Early Stage IP Strategies: The Long View Toward Strong Patents

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Early Stage IP Strategies: The Long View Toward Strong Patents

• Memorializing Your Inventions
• Ownership
• Portfolio Building
Memorializing Your Inventions

The “old days” of obviousness: Even these patents held up in court

*In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999)*

*McGinley v. Franklin Sports, Inc., 262 F.3d 1339 (Fed. Cir. 2001)*
Obviousness: Back in Power

Key Factors For Getting And Keeping Patents:

• Surprise
• Unexpected Results
• Recognition of a Problem
• Failure by others
• Long felt but unresolved needs
• Skepticism in the art
• Teaching away
• The invention’s commercial success
• Copying by competitors
• Creative claiming

Justice Kennedy,
Author of *KSR v. Teleflex* (2007)
Telling The Invention Story
Memorializing Your Inventions

§ How much commentary?

§ Recognizing success
   – Good to beat obviousness

§ Reporting failures
   – Good to beat obviousness…
   – But may be bad for enablement, written description, duty to disclose

§ Establishing conception dates

§ Identifying inventors
Laboratory Notebook Practices

**The Basics:**
- Preserve notebooks
- Don’t alter entries
- Timely date and countersign
- Use bound books
- Write in ink
- Avoid blank spaces
- New day on new page

**Winning Strategies:**
- State the problem to be solved
- Record surprising results
- Show recognition of invention
- List participants

**Pitfalls:**
- Don’t disparage the invention
- Don’t write about patents
- Don’t include privileged info
- Don’t include half-baked thoughts
- Don’t write personal matters
Ownership: Who Owns What?

Academic Collaborators

Your Company

Outsourced R&D

Employees
Ownership: Why’s It Matter?

§ Departed employees may make assignment problematic
§ Sale of IP assets – clouded title?
§ Standing in litigation
  – Reservations of right, restrictions complicate enforcement
  – Who are the necessary parties to assert your patent?
  – Who controls the case?
  – How many sets of lawyers?
§ Prior art landscape:
  – Your collaborators’ patents may be prior art to your IP
§ Do you really own your patents?
  – ImClone lost rights to its patent on Erbitux to academic researchers
  – *Yeda v. ImClone*, 443 F.Supp.2d 570 (SDNY 2006)
Ownership: Promoting Clean Title

§ Get agreements in place early on
   – Employment agreements, CDAs
   – Founders, consultants, collaborators?

§ Assignments
   – Systems in place externally and internally to file ASAP

§ Departing employees
   – Reminders of obligations, exit interviews
   – Notebook review, IDFs in place before departure?

§ Streamline encumbrances on IP
   – Clarify enforcement strategy up front
Portfolio Building: Timing of Applications

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<tr>
<th>Embodiments</th>
<th>Claims</th>
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<tbody>
<tr>
<td><img src="image1.png" alt="Apples" /></td>
<td><img src="image2.png" alt="Pie" /></td>
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- Race to the PTO with first embodiment?
- Will your first embodiment support meaningfully broad claims?
  - *Carnegie Mellon Univ. v. Hoffmann-La Roche, 541 F.3d 1115 (Fed. Cir. 2008)*
- Spend more time and money developing more embodiments?
- Will early “species” application be prior art against later “genus”?

?
## Portfolio Building: Coordinating Teams

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<thead>
<tr>
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<tr>
<td>Team A</td>
<td><img src="apple.png" alt="Apple" /> <img src="apple.png" alt="Apple" /> <img src="pie.png" alt="Pie" /></td>
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<td>Team B</td>
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- If Team A and Team B have different members, their claims are “to another”
- If common assignment, § 103(c) shields Team B from obviousness from Team A
- If Team A claims “species,” and Team B claims “genus,” there may be anticipation
Portfolio Building

§ Map out internal prior art relationships
§ Which applications are “by another”?
§ Which applications are commonly assigned?
§ Track 18 month clock
  – Applications publish in 18 months
  – Your pending apps “by another” will be prior art against your other applications under Section 102(e)(1)
Questions?
Thank You!