

Patent Prosecution Tips *and Traps*

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Who Owns My Case?

- ▶ Each inventor has the independent right to assign.
- ▶ Unless you have a joint assignment (or a complete set of independent assignments), there is a question mark with regard to ownership.

- ▶ MPEP 301 IV.

Joint ownership - Multiple parties may together own the entire right, title and interest of the patent property. This occurs when any of the following cases exist:

(A) Multiple partial assignees of the patent property;

(B) Multiple inventors who have not assigned their right, title and interest; or

(C) A combination of partial assignee(s), and inventor(s) who have not assigned their right, title and interest.

Each individual inventor may only assign the interest he or she holds; thus, an assignment by one joint inventor renders the assignee a partial assignee. A partial assignee likewise may only assign the interest it holds; thus, an assignment by a partial assignee renders a subsequent assignee a partial assignee. All parties having any portion of the ownership in the patent property must act together as a composite entity in patent matters before the Office.

Did the non-public and a foreign case constructively abandon my case?

- ▶ The non-publication request is a two-edged sword. You gain secrecy, but you create a risk of constructive abandonment.

- ▶ **35 U.S.C. 122(b)(2)(B)**

(i) If an applicant makes a request upon filing, certifying that the invention disclosed in the application has not and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications 18 months after filing, the application shall not be published as provided in paragraph (1).

(ii) An applicant may rescind a request made under clause (i) at any time.

(iii) An applicant who has made a request under clause (i) but who subsequently files, in a foreign country or under a multilateral international agreement specified in clause (i), an application directed to the invention disclosed in the application filed in the Patent and Trademark Office, shall notify the Director of such filing not later than 45 days after the date of the filing of such foreign or international application. A failure of the applicant to provide such notice within the prescribed period shall result in the application being regarded as abandoned.

Prosecute your target.

- ▶ Instead of just making your claims as broad as possible, identify your target coverage as early as possible during prosecution.
- ▶ A narrow claim that is issued and covers a competitor is more valuable than a broad claim that is still in prosecution.
- ▶ Consider how easy/difficult it would be to show evidence of use of your claims. Would extensive reverse engineering be required or can evidence probably be found using publicly available information?

Prosecute families for redundancy

- ▶ Even if you have claims that you think map to a target, keep prosecuting continuations (within reason) because you may need to adjust the claims after licensing negotiations start (e.g., after an IPR).
- ▶ A similar specification in a live case outside the chain of priority is handy (see slide on constructive abandonment).

Mind the geographic quirks.

- ▶ The remainder of this presentation will focus on prosecution outside of the United States.
- ▶ The combination of foreign language and foreign law creates unique problems of which to be aware.

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