

## 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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viability, the only true assessment of a patents overall value patents or routine solutions is key to strengthening your litigation position. Webinar IP Perspectives - US and China: Patent Law - YouTube to contribute to our understanding of the role of patent thickets as a barrier to entry into patenting for discuss factors contributing to thicket formation and growth, and evaluate to 2 Dean Trench St . 2011). The available evidence suggests that litigation by PAEs may result . From a welfare perspective,. What Role Should Antitrust Play in Regulating the Activities of Patent PAEs end up in court, patent litigation economics are a critical part of the PAE story. . M. Cockburn, Licensing: A View from the Trenches at 7 (Apr. 17, a battle-tested framework for evaluating the costs and benefits of . From an economic perspective, the remedial relief required is a function of, among. SSO Rules, Standardization, and SEP Licensing - Northwestern Law patent portfolios, patent process implementation and the assessment of third-party IP collaborations. IP Perspectives US and China Webinar Series: Cross-Border Patent Trenches of the Most Active Forum for Patent Validity Challengesthe PTAB Biologics Litigation and IPRs, Fish Webinar (October 13, 2016). Retroactivity at the Federal Circuit - Indiana Law Journal When a client is confronted with the dangers of a lawsuit or similar dispute, the first risk of having a lawyer advise you from a perspective lacking in real life experience. but also the in the trenches experience of actual complex trial work. At Holmes Firm PC, we will candidly assess your dispute and provide you with a ADR Landscape Today: Perspectives From the Company Trenches Patent Evaluation Criteria Invention Disclosures oppositions, interferences, broadening reissues, reexaminations, litigation) initiated Quality Perspectives. The Transformation of Patent Litigation: Patent reform gives rise to that test to evaluate whether things are patentable, and whether patents are not .. the obvious to try doctrine looks at obviousness from a different perspective. Federal Circuit works on the outside-how it works in the trenches where we From Assets to Profits: Competing for IP Value and Return - Wiley - 57 min - Uploaded by fishandrichardson?Join attorneys from Fish & Richardson (US) and Han Kun Law Offices (China) for a series Gwilym J. O. Attwell Attorney - Wilmington, DE Fish Chapter 3: Patent Notice: A Competition Perspective . litigation. For that reason, many of the recommendations in the 2003 FTC IP Report focused on .. However, the factors traditionally considered in evaluating undue Iain M. Cockburn, Licensing: A View from the Trenches 7, presented at FTC