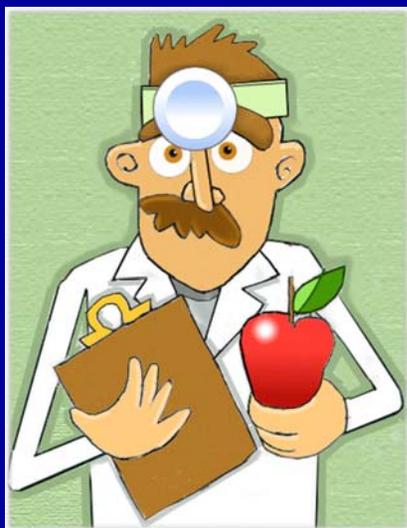


PROSECUTION THERAPIES: PRESCRIPTIONS FOR HEALTHY PATENTS

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Prosecution Therapies: Prescriptions for Healthy Patents



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Common sense helps us manage our personal health:

- Don't drink on a hot day... in Phoenix . . . in July.
- Don't substitute raw chicken for sushi if you have a fish allergy.
- Don't take your dog for a walk in a Minnesota winter, but leave your hat, gloves, and boots at home.
- Don't eat a gallon of Chunky Monkey® while watching Oprah and Giraldo back-to-back.



Unfortunately, common sense often doesn't help in prosecution:

Is my claim scope going to be okay, doc.

That's what prosecution therapy is all about, Dave.

- Amend claims
- Describe invention
- Distinguish references
- Submit experimental data



Prosecution Therapy Principles

- Know conduct that causes poor claim health.
- Implement preventive care.
- Enjoy healthier claims.

Your claims are looking better, Dave.

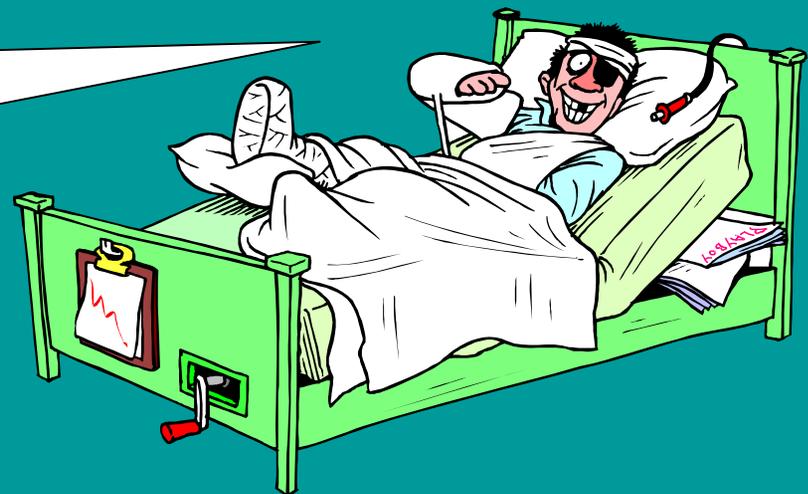


The case law is great medicine, doc.

Prosecution Therapy helps prevent these sickly claims:

- Placebo Claim
- Vestigial Claim
- Allergenic Claim
- Festo Flu
- Common Cold Claim
- Bloating Claim

There's hope for me yet!



PLACEBO CLAIM

CONDITION: Generic-looking claim that is entitled only to a surprisingly narrow, **LITERAL** claim construction.

I feel fine,
doc.

Yes, but there's nothing
in there. Not a peep.



The condition is becoming increasingly common!

TYPICAL FACT PATTERN THAT CAUSES THE PLACEBO CLAIM:

- Broad claim.
- Broad supporting specification.
- Generic terms unaltered during prosecution.
- Oops! CAFC uncovers **IMPLIED/INFERRED** disclaimer in the prosecution.
- Most often, disclaimer not needed to distinguish the prior art.

RESULT: *Surprisingly narrow claim construction*



Viskase Corp. v. Amer. National Can Co.

About 0.91?



Precisely
0.910.

You caught this
bug from your
attorney.

Day Intl. Inc. v. Reeves Bros. Inc.

Below the melting
point?



Below the melting
point and in the
range 110°F to
170°F.

You caught this
bug from your
attorney.

Ecolab Inc. v. Envirochem Inc.

Substantially
Uniform?

Substantially uniform
composition, not
substantially uniform
performance over time.



You caught this
bug from your
attorney.

*Tegal Corp. v. Tokyo Elect.
Amer. Inc.*

Plasma?

Only glow discharge
plasma and no other
plasmas.



You caught this
bug from your
attorney.

Rheox Inc. v. Entact Inc.

Calcium
orthophosphate?



Calcium
orthophosphate but not
TSP and not
monocalcium
orthophosphate.

You caught this
bug from your
attorney.

Biovail Corp. Intl. v. Andrx Pharma. Inc.

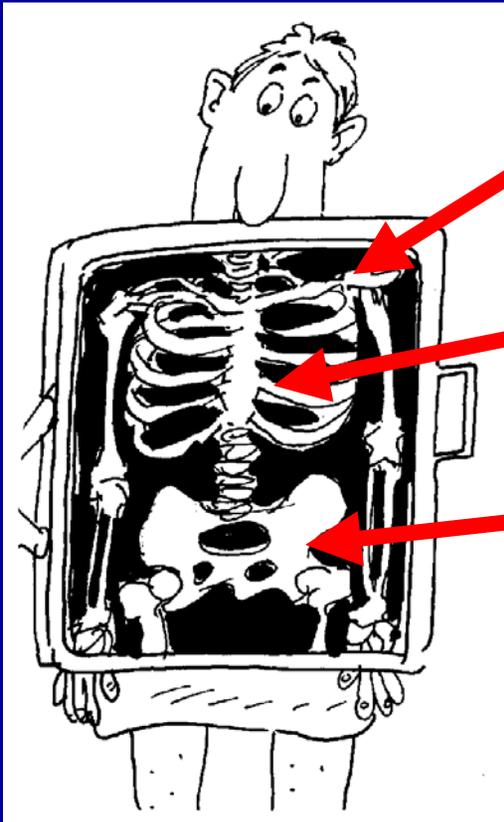
Have I got a
Placebo Claim
again, doc?

Same old, same old.

This time, you
caught it from a
related
prosecution
history.



Cause of Placebo Claim easy to see:

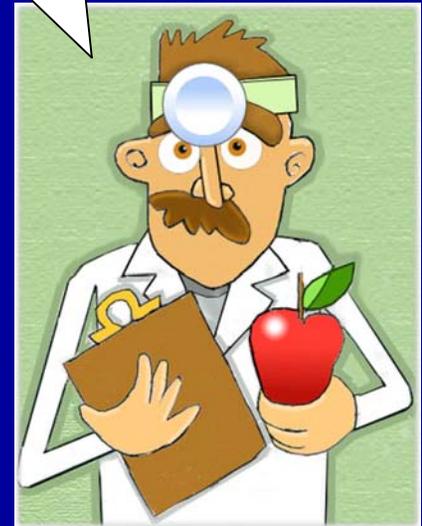


- Arguments are mismatched to claim scope
- Entirely attributable to attorney conduct
- Significant trend (today v. 1997-1998)

PLACEBO CLAIM PRESCRIPTION:

Prognosis is good for PREVENTION!

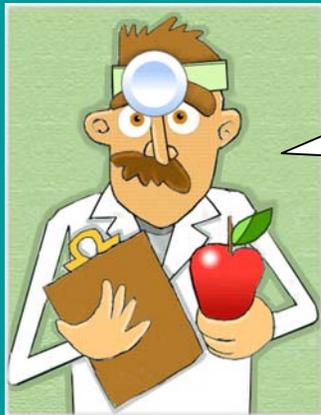
1. Match patentability arguments to pending claim scope, and
2. Link specific arguments to specific claims.



ALLERGENIC CLAIM (Prosecution Laches)

Condition: Claim that first appears irritatingly late in prosecution.

Unexpectedly established by CAFC in *Lemelson* (Fed. Cir. 2002).

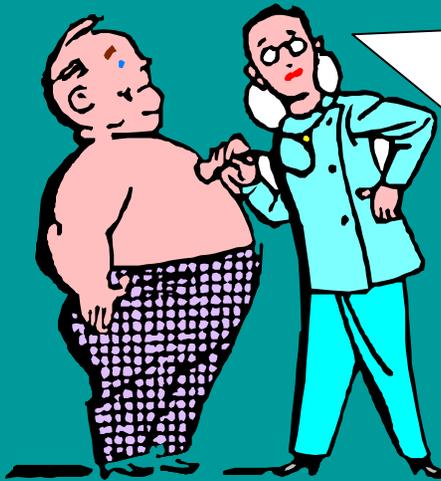


Unreasonable and unexplained delay in presenting a claim. In the presence of intervening rights, claims are unenforceable.

DOES PROSECUTION LACHES APPLY TO ME?

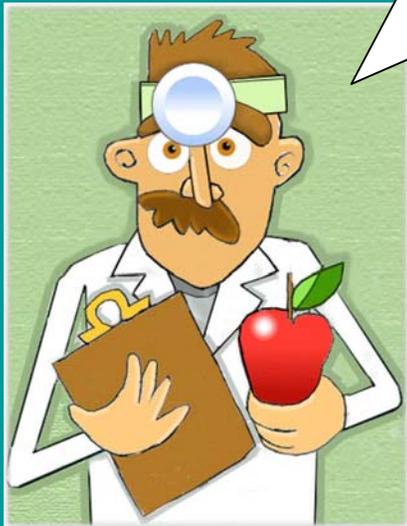
“The Court applied the doctrine in Webster a year later and held that an unreasonable eight-year delay rendered the claims at issue unenforceable. . . . The Court went on to say that a two-year delay was prima facie evidence of unreasonableness. Id. at 471.”

Weren't the
Lemelson
facts unique?



Yes, but there
are practical
implications for
everyone.

ALLERGENIC (PROSECUTION LACHES) PRESCRIPTION:



- Legislative/judiciary response
- File new claims and don't "pre-negotiate" against yourself
- Bonus: Art III and Separation of Powers aspects

THE VESTIGIAL CLAIM

Condition: Totally useless claim that is inoperable and covers nothing

- Impossible limitation
- Like your appendix, only more useless
- At least Placebo Claim covers something



- *Process Control* (Fed. Cir. 1999)
- *Elekta* (Fed. Cir. 2000)
- *EMI* (Fed. Cir. 2001)
- *Talbert* (Fed. Cir. 2002)

HOW BAD IS MY VESTIGIAL CLAIM CONDITION, DOC?

“ . . . administered under conditions effective to eliminate side effects by interfering with the ability of the virus to block said enzymatic activity . . .”

- Increasingly common
- Due diligence investigations
- Nonsensical feature or scientifically unsound mode of operation (theory/function)



EMI Group North America Inc. v. Cypress Semiconductor Corp.

No: “said refractory metal forming a cap to prevent evaporation of said fuse portion when said fuse portion is exposed to a directed energy source to increase the vapor pressure under the cap to produce an explosive removal of said portion[.]”

Yes. “...said refractory metal forming a protective element over at least a portion of the fuse portion in a manner effective to allow the fuse to be operatively triggered when exposed to . . .”



Proof. Proof. Proof.

VESTIGIAL CLAIM IS A RICHES TO RAGS STORY:

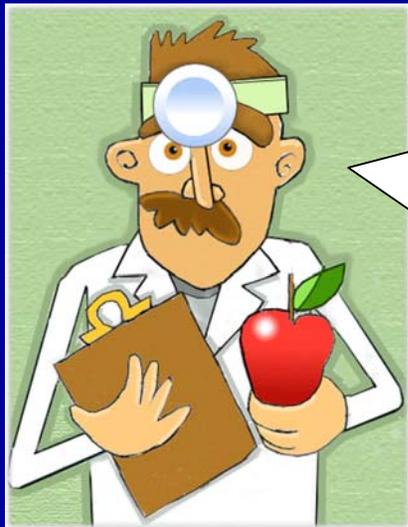
- Broad, operative claim filed
- Examiner rejects claim
- Prosecuting attorney narrows the claim with impossibility
- Narrowing amendment persuades the Examiner

Oops.

Claim has no value now.



HOW CAN A PERFECTLY GOOD CLAIM END UP IN THE VESTIGIAL SANITARIUM?



- Good prosecution integrates legal, technical and business perspectives
- In *Process Control*, *Elekt*a, *EMI*, and *Talbert*, only legal perspective kept in mind
- Technical and business perspectives completely ignored

VESTIGIAL CLAIM PRESCRIPTION

- Know the 1^o directive: **Commercial Value**
- Prosecution is a team effort: legal, technical, business
- Be wary of putting function/theory into your claims



Proof. Proof. Proof.



FESTO FLU

Condition: afflicted claim limitations may have no range of equivalents under the D/E



- *Festo* (Fed. Cir. 2000)
- Recent cases highlight draconian impact of *Festo* . . .

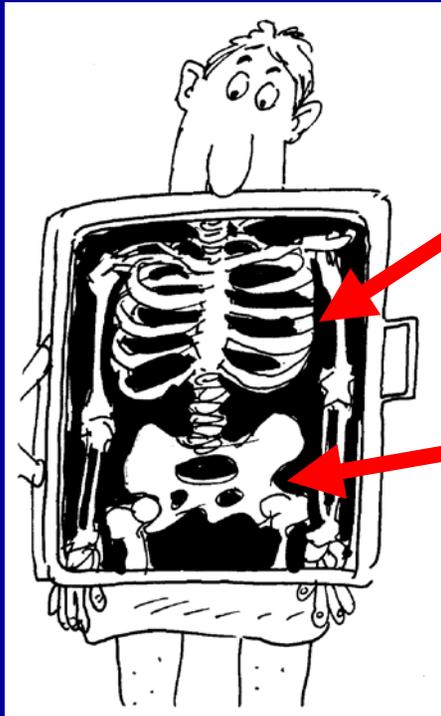
PROSECUTION STRATEGIES THAT FAILED TO FOIL FESTO:

- Claim substitutions
- §112 amendments
- Related prosecution
- Mere argument/acquiescence?



COMMON COLD

Condition: Claims that “catch” prosecution history estoppel from **OTHER** prosecution histories.



Unexpected source of
prosecution history estoppel

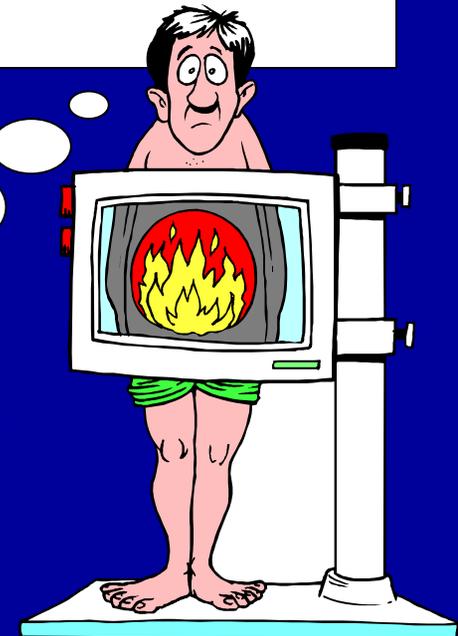
*Viskase Corp. v. American
National Can Co* (Fed. Cir.
2001).

THE MOST COMMON SOURCE OF INFECTION

- **Prospective estoppel:** past impacts present
- Clearly, earlier prosecutions impact later claims
- Many, many cases on point



Can the present
impact the past?
(**Retroactive
estoppel**)



DOES RETROACTIVE ESTOPPEL EXIST?

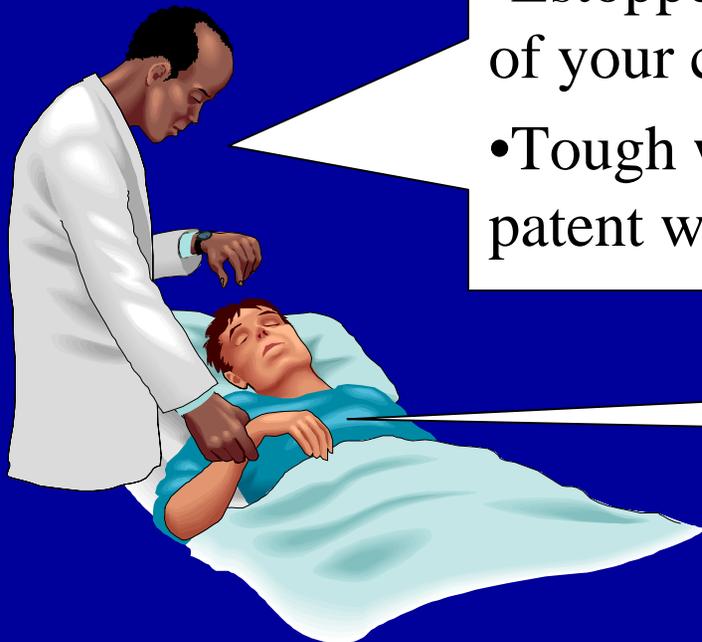
- Rationale of “prospective” cases suggests no, but...
- Foreign counterparts are relevant (*Tanabe*)
- Later U.S. prosecution explored by CAFC in construing earlier claims (*Desper*)



+ Yes.

CATCHING THE COMMON COLD FROM YOUR NEIGHBOR

- Prosecution history of a commonly-owned, but otherwise unrelated patent can infect your claims! (*Viskase*)
- Estoppel might not be your own, but that of your colleague down the hallway.
- Tough when multiple attorneys staff patent work for the same business unit!



This one is awful!

THE BLOATED CLAIM

Condition: A Markush claim is stuffed with Markush members, but fails to be assisted by pressure-relieving dependent claims.

You don't look surprised to see me, doc.

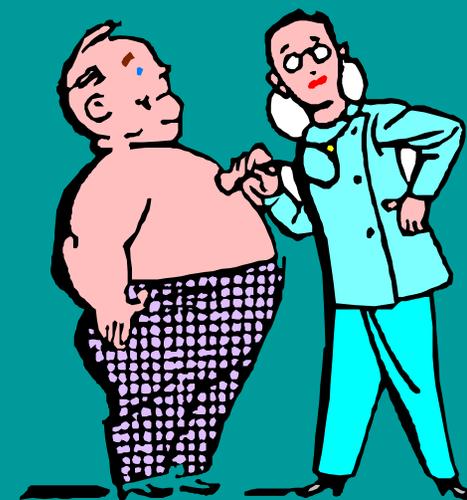


- Vulnerable to validity attacks
- Common in pharmaceutical and chemical patents

A RECENT BLOATED CLAIM THAT SUCCUMBED UNDER THE STRAIN OF BATTLE:

“A method of using compound X for
purpose A or purpose B.”

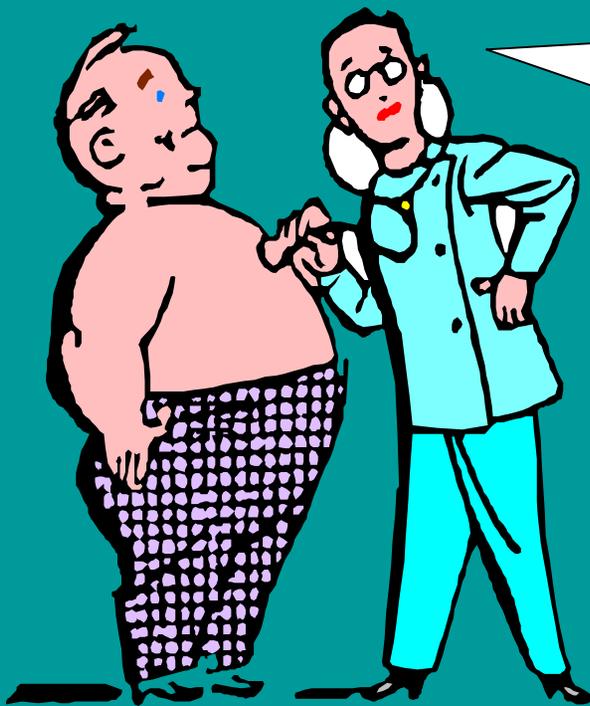
- *MSM Investments Co. v. Carolwood Corp.* (Fed. Cir. 2001)
- Simplest Markush claim imaginable: only 2 members



MSM CLAIM: A METHOD OF USING COMPOUND X FOR PURPOSE A OR B

Result: Claim invalid.

Accused infringer is a happy
camper!

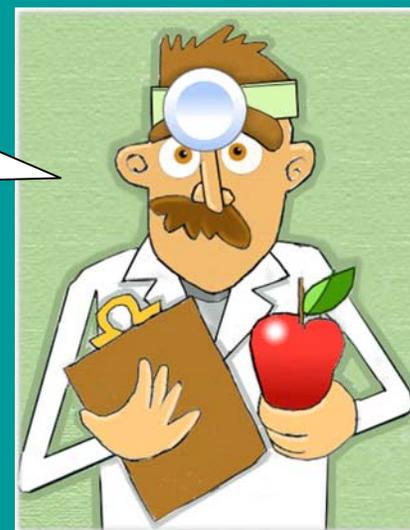


- A arguably patentable.
- B is in public domain.
- No dependent claim to A.
- Infringer using X for purpose A.

BLOATED CLAIM PRESCRIPTION:

“2. The method of claim 1,
wherein compound X is used for
purpose A.”

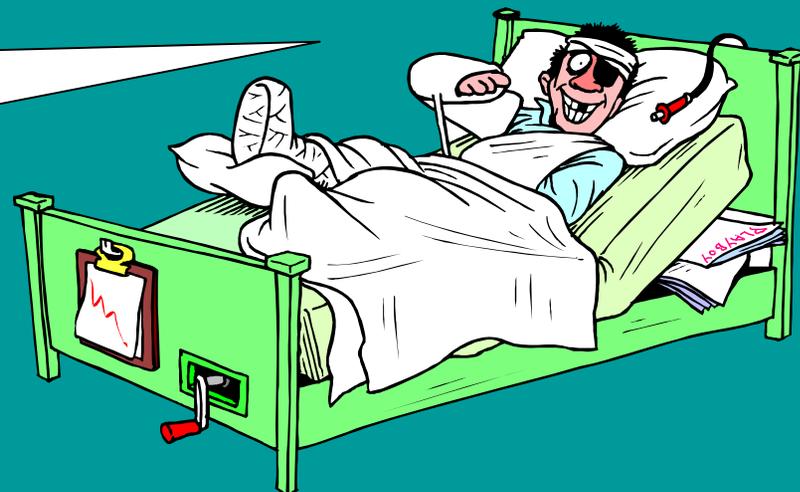
- Use dependent claims for key groupings and species
- If the *MSM* patentee had done this, the infringer would not have been able to enter the market unfettered:



Prosecution Therapy helps prevent these sickly claims:

- Placebo Claim
- Vestigial Claim
- Allergenic Claim
- Festo Flu
- Common Cold Claim
- Bloating Claim

I feel better already!



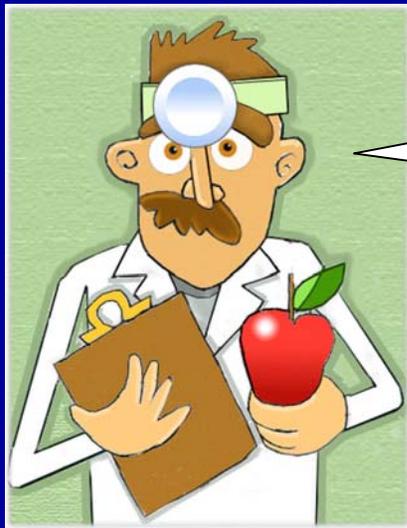
Prosecution Therapy helps prevent these sickly claims:

- Match arguments to claim scope
- Integrate legal, business, technical expertise
- File new claim ideas diligently
- Amend Carefully
- Prosecute consistently
- Back up Markush claims



I can do this!

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Thank you very
much for your time.

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