Jackie Hutter, MS, JD
The Hutter Group, LLC
IP ***Business*** Strategy
Decatur, GA
Web: www.JackieHutter.com
www.PatentMatchMaker.com
Blog: www.ipAssetMaximizer.com

Improve Your Chances of Obtaining a Patent at a Reasonable Cost and Time by Demonstrating the "Wow Factor" in the Application

A strong majority of people seeking patent protection to protect their products or technology leave the details the drafting process to their patent attorneys. That is, given the specialized (and, frankly, arcane) nature of the patenting process, even highly accomplished business professionals believe that a patent specialist (*i.e.*, attorney or agent) is better equipped to understand how to best describe their invention to the US Patent Office ("USPTO"). This can be an ineffective way to handle the front end of the patenting process because it can result in the process being more contentious. Such contentiousness can result in narrower claims than desired and can make the patent take longer to issue and make the process considerably more expensive.

In determining whether a client's invention meets the legal requirements for patentability, a patent specialist thinks about how to legally distinguish the invention from those that have come before. Specifically, the patent specialist must demonstrate to the USPTO—as represented In the person of a patent examiner—how the invention is new and not obvious in view of what others have done previously. The patent specialist must also determine how to describe the invention in a way that satisfies the precise technical and legal requirements. While working in this "legal silo," a patent specialist quite possibly does not have any knowledge about the commercial benefits the invention provides because the client's business team typically is not involved in the patent drafting process. This means that

when drafting the application, the patent attorney presents the invention in relation to the "check boxes" that the invention must satisfy in order to meet the legal requirements of patentability.

Moreover, even if such business information is available to the patent specialist, they rarely possess specific expertise in marketing or business. Without such training, a client cannot reasonably expect their patent specialist to present the invention in a way that effectively convinces the patent examiner that the invention "the best thing since sliced bread." Most patent attorneys thus will wholly ignore what I call the "Wow Factor" associated with an invention.

This "Wow Factor" sounds quite a bit like marketing, doesn't it? Exactly! And, given the fact that business professionals best understand the benefits their products and technology provide over others that have come before, a critical factor in a successful patenting effort is to not only demonstrate to the patent examiner that the claimed invention is legally patentable, but also that the invention is SUBJECTIVELY deserving of a US patent. It is this subjective aspect that is best handled by those who understand the benefits that a product or technology brings to the relevant consumer—that is, the marketing team charged with building a business case for the product or technology associated with the invention. While often absent from the patent drafting process, I believe that this marketing story serves as a critical factor any successful patenting process.

I will note that many patent specialists have disputed my contention that a significant aspect of a successful patenting process should involve developing a marketing story. These discussions typically center on the contention that "if an invention is patentable, the patent examiner is legally obligated to allow the patent application." This is no doubt true, but often an invention that is legally patentable enters into a contentious examination process when the examiner develops a point of view (albeit one that is legally wrong). When this happens, the examiner will often "dig in her heels" and refuse to allow the patent application based upon her misperception of the legal merits of the invention. Such a contentious examination process will, at a minimum, add considerable cost and time to the patent application process, but is also likely to result in undesirable amendments that will result in the final patent being insufficient to protect the commercial product or technology from competition.

In drafting a patent application covering a client's invention, many patent specialists fail to recognize that there is a person on the receiving end of each patent application. This

person—the patent examiner—spends her day reviewing patent applications in a fairly narrow technological area. Moreover, the patent examiner labors under a quota system that requires her to complete her examination of each application in a fairly short period of time. One can picture this examiner working on, say, light bulb patent applications. Each patent applicant (and his attorney) likely believes that his invention is unique and a "game changer." However, for the patent examiner who spends her work time examining light bulb inventions day after day, each application likely seems like a slight variation (if that) on what she has seen over and over again.

One can therefore picture the patent examiner effectively yawning at most patent applications that come across her desk. Add to this the short time the examiner has to gauge whether the invention meets the requirements for patentability and it should be clear why many worthy patent applications are subjected to contentious and expensive patenting process prior to issuance.

Further to these issues that are personal to the patent examiner's job, on a broader scale, one must also remember that the patent examiner's decision is imbibed with public policy considerations. That is, if the patent examiner allows a patent to issue covering the claimed invention, no one else will be able to legally do what the patent covers. The issued patent will thus effectively restrict the public's freedom of action in the area of the issued patent. To justify this, a patent application should demonstrate to the patent examiner why the public should be prevented from doing what it would otherwise legally be able to do—to practice the product or technology covered by the patent claims.

By remembering during the patent drafting process that there is a person who stands between the patent application and an issued patent much cost, time and effort can be eliminated from the patenting process. Put simply, in addition to presenting a legal basis of why an invention is patentable, a patent application should also present a MARKETING STORY the invention to the patent examiner. The key is to include in the patent application a "hook" or "theme" that is directed to building a story for the patent examiner why the invention is not only legally sufficient for patenting but also that the invention bears a business reason for existing. A critical part of this effort centers on demonstrating to the patent examiner why the invention merits allowance, especially given the fact that the patent will prevent others from freely acting. To do this, a patent search should be conducted and analyzed, as the

patent literature will likely serve as the primary source of rejections posed by the patent examiner.

To build this strong marketing story, the patent specialist should collaborate with one or more persons on the business team responsible for building a business case for the product or technology underlying the invention set forth in the patent application. This will allow the patent specialist to craft the underlying patentability story—or "Wow Factor"—that can result in the patent examiner picking up the application and thinking "this is not the same old light bulb invention that I see day after day." While the patent examiner will likely not allow the patent application on a first review, I contend that the subsequent examination process can be rendered less contentious by developing a marketing story to support the patentability story.

It should be noted that many patent specialists will not be amenable to this strategy because it is a deviation from the traditional methods of patent drafting. Specifically, many patent specialists have been trained to discuss only the invention in the application and to ignore the prior art unless it is brought up by the examiner. This strategy was certainly a viable one before the explosion of patent filings in the last 10 or so years, but now there is so much prior art available in most technology areas that a patent applicant must realize that the prior art cannot and should not be ignored. I believe that by facing the prior art head on and preparing a patentability strategy and a marketing strategy the patenting process will likely be less contentious.

Lastly, some patent specialists might look at my recommendations as a reason to rail against the USPTO and patent examiners. While there are many problems that need to be fixed, the truth is the system is what it is today. One can wish for legal purity in the patent system, or one can be pragmatic about what it takes to successfully obtain a patent under the conditions existing today where the patent has suitably broad claims to protect the underlying product or technology from competitive knock-offs, where this patent was obtained at an acceptable cost in a reasonable time frame. At the end of the day, most clients would prefer the latter.