

Inventors' Network

Volume 8 New <http://inca.hispeed.com>

of the Capital Area [INCA] Issue 2 [Was <http://inca.interspeed.net>]

Meeting is 7 Feb 00: 5:30 Networking, 6:30 Presentation & responses - 7:15 Member Issues

Ray Gilbert Pres (703) 971 9216 Phill Shaw Treas (703) 751 3422 Bill Kuntz VPres (202) 638 4988
Current Directors: Web Master - Raoul Drapeau, (703) 573 6055 ; Hospitality - Jerry Porter (301) 962 8491
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Membership, Call *Maurice Daniel* 703 931 2940 h Speaker-Host, Call *Denny Lennon* 703 620 5200
At-Large-[Conferences] Call *Allen Wood* 703 243 2774 h Asset-Oversight , Call *Tom Moseley* 301 384 6814 h

Our January 10 Program presented views by two of patent attorneys from within INCA. **Mr Nick Bromer** characterized how the inventor and the Patent Attorney/Agent (PA) ideally have different objectives and different styles in teaming to make a strong patent application.

The inventor draws and writes a specification that is specific as possible about his invention.

More is better.

The PA expresses claims as general as possible.

Short is best.

The inventor is well served to write so clearly that others in his field understand both the nature and the specifics of his invention. Descriptions need to be supported by graphics.

“A picture is worth a thousand words”.

The inventor also is well served to examine prior art personally, so that he can distinguish the essential differences between what others have expressed and what he considers to be his own.

If you find patent that describes the technology well, incorporate it as a reference.

Inventor's direct costs, as well as the court-safety of his property can be optimized by writing a clear and complete specification before its review by a patent attorney.

For example, both might consider who will be reading the patent.

*If jurors might need to read it, unusual clarity, as perceived by a common citizen may be unusually valuable, and worth some editing effort.

*If a potential customer might need to read it, the same clarity is valuable, as is exacting accuracy in description, data and implications.

An authoritative resource for both inventor and PA is the Manual of Patent Examining Procedure (MPEP). This document defines the rules and practices that the patent examiner must follow. Pressman's "Patent it Yourself" offers guidance to the inventors who want to minimize professional costs of their patent attorney.

Mr Allen Wood instructed about office actions and post-application responses that are expected in most prosecution of intellectual property. He defined the shorthand terms that relate to law and regulation sources cited in most office action letters from the examiner to the inventor/PA team. He also outlined the terms that demand timely action by the applicant:

- * "Restriction" is a term that demands a decision by the applicant, usually within 30 days. A USPTO letter asserts that the claims of an application are considered to be directed to different inventions. The applicant is to elect which invention to prosecute in that application, but may file a "divisional" application (or applications) for the other invention (or inventions). (Ref MPEP 201.06 and chapter 800).
- *Rejection - anticipation: The examiner asserts that claims offered in the application "read on" a particular prior art "reference" (for example, an earlier patent or a technical article or even a newspaper story).
- *Rejection - obvious: The examiner asserts that an ordinarily skilled person would have been motivated to combine or modify features disclosed in one or more prior art references so as to produce a method or apparatus on which the claims of the application would read.
- *Rejection - inadequate disclosure: The examiner asserts that one "ordinarily skilled in the art" would be required to do too much experimentation to make this work. The examiner may not understand the invention, either. [Where references have been cited or "incorporated by reference" in the application, what the references disclose becomes part of the disclosure of the application itself].
- *Rejection - "double patenting": Where an inventor already has a claim in an earlier patent that is the same as a claim in a later application, or a claim in a later application that is an obvious variation of a claim in an earlier patent.
- *"Ex parte Quayle": The examiner is ready to allow the application but minor alterations are still needed.

Allen shared a "terms" handout and illustrated how claims might be combined or amended to overcome the rejections cited in a first office action.

NICK and ALLEN's "before and after application" shared the importance of "more" information within the application package. Specifications that are sufficiently detailed permit flexibility by the claims writer in amending or substituting claims without requiring prohibited "new matter".

Independent inventors can minimize the billed hours from their patent counsel by:

Cooperating in assuring that the specification is easy to read and sufficiently detailed to understand and make happen;

Volunteering to "staff" a first action package from the examiner,
to make sure that examiners comments about cited art are correct;
to validate that claims, plus specification details do not actually read on cited references;
to summarize and to cite the differences between cited references and claims; and

Returning finished work at least 1 month prior to end of first 3-month response time.

Our Feb 7 Program is on the F I R S T Monday.

Denny Lennon has arranged for the vice president and chief technical officer of Xybernaut, **Mr Michael Jenkins** to be our speaker. Mike is a co-founder of the Xybernaut corporation, and leads the new product formation strategy team and their intellectual property program. He was instrumental in the development of the Mobile Assistant and currently holds nine issued patents including several of the key Xybernaut patents.

Mr Jenkins has also held positions in companies such as Educational Research Service, Unisys and MCI; working in disciplines such as software development, operating systems and database design.

He manages its Intellectual Property, participates actively in the engineering and specification-writing activities of this patent-oriented corporation and works directly with their patent counsel.

The Xybernaut corporation is based on the idea and intellectual property supporting customer needs for a “wearable computer”. Their business is international, requiring extensive travel by their executives.

See <http://www.xybernaut.com> web page to prepare questions for a knowledgeable patent strategist for this modern technology business.

Our Mar 20 Program will renew our pattern of T H I R D Mondays.

Don Kelly is our speaker. Until March he has been director of USPTO’s young “Office of Independent Inventors Programs”. He is now the CEO of Academy of Applied Science (AAS), and will be establishing the Washington DC office of this science and invention not-for-profit organization. [Read more about Don’s new role on page 4]

INCA BUSINESS

Our March meeting includes our annual INCA officer selection. Last year (1) we added a Vice President role for Bill Kuntz, (2) we welcomed Phill Shaw to continue as Treasurer; and (3) Phill conducted a nomination and vote for the President role.

As Ray Gilbert extended a temporary president role into a regular tour-of-duty, he became even more impressed with the flexibility of the INCA-member volunteering-process. Many have stepped forward to perform tasks that they sensed as needed. Their actions illustrate the delightful power of this innovative and thoughtful association. Its president gets to share in National recognition and wonderful invitations.

Between February and March 8, volunteers for FY 2000 President, Vice President and Treasurer are sought. Phill (703) 751 3422 phillshaw@erols.com will accept volunteer recommendations for self-nominated and other-nominated slate of officer-candidates. Candidates will be listed in the March newsletter and will be invited to make a brief candidate-mission statement at the March meeting.

Our March discussion-among-members will be open for ideas about:

- * current vision of the future of INCA Inventors,
- * the future of INCA impact upon our properties and our lives, and
- * currently-desired type of programs and presenters.

WEB SITE ADDRESS CHANGE:

Before the end of February, our website will answer to <http://inca.hispeed.com> as well as to our older name. Notices will include e-mail messages from Raoul as well as a pointer on <http://inca.interspeed.net> giving the new address.

GOOD NEWS AND PART OF ITS PRICE:

The good news is that one of our charter members, Don Kelly, is becoming the Chief Executive Officer (CEO) of the Academy of Applied Science (AAS), and will establish its Washington DC office. [go to www.aaa-world.org]

The AAS was founded by Robert H. Rines who performed for the benefit of all of us this summer in rewriting, in a short-period invitation of representative Henry Hyde, the House legislation for patent law. Dr Rines helped the law to be friendly to independent inventors.

One of the affiliates of AAS is the United Inventors Association of the USA (UIAUSA) [go to www.uiausa.com]. They already have invited INCA to accept a free one-year subscription to a greatly-expanded services for inventor groups.

Don will be leading an expansion of AAS to promote the interest of youth in the world of applied science and invention. He will establish the Academy as a global forum involving Intellectual Property protection.

One price we may feel from this change in roles, is that Don will be stepping away from his USPTO new Office of Independent Inventors Programs. Fortunately, Don retains friendships from wherever he has been.

EDUCATION:

The Harvard Business Review, Jan-Feb 2000 has a startling article, **“Discovering New Value in Intellectual Property”** p54. [Rivette & Kline]

Within 10 years, IBM’s rate of \$30 million in Royalties [1990] has grown to approximately \$1 billion (per year) royalties [1999]. This may help explain why IBM is the number one receiver of patents from USPTO.

A growing group of business leaders are using Intellectual Property as a line-item income base to initiate new levels of financial success. Firms cited in this article include Microsoft, Lucent, IBM, Dell, Dow Chemical Gillette, Texas Instruments and Xerox. Now the manager of White Oak Growth Stock Fund uses patents as a measure of productivity to help account for that fund’s growth of 32%/yr over 5 years.

Serious inventors and invention managers will want to read “Rembrandts in the Attic” (Unlocking the Hidden Value of Patents) by Rivette & Kline.

In 1972 about 5% of patents were issued to start-ups and other first-time patentees. By 1992 the number had grown to 23%. A Harvard research study of 1997 showed that small firms produce 15% of all patented innovations although they invest only 3% of R&D funding of the large corporations.

Small inventing entities can protect their property now through patent attorneys who work on contingencies and some affordable** patent insurance. While 155,000 patents are issued per year, only about 2,000 patent suits are filed, and only about 100 cases end up in court.

Economist Lester Thurow attributes the strategic value of patents: “skills and knowledge have become the only source of sustainable long-term competitive advantage.”

Rivette and Kline’s book needs to be on every inventor’s drafting table.

It costs less than \$20 plus postage at AMAZON.COM

BUSINESS WEEK www.businessweek.com/smallbiz/news/coladvice/ask/ak980903.htm

Patent insurance from an investor’s viewpoint was discussed by Jonathan B. Levine.

“-It is increasingly common for investment firms to require patent-infringement insurance” to cover costs of defense and of “enforcing your own patents against infringers”.

Many standard business liability policies also cover patent-infringement defense. But don’t count on it. Robert Fletcher of Intellectual Property Insurance Servicers Corp, Louisville Ky suggests that serious patent coverage warrants a limit of at least \$.5 - 1 million. US Premiums reflect the litigiousness of your product’s industry.

BusinessWeek on line invites questions about running your small-business. Bizweekqna@aol.com

FEB 2 & 3 conference on Intellectual Property by guests of Board on Science Technology and Economic Policy, The National Academies.

Lecture Room, National Academy of Sciences, 2100 C St NW Washington DC

Registration is complementary by fax to 202 334 1505, call Craig Schultz @ 202 334 2200 or fill out form on www.nationalacademies.org/ipr

CRAFTING AND DRAFTING

Professor Kayton, www.patentresources.com, has announced his 3-day course, Crafting and Crafting Winning Patents to be delivered in Washington DC on August 8 - 11. Its fee is \$1,595, and if you want additional material to help decide, you may fax a request to PRG (804) 296 3999 for a free copy of his 33 page “Overview of Crafting & Drafting”.

TRIZ dclark@ideationtriz.com offers a free e-mail subscription to weekly Inventive Principles. Dana Clark at Southfield Mi operates a consultant service that utilizes the Altshuler principles that were gleaned from an analysis of 2 million patents. With the free e-mail subscription is an

invitation to join the International TRIZ Club at www.trizclub.com. Further delving into the online TRIZ store provides a catalog of business offerings for tools to assist the inventive process.

MARKETING

MARKET LAUNCHERS of St Louis Mo (800 337-5758) report that they are looking for new products to sell through TV commercials and/or infomercials. Their client, Grove Products of Cincinnati works with inventors by paying for the cost of manufacturing and marketing the product. Reportedly, there is no cost to the inventor, but a royalty from sales.

Consumer products sought include: housewares, food processors & appliances, exercise eqpt, sporting goods [golf & fishing], cleaning and home-repair products, plus how-to tapes or self-help tapes. See www.Groveproducts.com and www.MarketLaunchers.com

Wall Street Journal of Dec 15, p B1 & B6 reported that “**People with Disabilities Are Next Consumer Niche**”. [<http://services.wsj.com>]

16.3 million people have mobility dysfunction. 13.6 million (kk) have limited hand use.
9 million have cognitive disabilities. 7.4 kk have hearing and 6.5 kk have visual disabilities.

Disabled people say, “We Have Money and Want to Spend”.

Of persons living in households with annual income of at least \$50,000,

15% have hearing disabilities;	12% have speech and language deficiencies;
9% have visual problems;	9% have limited hand use;
8% have cognitive disabilities; and	7% have mobility deficiencies.

Some potential invention-client companies might include: Johnson & Johnson, Microsoft & AOL.

Entrepreneur magazine of Feb, p 40:

Power of Convenience: 51% of Americans agree they're willing to pay extra for a product or service --- if it will make life easier.

Senior citizens “on-line” has grown from 600,000 in 1995 to 13 million in 1998.

Seniors appreciate larger typefaces and avoidance of clutter.

Ann Wrixen of SeniorNet says, “When we consider what these people have lived through, we realize that they are risk takers. They have more time and more life experience. They're really willing to try new things.”

FINANCE: Thunderbolt Capital Corp www.thunderboltcapital.com is a Venture Capital firm of Northbrook Il with initial investment of up to \$250,000; second round private placements between \$1-5 million and if things work right, possibly an I.P.O.

Thunderbolt is seeking companies with patented/proprietary products having sustainable competitive edge and rapid growth potential. They have contacted presidents of inventor groups to introduce their potential contribution to high tech inventors. They offer assistance in market development, sales distribution, research and manufacturing. (847) 412 1000

Patent Cancellation Alert is sent by a proprietary service to owners whose property was issued 3 years ago. For \$100, this service offers to “help you renew your patent”.

How an inventor can help himself in paying the maintenance fees:

So far, the USPTO has not introduced a service to advise patent owners that their maintenance fees are due. However, www.uspto.gov home page offers “printable forms” and PTO fees.

Click on PTO Forms to be offered an Adobe free Acrobat reader, which can be installed on your computer, if it is not already there.

Scroll down on Forms page to PTO/SB/45 Maintenance Fee Transmittal Form and click on number PTO/SB/45 to see an adobe page and then a picture of the form.

Click “print” to get a copy of your PTO/SB/45 form.

On home page, click on PTO fees, then click Download of current PTO fees.

The Jan 10 2000 adjustments can be read from the display, or printed.

Patent Maintenance fees due at 3.5 years are \$415.00 for small entity.

Late payment within 6 months costs an extra \$65.00.

Please note: After expiration (3.5 + .5 = 4 years) a surcharge for “unavoidable” delay is an extra \$700.00 and for “unintentional delay is an extra \$1,640.00.

PTO TODAY is an online Magazine for PTO’s Customers. First copy was 14 Jan 00.
www.uspto.gov/web/offices/ac/ahrpa/opa/ptotoday/ptotoday01.pdf or click from uspto home page.
Editor is ruth.nyblod@uspto.gov (703)305 8341 Crystal Park 2, Suite 0100 Wash DC 20231

Effective Nov 29, 2000, patent applications also filed abroad will be published 18 months after U.S. filing date, unless the application requests otherwise upon filing and states that the invention has not been and will not be the subject of an application filed in a foreign country.

Online Dialog with the Commissioner is scheduled for Thursday, Feb 10, 2000 between 1:00 p.m. and 2:00 p.m.. Log on to PTO Web site after 12:45 and click on home page link marked “Online Conversation with the Commissioner” and follow the instructions.

Don Kelly’s Office of Independent Inventor Programs has initiated an anti-scam campaign of media spots for voluntary broadcasts by radio and TV stations. PTO also has sponsored paid announcement in cities in the states of Florida and California where such scams are rampant. PTO will register complaints along with promoters responses, making them visible to other inventors and small businesses . Contact is IndependentInventor@uspto.gov or (703) 306 5568

Bottom Line::: If the code beside your name does not say 12/00, it is time for

*your check of \$36 for local membership status, or

* your check of \$10 for mail-only

subscription.

Our INCA address is shown below.

Raoul has done it again!!!! He has arranged for INCA to be part of a pilot project for electronic transmission of patent applications (EFS). Applications within the pilot project must be in Wordperfect 9. The pilot project has made a copy of this software available to INCA, through r-drapeau@usa.net (703) 573 6055.

Patent values

U.S. Corporations may earn Significant % profit from licensing their patents.

IBM reports \$1B/yr from Patent Licensing.

Texas Instruments between 1987&- 1994 collected \$1.9B royalties Vs. Operating Income \$1.3B

. * Afuah, Allan Strategies to Turn Adversity into Profits Sloan Management Review Winter 1999, p106

Patent policies:

Some University inventors may retain up to half of commercialization benefits.

Some corporations reward inventor team members:

\$1,500 at application + \$ 750 at assignment, plus \$7,500 for every 10th invention.

Average: \$3,000 for participation in invention.

Federal research employees may now participate in commercialization royalties of 15% with up to \$150,000 per year/patent.

Letter from Craig Rasmussen, Sat. Sem June 12 99

I met a man who was a little discouraged because he has presented his idea to quite a few companies and all but one, the last one, haven't been able to "see" the advantages. This should be addressed at INCA.

Many people have a great idea but become discouraged before they can convince someone else about it. I like to look at history and tell others about people who had fantastic ideas but nobody seemed to pay attention.

Robert Goddard was a professor at Texas A&M. He tried for twenty years to get the U.S military interested in rockets, but to no avail. At the end of WWII, Werner Von Braun was invited to come to the United States. He had developed the V2 rocket and had almost won the war for Germany with it.

When he was asked about his techniques and his research, he was astonished to find that the U.S.

Military had never heard of his hero, Robert Goddard or his pioneering work in rocket science.

Von Braun .

INVENTOR TECHNOLOGY:

-about Claims. Claims are the property within a patent. A candidate licensee will usually examine a patent's claims to determine if this property fits within his business and would add value to the business.

Note: Provisional applications do not include claims.

Their low fee of \$75 does not include provision for a USPTO patent examiner's time and judgment. If an inventor expects an application to result in an award of intellectual property, the application must be for a utility, a design, or a plant patent.

-about utility patent's "broad, independent claims":

Convention in writing and in examining claims is to expect the first offered claim to be the most broad.

It lists the minimum component or step means to achieve a solution to a prior-stated problem.

In minimizing the number of components or steps, the breadth of the claim may read on prior art not yet recognized by the inventor or his team. A first office action often challenges claims as being too broad.

The examiner may suggest narrowing the initial claim by adding restrictions cited in dependent claims.

It may mix elements from prior art with new elements.

It will use the most-broad terms for each element.

It will be considered an independent claim because it does not depend on a prior claim.

Clarity in claim-writing will express a claim title prior to use of the usual word "comprising".

Then the component major parts or means are listed (and numbered). The claim is made complete with a "wherein" expressions that link each of the listed components to the other components or means with terms such as "connects to" or "communicates with".

Many writers want to be sure that a reader of their claim will understand "what the aforementioned components and means do" or what functions are to be achieved from the apparatus' and/or method's structural description.

A "whereby" expression may be added to the end of a claim. It may include functional language as a means of enhancing communication, but the whereby expression cannot add structural property to a claim. It merely recites an objective.

About more-specific dependent claims:

One claim-writing strategy would write as broad as possible initial, independent claim, and let a series of claims, each dependent on the first one, further define specifics relating to a component or means of the first claim. Examiners may call these specifics a limitation, and explain that the independent claim, when read against an earlier patent (prior art)

A dependent second claim might be:

2. a

described claim's disclosure, which is the components of a claim immediately after the introduction that concludes cite limiting aspects of each element that further describe the unique character of each element.

[If the examiner finds prior art that seems to anticipate all elements of a most-broad claim, further definition is simple by combining supportive claims into the language of the most-broad one.]

-about narrow, dependent claims:

Supporting broader claims with multiple narrower claims strengthens specificity of the invention.

-about multiple sketches, with defined parts:

-about background

-about best embodiment

Should the examiner cite prior art that seems to covers the most broad claim, a substitute claim (with its own new number) can be expressed from combined elements within the dependent claims or from within drawings, specifications and cited references.

Reality in writing and examining claims is that almost anything can be awarded a patent as its definition is narrowed in depth to include greater and greater depth of unique features--- The importance of this condition is that an extremely narrow patent may offer very little property value. Of course, if that narrow product is an item with a new, broad, "faddish" market appeal, even a narrow patent may limit some threat of competition within a narrow market.

A format for claims will include a name for the claim, a list of elements such as items, methods, or steps, and how these elements cooperatively interact with one another to provide a working whole.

Conclusion: Claims for a breakthrough technology or a new use for a known product can be very broad, with few dependent claims. Licensees may be the ones who add their proprietary style to their products through multiple dependent claims.

Conversely, a claim set for mature technology tends to be narrow, with many dependent claims.

[A viable broad claim is usually much more valuable than a lot of narrow ones.]

BOARD MEETING PROVISIONS

3. Vision of program into 2000

Cooperative marketing efforts for individually owned intellectual properties

Cooperative effort policy

Independent Inventor & Corporate Licensee linkage systems

Creating and supporting new intellectual properties to meet market interests

Creative Problem Solving tools - Part of pre-meeting networking

Washington "Invention Conferences" with major customer groups

Capital Area "Inventor / Business Workshops" to tailor properties

Economic research

Studies to support changing fees within patent law for small entity

Basic principles from which to teach "project economics for

inventions"

Economic models generated and proofed from which to estimate development & promotion costs for inventions suitable:

for licensing

for manufacturing

for distribution

Sponsorship of INCA-like inventor organizations

Cooperate in starting new Inventor Associations
- for youth (Implement Lemelson Objectives)
- for out-lying communities (Implement Saturday
Seminar findings: Too few public arenas for
inventors)

Board Meeting, Continued

Recognition agency to identify inventor teams whose properties provide:
major humanity enhancements
important, timely social enhancement
economically-significant communication value
essential material-conservation merit
business initiation, growth and health

4. Amplify Inventor Initiatives, using available resources

INCA might demonstrate processes through which independent inventors thrive

**feed intellectual property benefits to customers through licenses
integrate tasks with corporate producers and marketers.**

**INCA and cooperative industries might demonstrate employed inventors:
processes**

**help corporations thrive from intellectual property benefits to
customers**

**assure high quality properties through equity in licensing from
employed inventors to other corporate producers and
marketers.**

**INCA, Universities and small entity corporations might broaden sound
inventor policy. refine a modern Intellectual Property policy for
Universities and Corporations**

regarding individual inventor equity-rights.

**[Consider Duke University Policy as model. Ref:
Inventions, Patents and Technology Transfer of July 1
1996, Nine pages]**

“ **A concept is expressed and refined with concept explanation and value additions.
Commercialization and directive-focus follow.
Protection strategies for intellectual property considered
Business formation (with a balance of talent) is discussed**

Marketing with definition and segmentation outlined
Financing converts aforementioned considerations into economic terms and marshals:
Deal Structure evaluation
Likely Investor demands
Program requirements and recommended posture.

A growing, evolving concept is summarized. Moderator / Mentor(s) suggest direction & offer advice. Audience reaction is noted. "Beta test" records reactions. Division of the audience into groups of fewer than 30 offers a close relationship to presenters, moderators, mentors and recorders.

Mar 21 Program Licensing Experience and considerations

April Saturday Seminar at USPTO for Independent Inventors

April 18

Non-disclosure agreements

Patent evaluation services as well as potential customers usually exchange Non-Disclosure agreements with an idea offeror - before the idea is disclosed.

Andy Gibbs' Patent Cafe' discusses Non-Disclosure Agreements in
http://www.patentcafe.com/cafe'_magazine/

1-Page FAX

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Jan 22 2000

Patent Resources Group, Inc
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Ref: Crafting and drafting Winning Patents

Dear Professor Kayton and Staff

In 1977 I participated in your pre-certification course at the Hyatt in Roslyn Va. As a patent agent I have not sought clients, but found the background and disciplines to particularly valuable in structuring some of my own property.

My Jan-Feb issue of Harvard Business Review had such a good article by Rivette and Kline, “Discovering New Value in Intellectual Property” that I also acquired a copy of their book, Rembrandts in the Attic (Harvard Business School Press).

I believe this book, though addressed to CEOs who may be missing their corporate financial opportunity in IT, offers some important direction to independent inventors.

E.g. The independent inventor’s most natural customers are these larger corporations. And the corporation’s well being is amplified by acquiring essential intellectual property from independent inventors because some of them are just a more efficient as well as effective base for generating new future-core property.

All of this preamble makes me want to know more about your August 8-11 presentation of Crafting and Drafting in Washington DC. Please send me your free copy of “Overview of Crafting and Drafting”.

With best regards,

Raymond D. Gilbert

Integrating Patents

= 20 yrs from application

Patent prosecution requires t-i-m-e: Patent lifetime

