EXHIBIT 11

Patents: A Most Difficult Legal Instrument to Draft

Written by **Gene Quinn**
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This is one of those articles that I write every so often, in slightly different ways, in order to try and explain to inventors what it is that they need to know before they make an **enormously costly mistake**. For better or for worse, there is a popular conception that patent attorneys and patent agents are not really necessary and an inventor can do it themselves and save money. The truth is that patent attorneys are among the most highly trained attorneys you will ever meet. In addition to having to successfully complete law school and take a State Bar Examination, patent attorneys must have a scientific background or else they cannot even sit for the **Patent Bar Examination**. As **John White** explains, a person becomes a patent attorney when they lack sufficient personality and charisma to do tax work! But when it comes to describing your invention in a document that will grant you exclusive rights with respect to only what is disclosed and claimed, isn't that the exact type of person you want in your corner?

It is extremely common for inventors to make mistakes that will render their hopes and dreams of a patent null and void. I cannot tell you how many times over my career I have talked to inventors who have come up with something special and are now ready to file a patent application. Frequently the story is that the inventor created something several years ago (perhaps more) and they have been using it and people love it. They finally now have the money to pursue a patent and want to get started. Those familiar with patent law know they cannot get started, because rights have irreparably been lost. The only recourse is to improve your magnum opus enough so that it is patentably unique compared to your original invention, which is not something that is typically easy for individuals to do.

Another thing I see with increasing frequency is the inventor who doesn't have much money and who wants to do things themselves. The first question inventors without much money should ask themselves is whether they should even be pursuing an invention. The cost of filing for and obtaining a patent is typically quite minor in comparison to the amount of money required to create, market and distribute the invention. So if you can only muster several hundred dollars and need to file your own application because that is all you have, what are the realistic chances that

you will be able to move forward in the commercialization process? I understand it is prudent to proceed with care and not needlessly waste money, which is why I am happy to work with those who must **start the patent process on a budget**, but a couple hundred dollars is not a budget. You might as well go to Vegas and put it all down on black and let it ride. At least you have close to a 50% chance, which is a greater chance of success than having only a few hundred to spend on your invention.

Then there is the inventor who has a plan, knows what they want to do, is organized, but knows believes patent attorneys are unnecessary. They are convinced that any schmo can draft a patent application after having read **Patent It Yourself**, and patent attorneys are too expensive anyway. We have all heard it, it is not news to us in the patent community, and invariably these inventors get such narrow rights that they are practically useless. I don't mean to poke fun, but I am trying to illustrate a point. Deep down inside everyone has to know that a professional who has spent years of time training, and years of time reading, writing and prosecuting patent applications for 40 to 60 hours a week knows far more about what is required than someone who read **Patent It Yourself**. Right?

On top of this, for well over 100 years courts have marveled at how difficult it is to draft a patent application. Starting in 1892, in the case of *Topliff v. Topliff*, 145 U.S. 156, the United States Supreme Court explained that a patent application is one of the most difficult legal instruments that can be drafted. In this regard the Supreme Court explained:

> *The specification and claims of a patent, particularly if the invention be at all complicated, constitute one of the most difficult legal instruments to draw with accuracy, and in view of the fact that valuable inventions are often placed in the hands of inexperienced persons to prepare such specifications and claims, it is no matter of surprise that the latter frequently fail to describe with requisite certainty the exact invention of the patentee, and err either in claiming that which the patentee had not in fact invented, or in omitting some element which was a valuable or essential part of his actual invention.*

This very same assertion was echoed by the United States Supreme Court 1963 in *Sperry v. Florida*, 373 U.S. 379, when Chief Justice Earl Warren explained:

> *Such conduct inevitably requires the practitioner to consider and advise his clients as to the patentability of their inventions under the statutory criteria, 35 U. S. C. 101-103, 161, 171, as well as to consider the advisability of relying upon alternative forms of protection which may be available under state law. It also involves his participation in the drafting of the specification and claims of the patent application, 35 U. S. C. 112, which this Court long ago noted "constitute[s] one of the most difficult legal instruments to draw with accuracy," Topliff v. Topliff, 145 U.S. 156, 171.And upon rejection of the application, the practitioner may also assist in the preparation of amendments, 37 CFR 1.117-1.126, which frequently requires written argument to establish the patentability of the claimed invention under the applicable rules of law and in light of the prior art.*

Still further, it was recognized by the United States Court of Appeals for the Federal Circuit in 1988 in *Laitram Corp. v. Cambridge Wire Cloth Co.*, 863 F.2d 855, when Chief Judge Howard Markey explained:

> *This appeal again illustrates one of the many difficult dichotomies that lurk in the lacunae of patent law. On one side rests the very important, statutorily-created necessity of employing the clearest possible wording in preparing the specification and claims of a patent, one of "the most difficult legal instruments to draw with accuracy." On the other lies the equally important, judicially-created necessity of determining infringement without the risk of injustice that may result from a blindered focus on words alone.*

Chief Judge Markey had a gift for language that could rival Shakespeare himself. According to **Dictionary.com**, the term "lacunae" means "a gap or missing part, as in a manuscript, series, or logical argument." So not only is a patent application one of the most difficult legal instruments to draft, but patent law has some lurking gaps and missing parts! It is hard to imagine a truer, more fair characterization from the first man to head

the Federal Circuit. If this description of patent law and patent applications doesn't sum up exactly why inventors should seek the advice of patent attorneys, I don't know what will.

Even more recently though, in 2004 in **Chef America v. Lamb-Weston**, the Federal Circuit was issued a decision that will really drive home how important it is to choose your words in order to make sure your words are exactly what you mean to say. In this instantly famous case the Federal Circuit had to interpret the meaning of the phrase "heating the resulting batter-coated dough to a temperature in the range of about 400° F. to 850° F." What should have been said was "heat the oven to a temperature in the range of about 400° F. to 850° F." Because what was said literally required the internal temperature of the dough to reach between 400° F. to 850° F., the patent owner had a useless patent. Inventors need to know that what they say will be interpreted literally. You get great latitude to define the invention, but because it is up to you to define the invention the court will not fix what is said, even when everyone obviously knows what you most likely meant.

In addition to writing for IPWatchog.com, I have spent the last 10 years working with independent inventors and teaching law students **how to pass the patent bar** and how to be patent attorneys. I have taught patent law, patent claim drafting, patent application drafting and licensing. I have come up with a unique process to help coax information about inventions out of inventors through a mentored system called the **Invent + Patent System**. This is an excellent start to the process, and if inventors really put in time and follow the directions they can come out with a really good provisional patent application. But an attorney can always make it better. The reality is that attorneys don't run out of time to work on an application, clients run out of money.

A good patent attorney can always make an application better by spending additional time on the application. You do reach a point of diminishing returns though, so you get to a high level that is acceptable and file the application. But don't fool yourself if you are an independent inventor. While you may need to cut corners to get from point A to point B, patent attorneys are not superfluous. If we were do you really think major corporations and stingy venture capitalists would hire patent attorneys to create and develop their patent portfolio? Of course not. If this were really so easy corporations would have their scientists and engineers, many who have PhDs, do the work. They don't for a reason.

About the Author

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Gene is a **US Patent Attorney**, Law Professor and the founder of **IPWatchdog.com**. He also teaches **patent bar review courses**. Gene has been quoted in the Wall Street Journal, the New York Times, the LA Times, CNN Money and various other newspapers and magazines worldwide

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1. john white **May 5th, 2009 1:21 pm** **edit**

   Gene:

   Inasmuch as I am mentioned, I'd thought my 2 cents might be tossed in. Patent attorneys are, far and away, the most trained, knowlegeable, and competent professional service providers extant. Their threshold of professional ability exceeds the medical and accounting and general legal communities by a wide margin. No other profession requires constant adherence to law (as written and interpretted in muliple venues), rules of practice in multiple forums (PTO, Dist. Cts., and CAFC), technical savvy across multiple disciplines, foreign rights protection in each country where rights may exist, and, all the while carrying absolute liability for error. I challenge anyone in any discipline on this assertion.

   So, you think you can do it yourself? By even pondering the question, you underscore your ignorance of what it is you're attemping. Can you save money by providing good materials with which the patent attorney can work, yes! (See Invent + Patent system and don't be lazy.) But, do not read a book, take a course, and then write an application that you expect will be worth anything. The greater likelyhood is your self-taught efforts will have a rather significant negative impact on value because you will, with certain publication, have eliminated all other forms of protection that cost nothing and forfeited all foreign rights to boot!

   If you're serious about harvesting the value of any invention, start by finding a patent attorney or firm that you can work with and afford.

2. **Gene Quinn** **May 5th, 2009 1:38 pm** **edit**

   Thanks for the comment John. I probably should have made mention of the fact that you routinely joke about the personality of patent attorneys during the PLI patent bar course, and that it is all done in good fun. Patent attorneys are challenged in many ways. As I always say, we have the double whammy of being lawyers and scientists, so we are hardly the life of the party. But ask a question at a cocktail event regarding an obscure Federal Circuit decision and everyone has an opinion. I love it!

   I hope all is well. See you in NY next week for the start of our summer run of patent bar review courses.

   -Gene

3. Thomas Sutrina **May 6th, 2009 11:51 am** **edit**

   About 15 yrs ago I wrote and filed for a patent. I did not go through. At the time I knew a co-worked that was in the process of becoming a patent attorney and three other engineers that also were new or working on being attorneys.

They suggested writing my own. I suspect they would not suggest that now. It was a great learning experience. I can now read claims and understand them and some of the approaches used to create the web of combinations used to extend coverage and block holes.

Would I suggest writing my own patent. I would suggest you do your own search on the google and then the us patent office site. I would suggest that your read and even diagram the claims of the patents closes to your invention. I would even suggest that you sit and outline and then write claims and then write the supporting descriptions. You have done your patent homework.

With some idea about the coverage you would have you can determine the value of the patent and the value of the product. What barriers to entering the market exist that you have get over and does your patent place a high barrier for your competitors? To obtain funding knowledge about the barriers to enter the market and the customer size and reason they will purchase your product will be use to create the elevator one minute pitch and the ten slides of a twenty minute pitch and ten minute question period.

I would suggest getting a patent attorney involved. Now you are in a position to know if the attorney has enough knowledge in the area of your patent to be the proper person. You are now in a position to ask very good questions. You in a position to evaluate the final claims he or she generate. And hopefully the work you have done will decrease the time (dollars) spent by the attorney on your invention.

4. **KrisBelucci June 1st, 2009 8:52 pm** **edit**

   I really liked this post. Can I copy it to my site? Thank you in advance.

5. **Gene Quinn June 2nd, 2009 12:54 pm** **edit**

   Kris-

   If you would like to take an excerpt and provide a link back to my site that is fine, but I would prefer you not copy and repost the entire article.

   Thanks for reading IPWatchdog.com.

   -Gene

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