

STRATEGIC REDUNDANCY

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Redundancy

NASA is famous for providing very high levels of redundancy for mission critical elements. With good reason. *There is a lot riding on it.*



Patent Redundancy

In a patent portfolio, there is great opportunity for establishing a very powerful redundancy strategy, however such tactic is rarely deployed well. In part, due to high cost a patent portfolio rarely includes duplicative efforts. Additionally, multiple claims in a patent give the impression that a redundancy is already being established. However, the multiple claims are most often drawn towards establishing a strong *layered* scope – or onion skin. For this presentation, it is suggested that a different sort of redundancy is underused in patent strategy.

Redundancy Permitted

There is no requirement in law that prohibits prosecution of two patent applications for the same, identical invention. It is entirely ethical to formulate two

independent disclosures which describe and define the same concept – from two complete different points of view. These may be filed as separate patent applications without restriction. These separate applications may be argued with different legal argument, different prior art citations, different examiners and different end results – ie particularly the granted claims set. Each claim set then would have its own distinct strengths and weaknesses.

Double Patenting

In the law, there is provision against 'double patenting'. This may be most easily understood in consideration of two patent applications that have nearly identical claims. Or at least not patentably distinct. In those cases, it is not permitted to have two applications where one has a later expiration date than the other. This rule is intended to avoid extending a patent term beyond the entitled 20 years.

For purposes of this discussion we assume two patent applications for the same concept where the claims *include* patentably distinct differences. Since a very small difference in a claim can render the claim patentably distinct, this bar is not high.

In the case were it is determined that the difference is not patentably distinct, the patentee may elect to simply disclaim the end portion of the patent term so that term is not unfairly extended. A full remedy.

Why Do It?

But why would one do file two patent applications for one single concept? The reason is simple: when one fails, the other may save the day if it does not have the defect of the first. If a second application is prepared by a second independent mind, it is likely to be logically organized in a completely different manner. Thus, where a first practitioner inadvertently incorporates a defect, a second practitioner may not similarly adopt same. Two points of view of the same thing can be VERY unique.

Excitement of Baseball

Imagine telling two independent people completely unknown to the other to each write an essay on the '*excitement of baseball*'. You are VERY likely to get two

completely different results. For example, a first author may write a fantastic description from the point of view of a lifelong fan who enjoys the ritual of game day and going to the ball park with family on a hot summer day. A second author may write from the point of view of a player who spent an entire lifetime preparing for the intense moment that starts with the crack of the bat. Admittedly, these two stories would be very different.

Similarly in a patent effort, one can expect two very different points of view coming from two independent experts having different points of view and background. Where one patent author aims attention on a first aspect, a second author without influence or even knowledge of the first is likely to be highly concentrated upon another aspect. This being despite having the *identical* starting point which may be a common invention disclosure by written document.

What is the end result? If two independent patent prosecution efforts arise from the identical invention disclosure provided by a single scientist, these efforts are most likely to produce a highly different scope of protection with strengths in different areas. Things anticipated and very cleverly defined in a first application will be surely different than the things anticipated and very cleverly defined in the second. It is not that one author is *better* than the other, although that possibility exists, but rather that two equally skilled authors will very likely diverge in their approach simply due to their vision forward that is shaped by their lifetime of experience past.

Mission Critical

Where a technology is considered '*mission critical*' to a company's future, it can be an excellent corporate plan to deploy an IP redundancy - a two path approach to securing maximum breadth in the patent portfolio.

Avoiding Bias

In a patent strategy that includes two parallel paths to protect the same concept, one need not even disclose the existence of the other effort. This can be useful to reduce bias. Once an author knows of the focus or even background of the other patent expert, she/he may be biased into moving his disclosure in some direction or manner.

Instead, it is entirely possible to simply hire a second patent attorney to write an application for the same invention without ever having told her that the other effort is being done.

A common patent examiner is likely to be the first to become aware of such arrangement, but that examiner has simply the obligation to examine both applications putting forth legal arguments for both.

Bad Example

In a very surprising end result, a patent application prepared for UC Berkeley to protect the very remarkable and soon to be Nobel winning science related to gene editing commonly known as 'CRISPR' by Jennifer Doudna and Emmanuelle Charpentier inadvertently omitted a most clearly important application. While the application covers prokaryotic cells – that is cells like bacteria having no nucleus, the application does not cover eukaryotic cells. Surely Doudna and Charpentier imagined that editing plants and animals like mammals would soon become immensely important. It was simply left out of the first told story.

If a second patent writer had prepared an application, he may have anticipated extending the concept into DNA edition without unnecessarily limiting it to bacteria and archaea. In hindsight, that was a HUGE unnecessary limitation incorporated into one of the most important patents of modern biology. MIT/Broad have now already established commercial dominance over the Berkeley patents – but for this tiny mistake that may have been avoided had a second set of eyes been on the topic.

Mission Critical

While it is certainly too expensive to repeat every patent application, for mission critical applications it can be a great patent strategy to duplicate a patent application with two separate writers. It was certainly too expensive for Berkeley to *NOT* deploy this strategy.