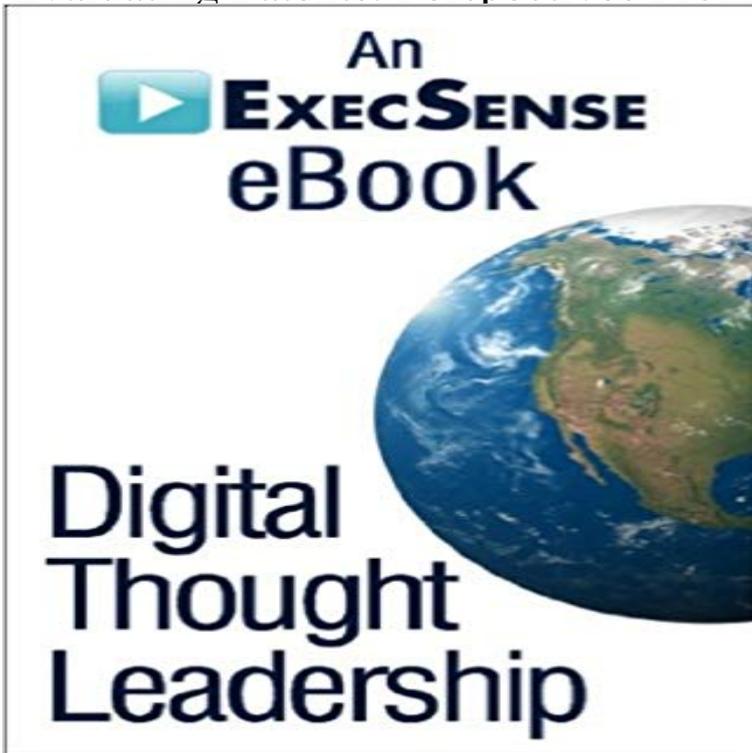


## Evaluating Patents: Perspectives From The Trenches Of Litigation



Authored by Ben Hattenbach, Partner at Irell & Manella LLP, Engineers, business people and lawyers often find themselves evaluating patents to determine whether they would be worth buying or selling, worth using in negotiations, or worth asserting in litigation. All too often during these exercises one can be seduced by the breadth of a patents claims, the ingenuity of its approach to solving a technical problem, or anticipated growth in the area of technology to which the patent is directed. While such considerations are certainly important components of an overall valuation, anyone assessing a patents genuine value must first and foremost examine how the patent would perform in litigation. Much of a patents real economic value, irrespective of whether the patent is being used purely as a defensive tool, in licensing discussions, or as an offensive weapon, ultimately depends on how the patent is expected to perform in court. In court, a judge decides what the patents claims mean, and a jury of laypeople will typically decide whether those claims are valid and infringed. Patents that are most likely to receive favorable treatment from judges and jurors tend to share a set of common characteristics. In particular: A patents claims should be varied in type, scope, and terminology. Well-designed claims should also map onto detectable, domestic activity likely to be carried out by a single actor. For purposes of maximizing damages, claims to systems and end products are particularly beneficial. Although claims establish the boundaries of the patent owners right to exclude, a broad patent specification filled with varied examples of how ones invention may be implemented is often no less important in determining a patents value. A patents specification should disclose multiple embodiments of the invention, including alternative aspects and implementations for as many elements as

feasible. Patent specifications should never use terms such as the invention in anything but the most expansive context. Specifications should similarly avoid indicating that anything is important or essential to the invention, such as by stating that particular elements are necessary or must be included when practicing even an illustrative implementation of the invention. Carefully worded prosecution histories are also of utmost importance to a patents chances of success in litigation. Patent holders will not be permitted to obtain a patent by taking a position before the Patent Office, but then seek a finding of infringement or defend against a validity challenge by asserting the opposite in court. Specifications containing extensive discussions of prior art are generally undesirable in litigation, as they often inadvertently give rise to narrowing constructions or safe-harbors for non-infringement. When evaluating patents, it is prudent to focus on these and other attributes central to predicting how the assets will perform in the crucible of litigation.

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