



IP Portfolio Management: How to Effectively Make Use of IP Rights

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Building the Portfolio

1. Smart Prosecution for Value

- Writing patent applications to withstand IPR challenges (post-grant proceedings)
 - Include lots of claims
 - Include a narrow independent claim with lots of elements
 - Consider a “means for” claim
 - Several independent claims with different language for similar elements
 - Use lots of dependent claims
 - Consider using a 1.132 Declaration to show secondary considerations

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Building the Portfolio

1. Smart Prosecution for Value (continue)

- Writing patents to overcome an *Alice* rejection (nonpatentable subject matter)
 - Add technical details
- Using data tools to understand examiner tendencies
- Using examiner interviews, accelerated examination and Track 1 filings to expedite prosecution and allowance
- If the case is important, always keep a continuation pending

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Building the Portfolio

2. Inventor Incentives and Road Shows

- Encourages more disclosures
- Downside is that you often get disclosures you don't want and isn't that part of their job? Also, costs time and money to run the incentive program
- Develop a culture – a “wall of fame” may be enough

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Building the Portfolio



3. Patent Review Committees

- Trend to develop a “scorecard” based on factors like – estimated product revenue, critical company technology, easy to design around, chances of obtaining patent protection, etc.



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Maintaining the Portfolio

1. Day-to-Day Management

- Docket internally vs. law firm
- Docketing software – can they speak to each other?
- Extranets – track costs
- Login to law firm's system
- Client teams
- Patent marking – new virtual marking provisions

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Maintaining the Portfolio

2. Annuities/Maintenance Fees

- Manage in-house? Most law firms don't want to do this and raises prices to encourage to take it in house. But, requires internal administration to happen.
- Monitor whether worthwhile to keep older patents

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Enforcing the Portfolio

1. Passive Enforcement

- Rather than bringing lawsuits, advertising the portfolio may be enough
- For many companies, the existing of a competitor patent alone may be enough to keep them out of a space – or spend time and money to design around

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Enforcing the Portfolio

2. Active Enforcement

- For some industries where inexpensive copies are possible (i.e., from China) may require aggressive enforcement. But, be prepared for mounting legal costs and complex issues, including IPRs. Can be years to come to a resolution. If you are willing to license rather than get an injunction, settlement can be much easier.

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Enforcing the Portfolio

3. Monetizing

- Enforcing a portfolio solely as another revenue source.
- Is it worth it? Not as easy as it used to be. Damages awards are being slashed, *Alice* makes enforcement of many patents more difficult and the new venue considerations limit where cases may be brought (*Heartland* decision).
- Get a reputation and open yourself up to countersuits.

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