

To Crush Your Competition A Strong Patent Is Important Learn How and Why

Chemical and pharmaceutical companies protect their investment in research and development and the future of the companies by securing patents on their inventions. Patents help you resist competition. Success or failure of the company often depends on the strength of the patent and the longer the term of the patent, the greater will be its value. A strong patent is one that defines your invention broadly and but at the same time builds in fallback narrow invention.

The United States Patent and Trademark Office receives hundreds of thousands of patent applications each year. In fact, the Patent Office has recently proposed new patent rules to ease the Examiner workload. According to one proposed rule, if a patent application is rejected, to be able to present your case again, the patent applicant will be limited to filing one request for continued examination (or RCE). In light of the new rule, unless the patent applicant masters the complexities of patent law, the applicant might end up getting a weak patent instead of a strong one.

Imagine you have filed a patent application where you have defined your invention broadly as well as narrowly in ten succinct sentences in what are known as patent claims. These patent claims will be numbered 1 through 10. Typically claim 1 will represent the invention of the broadest scope, and the higher numbered claims represent fallback narrow inventions. In our hypothetical, claims 2 to 10 will refer back to claim 1. Thus, claim 2 refers back to claim 1. Claim 4 refers back to claim 3, which in turn refers back to claim 2. Claim 5 refers back to claim 1 or claim 4. In this example, say claim 5 refers back to claim 1. Keep in mind that the more number of fallback claims you have, you have a better chance of winning the lawsuit in the event your competitor challenges your patent.

Now imagine that the Examiner rejects the patent, as it often happens, stating that the invention is not new or is only a minor modification of what is known already. You, as patent applicant, have a chance to respond to the Examiner. You present arguments stating why the invention is new and not obvious and why you should be granted a patent. The Examiner rejects your argument. Now, to continue your effort to get a patent, you wish to present new arguments. To do so, you may have to file an RCE (and the fee) along with the new arguments.

The Examiner takes it up again. This time, the Examiner softens a little and says, in a non-final rejection, that invention of claims 4 to 10 would be allowable as a patent if you rewrite claim 4 without a reference to claim 1, but continues to reject the broader invention of claims 1, 2, and 3. You now have a choice of taking what the Examiner gave you, that is, claims 4 to 10 or alternatively, argue some more. You choose to argue. The Examiner finally rejected your application, repeating what he said before, that is, claim 4 onwards would be allowable if you rewrite it as indicated before. Now, the options you have are very limited. You can rewrite claim 4 as the Examiner indicated, as new claim 1, and obtain a patent with new claim 1. However, you will not be able to get a patent with claims 5 to 10.

The Examiner would refuse to grant claim 5 to 10 because he will say that claim 5 now has been changed in its scope even though you did not change the wording of the claim. The Examiner will argue that original claim 5 referred back to original claim 1. Now, claim 5 refers back to new claim 1, which is of a different scope. The Examiner would indicate that, as the scope of the claim has changed, he would need to carry out further search and examination on claims 5 to 10. He would say that the patent law would not allow him to do so since the rejection has been made final already. The only way to get the Examiner moving on this would be if you could file an RCE. However, you have already used up your RCE option. You cannot file another RCE now, and therefore, you cannot get claims 5-10. You will get a patent with just one claim. If an infringer challenges your patent, and proves that your only claim is invalid, your entire patent would be thrown out.

If you had rewritten claim 4 (as new claim 1) when responding to the non-final rejection, rather than when responding to the final rejection as you did, patent law would have allowed the Examiner to carry out further search on claims 5 to 10, and the chances of getting those claims would have been favorable. If you had fallback position of claims 5 to 10 also, you would have a greater chance of winning the case.

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About the Author

Dr. Xavier Pillai is a partner at the law firm of Leydig, Voit & Mayer, Ltd. in Chicago, IL, specializing in patent law in chemistry, biotechnology, and pharmaceuticals. Phone: (312)616-5600, email at xpillai@leydig.com; or see <http://www.leydig.com>.