

# FISH IP LAW

## STRATEGIC PATENTING JANUARY 2018

# BEST PATENT PRACTICES - USA

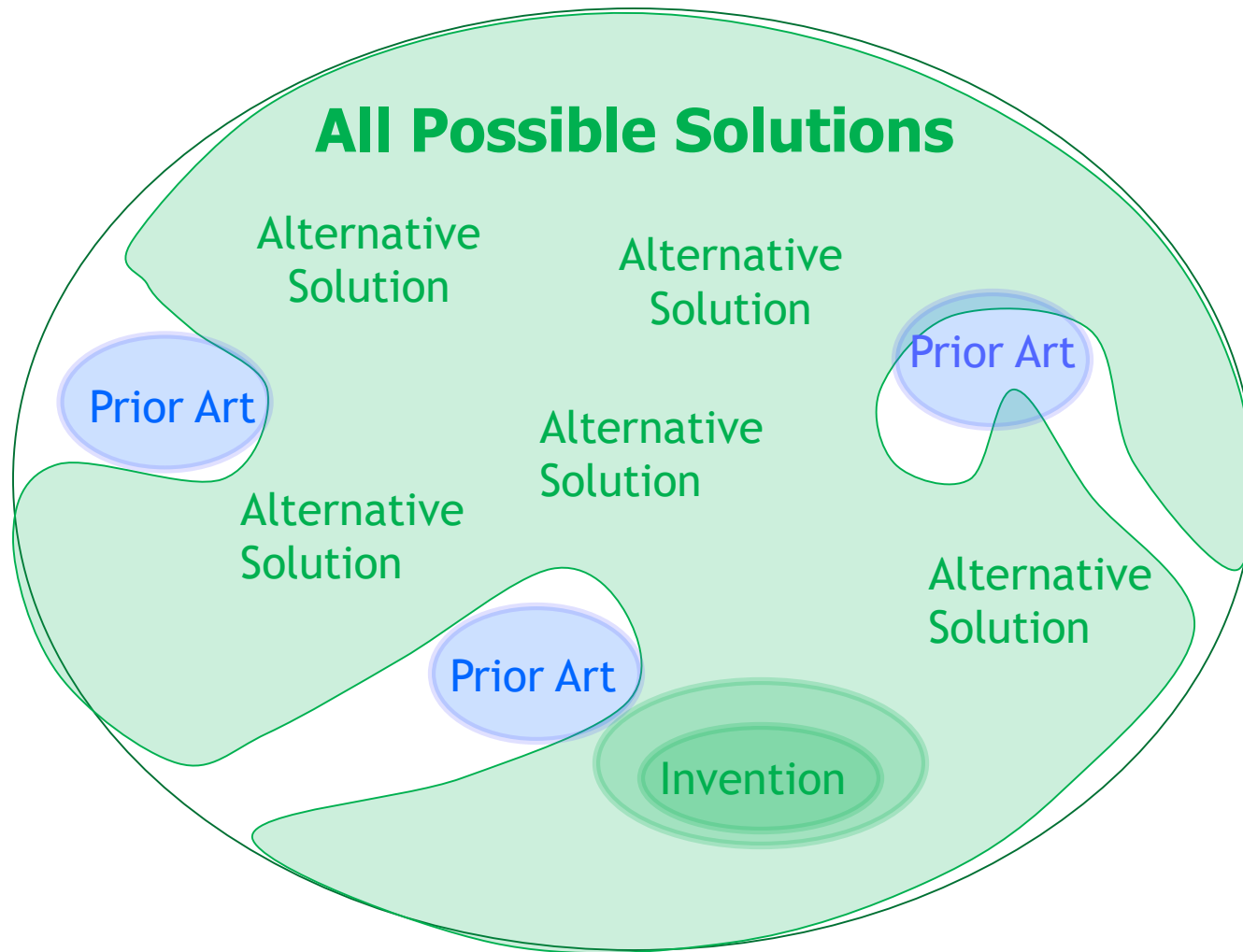
- ◎ Claim From A Marketing Perspective
  - ◎ Eliminate Unnecessary Elements
  - ◎ Reduce Invention to It's Essence
  - ◎ Use Tautologies
  - ◎ Consider Evolution Of Technologies
  - ◎ Block Competitor Evolution
- 
- ◎ Current Cases

# CLAIM FROM A MARKETING PERSPECTIVE

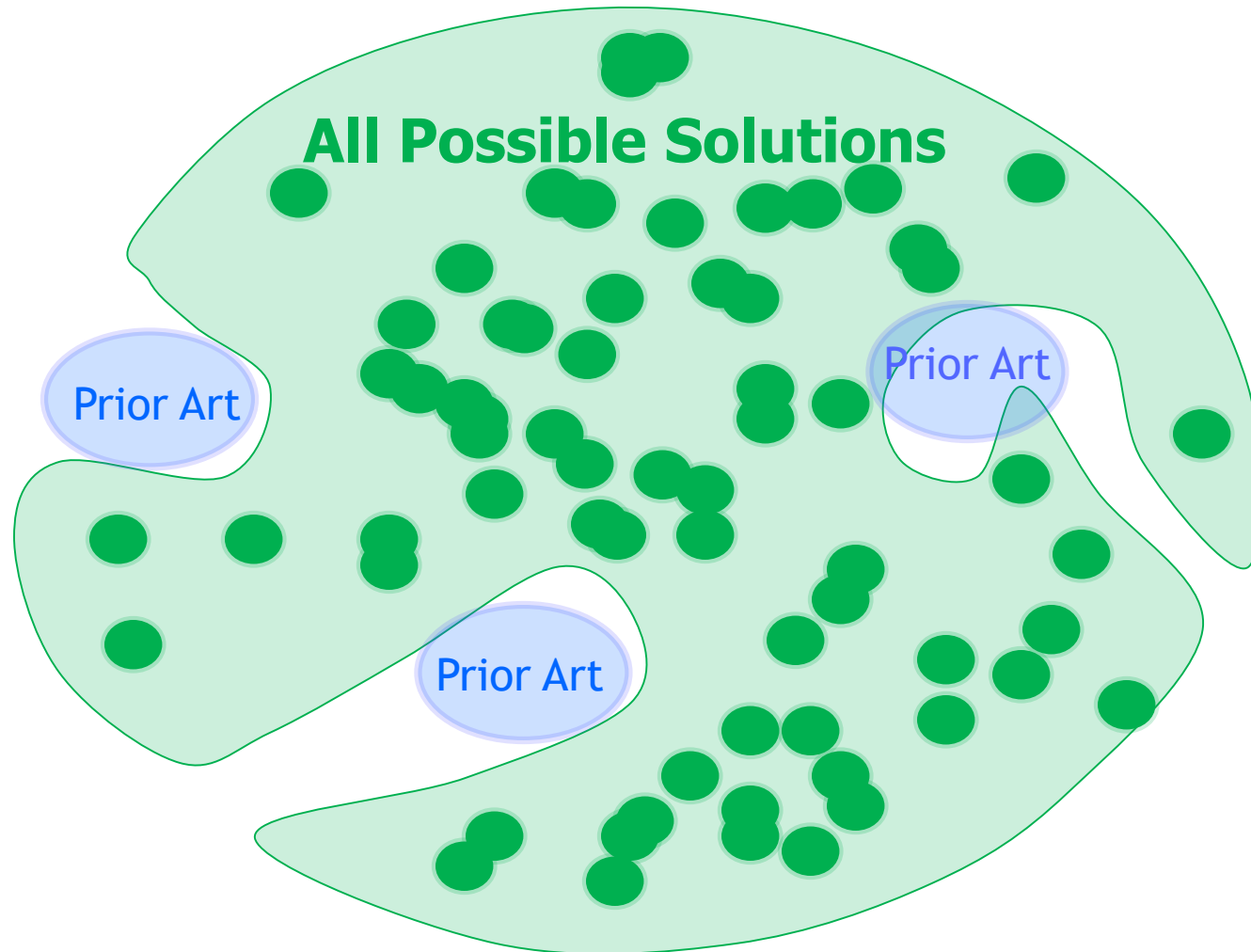
The question should not be  
“what did you invent?”

The question should be  
“what do you want to stop the  
competitors from doing?”

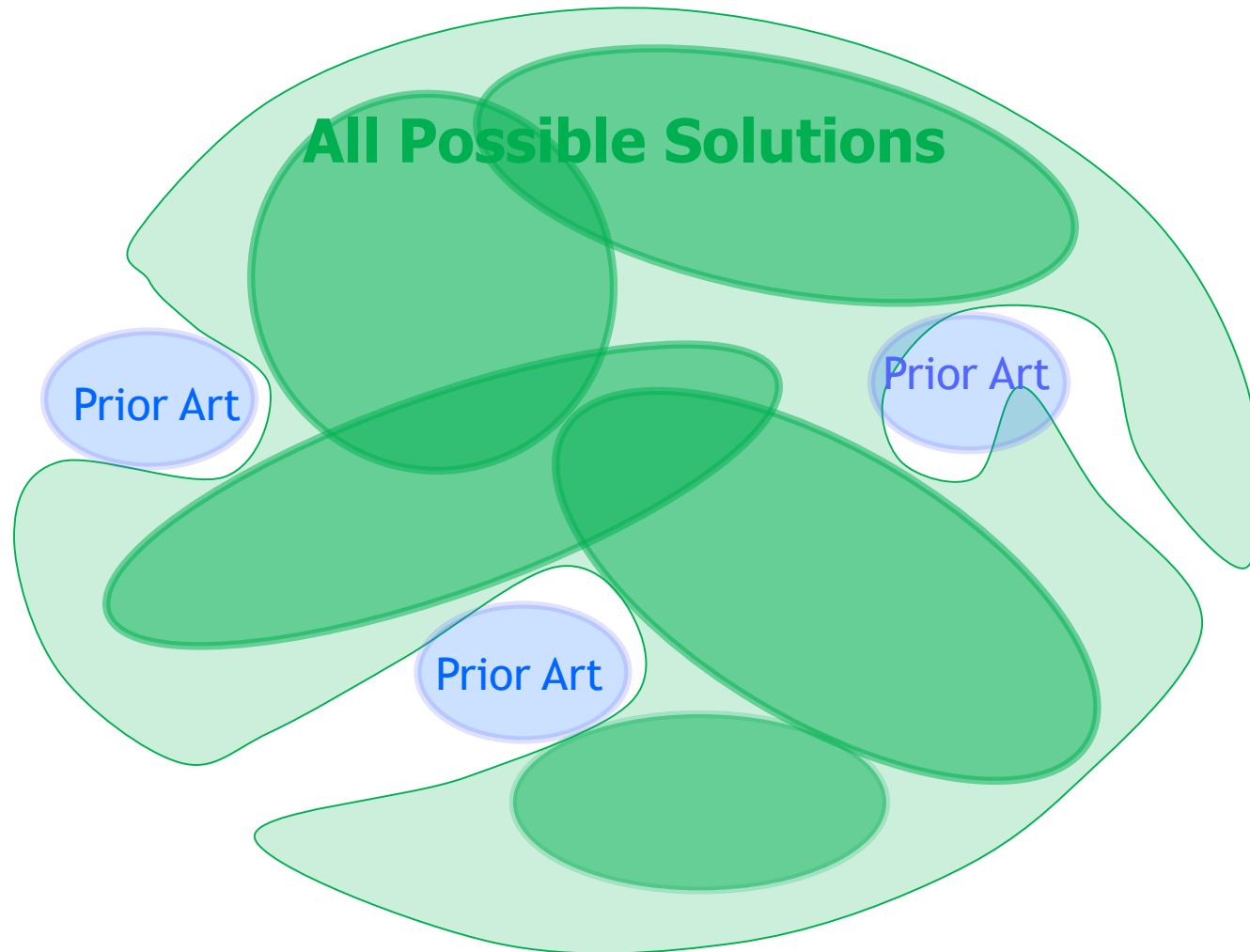
# CLAIM FROM A MARKETING PERSPECTIVE



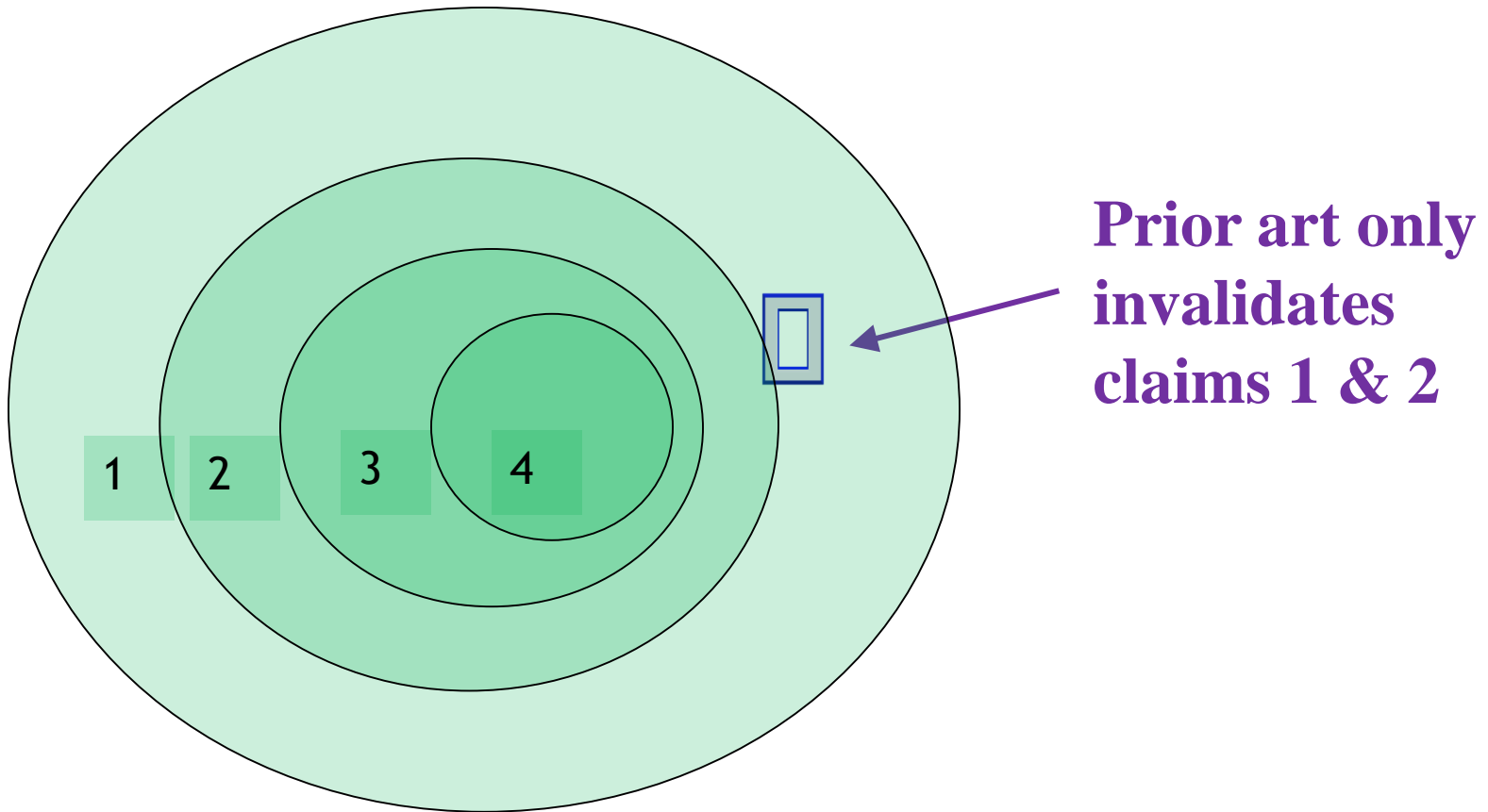
# NARROW CLAIMING APPROACH TO COVERING THE MARKETPLACE



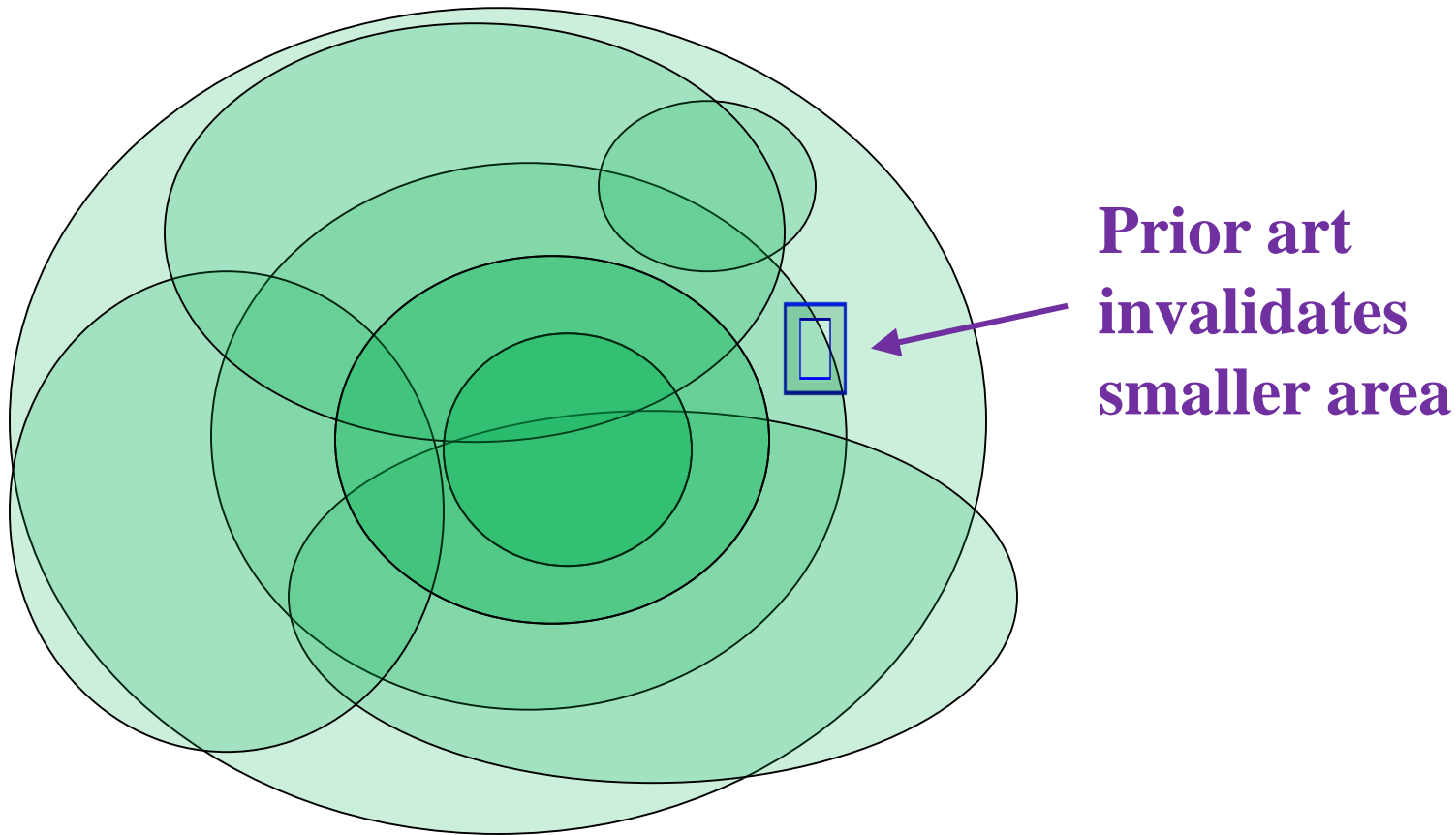
# BROAD CLAIMING APPROACH TO COVERING THE MARKETPLACE



# TARGET CLAIMING TO COVER THE MARKETPLACE



# OVERLAPPING TARGET CLAIMING IS BETTER COVERAGE





# ELIMINATE UNNECESSARY ELEMENTS

## Chair Example

A chair having:

- a flat seat;

- a vertical back;

- four legs; and

- the seat, back, and legs held together by nails.

# ELIMINATE UNNECESSARY ELEMENTS

## Chair Example

- ⦿ Seat doesn't have to be flat
- ⦿ Back doesn't have to be vertical
- ⦿ Chair could be said to have “at least two” legs
- ⦿ Chair could be held together with screws, bolts, dowels, etc.

# ELIMINATE UNNECESSARY ELEMENTS

## Bad Claim

A chair comprising:

- a flat seat;
- a vertical back;
- four legs; and
- the seat, back, and legs held together by nails, screws, bolts or dowels.



## Good Claim

A chair comprising:

- a seat;
- a back;
- at least two legs; and
- the seat, back, and legs held together by connectors.

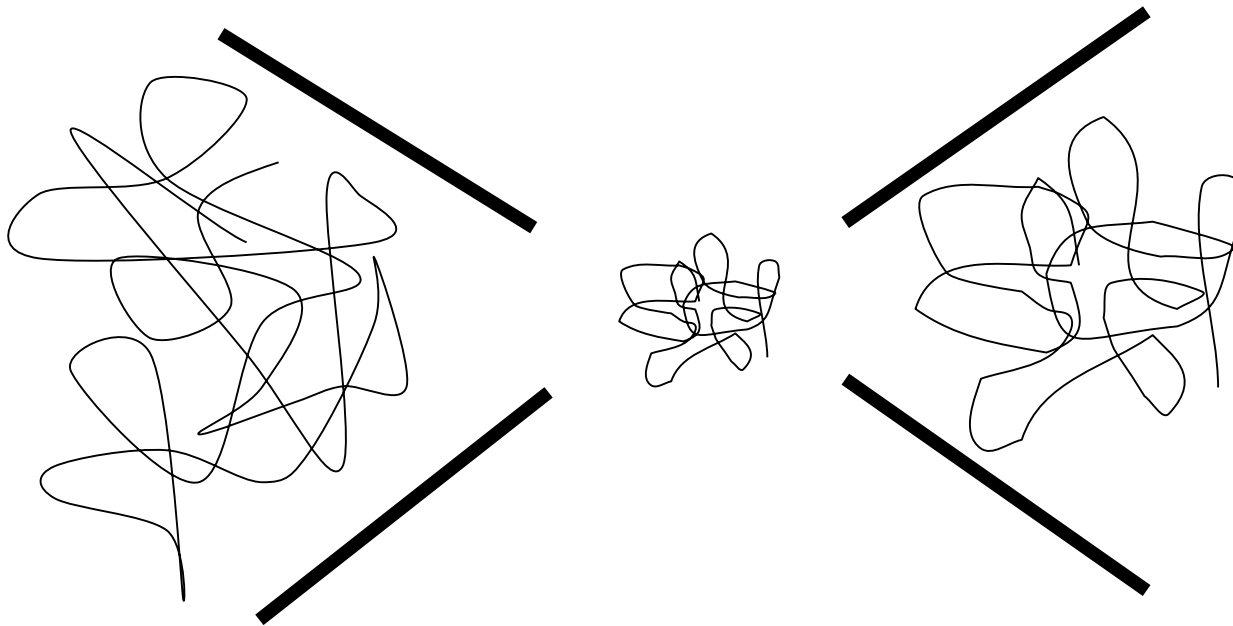
# ELIMINATE UNNECESSARY ELEMENTS

## TWO LEGGED CHAIR?



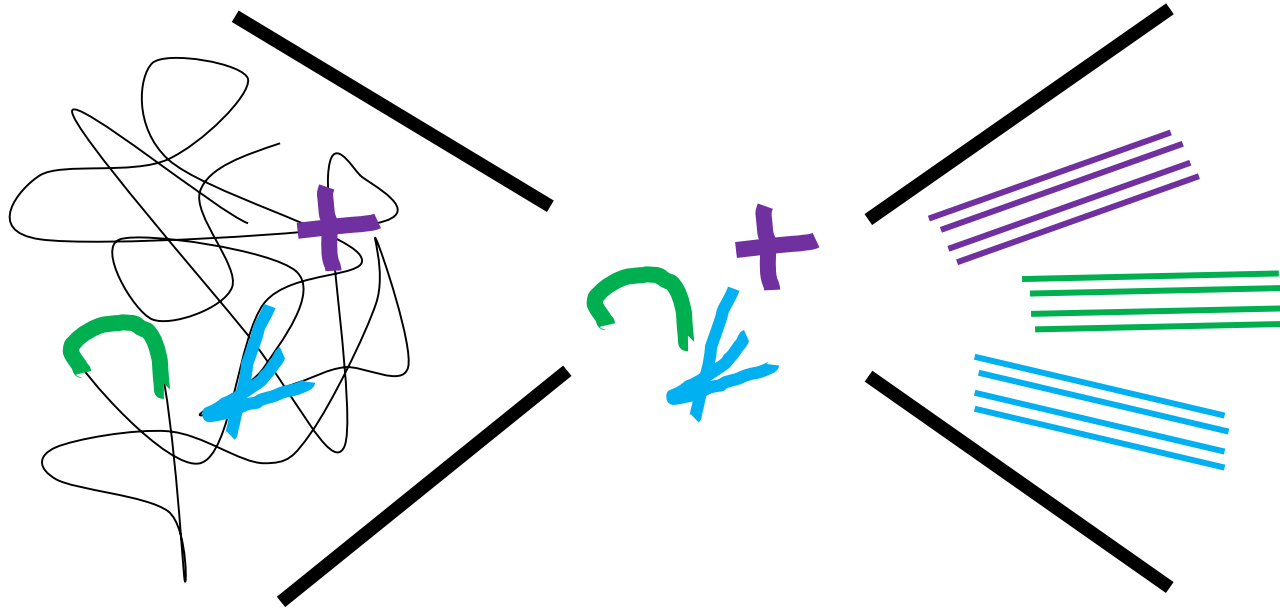
# REDUCE INVENTION TO IT'S ESSENCE

## Bad Claiming Practice

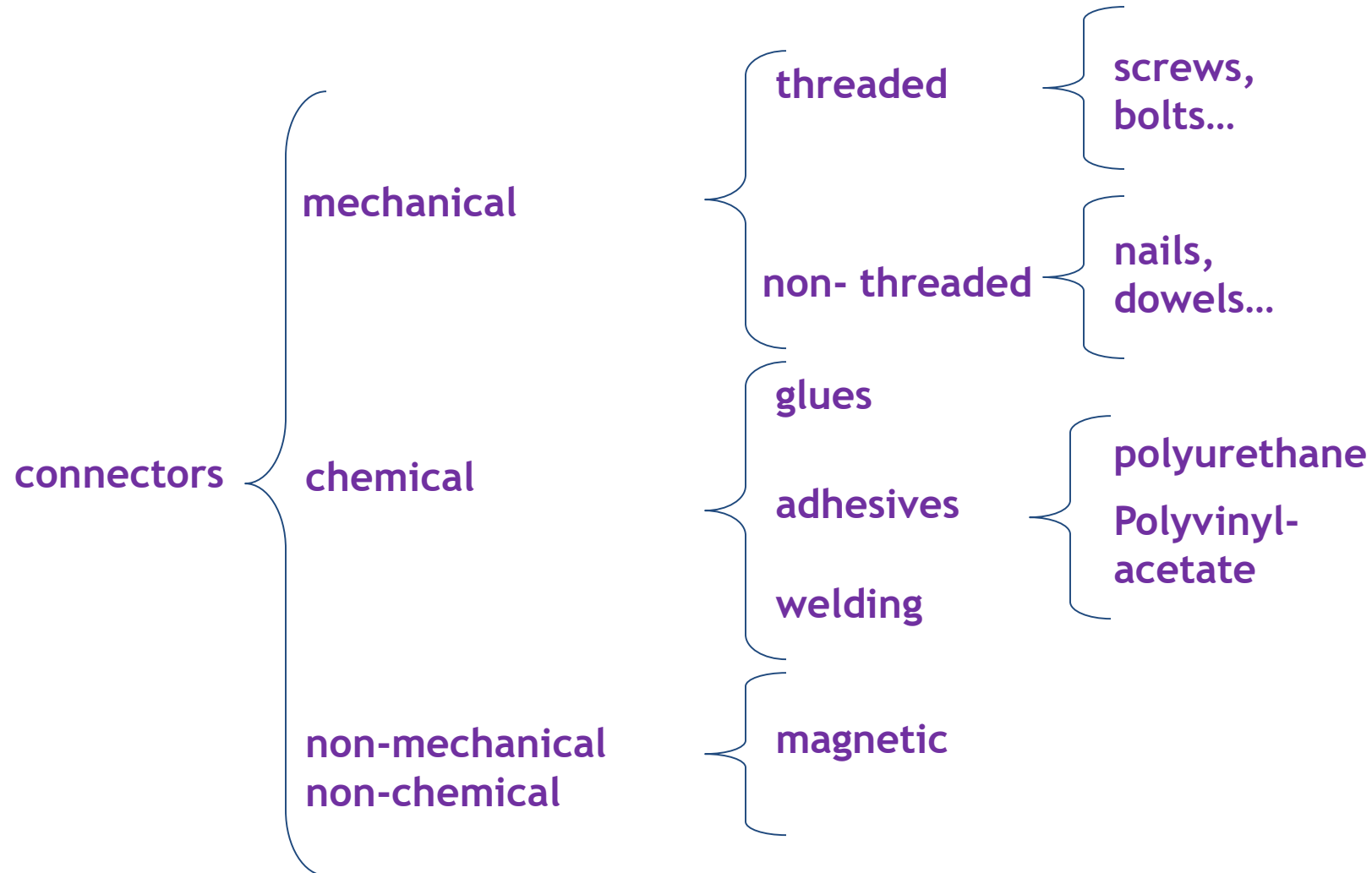


# REDUCE INVENTION TO IT'S ESSENCE

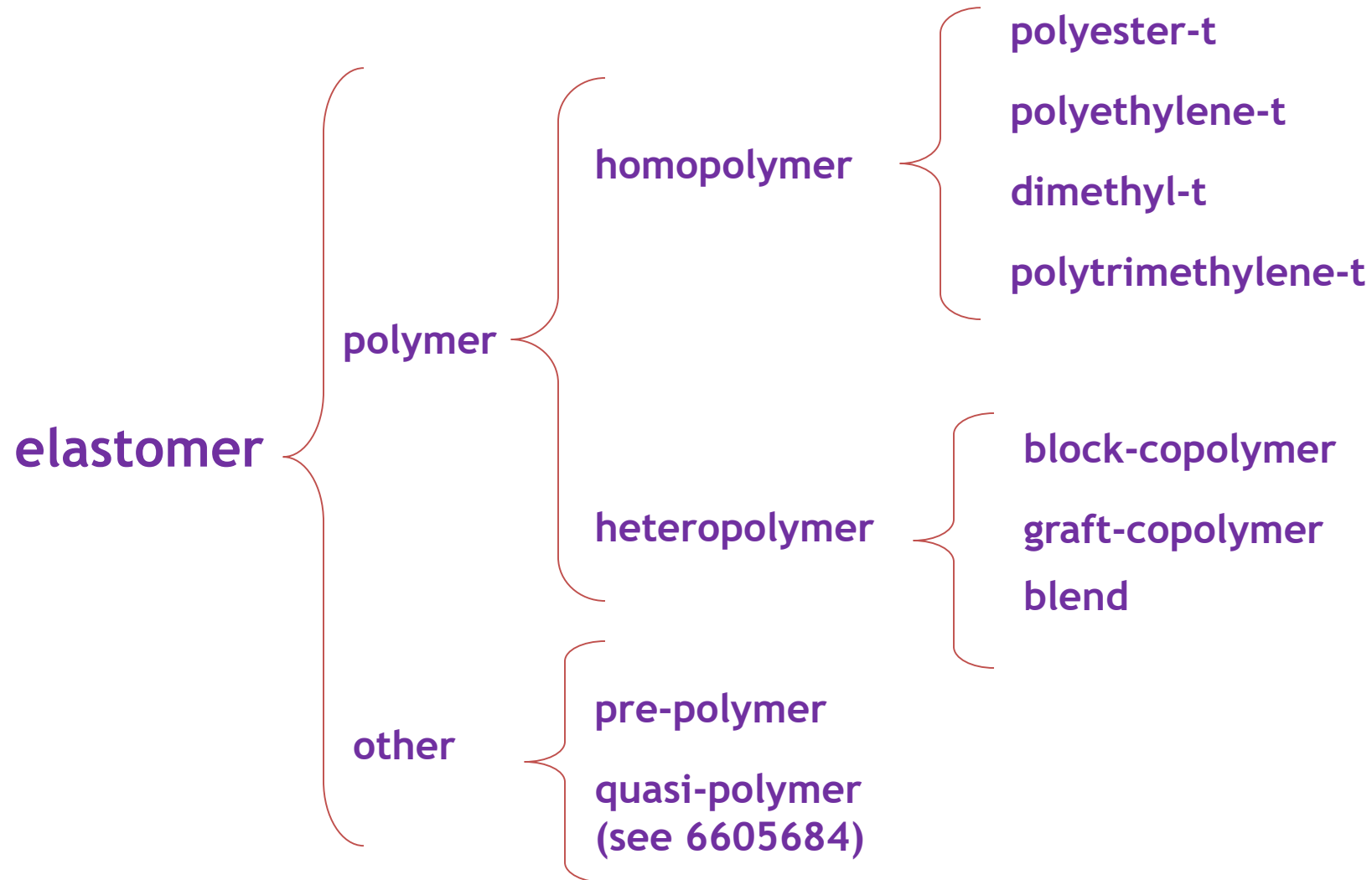
## Good Claiming Practice



# USE TAUTOLOGIES



# TEREPHTHALATE BALLOON





# CONSIDER EVOLUTION OF TECHNOLOGIES

## Develop Innovation Pipeline

- Few to many
- Lower dimensions to higher dimensions
- Lower frequency to higher frequency
- Standalone system to feedback
- Stationary to mobile
- Generalized to specialized
- Single systems to overlapping systems

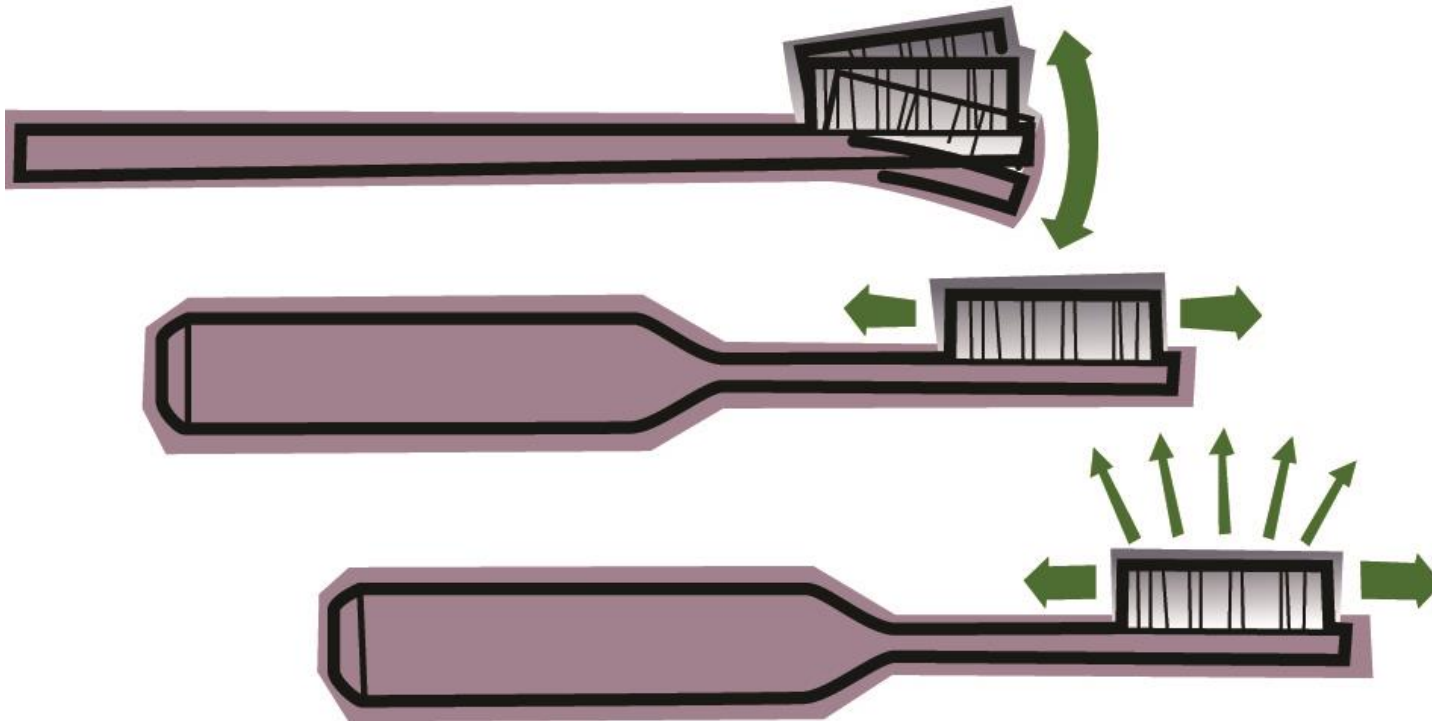
# TOOTHBRUSH EXAMPLE

Few To Many  
Lower Dimensions to Higher Dimensions



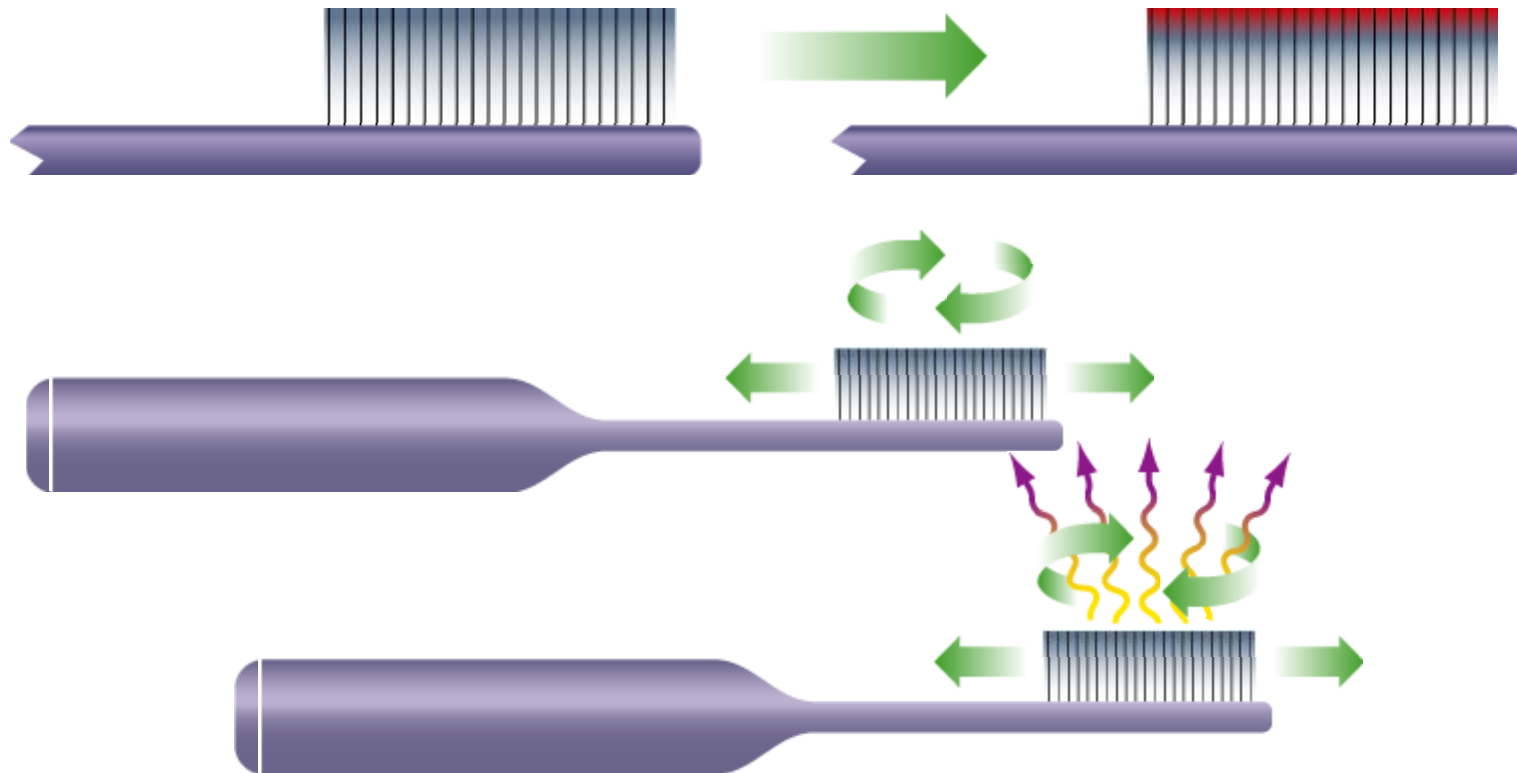
# TOOTHBRUSH EXAMPLE

Stationary to Mobile  
Lower Frequency to Higher Frequency



# TOOTHBRUSH EXAMPLE

Standalone System to Feedback  
Single System to Overlapping System

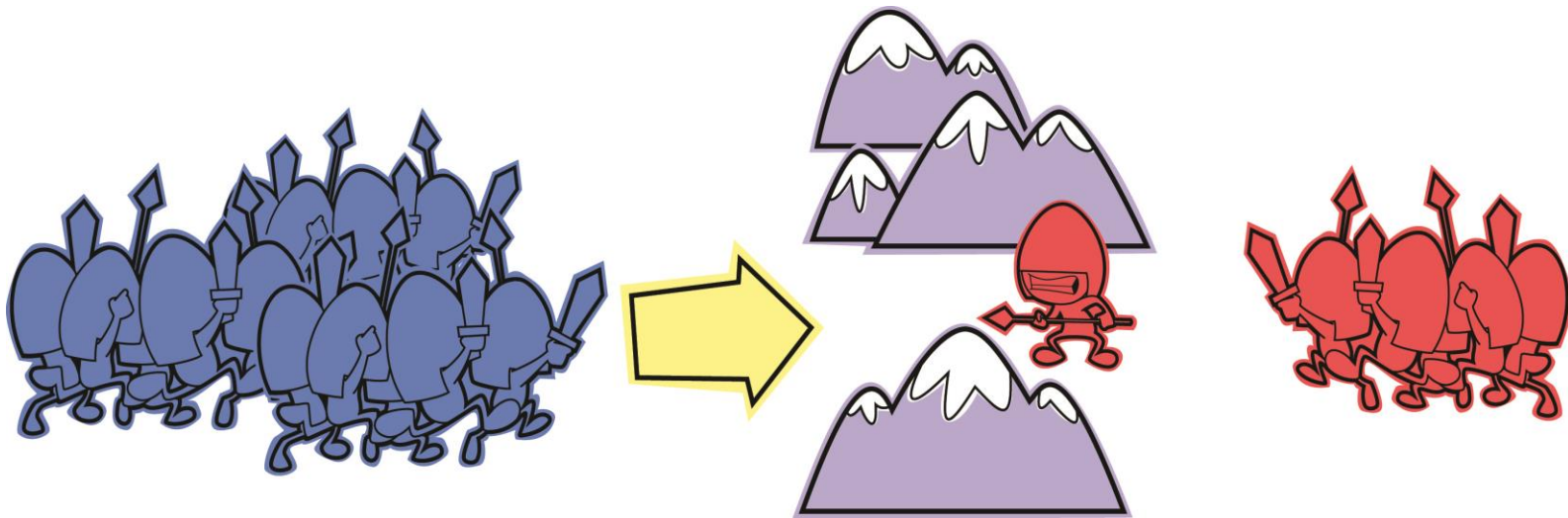


# **SAME PRINCIPLES APPLY TO GLUCOSE METERS**

- Few to many
- Lower dimensions to higher dimensions
- Lower frequency to higher frequency
- Standalone system to feedback
- Stationary to mobile
- Generalized to specialized
- Single systems to overlapping systems
- Synchronous to asynchronous
- Sequential to concurrent processing
- Continuously processed to interrupt driven

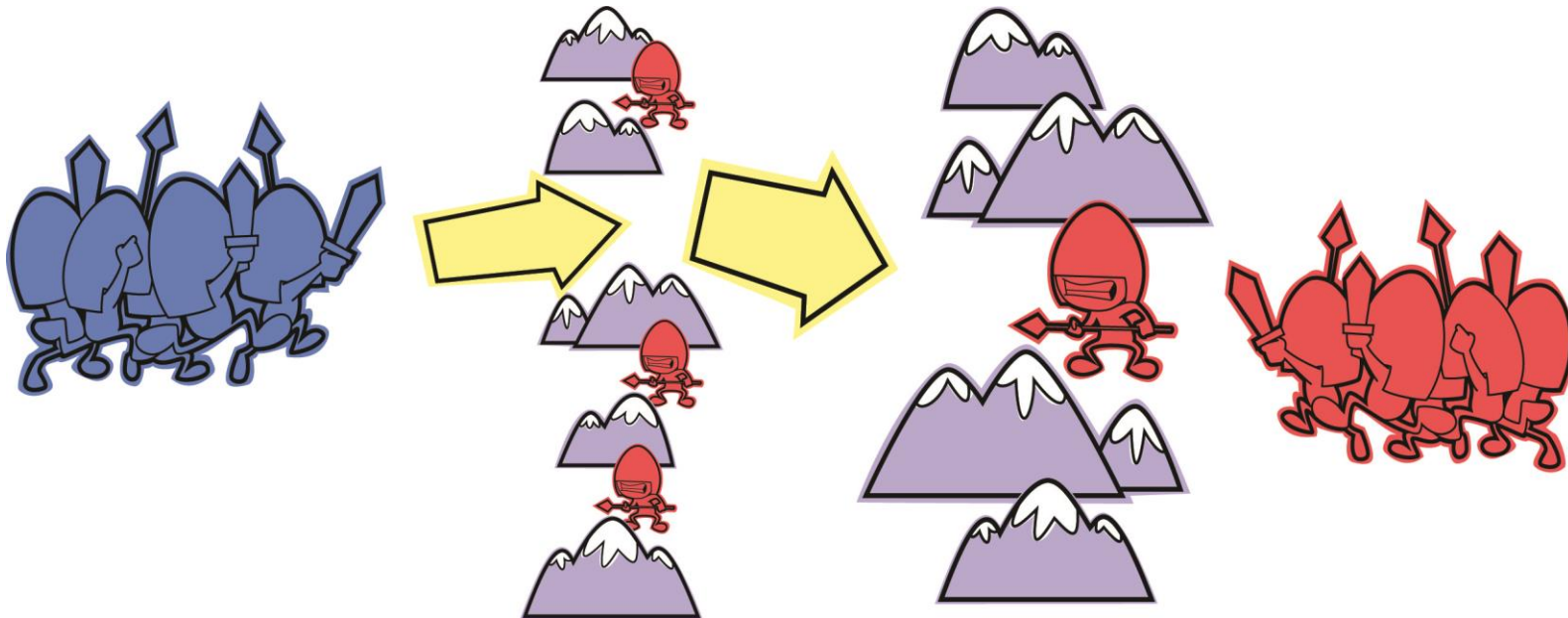
# BLOCK COMPETITOR EVOLUTION

Patents Are Choke Points



# BLOCK COMPETITOR EVOLUTION

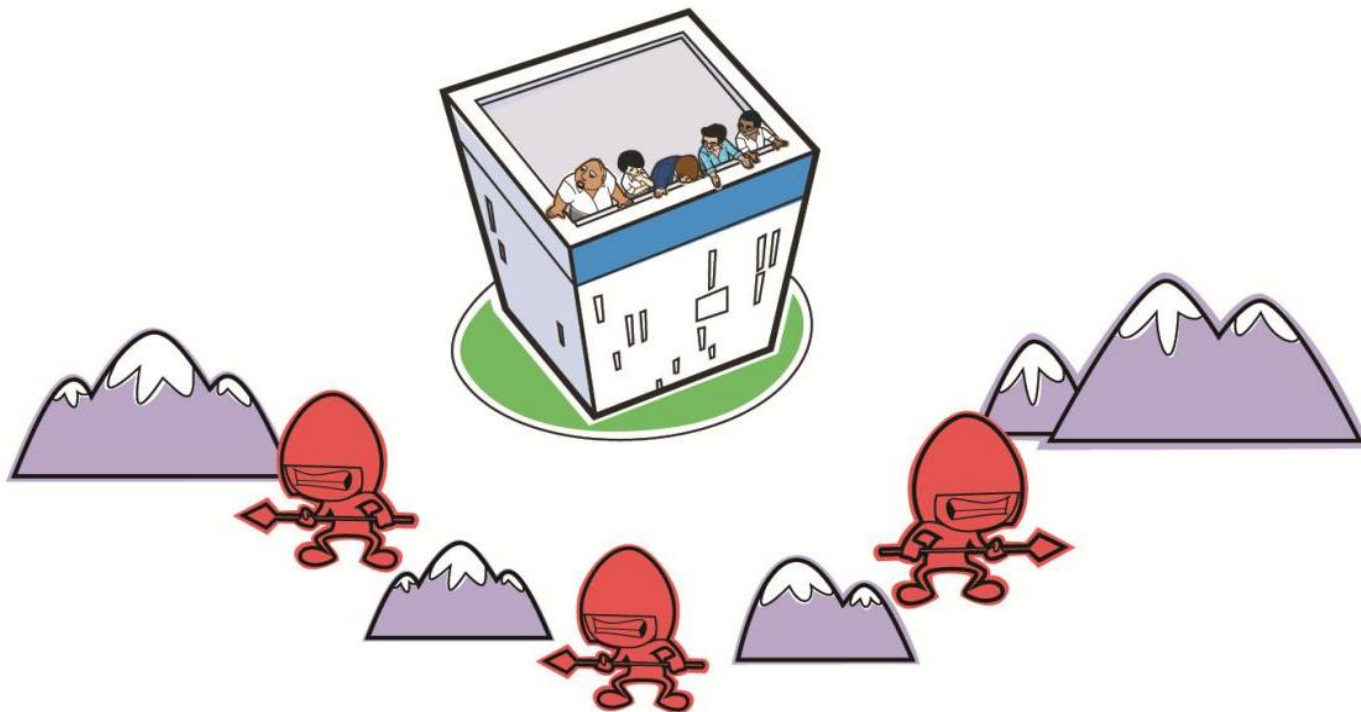
Sometimes Several Choke Points  
Are Needed





# BLOCK COMPETITOR EVOLUTION

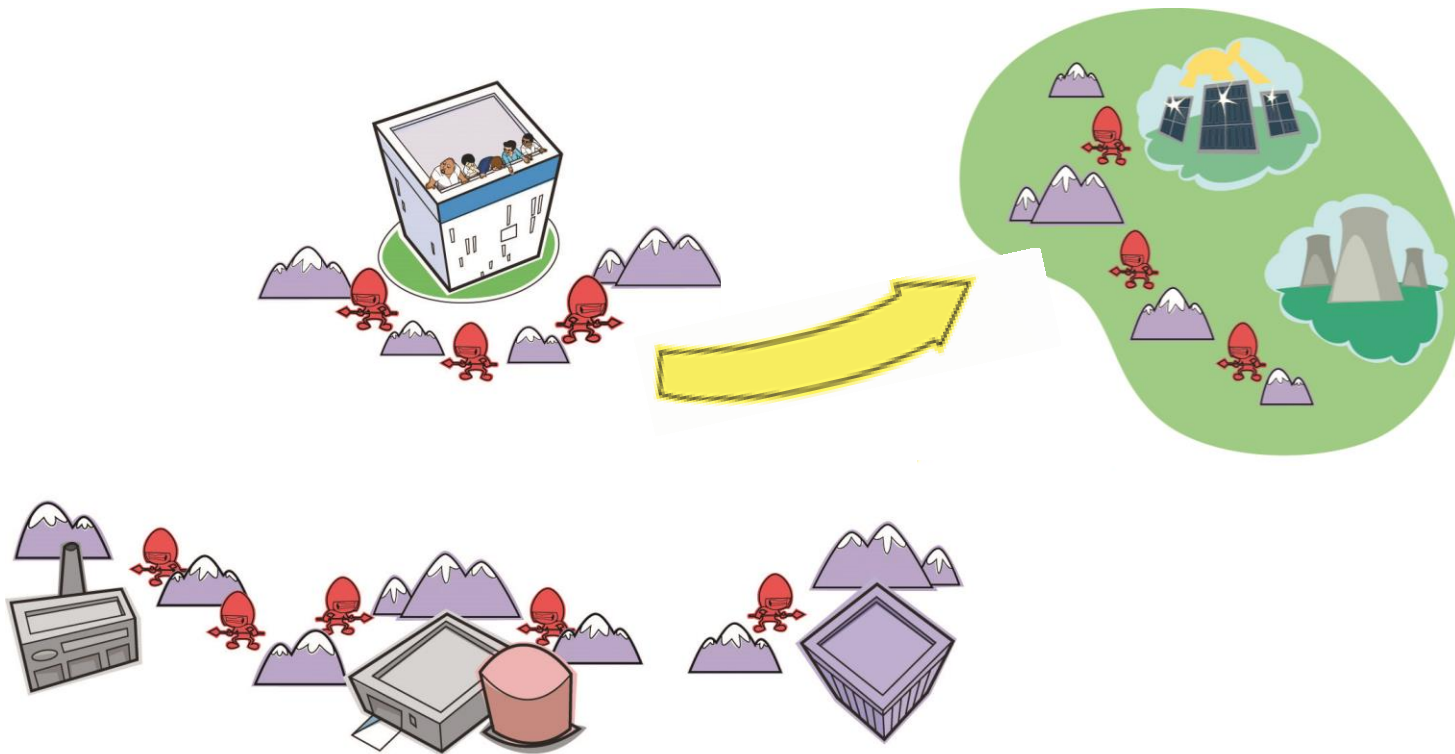
Everyone Tries To Protect Things  
They Have Already Invented





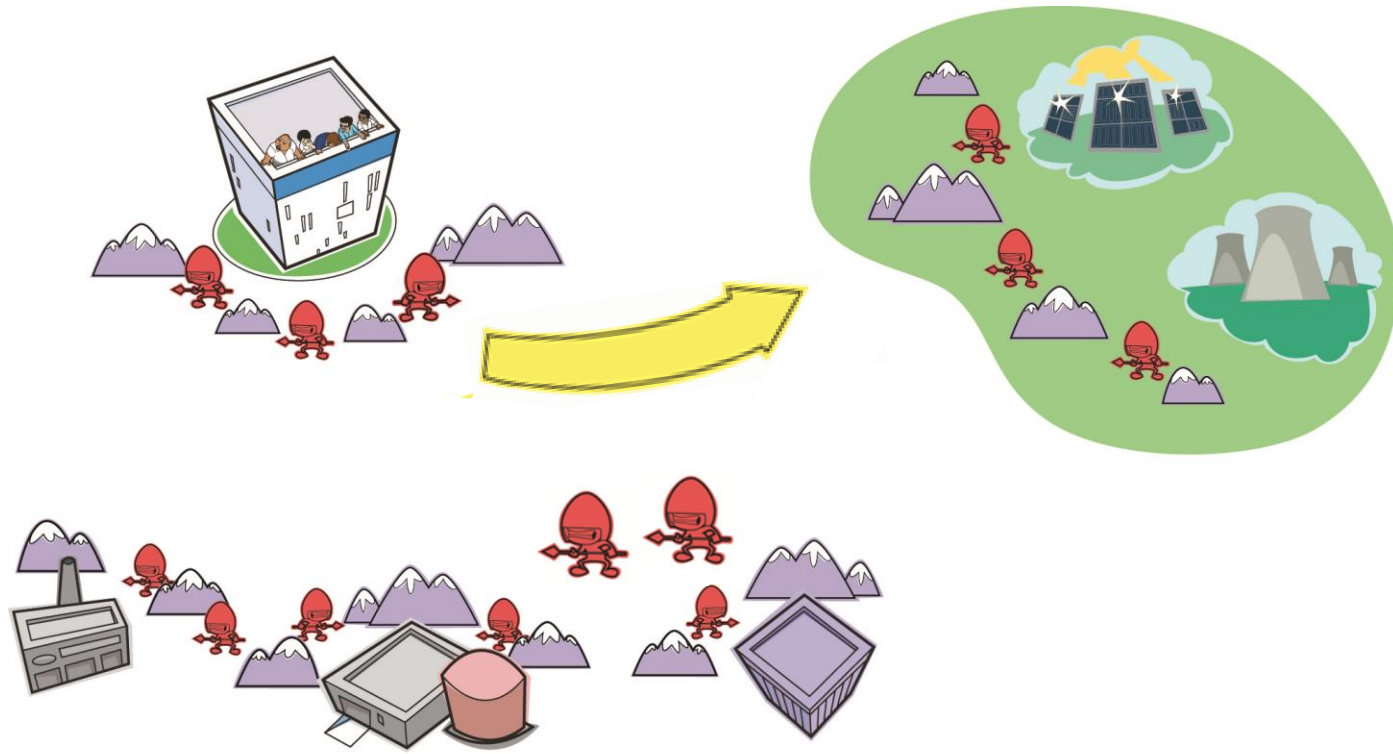
# BLOCK COMPETITOR EVOLUTION

The Trick Is To Patent What The Market  
Wants In 5 or 10 Years



# BLOCK COMPETITOR EVOLUTION

And Also Patent Where The Competitors Are Going



# RECENT US CASES

## What's Going On With Business Methods - Natural Products? Answer = Proportionality

- ⦿ The few patents surviving an *Alice* challenge have been narrowly tailored match the scope of the claims with the contribution to technology.
- ⦿ US Const art I, §8, cl 8) “promote the Process of Science and useful Arts”.

# SOFTWARE AND BUSINESS METHODS

- ◉ Proportionality can be established by reciting (a) real world effects, or (b) how something is accomplished:
  - *Intellectual Ventures v. Ricoh* (image scanning)
  - *DDR Holdings, LLC v. Hotels.Com* - (webpage display technology)
  - *Enfish v. Microsoft* (self-referential table)
  - *McRO v. BANDAI* (operation of a computer or a computer network)
  - *Bascom v. AT&T Mobility* - (nonconventional or non-generic arrangement)
- ◉ Proportionality not established by merely reciting what is being accomplished, rather than how:
  - *Alice v. CLS Bank* (electronic escrow service)
  - *Ultramercial, Inc. v Hulu* (payment of royalties)

# NATURAL PRODUCTS, DIAGNOSTICS

- ◉ Proportionality can be established by reciting (a) real world effects, or (b) how something is accomplished:
  - *Rapid Litigation v. Cellzdirect* (method of cryopreserving hepatocyte cells other than natural ability of cells to undergo the process)
- ◉ Proportionality not established by merely reciting (a) what is accomplished, or (b) conventional use of natural properties:
  - *Mayo v. Prometheus* (diagnostic method of determining the proper dosage)
  - *BRCA1- & BRCA2 v. Ambry (Myriad II)* (assays to naturally occurring genetic mutations)
  - *Ariosa v. Sequinom* (assays to find fetal DNA in maternal blood)

# MISCELLANEOUS CASES (1)

- Standard of Proof - *Ex parte Johnson*, (PTAB 2018)- USPTO need not provide factual evidence to support a finding of abstract idea.
- On-Sale Bar - *Helsinn Healthcare v. Teva* - Invention can be on-sale even if the details of the invention are not made public
- Standard of Proof in IPR- *Aqua Prods., Inc. v Matal* - petitioner must prove propositions of unpatentability
- Standing - *ArcelorMittal v. AK Steel* - subject matter jurisdiction for DJ is proper where patent holder failed to unconditionally assure alleged infringer and customers that it would never assert certain patent claims against them
- Damages - *Halo Elecs., Inc. v. Pulse Elecs* - exceptional case only if facts egregious

# MISCELLANEOUS CASES (2)

- ◉ Exhaustion - *Impression Prods. v. Lexmark Int'l* - no exhaustion where customers had choice to use Return Program
- ◉ Antitrust - *In re Lipitor Antitrust Litig.* - sufficiently large reverse payment can violate antitrust
- ◉ Antitrust - *Suture Express v. Owens* - precompetitive justification can preclude antitrust violation
- ◉ Written Description - *Intellectual Ventures I LLC v. Motorola Mobility* - written description can be issue of law if based solely on intrinsic evidence
- ◉ Sales Abroad - *Life Techs. Corp. v. Promega* - selling even single component of patented combination for combination abroad can be actionable
- ◉ Venue - *TC Heartland v. Kraft Foods* - can only sue a corporation for patent infringement only in state of incorporation



# PATENT STRATEGY RESOURCES

