

Strategies for Keeping Your Patent Applications on Track

By Steven R. Hansen

The goal of any patent program is to create value for your business—through the exclusion of competitors or through the generation of licensing royalty streams. However, extracting value from your patents requires attention and care. Technology is dynamic and fluid, so a strong patent portfolio is dynamically attuned to the changing nature of your business and your competitors' businesses.

Too often, patent applications are written based on business conditions at one point in time, usually early in the life cycle of a product's development, and then forgotten. It can take on the order of one-and-a-half to two years for the U.S. Patent & Trademark Office to examine a patent application. During that time, product features may change. The demands and desires of the marketplace may change or become clarified. If that happens, before they are even examined, your pending patent applications may no longer cover your products or those of your competitors (or potential licensees in the case of a licensing business model).

In addition, once a patent application undergoes examination, the patent attorney may be confronted with making changes to the claims or making arguments to get it issued as a patent. If those changes or arguments are not informed by the evolution of the technology, the resulting patent may have little commercial value.

To keep your patent applications on track, it is important to develop a practice of periodically monitoring their status, staying abreast of developments in the business and technology, and

making changes to the applications or filing new ones, if necessary. Here are some strategies for making sure that your patent applications stay on track and focused on the needs of the business:

1. Check with the USPTO and with the relevant office in other countries on the status of your patent applications.

According to the U.S. Patent & Trademark Office's dashboard (www.uspto.gov/dashboards/patents/main.dashxml), as of January 2012, on average, patent applications waited 22 months after filing before being examined. A lot can happen in 22 months. Product features may be added or removed. Competitors may release new products. In addition, it is not unheard of for patent applications to "fall through the cracks" at the Patent Office, so it pays to make sure someone monitors their status. Typically, this should be your patent attorney.

Once they are published, the status of the applications is available for anyone to see on the U.S. Patent & Trademark Office's Patent Application Information Retrieval (PAIR) system (www.uspto.gov/patents/process/status/). The PAIR system provides access to the text of pending claims and the history of any amendments that have been made as well. Even before publication, your patent attorney can access a section of PAIR known as "Private PAIR" to get an estimate of when your patent applications will first be examined. Until recently, attorneys had to submit "status inquiry" letters to the Patent Office to find out when an application would be examined. That process is now automated.

Many companies also seek patent protection outside of the United States. For foreign patent applications, you may need to contact attorneys in the jurisdiction of interest and have them send inquiries to the relevant patent office to find out when your applications will be examined. Once the examination process starts, the foreign attorneys should be keeping your patent attorney informed of the status of your applications.

2. Perform periodic reviews of your pending applications and make adjustments where necessary.

The life cycle of a patent application can be broken down into three parts: the pre-examination period prior to the issuance of a first office action, the examination period, and the post-examination period, prior to the issuance of the patent. The ability of applicants to adjust their patent applications to changes in product features or the marketplace varies during each of these periods. In general, it is easier to amend your patent claims earlier in the process. However, some level of review and collaboration between product design personnel and patent counsel should ideally occur in all three phases.

- *Robust communications between product design personnel and patent counsel are*

vital. To provide a meaningful review of pending patent applications, patent attorneys and product development personnel must communicate. Product design and development personnel will often assume that once a patent application is filed, the product is “covered” and give the application little further thought. That is not necessarily true. Depending on the nature of product changes or refinements, claims that once covered the product may no longer do so. Thus, it is vital that patent attorneys and product development personnel stay aware of one another’s activities.

How this communication is handled is largely a matter of organizational culture and preference. One method would be to have periodic meetings between patent attorneys and design personnel. The meetings should be timed so that some review occurs in each of the three parts of the patent application life cycle. They could also be keyed off of product development milestones.

Alternatively, or in addition, patent attorneys may be made part of the “team” and made aware of product development on an

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ongoing, real-time basis. This might involve copying patent counsel on product development team e-mails and correspondence or inviting patent counsel to product development meetings. However, the benefits of this approach must be weighed against the cost of the attorney time that is involved, especially because the product development team may be focused on many issues that are ultimately irrelevant from a patenting standpoint. Conversely, a product development person can be designated to interface with patent counsel and copied on all patent-related correspondence so the product development team is aware of the status of relevant patent applications.

- *Determine whether the patent claims cover the current design of the product and make required changes, where possible.* During each review, the claims of the patent application should be compared to the current design of the product to determine whether the claims “cover” or “read on” the product. This means making sure that the claims do not require a feature that is not part of the product. If the claims originally required elements A, B, and C and feature B has now been eliminated, the claims will not cover the product. As a result, a competitor could copy the modified product without infringing the claim. In that case, even if the application issues as a patent, the claim could not be used to stop the competitor. Thus, if possible, you would want to revise at least some of your claims to require only features A and C. Of course, if no relevant product changes have been made since the application was filed or since a prior review, this sort of analysis will be unnecessary.

Now the bad news: You do not have unfettered discretion to alter your patent applications after filing. For U.S. patent applications, there are two key limitations. First, any change you make to the claims must be supported by subject matter that was already in the patent application at the time it was filed. If your product development team adds a completely new feature that was

unknown at the time of filing, you will not be able to add that feature to your claims.

Second, any changes to the claims must not impair their patentability. To receive a U.S. patent, the claims must be both novel and nonobvious. Novel claims are those whose features are not identically described in a single prior art reference (e.g., prior patents, published patent applications, journal articles, etc.). Nonobvious claims are those that cannot be obtained by combining or modifying the prior art in a manner suggested by some teaching or motivation known to those skilled in the art. You cannot make claim amendments that eliminate the novel and nonobvious features of the claims because the Patent Office will not issue a patent without them.

Your ability to change your claims after a patent application is filed will typically be more constrained in foreign countries than in the United States. In both cases, you will be unable to add something to the claims that was not already present in the application at the time it was filed. However, in places such as Europe, China, and Japan, it may also be difficult, or impossible, to *delete* features from your claims, even if the modified claims would still be novel and nonobvious. The reason is that these jurisdictions have strict “original disclosure” requirements and often view changes that broaden the claims as going beyond the original disclosure. In addition, these jurisdictions are more likely to view features in the originally filed claims as “essential” to the invention and refuse to allow you to remove them from the claims. For these reasons, it is especially critical in many foreign jurisdictions to make any necessary changes to the claims as early as possible in the patenting process to improve your chances of having them allowed.

So what do you do if the changes in the product are not described in your patent applications? If possible, you file a new patent application that describes and claims them. A number of issues will impact whether this option is available, such as whether and when your earlier application was published, whether it names the same inventors, and whether the changes are significant

relative to the original application. Thus, you will need the help of your patent attorney to decide whether a new application is feasible. The feasibility of filing a new application may differ in the U.S. and foreign jurisdictions, so foreign counsel may need to be consulted to determine whether a new application is feasible in their respective jurisdictions.

- *Conduct reviews during each of the three phases.* Each phase of the patent application life cycle provides an important opportunity to tune your patent claims to recent developments. For example, if product changes are made before examination starts, claim amendments should be made so that the examiner reviews the modified claims, not claims that are no longer applicable.

During the examination period, patent attorneys and product development personnel should be communicating about the nature of any prior art that has been asserted by the Patent Office and about any proposed claim amendments or arguments. This collaboration will ensure that any such arguments and amendments are consistent with the product you are trying to protect. Some companies have their attorneys provide the office actions and references to product development personnel to get their input and to guide the attorney's formulation of a response.

It is particularly important to review your patent applications after they have been allowed by the Patent Office (i.e., once a Notice of Allowance has been issued) and before they actually issue as patents. The reason is that, at least in the United States, you have the ability to file continuation applications until the earlier application issues as a patent or is abandoned. Once the patent issues, this opportunity is lost. A continuation application has the same information as an earlier application but different claims. As a result, its filing date is effectively the same as that of the earlier application.

If a preissuance review reveals that the claims no longer cover your commercial product, your ability to amend the claims is somewhat limited. In general, you will need the Patent Office's permission. It is unlikely that you would be allowed to amend the claims at this point simply because of changes in your product. Thus, if the claims no longer cover the product, you should file a continuation application with claims that are drafted to cover it. If the product changes are not described in the earlier application, you may not be able to file a continuation. Instead, you may have to file a new patent application.

This is another area where U.S. and foreign practice may differ significantly. For example, in Europe, there is a specific time limit for filing continuation applications. Thus, you may be unable to file one by the time the earlier application is deemed allowable. In that case, if possible, you would want to file a new patent application with claims that cover the product.

3. Perform periodic reviews of your competitors' technologies and the marketplace.

The foregoing discussion may have suggested that the only purpose of your patent claims is to cover *your* product. That is not necessarily the case. You may also want to pursue patent claims that cover your competitors' technologies or other implementations that may be useful, even though your company is not practicing them. Such claims will maximize the scope of your patent estate and will reduce the ability of others to design around your patents and compete with your products.

You can do several things to stay aware of your competitors' technologies. First, monitor their published patent applications and issued patents. The USPTO web site (www.uspto.gov) provides a free tool that allows you to search for patents and published applications based on their owner and inventor names. You can also search based

on key words and the subject matter classes in which inventions are grouped. This type of monitoring may reveal where your competitors are heading and may suggest blocking patent claims that you will want to pursue in your applications. Of course, any such claims must be supported by your original application. Once your competitors' applications have been published, you can obtain information about their status (including the current text of their claims) through PAIR.

Second, tap into the knowledge of your salespeople. They are in the field and know the competitive landscape. Find out what product features the marketplace is responding to and what products your salespeople are competing against. Feed this information back to your patent attorney. It may suggest modifications to your claims that you can use to block your competitors.

Third, consult with your technical people to see what other design options they would consider to be viable other than the ones you ultimately pursued in your own products. This should be done when the patent application is first filed to make sure that it includes the various options and will support claims that cover them. However, things may change, and a good alternative

may suggest itself only after the patent application has been filed. In that case, a continuation application or a new application may be required.

As with your own products, outside of the United States, it can be more difficult to amend your claims to cover competitive products. Therefore, the involvement of foreign patent counsel can be critical to implementing this strategy.

Investing in a patenting program is expensive. Thus, it pays to protect that investment by making sure that you are extracting as much value from your patent estate as possible. By monitoring your applications and tuning them to changing technology and business conditions, you can better ensure that you get the best coverage possible and that your IP dollars are well spent.

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