

Not All Patent Lawyers Are Created Equal

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A poorly drafted patent can have disastrous results. It can serve to give away your most valuable secrets, cost millions in a doomed defense of it and even open the patent holder up to liability.

Patents are deceptively complex legal instruments requiring great skill, practice and training to draft well. Likewise, guiding the patent application through the examination process in the U.S. Patent and Trademark Office -- what we call "prosecuting the application" -- is a very complicated procedure that also requires great skill and training to do well.

Because of the intricacies, idiosyncrasies and often counter-intuitive nature of patent law, neither a layperson nor even an inexperienced patent lawyer can evaluate whether a patent application has been well-drafted or poorly-drafted or whether it has been well-prosecuted or poorly prosecuted.

Whether a patent application is well-drafted depends on knowledge of many arcane and complex interrelated patent laws and rules. It also requires a familiarity and acquired facility with techniques of patent drafting, and an appreciation of the technology involved and the state of the known technology.

Drafting and prosecuting a patent application is an art that is learned by way of a true apprenticeship that requires years of intensive tutelage under the guidance of an experienced and well-trained patent practitioner. As with a world-renowned artist or musician, a patent attorney is often known by the master under whose tutelage he or she apprenticed as a young attorney. It is an arduous course of drafting, re-drafting, re-editing, and so on until, over the course of years, truly expert skill is acquired.

In addition, patent drafting requires a precision of language that often goes unnoticed in normal life. For example the author of an "expert" column in a national magazine recently responded to the question, "How do noise-cancellation headphones work?" Her answer began, "First, insulation blocks as much noise as possible . . ." This, of course, is not true. Insulation obviously does not block as much noise **as possible**. Although unimportant in daily

conversation, a mistake like this in a patent may have dire consequences.

A patent attorney must be alert to the subtleties of language, such as the difference between an object that is "above" another versus one that is "over" another and the vagaries of words such as "between." For example, we refer casually to a baseball shortstop as "between" second and third base, but unless he is standing in the baseline, he might not be technically "between" them. Such a casual use of the word "between" in a patent could prove disastrous.

Other aspects of language are concepts peculiar to patent law. For example, ordinarily a patent claims something (an invention) that comprises various components. Under patent law, if you claim something that "comprises" the components, the patent will cover things that include those components plus any number of additional components. If you claim a chair that "comprises" a seat and four legs, a four-legged chair that also has a back would infringe the claim. By contrast, if you claim something that "consists of" the components, the claim covers only those things that have the named components and nothing else. A four-legged chair with a back might NOT infringe a claim to a chair that "consists of" a seat and four legs. A seemingly innocuous difference -- "comprising" versus "consisting of" -- may yield drastically different results.

Generally, one of the first skills that must be learned through training and experience is how to claim an invention; that is, how to define the invention. This is necessary to obtain a broad scope of protection that will withstand potential litigation when several patent attorneys will spend thousands of hours second-guessing every word the patent drafter used.

Did a claim to a cookie call for it to have chocolate chips? What if your competitor used butterscotch chips instead? What if someone finds an old cookie recipe that used semi-sweet chocolate chips, but you used milk chocolate chips? In that case, the early use of semi-sweet chips might invalidate a claim calling for chocolate chips, but not one calling for milk chocolate chips.

Technology-related issues also often arise in patent applications and should not be ignored. Yet sometimes this occurs when a new or untrained patent attorney fails to

appreciate the potential implications of the choice of technical language in the patent application. Other times the technological issue may require the attorney to be familiar with the technology involved in the invention, which is why patent attorneys are required to have a technical background.

Still other times, a patent attorney may fail to appreciate that many commonly used terms, such as “soluble” or “dry,” lack precise definitions. For example, is the soluble substance soluble in water or oil? Many substances commonly thought of as “insoluble” are actually soluble to a very limited extent. Does that make them soluble? What if the solubility depends on other conditions, such as temperature?

What about a “dry” powder? Typically, even the driest of powders contain some molecules of water, even if those molecules are bound up chemically in what we call “waters of hydration.” Are they dry? What about a substance that contains no water, but is in alcohol or oil? Is it dry?

Some errors are not those of language, but of approach. For example, inexperienced patent attorneys often take a mechanistic rather than conceptual approach to patents, viewing the invention as a series of discrete elements. While it is true that the elements in the claims are essential and are considered in determining patentability, a far better approach, which provides a stronger argument for patentability and broader patent protection, looks to the inventive concept and argues patentability based on a conceptual distinction between the invention and what had been done before.

Other errors by new patent attorneys may arise from their arguments while prosecuting the patent application. For example, as with the magazine columnist’s reference to “as much . . . as possible,” the untrained patent attorney might write that an invention differs from a prior device because the prior device “cannot” be altered to do what the invention does. Such absolute statements by an inexperienced patent attorney might be falsified by an attorney with a more creative mind in litigation, resulting in problems caused by the patentee having obtained the patent based on his false statement.

An experienced patent attorney also will include language that endeavors to support a variety of scopes of protection in case unexpected prior art is located later, while

maintaining a breadth sufficient to cover unanticipated developments or attempts to circumvent the patent.

For example, sometimes I draft and application an invention relating to an organic solution. Organic solutions use an organic liquid such as benzene instead of water for a solvent. Common organic solutions are dry cleaning fluids, paint thinners, nail polish removers, spot removers, liquid detergents, and perfumes. Typically, we describe the solution as containing something (the “solute”) in an organic solvent. In such situations, I usually add something the inventor probably has not mentioned to me: that the solution may be nonaqueous (that is, free of water). I often define what is meant by “nonaqueous” to cover a solution to which a potential infringer has added a tiny amount of water in the hope of avoiding infringement. This language has saved several patent applications that otherwise would have been doomed because the Patent and Trademark Office located some early reference to a mixture that is not an organic solution as we had in mind, but did happen to contain water and something that qualifies as an organic solvent.

Another essential skill is the ability to recognize whether the patent can be policed and to design claim strategies that allow policing of the patent. For example, infringement may be impossible to discover because the infringing activity is carried out in private. Or the claim might call for a multi-step process and no single entity carries out all of the steps. Or the only infringers are millions of individuals, too numerous to sue for infringements that, taken individually, are tiny.

Before you begin the hunt for a patent lawyer, you may find it helpful to prepare a checklist outlining the fundamental components of your invention and, also, alternatives for those components or the overall invention. In addition, assess your goals for the product in industry and in business markets.

How can you tell if a patent attorney drafts high quality applications? Absent a bad experience, there is often no way for inventors to know. But there are some good indications. For example, usually a patent application contains several titled sections, such as “Background of the Invention,” “Summary of the Invention,” and “Detailed Description of Preferred Embodiments.” A

Background or Summary that is longer than the Detailed Description is often a sign of poor patent drafting. Another red flag is raised by the use of indefinite terms without definition or the indiscriminate use of absolute terms such as “always,” “cannot,” and “must.” A mechanistic as opposed to conceptual approach to the patent claims or claims that cannot be policed may also raise suspicions.

You should also ask your potential patent attorneys a few key questions. For example, ask about their patent drafting training and, also, the extent of their patent drafting experience and experiences before the U.S. Patent and Trademark Office. If their training has not been under the tutelage of an experienced patent draftsman, ask if they have drafted applications for companies that have in-house patent attorneys. This is not a guarantee that they produce high quality applications. Many patent attorneys draft fine applications without such experience and many in-house patent attorneys themselves have not been well trained. However, it does suggest that their work may have been reviewed and approved by other patent attorneys.

Then ask about his or her exposure to patent litigation. While the patent draftsman need not be – and usually is not -- a litigator, exposure to litigation is invaluable because many patent issues arise during litigation and the application must be drafted with an eye to how it will be viewed and attacked in litigation.

Of course, ask about their technical background and education, as well as their experience with industries, companies, products or patents that may be germane to or relate to your own needs. Also, you may want to inquire about their experience with international patent procedures if your invention may be made, sold or used in other countries.

Your patent attorney should not only be skilled and experienced, but should thoroughly understand your invention to prepare a patent application that will best serve your needs and strive to protect your interests. Be aware that because patent law is so esoteric and idiosyncratic, it may be challenging to find a patent attorney whose skills and experience are exactly what you want. 