

Patents

*Protecting your Company's
inventions for today and the future*



***ASM/ASME JOINT MEETING
SEPTEMBER 15, 2008***

*Presented by:
Charles R. Reeves
Telephone (317) 713-4909
E-mail: creeves@uspatent.com*



**WOODARD, EMHARDT, MORIARTY,
MCNETT & HENRY LLP**

Why obtain patents?

To protect market share.

Art. 1, Sec. 8, CL. 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.”



Patents: Utility & Design

- **Utility Patent** – protects the *functional* aspects of an invention.
 - 35 U.S.C. Section 101 . . . “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof”
 - Has written “claims”.
- **Design Patent** – protects the *ornamental* aspects of a product.
 - 35 U.S.C. 171 . . . “any new, original and ornamental design for an article of manufacture”
 - No written “claims”; rather the drawings define the scope of protection.



Example Design Patents

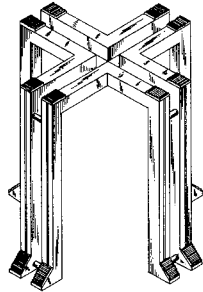
United States Patent [14]



U.S. Pat. No. 337,906
 [11] Patent Number: Des. 337,906
 [45] Date of Patent: Aug. 3, 1993

[54] TABLE BASE
 [75] Inventor: David R. Gussell, Jasper, Ind.
 [73] Assignee: Duro Sales, Inc., Jasper, Ind.
 [21] Term: 14 Years
 [21] Appl. No.: 039,638
 [22] Filed: Sep. 3, 1992

Related U.S. Application Data
 Division of Ser. No. 356,555, Jul. 18, 1990.
 U.S. Cl. Des. 425
 [58] Field of Search: Des. 425, 426, 427, 428, 429, 430, 431, 432, 433, 434, 435, 436, 437, 438, 439, 440, 441, 442, 443, 444, 445, 446, 447, 448, 449, 450, 451, 452, 453, 454, 455, 456, 457, 458, 459, 460, 461, 462, 463, 464, 465, 466, 467, 468, 469, 470, 471, 472, 473, 474, 475, 476, 477, 478, 479, 480, 481, 482, 483, 484, 485, 486, 487, 488, 489, 490, 491, 492, 493, 494, 495, 496, 497, 498, 499, 500, 501, 502, 503, 504, 505, 506, 507, 508, 509, 510, 511, 512, 513, 514, 515, 516, 517, 518, 519, 520, 521, 522, 523, 524, 525, 526, 527, 528, 529, 530, 531, 532, 533, 534, 535, 536, 537, 538, 539, 540, 541, 542, 543, 544, 545, 546, 547, 548, 549, 550, 551, 552, 553, 554, 555, 556, 557, 558, 559, 560, 561, 562, 563, 564, 565, 566, 567, 568, 569, 570, 571, 572, 573, 574, 575, 576, 577, 578, 579, 580, 581, 582, 583, 584, 585, 586, 587, 588, 589, 590, 591, 592, 593, 594, 595, 596, 597, 598, 599, 600, 601, 602, 603, 604, 605, 606, 607, 608, 609, 610, 611, 612, 613, 614, 615, 616, 617, 618, 619, 620, 621, 622, 623, 624, 625, 626, 627, 628, 629, 630, 631, 632, 633, 634, 635, 636, 637, 638, 639, 640, 641, 642, 643, 644, 645, 646, 647, 648, 649, 650, 651, 652, 653, 654, 655, 656, 657, 658, 659, 660, 661, 662, 663, 664, 665, 666, 667, 668, 669, 670, 671, 672, 673, 674, 675, 676, 677, 678, 679, 680, 681, 682, 683, 684, 685, 686, 687, 688, 689, 690, 691, 692, 693, 694, 695, 696, 697, 698, 699, 700, 701, 702, 703, 704, 705, 706, 707, 708, 709, 710, 711, 712, 713, 714, 715, 716, 717, 718, 719, 720, 721, 722, 723, 724, 725, 726, 727, 728, 729, 730, 731, 732, 733, 734, 735, 736, 737, 738, 739, 740, 741, 742, 743, 744, 745, 746, 747, 748, 749, 750, 751, 752, 753, 754, 755, 756, 757, 758, 759, 760, 761, 762, 763, 764, 765, 766, 767, 768, 769, 770, 771, 772, 773, 774, 775, 776, 777, 778, 779, 780, 781, 782, 783, 784, 785, 786, 787, 788, 789, 790, 791, 792, 793, 794, 795, 796, 797, 798, 799, 800, 801, 802, 803, 804, 805, 806, 807, 808, 809, 810, 811, 812, 813, 814, 815, 816, 817, 818, 819, 820, 821, 822, 823, 824, 825, 826, 827, 828, 829, 830, 831, 832, 833, 834, 835, 836, 837, 838, 839, 840, 841, 842, 843, 844, 845, 846, 847, 848, 849, 850, 851, 852, 853, 854, 855, 856, 857, 858, 859, 860, 861, 862, 863, 864, 865, 866, 867, 868, 869, 870, 871, 872, 873, 874, 875, 876, 877, 878, 879, 880, 881, 882, 883, 884, 885, 886, 887, 888, 889, 890, 891, 892, 893, 894, 895, 896, 897, 898, 899, 900, 901, 902, 903, 904, 905, 906, 907, 908, 909, 910, 911, 912, 913, 914, 915, 916, 917, 918, 919, 920, 921, 922, 923, 924, 925, 926, 927, 928, 929, 930, 931, 932, 933, 934, 935, 936, 937, 938, 939, 940, 941, 942, 943, 944, 945, 946, 947, 948, 949, 950, 951, 952, 953, 954, 955, 956, 957, 958, 959, 960, 961, 962, 963, 964, 965, 966, 967, 968, 969, 970, 971, 972, 973, 974, 975, 976, 977, 978, 979, 980, 981, 982, 983, 984, 985, 986, 987, 988, 989, 990, 991, 992, 993, 994, 995, 996, 997, 998, 999, 1000.

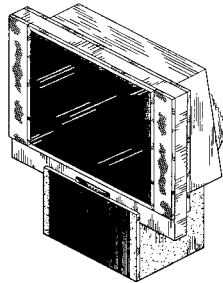


United States Patent [14]

U.S. Pat. No. 596,058
 [11] Patent Number: Des. 596,058
 [45] Date of Patent: Sep. 25, 1992

[54] REAR PROJECTION TELEVISION
 [75] Inventor: Richard A. Bourgeois, Noblesville, Ind.
 [73] Assignee: Thompson Consumer Electronics, Inc., Indianapolis, Ind.
 [21] Term: 14 Years
 [21] Appl. No.: 956,058

[52] U.S. Cl. Des. 124/126, 124/133, 124/134, 124/135, 124/136, 124/137, 124/138, 124/139, 124/140, 124/141, 124/142, 124/143, 124/144, 124/145, 124/146, 124/147, 124/148, 124/149, 124/150, 124/151, 124/152, 124/153, 124/154, 124/155, 124/156, 124/157, 124/158, 124/159, 124/160, 124/161, 124/162, 124/163, 124/164, 124/165, 124/166, 124/167, 124/168, 124/169, 124/170, 124/171, 124/172, 124/173, 124/174, 124/175, 124/176, 124/177, 124/178, 124/179, 124/180, 124/181, 124/182, 124/183, 124/184, 124/185, 124/186, 124/187, 124/188, 124/189, 124/190, 124/191, 124/192, 124/193, 124/194, 124/195, 124/196, 124/197, 124/198, 124/199, 124/200, 124/201, 124/202, 124/203, 124/204, 124/205, 124/206, 124/207, 124/208, 124/209, 124/210, 124/211, 124/212, 124/213, 124/214, 124/215, 124/216, 124/217, 124/218, 124/219, 124/220, 124/221, 124/222, 124/223, 124/224, 124/225, 124/226, 124/227, 124/228, 124/229, 124/230, 124/231, 124/232, 124/233, 124/234, 124/235, 124/236, 124/237, 124/238, 124/239, 124/240, 124/241, 124/242, 124/243, 124/244, 124/245, 124/246, 124/247, 124/248, 124/249, 124/250, 124/251, 124/252, 124/253, 124/254, 124/255, 124/256, 124/257, 124/258, 124/259, 124/260, 124/261, 124/262, 124/263, 124/264, 124/265, 124/266, 124/267, 124/268, 124/269, 124/270, 124/271, 124/272, 124/273, 124/274, 124/275, 124/276, 124/277, 124/278, 124/279, 124/280, 124/281, 124/282, 124/283, 124/284, 124/285, 124/286, 124/287, 124/288, 124/289, 124/290, 124/291, 124/292, 124/293, 124/294, 124/295, 124/296, 124/297, 124/298, 124/299, 124/300.

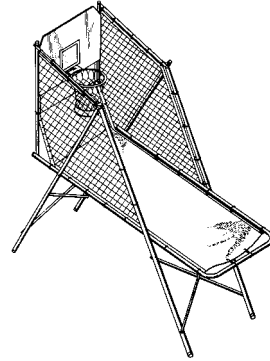


United States Patent [14]



U.S. Pat. No. 326,128
 [11] Patent Number: Des. 326,128
 [45] Date of Patent: May 12, 1992

[54] COMBINED BASKETBALL GOAL AND RETURN NET
 [75] Inventor: Max D. Smith, Evansville, Ind.
 [73] Assignee: Delta Industries, Evansville, Ind.
 [21] Term: 14 Years
 [21] Appl. No.: 385,568
 [22] Filed: Aug. 4, 1990
 [52] U.S. Cl. Des. 222/203, 222/204, 222/205, 222/206, 222/207, 222/208, 222/209, 222/210, 222/211, 222/212, 222/213, 222/214, 222/215, 222/216, 222/217, 222/218, 222/219, 222/220, 222/221, 222/222, 222/223, 222/224, 222/225, 222/226, 222/227, 222/228, 222/229, 222/230, 222/231, 222/232, 222/233, 222/234, 222/235, 222/236, 222/237, 222/238, 222/239, 222/240, 222/241, 222/242, 222/243, 222/244, 222/245, 222/246, 222/247, 222/248, 222/249, 222/250, 222/251, 222/252, 222/253, 222/254, 222/255, 222/256, 222/257, 222/258, 222/259, 222/260, 222/261, 222/262, 222/263, 222/264, 222/265, 222/266, 222/267, 222/268, 222/269, 222/270, 222/271, 222/272, 222/273, 222/274, 222/275, 222/276, 222/277, 222/278, 222/279, 222/280, 222/281, 222/282, 222/283, 222/284, 222/285, 222/286, 222/287, 222/288, 222/289, 222/290, 222/291, 222/292, 222/293, 222/294, 222/295, 222/296, 222/297, 222/298, 222/299, 222/300.

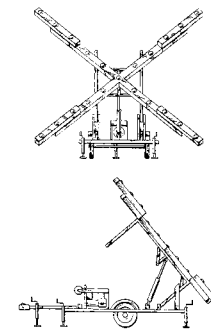


United States Patent [14]



U.S. Pat. No. 332,233
 [11] Patent Number: Des. 332,233
 [45] Date of Patent: Jan. 5, 1993

[54] RUNWAY MARKER FOR AIRPORTS
 [75] Inventor: John B. Batts, Ashland, Ind.
 [73] Assignee: Batts, Inc., Ashland, Ind.
 [21] Term: 14 Years
 [21] Appl. No.: 603,408
 [22] Filed: Apr. 30, 1991
 [52] U.S. Cl. Des. 100/184, 100/185, 100/186, 100/187, 100/188, 100/189, 100/190, 100/191, 100/192, 100/193, 100/194, 100/195, 100/196, 100/197, 100/198, 100/199, 100/200, 100/201, 100/202, 100/203, 100/204, 100/205, 100/206, 100/207, 100/208, 100/209, 100/210, 100/211, 100/212, 100/213, 100/214, 100/215, 100/216, 100/217, 100/218, 100/219, 100/220, 100/221, 100/222, 100/223, 100/224, 100/225, 100/226, 100/227, 100/228, 100/229, 100/230, 100/231, 100/232, 100/233, 100/234, 100/235, 100/236, 100/237, 100/238, 100/239, 100/240, 100/241, 100/242, 100/243, 100/244, 100/245, 100/246, 100/247, 100/248, 100/249, 100/250, 100/251, 100/252, 100/253, 100/254, 100/255, 100/256, 100/257, 100/258, 100/259, 100/260, 100/261, 100/262, 100/263, 100/264, 100/265, 100/266, 100/267, 100/268, 100/269, 100/270, 100/271, 100/272, 100/273, 100/274, 100/275, 100/276, 100/277, 100/278, 100/279, 100/280, 100/281, 100/282, 100/283, 100/284, 100/285, 100/286, 100/287, 100/288, 100/289, 100/290, 100/291, 100/292, 100/293, 100/294, 100/295, 100/296, 100/297, 100/298, 100/299, 100/300.



United States Patent [14]



U.S. Pat. No. 347,800
 [11] Patent Number: Des. 347,800
 [45] Date of Patent: Sep. 8, 1992

[54] WRIST-WATCH
 [75] Inventor: Ernest Schneider, Evidard, Switzerland
 [73] Assignee: Breitling Montres S.A., Grenchen, Switzerland
 [21] Term: 14 Years
 [21] Appl. No.: 465,386
 [22] Filed: Sep. 8, 1989
 [52] U.S. Cl. Des. 110/39, 110/40, 110/41, 110/42, 110/43, 110/44, 110/45, 110/46, 110/47, 110/48, 110/49, 110/50, 110/51, 110/52, 110/53, 110/54, 110/55, 110/56, 110/57, 110/58, 110/59, 110/60, 110/61, 110/62, 110/63, 110/64, 110/65, 110/66, 110/67, 110/68, 110/69, 110/70, 110/71, 110/72, 110/73, 110/74, 110/75, 110/76, 110/77, 110/78, 110/79, 110/80, 110/81, 110/82, 110/83, 110/84, 110/85, 110/86, 110/87, 110/88, 110/89, 110/90, 110/91, 110/92, 110/93, 110/94, 110/95, 110/96, 110/97, 110/98, 110/99, 110/100.



Example Utility Patents

United States Patent [19] **Patent Number: 5,567,036**
Theobald et al. [45] **Date of Patent: Oct. 22, 1996**

[54] **CLEARANCE AND SIDE MARKER LAMP** 4379,966; 51990; Muzio et al. 310500
 4379,971; 121990; Glavin 30072
 5066,971; 40191; Jankov 30222
 5464,964; 11902; Schmitz 30241
 5412,256; 31992; Roney 30241
 5452,046; 11792; Gendish 31211
 5310,451; 67994; Knapik 30241
 5430,809; 31995; Brant et al. 30280

[73] **Inventor:** Greg Theobald, Aurora, Ill.; Laila Jankovics, Bensenville, Canada; Fred Reber, Edwin Sapp, both of Madison, Ind.

[72] **Assignee:** Groco Industries, Inc., Madison, Ind.

[21] **Appl. No.:** 417,496

[22] **Filed:** Apr. 5, 1995

[51] **Int. Cl.:** B60Q 1/00

[52] **U.S. Cl.:** 362/98; 362/100

[54] **Field of Search:** 362/98; 362/100; 362/98.01; 362/98.02; 362/98.03

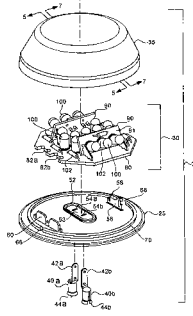
[56] **References Cited**

U.S. PATENT DOCUMENTS

3471,381; 107281; Raftoy 30226
 4182,838; 112718; Faber et al. 30223
 4664,628; 31987; Brown et al. 30087
 4066,638; 75187; Iwata 30280
 4379,223; 81990; Amano 30222

OTHER PUBLICATIONS

19 Claims, 7 Drawing Sheets



United States Patent [19] **Patent Number: 5,578,034**
Estes [45] **Date of Patent: Nov. 26, 1996**

[54] **APPARATUS FOR PREVENTING SCREW BACKOUT IN A BONE PLATE FIXATION SYSTEM** 4379,966; 51990; Muzio et al. 310500
 4379,971; 121990; Glavin 30072
 5066,971; 40191; Jankov 30222
 5464,964; 11902; Schmitz 30241
 5412,256; 31992; Roney 30241
 5452,046; 11792; Gendish 31211
 5310,451; 67994; Knapik 30241
 5430,809; 31995; Brant et al. 30280

[73] **Inventor:** Bradley T. Estes, Memphis, Tenn.

[72] **Assignee:** Danek Medical, Inc., Memphis, Tenn.

[21] **Appl. No.:** 477,296

[22] **Filed:** Jan. 7, 1995

[51] **Int. Cl.:** A61B 17/00

[52] **U.S. Cl.:** 606/81; 606/99; 606/72; 606/78; 111/020

[54] **Field of Search:** 606/71; 60; 61; 606/96; 69; 70; 71; 72; 73; 41/1009; 533; 970; 999; 352; 353

[56] **References Cited**

U.S. PATENT DOCUMENTS

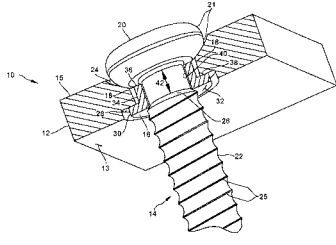
4,494,370; 111884; Sasser et al. 11992
 4,800,834; 114891; Moussette 41022
 5,261,996; 114991; Sautter et al. 60661
 5,280,978; 121991; Mann 60669
 5,271,605; 11494; Copeland et al. 60672
 5,296,796; 30491; Sautter et al. 60662
 5,266,796; 114991; Lewery et al. 60662
 5,261,101; 114991; Sauer 42143

OTHER PUBLICATIONS

George B. Kaufman, *The Metal With a Memory*, Invention & Technology, 1992, pp. 18-23.

Primary Examiner: Guy V. Tucker

25 Claims, 4 Drawing Sheets



United States Patent [19] **Patent Number: 5,568,129**
Sissetman et al. [45] **Date of Patent: Oct. 22, 1996**

[54] **ALARM DEVICE INCLUDING A SELF-TEST REMINDER CIRCUIT** 4365,556; 101990; Brooks et al. 30282

[73] **Inventors:** Ronald Sissetman, 13 Cedar Gate Cir., Aurora, Ill. 60206; Gerald D. Beck, 524 Willow Ln., Sleepy Hollow, Ill. 60118

[21] **Appl. No.:** 302,634

[22] **Filed:** Sep. 8, 1994

[51] **Int. Cl.:** G08B 17/00

[52] **U.S. Cl.:** 340/303; 340/314; 340/315; 340/316

[54] **Field of Search:** 340/303; 309/115; 514; 515; 516

[56] **References Cited**

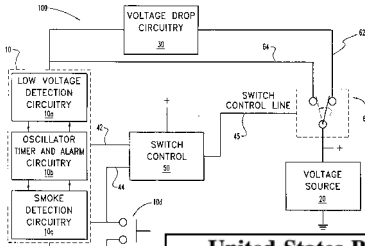
U.S. PATENT DOCUMENTS

4,097,800; 31979; Condon 30054
 4,138,472; 31979; Schaefer 30054
 4,148,819; 31979; Shaw 30013
 4,295,914; 31986; Singh 30013
 4,371,244; 31978; Bellone et al. 30094

OTHER PUBLICATIONS

Primary Examiner: Jeffrey Hoffman
 Attorney Agent or Firm: Woodard, Emhardt, Naughton, Moriarty & McNett

35 Claims, 9 Drawing Sheets



United States Patent [19] **Patent Number: 5,536,823**
Widlanski [45] **Date of Patent: Jul. 16, 1996**

[54] **3'-SULFONYL NUCLEOSIDE COMPOUNDS** OTHER PUBLICATIONS

[75] **Inventor:** Theodore S. Widlanski, Bloomington, Ind.

[73] **Assignee:** Indiana University Foundation, Bloomington, Ind.

[21] **Appl. No.:** 147,637

[22] **Filed:** Nov. 3, 1993

Related U.S. Application Data

[63] **Continuation-in-part of Ser. No. 840,382, Feb. 24, 1992, abandoned.**

[51] **Int. Cl.:** C07H 19/16; C07H 19/173; C07H 19/14; C07H 19/173

[52] **U.S. Cl.:** 536/27.6; 536/27.81; 536/28.5; 536/28.54; 536/115

[58] **Field of Search:** 514/23; 42; 43; 536/28.6; 28.7; 25.3; 115; 118; 28.5; 28.54; 27.6; 27.81

[56] **References Cited**

FOREIGN PATENT DOCUMENTS

9115500; 10/1991; WIPO.

OTHER PUBLICATIONS

Mirabelli et al., *Anti Cancer Drug Design*, vol. 6, pp. 647-661, (1991).

Uhlmann et al., *Chemical Reviews*, vol. 90, No. 4, pp. 544-584, (1990).

Musicki et al., *Tetrahedron Letters*, vol. 32, No. 10, pp. 1267-1270, (1991).

Reynolds et al., *J. Org. Chem.*, vol. 57, No. 11, pp. 2983-2985 (1992).

Primary Examiner: James O. Wilson
Attorney Agent or Firm: Woodard, Emhardt, Naughton Moriarty & McNett

[57] **ABSTRACT**

Analogues of RNA and DNA compounds contain a neutral, stereoregular linking group based on replacement of the phosphoryl with a sulfonyl group. Precursors to the analogues are also described, as are methods for preparing the precursors and analogues.

19 Claims, No Drawings

Typical Sequence of Events

1. Invention first made (may or may not be prototyped).
2. Patentability search.
3. File U.S. patent application . . . utility/design v. provisional.
4. Foreign patent filings within one (1) year of U.S. filing . . . PCT v. national filings.
5. Launch product in the marketplace.
6. Patent issues – start marking products with patent pending and patent number(s) immediately.



Invention Notebooks & Disclosures

- Reason: prove a date of invention earlier than your U.S. patent application filing date (presumptive date of invention) . . . for priority purposes.
- “Corroboration”: Must be signed and **dated** by a **witness**, who:
 1. Is **NOT** a co-inventor;
 2. Understands the technology; and,
 3. Has confidentiality obligation (fellow employee).
- Be detailed; show all alternative versions.
- Show testing results or summaries.
- No breaks or gaps.
- Tamper evident book: bound to show no pages added or removed.
- “Diligence” is good . . . may be critical.
- “Abandoned, suppressed or concealed” is bad.



“prior art”

(pre-existing technology) includes:

- Earlier patents & applications.
- Earlier publications, including:
 - Journal articles
 - Brochures & ads
 - Product catalogs
 - other
- Your **own** activity more than one (1) year before filing date:
 - Offer for sale
 - Sale
 - Public use
 - Publication, Website, Catalog, Brochure
- Other’s products/methods offered, sold or used in U.S.
- Earlier invention by others in the U.S.
- Public knowledge.
- **Prior art may have obvious uses beyond its primary purposes.**



“Nonobviousness”

- No single item of prior technology (“prior art”) has **all** the features claimed.
- Evaluate as of the time of the invention without **hindsight**.
- Evaluate from the perspective of a person of “ordinary” skill in the field.
 - Ordinary skill includes **ordinary inferences and creative steps**, i.e., **ordinary innovation is not patentable**.
 - Ordinary skill includes fitting multiple teachings together like pieces of a puzzle.
- *Supreme Court*: “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield **predictable** results”. *KSR Int’l v. Teleflex, Inc.*



“Nonobviousness” - cont.

- Example of Non-Obvious Inventions:
 - The invention provides an unexpected synergistic or surprising effect.
 - The invention runs counter to teaching of prior art.
 - The invention was uniquely challenging or difficult.
 - The invention was unpredictable at the time of the invention.
- “Secondary” considerations that **may** prove nonobviousness:
 - Commercial success
 - Long felt need satisfied
 - Copying
 - Others tried but failed to solve problem
 - Praise for the invention
- Supreme Court: A suggestion or motivation in the prior art to combine is no longer required. *KSR Int’l v. Teleflex, Inc.*



Patent Number Marking

- **CRITICAL**: failure to mark means that you forfeit recovery of **money** for all infringement before you notify competitor of their “infringement”. Their awareness of the patent is NOT enough.
- Normally, it is **NOT** enough to mark the **packaging** or your product **literature**. This is only enough when, from the character of the patented article, marking “*can not be done*”. 35 U.S.C. §287.
 - If you can mark with a trademark or product serial number, you probably will be considered capable of marking with a patent number.
- Examples:
 - Patent 5,054,234
 - Pat. 5,054,234



Scope of legal rights

- How broad are patents?

Utility Patent: defined by the written claims.

Design Patent: “substantially similar” in the eyes of the ordinary observer to the patent’s drawings.

Utility Patent Claims

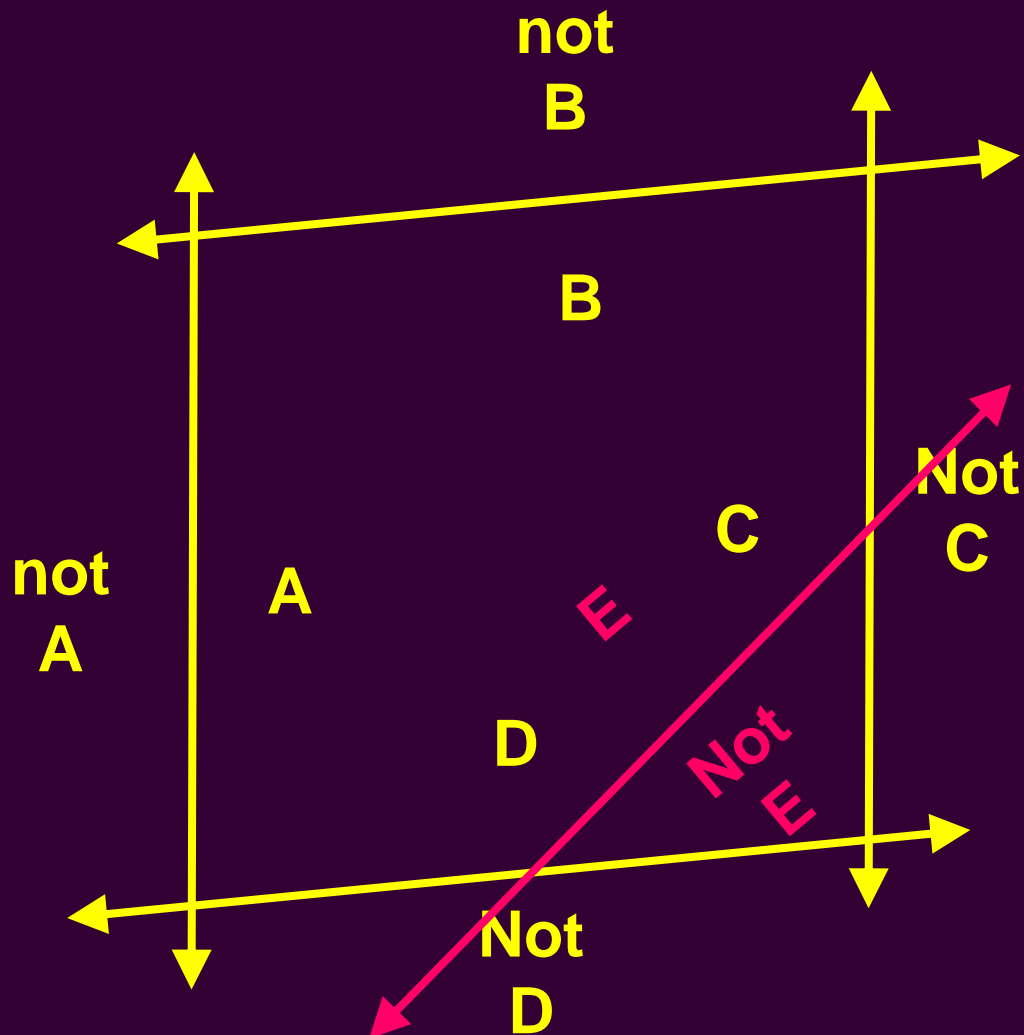
Venn Diagram:

1. The invention is the combination of at least:

A + B + C + D.

2. The invention of claim 1 and also including:

E.



Duty of Candor to the Patent Office

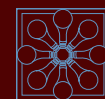
- Must always be truthful.
- Must disclose prior art that you know about and that is “material”.
- Do not omit material information (e.g. person signing an affidavit in favor of your patent application is being paid by you as a consultant).



Be smart

Jim,
I guess there is because I can't believe that any rational business sense would cause them to act like this. As you say, time will tell. It seems like a long expensive charade to go through to come to this. I have to admit, to being very depressed about this with all the time Steve and I have put in. There was so much that could have been done with that technology. If they don't license to someone else I will have no hesitation to use their technology and run the risk that Purdue will sue. I doubt they would or would even be aware that we were doing so. Proof of the old saying that some people are prepared to cut off their nose to spite their face.
This may be a 3 drink night.
ars

- No Incredibly Stupid E-mails.
- When lawfully “copying,” get advice of counsel.



Infringement: How to avoid

- Do not copy a competitor's product.
- If you must copy:
 - Look for patent numbers on their product.
 - Do a formal patent search.
 - Get a formal legal opinion.
- With legal advice, “design around” their claims to be safe.
- Having your own improvement patent helps, but is not a complete defense.
- Avoid other copying pitfalls such as trademarks, trade dress and copyrights.
- “Advertising Injury” insurance normally does NOT apply to patents.



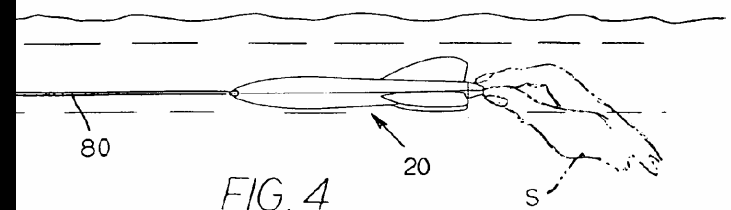
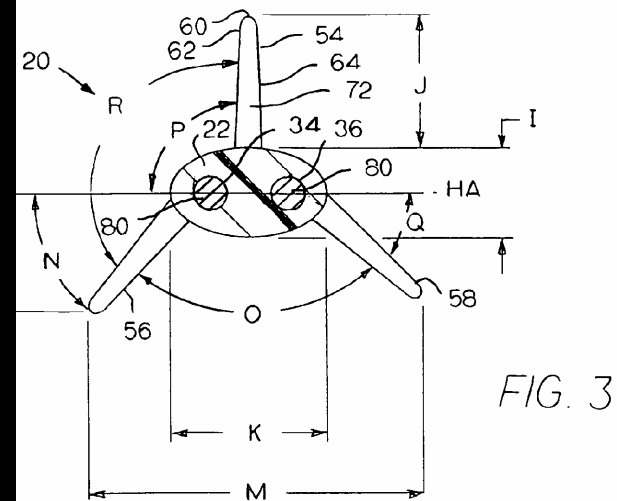
Working with patents

- **Design Around – its good to have options**
 - Avoid injunction against your product line.
 - Strengthens your settlement bargaining position.
 - Weakens their damages case even if you do not settle.



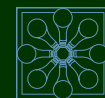
Design Around Example

1. A submersible projectile comprising: an elongate body having an axial forward end and an axial rearward end and a peripheral surface, and the elongate body has a central longitudinal axis; the **elongate body having a generally elliptical cross-section along substantially all of the axial length of the elongate body**; a plurality of fins projecting from the elongate body near the axial rearward end of the body, and the fins being spaced about the peripheral surface; and wherein one of the plurality of fins is an upper radial fin that has a generally vertical orientation, and the upper radial fin projects in a radial fashion away from the elongate body, and the plurality of fins further includes a **plurality of lower non-radial fins** that are **not** aligned to the central longitudinal axis of the elongate body.



Infringement: Bad things can happen

- Injunction:
 - Stop selling order from a Court.
 - Destroy infringing inventory.
- Pay damages caused to plaintiff:
 - Plaintiff's profits that it lost.
 - Price erosion
 - Reasonable Royalties
 - Other theories of damage..
- Turn over infringing profits to the plaintiff (design patents only).
- Damages/Profits **tripled** in exceptional case (e.g. jury finding that infringement was “willful”).
- Pay court “costs”.
- Pay other sides attorneys fees in exceptional case (often several million dollars).



Litigation-Patent Infringement \$1-\$25M Inclusive, all costs (Q42d)

Total Cost		Litigation-Patent Infringement \$1-\$25M Inclusive, all costs				
		Number of Individuals	Mean (Average)	First Quartile 25%	Median (Midpoint)	Third Quartile 75%
All Individuals		319	\$2,637,179	\$1,200,000	\$2,000,000	\$3,500,000
Type of Practice	1-5 Attorneys	33	\$1,446,364	\$625,000	\$1,000,000	\$1,500,000
	6-75 Attorneys	131	\$2,396,183	\$1,000,000	\$1,750,000	\$3,000,000
	76 or more Attorneys	67	\$3,549,254	\$2,000,000	\$3,200,000	\$4,000,000
	All Corporate	73	\$2,824,384	\$1,500,000	\$2,000,000	\$3,750,000
Location	Boston CMSA	18	\$2,638,889	\$1,437,500	\$2,500,000	\$4,000,000
	NYC CMSA	26	\$3,667,308	\$1,500,000	\$2,650,000	\$4,000,000
	Philadelphia CMSA	28	\$3,287,500	\$2,250,000	\$4,000,000	\$4,000,000
	Washington, DC CMSA	31	\$3,167,742	\$1,700,000	\$3,000,000	\$4,000,000
	Other East	16	\$2,468,750	\$1,150,000	\$2,000,000	\$3,000,000
	Metro Southeast	17	\$3,285,294	\$875,000	\$2,500,000	\$3,500,000
	Other Southeast	8	\$1,662,500	\$562,500	\$950,000	\$1,500,000
	Chicago CMSA	35	\$2,133,000	\$1,250,000	\$1,600,000	\$3,000,000
	Minne.-St. Paul PMSA	10	\$1,567,500	\$787,500	\$1,500,000	\$2,562,500
	Other Central	41	\$1,686,098	\$600,000	\$1,000,000	\$2,500,000
	Texas	23	\$2,847,826	\$1,000,000	\$2,500,000	\$3,500,000
	Los Angeles CMSA	20	\$3,015,000	\$1,212,500	\$1,500,000	\$1,937,500
	San Francisco CMSA	17	\$2,823,529	\$2,000,000	\$2,000,000	\$4,000,000
	Other West	27	\$2,279,630	\$1,500,000	\$2,000,000	\$3,500,000

Patent Royalties Court Order

TEAM SUCCESS: Patent infringement judgment

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF MISSOURI
EASTERN DIVISION

MERIDIAN ENTERPRISES CORP.,)
Plaintiff,)
vs.)
CARLSON MARKETING GROUP,)
INC.,)
Defendant.)

Case No. 4:01CV1955 CDP

SECOND AMENDED JUDGMENT

In accordance with the Memorandum and Order entered this same date, judgment issued on May 26, 2004 is amended to read as follows:

IT IS HEREBY ORDERED, ADJUDGED and DECREED that plaintiff Meridian Enterprises Corp. shall have judgment against defendant Carlson Marketing Group, Inc. on plaintiff's complaint and defendant's counterclaim, in the total amount of \$24,640,461.60, which total includes prejudgment interest and attorneys fees. Meridian is also awarded its taxable costs in the amount of \$72,413.20. A separate Permanent Injunction was issued on May 25, 2004.

IT IS FURTHER ORDERED, ADJUDGED and DECREED that defendant Carlson Marketing Group, Inc. shall account to plaintiff Meridian

amount of \$24,640,461.60, which to
attorneys fees. Meridian is also awarded
\$72,413.20. A separate Permanent Injunction

Opposing Counsel:
Robins Kaplan Miller &
Ciresi



**WOODARD, EMHARDT, MORIARTY,
MCNETT & HENRY LLP**

Practical Pointers

- Get assignments of inventions & “conceptions”.
 - From all employees.
 - From all non-employees.
 - From all consultants.
 - From all computer programmers.
- File applications on important inventions and products to protect market share.
- Be aware of and respect competitor’s patents.

Recent U.S. Patent Law Changes and Trends

- *KSR Int'l v. Teleflex, Inc.* (Supreme Court)
 - Expanded bases for finding an invention “obvious.”
 - A person of ordinary skill in the art has ordinary creativity.
 - A design need or market pressure plus a finite number of identifiable, predictable solutions is likely obvious.
- *In re Bilinski* (CAFC *en banc*)
 - Federal circuit is currently examining whether claims directed to a business method that does not require any technology (such as a computer or a storage device) is patent-eligible subject matter.
- *In re Nuijten* (CAFC)
 - A transitory propagating signal is not proper patentable subject matter.



Recent U.S. Patent Law Changes and Trends (cont'd)

- Patent Office Rules Changes
 - New Appeal Rules (Final)
 - Generally increases the amount of detail required in an appeal (\$\$\$). Also is less forgiving of mistakes, increases opportunities to make fatal (to the appeal) mistakes.
 - New IDS Rules (Not currently final)
 - Requires a detailed explanation (\$\$\$) of cited references when:
 - More than 20 references are cited.
 - References are cited after a first Office Action.
 - An individual reference is long, i.e., exceeds 25 pages.
 - New Continuation Rules (On appeal)
 - Limits number of patent applications directed to a particular invention to 3, including Requests for Continued Examination used to extend prosecution after a final rejection as well as traditional continuations and divisionals.
 - New Limitations to Number of Claims (On appeal)
 - Limits number of claims directed to a particular invention to 5 independent / 25 total claims, including co-pending applications.



Recent International Patent Law Changes and Trends

European Patent Office (EPO) Standards

- EPO Approach
 - Article 52(1) EPC . . .”provided that they are new, involve an inventive step and are susceptible of industrial application.”
 - Article 56 EPC – “An invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art.
 - Problem and Solution Approach
 - Determine the closest prior art.
 - Establish the objective technical problem to be solved.
 - Starting from the closest prior art and the objective technical problem, consider whether the claimed invention would have been obvious to the skilled person
- UK Approach in Contrast
 - Section 1 UKPA 1977 – A patent may be granted only for an invention in respect of which the following conditions are satisfied, that is to say –
 - The invention is new;
 - It involves an inventive step;
 - It is capable of industrial application;
 - The grant of a patent for it is not excluded . . .



Recent International Patent Law Changes and Trends (cont'd)

- Comparison of Approaches
 - UK-IPO and UK Courts typically adopt a less formulaic approach to assessing inventive step than the EPO
 - Current approach in *Pozzoli SPA v. BDMO SA* (2007) EWCA Civ 588
 - Reformulation of approach recommended by Court of Appeal in *Windsurfing International Inc. v. Tabur Marine (Great Britain) Ltd.*, (1985) RPC 59
- EPO Changes and Trends
 - Increasing fees for excessive claims
 - Strict on prior art analysis and specification support against “new matter”
 - Designation fees increasing
 - Renewal fees increasing
 - EPO v. PCT supplemental searching
 - Filing divisional(s) . . . strict requirements and excessive costs



Recent International Patent Law Changes and Trends (cont'd)

China's Drive for IP Recognition

- History:
 - Country of 1.3 billion people . . . “world’s factory”
 - Patent system began in 1985 . . . Now over 4 million filings
 - 20% annual increase in filings over 15 years
 - In 2007, 694,153 new filings . . . up 21% from prior year
 - Now third behind U.S. and Japan . . . Likely to surpass in 2012
 - New technical solutions
- What is patentable and how:
 - Three types of patents
 1. Invention patents . . . “a product, a process or an improvement thereof”
 2. Utility model patents . . . “a product’s shape or structure, or a combination of the two, and are also fit for practical use.”
 3. Design patents . . . “shape or pattern design, or a combination of the two, or even a combination of the colors and different shapes or patterns of a product, which enhance it aesthetically and are suitable for industrial application.”



Recent International Patent Law Changes and Trends (cont'd)

- Enforcement
 - Compendium on China National IP Strategy . . . essential by 2020
 - In 2005, 2,947 filings of patent actions, up 15.6% while U.S. filings going down over this period
 1. Foreign company filings were up over past year 77% with 60% winning . . . like Pfizer, Honda, Philips and 3M
 2. Notable Chint Group v. Schneider Electric decision and lessons
 - high damage recoveries possible
 - search China prior art for safety
 - consider utility model (10 year) patent strategy



Patents

*Protecting your Company's
inventions for today and the future*



***ASM/ASME JOINT MEETING
SEPTEMBER 15, 2008***

*Presented by:
Charles R. Reeves
Telephone (317) 713-4909
E-mail: creeves@uspatent.com*



**WOODARD, EMHARDT, MORIARTY,
MCNETT & HENRY LLP**