Potomac LAW GROUP

# ACC National Capital Region Patent Bootcamp

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ACC Association of Corporate Counsel
NATIONAL CAPITAL REGION

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# Poll: How familiar are you with patents?

**(A) Very familiar**

**(B) Somewhat familiar**

**(C) Unfamiliar**

# Overview of Presentation

## Hour 1: Patent 101

**Legal/Practical Basics**

**Patenting Details**

## Hour 2: Deeper Dive

**Global Patenting**

**Additional Topics**

# What Patents Are NOT

## Trademarks

- Words or symbols identifying the source of a product or service
- Examples: company names, company logos, product names, product logos, etc.

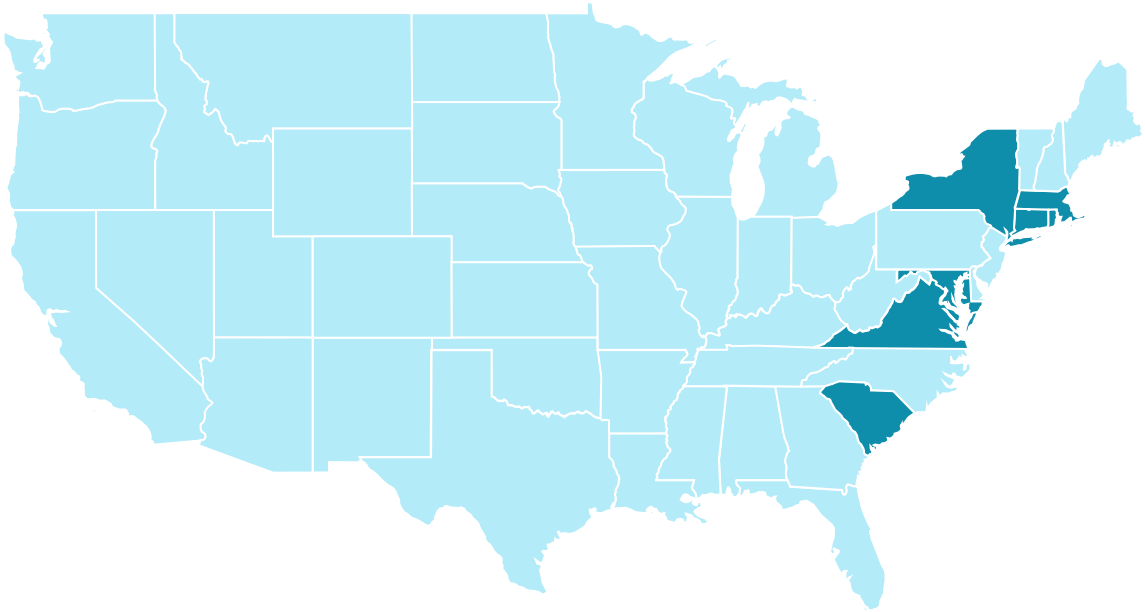
## Copyrights

- Expressions of an idea
- Examples: text (e.g., novels, poems, etc.), art, music, etc.

## Trade Secrets

- Information kept secret that provides a business advantage
- Examples: formulas, patterns, compilations, programs, processes, etc.
- Coca-Cola® recipe

# Patents: A Brief History



1641: Massachusetts is first colony with a patent law

Others soon follow suit:

- Connecticut
- South Carolina
- New York
- Maryland
- Rhode Island
- Virginia

# Patents: A Brief History

## 1789

- **U.S. Constitution gives Congress powers to grant rights to inventors (Article I, Section 8)**
  - Clause 8: *[The Congress shall have Power ...] To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.*

## 1790

- **Washington signs first federal Patent Act**
  - Defined the subject matter of a patent as "*any useful art, manufacture, engine, machine, or device, or any improvement there on not before known or used.*"
  - Granted the applicant "*sole and exclusive right and liberty of making, constructing, using and vending to others to be used*" of the invention

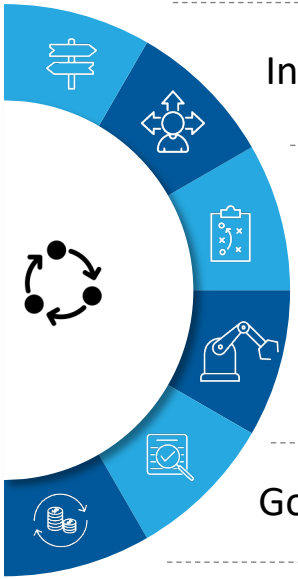
# U.S. Constitution

## Some Implications of Art. I, § 8

- Federal (not state) law applies
- Patent litigation is exclusive jurisdiction of:
  - Federal district courts
  - Court of Appeals of the Federal Circuit
  - U.S. Supreme Court
- Ownership of patents goes directly to inventors

# Patent quid pro quo

Inventor ⇔ government



Inventor publicly discloses the invention (instead of hiding as trade secret)

Public benefits from the disclosure

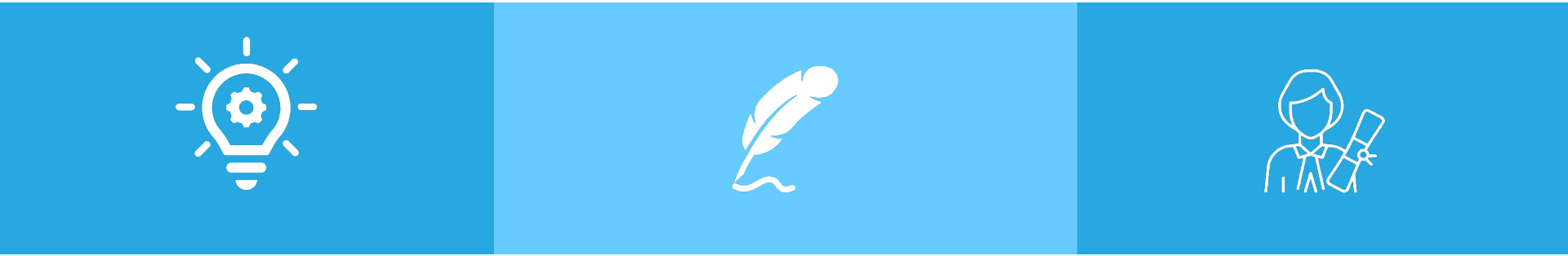
Public eventually can use the invention

Government grants exclusive rights to inventor

Inventor gains an advantage over competitors for a limited time

# Who Owns the Patent?

- **Initially, the inventor (per the Constitution)**
- **Assignee**
  - Owner by assignment
  - Generally, the inventor's employer
- **Employment contracts should proactively assign future inventions ("hereby assigns")**

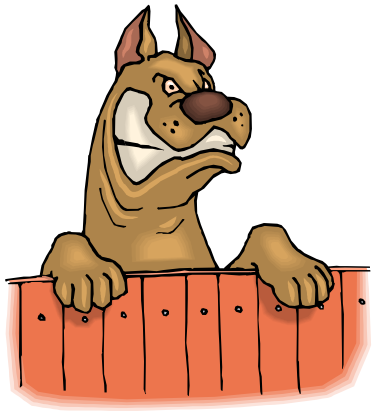


# Who is an inventor?

- **Inventorship (patent) ≠ authorship (article)**
- **Inventor contributes to the conception of the idea (as described in claims)**
- **Even a minor contribution to a single claim counts**
- **Caution: unintended inventors via ideas contributed by:**
  - Contractors
  - 3rd party partners
  - Customers

# What is Covered by a Patent?

- **The "invention"**
  - The subject matter described by the CLAIMS
  - Every word in a claim counts
  - Infringement = claim "reads on" accused product/method
- **The claims define the patent rights**
- ***"The name of the game is the claim."* – Judge Giles Rich**



# What is patentable?

**Devices/Materials:**

Mousetrap, smartphone parts, battery, software, chemicals (drugs/polymers) and mixtures

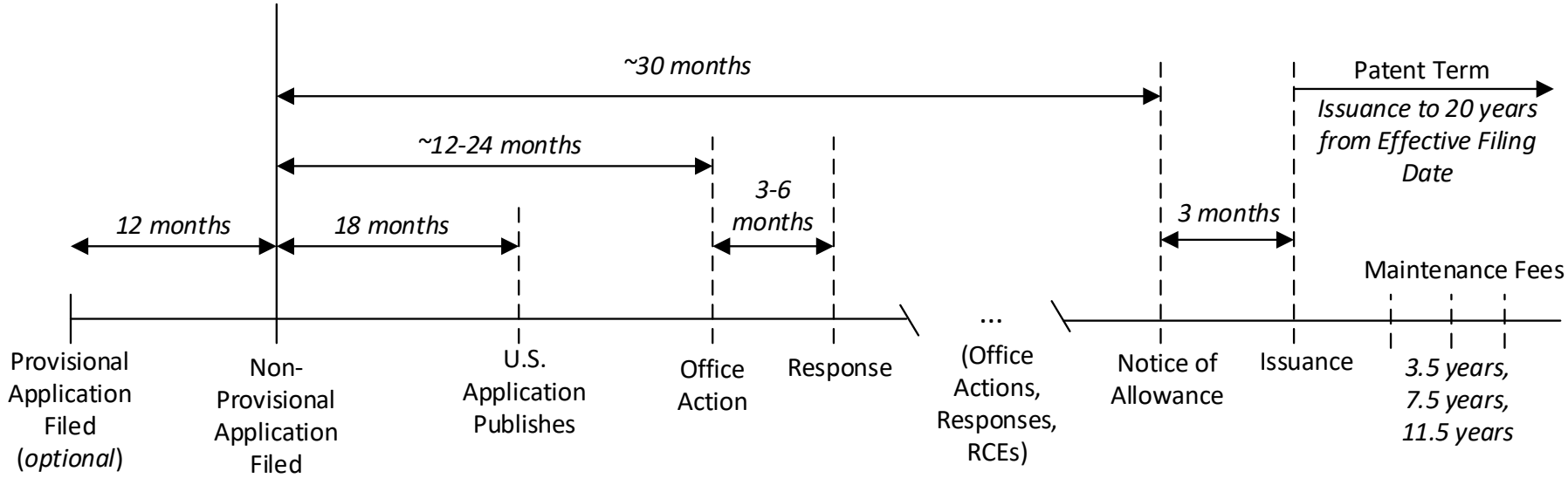
**Processes:**

Method of making/using a device/material, method of "getting something done"

**Generally NOT coverable:**

Math formula, product of nature (in isolation)

# Patent Timeline – United States



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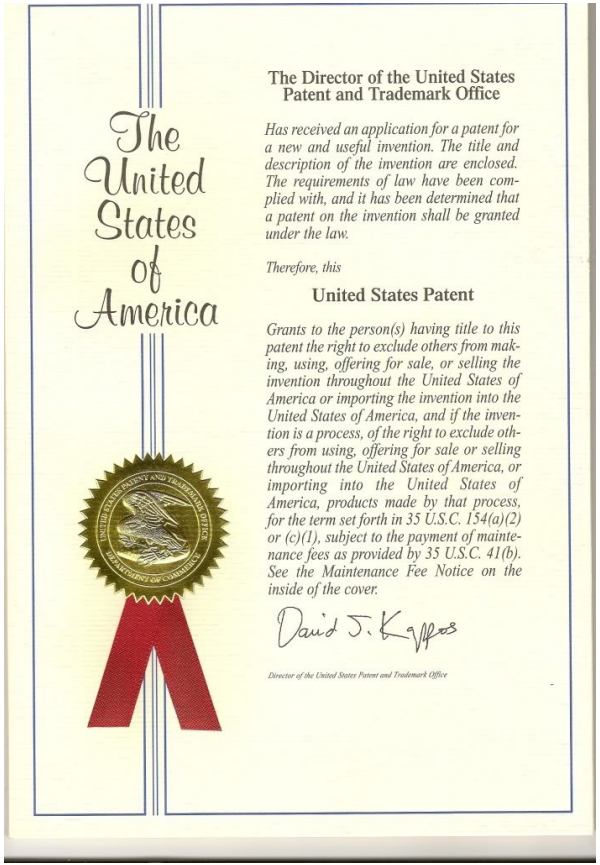
# Patent Certificate



The United States of America

The Director of the United States Patent and Trademark Office

*Has received an application for a patent for a new and useful invention. The title and description of the invention are enclosed. The requirements of law have been complied with, and it has been determined that a patent on the invention shall be granted under the law.*

*Therefore, this*

**United States Patent**

*Grants to the person(s) having title to this patent the right to exclude others from making, using, offering for sale, or selling the invention throughout the United States of America or importing the invention into the United States of America, and if the invention is a process, of the right to exclude others from using, offering for sale or selling throughout the United States of America, or importing into the United States of America, products made by that process, for the term set forth in 35 U.S.C. 154(a)(2) or (c)(1), subject to the payment of maintenance fees as provided by 35 U.S.C. 41(b). See the Maintenance Fee Notice on the inside of the cover.*

David J. Kappos

*Director of the United States Patent and Trademark Office*

# Patent Identifiers

- **Application number (upon filing)**
- **Publication number (upon publication)**
- **Patent number (upon grant)**


US011366011B2

(12) **United States Patent**
**Smith et al.**

(10) **Patent No.: US 11,366,011 B2**
(45) **Date of Patent: Jun. 21, 2022**

(54) **OPTICAL DEVICE**


(71) Applicant: **VIAVI Solutions Inc.**, San Jose, CA (US)

(72) Inventors: **Valton Smith**, Novato, CA (US); **William D. Houck**, Santa Rosa, CA (US)

(73) Assignee: **VIAVI Solutions Inc.**, San Jose, CA (US)


( * ) Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 176 days.


(21) Appl. No.: **16/784,928**

(22) Filed: **Feb. 7, 2020**

(65) **Prior Publication Data**

US 2020/0256727 A1 Aug. 13, 2020

**Related U.S. Application Data**

(60) Provisional application No. 62/805,048, filed on Feb. 13, 2019.

(51) **Int. Cl.**

| | |
|---|---|
| ***G01N 21/25*** | (2006.01) |
| ***G01J 3/02*** | (2006.01) |
| ***G02B 1/11*** | (2015.01) |
| ***G01J 3/28*** | (2006.01) |

(52) **U.S. Cl.**

CPC ..... ***G01J 3/0229*** (2013.01); ***G01J 3/2803*** (2013.01); ***G02B 1/11*** (2013.01); *G01J 2003/2806* (2013.01)

(58) **Field of Classification Search**

CPC ..... G01J 3/51; G01J 3/02; G01J 3/513; G01J 3/2803; G01J 3/46

USPC ..... 356/419

See application file for complete search history.


(56) **References Cited**

U.S. PATENT DOCUMENTS


| | | | | |
|---|---|---|---|---|
| 8,988,566 | B2 | 3/2015 | Wang et al. | |
| 10,168,459 | B2 | 1/2019 | Ockenfuss | |
| 10,651,216 | B2 | 5/2020 | Ockenfuss | |
| 2017/0034456 | A1 | 2/2017 | Kyung et al. | |
| 2017/0097451 | A1 | 4/2017 | Kyoung | |
| 2020/0193580 | A1 * | 6/2020 | McCall | H04N 5/332 |

FOREIGN PATENT DOCUMENTS

| | | | |
|---|---|---|---|
| CN | 104457708 | B | 7/2017 |
| EP | 3187910 | A1 | 7/2017 |
| TW | 2012148918 | A2 | 11/2012 |
| TW | 201407757 | A | 2/2014 |
| TW | 201706224 | A | 2/2017 |
| TW | 201734415 | A | 10/2017 |
| TW | 201827867 | A | 8/2018 |
| WO | 2012148919 | A2 | 11/2012 |

OTHER PUBLICATIONS

International Search Report and Written Opinion for Application No. PCT/US2020/017497, dated Jun. 8, 2020, 21 pages.

* cited by examiner


*Primary Examiner* — Md M Rahman

(74) *Attorney, Agent, or Firm* — Harrity & Harrity, LLP

(57) **ABSTRACT**


An optical device may comprise an array of sensor elements and an array of optical channels disposed on the array of sensor elements. At least one optical channel of the array of optical channels may be configured to pass bandpass filtered light to at least one sensor element of the array of sensor elements. At least one other optical channel of the array of optical channels may be configured to pass non-bandpass filtered light to at least one other sensor element of the array of sensor elements.


**20 Claims, 3 Drawing Sheets**



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# Patent identifiers

US 20200256727A1

(19) **United States**

(12) **Patent Application Publication**
**SMITH et al.**

(10) **Pub. No.: US 2020/0256727 A1**

(43) **Pub. Date: Aug. 13, 2020**

(54) **OPTICAL DEVICE**

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(72) Inventors: **Valton SMITH**, Novato, CA (US); **William D. HOUCK**, Santa Rosa, CA (US)

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USPC ..... 356/419
See application file for complete search history.

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**20 Claims, 3 Drawing Sheets**

# Sample Patent - Mousetrap

**United States Patent** [19]
**Boharski**

[11] **Patent Number: 4,641,456**
[45] **Date of Patent: Feb. 10, 1987**

[54] **MOUSE TRAP**

[76] Inventor: **Robert Boharski**, 7914 W. 92nd St., Hickory Hills, Ill. 60457

[21] Appl. No.: **691,206**

[22] Filed: **Jan. 14, 1985**

[51] **Int. Cl.**[4] ..... **A01M 1/12**
[52] **U.S. Cl.** ..... **43/73**
[58] **Field of Search** ..... 43/73, 99, 98, 60, 58, 43/65, 77, 76, 75

[56] **References Cited**

U.S. PATENT DOCUMENTS

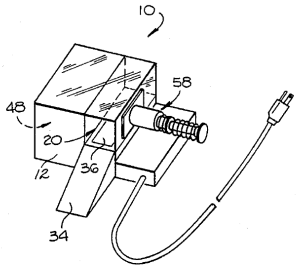
| | | | |
|---|---|---|---|
| 913,053 | 2/1909 | Riggs | 43/99 |
| 982,001 | 1/1911 | Hardegen | 43/73 |
| 1,281,876 | 10/1918 | Taylor | 43/99 |
| 1,464,697 | 8/1923 | Connolly | 43/75 |
| 2,445,166 | 7/1948 | Crumrine | 43/99 |
| 2,490,017 | 12/1949 | Crumrine | 43/99 |
| 4,145,834 | 3/1979 | Quigley | 43/73 |
| 4,250,655 | 2/1981 | Munns | 43/99 |

*Primary Examiner*—Gene P. Crosby
*Attorney, Agent, or Firm*—Paul H. Gallagher

[57] **ABSTRACT**

A housing has an entrance space into which the mouse enters. A pair of touchplates are embedded in the floor of that space, and when he steps on them, he bridges them and energizes a circuit for operating a pusher plate for pushing the mouse from the entrance space into a pit, where he is confined alive. A space is provided for bait at such location that the mouse is pushed into the pit before he can reach the bait. The pusher plate is actuated by a solenoid in a main circuit activated by a control that itself is energized by the presence of a mouse.

**4 Claims, 6 Drawing Figures**



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**United States Patent** [19]

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*Primary Examiner*—Gene P. Crosby

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A housing has an entrance space into which the mouse enters. A pair of touchplates are embedded in the floor of that space, and when he steps on them, he bridges them and energizes a circuit for operating a pusher plate for pushing the mouse from the entrance space into a pit, where he is confined alive. A space is provided for bait at such location that the mouse is pushed into the pit before he can reach the bait. The pusher plate is actuated by a solenoid in a main circuit activated by a control that itself is energized by the presence of a mouse.


**4 Claims, 6 Drawing Figures**

# Sample Patent - Mousetrap



FIG. **6** shows an alternative electrical circuit that may be used instead of that in FIG. **5**. In FIG. **6**, a source **90** is shown, from which a conductor **92** leads to the solenoid coil **65** and from the latter, a conductor **94** leads to a triac **96** and from the latter a conductor **98** leads to the source **90**. The foregoing circuit is normally inactive. A PE cell **100** includes elements **100***a*, **100***b* in conductors **102**, **104**, respectively, on opposite sides of the triac **96** and the source **90**. These elements are positioned on opposite sides of the entrance space **20** (FIG. **2**) and when the mouse moves between them, the triac is triggered, energizing the circuit and the solenoid **64**. The elements **100***a*, **100***b* are positioned at such location that when the mouse moves between them he will be in register with the trap door **54** and the pusher plate **60**, in the manner referred to above.

The instrumentalities, diode, SCR, triac and PE cell, may also be referred to as electric valves.

This electrical circuit produces an actuation of the solenoid that is extremely fast, and of only momentary duration, such as in the neighborhood of a single cycle of the solenoid and pusher plate. This fast action pushes the mouse from the entrance space into the pit, and as mentioned above, he has not yet reached the bait. The mouse is not injured because of the size and locations of the pusher plate and the trap door. The mouse is not pushed against any rigid objects, such as the bounding elements defining the opening **52** and the action of the pusher plate is considered entirely negligible, due to the nature of the animal. Experience has shown that mice trapped by this trap will enter into the trap again repeatedly after being released.

I claim:

**1**. A mouse trap comprising,

a housing defining an entrance space having a longitudinal direction and having an opening to the exterior to enable a mouse from the exterior to walk thereinto,

the housing having a pit on one side of and immediately adjacent the entrance space,

a pusher including a plate positioned with the plate on the other side of and immediately adjacent the entrance space,

spaced control elements in the entrance space positioned so as to enable them to be bridged in response to a mouse entering the entrance space, and the control elements being operable in response to being so bridged for actuating the pusher,

the housing also including a trap door normally closing the entrance space to the pit, but yielding in response to a mouse being pushed thereagainst and enabling a mouse to be thereby pushed into the pit, and the trap door thereafter re-assuming a closed position trapping the mouse in the pit, and the housing thereby being capable of so trapping the mouse in live condition,

circuitry including an electric valve having a control gate in series with the solenoid and operable for normally holding the solenoid inactive, and

the circuitry also including said control gate in series with said control elements and with the electrical source and the mouse upon touching the control elements completes circuit through the control elements and gate and the electrical source, and thereby completes circuit through the electric valve and energizes the solenoid.

**2**. A mouse trap comprising,

a housing defining an entrance space having a longitudinal direction and having an opening to the exterior to enable a mouse from the exterior to walk thereinto,

the housing having a pit on one side of and immediately adjacent the entrance space,

a pusher including a plate positioned with the plate on the other side of and immediately adjacent the entrance space,

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the housing also including a trap door normally closing the entrance space to the pit, but yielding in response to a mouse being pushed thereagainst and enabling a mouse to be thereby pushed into the pit, and the trap door thereafter re-assuming a closed position trapping the mouse in the pit, and the housing thereby being capable of so trapping the mouse in live condtion,

the pusher includes electrical means for operation thereof, and

the spaced control elements include electrically conductive touchplates in the electrical means and fixed in position in the entrance space, and positioned in spaced apart relation and operable in response to touching thereof by the mouse for completing circuit through the mouse and through the electrical means for operating the electrical means and thereby the pusher.

**3**. A mouse trap according to claim **2** wherein,

the housing defines a cavity beyond the touchplates in said entrance direction, constituting a position for bait beyond the reach of a mouse that is in position completing circuit between the touchplates.

**4**. A mouse trap according to claim **3** wherein,

said entrance space is defined by a floor element elevated relative to the bottom of the housing and thereby above the supporting surface on which the trap rests, and

the housing includes a ramp leading from the supporting surface to said floor element.

* * * * *

# Sample Patent - Mousetrap

I claim:

1. A mouse trap comprising,

a housing…having a pit (**48**) on one side…;

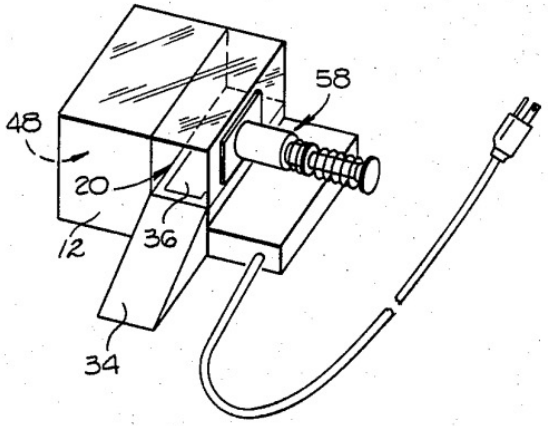
a pusher (**58**) including a plate…;

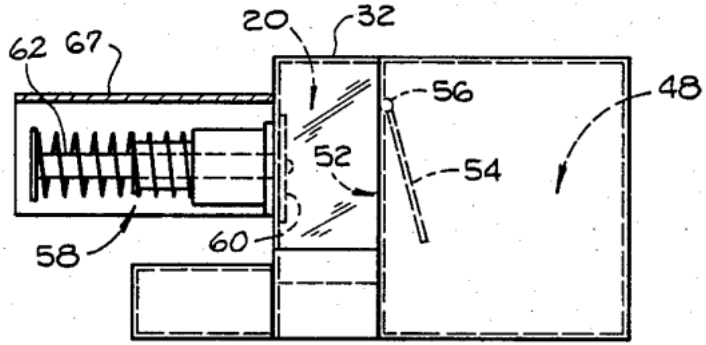
spaced control elements in the entrance space…for actuating the pusher;

the housing also including a trap door (**54**)…

the housing thereby being capable of so trapping the mouse in live condition; …

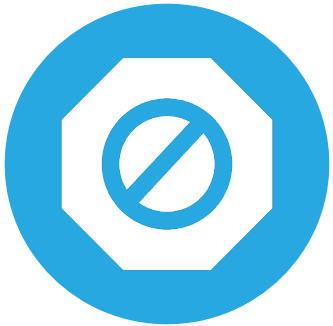
the mouse upon touching the control elements completes circuit through the control elements… .



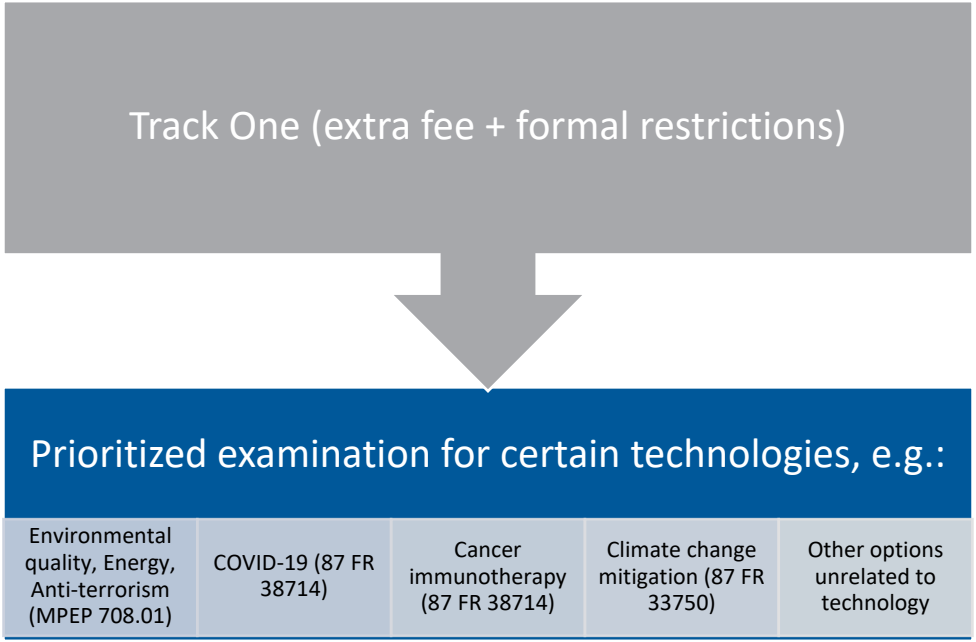



# An “Exclusive Right”

- **Government-granted “exclusive right” to an invention for a limited time**
- **A right to EXCLUDE others from using the invention**
- **This is not a right to practice the invention**
- **What’s the difference?**
  - Patentee (patent owner) may be subject to an earlier “dominating patent”
  - Example: improvement/selection inventions



# Need a Patent Faster?



# Poll: In which type of technology does your company innovate?

(A) Electrical/software

(B) Mechanical

(C) Chemical/life sciences

(D) No technological innovation

# End of Hour 1: Patents 101

# ACC National Capital Region – Patent Bootcamp

## Hour 2: Deeper Dive

**Global Patenting**

**Additional Topics**

# Poll: How often you do encounter patent issues?

(A) Very often

(B) Somewhat often

(C) Rarely or never

# Global Patenting

Patent rights are limited to actions in the issuing country

Global coverage requires patent in each country of interest

United Nations has 193 member states

More country coverage = greater cost

Patent office fees can be high

- USPTO is a “fully fee-funded agency”
- Many foreign patent offices start charging annual fees upon filing an application (USPTO charges maintenance fees only after grant)

Local counsel is usually needed in each country

# Global Patenting

Where to patent is a business decision

Factors to consider:

- Where is your product made?
- Where is your product sold?
- Where are your competitors?
- Where are the largest current/future markets?
- How strong are patent laws in each country?

# The Paris Convention (1883)

**1-year grace period for foreign filing**

- File in a member state on date X
- File in other member states within 1 year of X
  - Date X is the “effective filing date”

**A state must be a member to join other major patent treaties**

**Regional patent offices simplify process**

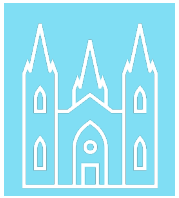
# What is a patent “family”?

## All patents related by priority

- All patents in a family claim priority to the same original application
- Patents in different countries
- Continuations and divisionals in same country

## Patent text (“specification”) is essentially the same

## Claims may differ but generally relate to same “invention”



# EPO
# A “regional patent office”

**European Patent Office (EPO)**

**Centralizes examination: One procedure can yield up to 39 patents.**

**Established in 1977 by the European Patent Convention (EPC), an “intergovernmental organization”**

**EPO has 39 member states**

- Separate from the European Union (27 member states)
- EPO does not include all states of European Union

**Granted EPO patents must be converted (“validated”) into patents in each desired member state.**

**Validated patents only have force in the particular member state**

**Unitary Patent and Unified Patent Court in progress for at least 10 years. Current projection is “possibly by 2023.”**

# Patent Cooperation Treaty (PCT)

Centralizes global filings – a placeholder allowing delay of examination and choice of countries

A system for centralized patent filing (some limited examination)

Established in 1970 **under the World Intellectual Property Organization (WIPO)**

Member states:  156

No provisions for granting patents (no “PCT patent”)

**Benefits:**

- Lowers cost via single application effective for multiple countries
- Delays foreign filing decisions up to 30 months

**Trade-offs:**

- Patent life remains 20 years from the priority date
- Not useful if you need a patent quickly

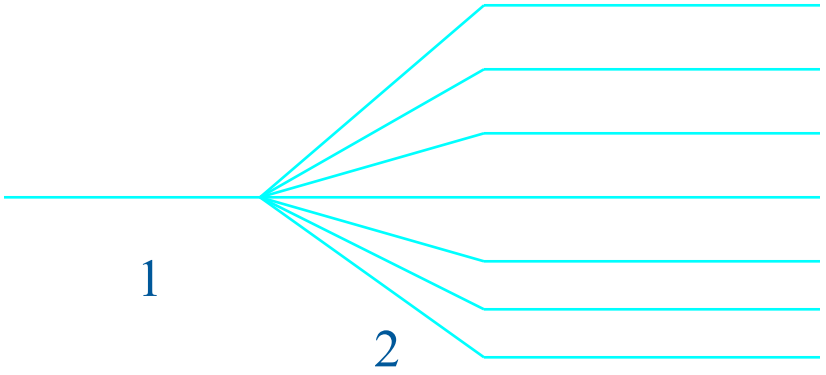
# PCT Phases

## 1. International phase

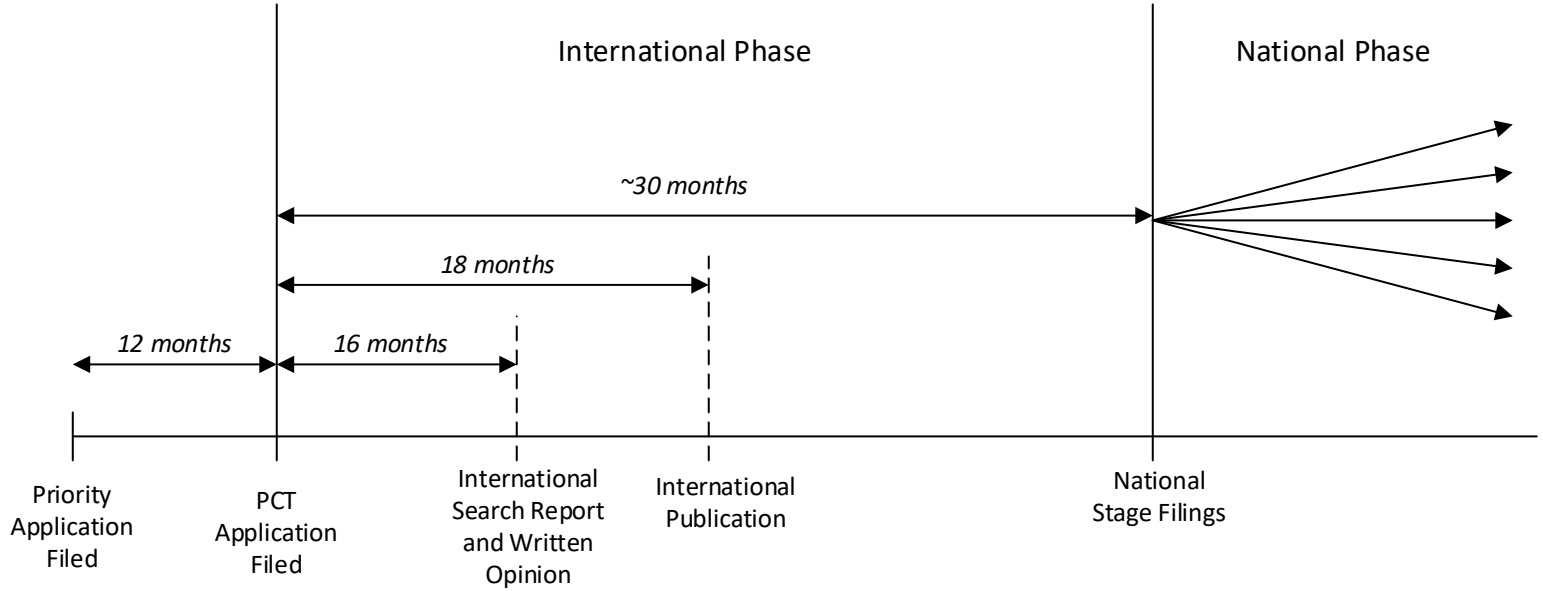
- Single application under PCT

## 2. National phase

- Multiple applications handled separately
- Individual patent offices evaluate patentability
- Independent grant decisions by patent offices
- Costs may skyrocket



# PCT Timeline



# Country Codes

**Two-letter code preceding patent (or application) number**

- Code indicates
  - Country: US, JP, GB, CN, etc.
  - Regional: EP
  - PCT application: WO
- Examples:
  - US 6,500,334
  - EP 0 416 373
  - WO 98 13044

# USPTO

Responsible agency: U.S. Patent and Trademark Office (USPTO)

USPTO issues about 7,200 patents every Tuesday

USPTO publishes patent applications every Thursday

About 8,000 patent examiners

>100 Administrative Patent Judges

See https://www.uspto.gov/sites/default/files/documents/USPTOFY21PAR.pdf

# What is “Prior Art”?

Any document properly applied to argue that a claim is anticipated or obvious

Anticipation: The prior art covers the claim

Obviousness: The prior art makes obvious what is covered by the claim

# Anticipation

Must file before invention is known in the world

Prior art must not have every element of your claim

File a patent application before making the invention public!

35 U.S.C. 102

Prior invention or disclosure of the claimed invention by another, or the inventor's own disclosure of the claimed invention by publication, sale, or offer to sell prior to the inventor's application for patent

Example

Claim:

A chair comprising a seat and 3 legs

Prior Art Disclosure > 1 year prior:

A chair comprising a seat and 4 legs

# Obviousness

## Claimed invention must not be too close to what is known

- Can combine prior art references to find the invention obvious
- Must have motivation to combine

## Rationale is specific and legal

- Not just “anyone would have thought of that”
- Cannot use hindsight

## 35 U.S.C. 103

- Would the differences between the claimed invention and the prior art such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains?

# Enforcement

- There are no “patent police”
- Patent infringement is a tort – not a criminal violation
- Patentee must identify infringers
- Patentee must sue infringers in federal court

# To have an effect, a patent must be:

- **Granted & in force**
  - Maintenance fees paid
- **Valid**
- **Enforceable**
  - Inequitable conduct?
  - Laches or equitable estoppel?
- **When can we say “patent pending”?**
  - Upon filing: “patent pending”
  - Upon grant: “patented”
  - Virtual marking: “Pat. www.website.com” (web site lists patent numbers)

# Trolls

"A derogatory term used to describe a company that uses patent infringement claims to win court judgments for profit"

Nothing inherently wrong with a company asserting patents without making any products of its own

Problem tactics include:

| | | |
|---|---|---|
| Sending cease & desist letters without investigating allegations | Asking for licensing fees well below cost of litigation, sometimes less than the cost of obtaining a legal opinion and litigation counseling | Asserting numerous patents merely to raise costs for victims |

# Licensing

A license is a promise not to sue

Licensee may be covered by another patent

Key provisions:

List of patents covered

“Field of use” or geographical restrictions

Choice of laws/venue (IPR can be excluded)

Who controls prosecution of applications, enforcement of patents

Is it a license or an assignment? Name of document is not dispositive.

# Patent Litigation

- Patent litigation can be very expensive ($2M to $5M)
- Patent litigation can take 3 to 5+ years
- District court judges have no technical background, juries may lack college degrees
- “Markman hearing” decides claim scope; often ends litigation
- To reduce cost and risk, accused infringer can assert invalidity at USPTO via Inter Partes Review (IPR)

# Inter Partes Review ("IPR")

- **Permits challenging validity before panel of USPTO Patent Trial and Appeal Board (PTAB)**
- **District courts generally stay litigation pending IPR outcome**
- **Cost ($0.5 to $1.5M) is significantly lower than litigation**
  - IPR cost has risen as procedure has become more complex
- **Very fast: IPR final decision within 1 year of initiation**
- **Available throughout life of patent**
- **Invalidity grounds are limited to prior art**
- **Less common option is Post Grant Review ("PGR")**
  - Only available 9 months after grant
  - Advantage: invalidity grounds not limited to prior art

# Court of Appeals for the Federal Circuit

**Jurisdiction includes all patent cases appealed from:**

- Federal district courts
- USPTO Patent Trial and Appeal Board
- U.S. Court of Federal Claims
- U.S. International Trade Commission

**Created in 1982 by combining:**

- U.S. Court of Customs and Patent Appeals
- U.S. Court of Claims, appellate division

# Glossary of U.S. application types

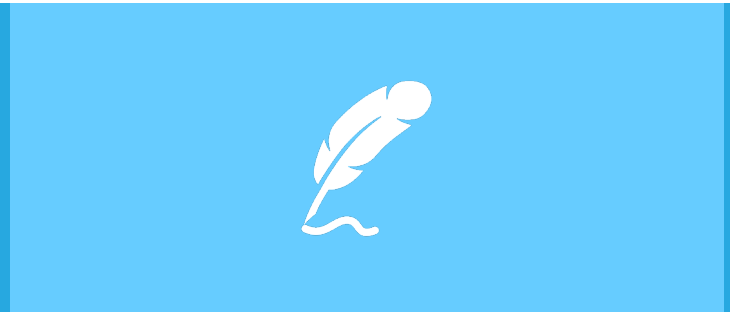
| TYPE | DESCRIPTION |
|---|---|
| Provisional | No examination. Retains right to filing date. Grace period. Not relevant to patent term. |
| Non-Provisional | A “normal” application. Full examination. Filing date starts 20-year patent term. |
| Continuation | Applicant re-files application to continue USPTO proceedings. Unlimited number of CONTs possible. Claims to any supported subject matter. |
| Continuation-in-part (CIP) | Same as continuation but adds some unspecified new matter. |
| Divisional | Same as continuation but claims are limited to distinct Group based on prior Restriction. |
| RCE | Not an application type (application number is retained); reopens examination after final rejection |

# Poll: Does your company have a process for inventors to submit ideas for patent applications?

**(A) Yes, we have a formal process**

**(B) Yes, we have an informal process**

**(C) No, we do not have a process**



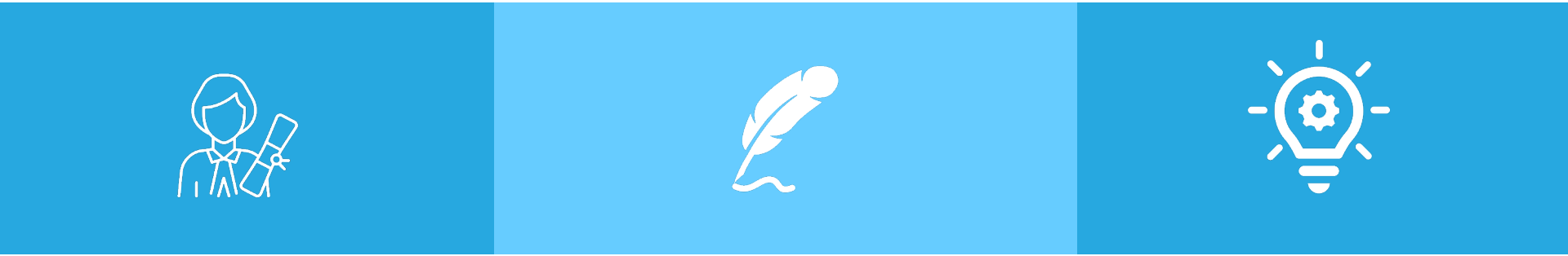
# Poll: How many patent applications does your company file per year?

**(A) More than 50**

**(B) Some, but less than 50**

**(C) Some, but I don't know how many**

**(D) None**



# ACC National Capital Region Patent Bootcamp

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## Thank you For Your Attendance

## Questions