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Q&A With Knobbe's Ron Schoenbaum

Law360, New York (May 22, 2013, 4:42 PM ET) -- Ronald J. Schoenbaum is a partner in Knobbe Martens Olson & Bear LLP's Orange County and Silicon Valley, Calif., offices. He focuses on patent prosecution, strategic patent portfolio management, and infringement/validity studies for information technology companies. As part of his practice, he frequently conducts in-house sessions with software developers and engineers to help clients identify and prioritize patentable inventions. Before law school, Schoenbaum obtained a masters degree in electrical engineering from Cornell and then worked as a design engineer for IBM. He joined the firm in 1993.

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

A: Our firm was recently asked to analyze a portfolio of over 1,000 patents in less than one week. Our client was considering placing a bid on the portfolio, and wanted us to rate and summarize each patent — and the portfolio as a whole — in terms of various criteria (quality, claim scope, relevance to industry, relevance to specific competitors, etc.). The most challenging part (aside from staying awake while reading patents late at night!) was to assemble and manage the large team of attorneys needed to complete the task. These types of short-fuse due diligence projects are becoming fairly common, but are always very challenging.

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

A: U.S. patent examination quality remains unacceptably low, especially for IT inventions. Many U.S. Patent and Trademark Office examiners are very well qualified. One key challenge, however, is for the patent office to consistently ensure that all patent examiners have an adequate understanding of the relevant areas of technology and be able to generate well reasoned decisions. The root cause of this problem is inadequate PTO funding. Without the full support of Congress in addressing this issue, we cannot expect to have a strong patent system.

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

A: The U.S. Supreme Court or Congress needs to articulate a better standard for determining the patent eligibility of software implemented inventions, and especially business methods. The Supreme Court largely punted on this issue in its Bilski decision by reiterating the “abstract idea” standard without attempting to define “abstract.” This vague standard has led to many seemingly inconsistent court decisions, and has driven some Federal Circuit judges to express frustration over the lack of a clear test. The Federal Circuit recently attempted to tackle this issue en banc in CLS Bank v. Alice Corp, but failed due to a lack of consensus among the judges.

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

A: I am very impressed by former USPTO Director David Kappos, and especially by the significant improvements in examination efficiency and fairness he brought to the USPTO. Before his tenure, many examiners (especially in the IT and business methods art units) would routinely and repetitively reject applications with no valid basis for doing so — perhaps out of fear of losing their jobs for issuing a controversial patent. When an applicant would appeal the meritless rejection, the examiner would simply re-open prosecution with a new (usually baseless) ground for rejection, depriving the applicant of the right to an appeal.

When David Kappos began as director in 2009, he quickly put an end to this practice, advising the examiners by email that "patent quality does not equal rejection." He also modified the examiner quota system to encourage examiners to resolve issues more efficiently, and he encouraged examiners to conduct more interviews. Thanks to these reforms, deserving applicants can now obtain patent protection much faster, and are less likely to incur significant legal costs for responding to baseless rejections.

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

A: In my first two-plus years of practice, I prosecuted a number of patent applications without conducting an interview with the examiner. After finally conducting a few interviews, I realized that I can usually get the patent issued faster and less expensively (and frequently with broader claims) if I conduct a personal or telephonic interview early in the examination process.

Today, I conduct an interview (or coach an associate on conducting the interview) in almost every application I handle. I occasionally come across entire patent portfolios in which no interviews were conducted, suggesting that some practitioners have not yet discovered the benefits of interviews.

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