

# **DRAFTING PATENTS FOR COMMERCIALIZATION**

## **FEDERAL LABORATORY CONSORTIUM FOR TECHNOLOGY TRANSFER**

### **Midwest/Southeast Joint Regional Conference**

October 25-27, 2006

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## PATENTS AS BUSINESS

- Patent applications and patents should be part of an overall business strategy
- You must know where you're going to have an idea of how to get there
- Non-profit -- this can be important

## PATENT PORTFOLIOS

- Who's on first?
- Maintaining knowledge of what's pending, what's issued, what's to be abandoned
- Must be aligned with the strategic vision of the organization
- Communication with management is of paramount importance

## DRAFT CLAIMS FOR LICENSING

- Many different kinds of claims (composition, method, etc.)
- Multiple Ranges
- Multiple Compounds
- Draft with markets in mind
- Multiple fields of use

# KEEP THE COMPETITION IN MIND WHEN DRAFTING/AMENDING CLAIMS

- Broad claims wreak havoc, even if not allowed (publication)
- A claim is not an invention, it is the boundaries of protection for an invention

# DON'T SELL YOUR INVENTION SHORT

- If you don't ask for a claim - you'll never know
- Question a first action allowance
- Strive forth broadest possible claims – it will pay off later.
- Consider continuations and continuations-in-part

## UNDERSTAND YOUR CLAIMS

- If you don't – no one will
- Work with your attorney
- Ask questions and demand answers

## TERM DEFINITIONS

- If you don't define it – the term will be given the ordinary (e.g., dictionary) definition. Look it up first!
- Important (e.g. claimed) terms must be defined with precision
- Precision does not mean "limited"

## **BE ALERT TO DEFINITIONS USED IN THE ART**

- ❑ Sometimes there is wide divergence within the art
- ❑ Individual scientists are frequent and sometimes bad lexicographers

## **WHEN IN DOUBT PLAGIARIZE! (OTHER PATENTS)**

- Prior patents in the field are a good source for claim construction/terminology ideas
- But be wary of copying by rote

# DON'T FORGET THE DEPENDENT CLAIMS

- The term "dependent" is a misnomer!
- Each dependant claim stands, and most importantly falls, on its own
- Ranges, components, mixtures of compounds

## DEPENDENT CLAIMS (CONTINUED)

- Many possible permutations
- Draft with increasing validity in mind
- Avoid claim fees by placing claims in specification (e.g. summary)

## **BUSINESS METHODS**

- Take advantage of what the law allows
- Upstream/downstream of the science (e.g. method for performing an experiment)

## **MAKE SURE THE SPECIFICATION SUPPORTS THE CLAIMS**

- Multiple ranges, components
- Alternative to each claimed feature
- Support even unclaimed features in case such are necessary later
- The specification should contain language that tracks the language of the claim

## DESCRIBE MULTIPLE EMBODIMENTS

- 1+1 does not equal 2 in embodiments
- Can support revised dependent claims
- Provides flexibility to amend during prosecution to draft hybrid claims

## **DRAFT CLAIMS WITH FOREIGN PROSECUTION IN MIND**

- No grace period!
- No medical and surgical procedures
- No computer programs
- No business methods
- Associate can revise, but only if supported

## Article 52(4)

"Methods for treatment of the human or animal body by surgery or by therapy and diagnostic methods practiced on the human or animal body shall not be regarded as inventions which are susceptible of industrial application within the meaning of Art. 52(1).

This provision shall not apply to products, in particular substances or compositions for use in any of these methods.

## Article 54(5) EPC

"The provisions...shall not exclude the patentability of any substance or composition, comprised in the state of the art, for use in a method referred to in Art. 52(4), provided that its use for ANY method referred to in that paragraph is not comprised in the state of the art."

# DRAFT CLAIMS WITH FOREIGN PROSECUTION IN MIND (CONTINUED)

- Support/Enablement requirements are very strict
- Almost literal support is required
- Multiple dependent claims can provide increased coverage

## **SECOND METHOD OF USE IS NOT POSSIBLE**

Instead try –

- Mode of administering use of a compound
- Treatment schedule or regimen
- Method for the manufacture of a medicament

# AVOID STEALTHY CLAIM LIMITATIONS

- Unnecessary fields of use
- Unnecessary verbage in claims
- Unnecessarily limited word choices for claims

## STEER CLEAR OF FESTO PROBLEMS

- Avoid amendments if possible
- May require increased numbers of claims
- May increase prosecution cost

# USE ALTERNATIVE CLAIMING STRATEGIES

- Compounds
- Composition
- Methods of Making Intermediates
- Kits
- Systems

# AVOID PROSECUTION HISTORY ESTOPPEL

- Don't say anything! (that you don't have to)
- Don't sink a patent to get another allowed
- Draft many claims of varying scope

## FIELD OF USE CLAIMS

- Useful for licensing
- A trap for the unwary in licensing
- The boundaries can be grey
- (cancer and neurology as brain cancer)

# LITIGATION

- A common, if unpopular, form of "commercialization"
- Clear claims are the rule
- Fuzzy claims may sometimes have a place – if you can get them allowed

# DRAFT CLAIMS FOR LITERAL INFRINGEMENT

- Breadth is paramount
- Narrowing views on equivalents
- Markman hearing can be a dice roll without claim clarity

# LITIGATION

- Avoid Method Claims
- Avoid claims that require you to sue your customer
- Look for claims that get at the manufacturer
- Claims to features that are demonstrable

# Q & A