



Mesmer & Deleault, PLLC

41 Brook Street, Manchester, NH 03104
Seacoast Office: One New Hampshire Ave., Suite 125
Portsmouth, NH 03801



Memorial Day

“Tip of the Month”

The Tortoise and the Hare ~ A Patent Prosecution Parable ~

The recent holiday brought the parable to mind and resulted in the following stylized retelling of a real-world scenario. (For more information, check this tip on our website for links to the Original Case *Mirror Worlds v. Apple*, the Patent ‘Hare’, the Patent ‘Tortoise’, and the Twenty-Five Million Dollar settlement.)

An Applicant had to choose a patent to run in the Infringement Race between two patent applications, which we will call the Patent Hare and the Patent Tortoise. As the nicknames suggest, the Patent Tortoise was slower and sturdier. During the qualifying race (also known as the Prosecution Race), the Patent Tortoise would deliberate before taking each carefully-analyzed step towards the finish line. The Patent Tortoise even made amendments to his planned path based upon the commentary from race officials (also known as Examiners). The Patent Tortoise persevered through a grueling Prosecution Race. Unlike the Patent Tortoise, the Patent Hare was so much faster that the Prosecution Race was completed in record time. Basically, a sprint to the finish. Afterwards, the Patent Hare laughed and said, “That Patent Tortoise is so slow! He’ll never be any good, why does he even bother?” The Applicant was tempted to simply abandon the Patent Tortoise during the Prosecution Race but ultimately decided to persevere, and the Patent Tortoise eventually completed the Prosecution Race.

Finally, it was the day of the Infringement Race, the Judges gathered, and the Patents stepped forward to win ‘first place’ and claim the prize. However, the Infringer no longer wanted to part with the Royalty Trophy, and wanted to keep the prize money for itself. The Infringer knew that it couldn’t count on preventing every Patent from completing the Race, so instead, the Infringer tried very hard to disqualify each of the Patents from the Race, so that no one could be declared the winner. The Infringer searched and searched and finally discovered that the Patent Hare only completed the Prosecution Race so fast because it zoomed through the Race Official Examiner discussing the prior art requirements. When the Judges reviewed the Prosecution Race, they agreed, and the Patent Hare was disqualified from even competing in the Infringement Race. No matter how hard the Infringer tried though, he could not find any basis for disqualifying the Patent Tortoise. In desperation, the Infringer went to the Applicant and offered the prize money, in exchange for keeping the royalties trophy, and the Applicant proudly agreed. The Patent Tortoise turned to the Patent Hare and said,

“You may be faster and flashier, but slow and steady won the prize.”

So the next time you are considering whether to persevere or sprint, ask yourself whether the hurdles you encounter might not be worth bringing home the trophy.

If you need help with patenting your inventions, please do not hesitate to give us a call at 603-668-1971, or contact us by e-mail at mailbox@biz-patlaw.com to schedule an appointment.

Frank B. Mesmer, Jr.
Robert R. Deleault
Joshua N. Mesmer
Sarita L. Pickett



(603) 668-1971

Fax (603) 622-1445

E-mail: mailbox@biz-patlaw.com

Website: www.biz-patlaw.com