

Episode 01:

Techniques and Analytics for Identifying Valuable Patents and Patents to Abandon

Patent Analytics Webinar Series

8–Episode Webinar Series

Episode 01 - Techniques and Analytics for Identifying Valuable Patents and Patents to Abandon

Thursday, April 16, 2020 at 12:00 PM CT

Episode 02 - Using Patent Landscapes to Develop IP Rich Products and Valuable Patent Positions

Thursday, April 30, 2020 at 12:00 PM CT

Episode 03 - Using Prosecution Analytics to Improve Prosecution Efficiency and Identify Wasteful, Unproductive Prosecution Spending

Thursday, May 14, 2020 at 12:00 PM CT

Episode 04 - Using Examiner Analytics to Improve Prosecution Efficiency and Develop Well-informed, Data-Driven Prosecution Decisions and Strategy

Thursday, May 28, 2020 at 12:00 PM CT

Episode 05 - Best Practices for Developing Reliable Freedom-to- Operate Landscapes and Advanced Techniques for Interactive, Reusable FTO Mapping

Thursday, June 11, 2020 at 12:00 PM CT

Episode 06 - Using White Space Maps to Identify Open Spaces in the Patent Landscape

Thursday, June 25, 2020 at 12:00 PM CT

Episode 07 - Using a Patent Analytics Dashboard for IP Strategy, Competitor Surveillance, and Portfolio Management

Thursday, July 9, 2020 at 12:00 PM CT

Episode 08 - Using Patent Prosecution History Reports to Increase Prosecution Efficiency and Avoid Unintended Estoppel

Thursday, July 23, 2020 at 12:00 PM CT

Today's Presenters...



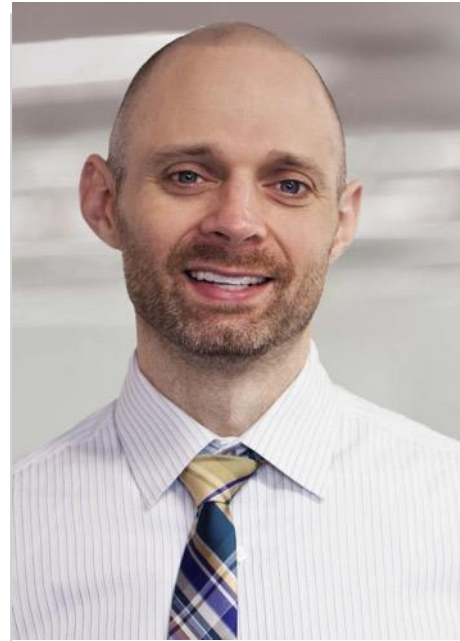
Steve Lundberg

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Janal Kalis

Principal
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Thomas Marlow

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Tyler Nasiedlak

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Schwegman Lundberg & Woessner



Mark Stignani

Analytics Chair & Firm
Compliance Officer
Former Chief Patent Counsel
Thomson
Schwegman Lundberg & Woessner

Key Concepts in Patent Value

The value of a large portfolio is heavily weighted toward a small fraction that constitute 80%+ of value

Sizable percentage of a portfolio may be a cash drain and burden on IP professionals

Why?

Patent filings are speculative – value is based on future events

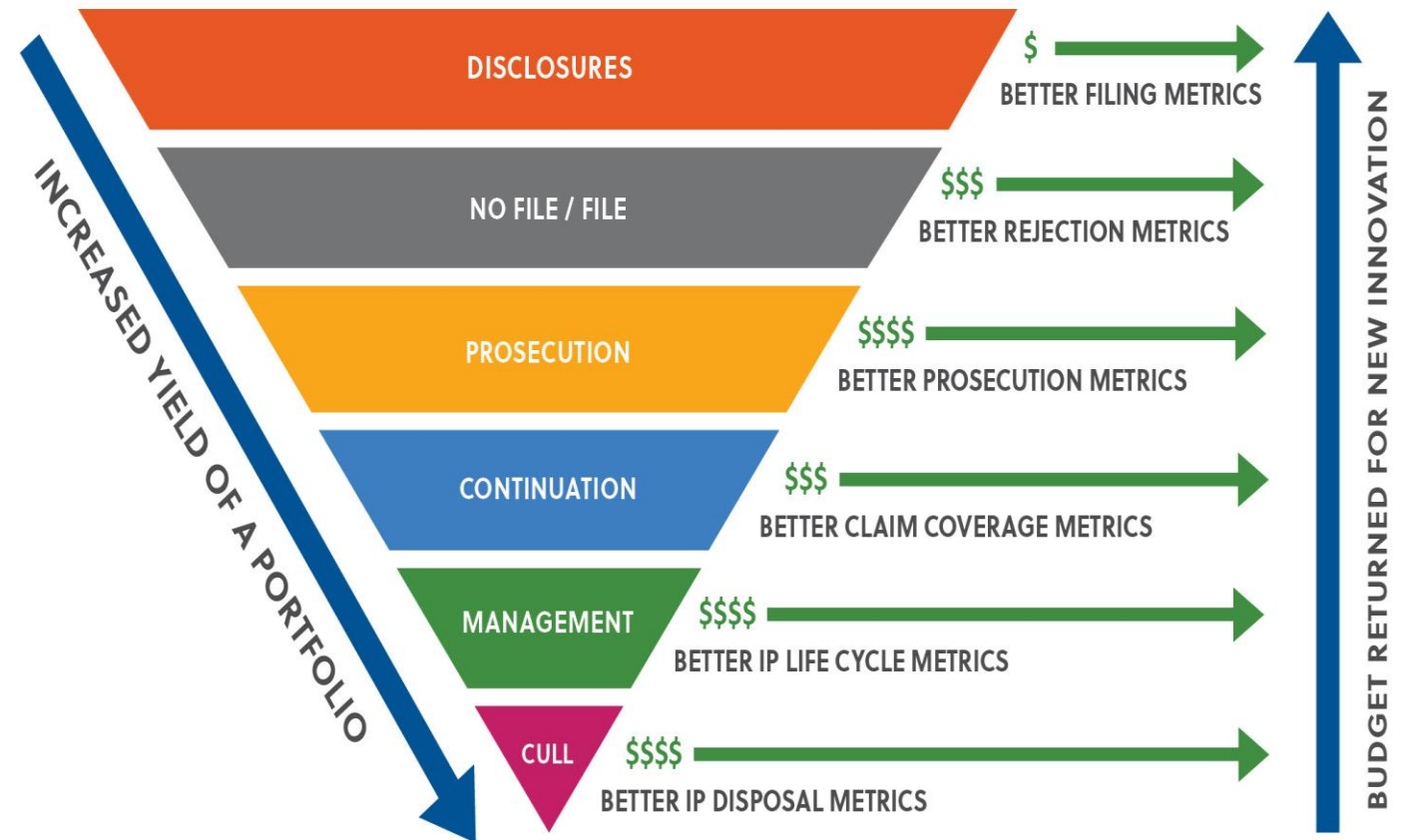
As time passes, value goes up or down based on changing circumstances

- Technology adoption – sales of infringing products
- Information not available at time of filing becomes public or otherwise discovered

Not an indication of failure selecting good cases to file

Value of Proactively Managing a Portfolio

- Patents are pre-targeted and ready-to-go when needed
- Claims of pending applications can be shaped to take advantage of new information such as prior art and product evolution
- Pending apps and issued patents that are no longer viable can be dropped and free up prosecution or annuity budget for more useful purposes



What you will learn today

- Analytics are not a magic bullet
- There are exceptions to almost every "rule"
- There is no one-size-fits-all approach
- Simple approaches often work better than complex ones
- "Eyeballs on" review is the ultimate tool
- There are time tested approaches that are proven to work well
- Identifying high and low value patents is hard work
- Task is like tending a garden – if not done regularly, the weeds can crowd out the flowers

Best Practices by Tyler Nasiedlak

- Involve a cross functional team (R&D, marketing, finance, legal) to identify important patents and patents not in line with business objectives
- Map claim coverage to company products and competitor products; know up-to-date coverage against each competitor
- Consider the sales revenue in the country of the patent; drop patents where little sales revenue
- Consider the enforcement in the jurisdiction of the patent; it is often difficult to sue outside of the US (esp. Asia) and damages may be less or difficult to obtain
- Consider the age of the patent; drop patents nearing end of life that still require an annuity
 - e.g., Germany may be a great jurisdiction, but is it worth a high annuity to keep a German patent in its 18th, 19th or 20th year?

Best Practices by Thomas Marlow

Tag/classify as you go

- Classifying a portfolio with internally useful tags is super useful
- Time intensive across a whole portfolio, but easy if done during invention review or grant

Focus on easy decisions

- Time is money
- Focus on those that are most easily identified as low or high value

Understand your business

- Useful patent analysis can't be done in a vacuum
- Begin with a good understanding of business strategy and plans 1,3 and 5 years out

Best Practices by Janal Kalis

Inventions/disclosures are tagged

- Each tag identifies tech area, product identifier, overall importance, license obligations and countries of interest

Tags are used to:

- Review disclosures for initial filing, PCT filing, national stage filing, paying of issue fees, and maintenance fees
- Parse portfolio by tech area/business unit/product identifier
- Patents and patent applications of interest can be sent to business units periodically to determine whether the tag is accurate

Users of the tagging system can quickly identify value of a patent if each tag is associated with a revenue/profit database by product

The tagging system combined with a revenue/profit database allows user to identify the most valuable patents, patents that may be abandoned or sold, and patents with ongoing obligations

Best Practices Dispositive Matrix

by Mark Stignani

Business Fit	Revenue	Standards	Encumber	Other Limits	Disposition
Yes	Yes	No	None	No	Keep
Yes	No	Yes	None	No	Keep
Maybe	Yes	Either	None	No	Keep?
Maybe	No	Either	Yes	Yes	Cull?
No	Yes	Either	Yes	Yes	Cull?
No	No	Either	Yes	Yes	Cull

Speed Analytics for Bad Patents

- 6+ Office Actions
- 2+ Request for Continued Examination
- Lack of any citation by Examiner
- Lack of Citation in last 5 years
- No family members/no continuations
- Inventor departed from company
- (complementary factor)
- Issued claim length substantially longer than filed claim length

Speed Analytics for Good Patents

Revenue generation

Used as a 102/103 reference against a competitor

Semantically similar claims to a known good patent

- Can also use clustering alg. But requires human concordance

Claim Unique words under 40

- Broad claim proxy

Extensive Family/Continuation Practice

- This can be a red herring

Analytics Used to find Broad or Narrow Patents

To find broadest patents for a particular technology

- Look in a time window that begins earlier than the original product/improvement launch and two years after that
- Starting with any patent that is relevant to the product/technology, use forward and backward citations to identify pool of patents with most likely candidates in the window

To find patents likely of less importance to a product or technology

- Using the same approach, identify patents of low value if the priority date falls outside the window

Citation Analytics to Identify Good / Bad Patents

- Cited by other key patents
- Cited by competitors
- Cited in volume
- Imprecise but fast – value in speed

US Patent Term Determination

- USPTO Patent Term calculation can be automated
 - Automated calculations should apply Patent Term Adjustment and Patent Term Extensions
 - Complex patent families may include Terminal Disclaimers of other patents
 - A patent can be near expiration or even DOA upon issuance by terminal disclaimer of other patents
 - We have observed such cases of limited or non-existent term in due diligence investigations
 - Automated techniques can scrape USPTO PAIR data to look for Terminal Disclaimers of other patents
 - Algorithmic analysis can be carried through the patent family priority tree for an accurate patent term determination that considers Terminal Disclaimers through the priority tree

Analytics Tools that are Useful

Patent Search

- More efficient work
- Derwent Innovation
- Total Patent One
- Innography
- AcclaimIP
- PatentLens
- Google Patents
- PatSnap
- Espacenet
- USPTO Web Patent DBs
- Patentscope by WIPO
- Lens.org
- PatBase
- Patseer
- Drug Patent Watch
- Orbit

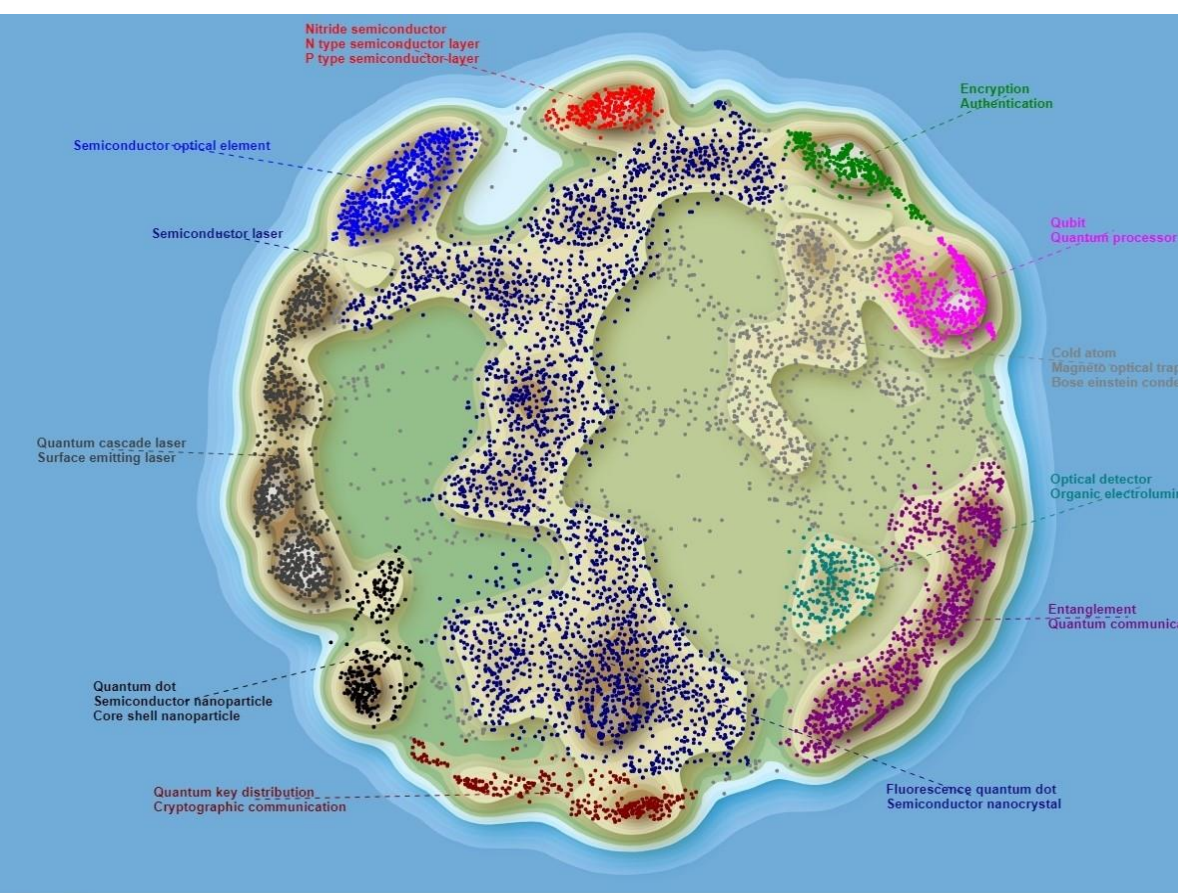
Analytics

- Patent Advisor
- PatentBots
- AcclaimIP
- Patent Buddy
- Innography
- Patent Sight

Patent Drafting

- Patent Optimizer
- Turbopatent
- PatentBots
- Specif.io
- Claimmaster
- Anaqua Studio (Turbopatent)

Machine v Machine Assisted



		A	B	C	E	F	G	H	I	J	K	L	M	N	O	P	R	S	T	U	V	W	X	Y	Z	AA	AB	AC	AD	AE	AF	AG	AH	AI	AJ	AK	AL			
Title	Potential Relevance				Expandable spinal implant and surgical method	Replacement disc	Middle expandable intervertebral disk implants	Artificial vertebral body	Vertebral prosthesis	Telescoping spinal fixator	Spinal implantation methods utilizing a middle expandable implant	Anterior interbody fusion device	Vertebral body prosthetic implant with slidably positionable stabilizing member																											
Patent#					5,059,199	5,035,116	5,171,278	5,290,312	5,306,310	5,336,223	5,390,663	5,397,364	5,443,515																											5,551,000
Assignee Name					Spino-Tech, Inc. (Minneapolis, MN)			Alphacore (Palm Desert, CA)	MAN Coramics GmbH (Deggendorf, DE)			DaniMed Medical, Inc (Memphis, TN)	Implis Corporation (Allendale, NJ)																										AcroMed Corp	
Filing Date					Apr 19, 1990	May 10, 1990	Feb 22, 1991	Sep 03, 1991	Aug 27, 1992	Feb 04, 1993	Aug 20, 1993	Oct 12, 1993	Jun 26, 1994																										Apr 2	
Total Claims					23			12	8	15	8	11	20																										1	
Claim# (Independent)																																							1	
Potential Relevance (3=High (Red), 2=Med (Yel), 1=Low (Green))																																							1	
Scope Concept (Appearance, Ass.)																																							1	
Rating (1-3)																																							1	
Claims Mapped																																							1	
Implant including a plurality of ribs, each rib deformable in response to a deformation force to change from a first shape to a second shape (claim 1)																																							1	
Implant that is slidably expandable (vertically and laterally)																																						1		
Means for applying a deformation force (claim 2)																																						1		
Implant having a shell structure on a hollow body configuration																																						1		
Implant comprising inner and outer portions, where the inner portion is softer than the outer portion																																						1		
Implant having an inner portion that includes a softer material than a material of an outer portion																																						1		
Implant including a foam material																																						1		
Inner portion of an implant comprising flexible formed polyethylene																																						1		
Coating on an inner portion of an implant that is formed radially outwardly (I) to conform the shape of the anatomical region of the disk space into which the implant is inserted, and (II) to arise greater than and proximal to the implant																																						1		
Implant that is cylindrically shaped and rotatably cylindrically shaped																																						1		
Introducing cancellous bone particles into a disk space between two adjacent vertebrae																																					1			
Retaining a length of an implant, the retention occurs on an inner distal portion of the implant to expand radially outwardly to conform the shape of the anatomical region of the disk space into which the implant is inserted																																						1		
Centering an adhesive substance radially to an implant to clear off a disk space between two vertebrae																																						1		
Implant having two hollow components adjacent and slidably engaged with each other, wherein each of the two hollow components comprise an exclusive interface and a sliding interface																																							1	
Implant having two hollow components that are engageable to prevent relative rotation to each other, when desired																																						1		
Implant having two hollow components that each have an opening that includes an access orifice																																						1		
Implant having a tubular structure being formed from two hollow rings being connected to each other by providing one of said hollow rings into the other																																						1		
Implant having a tubular structure being formed from two hollow rings being connected to each other by providing one of said hollow rings into the other																																						1		
Implant including a spring																																						1		
Implant having a tapered feature																																						1		
Spinal fixator having first and second arms joined by an elastic member																																						1		

**Thank You For Your Interest.
Questions?**

The Schwegman Analytics Advantage



SLW has been helping its clients find and improve high value patents for over 20 years and has invested heavily in its Analytics processes and tools for the last decade and is now expert at helping.

- More efficient work
- Shorter timelines
- Higher quality and key strategies
- IP Operations
- Fixed Fees/AFAs
- Tracking metrics
- Non-traditional providers

These materials are for general informational purposes only. They are not intended to be legal advice, and should not be taken as legal advice. They do not establish an attorney-client relationship.