



# **IMPORTANCE OF PATENT DRAFTING FOR INNOVATION AND COMMERCIALISATION**

Topic 10

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# “INNOVATE OR DIE”

Tom Peters, an American writer on business management practices, best known for “In Search of Excellence”



# KEEP INNOVATING – CONSIDER FILING A PATENT FOR EACH NEW IMPROVEMENT

- The initial invention – a 20 year patent term
  - eg, the incandescent light bulb
- Second generation improvement – a new 20 year patent term
  - eg, the fluorescent light bulb
  - do not rely on belief that the first patent for the initial invention will protect the improvement
  - assess initial patent for scope each time an important improvement is made
- Even if the first patent does cover the improvement, consider filing a new patent
  - yes, it may be narrower in scope but it will get a new 20 year term of protection
  - this means that at the end of the 20 year term for the first patent, the improvement is still protected

# COMMERCIALISATION AND PATENT DRAFTING

- What is the commercialisation strategy?
  - on your own
  - sale
  - licensing and cross-licensing
  - hybrid of the above
- Like any communication, keep in mind who the audience/reader of the patent specification will be
- Sometimes this is hard to know when you are drafting a patent
  - business and innovation commercialisation strategy needs to remain flexible
- Ultimately the purpose of the patent specification is litigation. It may never get there but...



# DRAFTING OF THE PATENT SPECIFICATION: THINK ABOUT THE FUTURE

- Initial specification (e.g., provisional) can be broad but should include as much detail as possible
- 12 months later, the complete (PCT) specification needs to be filed
  - the content of this is final; you cannot add new matter
- In Europe and many other countries the patent offices are very strict about claim language and subsequent amendment
  - usually you cannot broaden the scope of the patent after grant, you can only narrow it
- Ensure basic requirements are present
  - support, utility, industrial applicability
- After the complete specification is filed (during prosecution) remain very careful with amendments
  - claim amendment can be tough to get approved
  - prosecution history estoppel

# INFRINGEMENTS

- Keep in mind who the infringement targets will be
  - where, how, why
- Ensure you have claim language that can be used against infringers
- Patent can be infringed by:
  - use
  - sale
  - manufacture
- Various types of claims
  - method claims
  - system claims - where in infringement are they occurring? Blackberry
  - product by process claims
  - apparatus claims
- Contributory infringement
- Would you want to sue companies that are also your customers?

# PRIOR ART – THE FEAR OF THE UNKNOWN

- Prior art can come in different formats
  - prior use
  - prior publication, including your own!!!
- Why is it relevant?
- Crystal ball
  - unknown prior art is one of the main reasons why a patent specification is drafted to be long
  - to provide flexibility when the scope of the claims is being challenged (eg, during patent office exam or by competitor)
- Divisional filings to keep options alive
  - get a scope of protection granted for what looks okay
  - to pursue different claims



# EXAMPLES OF WHEN IT GOES WRONG

- Chef America, Inc. v. Lamb-Weston, Inc.
- Kustom Signals, Inc. v. Applied Concepts, Inc.
- Bayer AG v. Elan Pharmaceuticals Research Corp.
- Pharmacia & Upjohn Co. v. Mylan Pharm., Inc.



# PRACTICAL EXERCISE

# PATENT TACTICS

- Bracketing or patent thickets
- Defensive publication
- Be aggressive in using your patent when it is infringed
- Don't forget trade secrets
  - sometimes these go hand in hand with patent protection



# CONCLUSION

- In writing a patent specification it is very important for the attorney to really understand the invention. If the attorney does not understand the invention and appreciate the subtleties of the technology, the attorney cannot write a good specification.
- In addition, the attorney needs to understand the business model. A patent for licensing is different from a patent that protects an invention from being copied, which is different from a patent that is part of a large portfolio.
- Use a patent attorney with the right technical background to draft the patent specification and to guide it through examination.
- Do not contradict your arguments during examination in one country to your arguments in another country for the same patent family.