

Fitch, Even, Tabin & Flannery

FITCH EVEN TABIN & FLANNERY
INTELLECTUAL PROPERTY LAW | EST. IN 1859

Developing A Living Patent Portfolio

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Prosecution

- Prosecutors Strive To Build The Best Portfolio
 - Static portfolio (issue claims)
 - Living portfolio (claims in prosecution)

Portfolios

- **Static portfolio**
 - Claims Drafted Before We Had A Competitor
- **Living Portfolio**
 - Claims Drafted Yesterday – After Receiving Competitor's Design

Preparing For Living Portfolio

- Write A Detailed Application (You Do Not Know Where You Will Need To Run)
- Prosecute The Good Claims
- File A Continuation Before Issue Fee Payment For The Good Claims
- Minimal Prosecution Of Continuation Until A Target Is Known
- Focused Prosecution When Target (Competitor) Is Identified
- New Continuations As Needed

Living Portfolio

- Docket The 2 Year Limit For Broadening Reissue
- Honestly Review Near 2 Years – Is This Invention Worth More Investment?
- File Broadening Reissue If Warranted
- Prosecute

Reissue Filing (MPEP 1400)

- File With Issued Claims And At Least One New Broader Claim
- Need Only Declare One Error; e.g. “Failed To Claim Less Than We Had A Right To...”
- No Exhaustive Listing Of All Errors And How They Arose

Reissue Prosecution

- To Be Handled “Special” By USPTO
- You Can Amend Claims To Be Different Than Original Reissue Claims
- File Continuations Of The Reissue As Needed As Long As A Reissue Parent Is In Prosecution
- Take Allowance Of Desired Applications And Continue Prosecutions Of Others

Reissue Downside 35 U.S.C. §252 ¶2

- No Infringement Of New Claims Or Claims With Substantive Amendments Prior To Issue
- After Issue, Equitable Defense May Apply To Infringement Of New Claims
- Equitable Defense Not Frequently Granted And Royalties Will Likely Be Due

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