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Strategies for managing a patent portfolio

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A comprehensive patent strategy requires managing all aspects of a patent portfolio, from correctly identifying inventors and their assignment obligations to tracking priority of claimed subject matter. Overlooking these issues can have detrimental effects on patentability, validity, enforceability and patent term. The following basic tips should avoid some of these pitfalls.

Ownership/inventorship

Upon filing a first application, including a provisional application, the claims should be reviewed individually to identify each contributing inventor. If joint inventors are named, they must have in some manner communicated with another joint inventor to be properly named on the same application. The claim-by-claim identification of inventors is useful to track the contributions of each inventor as prosecution proceeds. Each time a divisional or continuation application is filed, the claims should be reviewed, and inventors identified, to track the inventive contributions.

In the United States, a patent application is owned by the inventor, absent an agreement to the contrary. Typically, inventors have employment agreements, which govern their assignment obligations. Although employment agree-

ments confer this ownership interest, assignments are filed before each patent office and provide third-party notice of the ownership. The employment agreements of each inventor should be reviewed to ensure they oblige the inventor to assign his/her rights, and that the appropriate entity is named in the assignment document. Ownership review and filing of assignment documents should be completed before filing the application. This is particularly important before filing an international application or other foreign application where the owner is the named applicant. Although it is sometimes possible to correct inventors or applicants after filing, the costs and procedures to do so can be substantial. In some instances, if an applicant is omitted, the error cannot be corrected later.

Continuation-in-part applications

Any continuation application that is filed to contain new matter can be designated a continuation-in-part (CIP) application and claim priority to an earlier filed parent application. Patent term, however, is calculated from the earliest claimed priority date, so that the added subject matter, which is not entitled to the priority date, loses valuable patent term. A patent practitioner should be wary before filing a CIP application because added subject matter that does not find basis in the earli-

er application does not benefit from the earlier filing date. It is a misconception that the earlier priority date will afford new matter in the CIP protection from prior art. In the United States, the parent application can be prior art to any claims to the added subject matter in the CIP application that do not share a common inventive entity. In foreign countries, the parent application, assuming it is filed in the foreign country, is per se prior art for novelty to any new subject matter, and can be prior art for inventive step if the earlier application has published. Thus, there is little benefit to filing a CIP application. In order to preserve patent term, any disclosure that encompasses new subject matter can be filed as a separate application. The claims should be drafted to be patentable over any prior art references, including any earlier applications.

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