

Business Methods Patent Prosecution and Strategies

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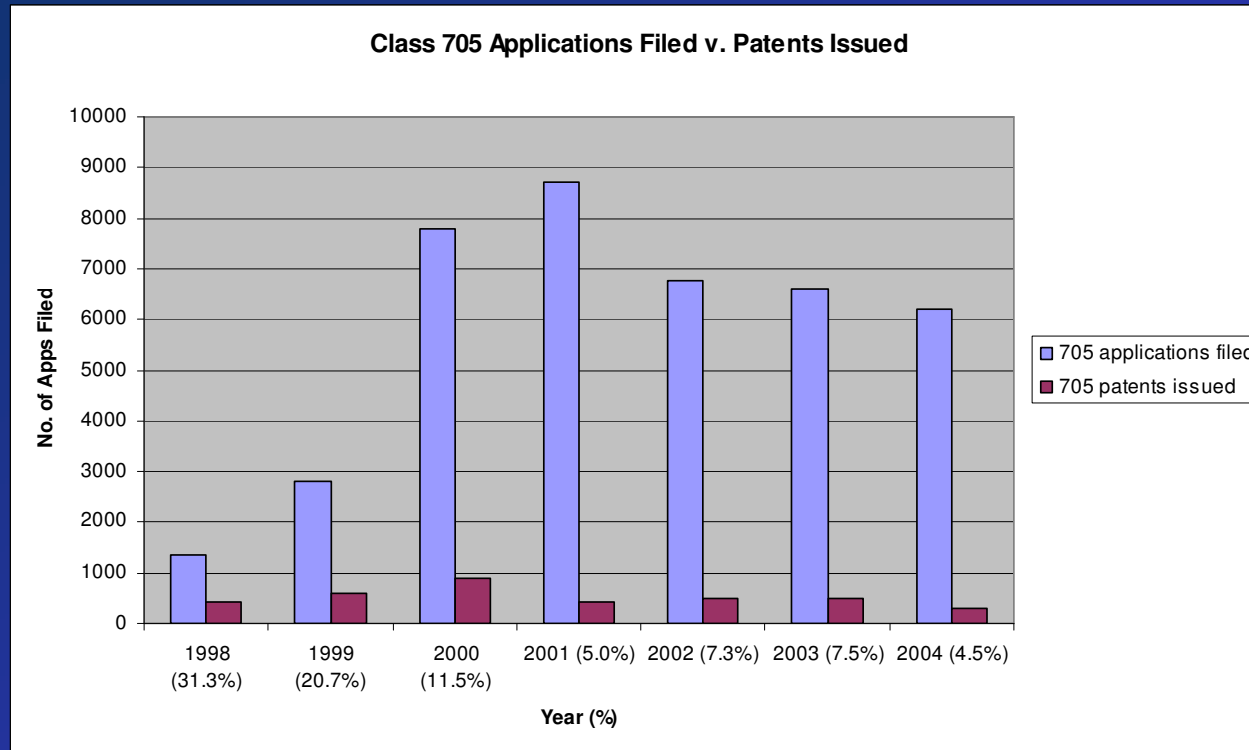
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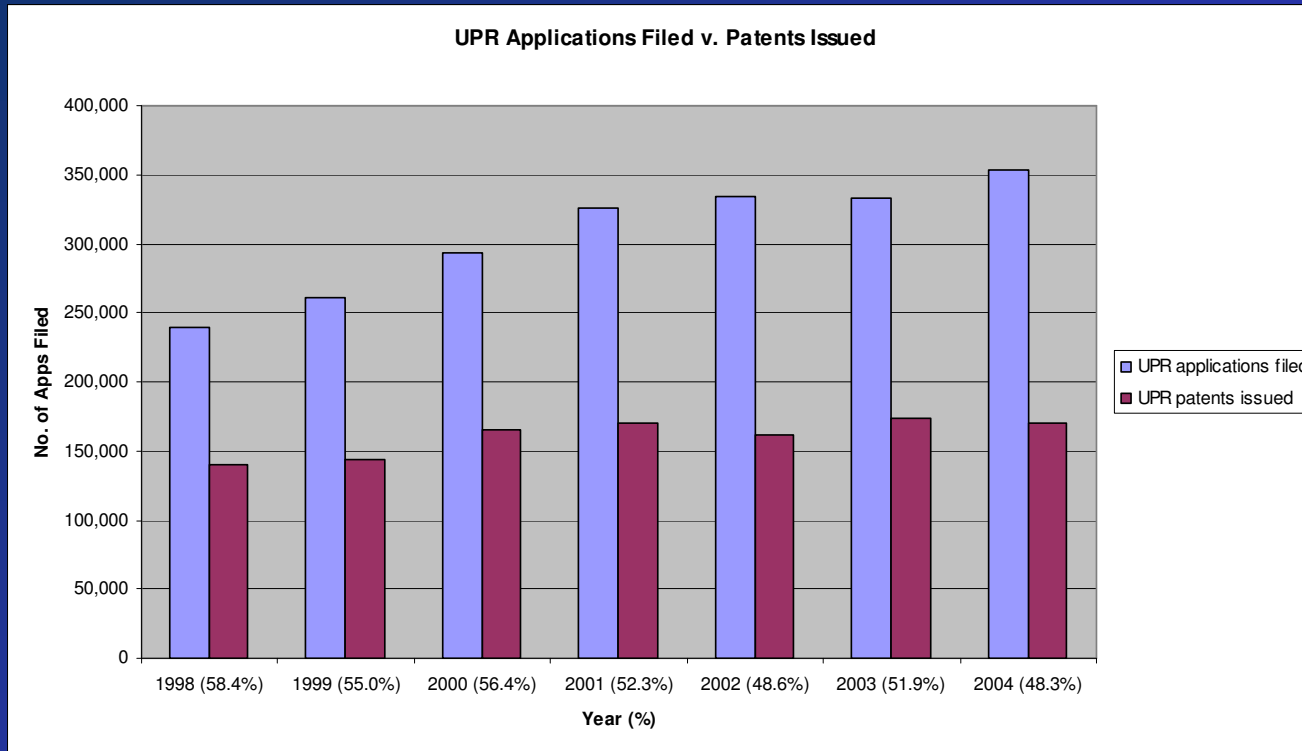
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Class 705 Applications Filed v. Patents Issued



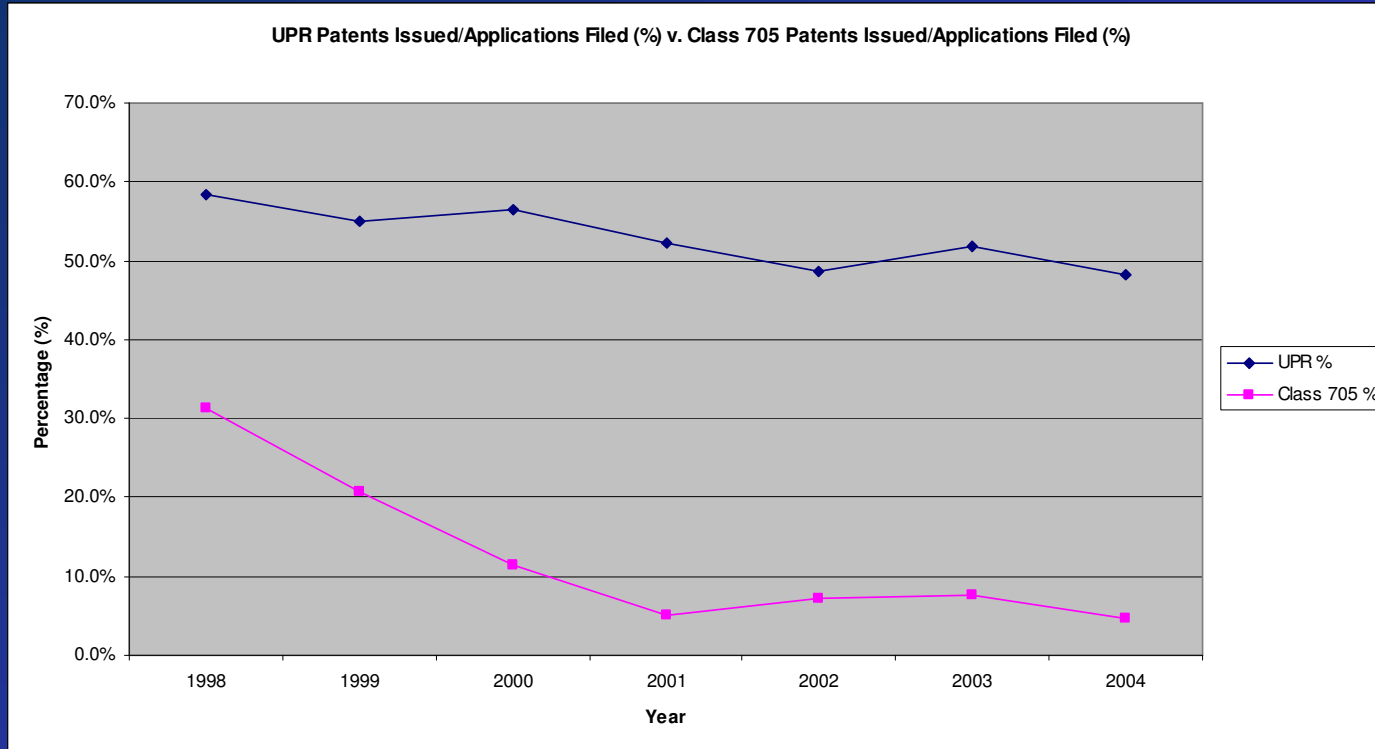
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UPR Applications Filed v. Patents Issued



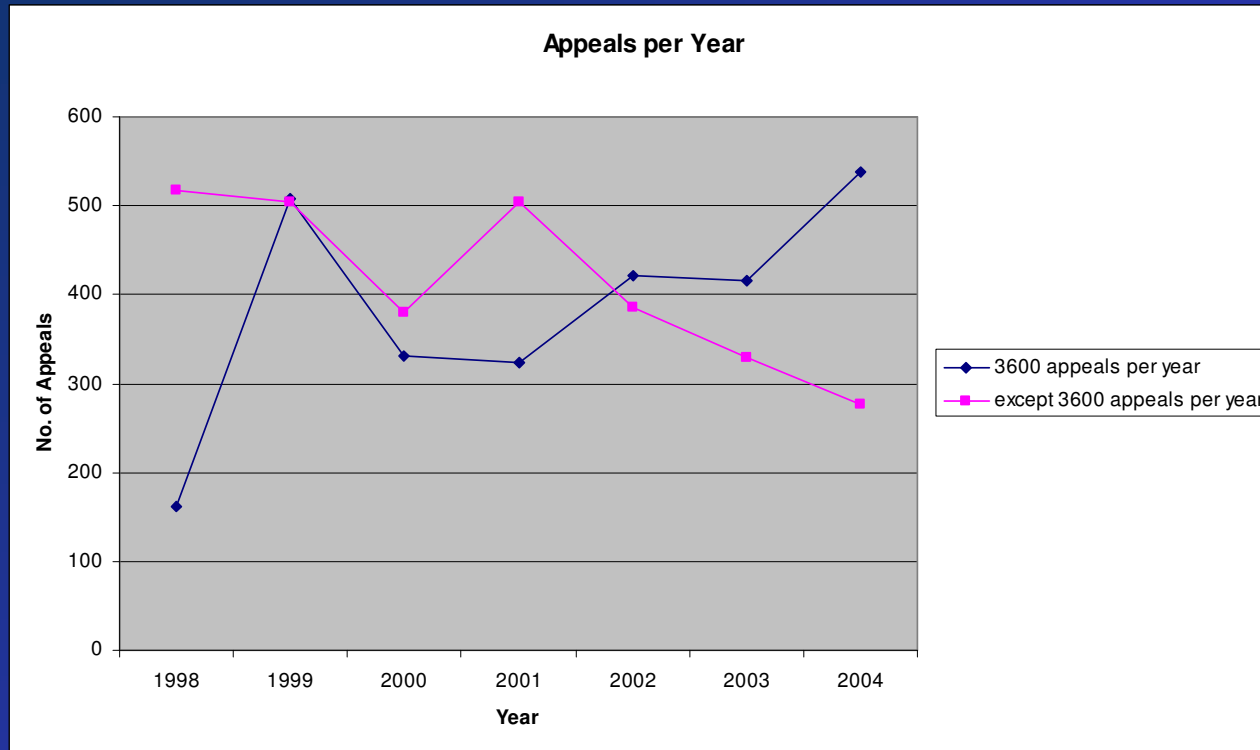
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Class 705 % v. UPR %



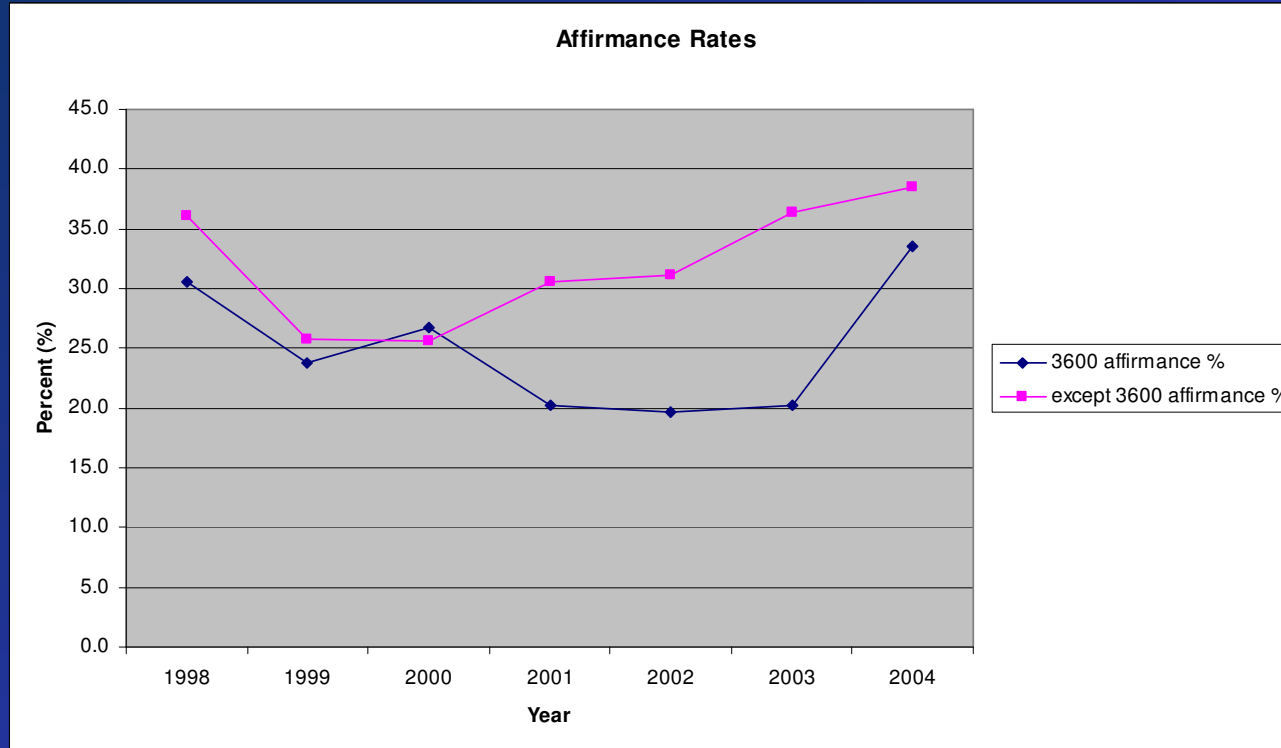
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Group 3600 Number of Appeals



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Group 3600 Affirmance Rates



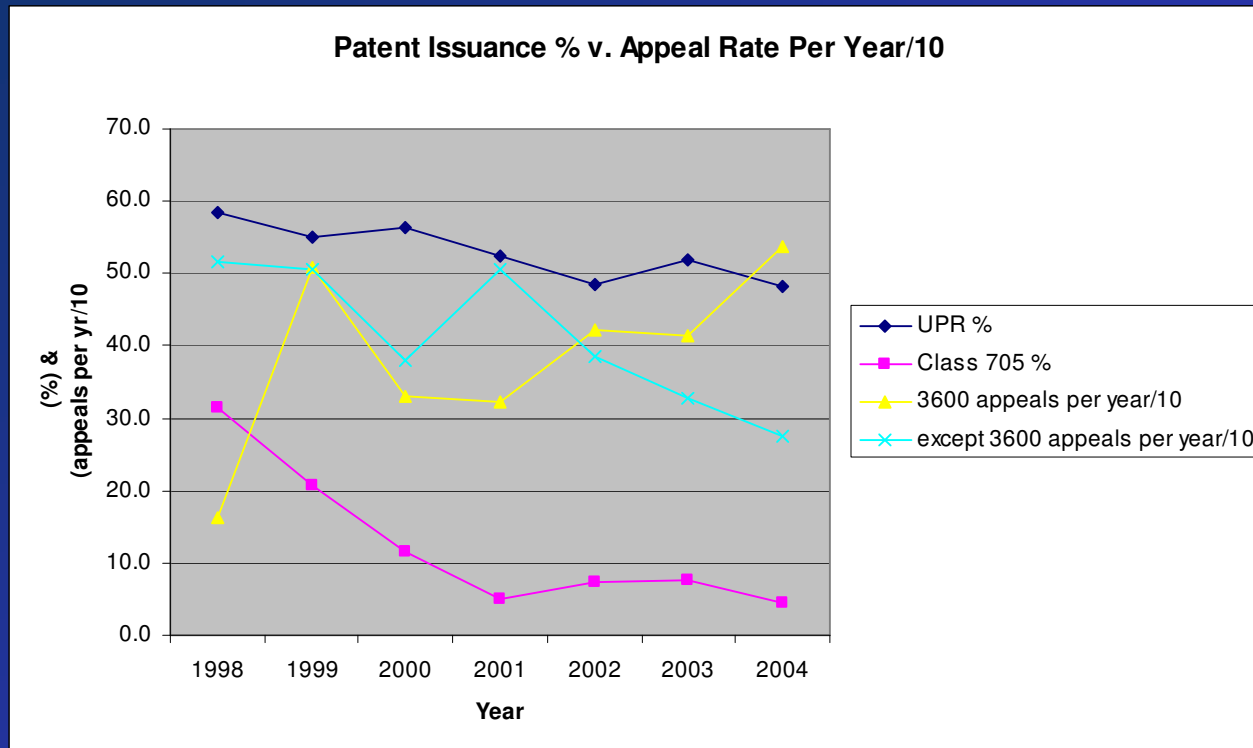
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Group 3600 Reversal Rates



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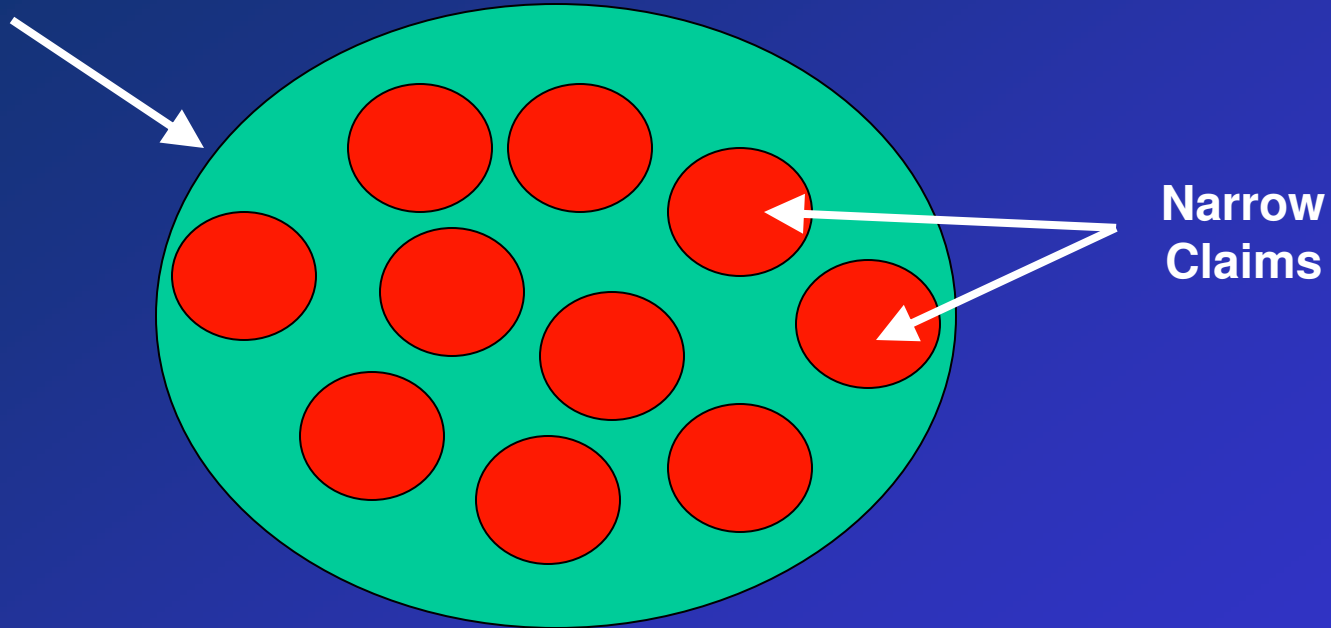
Patent Issuance v. Appeal Rate



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Covering IP Portfolio

- IP Portfolio



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Practice Considerations

- Consider narrower defensive patent claims versus broader offensive patent claims
- Consider patent portfolios as a deterrent to patent litigation and as a way to cross-license (“picket fence”) and offset royalty payments and/or for license pooling purposes
- Consider filing multiple applications versus jumbo to focus on only one embodiment and narrow the issues and search areas, to cultivate patent portfolios for business valuation purposes

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Practice Considerations

- Consider conducting a patent search for providing the best possible prior art to Examiners
- Consider ways to reduce stress for Examiners, such as reducing references cited in IDS, only one embodiment claimed, file divisionals for other embodiments, limited number of claims, focused prosecution, and narrower issues
- Consider establishing a good reputation with Examiners and SPEs

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Practice Considerations

- Having larger portfolio
- Not all eggs in one basket
- Faster allowance
- Overall lower cost

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About the Authors

Bijan Tadayon, Ph.D.

Dr. Bijan Tadayon is the Director of Intellectual Properties at ContentGuard, specializing in DRM, with investments from Microsoft, Time Warner, Thomson, and Xerox, and patent licensees such as Sony. In 1986, Bijan got his BS degree in Applied and Engineering Physics, ranking second in his class. His mentors included some famous Cornell physicists, Prof. David Lee and Prof. Robert Richardson, the winners of the 1996 Nobel Prize in Physics. Bijan got his PhD in Electrical Engineering from Cornell, and in early 1990s, he and his brother designed and fabricated of the fastest GaAs-based heterojunction bipolar transistor in the world. He was a co-founder of a software company. He was also a Technical Consultant and Advisor for a large law firm in Baltimore, MD. Until 2000, he was a primary examiner and a technical trainer at US PTO. Bijan has had more than 80 technical journal publications, technical presentations, or conference proceedings, in addition to some pending and issued patents, and 9 technical lectures at US PTO, so far.

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About the Authors

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Practice areas

Technology & Intellectual Property
Patent Prosecution
Software & Digital Technology
Trade Secrets

Education

The George Washington University Law School, J.D. (1998)
California State University, Long Beach, M.S.E.E. (1992)
California State Polytechnic University, Pomona, B.S.E.E. (1987)

Background

Carlos R. Villamar's practice involves foreign and domestic patent application preparation and prosecution, opinion work, litigation, and client IP counseling. Mr. Villamar's expertise covers a wide variety of technologies, including speech recognition, neural networks, sound and image processing, communications systems, computer systems, on-line gaming software and systems, semiconductors, medical imaging systems, software, and electromechanical devices.

Prior to joining the firm, Mr. Villamar gained extensive experience in numerous aspects of intellectual property law as an attorney of counsel at Ditthavong & Carlson, PC, and as an associate at Oblon, Spivak, McClelland, Maier & Neustadt, PC, where he worked in the Electromechanical Group. Mr. Villamar is also a former patent examiner at the U.S. Patent & Trademark Office, where he worked in the Speech Signal Processing Group.

As an electrical engineer, Mr. Villamar has over nine years of commercial experience. Mr. Villamar worked in production design and testing for the Standard Missile Program at the General Dynamics Corporation Missile Systems Group, where he was awarded an undergraduate fellowship. At the Hughes Aircraft Company Radar Systems Group, Mr. Villamar was awarded a Master's fellowship and gained extensive expertise in high-speed digital logic and computer design while working on the Advanced Tactical Fighter Program. Mr. Villamar then conducted independent research and development at the Hughes Aircraft Company Advanced Circuits Technology Center, where he designed high-speed digital signal processing and communications systems.

Mr. Villamar's publications include "Performance of a Backpropagation Neural Network in Diagnostic Rhyme Test Word Recognition," Chit-Sang Tsang and Carlos R. Villamar, The Society for Computer Simulation International, Vol. 70, No. 3, March 1998.

Admissions

Mr. Villamar is admitted to practice in Virginia, the United States Supreme Court, the Court of Appeals for the Fourth Circuit, the Court of Appeals for the Federal Circuit, the Virginia Supreme Court, and the District Court for the Eastern District of Virginia.

Affiliations

Mr. Villamar is a member of the American Bar Association, the Federal Circuit Bar Association, the American Intellectual Property Law Association, and the Hispanic National Bar Association. He also serves as co-chair of the Federal Circuit Bar Association Minorities Committee.

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