Drafting Patent Applications to Survive IPR

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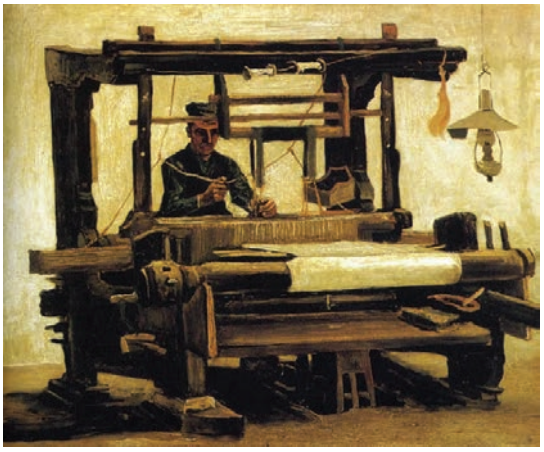
FISH & RICHARDSON

Factors to Consider

- Invention
- Prior Art
- Application
  - Claims
  - Specification
- Continuations
- Prosecution History
- Hurdles for Petitioner
- Costs and Benefits



"A weaver who has to direct and to interweave a great many little threads has no time to philosophize about it, but rather he is so absorbed in his work that he doesn't think but acts, and he feels how things must go more than he can explain it." Van Gogh, 1883.

Invention

- Have an invention that is truly patentable
- Give a frank assessment of patentability
- Develop a detailed understanding of the invention
  - How does it differ from the prior art?
  - Why is this difference important?

Prior Art

- Consider conducting a prior art search before filing
  - Don't rely on examiner to find all relevant prior art
- Disclose in IDS
- Have all relevant art considered by examiner
  - *Hulu LLC v. Intertainer Inc.*, IPR2014-01456 (PTAB March 6, 2015); *Microboards Technology LLC v. Stratasys Inc.*, IPR2015-00287 (PTAB May 28, 2015).

Application – Claims

- More is better
  - Forces petitioner to file more than one petition

- Varied is better
  - Every claim element must be addressed separately
  - Use different limitations in system and method claims
  - Use different terms as appropriate

Application – Claims

- Broad versus narrow
  - Broad claims to capture infringement
    - Low-hanging fruit for petitioners
  - Narrow claims to ensure patentability

    - At least one very narrow claim
      - *Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 59 (PTAB Nov. 13, 2013), aff'd in *In re Cuozzo Speed Techs., LLC*, 2015 WL 448667 (Fed. Cir. Feb. 4, 2015).
    - "Picture claims" to capture commercial embodiment
    - Detailed claims with features from different technology
    - Include an algorithm for software related innovations
      - Forces construction strategy that may hinder litigation

Title search: Drafting Patent Applications to Survive IPR

Also available as part of the eCourse
2018 Advanced Patent Law (Austin) eConference

First appeared as part of the conference materials for the
23rd Annual Advanced Patent Law Institute session
"Crafting Patents to Survive IPR Attack"