

Strategic Patenting Requires More than a Patent Practitioner

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What is strategic patenting?

Linking patenting activities to business strategies

Patenting Activities Vary Among Companies and at Different Stages of Development

patent
everything_____patent
nothing

Patenting everything is COSTLY
Patenting nothing is COSTLY

Potential Uses of Patents

- Establish proprietary/strategic position in the marketplace
- Business negotiations
- Generate revenues
- Reduce operating costs

Establish Proprietary/Strategic Position

- Protect core technologies and business methods from infringement
- Anticipate market trends and technology shifts
- Exclude competitors

Business negotiations

- Access complementary technologies and markets
- Avoid litigation
- Establish business alliances and collaborations

Generate revenues

- Licensing, selling, donating patents

Reduce operating costs

- periodic review and culling of patent portfolio
- use licensing revenues to fund R&D
- avoid litigation expenses
- get tax write-offs for patent donations to nonprofits and universities (maybe...)

What is strategic patenting?

Linking patenting activities to business strategies

Strategic Patenting Requires a Business Strategy



Said Alice to the Cheshire Cat:

“Would you tell me, please, which way I ought to go from here?”

“That depends a good deal on where you want to get to,” said the Cat.

“I don’t much care where____,” said Alice.

“Then it doesn’t matter which way you go.” Said the Cat.

Louis Carroll

Alice in Wonderland

Business Strategies Vary from Company to Company

some examples....

- create technologies and future markets
- provide products and services for known market
- establish reputation as “technology leader” in an industry
- provide new way to manufacture and distribute product

Patent Basics

- patents are **exclusionary** rights – they do not necessarily allow the patent holder to use the patented invention
- patents are **territorial and national** in scope- an invention that is patented in the U.S. can be freely used in another country where it is not patent-protected

Patent Basics

- patentable subject matter is determined by national law
 - in the U.S.:
 - “ any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof”

For example...



US005934226A

United States Patent [19]
Moore et al.

[11] **Patent Number:** **5,934,226**
 [45] **Date of Patent:** **Aug. 10, 1999**

[54] **BIRD DIAPER**
 [76] Inventors: **Lorraine Moore; Mark Moore**, both of 217 S. Glen Ave., Watkins Glen, N.Y. 14891; **Cely Giron**, 9388 Sawtooth Way, San Diego, Calif. 92129

943116 11/1963 United Kingdom .
 981247 1/1965 United Kingdom .

OTHER PUBLICATIONS

Penny Ward Moser, "Dreams, Schemes, and 3,300 Better Mousetraps," *Discover*, p. 85, Dec. 1985.

[21] Appl. No.: **08/951,171**
 [22] Filed: **Oct. 15, 1997**

Primary Examiner—Robert P. Swiatek
Attorney, Agent, or Firm—Richard C. Litman

Related U.S. Application Data

[60] Provisional application No. 60/029,142, Oct. 21, 1996.

[51] **Int. Cl.⁵** **A01K 23/00**
 [52] **U.S. Cl.** **119/868; 119/853**
 [58] **Field of Search** 119/714, 853,
 119/868

ABSTRACT

A bird diaper for an uncaged pet bird to wear, featuring an enclosed pouch for receiving and containing excrement, and apertures to accommodate both the wings and the tail of the bird. Elastic straps and hook and loop fastener components (e.g., VELCRO) secure the diaper onto the body of the pet bird without restricting movement. The bird diaper is fabricated from spandex (e.g., LYCRA) or another stretchable, lightweight material, allowing absorption of bird excrement to prevent leaks and facilitating easy cleaning using soap and water. The bird diaper can incorporate decorative designs, bright colors and is available in different sizes. The bird diaper also has a leash which is insertable within the hook and loop fasteners. The leash serves to restrain or limit the bird's area of free flight.

References Cited

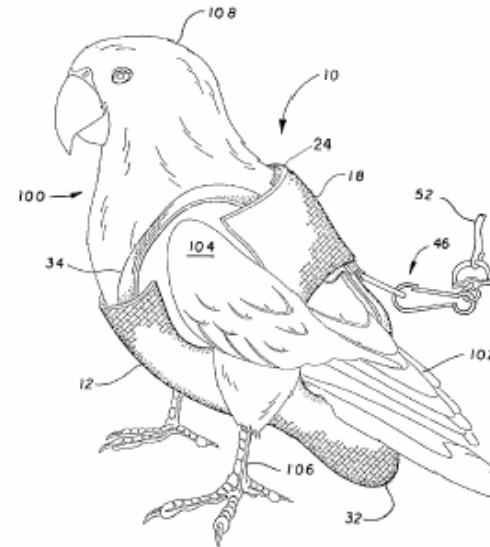
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18 Claims, 7 Drawing Sheets



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another
example



US005298274A

United States Patent [19]

[11] Patent Number: 5,298,274

Khalsa

[45] Date of Patent: Mar. 29, 1994

[54] METHODS FOR MAKING TORTILLA CHIPS AND TORTILLA CHIPS PRODUCED THEREBY

Primary Examiner—D. Czaja
Assistant Examiner—Mary S. Mims
Attorney, Agent, or Firm—Stoel Rives Boley Jones & Grey

[76] Inventor: Nirbhao S. Khalsa, 3141 NW. Greenbriar Ter., Portland, Ore. 97210

[57] ABSTRACT

[21] Appl. No.: 867,262

Tortilla chips having improved flavor, sweetness and textural characteristics, as well as enhanced nutritional values, are provided using a combination of whole kernel dried corn and germinated grain such as corn to produce a masa dough. Germinated grain contributes a "sweet" flavor as a consequence of the high concentration of natural sugars in the sprouted material. The sprouted corn also contributes substantial fiber and nutritional values to tortilla chips. Specialized methods and systems for producing and processing masa dough having a germinated fraction are required as a consequence of the unique consistency and higher fiber content of the masa dough mixture.

[22] Filed: Apr. 10, 1992

[51] Int. Cl.⁵ A23L 1/10; A23L 1/185

[52] U.S. Cl. 426/560; 426/28; 426/438; 426/439; 426/808

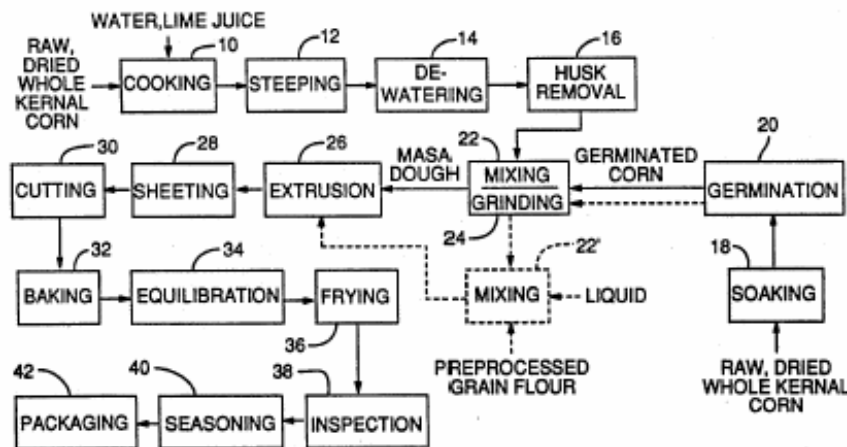
[58] Field of Search 426/28, 560, 438, 439, 426/808

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U.S. PATENT DOCUMENTS

4,613,507 9/1986 Falger et al. 426/28
4,756,920 7/1988 Willard 426/560
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26 Claims, 2 Drawing Sheets



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“Strategic Patenting” is a Process:

- Identifying and prioritizing key innovations for patenting, requires
 - an effective invention disclosure process
 - guidelines on whether to patent, keep as trade secret or publish
 - a procedure for technical, strategic and legal review of inventions

The Review Process

- process should be consistent, yet flexible
periodic patent coordinator meetings with
input from general managers, technical
managers, and IP attorneys:
assess strategic value, technical merit,
patentability, scope of protection, foreign
filing, costs, timing

Strategic Patenting Requires More Than a Patent Practitioner

Strategic patenting comprises:
a collaborative effort requiring
business, technical and patenting
expertise;
innovation; and
luck.



The End

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