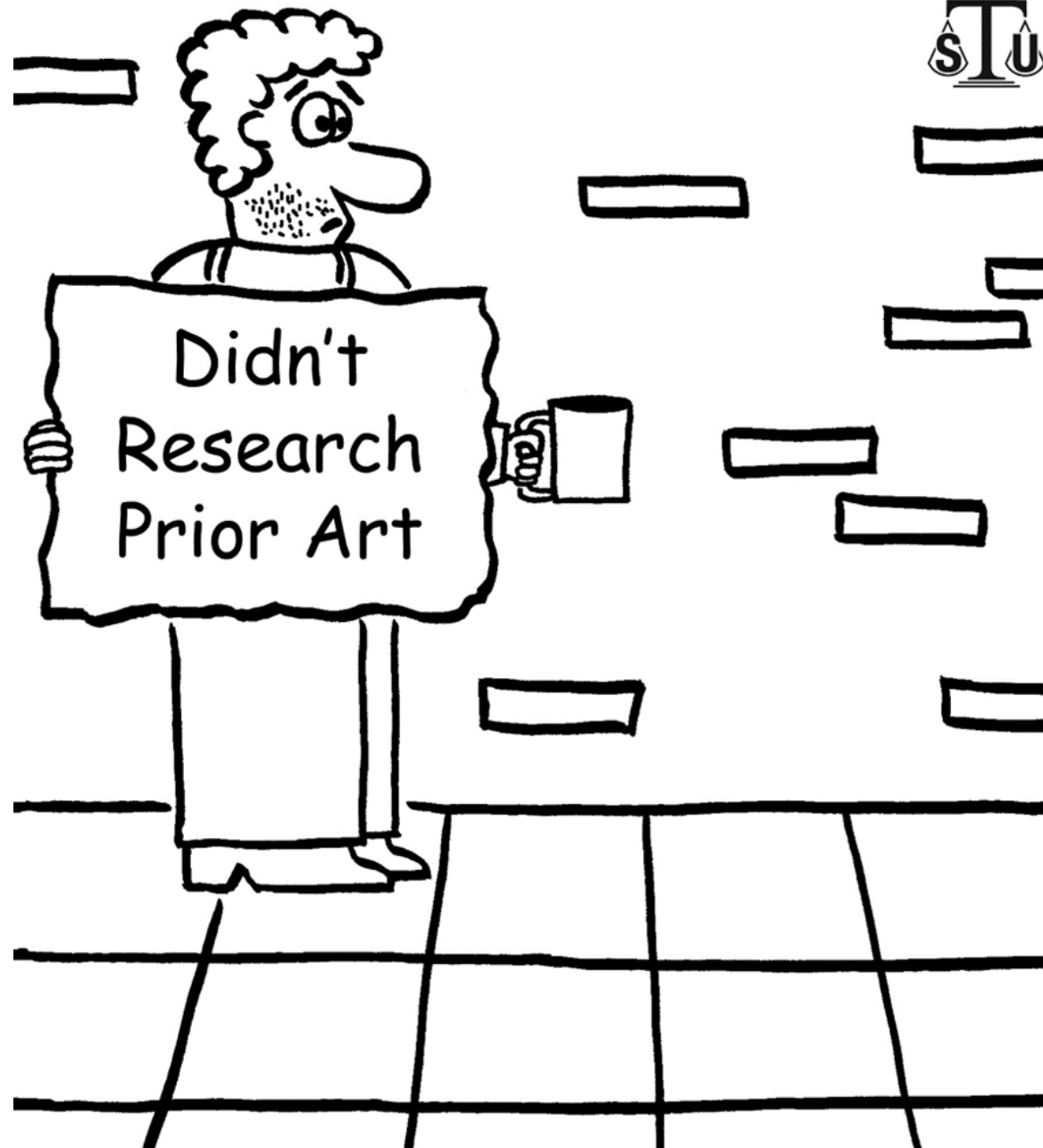
6) Not keeping the file open with a continuation application

1. No One Is Practicing The Invention

- **Entrepreneurial risk – happens all the time**
- **Patent owners failed to commercialize**
 - No market uptake
 - Failure to raise the next (first) round
- **No one else is practicing the invention(s)**
- **The products evolved and the claims did not**
- **Pivot or chalk it up to experience and move on**

2. The Claims Are Unenforceable

- Claims “define in technical terms the extent i.e., the scope of the protection conferred by a patent.”
- Example claim problems
 - Claims too narrow
 - Claim elements A+B+C+D+E
 - Infringement requires that all claim elements be practiced usually by a single entity
 - A+B+C+D doesn't infringe
 - One party does not practice all claim elements
 - So-called “divided infringement claims”
 - A+B+C+D practiced by one entity E practiced by another
 - Often solved by better claim drafting



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What IS Prior Art?

- **“Prior art constitutes those references or documents which may be used to determine novelty and/or non-obviousness of claimed subject matter in a patent application”**
 - Printed documents
 - Patents and published patent application (domestic and foreign)
 - Non-Patent Literature: magazine articles newspaper articles, electronic publications, on-line databases, websites or Internet publications (MPEP 2126-2128)
- **Evidence of public use or on sale**
- **Otherwise available to the public**
 - an oral presentation at a scientific meeting
 - a demonstration at a trade show
 - a lecture or speech
 - a statement made on a radio talk show
 - a YouTube video website or other on-line material (this type of disclosure may also qualify as a printed publication)

See this PTO presentation: <https://www.uspto.gov/sites/default/files/documents/May%20Info%20Chat%20slides%20%28003%29.pdf>

3-4-5: Failure to Search the Prior Art

- **3. Leaving the searching to the patent examiner**
 - Patent dead on arrival in almost all cases
- **4. Failure to search the patent prior art**
- **5. Failure to search the non-patent prior art**

- **Inventors are NOT required to search for prior art**

- **Inventors ARE required to tell the patent office about prior art that they know about**
 - Failure to do this is often considered “inequitable conduct” and is grounds for invalidating a patent if litigated

- **For continuation applications, the examiner is supposed to take into account prior art cited in prior applications:**
 - Manual of Patent Examining Procedure (MPEP) 2001.06(b): "If the application under examination is identified as a continuation, divisional, or continuation-in-part of an earlier application, the examiner will consider the prior art properly cited in the earlier application. See MPEP Â§ 609 and MPEP Â§ 719.05, subsection (II)(A), example J. The examiner must indicate in the first Office action whether the prior art in a related earlier application has been reviewed. Accordingly, no separate citation of the same prior art need be made in the later application, unless applicant wants a listing of the prior art printed on the face of the patent."

Best Practice: Searching Matters Because

- **May indicate seriousness of purpose or strategic intent**
- **Find as many references as possible**
 - Remember to search with synonyms
- **Fillable IDS forms available from the USPTO [here](#)**
- **However, not all patent attorneys agree**
 - May create a roadmap for invalidity challenges
 - Additional expense especially for startups, independent inventors

Many Useful Free Online Tools – Some examples:

- **The USPTO patent search**
 - <https://ppubs.uspto.gov/pubwebapp/>
- **Google patents – some prior art presented**
 - patents.google.com
- **The European Patent Office database**
 - worldwide.espacenet.com/?locale=EN_ep
- **WIPO Database**
 - www.wipo.int/patentscope/search/en/search.jsf
- **Sumo Patents (charges for paper copies)**
 - www.sumobrain.com/quick_search.html
- **The Internet Archives**
 - www.archive.org/web/web.php
- **DuckDuckGo – doesn't record your searches**
 - www.duckduckgo.com

Best Practice: File Utility Applications Track 1

- **Prioritized examination - within one year**
- **Depending on the year allowance rates for Track 1 range from 50% to 84%**
- **Fees advantageous for individuals small entities**
 - The fees for large, small and micro entities (as of the filing date)
 - \$4000 \$2000 or \$1000
- **You and your attorney need to respond to office actions on a timely basis**
 - Loose Track 1 status if:
 - the applicant files a request for an extension of time for anything;
 - once a “final” office action is sent by the USPTO;
 - applicant files an Request for Continued Examination (RCE);
 - applicant files an appeal; or
 - applicant amends the application to have in excess of 4 independent claims and 30 dependent claims.
- **Consult a registered patent attorney for additional information**

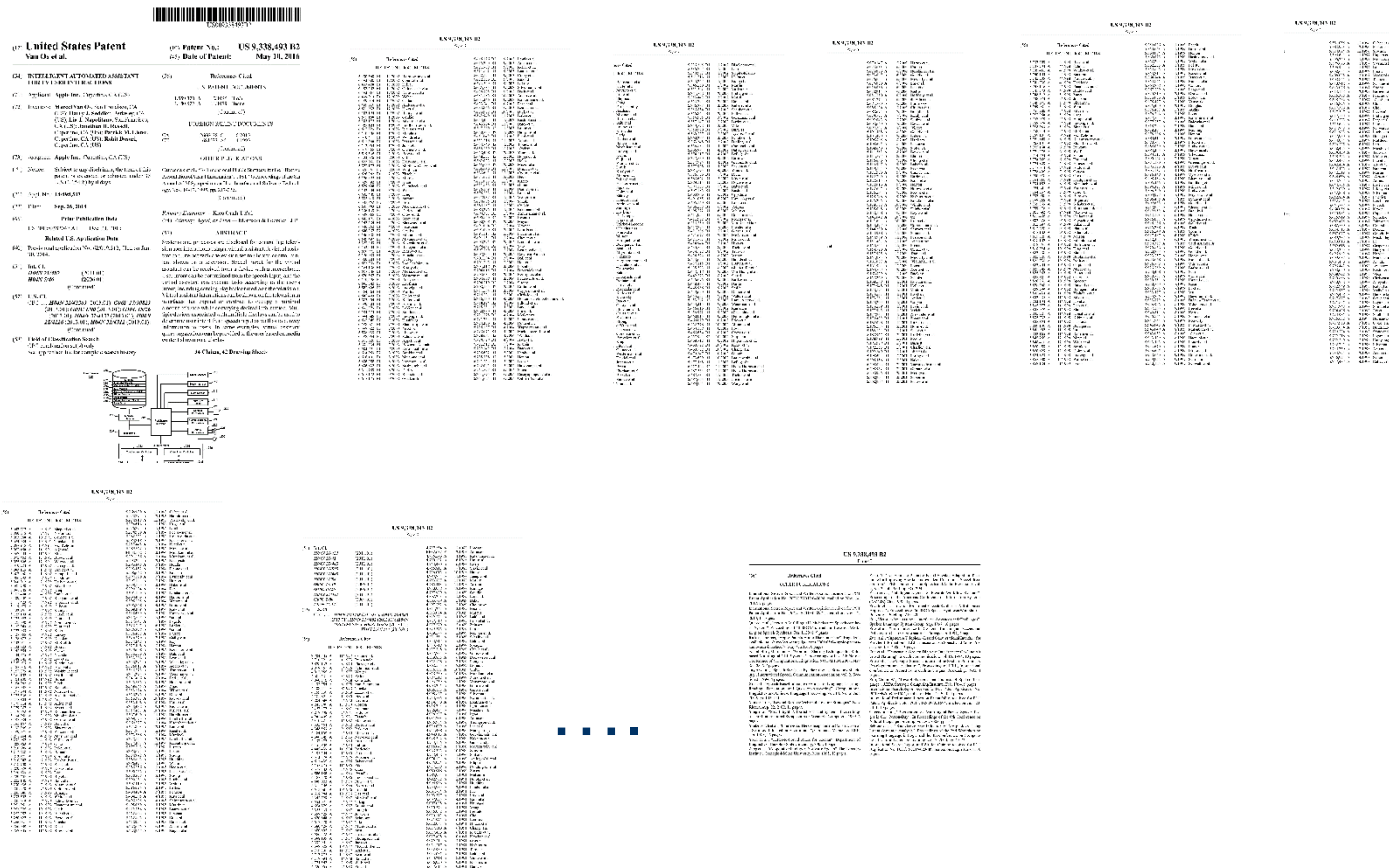
Best Practice: Keep the File Open With A Continuation Application

- **Before an allowed patent issues file a continuation application based on the same specification**
 - File continuations Track 1
- **Allows one to tailor claims to evolving (competitor) products or services in the marketplace**
 - Also to correct mistakes
- **Is an implied threat (and opportunity) since the allowed claims may not “read” precisely on an evolving competitor product / service**
- **Remember to search the new claims 😊**

Report Prior Art In One Or More Information Disclosure Statements (IDSs)

- **Some patent attorneys are concerned that an extensive list makes it easier for defendants to challenge patent validity in an Inter Partes Review**
- **In-depth searching indicates**
 - seriousness of purpose
 - strategic intent to defend and possibly assert one's patents
 - May be used to create substantial Applicant Admitted Prior Art as a defensive strategy
 - More about this later in this presentation
- **Compare Apple's "Intelligent automated assistant for TV user interactions" patent (US 9338493) with the garden variety Apple patent**
 - (See next slides)

Apple US 9338493 - 46 Pages Of References – Patent And Non-patent Art



Title: “Intelligent automated assistant for TV user interactions”

Lots of references in part because of the different technologies combined to form the claimed inventions

Apple seems to put fewer resources into patents that appear to be non-strategic – see next slide

For its time the original iPod patent had a large number of prior art citations suggesting its strategic importance to Apple

Apple US 8375312

Example “garden variety” Apple Patent



(12) **United States Patent**
Marinkovich et al.

(10) **Patent No.:** US 8,375,312 B2
(45) **Date of Patent:** Feb. 12, 2013

(54) **CLASSIFYING DIGITAL MEDIA BASED ON CONTENT**

(75) **Inventors:** Mike Marinkovich, Santa Clara, CA (US); Greg Lindley, Sunnyvale, CA (US); Alan Cannistraro, San Francisco, CA (US); Evan Doll, San Francisco, CA (US); Gary Johnson, San Jose, CA (US)

(73) **Assignee:** Apple Inc., Cupertino, CA (US)

(*) **Notice:** Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 1228 days.

(21) **Appl. No.:** 11/760,720

(22) **Filed:** Jun. 8, 2007

(65) **Prior Publication Data**
US 2008/0307337 A1 Dec. 11, 2008

(51) **Int. Cl.**
G06F 3/00 (2006.01)
G06F 3/048 (2006.01)

(52) **U.S. Cl.:** 715/762; 715/764; 715/804; 715/833; 715/846; 715/848; 715/768

(58) **Field of Classification Search** 715/762, 715/764, 804, 833, 846, 848
See application file for complete search history.

(56) **References Cited**

U.S. PATENT DOCUMENTS

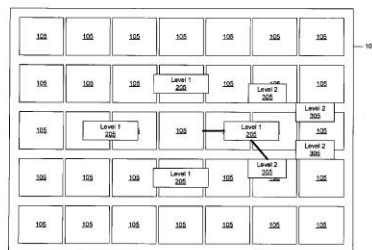
5,671,381 A * 9/1997 Stranick et al. 715/848
5,694,176 A * 12/1997 Bonette et al. 725/43
5,835,094 A * 11/1998 Ernel et al. 715/848
6,028,603 A * 2/2000 Wang et al. 715/776
6,160,554 A * 12/2000 Kenise 715/804
6,208,344 B1 * 3/2001 Holzman et al. 715/846
6,253,218 B1 * 6/2001 Aoki et al. 715/201
6,326,988 B1 * 12/2001 Gouid et al. 715/850

Primary Examiner — Steven B Thieriault
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(57) **ABSTRACT**

A computer-implemented method for classifying digital content can include displaying one or more poster frames in a user interface, wherein a poster frame corresponds to an item of digital content, displaying one or more first level classification panes adjacent to a poster frame corresponding to an item to be classified, wherein a first level classification pane is associated with a keyword, and enabling a user to associate a poster frame with a first level classification pane to cause the keyword associated with the first level classification pane to be associated with the item to which the poster frame corresponds.

22 Claims, 4 Drawing Sheets



US 8,375,312 B2
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U.S. PATENT DOCUMENTS

2005/019292A A1* 9/2005 Drucker et al. 707/1
2005/0246331 A1* 11/2005 De Vorechik et al. 707/3
2006/0069098 A1* 3/2006 Artman et al. 715/721
2009/0063552 A1* 3/2009 Jones 707/102

7,672,950 B2* 3/2010 Eckardt et al. 707/999.01
7,716,604 B2* 5/2010 Katoaka et al. 715/835
7,769,745 B2* 8/2010 Naaman et al. 707/715
2003/0126212 A1* 7/2003 Morris et al. 709/205
2004/0213553 A1* 10/2004 Nagahashi 386/69

* cited by examiner

Title: “Classifying digital media based on content”

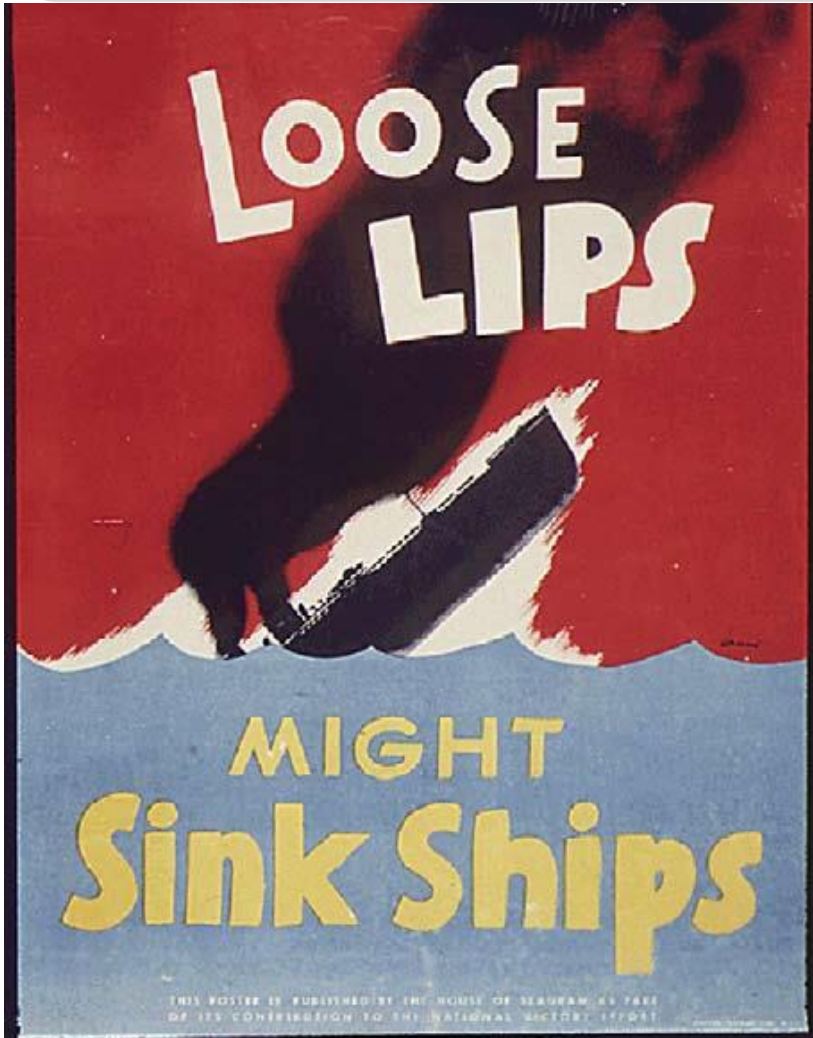
Report Prior Art In One Or More Information Disclosure Statements (IDSs)

- **Fillable IDS forms available from the USPTO [here](#)**
- **The examiner will review the IDS and indicate which entries are not acceptable because of certain formalities, e.g.:**
 - No date of publication
 - No URL for web non-patent documents
 - No English translation of documents not in English

Best Practice: Consider Foreign Filings

- **The US patent system may not be fixed anytime soon**
- **Despite costs, filing abroad is becoming an important patent strategy for large companies and some smaller entities as well**
 - Filings in Germany the UK and China May be more attractive than filing only in the USA
 - A patent owner can get an injunction in Germany the UK and maybe in China
 - Raises portfolio development costs substantially
 - China expensive because of translation costs
 - Going international clearly raises cost-benefit issues especially for startups
- **If resources are available, consider filing more broadly**
 - Countries in which competitors do business
 - Countries with the largest markets for your products / services

Best Practice: Avoid Prior Disclosure – The On-sale Bar



- Disclosing your invention without an NDA before filing a patent application: you lose your foreign patent rights immediately and your US patent rights in most scenarios
- Offering your invention for sale or license – even under an NDA – before filing a patent application: subsequently issued patent likely invalid
- Still evolving areas of US patent law
- Consult a registered patent attorney

Best Practice: Work With A Registered Patent Attorney



- Even if you draft a patent application yourself have a registered patent attorney provide feedback
- Better to have the patent attorney draft the final version and handle interactions with the USPTO
- Best not to talk with USPTO yourself

However: Some Patent Attorneys Are Occasionally Part Of The Problem

- **Numerous patent attorneys have told me that their job is getting a patent issued (regardless of quality)**
 - Creates a version of “the Dancing Dog Problem:” the dog dances but not very well
- **Some patent attorneys recommend not doing prior art searches**
 - Among the key mistakes that lead to worthless patents
 - Inventors and patent owners can do much of this themselves
 - Usually worth the time and effort
 - Many free tools (noted above)
- **Patent quality is key to higher patent value**

Best Practice Recommendations

- **Try to anticipate where the market will be in 2-5 years**
 - Envision the invention broadly
 - Think about alternative “embodiments” of the invention
 - Can tweak the claims as the market evolves through claim amendments and/or with continuation applications.
- **File US Utility Applications Track 1 – effective for individuals and small entities**
- **Draft claims with potential damages in mind**
 - Might prefer apparatus claims to method claims when possible
- **Make sure its possible and likely for one party (a competitor) to infringe the claims**
- **Search extensively especially for computer and communications related patent applications**
- **Consider replacing any patent attorney who recommends not searching the patent and non-patent prior art**
- **Keep the file open with continuing applications**

Acknowledgements and Disclaimers

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About Patent Kinetics and Bob Weber

- Based on more than two decades of practical experience, Patent Kinetics, LLC helps patent owners, inventors and investors get a financial return on their substantial investments in R&D. We specialize in patent portfolio strategy and implementation and in enforcement opportunity evaluation mainly in the electrical and mechanical technology domains.
- Bob Weber is an intellectual property professional, inventor, serial entrepreneur, senior executive, and management consultant. Weber is an inventor with 27 issued US patents and a number of foreign counterparts. Weber is a member of the Silicon Valley Chapter of the Licensing Executives Society 2010-2022 and has served on the chapter's Board of Directors and Program Committee. In Boston, he has served on the Advisory Board of the Boston Entrepreneurs Network ("ENet") where he was Vice Chair, Programs 2005-2005. On occasion, Weber has also co-organized and moderated ENet's "Legal Issues for Entrepreneurs" meetings.

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The End

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Muchas gracias

Domo arigato

Dank u

Danke schoen

Thank you