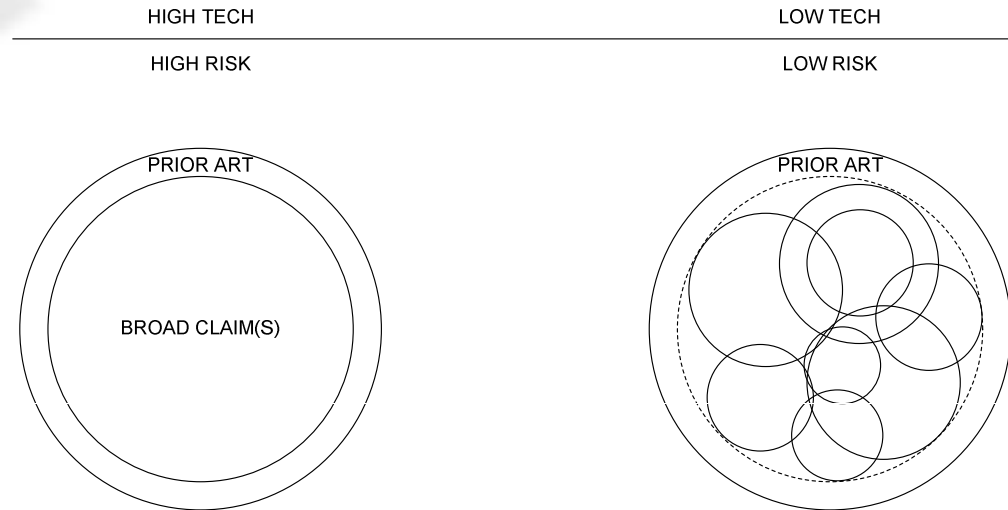
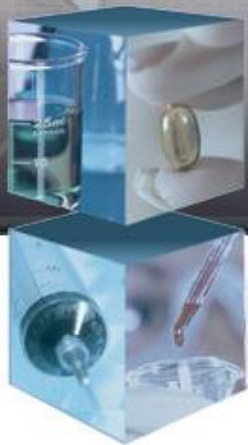


# Strategies for Maximizing IP Portfolios for Start Up Companies

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# Claiming Techniques



- **Pros:**
  - Captures more infringers
  - Reduces costs
  - Favors high tech
- **Cons:**
  - Easier to invalidate
  - Harder to prosecute
  - Disfavors low tech

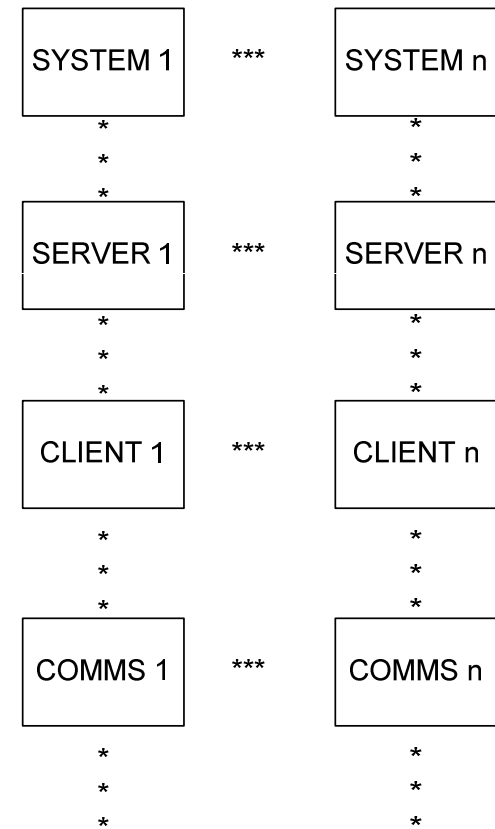
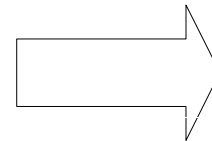
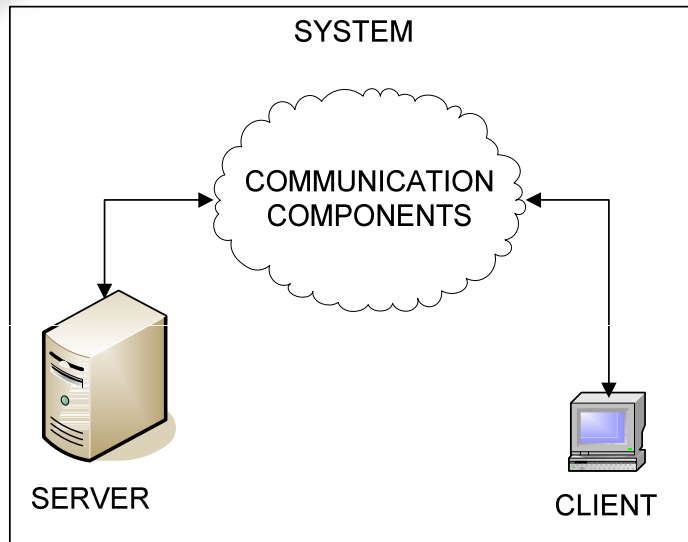
- **Pros:**
  - Harder to invalidate
  - Easier to prosecute
  - Favors low tech
- **Cons:**
  - Easier to design around
  - Increases costs
  - Disfavors high tech



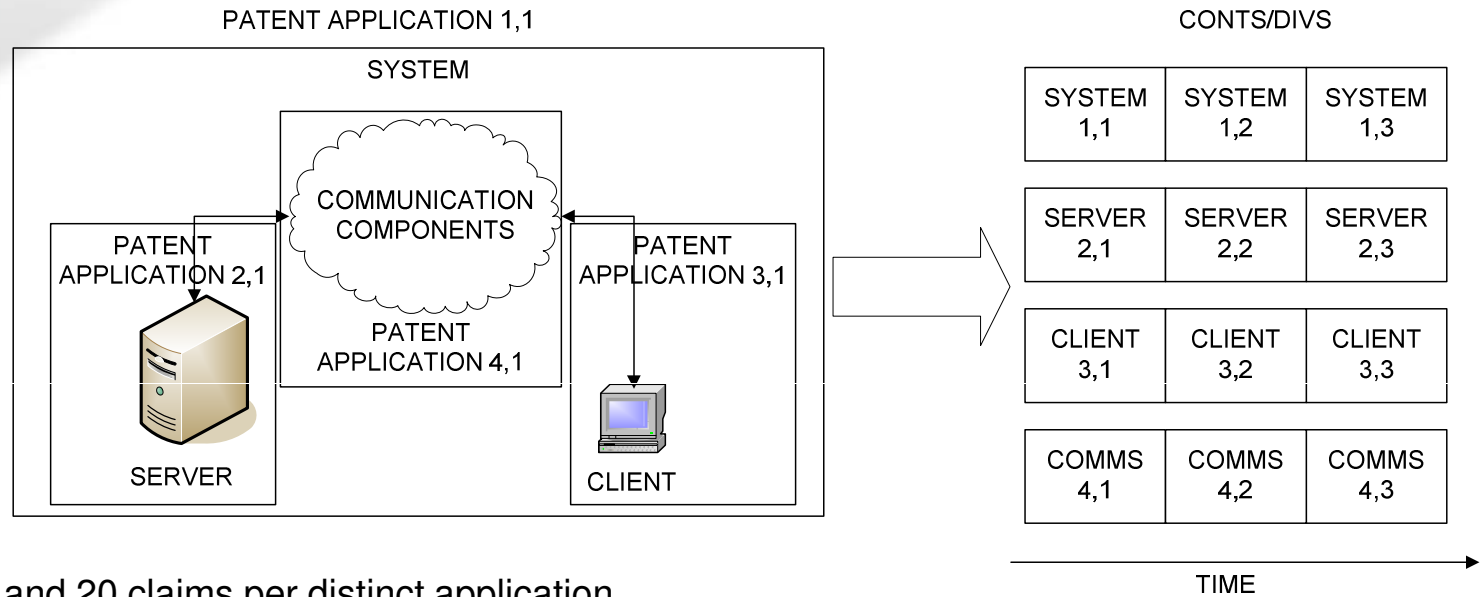
# Old Filing Techniques

PATENT APPLICATION

CONTS/DIVS

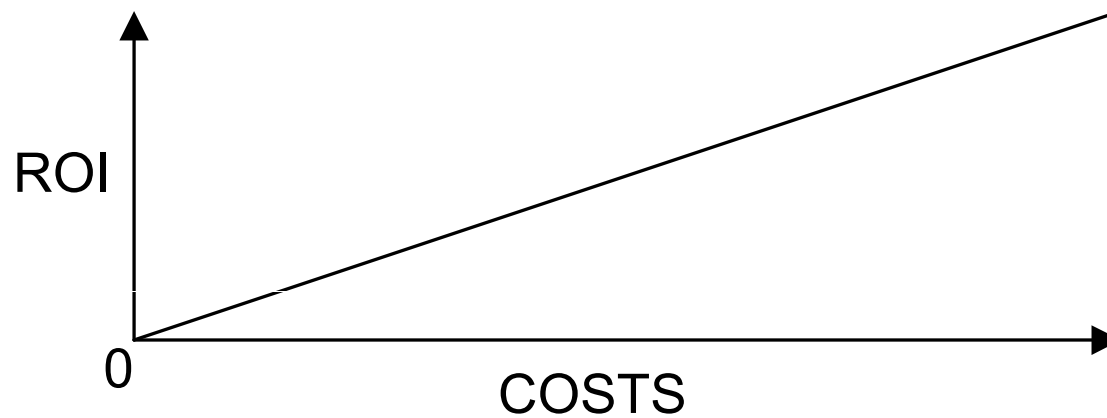


# New Filing Techniques



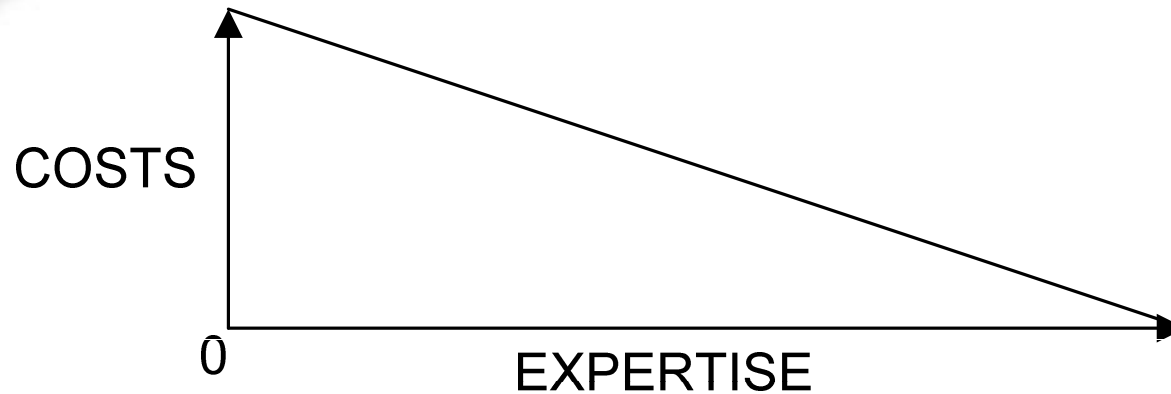
- 3 and 20 claims per distinct application
- Applications should be two-way distinct to maximize number of families per invention
- This strategy may not work well for bio-tech and chemical cases

# Metrics: ROI



- Increase in patent prosecution costs, should drive portfolio Return on Investment (ROI) analysis before filing

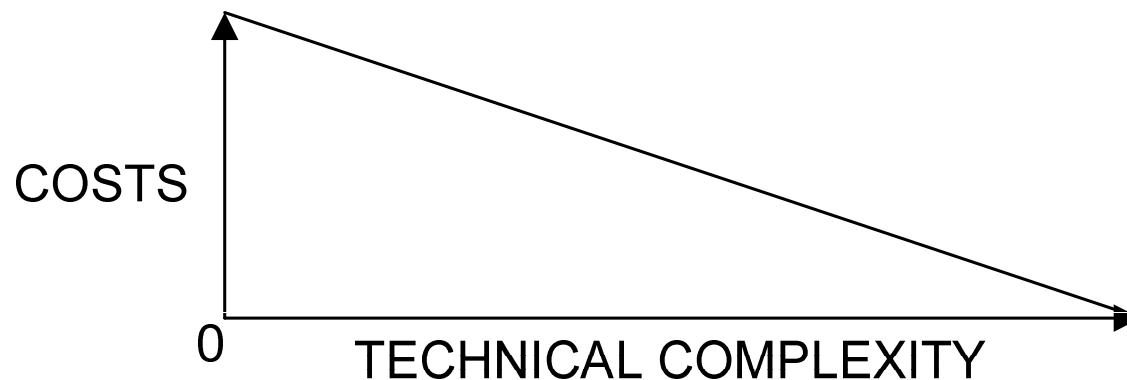
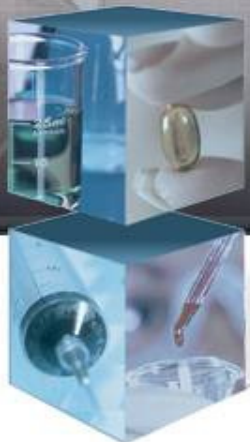
# Expertise



- Increased prosecution costs, should drive increase in expertise in patent portfolio planning and prosecution



# Technical Complexity



- Due to USPTO/court bias against low tech, high tech patent portfolios should cost less to prosecute than low tech patent portfolios



# KSR

- Graham v. John Deere factors still apply
- TSM (Teaching, Suggestion, Motivation) – applicable as one test under a more flexible review
- Other Considerations
  - “Combination” v. Non-combination patent?
  - Design Need/Market Pressure
  - Known Problem – Predictable Solution?
  - Look at Person of Ordinary Creativity
  - Use Ordinary Common Sense



# In Re Bilski

- New USPTO Guidelines for 35 USC § 101
  - whether a method claim qualifies as a patent eligible process under 35 USC § 101
    - whether the claim falls within one of the four statutory categories of invention recited in 35 USC § 101: process, machine, manufacture and composition of matter
    - The latter three categories define "things" or "products," while a "process" consists of a series of steps or acts to be performed
    - § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing.
      - If neither of these requirements is met by the claim, the method is not a patent eligible process under § 101 and should be rejected as being directed to non-statutory subject matter

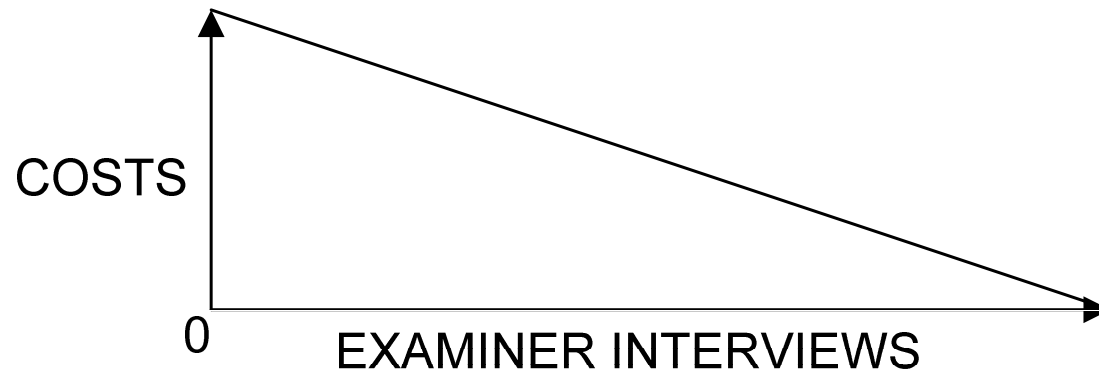


# In Re Bilski

- New USPTO Guidelines for 35 USC § 101
  - whether a method claim qualifies as a patent eligible process under 35 USC § 101
    - An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps
    - Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied,
      - for example, by identifying the apparatus that accomplishes the method steps, or
      - positively recite the subject matter that is being transformed, for example, by identifying the material that is being changed to a different state
    - If the claimed method is determined to be a statutory subject matter eligible process, the inquiry proceeds to determine whether the claimed invention falls within a judicial exception (law of nature, natural phenomena, or abstract idea)



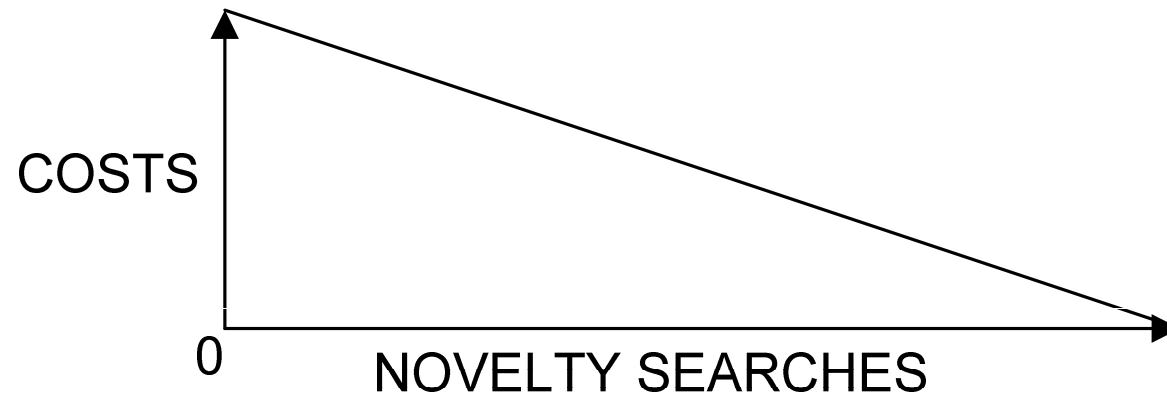
# Examiner Interviews



- Examiner interviews should help reduce patent prosecution costs



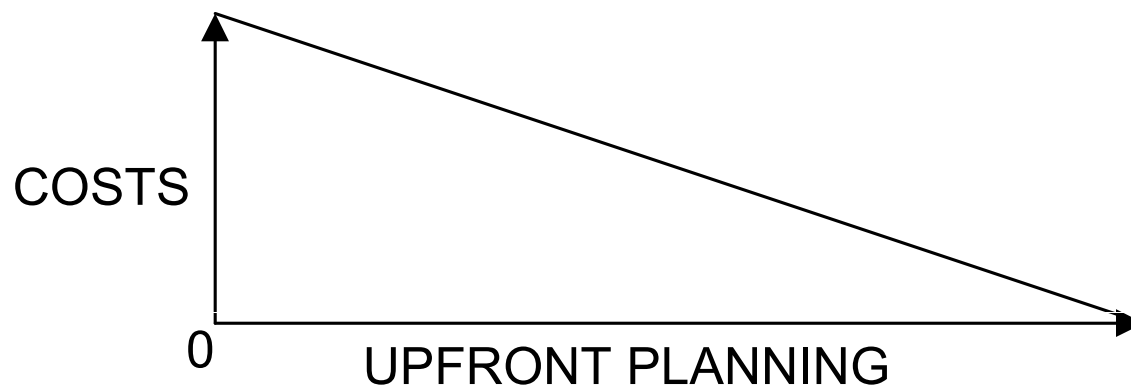
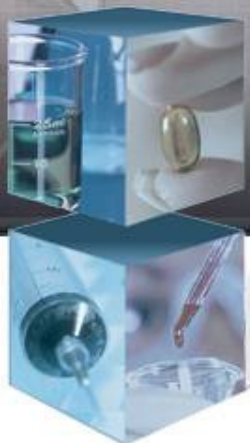
# Novelty Searches



- Novelty searches should help reduce patent prosecution costs



# Upfront Planning

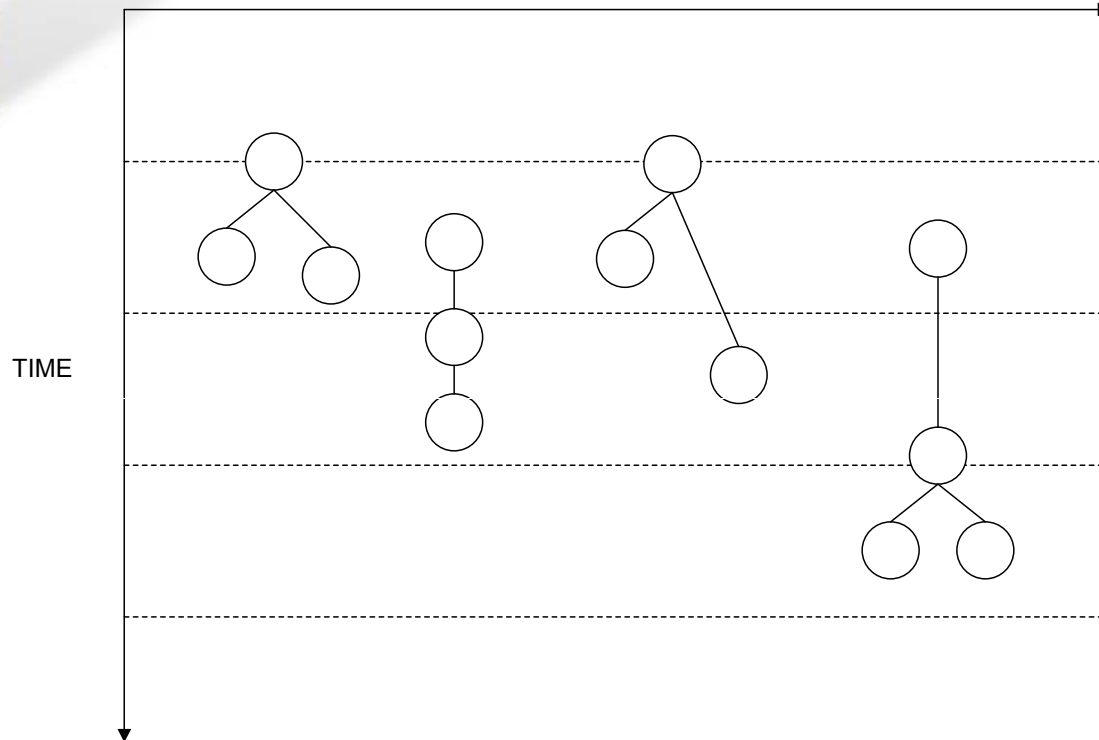


- Upfront planning should help reduce patent prosecution costs



# Temporal Family Trees

PATENT FAMILIES

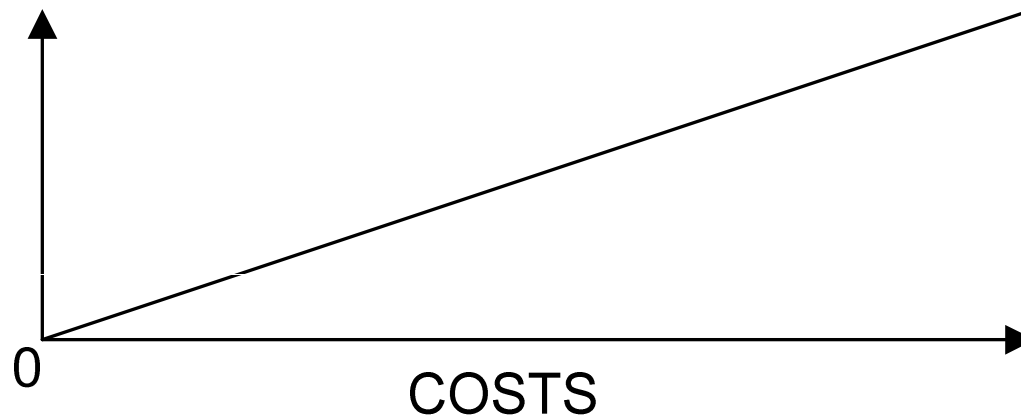


- For changing related case/IDS requirements, temporal family tree plotting should help avoid issues



# Appeals

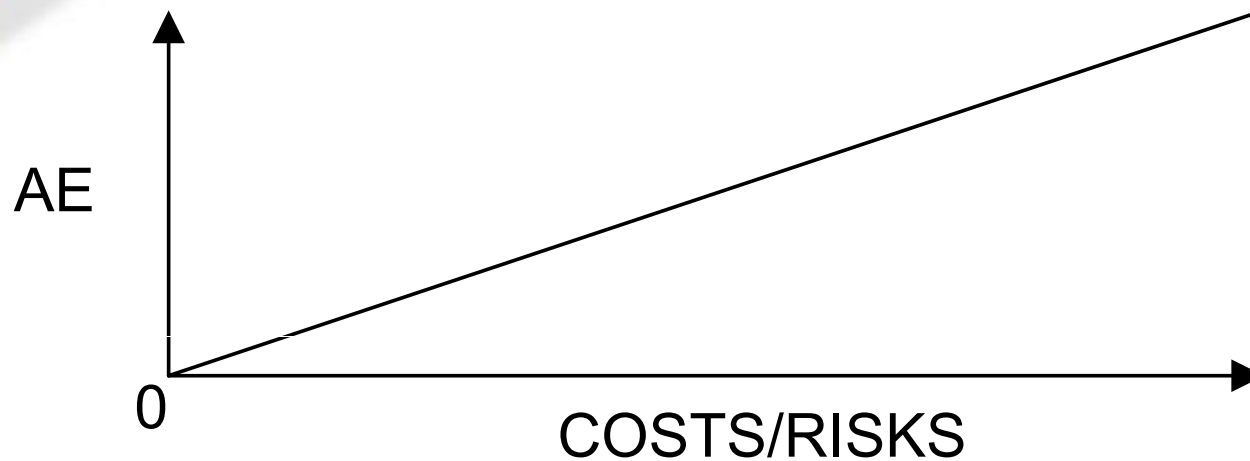
APPEALS



- For low tech, Appeals will need to be taken more often increasing patent prosecution costs

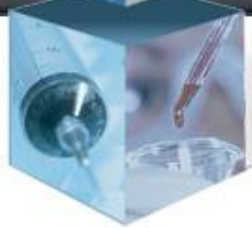
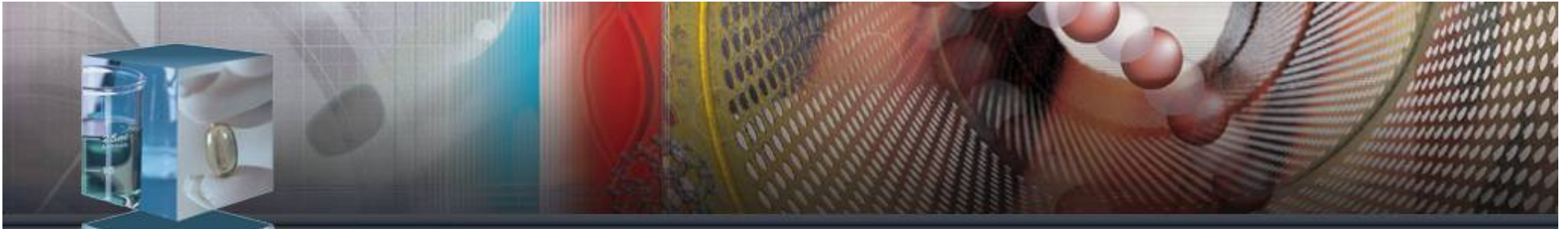


# Accelerated Examination



- Accelerated Examination (AE) will increase patent prosecution costs and possible inequitable conduct issues, but should decrease pendency





Thank you!

