

The Patent Lawyer

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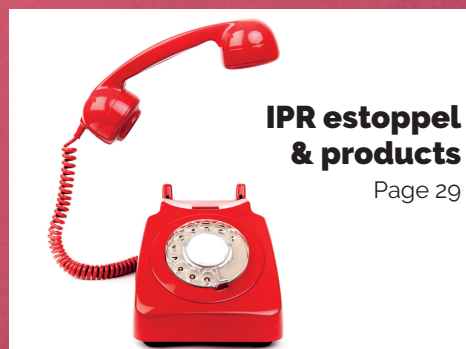
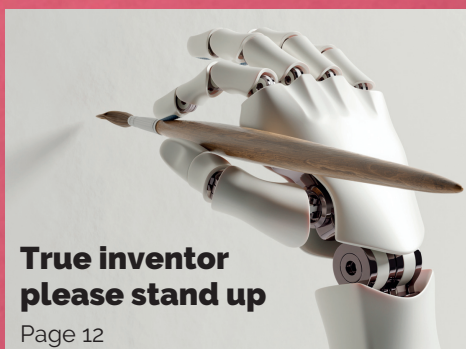
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The power of paralegals post-pandemic


IP TrendMonitor

The Patent Lawyer investigates the changing legal landscape that has resulted in a shift in the function of paralegals, discovering how one particular solutions provider is opening the door to new opportunities for leveling up in the patent space.



Jurisdictional Briefing, US: inventor interviews – do a great job on these and make patent law easy

Howard Levy, Partner at Cantor Colburn LLP, discusses how patent attorneys can approach inventor interviews to ensure that they are as successful as possible.

Patent attorneys must learn to be good interviewers. The initial inventor interview is the foundation of a patent, the "prep and pros" follows, and ultimately commercialization or enforcement. The good news is that interviewing inventors is perhaps the best thing about being a patent attorney. Inventors are almost always happy to talk about their work, their challenges, and how they overcome those challenges.

The following are essential practice tips for the inventor interview.

The outset – manage the mission & shared expertise

- **Establish your credentials.** When inventors ask about my background, I let them know that I have more than



Howard Levy

Résumé

Howard Levy, Partner

Cantor Colburn Partner, Patent Attorney, and Mechanical Engineer, Howard has more than 20 years of experience in patent law, working with some of the most innovative companies in the world. Howard's favorite part of his job is meeting with inventors, learning about their work, and helping them obtain patents that encourage further innovation. His talent for quickly understanding various technologies related to aerospace, power generation systems, electronics, semiconductors, computer science, and more allows him to easily connect with inventors working in all sorts of industries.

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20 years of experience writing and prosecuting patent applications, and how many years I have been working in their technology area. Then I add, "that said, you should assume I don't know anything." This lessens the formality of the interview while establishing that I have patent law expertise and they have technical expertise.

- **Inventors should know what the goal of the interview is at the start.** I have developed a script that accomplishes this and works for me. I'll say: "I've reviewed the disclosure and I believe I have a good handle on the invention. Let's have the inventive team go through it, talk about the prior art, what the problems were, and how you went about solving those problems. I'll jump in with questions." The inventors take it from there.

Of note, a colleague handles interviews differently. He lets inventors know that he will describe their invention to them to ensure he understands it and invites them to interrupt. Ultimately, our approaches arrive at the same understanding. Over time, you will find the approach that works best for you.

- **Be upfront with inventors if you are confused about something.** They'll

appreciate your honesty and may even be happy that you have an appreciation for the complexities of their work.

The meaty part – claim structure

- **The primary goal of any patent attorney should be to fully understand the invention**, including additional and/or alternative embodiments, by the end of the interview. If you need to go over the disclosure again, say so. It's almost certainly better to acknowledge difficulty with a concept during the interview than to pretend it doesn't exist only to have more difficulties later when you might not be able to get in touch with the inventors.
- **Once the meat of the interview starts, don't hesitate to ask questions.** Remember that there are no bad questions. If there is an acronym, a term, or data in the disclosure that you don't recognize, request a definition or an explanation.
- **Make use of your technical background.** If a disclosure refers to some electrical phenomena but doesn't mention others, ask why that is. Inventors may use that opportunity to rethink something. They will usually welcome your insight.
- **Think about claim structure.** If the disclosure refers to an apparatus and a method, the application could have broad and narrow independent apparatus claims along with an independent method claim. If the disclosure includes multiple distinct ideas, identify a generic way to cover all of them in one claim.

Winding down – prosecution

- **If the disclosure relates to a computer-implemented method, there may be a subject matter rejection.** You may want to preempt this by asking the inventors to develop ideas relating to automated tangible actions. For example, if the disclosure relates to health data analysis, request the inventors to develop ideas relating to using analysis results to take automatic therapeutic actions.
- **Let the inventor know that you are playing devil's advocate** and trying to think about the invention the way an Examiner with limited time would. If the invention is a modification of a device that already exists, obviousness rejections are

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likely. Ask the inventors why a skilled person might be dissuaded from making the modification. Ask if there are negative effects or bi-products.

- **If the disclosure does not go into detail on an important aspect, request that the inventors generate additional descriptions.** I'll say: "I don't relish asking you to do this, but it's necessary to develop fall back positions. A hand drawing and a short writeup is enough for me to get started."
- **Try to consider the invention in an abstract sense** and to see if the abstracted invention can apply to other technical fields the inventors may not have considered.

Finish strong – accentuate the positive

- **Set expectations** regarding when a draft can be expected and explain the timeline of traditional patent prosecution.
- **Finish the interview positively.** I suggest that the inventors continue thinking about the invention and let me know if they come up with anything. I encourage them to enjoy the creative process. This message almost always gets through.

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