

Patent Savvy for Managers: Spot & Protect Valuable Innovations in Your Company

By Kirk Teska

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When the iPhone was unveiled at the 2007 MacWorld convention, Steve Jobs made things clear; “we filed for over 200 patents for all the inventions in the iPhone and we intend to protect them.”¹ Jobs’ statement served dual purposes. Certainly Jobs was playing the role of the salesman and was bragging about the amount of innovation that Apple packed into the new product, but Jobs was also acting as CEO and was assuring his investors that Apple was prepared to assert its intellectual property rights against competitors and, if necessary, defend its new product against claims of patent infringement. Just a year after Jobs introduced the iPhone, at least two infringement suits have already been brought against Apple over the technology.²

In his introductory remarks to *Patent Savvy for Managers* the author, Kirk Teska, states that, “for most businesses, being patent literate is not a luxury, it’s a necessity. Patents are

¹ Ryan Block, Live from Macworld 2007: Steve Jobs keynote, www.endgadget.com (posted Jan 9th 2007 at 12:00pm), available at <http://www.engadget.com/2007/01/09/live-from-macworld-2007-steve-jobs-keynote/>. See also streaming video of Keynote address Macworld San Francisco 2007, Apple Inc., www.apple.com/iphone/keynote.

² See Rachael Metz, Apple, AT&T sued over "visual voicemail," *The Boston Globe* (Dec. 3, 2007), available at http://www.boston.com/business/articles/2007/12/03/apple_att_sued_over_visual_voicemail/ (patent holding company seeking an estimated \$360 million in damages and future royalties from Apple and AT&T alleging the "visual voicemail" feature on the iPhone infringes two patents). Hiawatha Bray, Mass. man suing Apple over patent, *The Boston Globe* (Feb. 28, 2008), available at http://www.boston.com/business/technology/articles/2008/02/28/mass_man_suing_apple_over_patent/ (independent inventor claiming iPhone infringes patented caller identification technology).

everywhere, and business owners and managers ignore patents at their peril.”³ Indeed, when Research In Motion (RIM), the maker of the Blackberry, lost a jury verdict for patent infringement that threatened the immediate shutdown of the Blackberry mobile email service, many people in business and government realized, perhaps for the first time, the power of injunctive relief in patent cases. The story of the Blackberry litigation makes for an interesting read and indeed, Teska devotes an entire chapter of *Patent Savvy for Managers*, aptly entitled “Live and Let Die: The Exhausting Effects of Patent Litigation,” to the Blackberry litigation. The author recounts the various phases of litigation, dissects each party’s moves, and offers a post-hoc analysis of strategic decisions from a legal as well as business perspective.

In addition to the in-depth treatment of the Blackberry case, Teska offers several case studies throughout the book including synopses of three classic patent litigation cases involving well-known companies: *Gillette v. Schick*, *Amazon.com v. Barnes & Noble* and *John Deere v. Toro*. Each case highlights a peculiar aspect of patent law and the three cases together illustrate the vagaries (“sometimes a crapshoot and always expensive”) of patent litigation.⁴ To guide the reader, Teska prefaces each of the case studies with a bottom line, a rule and a caveat and offers background information on the companies. Teska also throws in a case from his own practice to illustrate the point that for some companies it may be less costly to change the product than to fight a claim of infringement in court.

Technology and consumer electronic companies likely seek patent protection in the U.S. and many other countries because these companies manufacture and distribute their products globally. The back of the popular iPhone for example, reads in small, laser-etched letters,

³ KIRK TESKA, *PATENT SAVVY FOR MANAGERS: SPOT & PROTECT VALUABLE INNOVATIONS IN YOUR COMPANY* 6 (2007).

⁴ *Id.* at 46.

“Designed by Apple in California. Assembled in China.”⁵ This is a sign of the times. These days, much of the manufacturing occurs overseas according to designs and under license of technology developed in the U.S. The success of today’s U.S. economy in the global marketplace builds largely on the protection of intellectual property, in particular a strong patent system.⁶

Teska wants the reader to think of patents in terms of business and as one of the most valuable assets in the U.S. economy. By viewing a patent as business proposition managers are able to apply familiar cost-benefit analysis when deciding if, when, and how to patent.⁷ Indeed, the issue of costs versus benefits is a common thread throughout the book. Teska includes tables and graphs to educate the reader as to what kinds of costs are likely to occur at different stages of the patent process. The average costs to secure patent rights in the U.S., which includes a prior art search, filing and prosecution expenses, range from \$20,000 - \$30,000. Additional costs occur over the lifetime of a patent for maintenance. Filing in any foreign country may easily double these costs and, should the patent give rise to litigation, companies may need to pay \$1-3 million to assert their rights in a full-blown trial.⁸

The author’s writing style is direct and informative making the book a quick and entertaining read. Sidebars, charts and bulleted text provide easy access to information and allow for flexible reading depending on the reader’s background and objectives. A personal favorite of mine is the section entitled “Anatomy of a Patent” in which the book makes excellent use of both visual and textual information to introduce the reader to the various sections of a

⁵ See Galleries: iPhone first hands-on and unboxing, [www.engadget.com, http://www.engadget.com/photos/iphone-first-hands-on-and-unboxing](http://www.engadget.com/photos/iphone-first-hands-on-and-unboxing).

⁶ TESKA, *supra* note 3, at 6.

⁷ TESKA, *supra* note 3, at 6.

⁸ TESKA, *supra* note 3, at 71.

sample patent document and how to read them.⁹ By overlaying his comments and explanations directly on images taken of an actual patent (the Amazon “1-Click” patent) Teska adds realism and immediacy to the information contained in this section.

The author writes from the perspective of a practitioner as well as a teacher of patent law. Indeed, he has many years of experience in both areas. Teska is managing partner of the intellectual property law firm Iandiorio, Teska & Coleman and a freelance writer.¹⁰ He is also a professor at Suffolk University Law School, where he teaches courses in patent claim drafting and software law. Teska’s teaching experience is evident in his ability to break down complicated matters, such as patent claim language, into bite-size chunks, which he then presents in an informal and interactive way. The reader is essentially enjoying a personal lecture on patents and patent law peppered with anecdotes and tips from Teska’s own practice as an attorney.

Although managers, who may have a background in business, science or engineering, are Teska’s target audience, law students, new associates, and in-house counsel will nevertheless find this book extremely useful. It explores the business side of patents and offers tips and caveats from a seasoned patent attorney. Teska orients the reader early on in the text, dispelling patent myths (e.g. “You can file a worldwide patent,” “Most patents have commercial value”), proclaiming patent truths (e.g. “A patent alone does not make you money,” “All things patent are costly”), and comparing the lifecycle of a patent to that of a typical product.¹¹ Aspiring attorneys will also appreciate the real-world case studies and detailed description of tools to

⁹ TESKA, *supra* note 3, 85-104.

¹⁰ Teska writes patent law columns for Mass High Tech and Lawyers Weekly and regularly contributes articles on intellectual property to IEEE Spectrum and other publications. *See also* TESKA, *supra* note 3, back cover.

¹¹ TESKA, *supra* note 3, chapter 1.

manage patent portfolios and associated costs found throughout the book. For example, Chapter 7 entitled “The Good Shepherd: Patent Prosecution and Management,” describes what happens once a patent application has been filed and what additional costs may occur. The chapter lays out basics of patent prosecution, i.e. the process of steering a patent application through the U.S. Patent and Trademark Office, and how to keep track of patents after issuance. Teska guides the reader with a sample spreadsheet for tracking action items and costs for the family of patents associated with a given project. The tone and the presentation of the various chapters, including sidebars and timelines, provide a fun and refreshing look at patents that contrasts nicely with standard legal textbook fare.¹²

Mindful of his target audience of business professionals and in keeping with the informal and straightforward style of the text, Teska generally avoids citing to any legal sources.¹³ Some readers, however, may want to directly look at relevant case law and secondary sources. Those readers would have benefited from a brief listing of references at the end of each chapter. This would neither disrupt the flow of the text nor noticeably increase the length of the book, but add valuable information for those who want to dig deeper. To put it in cost-benefit terms, the benefit of adding references to the end of each chapter, a feature that would increase the appeal of the book to readers that crave further information, outweighs the cost, i.e. the cost of extra editing time and page length. Even in its current form, the book supplies a few lists of resources,

¹² Case in point: Many chapters and sidebars have witty and provocative titles. *See, e.g.*, “What to Do When Your Candy Bar Melts: Capturing Patents” TESKA, *supra* note 3, 129; “Who are Patent Examiners, and Why Are They so Unhappy?” *Id.* at 183.

¹³ The author, however, does not strictly adhere to this rule. *See* TESKA, *supra* note 3, at 55-58, 64, 179, 264 (providing in-text references to several U.S. patents, a book, and two court opinions).

including Internet addresses for searching patents and for researching commercial potential in foreign countries.¹⁴

Patent Savvy for Managers is a concise and easy to read reference guide to patents and the patent system. Teska's stated goal is to explain how patent law works and to give the reader tools for spotting, protecting, and preserving patentable inventions, while managing the associated risks and costs.¹⁵ He accomplishes this by providing interesting case studies and by teaching readers techniques and strategies on how to read a patent, identify and protect patentable inventions, manage and maintain patent portfolios, and deal with patent infringement and patent claims. An excellent resource for business and industry managers, this book is an equally fun read for law students and lawyers interested in the business side of patent law.

¹⁴ TESKA, *supra* note 3, at 162, 205.

¹⁵ TESKA, *supra* note 3, at 2-3.