

How to Check Your Patents for Loopholes

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Overview

1. “Patent profanity”* in your patent applications or correspondence with the Patent Office
2. “Objects of the invention” in the summary section
3. Misuse of the word “invention”
4. Means-plus-function language in the claims
5. Claims overly detailed or not focused on the right features
6. Keeping patent families alive
7. Coordination between patent and regulatory efforts
8. Marking products with patent information

* I believe the term “patent profanity” was coined by Tom Irving of Finnegan Henderson

Doug Limbach's background

- 23 years in IP law
- 2 years founder of mobile device startup
- 6 years as electro-mechanical engineer
- BS degree in mechanical engineering

Shay Glenn LLP

- 12 attorney intellectual property law firm in Silicon Valley
- Firm formed in 2006
- Our firm specializes in counseling early stage companies and those who invest in early stage companies
- About 80-90% of our work is in the medical device/life science area

Shay Glenn technical degrees

- Aerospace
- Biomedical (M.S.)
- Chemical
- Electrical
- Material Science
- Mechanical
- Neuroscience (Ph.D.)
- Optical Engineering (Ph.D.)

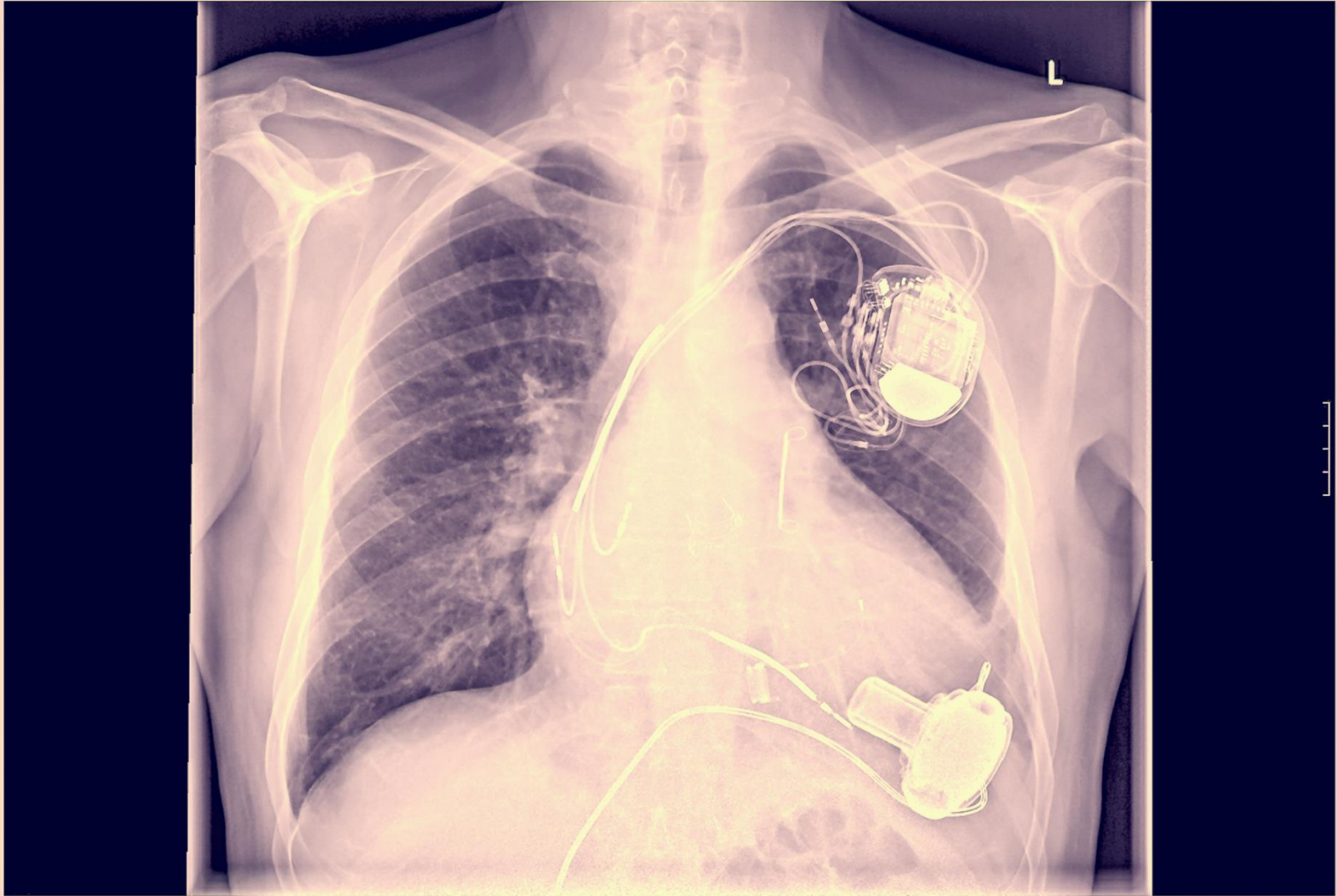
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1st type of loophole – “Patent Profanity”



Two implantable battery companies



Claim language determines the scope of a patent

Broader claim

Claim 1.

An implantable battery comprising:
element **A**;
element **B**; and
element **C**.

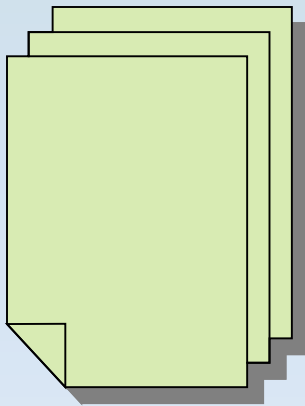
Narrower claim

Claim 2.

An implantable battery comprising:
element **A**;
element **B**;
element **C**; and
element **D**.

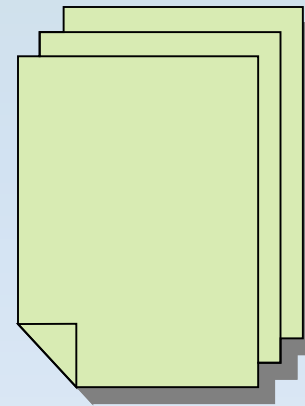
Claims are interpreted in light of the Description section of a patent

Description section



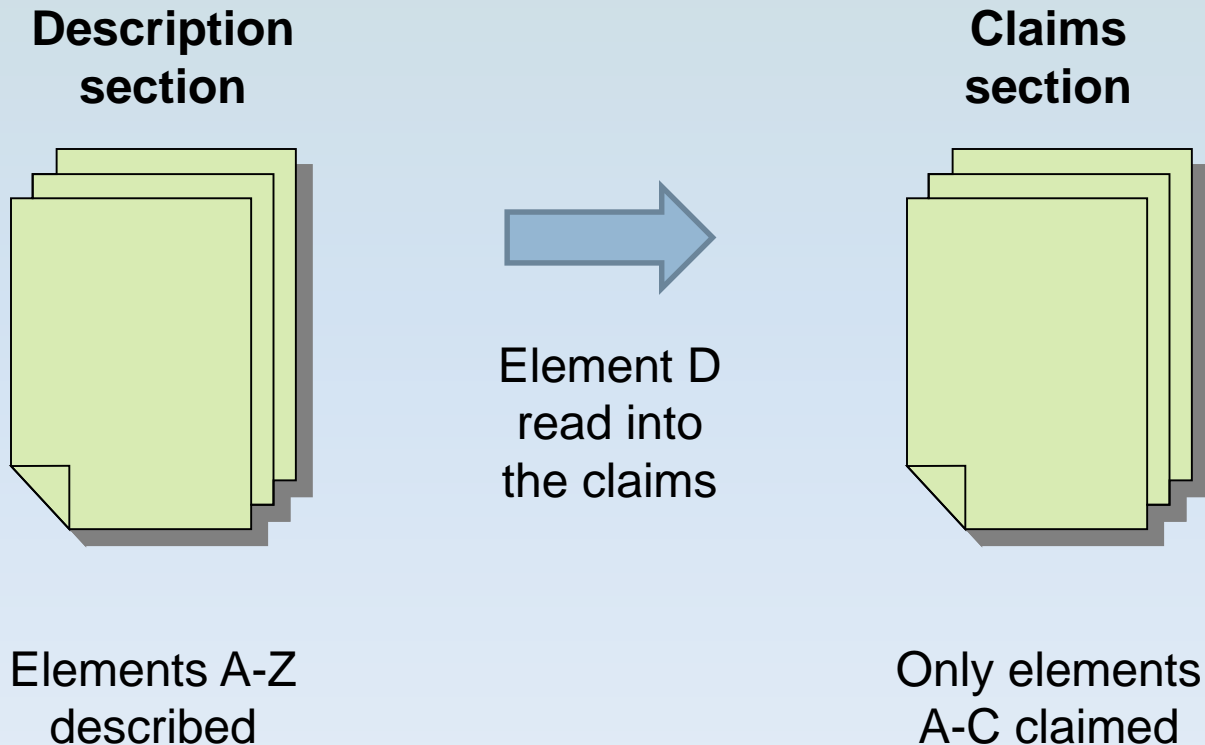
Elements A-Z
described

Claims section



Only elements
A-C claimed

Claims are interpreted in light of the Description section of a patent



Patent Profanity



Patent Profanity



2nd type of loophole – Objects of the invention



“Objects of the invention” can be used by others to avoid infringing your patent

- **Problematic:** “It is an object of the present invention to provide an improved vertebral distraction device for use in discectomy procedures.”
- **Use instead:** “According to some aspects of the present disclosure, an improved vertebral distraction device for use in discectomy procedures is provided.”
- **Or use:** “In some embodiments, an improved vertebral distraction device may be used in discectomy procedures.”

Objects of the invention



3rd type of loophole – Misuse of the word “invention”



Avoid using the word “invention” altogether

- Your invention should be defined by the Claims section of your patent, not by other sections of the patent
- **Problematic:** “The present invention provides a lever arm for adjusting the spine.”
- **Use instead:** “In some implementations of the present disclosure, a lever arm is provided for adjusting the spine.”
- **Or use:** “A lever arm may be provided for adjusting the spine.”
- Don’t even use “invention” in the headings. “Summary of the Invention” should be changed to “Summary of the Disclosure” or just “Summary.” “Detailed Description of the Invention” should be changed to “Detailed Description.” Same with the Background section.

Misuse of the word “invention”



4th type of loophole – “Means-plus-function” language



“Means-plus-function” language in the claims

- **Problematic:** “a means for fastening part A to part B”
- **Use instead:** “a fastener, fastening part A to part B”
- By statute, a claim element may be expressed as a means for performing a specified function without the recital of structure, and the claim will be construed to cover the corresponding structure described in the specification, and equivalents of that structure.
- If there is no corresponding structure given in the specification, then the means-plus-function term will be considered indefinite, rendering the claim invalid.

Means-plus-function language



5th type of loophole – Overly detailed claims or claims not focused on the right features



Overly detailed claims or claims not focused on the right features

- Claim length
- Claim focus



Overly detailed claims or claims not focused on the right features



6th type of loophole – Keeping patent families alive



Keeping patent families alive

- There are 3 types of continuing applications:
 - Continuation, Continuation-in-part (CIP) and Divisional
- Must be filed while the parent application is still pending
- Main reasons for keeping a patent family alive include:
 - Correct problems in parent application (as previously discussed)
 - Draft new claims to cover a new product line not covered by original claims
 - Overcome newly discovered new prior art (original claims invalid)
 - Draft new claims tailored to a recent competitor's product, and make it difficult for all competitors to design around your patents
 - Safeguard against changes in the patent law (e.g. patentable subject matter)

7th type of loophole – Coordination between patent and regulatory efforts



Coordination between patent and regulatory efforts

- Proving substantial equivalence to a predicate device in an FDA filing
- Duty to disclose prior art aware of to USPTO
- Patent can become unenforceable due to fraud on the USPTO

8th type of loophole – Marking products with patent information



Marking products with patent information

- The purpose of marking a product is to provide constructive notice to the public that the article is patented.
- Failure to appropriately mark a product can preclude the recovery of damages for infringement until effective notice is given.
- The recently enacted America Invents Act provides patentees with the option of using “virtual marking.”
- When licensing your technology to another company, ensure that the license includes a clause requiring the company to mark all of its products covered by your patent(s).

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Questions?

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