

Collaborative Partnership Leads to Better Patents

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ABSTRACT:

Quote: “In the long history of humankind (and animal kind, too) those who learned to collaborate and improvise most effectively have prevailed.” attributed to Charles Darwin

In-house counsel is the primary point of contact for inventors and innovators with an organization, and thus can influence the innovation process through education, inventor outreach, and patent harvesting. However, in-house counsel is not alone in this process and can partner with and leverage outside counsel as a force multiplier to accelerate these efforts. This is a win-win for both parties as in-house counsel benefits from additional resources and expertise and outside counsel can more deeply engage with the inventors and build relationships for more effective disclosure and partnership.

Note: In the following article the term engineer is used, but this applies equally to software developers, scientists, technicians, technologists, and anyone in the creative technical arts.

GENERAL POINTS TO COVER:

In-house counsel (IHC) are being asked to do more with less: limited budgets, fewer staff, and particularly in large multinational organizations, clients spread across a broader geographical footprint.

Our patent clients, usually engineers and scientists, frequently have tight project deadlines and particularly for less experienced clients find it too time consuming to write up and submit invention disclosures or are unsure of exactly what is required to be written for an invention disclosure.

Outside counsel (OC) often have deep subject matter experts within their patent practitioner ranks. In conjunction with IHC, these experts can facilitate invention harvesting and identify potential areas of interest to explore. In partnership with in-house counsel, outside counsel can help work with engineers to guide them on how to write invention disclosures or even

write invention disclosures themselves after conversing with engineers, if a company believes it more cost effective to have their OC provide such services. This may be helpful when the engineer’s time is deemed to be of more value spent on product development related to an invention, particularly with tight release deadlines.

OC may have national or regional coverage, and in some circumstances may provide a local attorney to participate in disclosure meetings or harvest at sites/countries where attendance by IHC may not be practical due to time constraints or travel budgets.

BUILDING A TRUSTED RELATIONSHIP WITH THE INVENTOR COMMUNITY

The in-house counsel’s clients include the corporation as a whole and its shareholders. Most day-to-day interactions are with the various business units (BUs) and other functional groups. The patent in-house counsel works closely with their community of innovators and particularly in the engineering groups (current product development) and research and development groups (next generation research and product roadmaps).

Many organizations have serial inventors –those who invent repeatedly in the same general technical area or in adjacent spheres. In-house counsel have the opportunity to work closely with these clients and encourage innovation in their technology area.

In-house counsel participate in the invention disclosure process and can prompt or encourage an inventor to disclose more invention, but due to time or budget constraints this is not possible in all circumstances.

Through collaborating and drafting multiple cases with a serial inventor, outside counsel can also build a relationship with that inventor and encourage the inventor to disclose more thoroughly and broaden the scope of their patent drafts. Particularly where inventors are located close to the outside counsel office, in-person disclosures and interviews can be very helpful in establishing this relationship.

In-house counsel can facilitate this by selecting trusted outside counsel with expertise in the inventor’s field and have them build a rapport with the inventor. Outside counsel can earn this by providing quality draft applications and encouraging further ideas from the inventor with their cooperation and participation. When inventors go through the invention disclosure and application review process with trusted outside counsel and discover that it takes less of their time and effort than they had originally expected, inventors then become more willing to submit future invention disclosures because they have seen that it will not significantly impact their product development work. Inventors and in-house counsel alike appreciate ease of interaction with outside counsel, and clear and timely communication between outside counsel and the in-house clients.

ACCELERATING INVENTION HARVESTING:

Invention harvesting is a process whereby counsel (usually IHC but occasionally OC) engage in exploratory discussions about invention ideas with a technical team, and record those ideas for potential patent filing. These inventions may include features recently implemented in products (as long as there is no on-sale bar), improvements to features or products that engineers have conceived but have not implemented in products, or features whose conception are sparked by the invention harvesting process itself. An important part of the invention harvesting process can be the education of engineers as to what constitutes a patentable invention as some engineers that do not have experience with patents may not appreciate that the features they have invented are patentable.

In-house counsel can moderate these harvests and track the resulting invention ideas for write-up. Outside counsel can facilitate this by participating in the meeting, taking detailed notes and gathering material and inventor insights required to write up the ideas for filing.

Particularly in a first-inventor-to-file regime, it is important to quickly protect inventions identified during such harvests. When engineers are already committed to projects with tight deadlines, outside counsel can greatly assist by writing invention disclosure documents and then drafting a detailed provisional application for filing.

Both IHC and OC can improve results of patent harvesting by inquiring into recent problems solved by the inventor, known competitor product developments, and future product trends, etc.

By developing a history of interaction with the inventors in a particular technology area or product space, the outside counsel may have a broader view of the inventions both individually and as a portfolio.

COLLABORATION ON THE PATENT APPLICATION DRAFTING

In-house counsel usually has greater access to product development knowledge than the outside counsel, and it is important that this be used over the lifetime of both the product and patent to craft effective and business-relevant claims.

During the invention drafting stage, both inventors and in-house counsel should communicate clearly to the outside counsel the intended product applications for inventions on which applications are being drafted, and also any potential variants that may be later productized by the applicant or its competitors. Other business stakeholders such as in-house IP strategists or business partners should also be consulted during the drafting stage to ensure that business needs are fully addressed. In addition, engineers should be asked by both in-house and outside counsel to think about alternative ways that others might design around their product features in order to capture such variants in a patent application. In communicating inventions to both in-house and outside counsel, engineers tend to be focused on their company's product implementation and not on how other companies may implement either similar or different features.

COLLABORATION SHOULD CONTINUE AFTER THE PATENT APPLICATION FILING

At some companies, the collaboration among in-house counsel and outside counsel (and also inventors) ends with the filing of a patent application and outside counsel are left to their own devices to prosecute applications through the Patent Office. In some situations, the outside counsel may be prosecuting the application based on business direction or information that might be years out of date.

In the period (sometimes 2 to 3 years) that it takes to have an application examined by the Patent Office, the product features or importance of certain elements

that were claimed in an application might have changed substantially. Occasionally, these changes are to the point where certain features should be removed from the independent claims of a patent application, if possible, while others should not be considered for inclusion in independent claims to secure allowance of a patent.

Moreover, competitor products may be subsequently developed that include features described in patent applications that are either not currently claimed or not claimed in the best manner possible, with the benefit of hindsight. In-house counsel should communicate the company's product development information and competitor product development information to OC if known.

If such information is not readily available to IHC, then IHC and OC can work together to seek out such information from the inventors or other appropriate individuals at the company that could have such knowledge. Unfortunately, some companies do not want to place further demands on an inventor's time after a patent application is filed. Such a company's policy in this matter may have been implemented because their outside counsel were not properly advised on how to interact with inventors to be respectful of their time by focusing the inventor to respond to very specific questions and issues rather than making broad requests for input on rejections of their patent applications that can discourage and dissuade them from participating in the process.

When outside counsel collaborates with their in-house counterparts, valuable information can be derived from inventors during the prosecution of an application without imposing significant burdens on an inventor's time. In addition, collaborating with an inventor during the prosecution of an application also aids in continued invention harvesting. Sometimes a company may seek an inventor's input regarding the scope of the claims to be issued at the time of allowance of a patent application which may be many years after an application has been filed. However, in some instances, inventors have indicated that newer versions of the product were released in the intervening time but the claims cannot not explicitly cover those revised or new features and it may be too late to file improvement patent applications due to the public disclosure bars.

By collaborating with inventors during various stages of prosecution, in-house

counsel and outside counsel may discover new inventions that were subsequently created that would not otherwise have been brought to the attention of in-house counsel through invention disclosure submission or captured by invention harvesting sessions.

COLLABORATION STYLE CAN IMPROVE LEGAL OUTCOMES:

In addition to collaboration on technical and patent drafting matters, clear and professional interaction between in-house counsel, outside counsel, and professional staff can support effective filings and portfolio management. By keeping all relevant parties in the loop, miscommunications can be prevented and filing errors or missed deadlines averted. This is particularly important in the present first-inventor-to-file system.

IMPROVING COMMUNICATION WITH THE INVENTOR COMMUNITY.

Sometimes inventors get discouraged from submitting invention disclosures of their inventions to the legal department if their submissions are turned down repeatedly. It is important for in-house counsel to communicate with inventors on why their submissions were not approved (e.g., by an invention review committee) in a manner that will still encourage them to provide future submissions.

First, the in-house counsel (or the invention review committee) can improve communication by acknowledging the significance of the inventive contribution and then explaining some of the factors that go into a company's decision making process. One such factor being the ease with which the company would be able to detect that a competitor has included the invention in their product or is practicing the invention. While certain inventions may be very important to the company and to the operation of a product, if they are not detectable through product documentation or reverse engineering, then it may not be financially in the company's interest to pursue a patent on the invention where it cannot be easily determined that a competitor is making or using the invention. In addition, the company may make a strategic decision to focus its portfolio building efforts on particular technology areas, and file less on other areas according to corporate strategy.

If inventors are provided recognition of their inventive accomplishments (e.g., through awards, financial incentives for

submitting invention disclosures, etc.) and understand the reasons behind the company's decision not to pursue a patent on their inventions, then inventors are far more likely to not be discouraged from continuing to submit invention disclosures in the future.

In-house counsel and outside counsel can enhance understanding and encourage invention disclosures by taking time to fully understand an invention, the surrounding technology, and market. When counsel can demonstrate both technical and business understanding of an invention, it can raise the level of inventor confidence in the legal partners.

CONCLUSION:

In-house and outside counsel play individual, but critical, roles in developing innovative IP assets and protecting R&D investments of organizations. By developing a shared vision of success and implementing clear communication and collaboration processes, both client satisfaction and business outcomes are improved. This can generate substantial financial value in the form of new IP assets and market exclusivity, with resulting value for inventors and investors and manufacturers of the patented products. This is the very incentive to innovate envisioned by the Founders to “promote the progress of science and useful arts.”