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**ADVANCED CORPORATE PATENT
ATTORNEY TRAINING PROGRAM**

Prosecution Practices: Create synergy with your Outside Counsel

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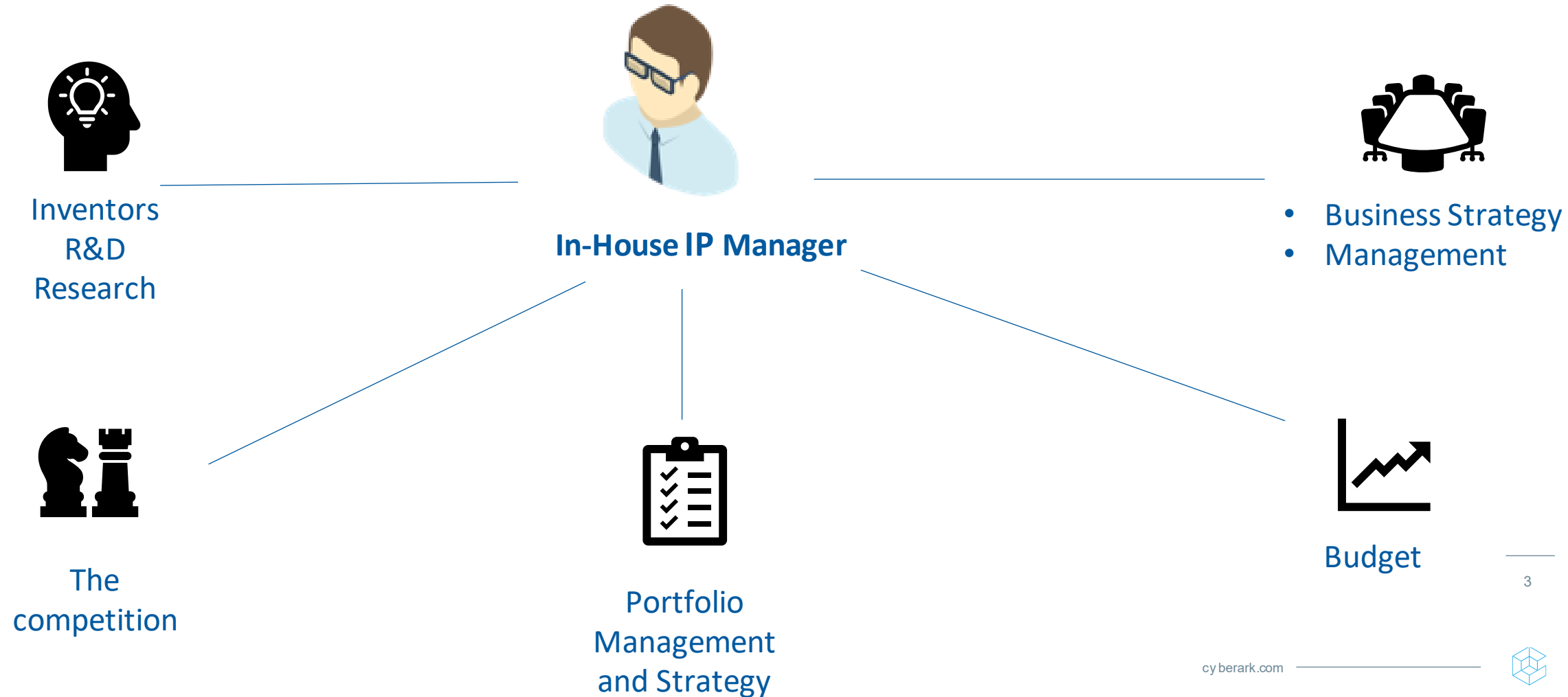
The Goal – Competitive Advantage

Patent Value is the compass

- Strategic alignment, business relevance
- Scope
- Ability to design around
- Detectability (SaaS)
- Enforceability



The IH/OC synergy in prosecution



The IH/OC synergy in prosecution

How does the OC fit in the IP management fabric?

- Legal expertise in each jurisdiction: examination rules, current case law
- Day to day hand-on experience: know your PTO, specific examiners and tribunals, trends from similar cases
- Different POV, devil's advocate



Case Study - The prosecution of EP-X

Background

- Important patent family - key feature, important product
- EP got held back, facing oral proceedings
 - **To complicate things :**
 - The inventor is no longer with the company
 - The current OC: not the drafter, not involved in prosecution until now
 - The closest prior art – own publication re previous system



Case Study - The prosecution of EP-X

The In-House front

- What does the OC need from the In-house team?
 - **Context** : the In-house story, current state of the product, the competition
 - **Guidance**: the business strategy, our goals, the portfolio
 - **Technical orientation**: support from the inventors / relevant R&D team



Case Study - The prosecution of EP-X

What's expected from the OC?

- **Excellent cover of the legal side** – scan for legal mistakes by the examiner, apply current case law

However, even if it were accepted that such a scenario is only envisaged by having prior knowledge of the application, **this can legitimately be the case since these aspects are evidently the non-technical aspects of the subject-matter of the application and according to GL G-VII.5.2**, *"Where the claim refers to an aim to be achieved in a non-technical field, however, this aim may legitimately appear in the formulation of the problem as part of the framework of the technical problem to be solved, in particular as a constraint that has to be met (see T 641/00, T 172/03 and G-VII, 5.4.1)."*

- Tailor the best arguments and tactics to the case at hand
- **Remember the value compass** - alignment between our goals and needs and the actual case at hand
 - support, enablement, achievable scope



Case Study - The prosecution of EP-X

EP-X – Oral Proceedings tactics

- Make the most of auxiliary requests at the EPO
 - Unique feature of the pre- and post grant procedures at the EPO
 - Filed at the same time as the main claims being pursued
- **Apply best practices:** arguments for the Main vs. Auxiliary Req.; convergent requests
- **Keep all alternative claim sets valuable** – scope, detectability, enforceability
- **Plan ahead** - grab-n-go or be prepared to appeal – according to importance, budget



Tips and takeaways

- Synergy is achieved by playing to the strengths of each role
- Patent value is the compass
- Capture and preserve organizational knowledge
- Long term relationship with the OC will have its benefits

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