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Phone: +1 646 783 7100 | Fax: +1 646 783 7161 | customerservice@law360.com

Q&A With Procopio's Miku Mehta

Law360, New York (July 17, 2013, 12:29 PM ET) -- Miku H. Mehta is a partner in Procopio Cory Hargreaves & Savitch LLP's Silicon Valley, Calif., office. His practice focuses on the preparation and prosecution of patent applications before the U.S. Patent and Trademark Office. He has also worked on due diligence projects, including preparation of opinions in the areas of patentability, validity, infringement and product clearance, as well as patent licensing. His areas of focus include technology fields such as computer software and hardware, networks, Internet-related applications, environmental technologies, optics, mechanical engineering, business processes and medical devices.



Miku Mehta

Q. What is the most challenging case you have worked on and what made it challenging?

A. While every case has its challenges, one particular case comes to mind as an example of the challenging situations we can face in patent prosecution. A few years ago, I inherited a patent application from another attorney, who had in turn inherited the case from the original drafting attorney. By the time I had inherited the case, the application had been in prosecution before the USPTO for about five years, which is a relatively long time, given that at the time patents were typically issued in about three years.

Due to the previously made arguments, there were a limited number of new arguments that could be made that would be consistent with what had already been done. To make matters worse, the previous attorney had taken a somewhat contentious approach to the case, and was not available to discuss the case with us. The examiner was also unhappy about the approach that was being taken and the client was frustrated at the lack of progress, and that the application did not reflect the changes in his technology.

Unraveling this situation required first meeting with the client and confirming that the client still wanted to pursue the patent application in its current form. It turned out that there had been a big change in their technology. Fortunately, the specification included subject matter that would allow us to protect their new implementation. When we asked about covering competitors' products, it turned out that the client wanted patent protection in this area as well.

Once we felt that we had a set of claims directed to the client's interests, we then focused on the examination. As the application had not been interviewed, I called the examiner to introduce myself and explain that we wanted to work with her towards allowance. At first, the situation was very antagonistic due to the previous tenor of prosecution. Her response was that she had one of the lowest allowance rates amongst all examiners, and she wanted to keep it that way.

Eventually, we were able to interview the case on the merits. When we had a chance to explain the differences between the prior art and the claims by telephone and then in

person, the examiner opened up. She proposed amendments to allow the application.

What I learned from this case is that it is important to ensure that your client's patent application reflects their business needs, not just when drafting, but throughout the pendency of the application. This case also highlights the importance of examiner interviews, and maintaining good relations with the examiner. With the USPTO opening a branch office in Silicon Valley, we hope to be able to conduct more in-person interviews. We also hope that it gives clients in Japan, Korea and other regions that have a time overlap with the West Coast a chance to more actively participate in the process during their business hours. In the above case, it might have helped if the client had been given such an opportunity.

Q. What aspects of your practice area are in need of reform and why?

A. The America Invents Act has addressed many areas of patent practice in need of reform, including a change from the first-to-invent system to first-to-file, a redefinition of prior art, new patent post-grant patent challenge options, and changes in the fee structure and false marking, among others.

However, there are some areas not addressed by AIA that could still use reform. One such area is the calculation of patent damages: There are uncertainties associated with the current methodologies. Another area involves the closing of the gap between the outcome of *Therasense* and the requirements of 37 CFR 1.56, which might resolve uncertainty with respect to the scope of the duty of disclosure. These areas are in need of reform because the current situation creates too much uncertainty, and may increase the cost of patenting and doing business in certain situations.

Q. What is an important issue or case relevant to your practice area and why?

A. There have been many court decisions over the years that have attempted to define the patentability of software, including the *Bilski v. Kappos* U.S. Supreme Court decision. However, there continues to be uncertainty regarding the appropriate standard for software protection, particularly with respect to claim drafting. A recent case that illustrates the challenges associated with resolving this issue is *CLS Bank v. Alice Corp.*, an en banc decision the Court of Appeals for the Federal Circuit. In this case, a 10-member en banc panel produced seven different opinions concerning the application of 35 USC §101 to software.

The uncertainty is associated with how claims and specifications should be drafted to capture the core technology of software. This uncertainty over the appropriate protection to seek may be further complicated by the eligibility of software for copyright protection, and the wide differences in how other countries treat software with respect to patents.

Resolving these issues would address claim-drafting questions, provide guidance on how to effectively claim software, and address some of the business uncertainty faced by us and our clients in this field.

Q. Outside your own firm, name an attorney in your field who has impressed you and explain why.

A. I am grateful to have had the opportunity to learn the substantive and business aspects of patent law from so many experienced attorneys. There are a couple of attorneys who are good examples.

I have been impressed by John Eisenhart [of Nixon & Vanderhye PC], who was a partner at my first firm, due to his substantive patent drafting skills, and his mentoring ability. John expended considerable time and energy teaching me how to draft and prosecute patent

applications. He taught me the importance of having a methodology and structure for drafting an application, and also how to interact with inventors to understand the core technology without wasting their time, and to ask questions that provide guidance on the business purpose of the patent application.

The training I received from John reminds me that our trade cannot be learned only from texts, seminars or remotely reviewed documents with tracked changes. There is nothing that can replicate the experience of having your claims dissected in-person, followed by a discussion on claim terminology, enablement, or why the client would want such a claim, and then a teaching on these points. When we discuss patent quality, we should recognize the impact of having experienced patent attorneys take the time to mentor new members of the profession, face-to-face.

I have also been impressed by Darryl Mexic (now retired), a partner in my former firm, for his understanding of the international business aspects of patent law and the way he communicated with clients. Darryl continuously built a practice over a period of decades, including his time in Japan. He assembled effective teams of attorneys based on client needs, and developed a workflow based on client directives. It is because of him that I had the opportunity to work in Japan, which has been the best professional and personal experience of my career. He advised me to be patient, build strong relationships, and enjoy the experience.

Q. What is a mistake you made early in your career and what did you learn from it?

A. Very early in my career, I was transitioning from being a software engineer to a patent attorney. At the time, I found myself identifying with the inventors a bit more than I probably should have, and I asked too many questions, and used up the available discussion time too quickly. Because of this tendency, my work product was longer and more detailed than sometimes necessary. As a result, we experienced time and cost pressure.

Once I realized that I was doing this, I changed my approach. I began to emphasize the issues associated with the business reason for pursuing the technology, rather than some of the more academic questions. Over time, and by learning from those around me, I was able to develop an approach that allowed me to be more concise and focused on the business and legal issues.

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