A PLEA FROM THE TRENCHES:
HOW PROSECUTORS CAN MAKE THE LIVES OF LITIGATORS EASIER

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I. Introduction

The lives of patent prosecutors are not easy. They toil away day-in and day-out on difficult, rather esoteric matters to achieve a singular goal: the issuance of patents for inventions of critical importance to their clients. One would hope that after they reach the holy grail of an issued patent that prosecutors could rest on their laurels and accept congratulations for a job well done.

Regrettably, however, that is not always the case. More often than not, the patents prosecutors work so hard to obtain become the centerpieces of highly charged, take-no-prisoners litigation, during which the prosecutors' prized patents get scrutinized, criticized, ripped apart, attacked, deconstructed, ridiculed, torched – and worse. Then, the ultimate fate of the patent is decided by a judge or jury who almost certainly has no background, familiarity or experience with the technology at issue or the patents themselves.

While prosecutors and litigators typically have no more in common than cats and dogs, we can nevertheless learn from one another. The purpose of this paper is to discuss how some errors made during the patent prosecution process play out in litigation – not to dump on prosecutors, but hopefully to provide constructive suggestions on how problems can be avoided.

II. Divided By A Common Document

Winston Churchill famously described the British and American people as "two great nations divided by a common language." So it is with patent prosecutors and patent litigators: two accomplished groups of practitioners divided by a common document – the patent. They are

divided because they approach patents from opposite ends. Prosecutors look at a patent prospectively, as the ultimate prize resulting from a difficult, often drawn out process. Litigators look at a patent in hindsight, as the hand they have been dealt for the purpose of pursuing a more tangible prize – damages and/or injunctive relief. Alas, while mutually respectful of one another, the different direction from which they approach patents makes it virtually impossible for prosecutors and litigators to co-exist without some tension.

To further hinder the messy relationships between prosecutors and litigators, there is no such thing as a perfect patent. Certainly, some patents are better than others, both in terms of quality of draftsmanship and content. However, the entire nature of a patent makes it rife with internal tension: The patentee wants claims of a patent to be broad enough to cover as many products as possible but not too broad to fall within invalidating prior art. The patent specification should describe the best mode for practicing the invention claimed, but should not disclose too much so as to avoid limiting the scope of the claims. And so on. Therefore, no matter how well a patent is drafted and how completely it covers the subject matter of the invention, it will be vulnerable to challenges – and falls short of perfection.

Furthermore, both prosecutors and litigators operate in real world environments that make any attempt to obtain perfection – or establish common ground – even more difficult. Prosecutors must fulfill the desires of clients, which frequently impose cost limitations and time constraints that compel prosecutors to make numerous judgment calls that affect the quality and strength of a patent. They also have to please examiners from the United States Patent and Trademark Office – and in many cases, from foreign patent offices, as well. Examiners often do not see an invention or a patent application in quite the same way as prosecuting attorneys, which leads to a substantial amount of give and take before a patent will actually issue.

Prosecutors also have to deal with outside events – such as market forces and advancements in technology – that could profoundly affect patents they are prosecuting.

By the same token, litigators have their own real world circumstances to deal with. Litigators, too, act at the pleasure of clients, which always brings into play cost and timing issues. Unlike prosecutors, however, litigators are being challenged every step of the way by one or more well-funded, passionate opponents. Litigators also regularly face judges, who will frequently knock them off their desired path. Finally, litigators have to deal with outside events – such as market forces, advances in technology, changes to the accused infringing products and the discovery of new prior art – that could profoundly affect the litigation involving the patents.

Faced with such forces, it is no wonder that prosecutors and litigators often find themselves disagreeing with one another.

III. Not A Cure All

Although the theme of this article focuses on problems that arise in patent litigation as a result of actions taken during the prosecution of the patent in suit, the goals of the paper are limited. It is not intended to provide suggestions to prosecutors on what they should be doing differently in prosecuting patents. I do not in any way intend to advise prosecutors as to how they should do their jobs, nor am I qualified to do so.

The article is also not intended to set forth a comprehensive list of anything and everything that can go wrong during attempts to enforce patents. Unfortunately, such a list could potentially encompass every aspect of preparing and prosecuting a patent application because in litigation every component of the process is subject to intense scrutiny and, perhaps, vigorous challenge.

Finally, the article does not purport to identify the "top" or most serious mistakes made in prosecution. Such a determination is inherently subjective, and different people would undoubtedly consider certain errors more profound than others. More importantly, the significance of a particular error depends to a large extent on the magnitude of the problems caused by the error. A seemingly minor error that causes enormous difficulties in litigation will likely be of much greater importance than a much more serious error that turns out to be inconsequential.

IV. Since You Asked

Enough on what this article is not. What I hope it to be is a summary of some of the problems with patents I have encountered during the course of litigation. Most importantly, I will discuss problems that can typically be fairly easily remedied if the prosecutor gives these issues some consideration during the prosecution process. As noted above, the problems discussed are not intended to represent a complete or comprehensive list of issues that can make enforcement more difficult, but merely problems that have reared their heads in cases on which I have worked.

A. Lack of Clarity

The single most vexing problem that occurs over and over again in trying to enforce a patent relates to a lack of clarity regarding what the patent actually says. Much of this problem stems from the fact that the language used in a patent is itself virtually unintelligible to someone who lacks familiarity with the subject matter – which would include most of the country. This is true with respect to almost every patent that issues – good, bad or indifferent.

To the extent they do not already realize it, patent prosecutors have to understand that they draft patents in a language that involves English only to a point and is largely

incomprehensible to most people. As an example, I quote here a statement that makes up part of the first independent claim of a rather ordinary patent in the electronics field:

> a first-chip type integrated circuit chip mounted on the substrate, the first integrated circuit chip including a first power switch fabricated therein to alternately couple and decouple the input terminal to the output terminal, wherein the flip-chip type integrated circuit chip includes a p-type region and an n-type region, and the first power switch includes a plurality of p+ regions fabricated in the n-type region in a first array, and a plurality of n+ regions fabricated in the p-type region in a second array, and wherein alternating p+ regions are connected to the input terminal and to an intermediate terminal, and alternating n+ regions chip are connected to the intermediate terminal and to ground;

A mouthful to say the least. And this represents only *part* of the claim – albeit the most challenging part of the claim. While this is from a patent in the electronics field, the problems are by no means limited to that field. The simple fact is that patents are almost universally written in a way that makes them a challenge to understand. On top of that, the structure of a patent is foreign, and to the untrained eye, patent drawings look like little more than rudimentary scratches. Even the terms used in talking *about* patents rarely get used in any other context, such as “abstract,” “specification,” “independent claim,” “dependent claim,” “method claim,” “prosecution,” “file wrapper” and “prior art.”

Then there are the words used by patent prosecutors. Not even taking into account the unfamiliar and often scary scientific terms that are a necessary part of any patent, prosecutors

tend to use obscure words that can perplex a non-practioner reader. All too often, one sees in patents such words as “proximal,” “synchronous,” “medicament” and “plurality” rather than their more common synonyms “nearest,” “at the same rate,” “medicine” and “several.” I do not mean to suggest that the less familiar words should never be used or that the suggested synonyms are exact substitutes that should always be used. The point is that at times it can appear that prosecutors purposely choose words that would perplex the average person and that, when possible, prosecutors should give some thought to using common words in order to make the patent more understandable to those whose careers do not involve the regular reading or writing of patents.

Problems with the words used are compounded by the way the words are strong together in what may loosely qualify as “sentences.” The sentences in patent claims meander for many lines, with clauses within clauses, frequent semicolons, paragraph breaks in the middle of sentences and seemingly randomly-inserted commas. No one else writes like that – outside of the authors of European literature – so people are not used to reading – and have difficulty understanding – sentences constructed in that way. Not every patent has to be written with the clarity of a Hemmingway novel – although a laudable goal if it could be accomplished – but shorter sentences and the greater use of numbers to set off clauses within a sentence or paragraph could render patents exponentially easier to understand.

Why, prosecutors may wonder, does drafting a patent claim in the manner illustrated above present a problem? Patents are always and have always been written this way. Patent examiners apparently do not object to this form of drafting, as patents with such language issue all the time – indeed, the language quoted above appears in an issued patent. The fact, prosecutors may believe, that others may not understand what they have written does not really

matter; in fact, those accomplished in the art of drafting a patent make up a rather exclusive club, and the exclusive nature of that club would be diminished if *anybody* could understand the intricacies of a patent.

Wrong! To understand why a patent claim written in a way that cannot be understood by the unwashed masses ultimately may cause problems, consider who the ultimate audience for the patent is. The patent examiner? A person skilled in the art who must be able "to make and use" the disclosed invention?[1] The technical employees of the client? Of course, patents are written to be read and understood by all of those people.

I would like to suggest, however, that the ultimate audience for any patent that may become the subject of litigation is the person who has to interpret the patent – the judge of the case – and the people who have to decide whether the patent is valid and/or infringed – either the judge or the jury. Those people, who do not live and breathe patents, will likely find language of the type quoted above not only difficult to understand, but out-and-out intimidating. And this is before we factor in the technology itself, which is almost always outside of the knowledge and experience of the typical judge and juror. The less the deciders of the case understand what is written in the patent, the more their decision rests on other factors and the less predictable the outcome of the case becomes.

Of course, there are limitations as to what prosecutors can do differently. Patents, by their nature, use words to describe highly technical, scientific principles and operations. Even the clearest, most diligent writers cannot describe many of these concepts in a way that would be easily understood by non-scientists. In addition, the patent law, particularly 35 U.S.C. § 112, and the Patent Office rules require patents to contain certain essential components, although they do leave it largely up to the prosecutor as to how to implement the rules in a particular application.

Finally, it would be unrealistic to expect that years of convention could all of a sudden be disregarded. This paper is not a revolutionary manifesto.

I would like to encourage prosecutors, however, to strive for more clarity within the current patent framework. As you work through the drafting process, think about what you are trying to describe and make an effort to describe it in a more easily understood manner. Write as though the patent will be read by your spouse or college-age child. As noted above, whenever possible, use common words rather than obscure words, terms of art or jargon. Most importantly, each time you do a draft, think of ways to make the application more easily understood.

B. Take a Position

While I stand by everything I wrote about more clarity in patents, we have all seen situations where a patentee does not want his patent to be easily understood. A patent should be drafted in an understandable fashion only if the drafter or owner wants it to be understood. Most patentees want a patent that is broad enough to cover as wide a spectrum of infringing products as possible, but not too broad to fall within invalidating prior art. Some prosecutors attempt to resolve these internally inconsistent goals by making the claims vague – the thought being that the breadth of the scope can be defined in litigation once an actual accused product and applicable prior art have been identified – and then, if possible, "adjusted" in the next case to fit that accused product and prior art. This is a risky strategy. First, if the patent owner tries to assume inconsistent positions from one case to the next, the accused infringer in the later case will almost certainly make an issue of it, which could harm the owner's credibility. Second, vaguely stated claims run the risk of being invalidated for not "particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."[2]

In short, in attempting to have it both ways – broad enough scope to widely enforce, but narrow enough to avoid invalidating art – the patent owner may end getting neither. In most cases, it is better for prosecutors to take a position in the patent and clearly define the breadth of the scope.

Another area where the patentee and prosecutor are faced with a decision involves the definition of claim terms. "[A] patentee may choose to be his own lexicographer and use terms in a manner other than their ordinary meaning, as long as the special definition of the term is clearly stated in the patent specification or file history."[3] Thus, to the extent the patentee defines claim terms in the patent itself, the more likely it is the court will adopt those definitions in construing the patent. By giving certain terms a specific meaning in the patent, the patentee could limit the scope by not including in a definition a use or meaning that covers a potentially infringing product. In drafting a patent application, the patentee and prosecutor should determine whether clearly defining certain terms to improve the chances of getting a desired result in the *Markman* proceeding provides greater value overall than not defining terms in order to avoid limiting the claims in an undesirable manner. Whichever decision is made, the prosecutor and patentee should do so after careful consideration, rather than by default.

C. Make Sure Everything Fits Together

While the claims of a patent are undoubtedly the most important component, inasmuch as they set forth the invention actually being claimed, a prosecutor should not give short shrift to the other parts of the patent. Doing so can lead to problematic consequences. First, courts are to use the specification, drawings and abstract in construing the patent.[4] Accordingly, insufficient focus on those components can result in a construction that is narrower or different than the patentee intended.

Conversely, the specification does not constitute claims. Subject matter disclosed in the specification but not the claims themselves may not be eligible for assertion as part of the invention.[5] For both of these reasons, it is absolutely essential that the language of the claims be consistent with that of the specification – as well as will the abstract and the drawings.

Section 112 *requires* the specification to "set forth the best mode contemplated by the inventor of carrying out his invention." The failure to set out the *best* mode can result in a failure to comply with section 112 and thus an invalid patent.[6] Of course, whether the description of a use of an invention qualifies as the "best" mode is subjective, but this is not the place for the patentee or the prosecutor to get cute. If the patentee truly recognizes that, at the time of the application, there is a way to practice the invention that is superior to others, he should describe that way in the application. It is not worth risking invalidation to proceed in any other way.

D. Identify the Proper Inventors – All of Them

When two or more persons jointly come up with an invention, each person who contributed ***must*** be identified as an inventor in the application and issued patent.[7] Although the failure to include an individual on an application or patent – or the inclusion of someone who should not have been listed – can relatively easily be corrected, the applicants must demonstrate that the error was made without a "deceptive intention."[8] Nevertheless, the last thing a patentee wants to have to fight over once a patent is in litigation is whether others should have been named – or not named – as inventors. And, if a finding of deceptive intent could lead to invalidation of the patent – which is obviously not a result the patentee wants.[9]

To avoid this problem, the prosecutor should make every effort to ensure that all correct individuals – and only correct individuals – are listed as inventors from the start. This means, where possible, the prosecutor should talk to everyone who worked in any capacity on the

development of the invention and make a reasoned judgment call on who made a substantial enough contribution to qualify as a named inventor. If an inventorship error does surface, the prosecutor should immediately take steps to correct the error in the application or issued patent.

E. Know the Complete History of the Invention

Many a patent has been invalidated because of activities not directly related to the application or prosecution of the patent in the United States. Section 102(b) of Title 35 bars the issuance of a patent as to an invention "in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States." Many patent owners have business reasons for making a public use of an invention as soon as possible – for demonstrating the use of the invention, rolling out the invention at trade shows and the like. Similarly, the owner may make a very modest sale of an invention relatively early in the invention's life for the purpose of satisfying a valuable customer or generating revenues. Often, these activities are taken without consideration of whether a patent application should be filed or when the application can be ready for filing. Any such sale or use, even if minimal, can result in invalidating the patent if the patentee does not take care to get an application on file within a year of those events.

One of a prosecutor's critical jobs thus is to determine whether there has been a public use or sale of the invention and, if so, when that use or sale took place. Because the patentee may not truly understand what constitutes a public use or sale, it is incumbent on the prosecutor to probe diligently to uncover all activities that might conceivably qualify as an invalidating use or sale. Once he becomes aware of any such public use or sale, the prosecutor must make sure to get the application filed within the one-year window provided for by section 102(b) – if it is not already too late.

Foreign applications can also present problems. While a patentee can claim the date of filing of a properly issued foreign patent as the priority date for a U.S. patent on the same invention,[10] care must be taken to qualify for an earlier priority date based on a foreign filing. The U.S. application must be filed within 12 months of the earliest date the foreign application was filed, and the foreign application must meet the disclosure requirements of section 112.[11] Also, as a general matter, for inventions made in the United States, the U.S. application must be filed at least six months earlier than any foreign application, or the patent will be invalid.[12] While a mistake relating to the premature filing of a foreign application can be corrected by obtaining a foreign filing license, that can be a cumbersome process which might slow down or, in a worst case, end pending litigation on the patent.

The lesson for prosecutors here is to make sure you have a complete understanding of any and all foreign filings made on the invention. The prosecutor should get copies of all foreign applications, make sure they are consistent with what is claimed in the U.S. application and, where necessary, request a foreign filing license as promptly as possible.

F. Beware Provisional Applications

It has become increasingly common for prosecutors to file a provisional application pursuant to 35 U.S.C. § 111(b), primarily in order to preserve the earliest possible priority date for the invention. Because the provisional application need not state claims, they allow the prosecutor some flexibility as to how to fashion the claims when ready to file a full application.

Provisional applications do not come without risk, however. First, the application is deemed abandoned if the patentee does not file a complete application within one year of filing the provisional.[13] Second, inconsistencies between disclosures made in the provisional application and the later application – particularly regarding matters such as the best mode for

practicing the invention – could invalidate the patent under section 112, as case law would seem to suggest that a best mode disclosure would have to be updated if any new matter is disclosed in a subsequent utility application.[14]

Therefore, prosecutors must take care in drafting a utility application in a situation where a provisional application is already on file to ensure that the utility application tracks the content of the provisional application. When it is necessary to add new matter to the utility application, the prosecutor should make sure to update the best mode disclosure.

G. Bombs Hidden in the File Wrapper

The importance of the file wrapper in construing patent claims is well established.[15] Notwithstanding the universally-recognized power of the file wrapper, I am forever amazed at the frequency with which statements made by the prosecutor to the examiner rear their ugly heads during litigation. A prosecutor must, must, must take great care in arguing a particular point during prosecution or in responding to a rejection by the examiner. It serves no purpose to make a statement for the purpose of getting claims allowed if the ultimate effect is to end up with claims that, for all practical purposes, cannot be enforced. This goes back to an issue raised earlier in this paper: prosecutors have to understand how a patent will be used and work diligently to avoid saying something that might hinder that future use.

V. Conclusion

Another litigator could undoubtedly come up with a different list of "patents gone wrong." The above discussion reflects my experiences. My goal has been to share with prosecutors what happens with their work once it results in issued patents and to plant some ideas as to how certain problems might be avoided in the not-so-unlikely event their patents end up in litigation.

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[1] 35 U.S.C. § 112.
[2] 35 U.S.C. § 112; *Union Pacific Resources Co. v. Chesapeake Energy Corp.*, 236 F.3d 684, 692 (Fed. Cir. 2001).
[3] *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996).
[4] *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315-16 (Fed. Cir. 2005 (*en banc*)).
[5] *Oak Technology, Inc. v. U.S. Int'l Trade Commn.*, 248 F.3d 1316, 1329 (Fed. Cir. 2001).
[6] *Pfizer Inc. v. Teva Pharms.*, 518 F.3d 1353, 1364 (Fed. Cir. 2008).
[7] 35 U.S.C. § 116.
[8] *Id.*; 35 U.S.C. § 256.
[9] 35 U.S.C. § 256.
[10] 35 U.S.C. § 119(a).
[11] *Id.*; *In re Gosteli*, 872 F.2d 1008, 1010 (Fed. Cir. 1989).
[12] 35 U.S.C. § 184.
[13] 35 U.S.C. § 111(b)(5).
[14] *See Johns-Manville Corp. v. Guardian Industries Corp.*, 586 F. Supp. 1034 (E.D. Mich. 1983); MPEP § 2165.01.
[15] *Phillips v. AWH Corp.*, *supra*, 415 F.3d at 1315-16.