



PROTECTING WHAT MAKES YOU UNIQUE

Inventors Network of Minnesota

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William Berggren Iain A. McIntyre

YOUR SPEAKERS

William Berggren

Iain A. McIntyre Ph.D.

Berggren Law Offices
(615) 748-5998

Carlson Caspers
(612) 436-9610

20 yr. engineer at 3M
10 yrs. patent liaison/agent
15 yrs. patent attorney

10 yr. laser physicist
5 yrs. patent agent
17 yrs. patent attorney

Transactional

Contested matters



TYPES OF IP PROTECTION

Type	Duration	What it Covers
Patent	20 years from priority	Prevent others from making, using, selling, offering for sale and importing.
Trade Secret	Indefinite	Any information, e.g., product plans, processes, customer lists, etc., so long as it is kept confidential.
Trademark	Indefinite, so long as used	Identifies source – 3 rd party cannot be “confusingly similar.”
Copyright	95 years	Creative expression.



PATENT TYPES

Type of Patent (application)	Description
Provisional application	Inexpensive to file at PTO. Content requirements the same as utility patent. 12 mos. lifetime – placeholder for utility application .
Utility patent	Covers: useful process, machine, manufacture, composition of matter. 20 years.
Design patent	New, original ornamental design 14 years.
Plant patent	Asexually reproduced (non-tuber) plant 20 years.



UTILITY PATENTS (NONPROVISIONAL)

Subject matter	New and useful process, machine, manufacture, or composition of matter, or improvement.
Timing	File application within 12 mos. of initial public disclosure (US only). File application before initial public disclosure.
Content of application	Enabling specification – allow others to make and use the invention. Claims clearly describing the invention. Drawings (where necessary for understanding) Published at 18 mos. (possible to opt out)
Examination	Examination at PTO Novelty (prior art) nonobviousness (prior art) enablement



UTILITY PATENTS – O(UTSIDE)US

Mechanism	Individual country/region. International application (PCT).
Timing	Within 12 mos. of priority date in US to maintain priority. Non-US countries have absolute bar to patents if filed after made public.
Procedure	Search report < 20 mos. from priority. Examination report (non-binding) <30 mos. from priority.
Reasons for filing PCT	Single application covers most countries/region. Still have to file in individual countries/region. Delay decision of where to file – allows time for product's market to develop.



INVENTORSHIP AND OWNERSHIP

○ Inventor

- Conceived claimed subject matter
 - Reduced claimed subject matter to practice
- May have joint inventors
- Important to get inventorship right, or patent may be invalid

○ Ownership

- Ownership rights arise with the inventor
- Assignment obligations?
- Assignment of ownership should be recorded at PTO



PROSECUTION TIMELINES

- After filing (typical):
 - Application publishes 18 mos. from priority date
 - Office action (12-24 mos.)
 - Respond to office action (2-6 mos.)
 - Second office action or allowance (<3 mos)
 - Additional actions/responses
- Most patents issue <3 yrs. of filing
 - If over 3 yrs., patent life may be extended
- Continuation/divisional application may be filed so long as application pending



PATENT COSTS

- Application
 - preparation (\$5k - \$20k)
 - prosecution (\$0k - \$5k)
- PTO fees*
 - Filing (~ \$1.5k)
 - Issue (~\$1k)
- PCT filing - ~ \$5k
- Maintenance
 - US (< \$13k over life of patent)*
 - OUS (up to \$100k over life of patent in single country)

*fees reduced for small and micro entities



YOU HAVE YOUR PATENT, NOW WHAT?

- You find an infringer – what do you do?
 - Approach for license?
 - License offer has to avoid risk of litigation, else they can file DJ action
 - Wait and see?
 - laches
 - Lawsuit
- Talk to counsel
 - Opinion of infringement
 - Strengthen patent portfolio
 - Rule 11 basis for filing lawsuit



SO, YOU DECIDED TO SUE

- What to expect in litigation
 - Elements of litigation
 - Pre-suit analysis (1-3 mos.)
 - Complaint/answer (1-3 mos.)
 - Initial discovery (documents, emails etc.) (6 – 9 mos.)
 - Depositions – fact witnesses (3-6 mos.)
 - Experts – reports and depositions (3-6 mos.)
 - Pretrial (motions to exclude, summary judgment) (1-6 mos.)
 - Trial (incl. post-trial briefing)
 - Appeal
 - Costs
 - Through trial \$MM
 - Appeal \$k100's
 - Alternative fee arrangements



IF YOU'RE SELLING A PRODUCT, YOU CAN ALWAYS BE SUED

- Reduce risks of being sued:
 - Freedom to operate review
 - Best before large investment in development/marketing
 - Identify highest risk patents and make contingency plan
 - Design around
 - Find invalidating prior art
 - Professional search firm/personal search
 - Get patent protection on product
 - Patent is not a right to sell the patented product
 - Not shield against suit, but puts you in better position for settlement
 - Helps tell story to jury



YOU'VE BEEN SUED – NOW WHAT?

- Slog it out
 - Costs, timeline like plaintiff's
 - Alternative fee arrangements different
- Settle
 - Settlement terms depend on
 - Strength of case
 - Economics
 - With/without license?
- Fight validity of patent at PTO
 - Re-exam
 - Inter partes review



INTER PARTES REVIEW

- New post-grant procedures introduced under America Invents Act, 2012
 - *Inter partes* review, post grant review
 - Advantages to accused infringer
 - Burden of proof
 - Claim construction
 - Speed
 - Cost
 - Disadvantages to accused infringer
 - Estoppel
 - Limited discovery
 - Patent owner can amend claims – petitioner has burden to show they are not patentable.



INTER PARTES REVIEW (2)

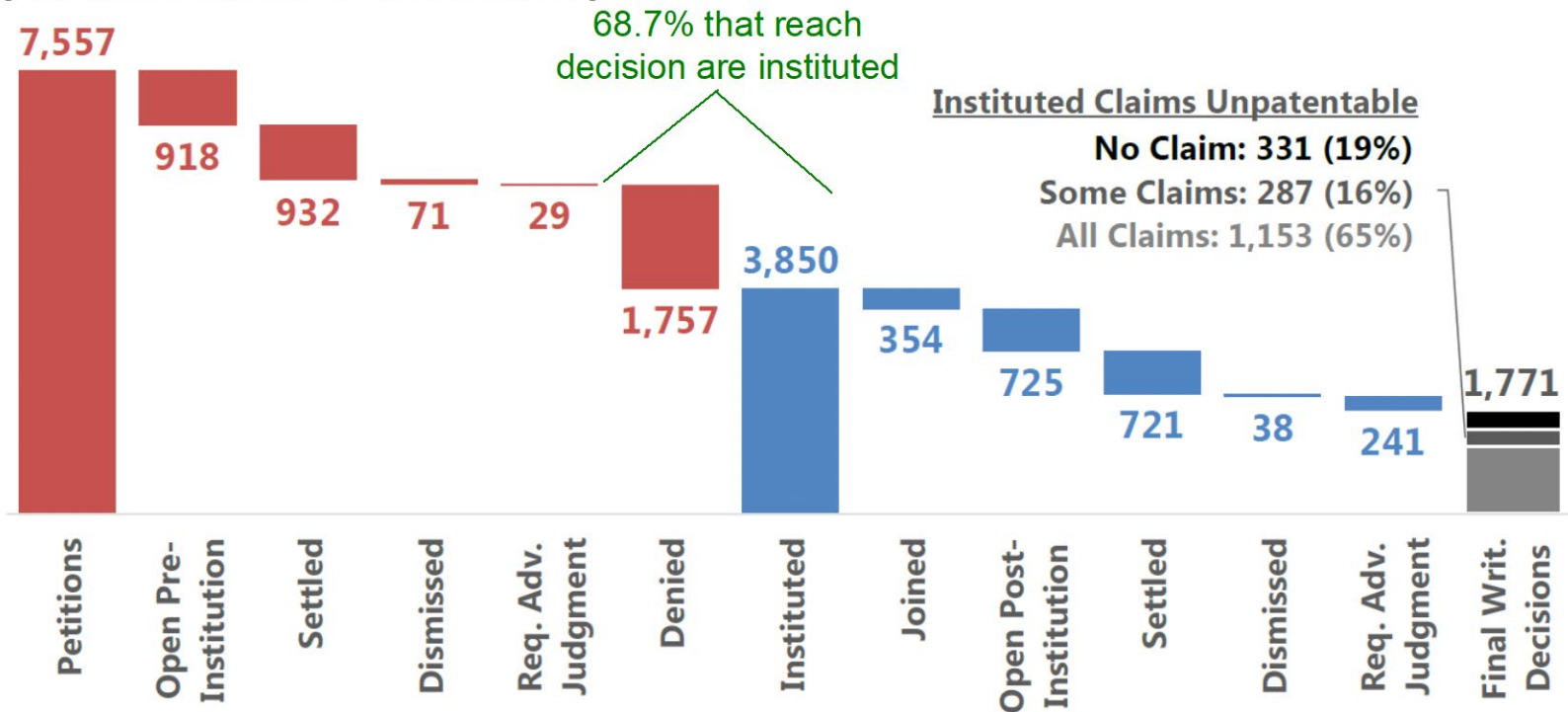
- Defendant files petition with PTO to review validity of patent
 - Petition – states reasons why petitioner believes patent invalid, based on written prior art (patents, publications)
 - Institute IPR if “reasonable likelihood petitioner will prevail on at least one ground of invalidity”
 - Standard for invalidity – preponderance of the evidence
 - Estoppel – any ground petitioner knew, or should have known about
- Constitutionality of IPRs currently under review at U.S. Supreme Court (Oil States v. Greene’s Energy)



INTER PARTES REVIEW (3)

Status of Petitions

(All Time: 9/16/12 to 9/30/17)



RECENT CHANGES IN PATENT LAW

- No longer first to invent, but first to file:
 - Is there still a 12 mo. grace period between publication and filing?
 - Is there any need to be able to verify dates?
 - Invention
 - Conception, reduction to practice
 - Publication
- Can I still patent software?



TRADE SECRETS

What is a trade secret?	<ol style="list-style-type: none">1. Not generally known to the public.2. Confers some economic benefit to holder.3. Is the subject of reasonable efforts to maintain confidentiality.
What can be a TS?	Formula, practice, process, design, instrument, pattern, commercial method or compilation.
How long can TS exist?	Indefinitely, so long as confidential.
Disadvantages of TS	Lose TS when discovered, reverse engineered, subject of 3 rd party's patent.
Recourse for misappropriation	Sue (state or federal court) thief and those who benefited from theft.



TRADEMARKS (AND SERVICEMARKS)

How the TM right arises	1 st use in the marketplace, by county. Federal application - based on use or intent to use.
Why register Federal TM?	Constructive use in all US counties. Notice to others. Evidence of ownership. Can sue in Federal court.
Application for TM	Not confusingly similar to other marks. Word, name, symbol, color (rare). Strength of mark: fanciful, arbitrary, suggestive, descriptive, generic Generic - no TM protection. Descriptive – TM protection only after acquired secondary meaning.
Mark expires	Failure to protect, no longer use



COPYRIGHT – PROTECTING HOW AN IDEA IS EXPRESSED

Covers	Expression of ideas, not the ideas themselves. Bundle of rights: reproduction, performance, distribution, derivative works, “moral” rights.
How and when	Copyright exists at time work is fixed in a tangible medium by author.
Why register with Copyright Office	Cannot file federal lawsuit without registering. Statutory damages. Make copyright public record.
Input dates	Within 3 mos. of publication.
Standard of review	Aware of original and similarity to original (evidence of copying).



THANK YOU

**INVENTORS NETWORK OF
MINNESOTA!**

