

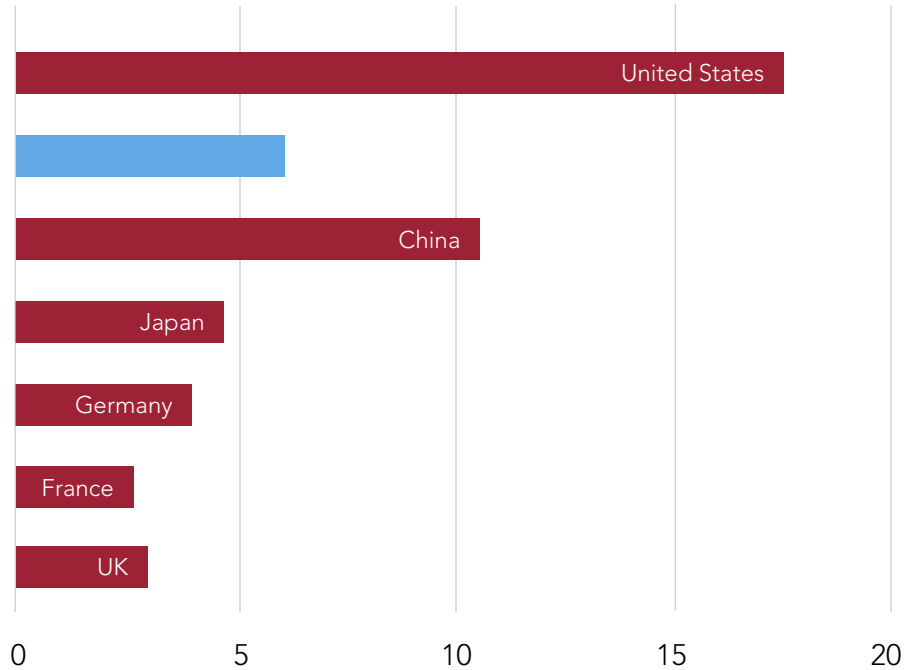
Building A Powerful U.S. Patent Portfolio

Agenda

- Why and What?
- Two Critical Components of a Strong Patent Portfolio Strategy

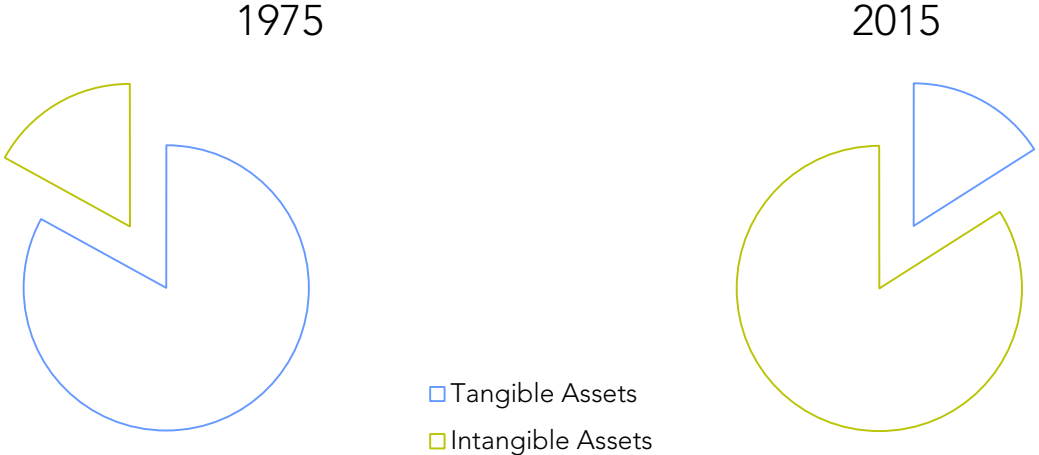
Why Create A Patent Portfolio

2014 GDPs (\$USD trillions) Compared to U.S. IP Market



Why Create A Patent Portfolio

Components of S&P 500 Market Value



Source: www.oceantomo.com/2015/03/04/2015-intangible-asset-market-value-study/

Why Create A Patent Portfolio

Sample Adjudicated Patent Damages Awards, 1995-2014

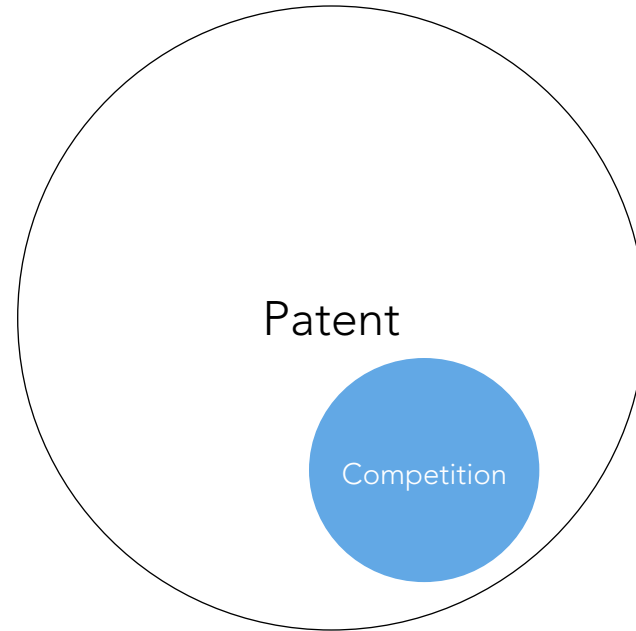
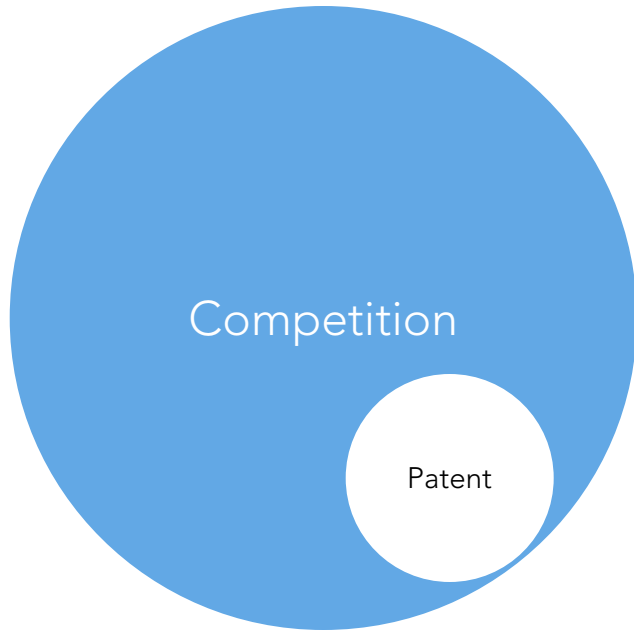
Year	Plaintiff	Defendant	Technology	Award (\$M)
2009	Centocor Ortho Biotech Inc.	Abbot Laboratories	Arthritis drugs	\$1,673
2007	Lucent Technologies Inc.	Microsoft Corp.	MP3 Technology	\$1,538
2012	Carnegie Mellon University	Marvell Technology Group	Noise reduction on hard drive circuits	\$1,169
2010	Mirror Worlds LLC	Apple Inc.	Operating system	\$626
2005	Cordis Corp.	Medtronic Vascular, Inc.	Vascular stents	\$595
2004	Eolas Technologies Inc.	Microsoft	Internet browser	\$521
2011	Bruce N. Saffran M.D.	Johnson & Johnson	Drug-eluting stents	\$482
2014	Massimo Corp.	Philips Electronics N. Am. Corp	Device measuring blood oxygen levels	\$467

The right to exclude others from making, using, selling or importing

35 U.S.C. § 271

What Rights Does A Patent Grant

Barrier to Entry



Agenda

- Why and What?
- Two Critical Components of a Strong Patent Portfolio Strategy

Two Critical Components

H. R. 1249

One Hundred Twelfth Congress
of the
United States of America
AT THE FIRST SESS
Began and held at the City of Wash
the fifth day of January, two th

An Act
To amend title 35, United States Code, in
the United States of America in Congress

SECTION 1. SHORT TITLE; TABLE OF CONT

(a) SHORT TITLE.—This Act may be
America Invents Act.”

(b) TABLE OF CONTENTS.—The tab
is as follows:

- Sec. 1. Short title; table of contents.
- Sec. 2. Definitions.
- Sec. 3. First inventor to file.
- Sec. 4. Inventor's oath or declaration.
- Sec. 5. Defense to infringement based on prior art.
- Sec. 6. Post-grant review proceedings.
- Sec. 7. Patent Trial and Appeal Board.
- Sec. 8. Prosecution submissions by third parties.
- Sec. 9. Venue.
- Sec. 10. Fee sharing agreements.
- Sec. 11. Fee sharing authority.
- Sec. 12. Supplemental examination.
- Sec. 13. Pendency requirements.
- Sec. 14. Tax strategies deemed within the prior art.
- Sec. 15. Marking.
- Sec. 16. Advice of counsel.
- Sec. 17. Infringement by induced.
- Sec. 18. Jurisdiction and procedural matters.
- Sec. 19. Technical disclosures.
- Sec. 20. Technical disclosures.
- Sec. 21. Travel expenses and payment of administrative expenses.
- Sec. 22. Intellectual Property Office funding.
- Sec. 23. Intellectual Property Office.
- Sec. 24. Designation of Detroit satellite office.
- Sec. 25. Priority maintenance for important inventions.
- Sec. 26. Study on implementation.
- Sec. 27. Study on genetic testing.
- Sec. 28. Patent Ombudsman Program for small business.
- Sec. 29. Establishment of methods for studying in the field.
- Sec. 30. Study of copyright.
- Sec. 31. USPTO study on international patent protection.
- Sec. 32. No time program.
- Sec. 33. Limitation on issuance of patents.
- Sec. 34. Study of patent litigation.
- Sec. 35. Effective date.
- Sec. 36. Redundant offices.
- Sec. 37. Continuation of 30-day period for applicants.

SEC. 2. DEFINITIONS.

In this Act:

(1) DIRECTOR.—The term “Director of Commerce for Intellectual Property and Trademark” of the United States Patent and Trademark Office.

Validity

UNITED STATES PATENT APPLICATION
FOR

METHOD AND APPARATUS FOR DISPLAYING INFORMATION IN
RESPONSE TO MOTION PICTURE PROGRAMMING

INVENTORS

Maryse Thomas
of Eden Prairie, Minnesota, U.S.A.

John G. Thomas
of Victoria, Minnesota, U.S.A.

Prepared by:

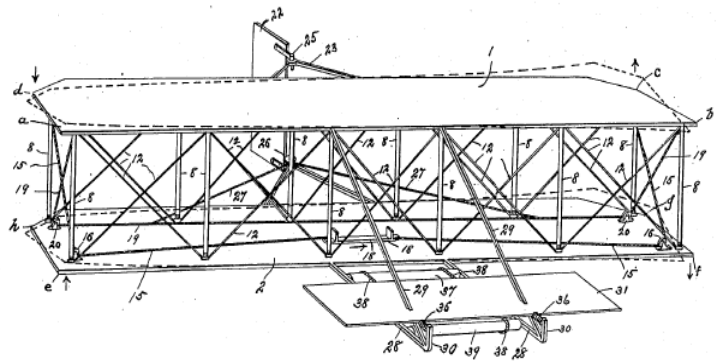
Schwegman, Lundberg & Woessner, P.A.
1600 TCF Tower
121 South Eighth Street
Minneapolis, Minnesota 55402
Attorney Docket No. 1424.001U12

Adequate Claim Coverage

Validity

Criteria for Patentability

Novel Non-obvious

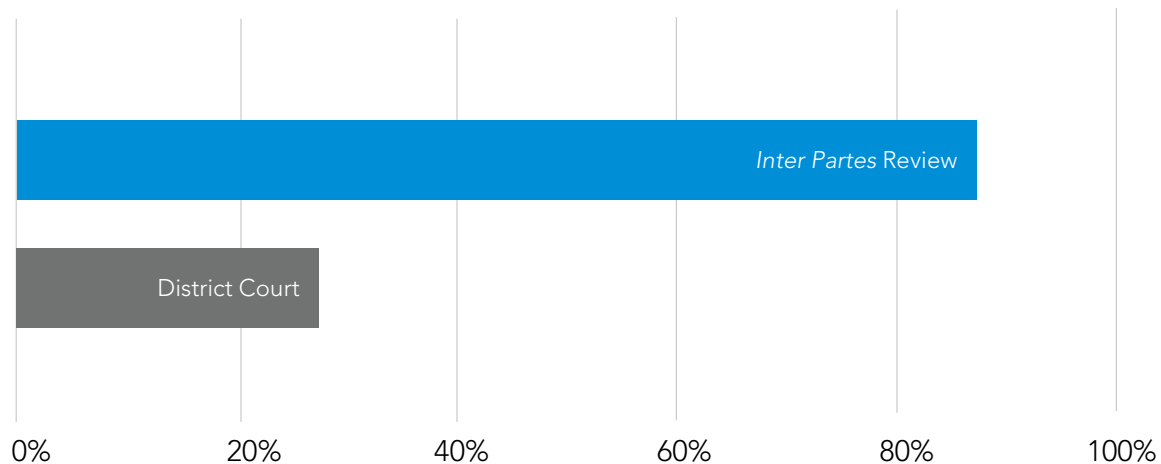


U.S. Patent No. 821,393

Post Grant Proceedings

Validity

Exemplary Effectiveness of Post Grant Proceedings



Inter Partes Review Partial and Complete Invalidation Win Rate

Source: Patent Trial and Appeal Board Statistics, 1/31/2016,
www.uspto.gov/sites/default/files/documents/2016-01-31%20PTAB.pdf

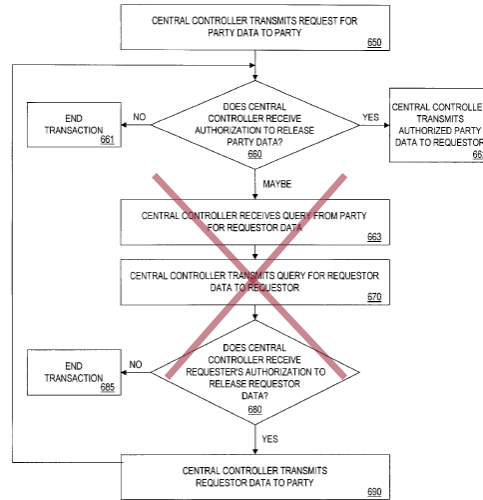
Source: Docket Navigator, 2015 Year in Review, home.docketnavigator.com/year-review/

Validity

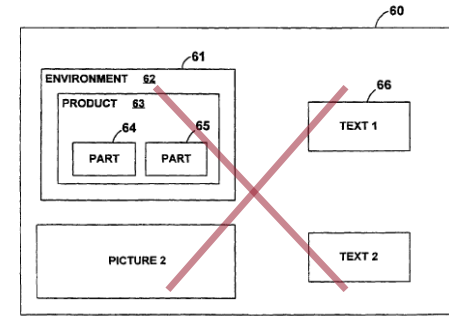
Non-patentable Subject Matter

- Laws of nature
- Physical phenomena
- Abstract ideas

Alice Corp. Pty. Ltd. v. CLS Bank Int'l, et al., 134 S.Ct. 2347 (2014)



U.S. Patent No. 5,884,272

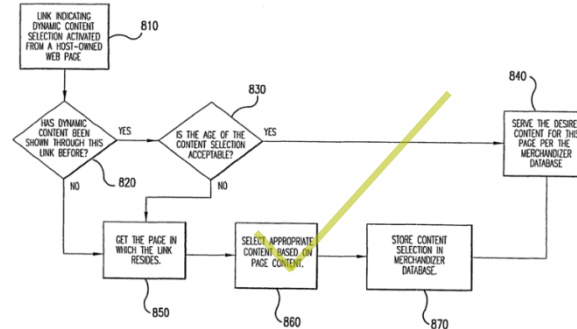


U.S. Patent No. 7,606,739

Validity

Computer Based Patents Still Viable

- Claims directed to overcome a problem specifically arising in the realm of computers
- Utilize prosecution and litigation counsel



U.S. Patent No. 7,818,399

Patent Due Diligence Checklist

- ✓ File Early
- ✓ Write a Quality Patent Application
- ✓ Build IP Portfolio that Increases Valuation
- ✓ Manage Litigation Risk
- ✓ Keep IP Organized
- ✓ Employee Agreements
- ✓ Independent Contractor Agreements
- ✓ Non-disclosure Agreements
- ✓ Patent Assignments
- ✓ Avoid Joint Ownership

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