

Strategies for aggressively building a patent portfolio

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Ron Schoenbaum Plug and Play Tech Center – Silicon Valley



Topics

- How are patent rights most commonly lost?
- Ten strategies for aggressively building a patent portfolio

HOW ARE PATENT RIGHTS MOST COMMONLY LOST?

How are patent rights lost?

1. Failure to recognize invention before bar date
 - Inventors unaware of what can be patented
 - Inventors consider invention to be obvious
 - Invention difficult to ascertain (e.g., novel combination of old elements or steps)

How are patent rights lost?

2. Inventors lack motivation to participate in patent process

- Inventors do not like working with patent counsel to prepare patent application
- Inventors are morally opposed to patents

How are patent rights lost?

3. Company “accidentally” discloses product details before patent application filed. Examples:

- Member of marketing department discloses details of new product to potential customers**
- Company releases beta version of product without NDA**

How are patent rights lost?

4. Contractual deficiencies

- Joint development agreement lacks favorable IP ownership provision
- Inventors have not executed an appropriate invention assignment agreement
- “I agree to assign, and do hereby assign, ...”

TEN STRATEGIES FOR AGGRESSIVELY BUILDING A PATENT PORTFOLIO

1. Provide a simple idea submission form

- On company intranet
- Simple form that can be completed in 5 to 15 minutes
- Periodically email link to developers with reminder message



2. Conduct periodic “brainstorming sessions”

- 1-hour sessions with groups of 5 to 15 developers
- Not limited in scope to ideas currently being implemented
- No idea is too basic to be considered
- Conduct at least once per year



3. Educational seminars (online or in-person)

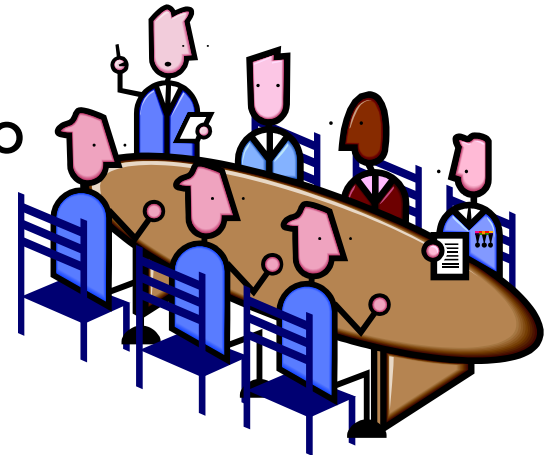
- Conduct once every 1 to 3 years
- Topics:
 - What can be patented
 - How to document invention and submit for consideration
 - Why patents are important to the company
 - How not to deal with patents of others



4. Form a patent committee

Responsibilities:

- Evaluate each identified invention based on various criteria (see next slide)
- For each invention, decide whether to
 - (a) file regular patent application
 - (b) file provisional application
 - (c) do nothing
 - (d) create defensive publication (e.g., using IP.com)



4. Patent committee (con't)

- Typical criteria considered:
 - Will infringements be detectable?
 - Is invention important to company and competitors?
 - Will the technology become obsolete in a few years?
 - Likelihood of getting a patent

5. Implement a patent incentive program

- \$1000 to \$3000 per inventor upon filing (typical)
- Additional award upon issuance (if still employed)



6. Conduct an IP audit

- Review (or create) standard employee agreement, consulting agreement, and company NDA
- Review (or create) internal procedures for making disclosures to, and entering into agreements with, other entities
- Review any existing license and joint development agreements



7. Reassess pending applications

- Compare pending claims to activities of company and competitors
 - Upon receiving an initial Office Action (at least)
- Revise claims, if appropriate
- Mine patent disclosure for unclaimed features

8. Keep a continuation pending

- At least for most important inventions
- Enables patent owner to:
 - Pursue additional claims
 - Eliminate infringement loopholes
 - Have newly discovered references considered
 - Eliminate problems caused by new case law
- Puts company in much stronger position for licensing negotiations and litigation

9. Consider Prioritized Examination (PE)

- **Cost (PTO fee): \$4,000 for large entities, \$2,000 for small**
- **PTO issues first Office Action roughly 2 to 5 months from filing**
- **PTO goal of “final disposition” within 12 months**
- **Prompt responses to Office Actions required or else priority status will be lost**
- **Unlike Accelerated Examination program, no prior art search is needed, and no Examination Support Document needs to be prepared.**

10. Buy patents and applications

- Via patent auction or broker
- Directly from patent owners

Questions?

Ron Schoenbaum ron.schoenbaum@knobbe.com
949-760-0404



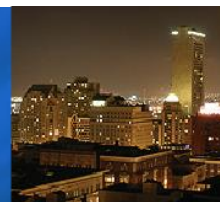
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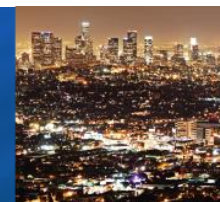
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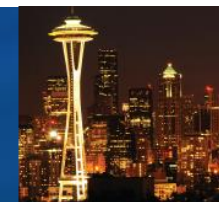
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