

Patent Law Trends and Practical Considerations

May 26, 2010

Legislative Reform

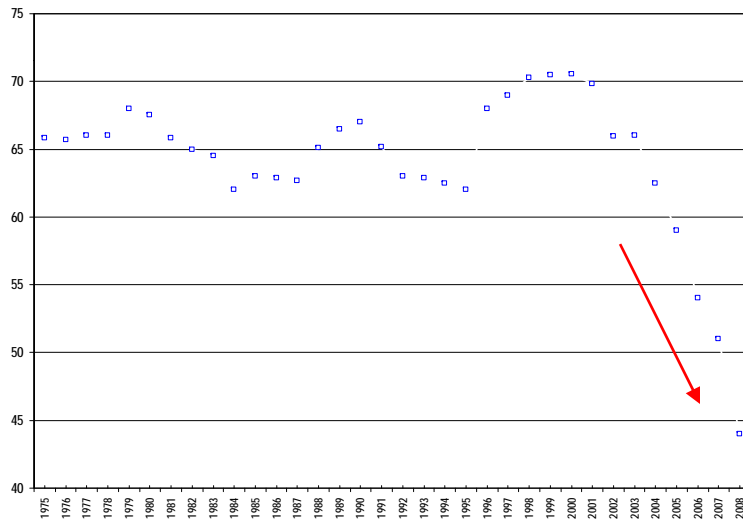
- Patent Reform Bill (S515)
 - First inventor to file with one-year grace period
 - Post-grant review: Challenge for any reason w/in 9 mos of grant
 - Damages: Factor-based analysis
 - Venue: Easier transfer to more convenient forum
 - False marking claims limited to those who have suffered injury
 - Best mode eliminated as basis for invalidity
 - Willful infringement requires “objective recklessness”
 - Inequitable conduct: Untouched
 - New option for patentee to submit unconsidered prior art
 - Fee-setting authority given to PTO
- House Bill (introduced May 18, 2010)
 - Fee setting authority to PTO
 - Limit on diversion of PTO revenues

Executive Branch Trend

- US Patent and Trademark Office (PTO)
 - New Senior Management 8/2009
 - Revised Production Measures
 - New Supervisor and Examiner Performance Measures
 - Compact, Accelerated and Delayed Examination
 - Increased Examiner Meetings and Ombudsman
 - PTO Job Creation White Paper
 - Director on Patent Appeals Board
 - No deference given to examiner
 - Quality Task Force public meetings
 - Backlog still HUGE
- Federal Trade Commission/Dept of Justice/PTO
 - Workshop about Promoting Innovation

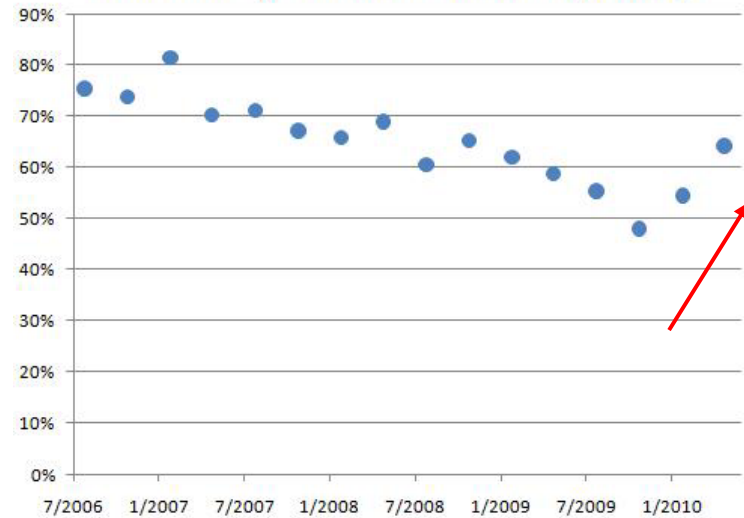
So What is Happening...

Patent Allowance Rate



08-31-09 Statistics

USPTO Utility Patent Allowance Rate Issued Patents / (Issued Patent + Abandoned Applications)



Patently-O 05-21-10 Statistics

Judicial Branch Trend

- Active Year for Judiciary
 - Supreme Court reviews
 - Multiple *En Banc* reviews
 - Multiple decisions addressing controlling legal questions
 - Chief Judge retiring to influence patent system
- Judicial Adjustments on Patent Reform Issues
 - Venue – E.D. Texas
 - Damages
 - Inequitable Conduct

What Now for Medtech Cos.?

- Different patent families have different goals.
Different goals now require new patent strategies
- Requires more strategic thinking during application preparation & dealing with patent examiner
- Requires more resources for tactical execution of strategy (Spend more per application)
- Conduct substantial prior art searching before filing
- Emphasis on meeting with examiner