

## ARCHIVE 2008

### **“Intellectual Property: What Is It and What Do I Do With It?”**

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Intellectual Property is important, and will become increasingly important, to the electronics industry. Intellectual Property includes (but is not limited to) patents, copyrights, trademarks and trade secrets. After a brief review of the types of Intellectual Property, this tutorial primarily focus on a deep dive into the patent aspect of Intellectual Property. Topics included are pre-patent protection of your Intellectual Property, what is a patent, how to read a patent, how to interpret the claims of a patent, the patenting process from invention disclosure to patent, types of patent applications, worldwide patenting mechanisms including the Paris Convention, the European Patent Convention and the Patent Cooperation Treaty and some recent important court decisions. Patent enforcement, highlighting some troublesome countries, are also be touched upon.

Who should have attended this tutorial?

Have you ever had questions on Intellectual Property but you didn't know who to ask for answers? Have you ever wanted to learn more about Intellectual Property? This tutorial is meant to be a primer on Intellectual Property for inventors, engineers and business persons (i.e., specifically non-lawyers) who deal with Intellectual Property in some way, shape or form. The tutorial will cover a broad range of topics beginning with a definition of what is Intellectual Property and then move into the arena of patents as Intellectual Property. The tutorial will finish with some discussion of international aspects of protecting and enforcing Intellectual Property. There will be something in the tutorial for all those interested in the subject of Intellectual Property, whether you know a little or a lot about Intellectual Property.

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## Intellectual Property: What Is It and What Do I Do With It?

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## Tutorial Goals

- ® Increase your knowledge of intellectual property
- © Become a more knowledgeable intellectual property consumer
- ™ Become a better manager of intellectual property

?!?!?

?!?!?

## There Are No Stupid Questions

This presentation is meant to be interactive

Questions are not just encouraged, they are expected

Please feel free to ask questions at any time during this presentation.

## Agenda

- What is Intellectual Property
- What Can I Do With Intellectual Property
- Patents Deep Dive
  - History of Patents
  - Patent Requirements
  - Patenting Process
  - Infringement; Validity; Licensing
  - International Patenting
  - International Patent Enforcement
  - Court and USPTO Activities

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## Why Do We Care About Intellectual Property (IP)?

By one account, IP is estimated to account for over 2/3 of all corporate value

IP is a powerful defensive and offensive weapon!

- Think Blackberry and Vonage

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## Common Forms of Property

### Real Property

- House, Land



### Personal Property

- Jewelry, cars



### Intellectual Property © ® ™

- Intangible property

## Types of Intellectual Property (IP)

### Patents

- Idea / invention

### Trademarks

- indicator of source of goods / services

### Copyrights

- fixed expression of an idea

### Trade Secrets / Know-how

- secret information (technical or business)

## Types of Intellectual Property (IP) (Cont.)

### Patents:

- Statutory (35 U.S.C., 37 C.F.R.) – well-defined

(read as “title 35 United States Code”,  
“title 37 Code of Federal Regulations”)

[www.uspto.gov](http://www.uspto.gov) if you deal with IP in any context  
BOOKMARK THIS SITE!

## The Patent Quid Pro Quo

A patent is an agreement between the Government and the inventor where the government grants the inventor the right to exclude others from making, using, selling, offering for sale or importing the invention for a limited period of time (20 years from earliest filing date).

What's missing here?

## The Patent Quid Pro Quo (Cont.)

What does the Government get from the inventor?

- The inventor provides disclosure of the invention in a manner that enables one of ordinary skill in the art to practice the invention in some form
- Promotes the progress of the science and useful arts

## Types of IP (Cont.)

Patents (Cont.):

The scope of a patent is strictly determined by its claims

The specification merely provides background and context for the claims

Analogy to real property

- Claims define the “metes and bounds” of invention

## Types of IP (Cont.)

### Trademarks:

- Statutory (15 U.S.C., 37 C.F.R.), well-defined
- Common law trademarks also
- Identifies the source of product or service
- Right to exclusive use is lost if trademark becomes generic

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## Types of IP (Cont.)

### Trademarks (Cont.):

- Proper usage: treat as an adjective, i.e., Coke® soft drink, not Coke®
- Identify trademark with “TM”
- Identify service mark with “SM”
- Best to register, then get “®”
- Search for prior use of mark on

[www.uspto.gov](http://www.uspto.gov)

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## Types of IP (Cont.)

### Copyrights:

- Statutory (17 U.S.C.), well defined
- Copyright is expression of idea but not the idea itself
- Can prevent others from making copies or derivative versions of (called “Derivative Works”), selling, performing or displaying a work of authorship

## Types of IP (Cont.)

### Copyright (Cont.):

- Copyright attaches upon tangible creation of work
- Need to register to bring lawsuit
- Form of copyright notice:
  - © (or “Copyright” or “Copr.”)
  - Year of first publication
  - Name of owner of copyright

[www.copyright.gov](http://www.copyright.gov)

## Types of IP (Cont.)

### Trade Secrets / Know-How:

- Non-statutory, Less well-defined
- By definition, gives competitive advantage to its owner
- Secrecy is necessary – may be lost through intentional or inadvertent disclosure
- Trade secrets and patent application – trade secret lost when patent application is published

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## Types of IP (Cont.)

### Patent vs Trade Secret vs Trademark vs Copyright

Assume: Test-Rite™ Socket Tester

- Trademark: Test-Rite™
- Trade Secret: Socket testing process (assume confidential)
- Patent: Apply for patent on socket testing process
- Copyright: Software, manuals

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### What Can We Do With IP?

- Implement it in products / services (subject to the rights of others)
- Sell it, License it (For \$\$ or License Back or other value)
- Use it to stop others from doing something (e.g., selling a competing product, a knock-off, etc.)
- Use defensively

### What Can We Do With IP? (Cont.)

- Use it to gain mindshare
- All of the above

### Protecting the Invention Pre-Patent

- Applies to trade secrets / know-how as well
- Control access to the invention to those who have a need to know
- Disclose to third parties only when necessary

### Protecting the Invention Pre-Patent (Cont.)

Use a confidentiality agreement that is commensurate in scope with the invention:

- number of years of confidentiality
- who can see it and use it
- what can the other party do with it
- no reverse engineering

SEE SAMPLE IN  
APPENDIX

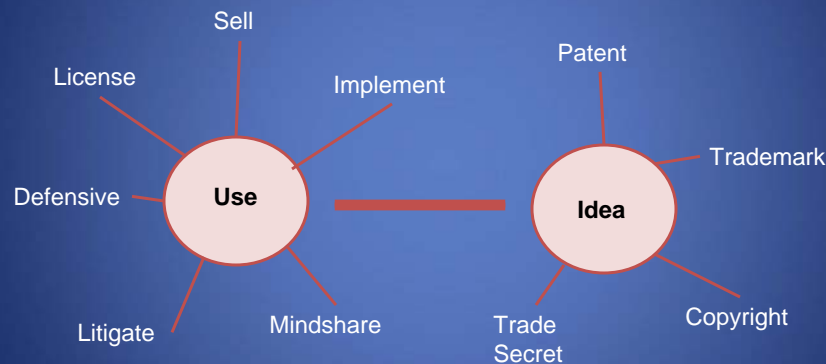
## Why Do Patents Exist?

Authorized by the US Constitution (Article 1, Section 8). But why????

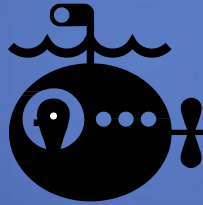
Consider the problem of technical progress:

- Why should I work hard to develop a product if someone is going to come along and copy it as soon as I introduce it into the market place?
- We need something to protect the inventor so they will remain motivated to invent and commercialize.

## The IP Sandbox



## Patents Deep Dive



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## History of Patents

Patents Authorized by U.S. Constitution  
(Article I, Section 8:)

“Congress shall have power to promote  
the progress of science and useful arts  
by securing for limited times to authors  
and inventors the exclusive right to their  
respective writings and discoveries.”

First Patent Act 1790

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## History of Patents (Cont.)

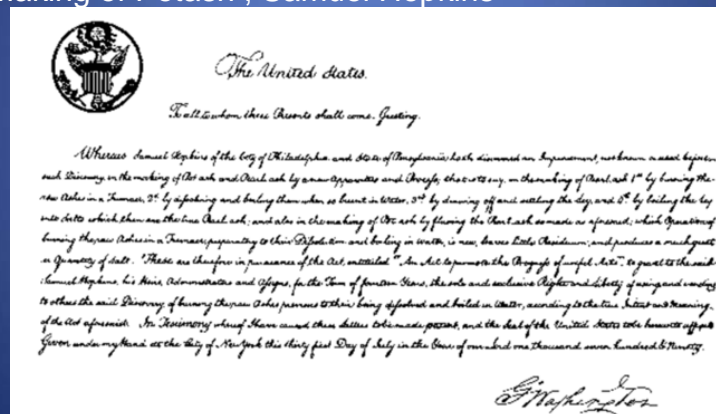
In 1793, repealed 1790 Act and defined what is patentable subject matter:

“Any new and useful art, machine, manufacture or composition of matter and any new and useful improvement on any art, machine, manufacture or composition of matter.”

This definition of patentable subject matter is little changed to this day.

## History of Patents (Cont.)

First Patent July 31, 1790  
Making of Potash, Samuel Hopkins



### Patents Today

- The invention must be for a process, machine, manufacture or composition of matter or improvement thereof
- Must be something that is tangible / physical
- Earliest Patent Act required model to discourage patenting of ideas
- If the invention must be something that is tangible or physical, how can software and business methods be patented?

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### Patent Requirements

The invention must be:

- new
- useful
- non-obvious to one of ordinary skill in the art
- disclosed in a manner sufficient to enable one of ordinary skill to practice the invention without undue experimentation (i.e., if one needs to make another invention to practice your invention, then no invention.)

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## Patent Requirements (Cont.)– Novelty (New)

What's the reference point?

- The effective filing date of your patent application; sometimes the date of conception of your invention
- anything before the reference point is called "Prior Art"

## Patent Requirements (Cont.)– Novelty (New) (Cont.)

The invention is novel if it meets all of the following:

- it is not known or used by others before your date of conception
- it has not been previously patented or described in a printed publication more than one year before your filing date
- it has not been offered for sale more than one year prior to your filing date



### **Patent Requirements (Cont.)– Utility (Useful)**

- The invention must have at least one use that is not against public policy
- If the invention is not operable, it is per se not useful
  - Anything that defies the laws of nature is considered to be not operable (e.g., perpetual motion machine)
- Just figuring out how or why something works isn't enough (e.g., scientific insight)

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### **Patent Requirements (Cont.) – Non-Obviousness**

- The differences between your invention and the Prior Art must be such that the invention would not be considered obvious to a person of ordinary skill in the art at the time you filed your patent application
- Obviousness is often (usually) a judgment call

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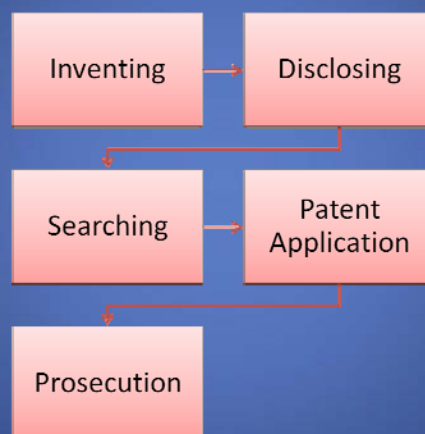
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## Patent Requirements (Cont.) – Non-Obviousness (Cont.)

- Multiple pieces of prior art can be combined
- No limit on how far back Examiner can go to find Prior Art
- Obviousness issues can often be overcome by pointing to an unexpected result of your invention.

## Patenting Process



### The Inventing Process – Why Do It?

- Personally rewarding to obtain a patent
- Opportunity to take an entrepreneurial risk!
- Technical vitality
  - Collaborate with others to create new ideas
  - Process forces inventors to look outside of your company

### The Inventing Process – Why Do It? (Cont.)

- Professional growth
  - Increase breadth of knowledge
  - Develop Problem Solving Skills
  - Recognition by peers and industry
- May be Critical to Your Company's Business

## **Inventing Process – What am I looking for?**

- Solutions to problems
- New uses for existing stuff
- Workarounds that avoid someone else's patent
- New functionality – but not merely new benefits of old stuff

## **Inventing Process – How do I do it?**

- No magic answer – whatever works for you!!
- Do research, observe problems, propose ideas
- You can invent by yourself or use a team approach to provide more energy and a broader skill set to develop more refined ideas
- If you are inventing in an area outside your normal expertise, you may need to do more research – or better still find and team with an expert in the field

## Disclosing Process

### Suggested Content of your invention disclosure:

- Name the Inventors - those who made an inventive contribution
- Body of the Disclosure
  - What are the benefits of the invention
  - How do you propose to achieve the benefits
  - Start from your specific idea and see if you can broaden or generalize it

## Disclosing Process (Cont.)

### Additional considerations for invention disclosure:

- Any commercial activity relating to the invention
- Relevant Prior Art
- Related Inventions
- Has invention been disclosed to others outside of your company

POSSIBLE PATENT BARS!!



## Disclosing Process (Cont.)

### Duty of disclosure:

Under US Law, the inventors and persons involved in the patent application preparation / examination have a duty to disclose any prior art they are aware of that may be material to the examination of the patent application

## Disclosing Process (Cont.)

### Inventorship:

Under US Law, the patent must name the actual inventors of the invention as defined by the claims. That is:

- no extra people (misjoinder)
- no people left off (nonjoinder)

### Disclosing Process (Cont.)

#### Inventorship (Cont.):

An Inventor:

- Is a person who contributes to the conception of the claimed invention
- Must be able to identify the claims or portions thereof to which he/she contributed

An Inventor is not:

- Any person who did not make an inventive contribution to the claims.

### Disclosing Process (Cont.)

#### Inventorship (Cont.):

In other words, an Inventor is **NOT** (unless they made an inventive contribution):

- A person who suggested the problem
- A person who tests or verifies that the invention works
- A person who merely understands the theory of why or how the invention works
- An expert who agrees that the invention is based on sound theory
- A person who manages or supervises an inventor
- Your office mate (or cube neighbor)
- Your significant other
- Your coworker



## Disclosing Process (Cont.)

### Patent Application Declaration

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.			
NAME OF SOLE OR FIRST INVENTOR:		<input type="checkbox"/> A petition has been filed for this unsigned inventor	
Given Name (first and middle (if any))		Family Name or Surname	
Inventor's Signature			Date
Residence: City	State	Country	Citizenship
Mailing Address			
City	State	Zip	Country
<input type="checkbox"/> Additional inventors or a legal representative are being named on the supplemental sheet(s) PTO/SB002A or OQLR attached hereto.			

(Page 2 of 2)

## Disclosing Process (Cont.)

### Inventorship (Cont.):

#### 18 U.S.C. 1001

When you sign the papers for your patent application you are saying that the inventor listing is correct to the best of your knowledge and that you will comply with the duty to disclose prior art

Penalty of fine and/or imprisonment for false statements

### **Searching Process - The objective**

One objective of searching is to spend a limited amount of time to identify published documents ("prior art") which may:

- disclose the invention
- provide sufficient teaching (alone or with other prior art) to make the invention "obvious"
- limit the ability to broadly protect the invention

### **Searching Process - The objective (Cont.)**

Through such prior art, business / legal can:

- more accurately assess the true value of the invention as a patent
- provide guidance and stimulus to improve the invention

## Searching Process (Cont.) - Strategy

Identify search terms (keywords)

Analyze the invention and try to answer the following questions:

- What is the problem(s) addressed (solved) by the invention?
- What is the action (solution) proposed by the invention to address the problem?
- What Is the field or context of the invention?

Think about what you want to search for

## Searching Process (Cont.) – modifying the search

What if I find too many documents?

- Try combining more search terms
- Try segment searching (e.g. looking for term in only a section of the document)
- Try proximity searching (e.g. requiring that the search terms be within a certain distance from each other in the document)

## Searching Process (Cont.) – modifying the search (Cont.)

What if I find too few documents?

- Try using fewer terms
- Try finding alternative words for the terms being used
- Try using truncated search terms
- Try searching the database in full text mode

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## Searching Process (Cont.)– Performing the search

Where to search?

[www.uspto.gov](http://www.uspto.gov) (US Patent Office)

[www.espacenet.com](http://www.espacenet.com) (European Patent Office)

[www.google.com/patents](http://www.google.com/patents) (Google patents)

[www.patentfetcher.com](http://www.patentfetcher.com) (retrieving patents)

**NOTE:** If the database you are using is "full text", the search engine will look for the search terms in the entire text of the document. If the database does not use "full text" searching, then you will probably retrieve fewer documents.

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## Searching Process (Cont.) – Search Example

Assume you want to search for a circuit board having extra non-functional vias

Start at [www.uspto.gov](http://www.uspto.gov) with the search query:

Spec/package and (dummy and via)

What do you get?

## Searching Process (Cont.) – Search Example (Cont.)

Narrowing the search:

Spec/(pcb or pwb) and (dummy and via)

Are you happy with results?

Spec/(pcb or pwb) and “dummy via”

Are you happy with the results?

### Searching Process- Search Example (Cont.)

Broadening the search:

Spec/(pcb or pwb or package) and “dummy via”

Are you happy with the results?

### Searching Process (Cont.) – Analyzing Results

Is the document relevant? That is:

- Does the document propose or disclose the same solution, objective and means of accomplishing the objective as the invention?
- Does the document disclose one or more of the features of the invention?
- Does the document (alone or in combination with other documents) suggest the invention?
- Does the document disclose the problem solved by the invention? (a good background reference)

## Types of Patent Applications

**Utility Patent Application** – any new and useful process, machine, article, manufacture or composition of matter, or any new and useful improvement thereof.

**Divisional Patent Application** – a utility patent application is determined to have 2 or more “inventions” and is divided; 2<sup>nd</sup> application is the divisional patent application.

**Continuation in Part Application (CIP)** – “new matter” is added to the invention and a new utility patent application is filed.

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## Types of Patent Applications (Cont.)

**Continuation Patent Application** – a 2<sup>nd</sup> utility patent application on the same invention is filed.

**Request for Continued Examination (RCE)**  
-not a new application

**Provisional Patent Application** – reserves filing date but is not examined; must be followed within 1 year with a nonprovisional patent application.

Can mix and match; for example, a Continuation of a Divisional Patent Application

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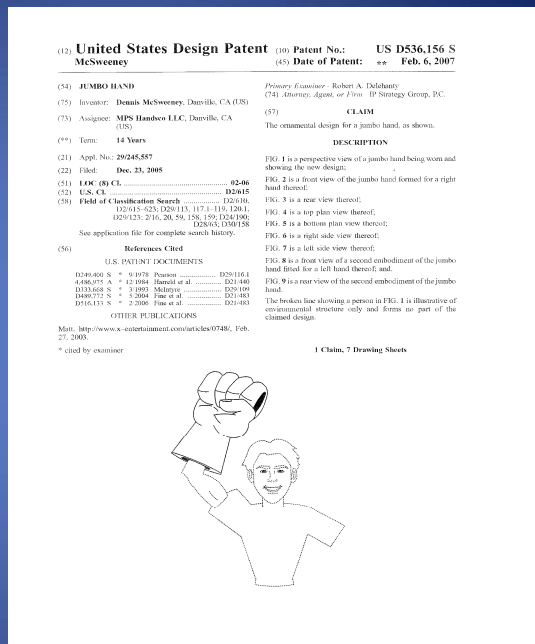
## Types of Patent Applications (Cont.)

## Others:

**Design Patent Application** – a new, original and ornamental design for an article of manufacture

Utility Model Patent Application - narrow in scope; not in US

# Design Patent



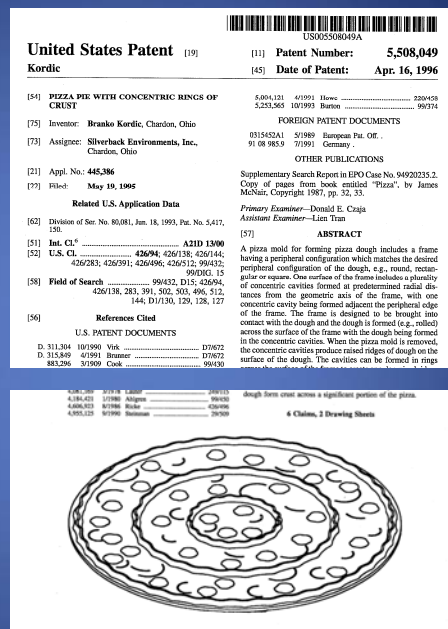


## What's in a (utility) patent application?

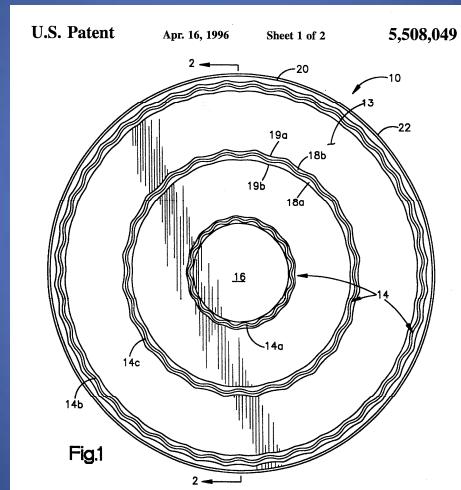
Title  
Inventors  
Drawings  
Specification  
    Background  
    Summary  
    Detailed Description  
Claims  
Abstract

## What's In a Patent Application

Front page



## Patent Application - Drawings

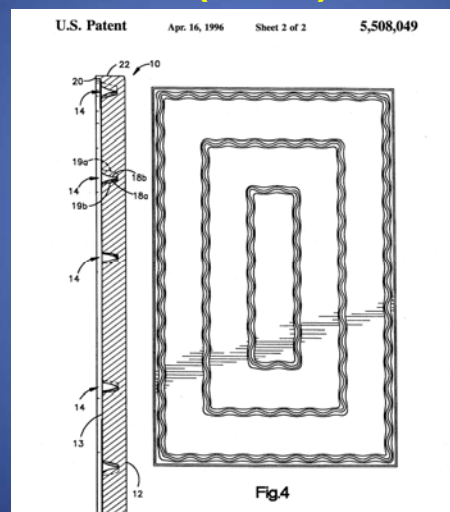


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## Patent Application – Drawings (Cont.)



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## Patent Application - Specification

### Background

- Persuade the reader regarding the patentability of the invention by describing the problem solved and/or value associated with the benefits of the invention

### Summary of the Invention

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## Patent Application – Specification (Cont.)

**1**  
**PIZZA PIE WITH CONCENTRIC RINGS OF CRUST**

This is a divisional of application Ser. No. 08,080,081 filed on Jun. 18, 1993, now U.S. Pat. No. 5,417,150.

**FIELD OF THE INVENTION**

The present invention relates generally to dough forming device and more particularly to a pizza mold for forming a plurality of concentric raised ridges of dough (i.e., crust) on the surface of a pizza pie.

**BACKGROUND**

Pizza making has become a successful industry serving countless individuals. Pizza pies typically have an annular (round) configuration, although square and rectangular-shaped pizzas are also known and have had some recent acceptance in the consumer market. Toppings such as cheese, meat, and/or vegetables are distributed across the surface of the pizza pie within the area bounded by the crust, and the pie is baked in an oven for a short period of time. After the cooked pizza is removed from the oven, the pizza is sliced into, e.g., wedges or squares.

While automation in the industry has brought rapid and efficient means for mixing, kneading and cooking the pizza dough into a finished pizza pie, it is applicant's belief that there has been little innovation in the configuration of the pizza pie itself (besides the above-mentioned square or rectangular peripheral configurations). In applicant's experience, the pizza pie includes a substantially flat central surface area with a raised crust around only the outer peripheral edge of the pie. When the pizza is sliced, only a small segment of crust accompanies each slice of pizza. Moreover, if the pizza is sliced into squares, it is possible that the inner squares of the pie will fail to have any crust on them whatsoever.

Applicant believes that there is a consumer demand for a pizza pie which has crust formed at locations other than just around the outer peripheral edge of the pie, such that almost any slice of pizza (be it wedge-shaped or square-shaped) will preferably have multiple segments of crust accompanying it. Applicant believes that such a pizza pie has better texture, flavor, and aesthetic appeal.

Certain dough forming devices and techniques are already known in the art, some of which are applicable to pizza pies. For example, Sprentzel U.S. Pat. No. 3,166,027; Spinosa U.S. Pat. No. 3,194,185; Mahony U.S. Pat. No. 3,322,074; LaMonica U.S. Pat. No. 3,864,071; and Lauter U.S. Pat. No. 4,081,169, disclose molds and frames for forming dough into a flat, round configuration, such as typically found with pizza pies. Further, U.S. Pat. No. 883,296 and U.S. Pat. No. Des. 311,304 disclose molds for forming wedge-shaped slices in flattened, round dough. However, none of the prior devices and techniques address the problem of having only a single segment of crust (or no crust at all) on each slice of pizza.

**SUMMARY OF THE INVENTION**

The present invention provides a new and useful pizza mold for pizza dough which forms a plurality of concentric raised ridges in the dough. The mold is particularly useful for forming concentric ridges of crust on a pizza pie such that practically every slice of the pizza has multiple segments of crust to improve the texture, flavor and aesthetic appeal of the pie.

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## Patent Application – Specification (Cont.)

### Detailed Description/Description of Preferred Embodiments:

Provide adequate disclosure of the invention:

- enable one of ordinary skill to practice the invention without undue experimentation
- show possession of the claimed invention
- examples are not required but can be helpful for chemical or process patents

## Patent Application – Specification (Cont.)

### DETAILED DESCRIPTION OF THE PREFERRED EMBODIMENT

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Referring to the drawings, and initially to FIGS. 1 and 2, a pizza mold, indicated generally at **10**, is shown for forming raised ridges in pizza dough. It should be apparent to those skilled in the art upon reading the following description, however, that the principles of the present invention can also be applied to forming dough other than pizza dough, for example, bread or cake dough. Such alternative uses are therefore within the scope of the present invention. As such, the terms “pizza mold” and “pizza dough” are not intended to be limiting the present invention to only forming pizza pies. Rather, the principles of the present invention are applicable to any type of dough which can be formed using the following described techniques.

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The pizza mold **10** comprises a frame **12** having a predetermined peripheral configuration. In FIGS. 1 and 2, the frame **12** has a disc-shaped annular configuration; how-

### Patent Application - Claims

The claims define what physical thing or process you are asking for the right to exclude others from doing:

- The claim must have some physical aspect (not just mental steps)
- It is a physical description of something that can usually be considered as one or more physical features (sometimes called elements or limitations)
- not just an expression of a desired result – e.g.: all things that solve problem X --

### Patent Application – Claims (Cont.)

Independent vs. Dependent Claims:

- Independent claims stand on their own
- Dependent claims refer back to an independent claim
- Dependent claims have all the limitations of their parent claims + the recited limitations
- Often not the most important claim limitations

## Patent Application – Claims (Cont.)

5,508,049

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aspects are for a rectangular or square pizza mold are the same as discussed previously with respect to the round pizza mold. For example, for a rectangular or square frame, the dough cavities can be formed in rectangular or square configurations across the surface of the frame. Additionally, the frame can have a rectangular or square peripheral configuration, depending upon the desired peripheral configuration of the pizza.

As indicated above, the present invention provides a new and useful mold for forming dough products such as pizza dough. Although the invention has been described in its preferred form with a certain degree of particularity, it is understood that the present disclosure has been by way of example, and that numerous changes in the details of construction and the combination and arrangements of parts may be resorted to without departing from the spirit and scope of the invention as hereinafter claimed. It is intended that the patent shall cover, by suitable expression in the appended claims, whatever features of patentable novelty exist in the invention disclosed.

What is claimed is:

1. A pizza pie, comprising:

a substantially flat piece of cooked pizza dough having a predetermined peripheral configuration,

said piece of cooked pizza dough having a surface which includes a plurality of concentric raised ridges of crust formed at predetermined distances from a linear geometric axis which passes through a center of the pizza dough in a direction which is substantially perpendicular to the substantially flat piece of cooked pizza dough,

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with one of said concentric raised ridges of crust being adjacent a peripheral outer edge of the pizza pie.

2. The pizza pie as in claim 1, further including a topping located on the surface of the pizza pie between adjacent concentric raised ridges of crust.

3. The pizza pie as in claim 1, wherein said pizza dough has an annular peripheral configuration and said raised ridges of crust are formed in concentric annular configurations in the pizza dough at predetermined radial distances from the linear geometric axis of the dough.

4. The pizza pie as in claim 1, wherein said pizza dough has a square or rectangular configuration and said raised ridges of crust are formed in square or rectangular configurations in the pizza dough at predetermined distances from the linear geometric axis of the pizza dough.

5. A pizza pie, comprising:

a substantially flat piece of cooked pizza dough having a predetermined peripheral configuration,

said piece of cooked pizza dough having a surface which includes i) a first raised ridge of crust adjacent to and extending entirely around a peripheral outer edge of the pizza dough, and ii) at least one other raised ridge of crust formed at a predetermined distance inwardly from the peripheral edge of the pizza dough and extending along an extent of the surface of the pizza dough.

6. The pizza pie as in claim 5, wherein said at least one other raised ridge of crust extends across the surface of the pizza dough in a configuration which matches the peripheral configuration of the pizza dough.

\* \* \* \* \*

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## Patent Application – Claims (Cont.)

### U.S. Patent 5,508,049

(Preamble) (Transition)

1. A pizza pie, comprising:

(Elements)

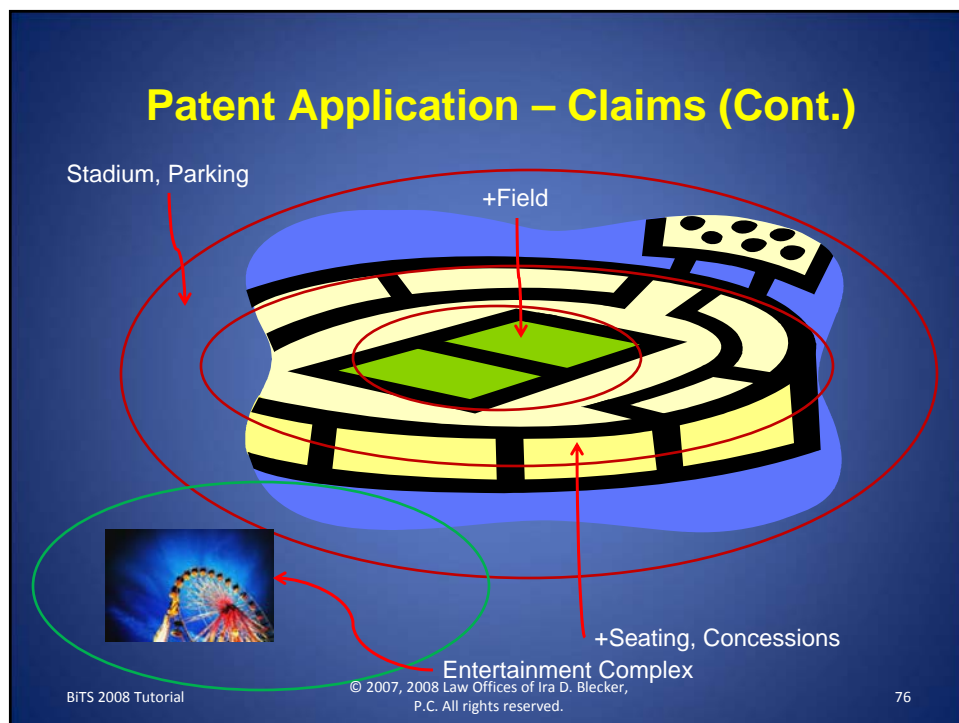
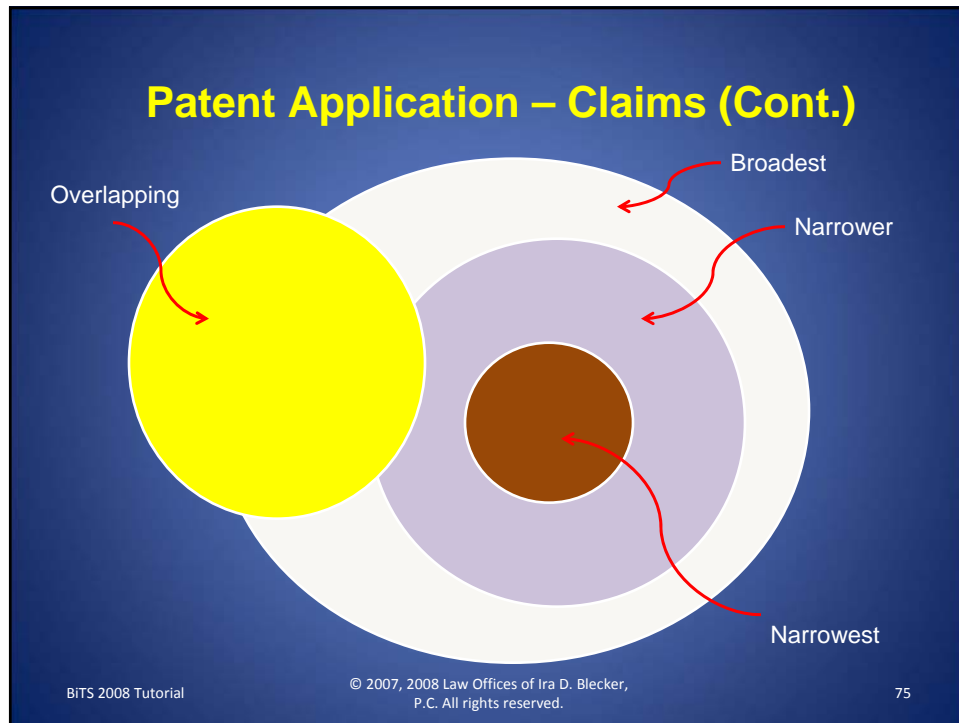
a substantially flat piece of cooked pizza dough having a predetermined peripheral configuration,

said piece of cooked pizza dough having a surface which includes a plurality of concentric raised ridges of crust formed at predetermined distances from a linear geometric axis which passes through a center of the pizza dough in a direction which is substantially perpendicular to the substantially flat piece of cooked pizza dough, with one of said concentric raised ridges of crust being adjacent a peripheral outer edge of the pizza pie.

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### Prosecuting a Patent Application

Use a competent patent attorney or agent

OR

Prosecute patent application yourself (Pro Se) – become familiar with:

- United States Code (USC)
- Code of Federal Regulations (CFR)
- Manual of Patent Examining Procedure (MPEP)

Consult [www.uspto.gov](http://www.uspto.gov)

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### Prosecuting a Patent Application (Cont.)

What is a competent patent attorney or agent?

A patent attorney or agent who:

- Is licensed to practice before the USPTO
- Has desired experience level
- Has expertise in your technology
- You feel comfortable with

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## Prosecuting a Patent Application (Cont.)

File patent application with USPTO

All necessary forms (transmittal sheet, fee sheet, declaration and power of attorney, Information Disclosure Statement (IDS)) on [www.uspto.gov](http://www.uspto.gov).

Pay filing, search and examination fees of about \$500.00 for a small entity.

Then wait.....

Then wait some more.....

## Prosecuting a Patent Application (Cont.)

In USPTO:

Formalities are checked such as fees, signatures, declarations

Patent application classified and assigned to appropriate technology center.

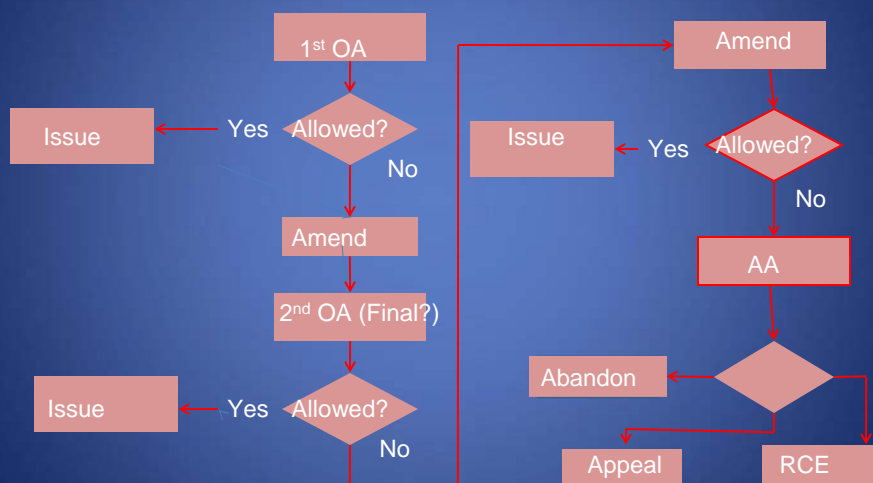
## Prosecuting a Patent Application (Cont.)

In USPTO (Cont.):  
Examiner will either:

- Issue a “Restriction Requirement” indicating that 2 or more “inventions” are claimed  
OR
- Search the Prior Art and issue an office action on the merits

Applicant **MUST** respond in a timely manner to the restriction requirement (if any) and office action or patent application goes abandoned.

## Prosecuting a Patent Application (Cont.)



## Patent Infringement / Validity / Licensing

### Patent Claim Interpretation - What do the claims cover?

Some terms (e.g., Preambles) have judicially-determined meaning

- "consisting of" = no elements beyond what is recited
- "consisting essentially of" = additional elements allowed but no material alteration of claimed article/process
- "comprising" (also "containing", "including", "having") = can have anything else as long as not contradictory

Answer can depend on the specification & what went on during examination

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## Infringement

### How does the activity or product in question compare to the patent claim?

If the activity/product meets all the limitations of the claim, then the claim/patent is literally infringed.

### What if there is no literal infringement?

If there is no literal infringement, but the differences appear "insubstantial", the Doctrine of Equivalents may be invoked to find infringement as a matter of fairness to the patent owner

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## Validity

Are the claims in the patent valid and enforceable?

If you are considering your activity relative to others' patents, it is almost always a lower legal risk position to be able to say that you do not infringe as opposed to saying that the patent is invalid.

Possible grounds for invalidity are generally the same as the bases for examination (adequate disclosure, utility, novelty, obviousness)

## Validity (Cont.)

Are claims unenforceable for other reasons?

- Inequitable conduct – e.g. knowingly concealing prior art; knowingly presenting false data
- Improper inventorship or ownership – someone else invented; inventors did not have the right to assign to the patent owner; patent owner gave up rights to someone else
- Expired patent – expired patents are not enforceable

### Licensing

A license is a grant of a right to someone else.

- You can't grant the right if you don't own the right in the first place
- Exclusive licenses generally give all the rights of the licensor to the licensee
- Non-exclusive licenses generally don't prohibit the licensor from granting licenses to others
- It is important to be sure of the basis for paying any royalties due under the license.

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### Licensing (Cont.)

#### Licensing value

- Look at the BENEFITS associated with the claimed article, composition or apparatus or with practicing the claimed method
- RELATIVE VALUE amongst patents is important
- In general, someone will want to license your patent if practicing it gives them a NET BENEFIT that is better than the alternatives available

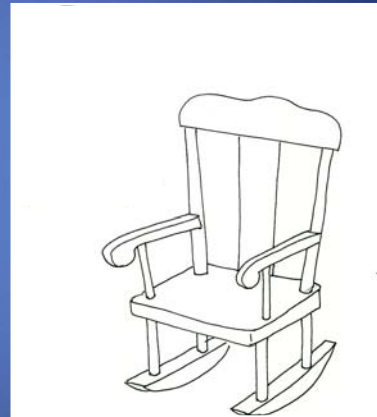
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### Infringement Example

A rocking chair comprising:  
a platform;  
four legs fastened to the platform so as to support and elevate the platform;  
a back fastened to the platform;  
two arms fastened to the platform; and  
rocking means fastened to the legs.



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### Infringement Example

A stool comprising:  
a platform; and  
three or more legs  
fastened to the platform  
so as to support and  
elevate the platform.



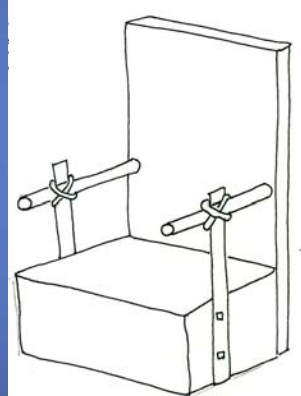
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### Infringement Example

A bench comprising:  
a platform; and  
a back fastened to the  
platform; and  
two arms fastened to  
the platform.



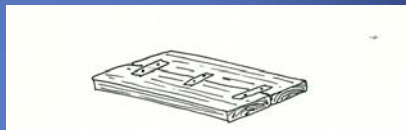
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### Infringement Example

A seat comprising:  
a platform.



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### Infringement Example

- Making, Using, or Selling the rocking chair would infringe which of the patents?
  - Stool?
  - Bench?
  - Seat?
- Which invention is the most detailed?
- Which patent is the most valuable?

### International Patenting

- Paris Convention
- European Patent Convention
- Patent Cooperation Treaty (PCT)



## International Patenting (Cont.)

### Paris Convention (Paris Convention for the Protection of Industrial Property):

- Adhered to by 168 countries
- Each country guarantees to the citizens of the other countries the same rights that it gives to its own citizens
- Provides for right of priority
- Subsequent applications must be filed within 12 months of priority application

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## International Patenting (Cont.)

### European Patent Convention:

- Implemented by European Patent Office (EPO)
- Uniform application procedure for seeking patent protection in 38 European countries
- Substantive search and examination by EPO – result is European patent (actually a bundle of National patents)
- Validation (and possibly translation) in member states – result is valid National patent in each member state

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### International Patenting (Cont.)

#### Patent Cooperation Treaty (PCT):

- Adhered to by over 124 countries
- Provides for centralized filing procedures and a standardized application format
- Provides for an international filing date and search by receiving office
- National application must be filed no later than 30 months (usually) from international filing date

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### International Patent Enforcement

- Patents are territorial
- Patents have to be enforced country by country (with some limited exceptions)
- Infringing goods
- Counterfeit goods

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### Counterfeit Goods

- Costs the US economy approximately \$250 Billion per year
- Mainland China produces 80+% of counterfeit goods
- Hong Kong produces 5% of counterfeit goods
- India, Indonesia are other major producers of counterfeit goods
- Examples: Lipitor, Apple Nano, Airplane parts, Computer software, Designer goods

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### Counterfeit Goods



Shenzhen, China

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## Counterfeit Goods



Counterfeit Mall  
Shenzhen, China

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## Enforcement Strategies

- Political
- Business
- Legal

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### Enforcement Strategies (Cont.)

#### Political:

- Congressional Pressure
- US Delegation visits (e.g., USPTO)
- World Intellectual Property Organization (WIPO)
- World Trade Organization (WTO)
- US Trade Representative
- International Trade Commission

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### Enforcement Strategies (Cont.)

#### Business: Supply Chain Best Practices

- Secure Legitimate Inputs
- Verify Legitimacy of Customers and Distributors
- Manage Production Waste and Damaged Inventory
- Ensure Legitimacy of Purchased Products at Retail Level
- Monitor Brand Integrity
- Outreach to Law Enforcement and Regulatory Officials

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## **Enforcement Strategies (Cont.)**

### **Legal:**

- Sue infringer in country where patent has been granted
- Border measures (e.g., US Customs enforcement)
- ITC Section 337 Proceeding – proceeding before the International Trade Commission; decision 12-18 months after filing

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## **Enforcement Strategies (Cont.)**

### **Patent Enforcement in China:**

- Enforcement is weak (but getting better) due to lack of coordination and local protectionism
- Penalties usually are non-deterrent
- Damage awards are low (usually) and difficult to collect
- Hijacking of patents is common

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## Enforcement Strategies (Cont.)

### Useful Websites:

- [www.stopfakes.gov](http://www.stopfakes.gov) (US Strategy Targeting Organized Piracy)
- [www.thetruecosts.org](http://www.thetruecosts.org) (US Chamber of Commerce)
- [www.uspto.gov](http://www.uspto.gov) (US Patent and Trademark Office)
- [www.wipo.org](http://www.wipo.org) (World Intellectual Property Organization)

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## Court and USPTO Activities

### Courts:

- KSR v Teleflex – latest word on obviousness
- McKesson Information Solutions v Bridge Medical – disclosure of prior art in related applications

### USPTO:

- Peer-to-Peer Patent Application Review

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### Court and USPTO Activities (Cont.)

#### Courts:

KSR v Teleflex – latest word on obviousness

Possibly most significant case in last 50 years  
– or not

Rates of patentability (around 60% prior to and after KSR) essentially the same

Teaching, suggestion or motivation not exclusive test

Look to predictability of results

### Court and USPTO Activities (Cont.)

#### Courts:

McKesson Information Solutions v Bridge Medical – disclosure of prior art in related applications

- Need to apprise Examiner of existence of related cases AND course of prosecution of related cases, including reminding Examiner of action that Examiner took in related case

- Pendulum swing towards inequitable conduct.



### Court and USPTO Activities (Cont.)

#### USPTO:

##### Peer-to-Peer Patent Application Review:

- A pilot program run by USPTO and New York Law School
- Limited to computer architecture, software and information security
- Members of public participate by contributing relevant prior art
- See [www.peertopatent.org](http://www.peertopatent.org)

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**Patents, Technology Licensing and Outsourcing  
of Legal Services**

## APPENDIX

## SAMPLE CDA

### CONFIDENTIAL DISCLOSURE AGREEMENT

1. Effective (Date) , (Your Name and Address), hereinafter referred to as (DISCLOSER), desires to disclose to (Company Name and Address) (RECIPIENT), certain confidential information which RECIPIENT acknowledges to be of a confidential character, such information relating to products developed by the DISCLOSER ("Confidential Information").
2. The Confidential Information under Agreement is described as: (Description Of Software, Product, Technology or Name)
3. RECIPIENT shall use the Confidential Information only for the purpose of evaluation.
4. This agreement controls only Confidential Information which is disclosed for a period of one (1) year from the date of the agreement.
5. RECIPIENT's duty to protect information under this Agreement expires three (3) years from the receipt of the Confidential Information .
6. RECIPIENT shall protect the disclosed Confidential Information by using the same degree of care, but no less than a reasonable degree of care, to prevent the unauthorized use, dissemination or publication of the confidential information as the RECIPIENT uses to protect its own Confidential Information of a like nature.



### **SAMPLE CDA (CONT.)**

7. RECIPIENT shall have a duty to protect only that Confidential Information which is (a) disclosed by DISCLOSER in writing and is marked as confidential at the time of disclosure, or which is (b) disclosed by DISCLOSER in any other manner, is identified as confidential at the time of disclosure and is also summarized and designated as confidential in a written memorandum delivered to the RECIPIENT's representative named in paragraph 1 above within thirty days of the disclosure.
8. This Agreement imposes no obligation upon RECIPIENT with respect to confidential information which (a) was in the RECIPIENT's possession before the receipt from DISCLOSER; (b) is or becomes a matter of public knowledge through no fault of the RECIPIENT; (c) is rightfully received by the RECIPIENT from a third party without a duty of confidentiality; (d) is disclosed by DISCLOSER to a third party without a duty of confidentiality on the third party; or (e) is independently developed by the RECIPIENT.
9. DISCLOSER warrants that it has the right to make the disclosure of information contemplated by this Agreement.
10. RECIPIENT does not acquire any intellectual property rights under this Agreement except the limited right to the use set out in paragraph 3 above.
11. Neither party has an obligation under this Agreement to purchase any service or item from the other party.

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### **SAMPLE CDA (CONT.)**

12. Neither party has an obligation under this Agreement to offer for sale products using or incorporating the Confidential Information.
13. NO LIABILITY FOR CONSEQUENTIAL DAMAGES. To the maximum extent permitted by applicable law, in no event shall DISCLOSER be liable for any damages whatsoever (including without limitation, damages for loss of business profits, business interruption, loss of business information, or any other pecuniary loss) arising out of the use of or inability to use DISCLOSER's product, even if DISCLOSER has been advised of the possibility of such damages.
14. The parties do not intend that any agency or partnership relationship be created between them by this Agreement.
15. All additions or modifications to this Agreement must be made in writing and must be signed by both parties.
16. This Agreement is made under and shall be construed according to the laws of the State of (Your State) without regard to the conflicts of law.
- DISCLOSER Signature \_\_\_\_\_ RECIPIENT Signature \_\_\_\_\_

Name _____	Name _____
Title _____	Title _____
Date _____	Date _____

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## Compendium of Web Sites

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[www.espacenet.gov](http://www.espacenet.gov)  
[www.google.com/patents](http://www.google.com/patents)  
[www.patentfetcher.com](http://www.patentfetcher.com)  
[www.stopfakes.gov](http://www.stopfakes.gov)  
[www.thetruecosts.org](http://www.thetruecosts.org)  
[www.wipo.org](http://www.wipo.org)  
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