

**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**

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**Episode 02** - Using Patent Landscapes to Develop IP Rich Products and Valuable Patent Positions  
**Thursday, April 30, 2020 at 12:00 PM CT**

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**Episode 03** - Using Prosecution Analytics to Improve Prosecution Efficiency and Identify Wasteful, Unproductive Prosecution Spending  
**Thursday, May 14, 2020 at 12:00 PM CT**

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**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**

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**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**

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**Episode 06** - Using White Space Maps to Identify Open Spaces in the Patent Landscape  
**Thursday, June 25, 2020 at 12:00 PM CT**

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**Episode 07** - Using a Patent Analytics Dashboard for IP Strategy, Competitor Surveillance, and Portfolio Management  
**Thursday, July 9, 2020 at 12:00 PM CT**

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**Episode 08** - Using Patent Prosecution History Reports to Increase Prosecution Efficiency and Avoid Unintended Estoppel  
**Thursday, July 23, 2020 at 12:00 PM CT**

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# Today's Presenters...



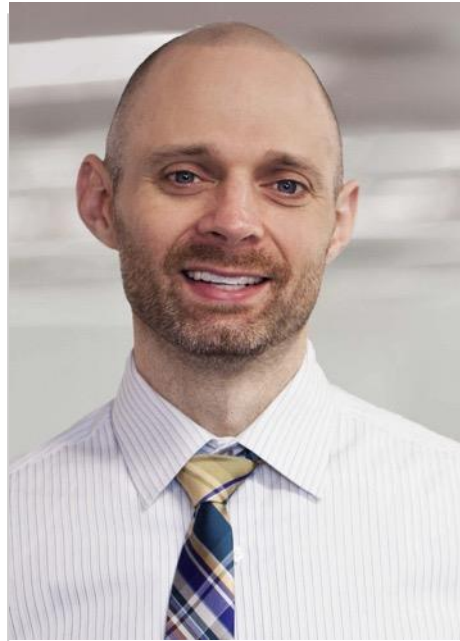
**Steve Lundberg**

Principal & Chief Innovation Officer  
Schwegman Lundberg & Woessner



**Janal Kalis**

Principal  
FTO and Patent Analytics Expert  
Schwegman Lundberg & Woessner



**Thomas Marlow**

President, Renewals  
Former Chief Patent Counsel of  
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**Tyler Nasiedlak**

Principal  
Former Chief Patent Counsel  
Guidant Corporation/Boston  
Scientific Corp (CRM/CV)  
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

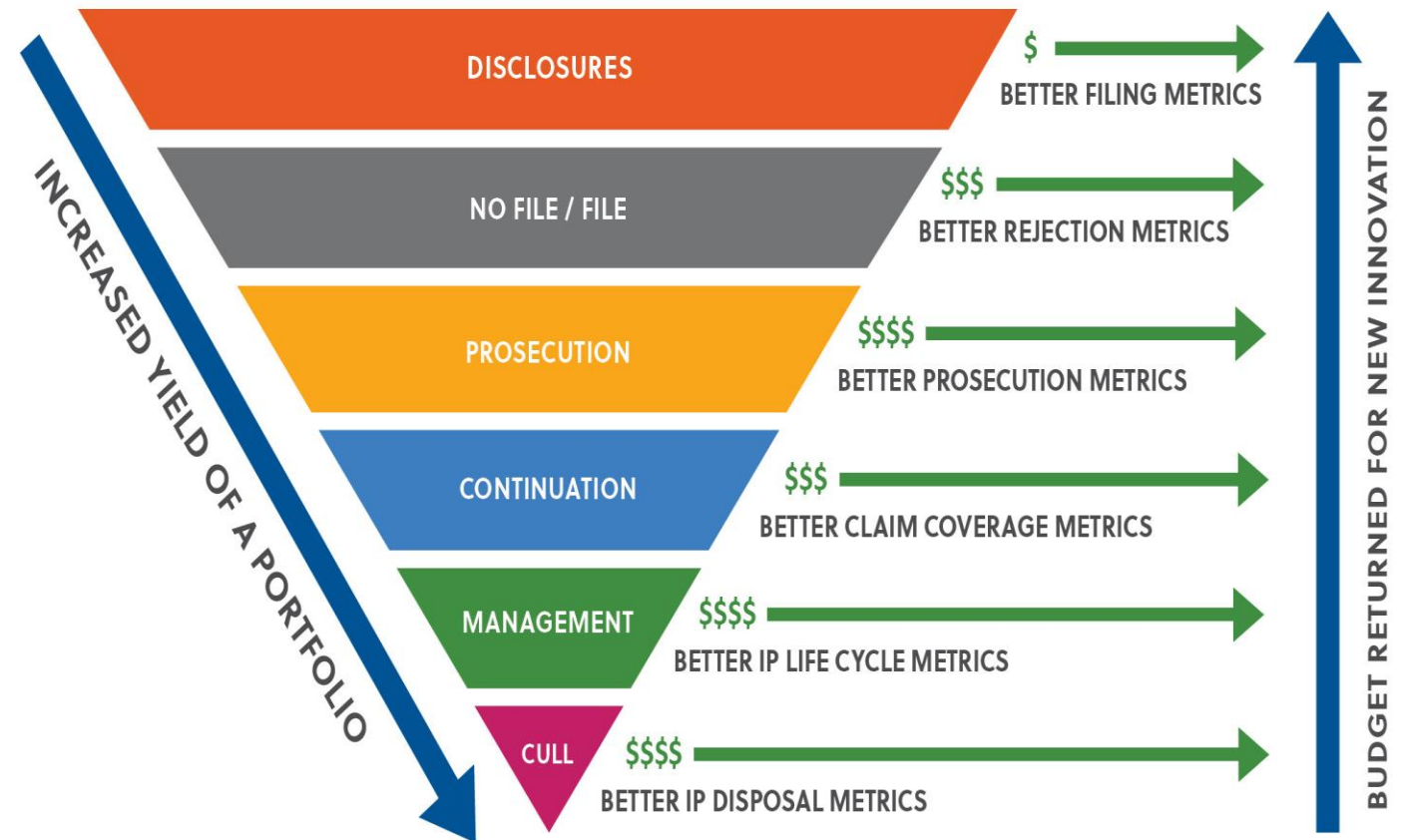
As time passes, value goes up or down based on changing circumstances

- 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)





**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

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