



**Ben-Ami & Associates**  
Patent Attorneys

# ***Practical Tips for Improving the Quality of the Patent Process***

*Gad Benett, Avi Avital*  
*Partners, Patent Attorneys*

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# *Today's Program*

1. Overview
2. Filing Strategies
3. Improve the Quality of the Patent Application
4. Questions & Answers

# *Ben-Ami & Associates*

- Boutique Patent Attorney Firm, Established in 2001 by Paulina Ben-Ami (1<sup>st</sup> woman Patent Attorney in Israel)
- 9 Patent Attorneys, 2 trainees
- 1 trademark attorney, 20 People Staff
- Patent Attorneys with Extensive Industry Experience
- Ranked #7 in D&B and BDI rankings

# Overview

- About us
- History of Intellectual Property
- What is a patent?
- Why patent?
- Other IP rights

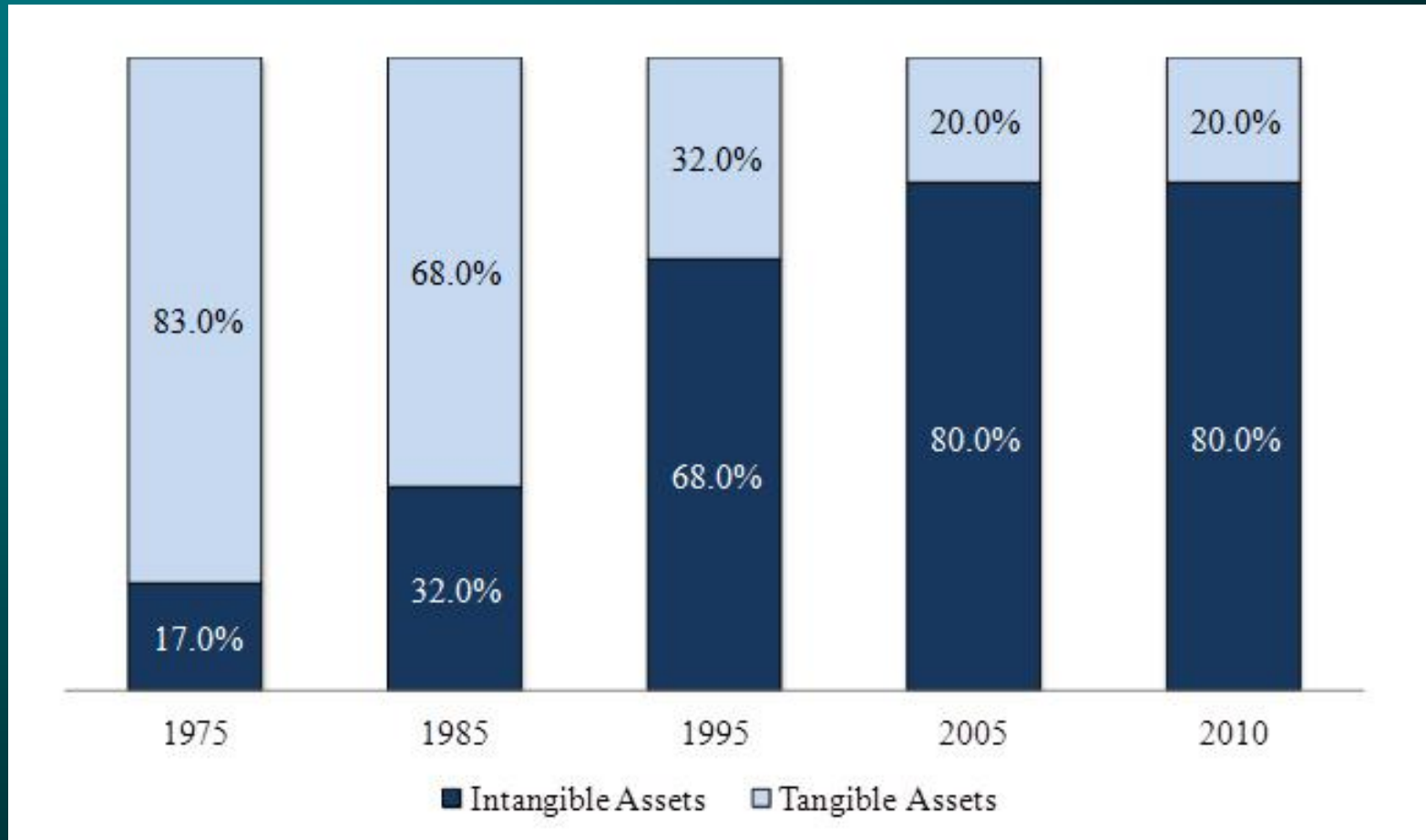
# *Wealth in the Past was Mainly*



# *Guarding Such Wealth*



# Property Nowadays



S&P 500 Companies (Source: Ocean Tomo)

# *Those 81% of Intangible Assets Include*

- Knowledge
- Reputation
- Design
- Art
- Anything created by the human intellect...



# *The Story of WebVan*

Raised \$375M in 1999:

- Upon a \$6B valuation
- Went bankrupt in 2009
- Liquidator extracted only \$300,000



# *Intellectual Property*

- Intellectual Property covers all creations of the mind:

1. Registered rights:

Patents, trademarks, design...

2. Non-registered rights:

Copyrights, performance rights, trade secrets, reputation...

# *What is a patent?*

- A patent is a right to exclude others from practicing the patented invention.
- A patent does not necessarily give the owner the right to practice the invention, because of prior patent rights.
- A patent is territorial in extent.
- A patent right gives a protection right which ends 20 years from the earliest filing date.

# *Why patent?*

- A patent may boost the value of your company (Nokia patents valued at \$2.2B).
- Licensing.
- Business collaborations.
- Strategic advantage over competitors.
- A patent may assure in practice freedom to operate (“balance of terror”).

## *A Patent Application has to:*

- Provide sufficient information to allow a person skilled in the relevant field to reproduce the invention
- Clearly define the scope of the patent rights sought

# *Basic Deal behind the Patent: Give n' Take*

- Give (disclose) to the public something new (and beneficial)
  - Receive some exclusivity rights
  - Usually 20 years from filing
- 
- Concept from 500 B.C. in Greece: he who discloses a new luxury product will receive one year exclusivity



# *A Patent Attorney's Work*

So what does a Patent Attorney do?

1. Meet the inventor, study the technology / field;
2. Inquire how the invention can / will be commercialized;
3. Define a strategy for defending the core of the technology (midway between a too broad claim that will be hard to get and a too narrow claim that will not protect enough);
4. Draft and file the patent application;
5. Respond to all Examiner allegations regarding novelty and non-obviousness of the claimed invention.

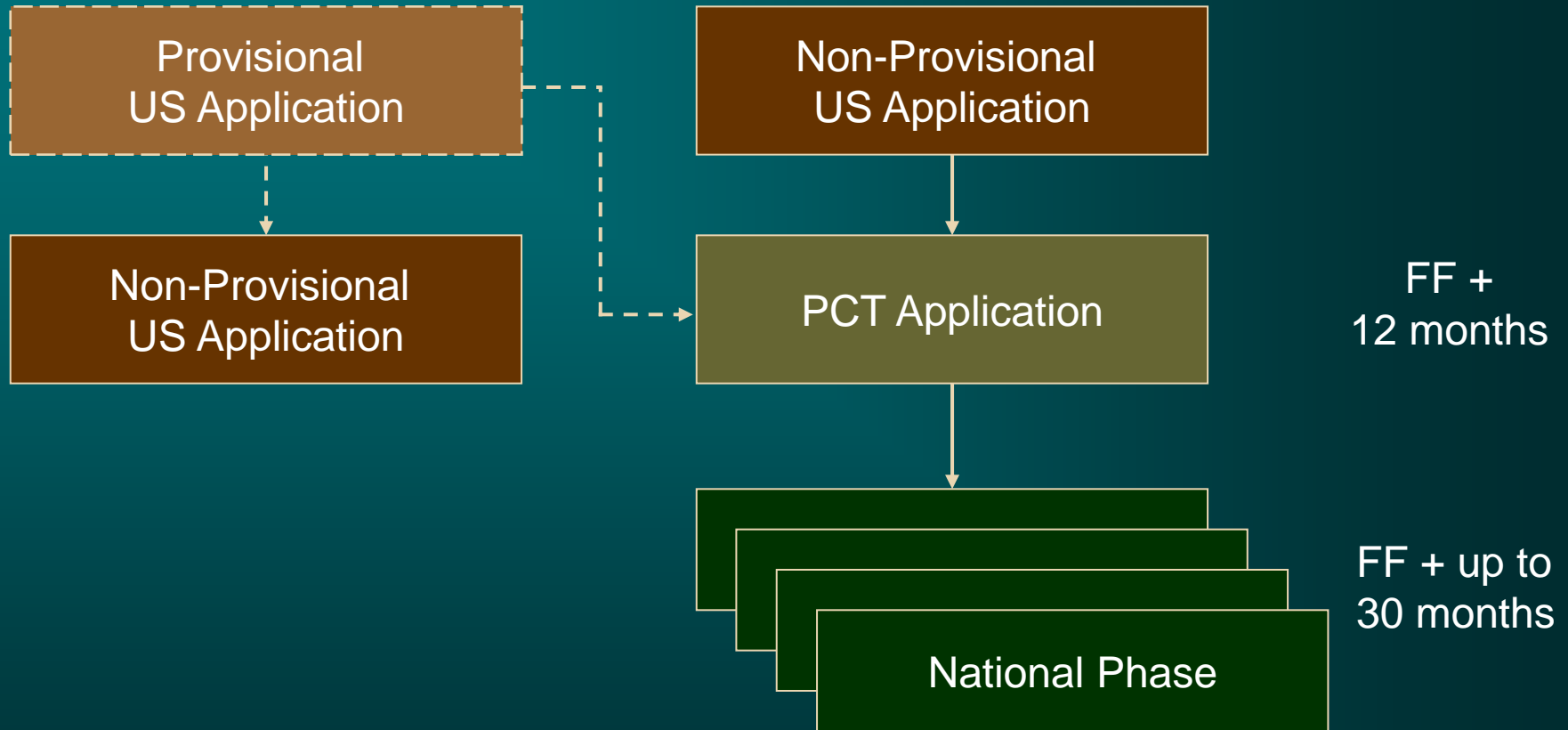
## *Consider Other IP Rights:*

- Design
- Utility Model (where available)
- Trade Marks
- Copyrights
- Trade Secrets

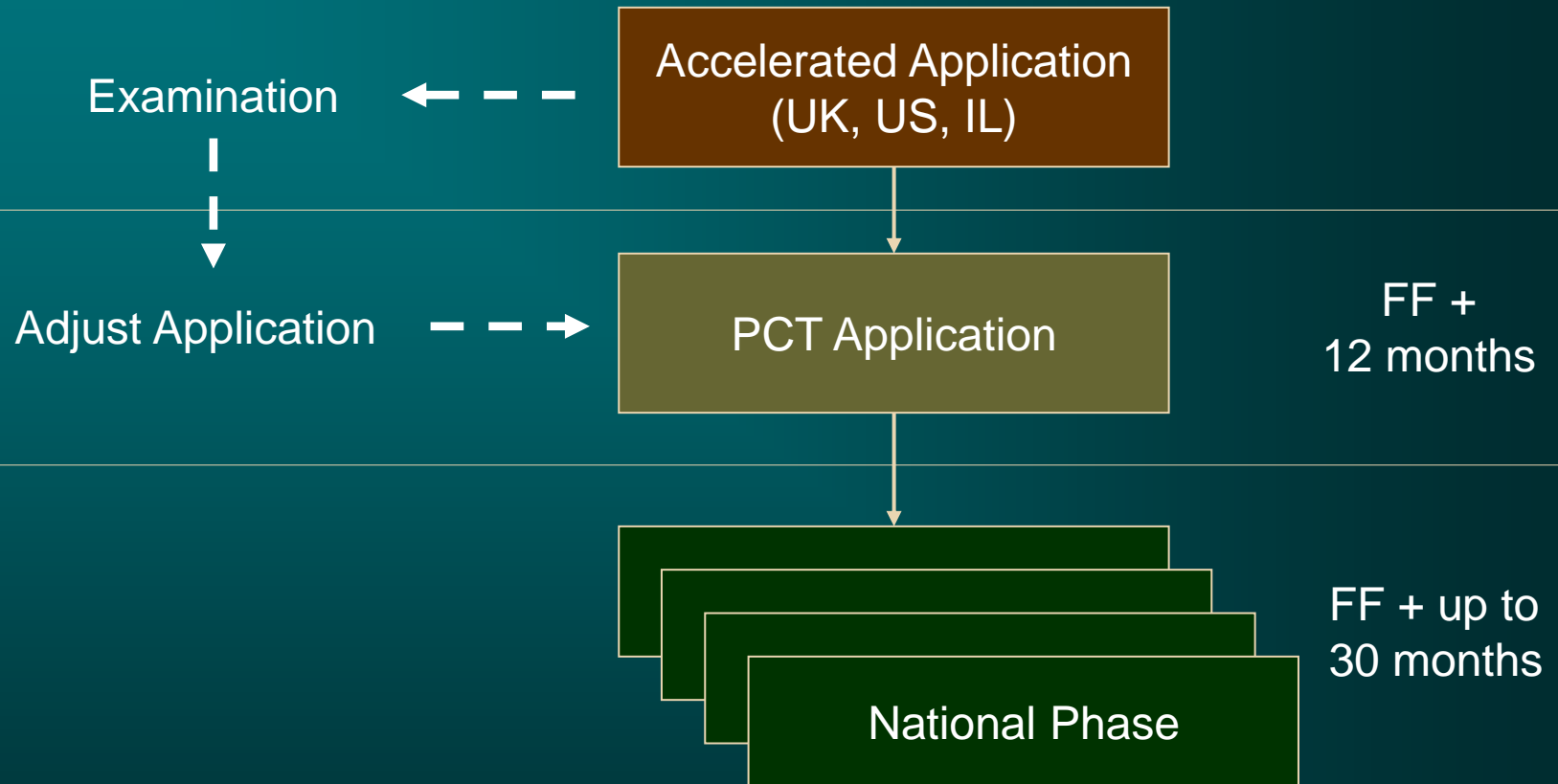


# *Filing Strategies*

# “Classical” Filing Strategies



# Alternative Filing Strategies: Y1 Feedback



# Alternative Filing Strategies: *SMALL*

Small Market / Budget

Non-Provisional  
US Application

First Filing (FF)



European Application

FF +  
12 months

# *To Provisional Or Not To Provisional?*

- Go for a Provisional Application when:
  1. Major developments are ahead
  2. Product launch is far
  3. Limited disclosure is available (“placeholder”)
  4. Informal drawings are available
  5. Need to save on filing fees

# *To Provisional Or Not To Provisional?*

- Go for a Full Application when:
  1. Disclosure is Finalized
  2. Product is Mature
  3. Time to Market is Important

## *Consider Accelerated Prosecution*

- Some countries will accelerate prosecution and/or grant a patent based on a grant of another country:
  - Japan <==> United States
  - UK <==> United States
  - Canada <==> United States
  - Korea <==> United States
  - US, EP etc ==> Israel

# *Recommendations for a Quality Patent Application*



# *Before Filing the Patent Application*

- **Avoid any publication, public usage prior to filing**
  - **For example, Web site, exhibition, sale, offer to sale...**
- **Use a Non Disclosure Agreement (NDA)**
  - **With customers, suppliers, contractors etc.**

# *Perform Your Own Search*

- **Free Online Patent Databases:**
  - 
  - **USPTO ([www.uspto.gov](http://www.uspto.gov))**
    - **Only US patents / Applications, full text search**
  - **Google Patents ([www.google.com/patents](http://www.google.com/patents))**
    - **US, European and WIPO databases**
  - **EPO ([ep.espacenet.com](http://ep.espacenet.com))**
    - **Worldwide searches, title + abstract search only**

# *How To Search*

**(1) Keywords (try different variations)**

**(2) Classifications (for the courageous ones!)**

# Classification Search

## Search the European classification

Find classification(s) for keywords

syringe injection

Search

Go

Index [A](#) [B](#) [C](#) [D](#) [E](#) [F](#) [G](#) [H](#) [Y](#)

Previous: [H04L](#)

Next: [H04L5/00](#)

### ELECTRICITY

[H](#)

### ELECTRIC COMMUNICATION TECHNIQUE

[H04](#)

### TRANSMISSION OF DIGITAL INFORMATION, e.g. TELEGRAPHIC COMMUNICATION

[H04L](#)

(typewriters [B41J](#); order telegraphs, fire or police telegraphs [G08B](#); visual telegraphy [G08B](#), [G08C](#); teleautographic systems [G08C](#); ciphering or deciphering apparatus per se [G09C](#); coding, decoding or code conversion, in general [H03M](#); arrangements common to telegraphic and telephonic communication [H04M](#); selecting [H04Q](#))

Arrangements for detecting or preventing errors in the information received (correcting synchronisation [H04L7/00](#) ; [N: for digital computers [G06F11/00](#)] ; arrangements in the transmission path [H04B](#))

[H04L1](#)

[H04L1/00](#)

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[N: Systems modifying transmission characteristics according to link quality including power backoff (adaptive data allocation for multicarrier modulation [H04L27/26M1P](#) ; controlling transmission power for radio systems [H04B7/005B](#))] [[C0807](#)]

[H04L1/00A](#)

[N: by adapting the transmission rate] [[N9911](#)]

[H04L1/00A1](#)

# *How to Read the CLAIMS*

## READ & UNDERSTAND Claim 1!

In general,

1. A claim (including Claim 1) does not need to describe / explain how the invention works.
2. Rather, the claim needs to list all the elements, that if found in a competing product, would infringe on the patent.
3. Each element (component) of a claim must be verbally linked, functionally or structurally, to at least one other element of the claim.

# *Art & Science of Claim Drafting*

## Technically – 100% OK

- 5 elements
- Claims connects all 5 elements
- Describes flashlight correctly

## Practically – bad claim for patentee

- Why???

# *Art & Science of Claim Drafting*

## Suggested Claim (1b)

A flashlight **for use with batteries**, comprising:

1. a tube;
2. a lamp;
3. a holder mounted on the tube to hold the lamp; and
4. a switch mounted on the tube, the switch being manually movable between on and off positions and connecting the batteries to the lamp when in the on position.

# *Art & Science of Claim Drafting*

## Suggested Claim (1a)

A flashlight, comprising:

1. a tube;
2. a lamp;
3. a holder mounted on the tube to hold the lamp;
4. batteries in the tube; and
5. a switch mounted on the tube, the switch being manually movable between on and off positions to electrically connect the batteries to the lamp when the switch is in its on position.



# *Check the Patent Application*

- **Make sure the claims cover your product as sold**
- **Make sure claim one is not too narrow**
- **Spend the time to see if you can design around your own claims!**

## ***Check the Patent Application (2)***

- **Provide enabling description with examples**
- **Describe major alternatives, variations**
- **In the US, provide the best way to reproduce the invention**

**Original drafting mistakes may prove irreversible !!!**

## ***“Hidden” Future Costs***

- **Do you really need that many claims? Additional claims = future costs either in official fees or claim amendments**
- **“Bloated” description can be costly where translation is required (Japan, China...)**

# *Not All Patents Are Made Alike...*



OR



A good patent has:

1. A clear description of the invention
2. Description of alternatives and variations
3. Claims that literally read on infringing product
4. Claims that cover alternatives and variations

# *Working with Your Patent Attorney*

- Prepare a written description with examples
- Describe major alternatives, variations
- Explain the difference between the invention and the current state of the art
- Optionally, do your own preliminary search
- Understand CLAIM 1, see if you can work around it

**Result = higher quality drafting and lower costs!**

# *Questions & Answers*





**Ben-Ami & Associates**  
Patent Attorneys

***Thank you!***

Gad Benett

gad@benami.com

0526-621062