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Drafting Quality Claims: Cost Effective Correlation with Business Purposes

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Over 80 Years of IP Excellence

AGENDA

- MOST COMMON BUSINESS PURPOSES TO SEEK PATENTS
- CLAIMS CONTENTS – TO SUIT BUSINESS PURPOSES
- FILING & PROSECUTION STRATEGY – TO SUIT BUSINESS PURPOSES
- BUSINESS PURPOSES AND CORRESPONDING CLAIMS/PROSECUTION STRATEGIES
- EXAMPLES OF STRATEGIES FOR DIFFERENT BUSINESS PURPOSES
- CONCLUSIONS

MOST COMMON BUSINESS PURPOSES

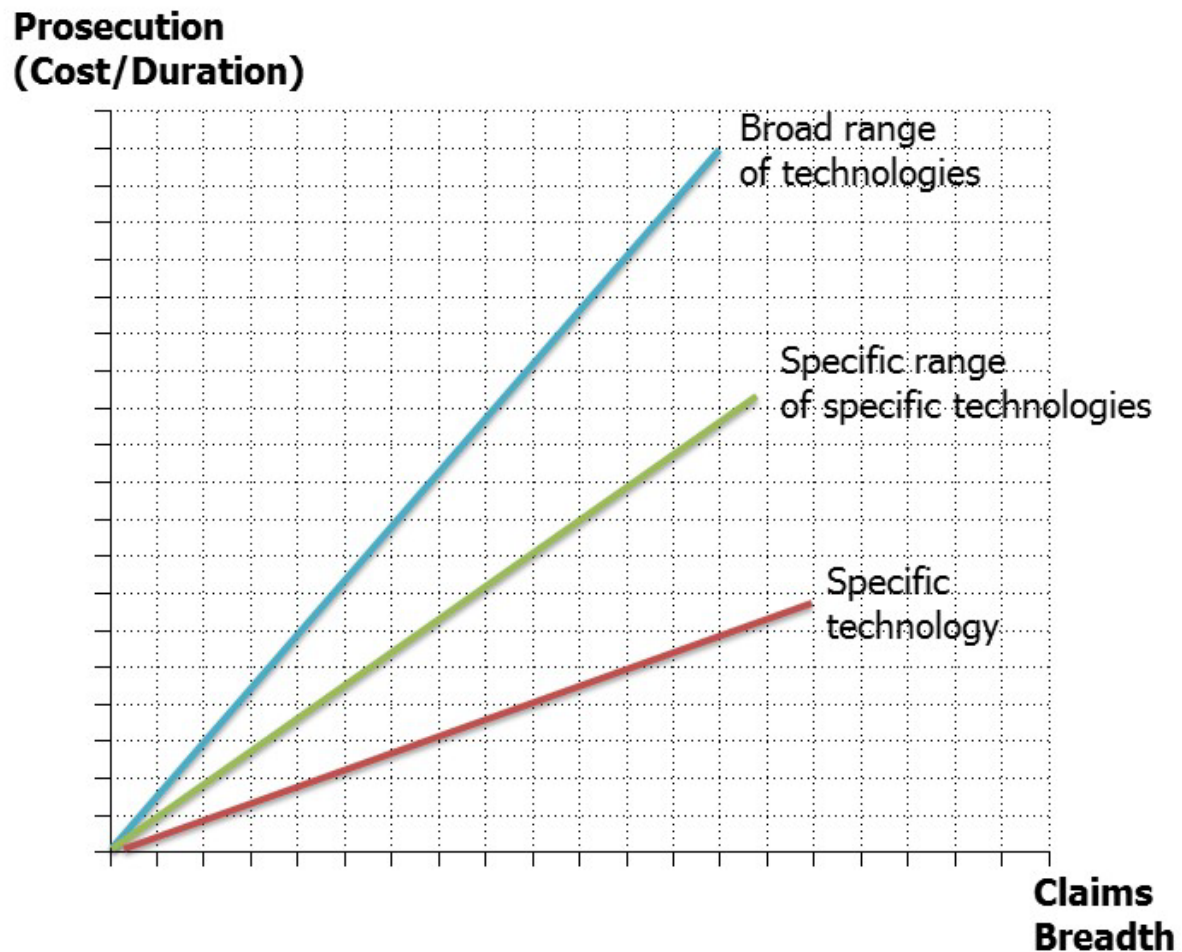
- Offensive
- Defensive
- Licensing
- Tenders
- Ability to obtain investment for private inventor/s
- Ability to raise funds for a company (e.g. start-up)
- Marketing advantages

CLAIMS CONTENTS - TO SUIT BUSINESS PURPOSES

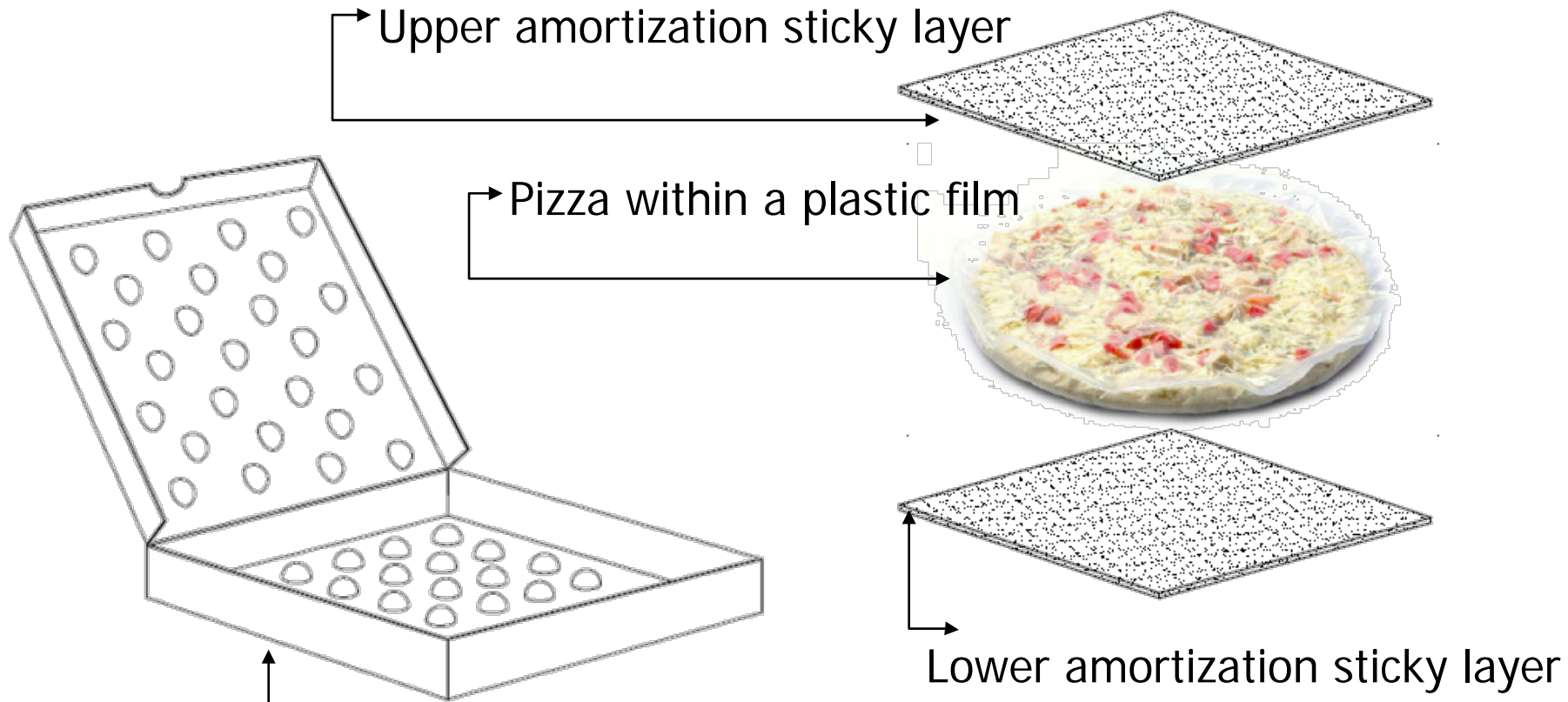
- Scope of independent claims vs. cost-effectiveness
 - ❑ Functionality limitations
 - ❑ Technology-relating limitations
- Claims set structure
 - ❑ Types of Claims
 - ❑ Number of independent and dependent claims

CLAIMS CONTENTS – TO SUIT BUSINESS PURPOSES

Scope of Claims vs. Cost-effectiveness

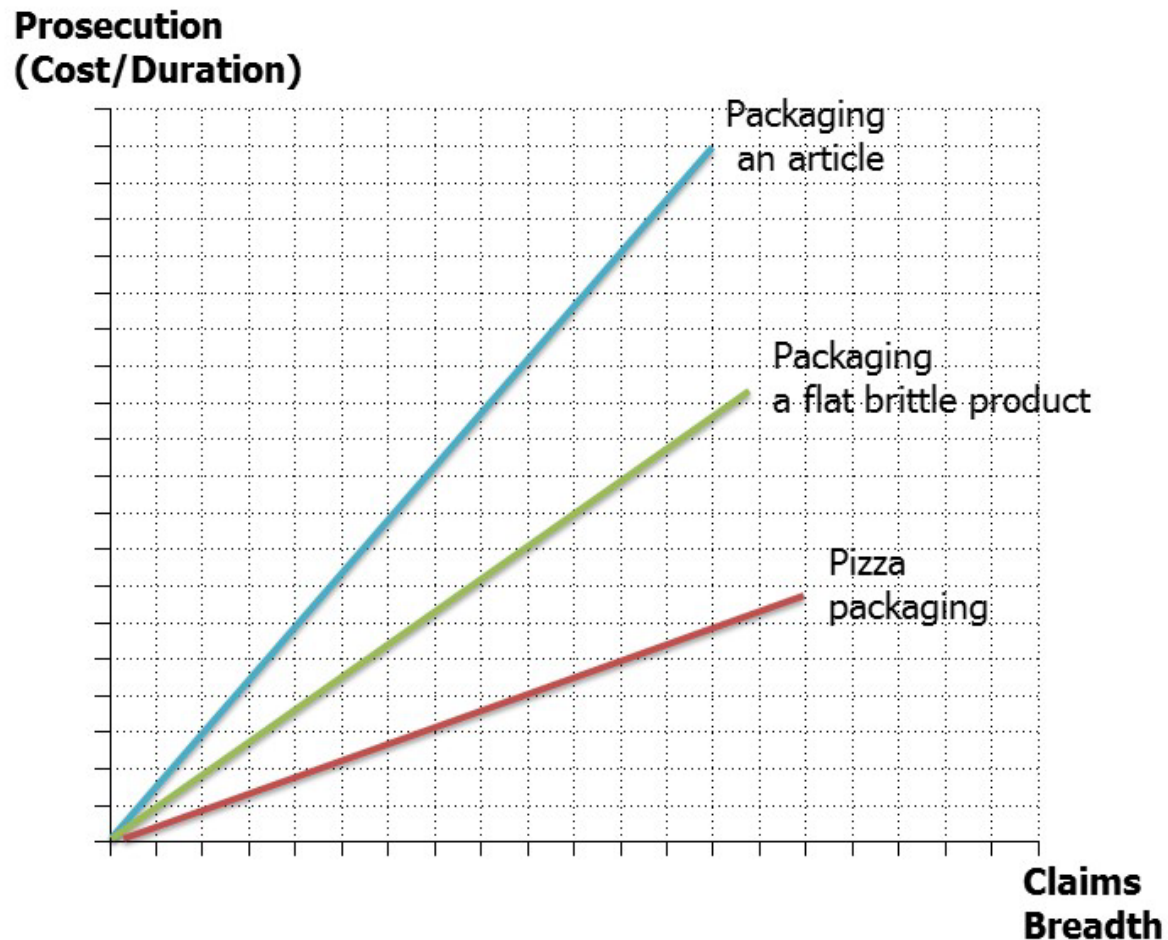


EXAMPLE: FROZEN PIZZA PACKAGE



EXAMPLE: FROZEN PIZZA PACKAGE

Scope of Claims vs. Cost-effectiveness



FILING & PROSECUTION STRATEGY - TO SUIT BUSINESS PURPOSES

Filing and Prosecution Strategy

- **Short route** (granted patent a.s.a.p.)
 - ❑ First filing with a fast WO (e.g. UK, Israel)
 - ❑ Accelerated Examination (GPPH/PPH; PACE/EPO)
- **Long route** (applicant's flexibility, uncertainty for 3d parties)
 - ❑ PCT filing (importance of the order of claims)
- **Continuation/divisional practice**
- **Combined** - for different claims sets

BUSINESS PURPOSES AND CORRESPONDING CLAIMS/PROSECUTION STRATEGIES

Offensive Patenting

Purpose

To prevent others from exploiting the technology, i.e. enabling the patentee to use his patent to sue for infringement

Subject Matter

- What the patentee is practicing or intends to practice
- Normally, relating to the company's core business

BUSINESS PURPOSES AND CORRESPONDING CLAIMS/PROSECUTION STRATEGIES

Contents of Claims for Offensive Patenting

➤ Types of claims

- Suitable for enforcement
- Suitable against expected kind of infringement

➤ Independent claims

- Broad functionality (not allowing designing around)
- Narrow field of technology (to restrict to the field of the company's interests)
- Directed exactly to the business model of the potential infringer
- Allowing to prove infringement

BUSINESS PURPOSES AND CORRESPONDING CLAIMS/PROSECUTION STRATEGIES

Filing & Prosecution Strategy for Offensive Patenting

➤ If easy to copy and fast to reach the market

- ❑ Short route (granted patent a.s.a.p.)
 - First filing with a fast WO (UK, Israel)
 - Accelerated Examination (GPPH/PPH; PACE/EPO)
- ❑ Continuation/divisional practice (for attempts to design around)

➤ If hard to copy and/or takes long to reach the market

- ❑ Long route (flexibility for the applicant, uncertainty for 3d parties)

BUSINESS PURPOSES AND CORRESPONDING CLAIMS/PROSECUTION STRATEGIES

Defensive Patenting

Purpose

To prevent a third party from restricting the patentee's freedom to operate, i.e. to disable the third party to sue the patentee for infringement of the third party's exclusive rights.

Subject matter

- What the patentee is practicing or intends to practice
- What the potentially threatening third party may possibly practice or is already practicing

BUSINESS PURPOSES AND CORRESPONDING CLAIMS/PROSECUTION STRATEGIES

Strategy for Defensive Patenting

Defensive patents do not need to be strong so most considerations depend on financial resources (FR) the applicant is prepared to invest

Independent Claims

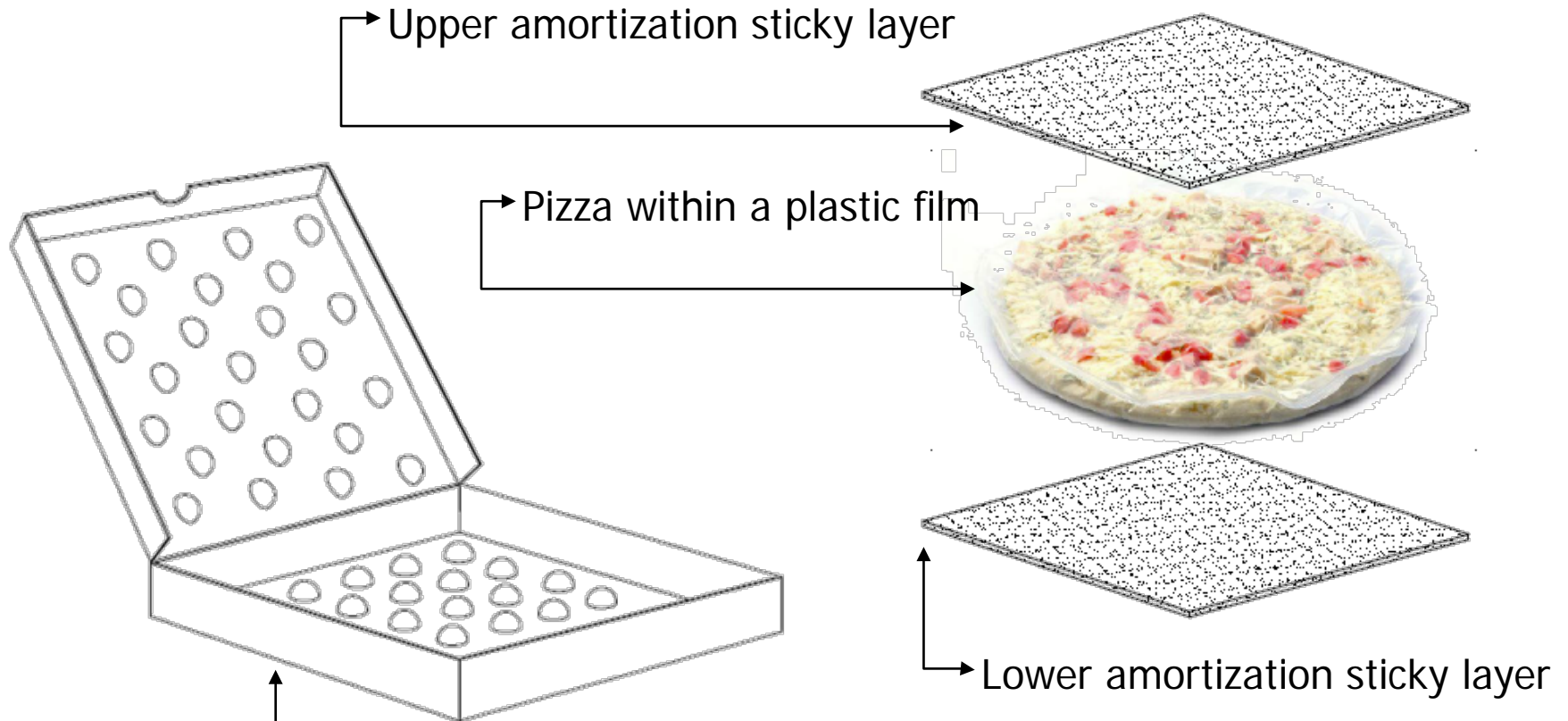
- If FR are high - broad functionality scope (limited only by prior art considerations)
- If FR are limited – narrow functionality scope
- Filing & Prosecution – Depends on the FR

BUSINESS PURPOSES AND CORRESPONDING CLAIMS/PROSECUTION STRATEGIES

Examples of Considerations for Other Business Purposes

- Licensing - delayed prosecution costs for each of
 - ❑ One patent application directed to different possible technologies
 - ❑ Separate/divisional application for each technology of interest
- Tender - directed to the specific technology and all possible infringers
- Marketing advantages - minimal expenses
- Ability to obtain investment - depends on the kind of investors
- Ability to raise funds - a large number of applications with long-route prosecution

EXAMPLE: FROZEN PIZZA PACKAGE



EXAMPLE: FROZEN PIZZA PACKAGE (CONT'D)

Business model

Packaging boxes manufacturer produces the boxes and supplies them, in kits with the off-the-shelf sticky layers, to manufacturer of frozen pizza, who packages the pizza for sale

Market-relating considerations

- Easy to copy
- Easy to market



EXAMPLE : FROZEN PIZZA PACKAGE – 1ST APPLICANT, 1ST BUSINESS PURPOSE

Applicant Pizza Manufacturer

Business Purpose Offensive

To prevent other pizza manufactures from producing and selling pizza packed by the Applicant's method

➤ Independent claim

Pizza package including pizza + broad functionality scope

➤ Filing & prosecution Short route + cont. filing



EXAMPLE: FROZEN PIZZA PACKAGE – 2ND APPLICANT, 1ST BUSINESS PURPOSE

Applicant Packaging Box Manufacturer

Business Purpose Offensive

To prevent other packaging manufactures from producing the inventive packages for anything and, particularly, for pizza

➤ Independent claims

❑ *Packaging box for pizza w/o pizza in the claim*

❑ *Packaging box for a brittle flat product/article*

❑ Claim for entire package would be against the customer

➤ Filing & prosecution Short route + cont. filing



EXAMPLE: FROZEN PIZZA PACKAGE - 2ND APPLICANT, 2ND BUSINESS PURPOSE

Applicant Packaging Box Manufacturer

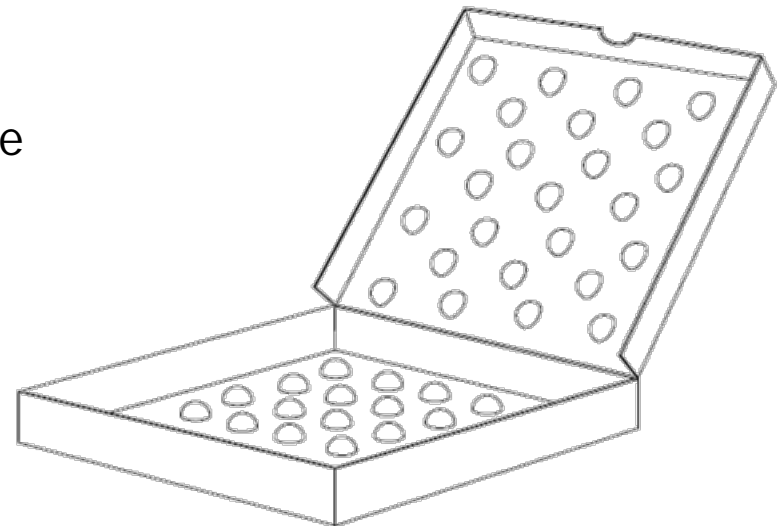
Business Purpose Defensive

Not to be sued by a competitor producing packages for anything

Independent claims

- If FR are high, broad functionality scope
(limited only by prior art considerations)
- If FR are limited, narrow functionality scope
- Technology scope – broad

Filing & prosecution – depends on FR



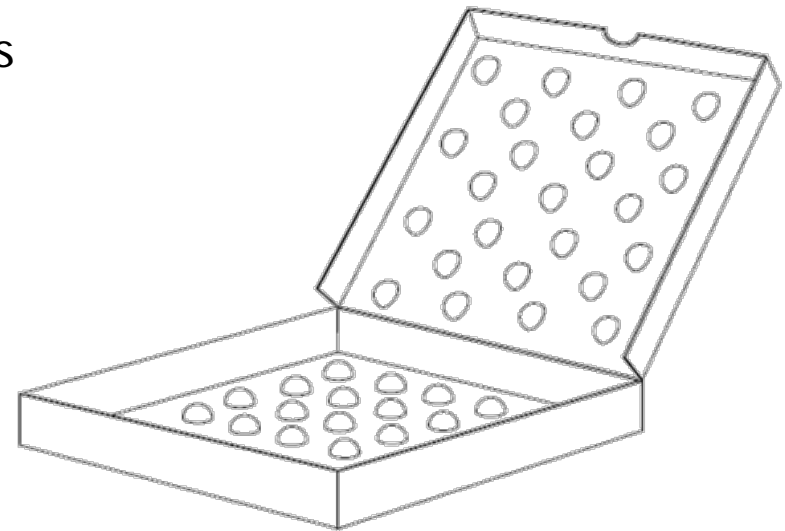
EXAMPLE: FROZEN PIZZA PACKAGE – 2ND APPLICANT, 3^D BUSINESS PURPOSE

Applicant Packaging Box Manufacturer

Business Purpose - Tender for Pizza Packaging

To increase chances to win the tender

- Independent claims – all possible types of pizza-relating claims with broad functionality scope
- Filing & prosecution To postpone decisions depending on the terms of the tender



EXAMPLE: FROZEN PIZZA PACKAGE - 3^D APPLICANT, 1ST BUSINESS PURPOSE

Applicant Private inventor/s

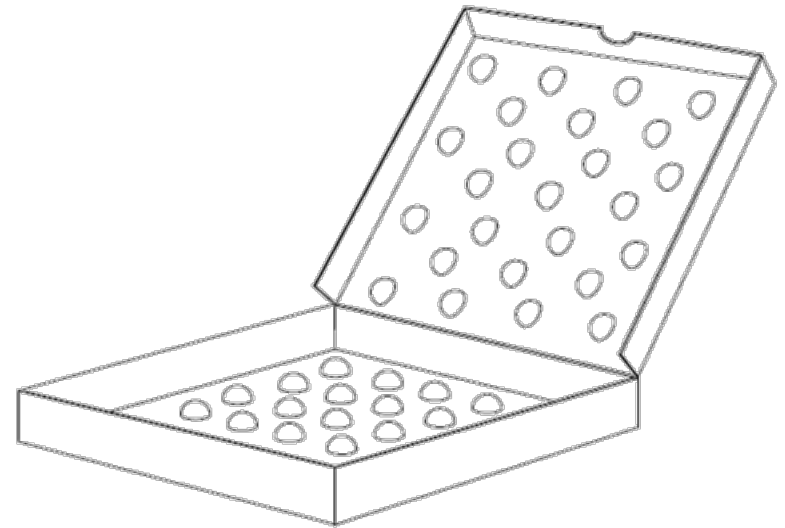
Business Purpose Licensing to pizza and/or pizza packaging box manufacturers

➤ Independent Claims

- Pizza package including pizza*
- Pizza packaging box per se*
- Packaging box for a brittle flat article*

➤ Filing & Prosecution

- Long-route or combined



CONCLUSIONS

Suggested Business –Related Questions to Raise before Starting Patent Drafting

- What is the applicant's business purpose? If offensive,
 - ❑ Whom does the applicant wish to prevent from using his invention?
 - ❑ How does the applicant expect the use to be performed?
- Bearing in mind financial consequences:
 - ❑ How broad is the field of technology to be covered?
 - ❑ Does the applicant wish to have a long pendency period or to get a granted patent as soon as possible?

Thank
you!



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