

## 10 Mistakes That Drive Litigators Crazy

*Friday, Sep 14, 2007* --- It has been said that patent prosecution is more of an art than a science – the art of dancing with the examiner is often more critical than the science involved in the patent.

However, in this dance, sometimes steps are missed or feet are accidentally trod upon or even an entire shoe is lost.

These glitches may not be obvious at the time – after all, the patent was issued – but may only come to light years later, when the patentholder needs to enforce his patent against an infringer and may weaken, or fatally injure, the patentee’s chances of success.

So, please keep the next generation of litigators happy and avoid these mistakes that will make them tear their hair out.

### #10 Not Disclosing Prior Art

The rules of the Patent Office require an applicant to disclose all of the prior art he knows about.

Failure to disclose known prior art is considered “fraud on the patent office” and can result in the loss of not only the claim the prior art relates to, but the entire patent.

It is the patent attorney’s job to make sure he has discovered all the prior art the inventor knows about.

### # 9 Leaving out the Best Mode

US patent laws require an inventor to disclose the “best mode” that the inventor knows about to use his invention.

The inventor is not allowed to keep the best use of his invention as a trade secret.

Disclosure is only required if the inventor actually has a “best mode.”

Disclosure is required if the mode the inventor himself considers the best – it does not matter whether it is actually the best.

The courts treat the failure to disclose the best mode very harshly – it will invalidate the entire patent.

## #8 Listing too Many Inventors

This is often a problem when a group is working on a project that results in a patent.

The only persons who may be listed as “inventors” are those who participated in the “conception of the idea” of the invention. Not the supervisor of the group. Not the technician who implemented the idea and made it work.

Improperly including people as inventors can create real headaches.

If one of these “inventors” does not assign the patent to his company, he will retain an ownership interest.

The company may have to go back to the patent office to correct “inventorship” in the middle of a lawsuit or risk invalidation.

All inventors will be deposed in any lawsuit, creating disruption if they have different views of what the patent means.

## # 7 Not Finding Prior Art

Patents should be drafted and prosecuted with the prior art in mind to ensure that the claimed invention is truly novel.

A patent which the examiner has issued in spite of this prior art is stronger in subsequent litigation than if the examiner has not considered it.

Every patent lists the prior art considered by the examiner – some call a patent with a long list of references a “Superman” patent.

It is far better to find these prior art references yourself and give them to the examiner [and have the patent issue in spite of those references] than wait for you opponent in a lawsuit to find them and use them against you.

## #6 Patenting too Narrowly

Some inventors will simply patent their new product without trying to get broad protection for their idea. Narrow patent claims makes it easy for a competitor to design around your invention.

Claims should broadly define novel concepts that include potential design-arounds.

## #5 Ignoring Festo

The courts will strictly hold patent applicants to representations they made about their patents during prosecution – this is known as “prosecution history estoppel.”

This was the decision of the U.S. Supreme Court in the Festo decision.

If patent applicants make what, at the time, seem to be minor amendments to avoid prior art, the courts will hold them later to what they said the patent covered.

This is particularly important when the patent owner sues under the “doctrine of equivalents,” seeking to expand the scope of the patent’s coverage beyond its literal limits.

Lack of care in making such amendments can severely restrict the scope of the patent in a subsequent litigation, even if such amendment were not necessary to getting the patent issued.

#### #4 Characterizing the Prior Art in the “Background” Section

It is important to draft patent claims with one eye on the prior art.

Overly broad patents which then have to be “fixed” through extensive negotiation with the examiner may create more Festo problems than the advantage gained by submitting broad claims.

However, specifically calling out, characterizing and distinguishing the prior art in the “Background” section of the patent may create even more problems.

In a subsequent litigation, the litigator will be handcuffed to the inventor’s description of this prior art – even if it is wrong!

It is considerably less risky to simply stress the novelty of the invention without reference to particular prior art.

#### # 3 Mis-Characterizing the Invention in the Abstract

Even though the Patent Office does not use the abstract to interpret the claims of the patent, the courts do!

The abstract can and will be used by the courts to determine – and probably restrict – the scope of the patent.

The abstract should track the language of the broadest claim exactly.

#### # 2 Using Vague Undefined Terms

Under the Markman decision, the court has sole authority to say what the patent means. The meaning of particular terms used in the claims is the most important – and contentious -- issue in any patent litigation.

Although the inventor is entitled to define his own terms, where important

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terms are left vague and undefined, it is left to the lawyers and courts years later to determine what the inventor meant.

Often courts turn to the dictionary to determine what a patent term means, a result which could have been avoided by careful drafting.

## #1 Using Inconsistent Language in Specification and Claims

Since the meaning of particular words is critical to determining the scope of a patent, it is very important to use terminology consistently within the patent

Items and concepts must always be referred to using the same words – a concept cannot be described one way in the claims and in another way in the specification.

This kind of sloppy drafting introduces disruptive uncertainty into any subsequent litigation and makes it very difficult to persuade the court to interpret the claims in the manner the inventor intended.

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