

Digital Transformation of the Legal Industry Webinar Series

SLW Digital Transformation Case Study: Due Diligence, Freedom to Operate Studies, Landscape Studies, Portfolio Curation, Portfolio Analytics, Landscape Analytics, Examiner and Attorney Analytics

8-Episode Webinar Series

Episode 01 – What is Digital Transformation for Law Practices?
Thursday, February 11th, 2021, at 12:00 PM CT

Episode 02 – SLW Digital Transformation Case Study: Overview of SLW systems, tools, data lake, processes, teams and personnel.
Thursday, March 11th, 2021, at 12:00 PM CT

Episode 03 – SLW Digital Transformation Case Study: Application Preparation – Disclosure intake and docketing, application drafting tools, production management
Thursday, April 13th, 2021, at 12:00 PM CT

Episode 04 – SLW Digital Transformation Case Study: Prosecution I – Receiving & Reporting PTO Correspondence – docketing, data/document storage, work packets, drafting and filing papers and responses; reporting to clients
Thursday, May 13th, 2021, at 12:00 PM CT

Episode 05 – SLW Digital Transformation Case Study: Prosecution II – Claim tracking, reference analysis tools and reports, prosecution landscape tools and reports, IDS management
Thursday, June 10th, 2021, at 12:00 PM CT

Episode 06 – SLW Digital Transformation Case Study: Due Diligence, Freedom to Operate Studies, Landscape Studies, Portfolio Curation, Portfolio Analytics, Landscape Analytics, Examiner and Attorney Analytics
Thursday, July 8th, 2021, at 12:00 PM CT

Episode 07 -- SLW Digital Transformation Case Study: Billing, Invoicing, Client Budgeting and Cost Projection
Thursday, August 12th, 2021, at 12:00 PM CT

Episode 08 -- SLW Digital Transformation Case Study: Recruiting, on-Boarding, Training, Firm Communications
Thursday, September 9th, 2021, at 12:00 PM CT

Before We Get Started...



Recording

A link to the recording and slides will be emailed to all registrants.



Questions

Type in the question box and we will answer in real time or during the Q&A.



Social

Follow us on LinkedIn or go to SLW Institute on slwip.com to see upcoming and on demand webinars.

Today's Presenters...



Steve Lundberg
Principal & Chief
Innovation Officer
Schwegman
Lundberg &
Woessner



Suneel Arora
Principal
Schwegman
Lundberg &
Woessner



Milena Higgins
Chief of Data
Analytics
Schwegman Lundberg
& Woessner
Ph.D. Physics



Janal Kalis
Principal
Schwegman
Lundberg &
Woessner
FTO and Patent
Analytics Expert



Andre Marais
Principal
Schwegman
Lundberg &
Woessner



Thomas Marlow
President, Renewals
Former Chief Patent
Counsel of Fairchild
Semiconductor
Black Hills IP



Patent Due Diligence

Analyzing a Patent Portfolio to determine whether it supports your business objectives



Tasks in Patent Portfolio Due Diligence

- Identify all patents/patent applications in the portfolio;
- Check assignments of issued patents and patent applications;

Tasks in Patent Portfolio Due Diligence

Identify active patents, patent applications:

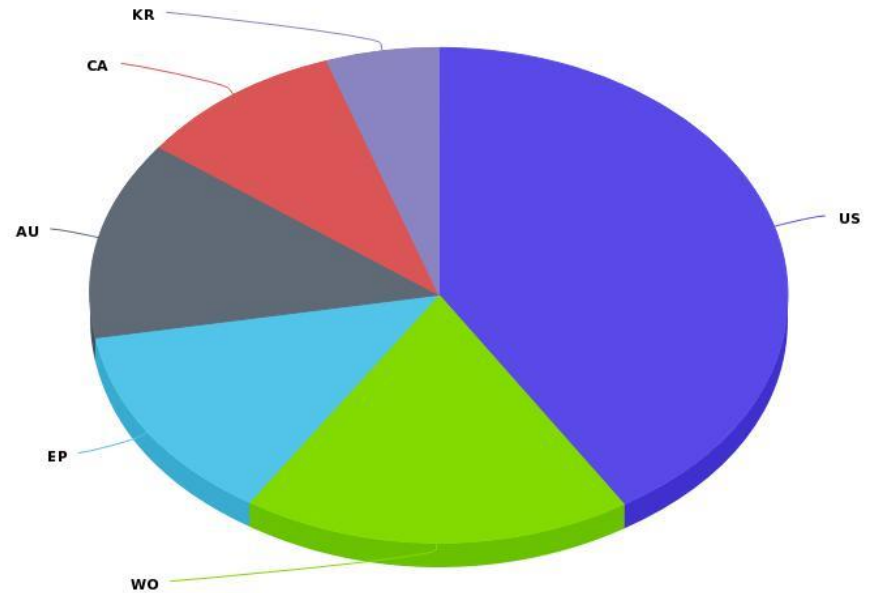
- ❖ Check payment of annuities, maintenance fees;
- ❖ Check patent expiration dates;
- ❖ Identify abandoned patent applications;
- ❖ Determine life left on issued patents that are not expired

Tasks in Patent Portfolio Due Diligence

- Identify Patent Families by Priority Across Countries and by Subject Matter;
- Align Patent Families with Products of Interest;
 - ❖ Use Portfolio Owner's curation, tagging;
 - ❖ Use Key Words in Abstract and Claims;
- Identify Patent Families of Interest;
- Review Backward/Forward Citations
- Review/Analyze Claims in Patent Families of Interest;
 - ❖ Review Countries Covered; Remaining Term; Scope of Claims

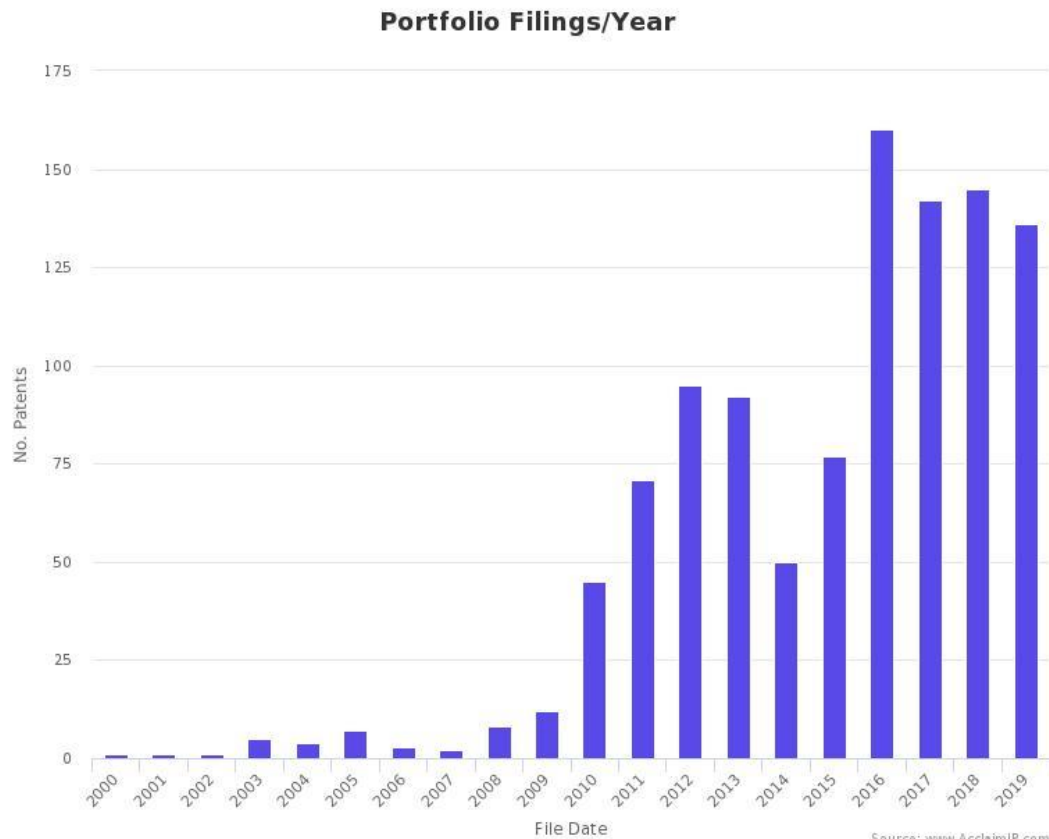
Top Patenting Countries

Top Patenting Countries



Date Charting

- Priority Date
- Filing Date
- Published/Grant Date

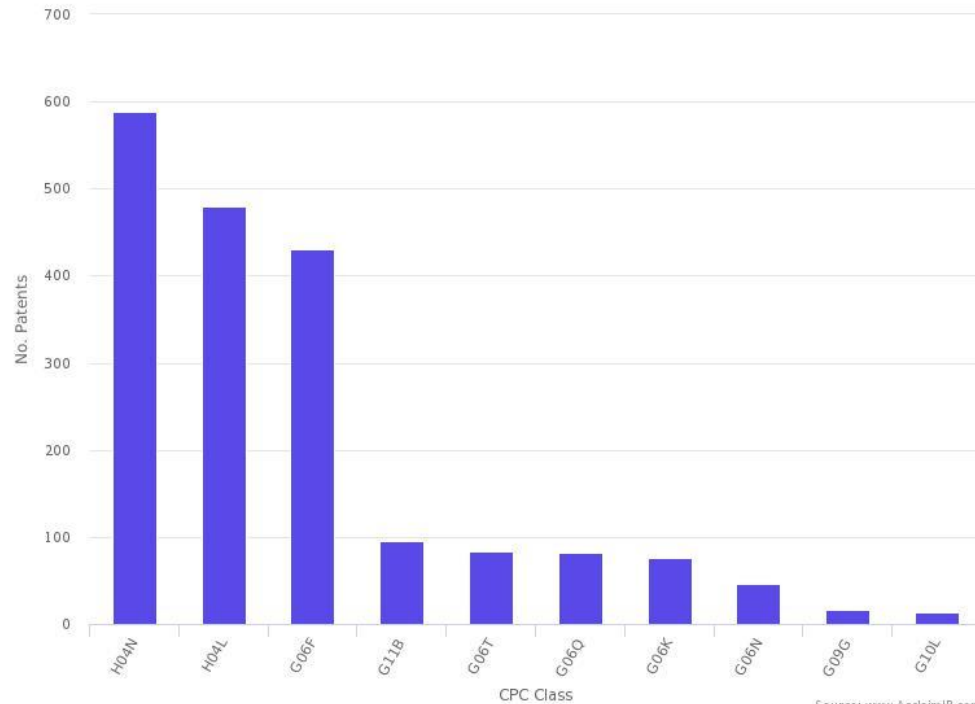


Top Classifications

- CPC / IPC
- Ranking at all class levels (Section to Complete class)
- First Only or All mentions of class available
- Class Titles Exportable

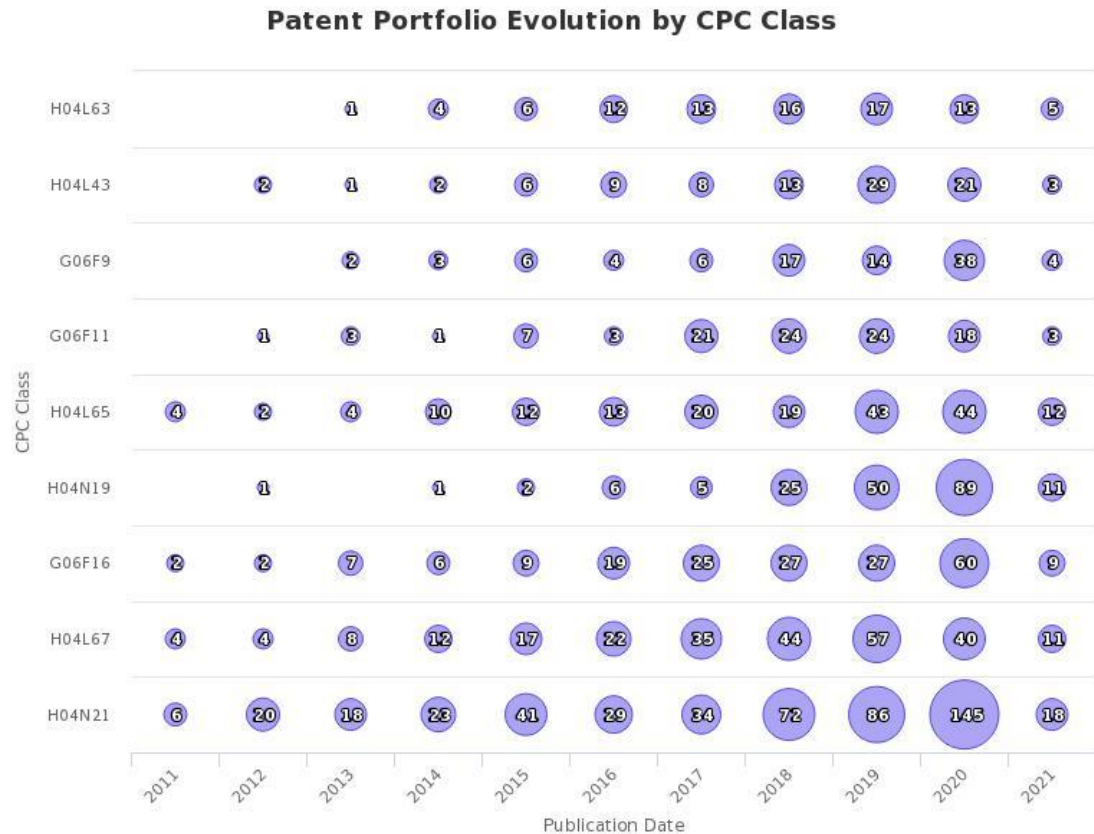
Top CPC Class

Ranking of Top Subclasses



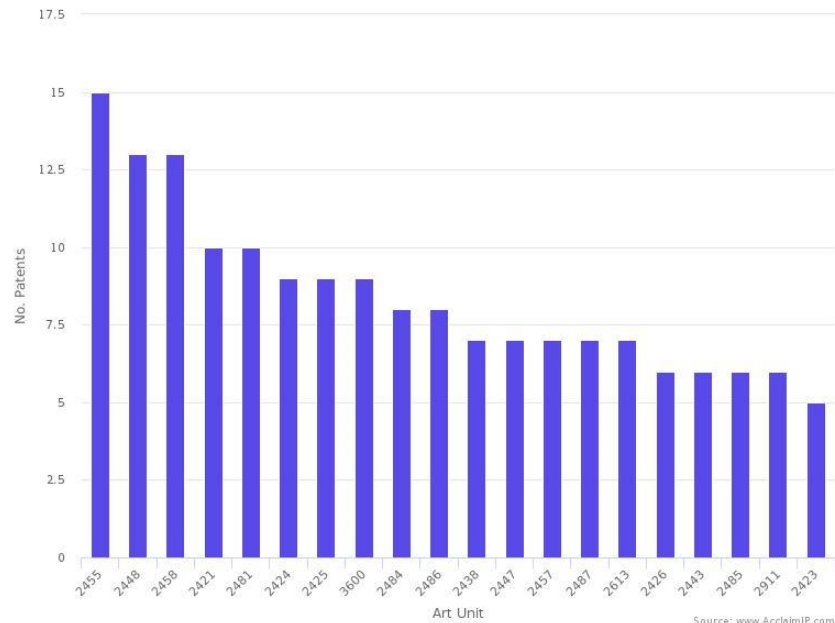
Source: www.AcclaimIP.com

Portfolio Evolution by Class

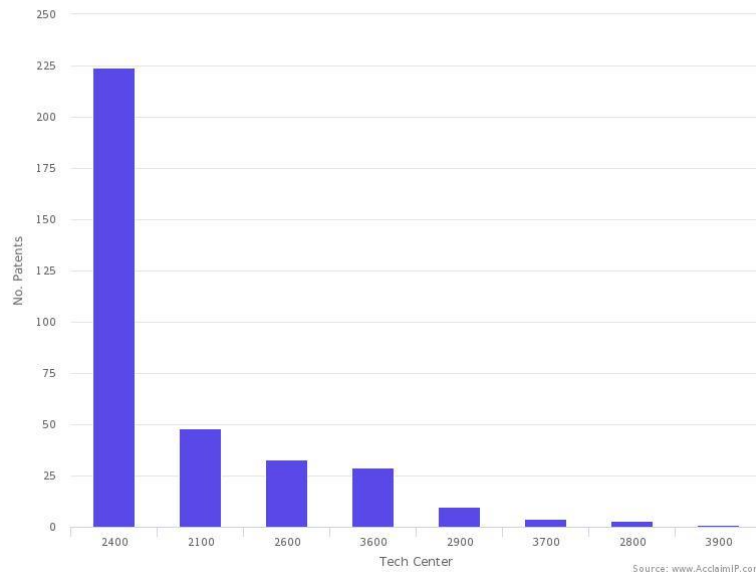


Top Art Unit / Tech Center

Top US Art Unit



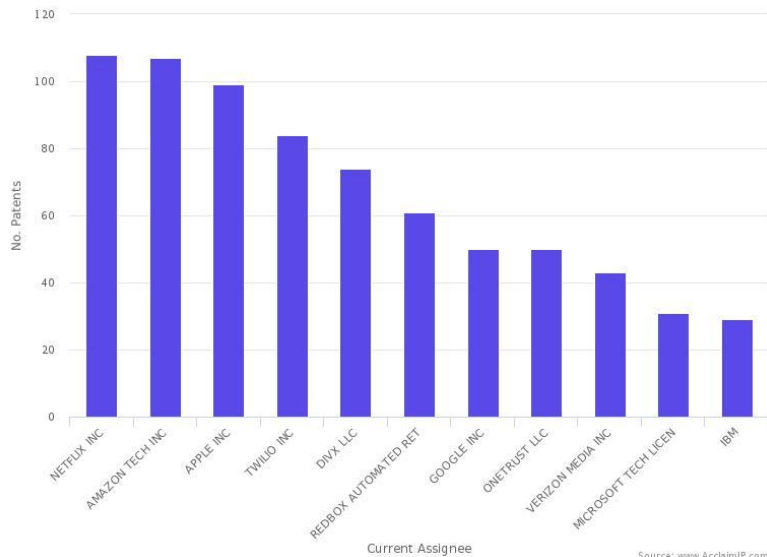
Top US Tech Center



Citations

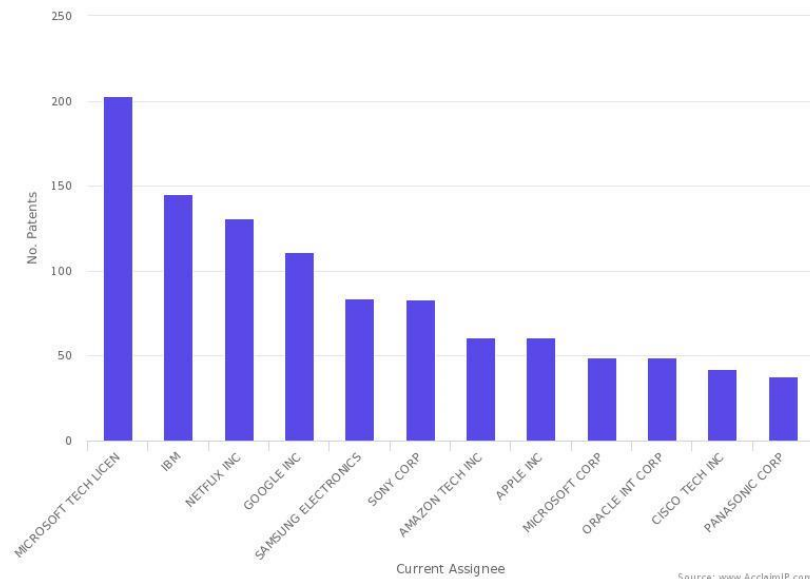
Forward Citations

Companies Citing Portfolio



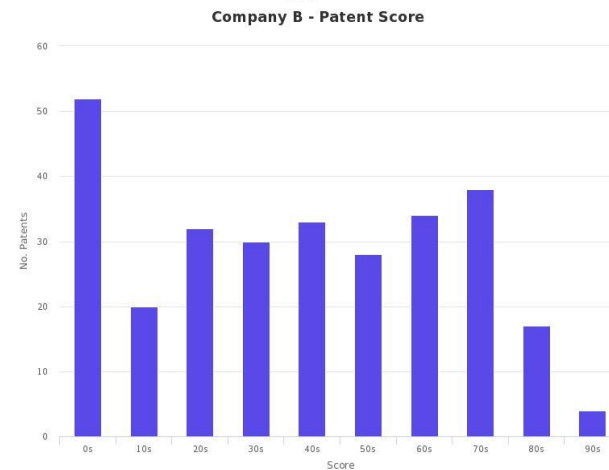
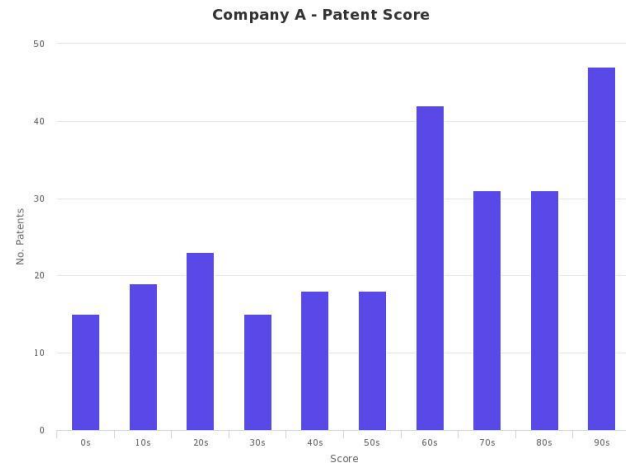
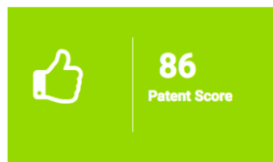
Backward Citations

Companies Portfolio is Citing



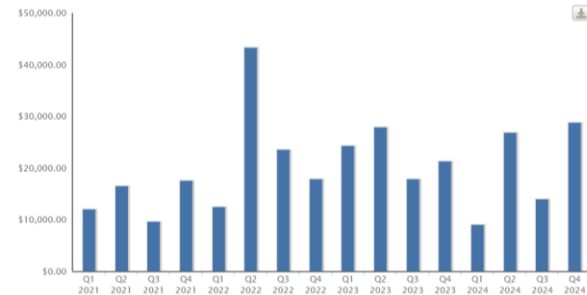
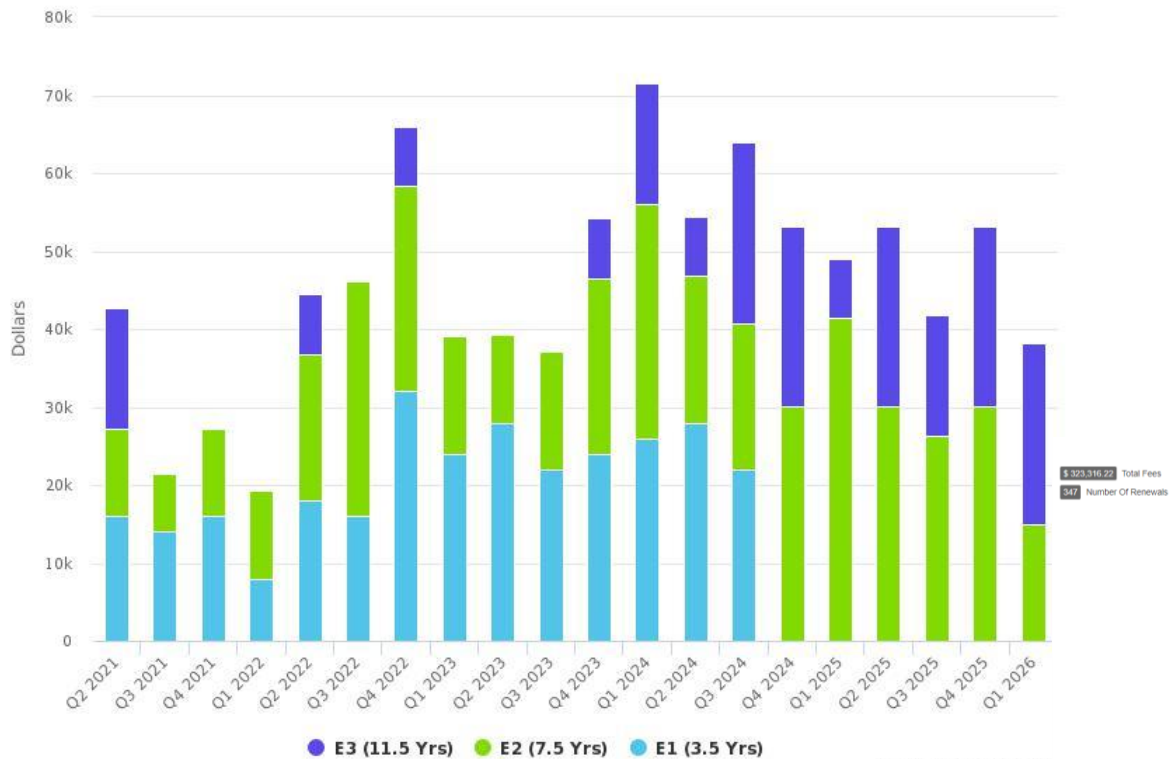
Patent Score

- Automated
- Citation Score
- Legal Score
- Technology Score



US Maintenance Fees by Calendar Quarter

*Based on upcoming maintenance fee payment due dates



Source: www.AcclaimIP.com

Company-Level Analysis



Filing Trends

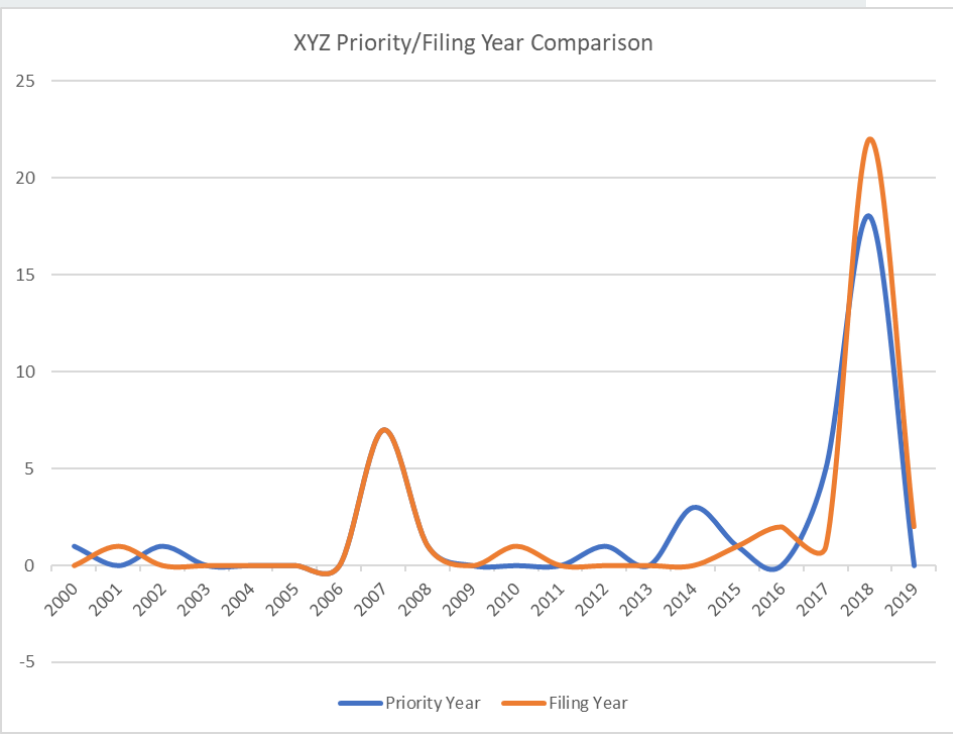
Key Technology Features

Portfolio Characteristics

- Expired vs. Active
- Pending Cases Trend
- Abandonment Rate
- Claim Scope

Notable Patents

Technology Filing Trends





SWOT Analysis

STRENGTHS	WEAKNESSES
<ul style="list-style-type: none">• Large, strong portfolio in foundational A234 technology• Considerably more active patents than other competitors	<ul style="list-style-type: none">• Significant percentage of portfolio is expired or will expire soon• High rate of abandonment• Claim scope appears to be narrower than competitors• Weaker patent position for C119 technology
OPPORTUNITIES	THREATS
<ul style="list-style-type: none">• Reduce abandonment rate by implementing pre-filing screening• Target prosecution of key applications (improve claim scope)• Investigate partnership opportunities for C119 technology• Investigate different applications for B665 technology	<ul style="list-style-type: none">• Competitor 1 has a strong portfolio in A and B technologies• Competitor 2 has substantially increased filings in A234 technology in recent years• Smaller players filing in C119 technology• Emerging B665 technology may disrupt A234 technology market



Software Tools Used:

Patent Searching / Analytics Reporting:

- AcclaimIP
- TotalPatent One®
- PatentBuddy™

Other Patent Software Used (Monitoring/Analysis)

- Patent Bots
- Patent 300® Dashboard



Freedom-to-Operate Searching, Mapping and Analysis

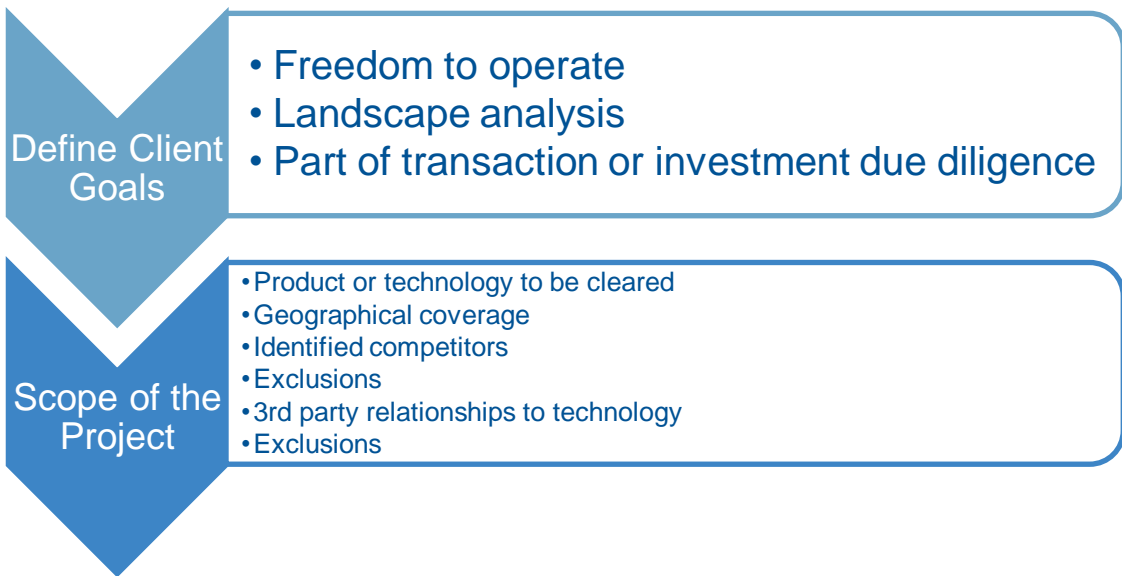
Develop FTO Patent Maps for Broad Technology Development Initiatives or Specific Product Design Initiatives, Including Interactive, Reusable FTO Mapping



Preliminary Considerations

- Client end goals and audience
- Is it FTO or Landscape?
- Timing of FTO – before or after design is completed
- Understand client's budget
- Leverage domain expertise of client to use budget wisely (e.g., SLW identifies patents, client reviews)

Goals and Scope

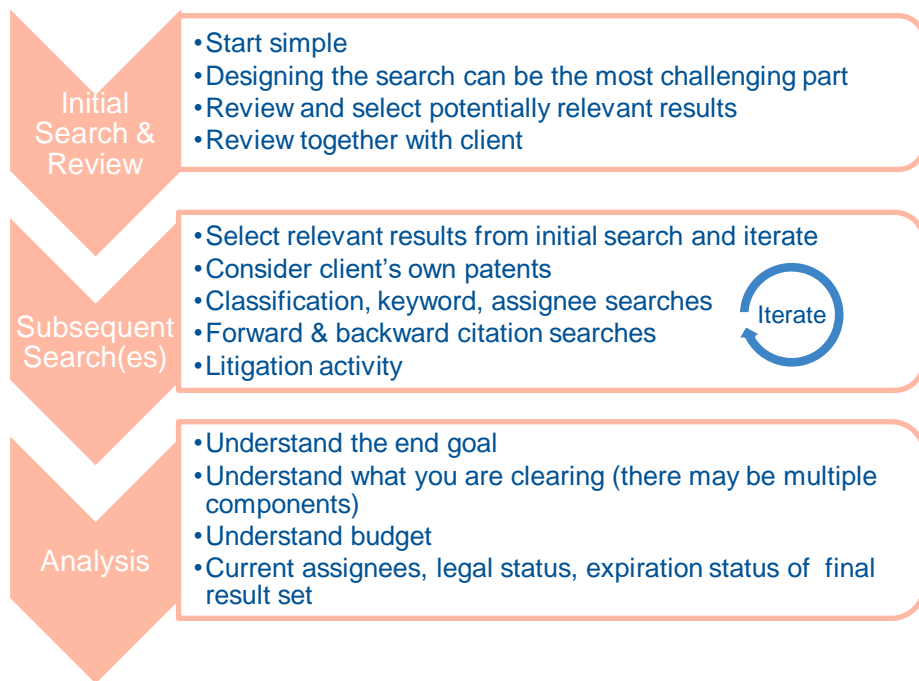


Search



- Who will perform the search?
- Design the search strategy
- Consider nontraditional or nonpatent search sources and datasets outside typical IP search

Review



- SLW reviews search results (first pass)
- Pick out potentially relevant results
- Work with client to narrow those down to a manageable list
- Come up with key list of patents for further review
- What is the relevant output?



Deliverable Types

- FTO Memo
- ClaimBot
- Pitch Deck Slide Summary
- List of Constraints
- List of Questions for Target

Deliverable Interactive Claim Map

The table displays a grid where rows represent different patent concepts and columns represent individual patents. The grid is color-coded based on the 'Key' provided: Red indicates 'Current Interest', Yellow indicates 'Future Interest', and Grey indicates 'Not of interest'. A 'Rating (1-3)' column on the left indicates the level of potential relevance for each concept. A timeline at the top of the grid shows filing dates from 1998 to 2008, with vertical lines separating individual patents.

Independent claims

Claims Needing Further Review are Automatically Identified (in red)

Scope Concepts
(minimal client time needed)

Potential Relevance
("1," "2," or "3" - client provides input about present & future design)

Individual Patents
(separated by violet and white columns)

Key
■ Current Interest
■ Future Interest
■ Not of interest



Examiner Analytics

Use Examiner Analytics to Develop Well-informed,
Data-Driven Prosecution Decisions and Strategy





What is it?

- Examiner and Art Unit Analytics show key statistics for patent prosecution practices for PTO tech centers, art units, individual examiners.



Value Proposition

- Examiner/Art unit analytics provide a basis to tailor prosecution strategies to better advance applications through prosecution
- Examiner analytics provide valuable insight into Examiner behavior, in absolute terms and relative terms, enabling a practitioner to make more informed choices on such things as interviewing a case, filing an RCE, filing an appeal, etc.

PEDS (USPTO Patent Examination Data System)

Refine by

Clear

Top Filters

More Filters

Application Number >

Filing or 371(c) Date >

Application Type >

Examiner Name

Top Values (Up to 25)
SITTNER, MICHAEL J 277

Group Art Unit >

Class / SubClass >

First Named Applicant >

Earliest Publication Number >

Patent Number >

Refined by:

Examiner Name: SITTNER, MICHAEL J ✕

277 Results match the selected criteria

Expand All / Collapse All |

Request Download ▾

Application/PCT #	Title of Invention	Status
> 09328672	ELECTRONIC BOOK SELECTION AND DELIVERY SYSTEM WITH TARGETED ADVERTISING	Abandoned -- Failure To Respond To An Office Action
> 09734044	SYSTEM AND METHOD FOR INCENTIVIZING ONLINE SALES	Abandoned -- Failure To Respond To An Office Action
> 10401503	METHOD AND APPARATUS FOR ELECTRONIC SUPPORT AND DELIVERY OF MULTIPLE LOTTERY AND SWEEPSTAKE PROGRAMS, IN SUBSTANTIALLY OFF-LINE ENVIRONMENTS	Abandoned -- Failure To Respond To An Office Action
> 10485398	POINT-USED ELECTRONIC TRADING SYSTEM, POINT-USED ELECTRONIC TRADING METHOD, BROADCAST RECEPTION APPARATUS, AND BROADCAST RECEPTION METHOD	Abandoned -- Failure To Respond To An Office Action

PatentPrufer



EXAMINER

Interview Success Rate ¹



Final Rejection Allowance Rate With AFCP ¹



Final Rejection Allowance Rate Without AFCP ¹



ART UNIT

Interview Success Rate ¹



Final Rejection Allowance Rate With AFCP ¹




Final Rejection Allowance Rate Without AFCP ¹



PatentBots

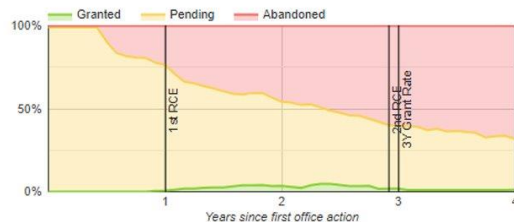
Grant Rate and Difficulty Ranking

3-Year Grant rate:	2% over 110 cases
Difficulty: 🚩	Extremely Hard
Difficulty Percentile: 🚩	98th 

With Examiner Sittner, you have a 2% chance of getting an issued patent by 3 years after the first office action. Examiner Sittner is an extremely hard examiner and in the 98th percentile across all examiners (with 100th percentile most difficult).

Grant Rate Timeline

Below is the grant rate timeline for Examiner Sittner, where the timeline is relative to the date of the first office action. The three-year grant rate is the percentage of applications granted at three years after the first office action.



History of Appealed Cases

- **Green:** good outcomes (PTAB reversed, PTAB affirmed in part, examiner allowed claims, or pre-appeal conference withdrew rejections)
- **Yellow:** neutral outcomes (examiner reopened prosecution or pre-appeal conference reopened prosecution),
- **Red:** bad outcomes (PTAB affirmation),
- **Gray:** uninformative outcomes (abandonment or filing of RCE), and
- **White:** appeals are still pending.

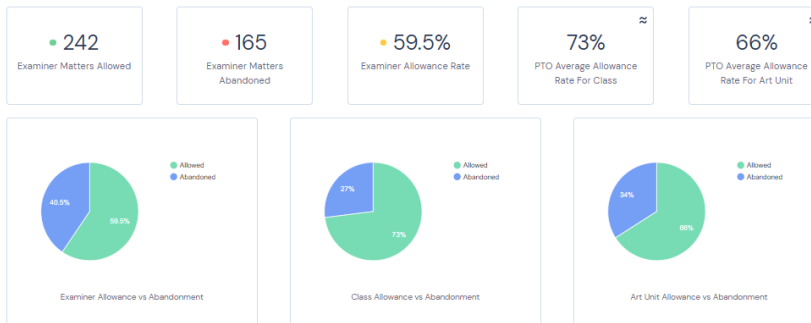
Number	Status	History	Patent-Plex 🚩
15893354	Pending	Notice of Appeal » Appeal Brief » Ex. Answer » Reply Brief » Ex. Reversed	View
15053889	Pending	Appeal Brief » Notice of Appeal » Ex. Answer » Reply Brief » Ex. Reversed	View
15036348	Patented	Appeal Brief » Notice of Appeal » Ex. Reasons for Allowance	View
15192128	Patented	Notice of Appeal » Appeal Brief » Appeal Brief » Ex. Reasons for Allowance	View
14329796	Patented	Notice of Appeal » Appeal Brief » Ex. Answer » Reply Brief » Ex. Reversed	View
14454579	Patented	Notice of Appeal » Appeal Brief » Ex. Answer » Reply Brief » Ex. Reversed	View



METHODS AND APPARATUSES FOR TRIALING A HUMERAL HEAD

App No:	15846624	Entity Size:	UNDISCOUNTED
Patent No:	Not Available	Filing Date:	2017-12-19
Examiner Name:	SCHILLINGER, ANN M	Earliest Publication Date:	2018-06-21
Group Art Unit:	3774	Notice of Allowance Mailed:	as 2021-04-09
Class:	623		

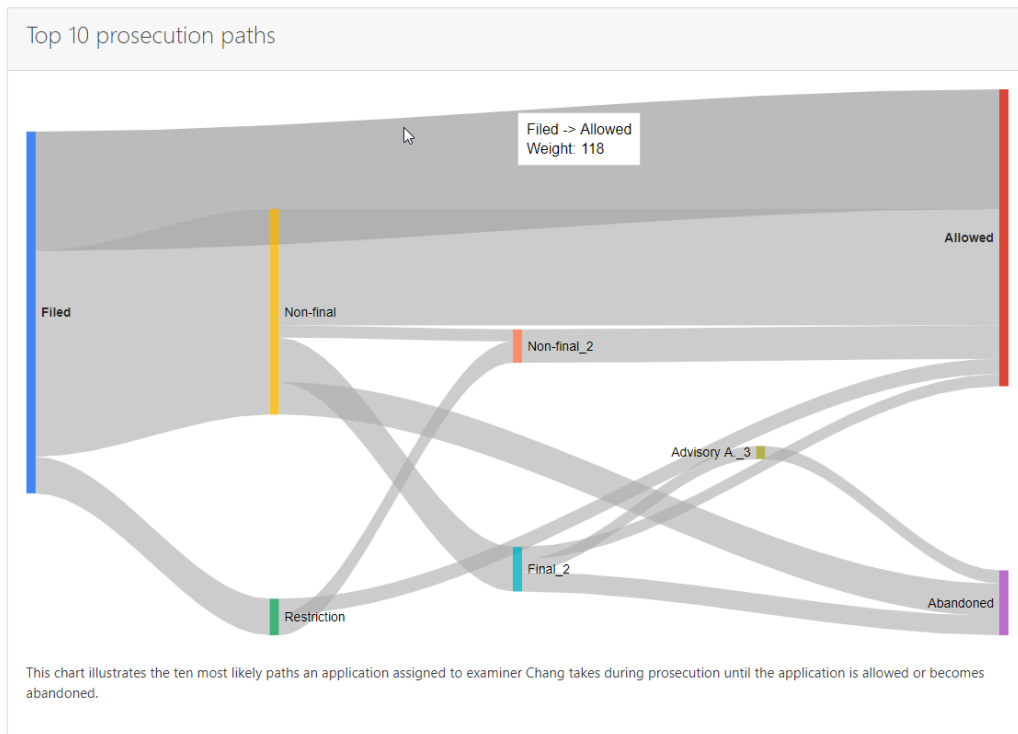
Allowance vs Abandonment Rates



Allowances vs Rejections in the Past 6 Months



SmartPat





IP Asset Curation





cu·ra·tion

/kyə'rāSHən/

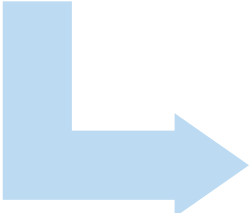
Noun

1. the action or process of **selecting, organizing, and looking after the items** in a collection or exhibition

PRE-FILING



PROSECUTION



POST-ALLOWANCE

3. ACTION

1. CATEGORIZE

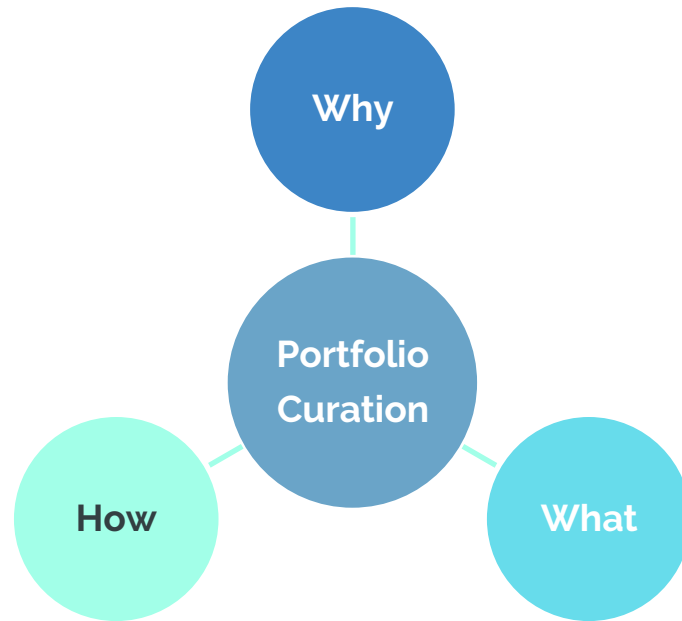


2. RANK



Patent Curation: Questions to Answer

Why are we building a patent portfolio? (What is the ROI?)



How do we build the patent portfolio to maximize ROI?

What assets do we need in the portfolio to achieve the "why"?

Patent Curation: Questions to Answer



Why are we building a
patent portfolio?

Patent Curation: Start with the “Why”

90%

FREEDOM TO OPERATE

Deter would-be litigants
Cross-licenses

90%

DEFENSIVE

Direct Copying
Counter-Suit

60%

RECOGNITION

Company/Marketing
Employee

80%

INDUSTRY COLLABORATION

Joint Ventures
Standards Bodies
Open Source Protection

10%

OFFENSIVE

Licensing

30%

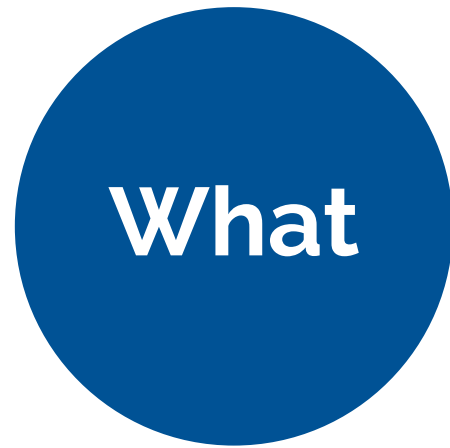
R&D TAX CREDIT VALIDATION

75%

VALUATION

Funding
Exit

Patent Curation: Questions to Answer



What assets do we need
in the portfolio?

What



Inputs

Business
Landscape

Patent
Landscape

Resources



Outputs

Objectives
Goals

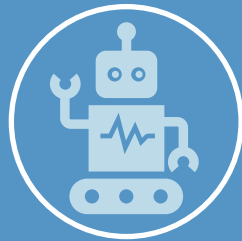
INPUT: BUSINESS LANDSCAPE

| What



Markets

Competitors
Yours



Technologies

Competitors
Yours



Products

Competitors
Yours



INPUT: PATENT LANDSCAPE

| What



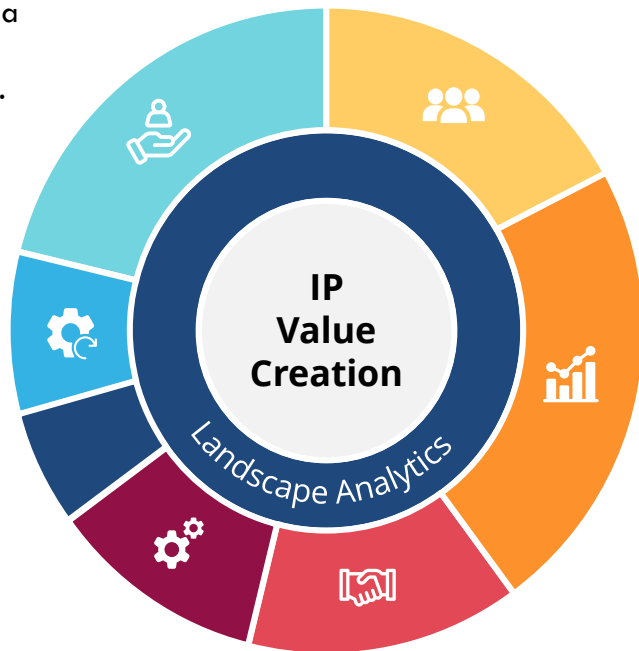
Value Proposition

Identify strengths and weaknesses of a company's patent position in order to optimize patent and product curation.

Strengths
Weakness

Competitive Intel

Gain strategic competitive insight into the relative strengths and weaknesses of the patent positions of competitors in a technology space.



Identify possible emerging threats in a technology space.

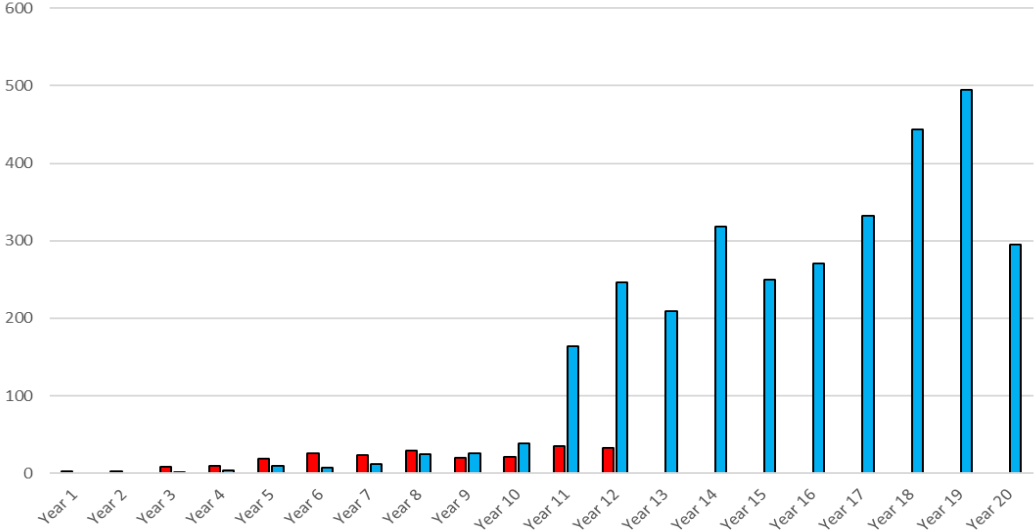
Threats

Opportunity

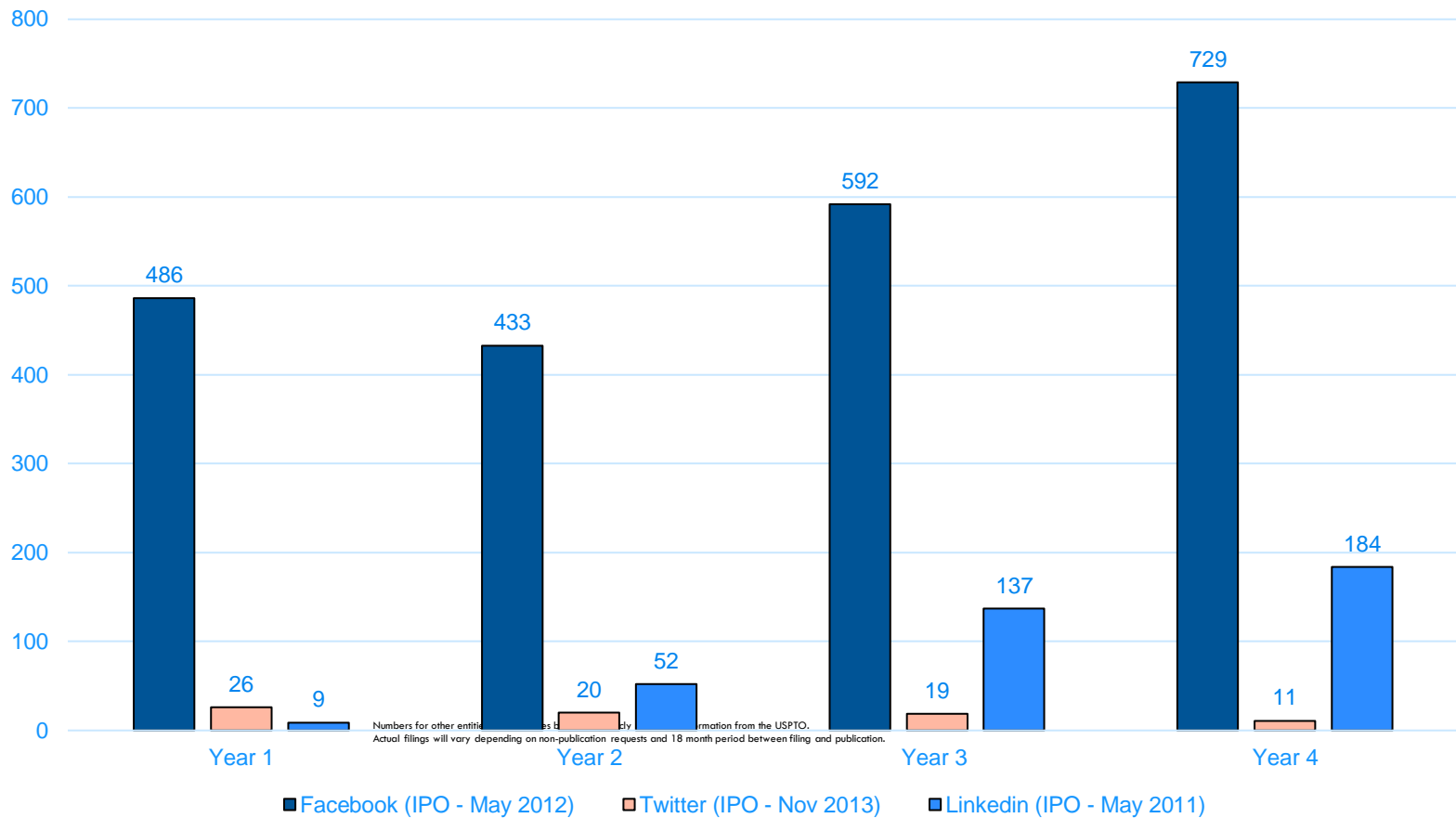
Identify opportunities to expand in a technology space (e.g., potential partnering, licensing, acquisition opportunities)

Benchmarking: Company Patent Growth Since Founded Comparison

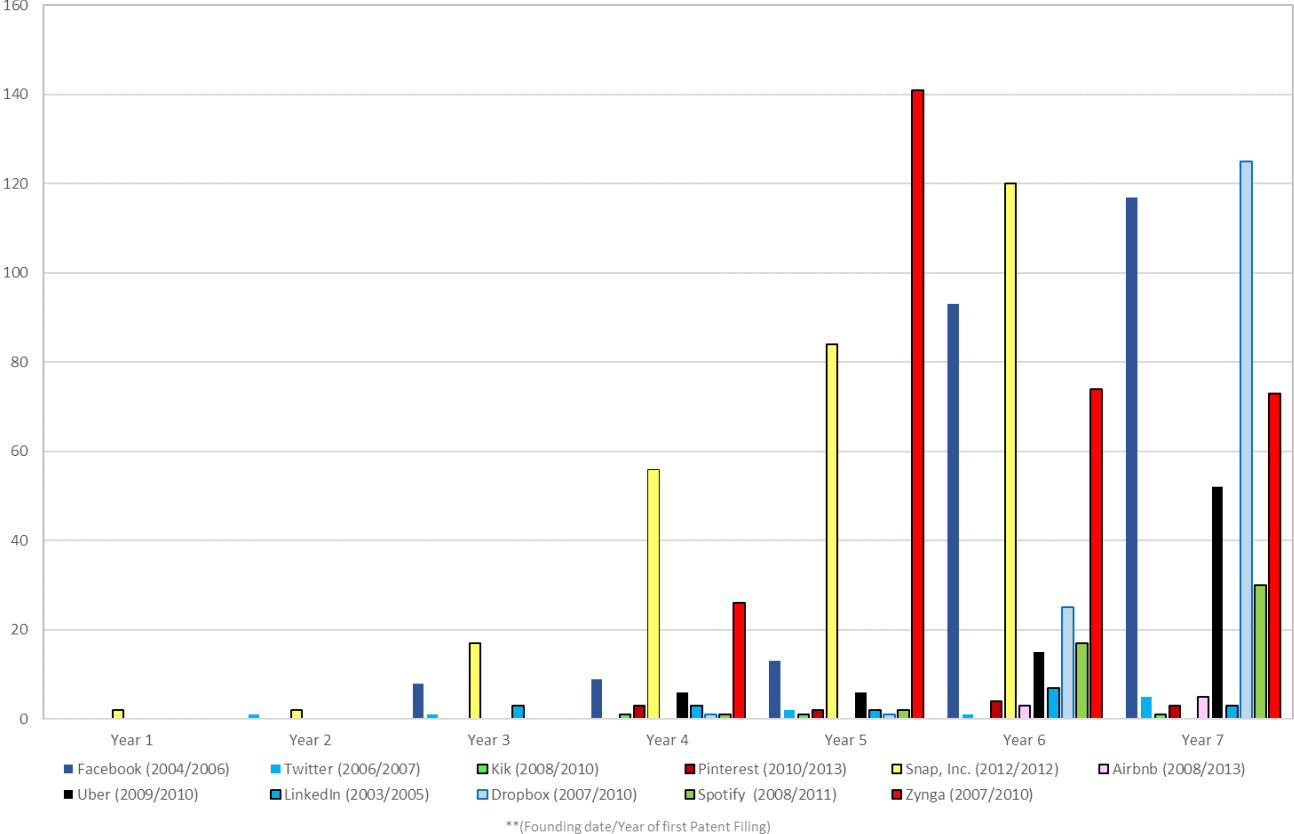
US Filings/Year Comparison
US Utility Apps - All Statuses Included



Company Filing Comparison	Year 1	Year 2	Year 3	Year 4	Year 5	Year 6	Year 7	Year 8	Year 9	Year 10	Year 11	Year 12
██████████ (Founded: 2008)	2009	2010	2011	2012	2013	2014	2015	2016	2017	2018	2019	2020
	3	3	8	9	19	26	23	29	20	21	35	33
██████████ (Founded: 1999)	2000	2001	2002	2003	2004	2005	2006	2007	2008	2009	2010	2011
	0	0	1	4	9	7	12	25	26	39	164	246



Benchmarking: Startup Patent Filing Comparison Chart – 1 of 2

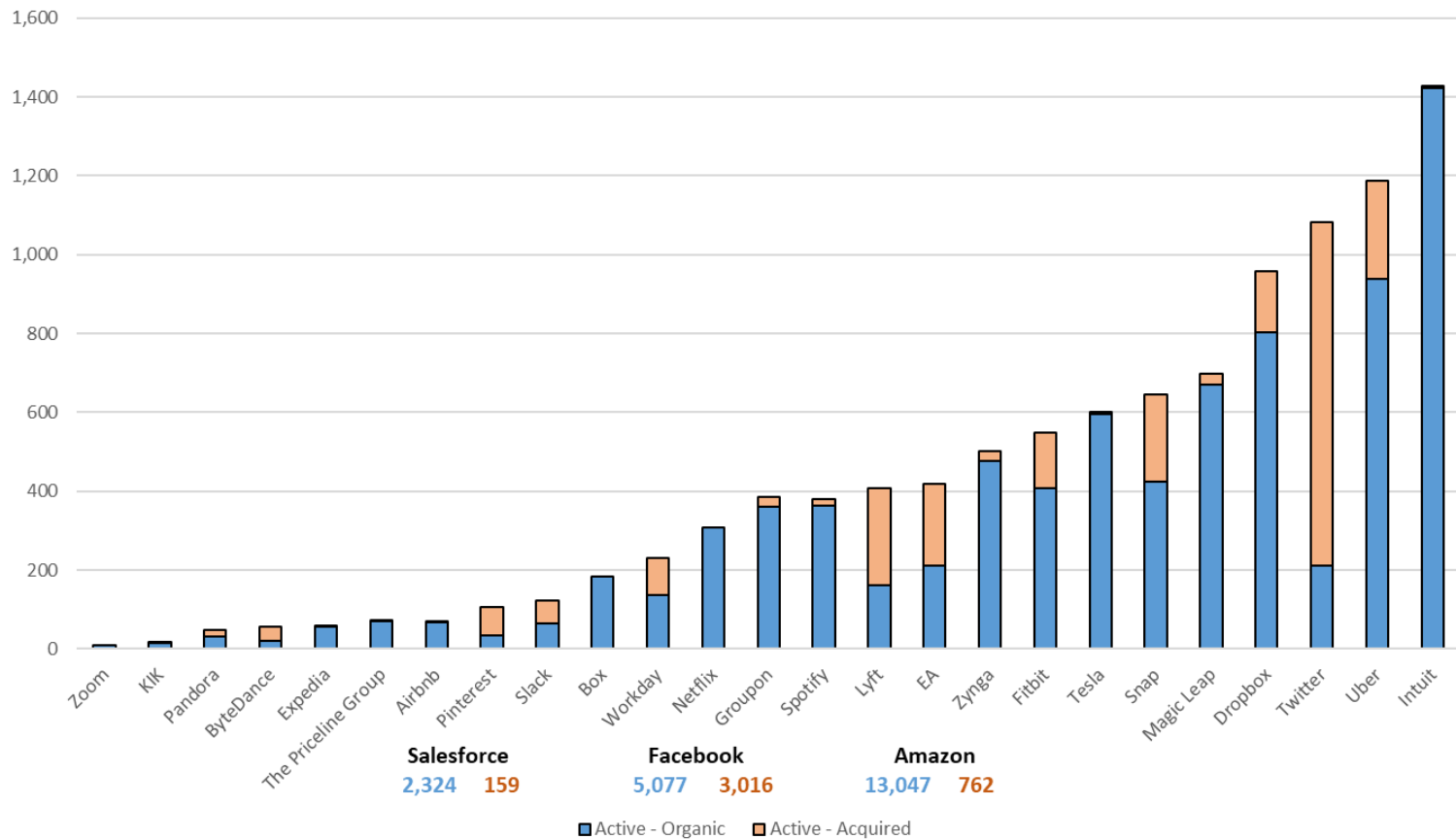


Competitor Patent & Value Comparison

Company Name	Active US Patent Matters (Issued & Pending)	Market Cap	Year Founded	# of Active Patents / Billion in Market Cap	Avg # of Patent Matters / Years Since Founding
Microsoft	40000+	\$1.69T	1975	0.02	889
Google	30000+	\$1.10 T	1998	0.03	1364
Cisco	15000+	\$177 B	1984	84.75	417
Amazon	14000+	\$1.70 T	1994	0.01	538
Adobe	5000+	\$246.5 B	1982	20.28	132
SalesForce	3000+	\$241 B	1999	12.45	143
Avaya	2500+	\$1.30 B	2000	1923.08	125
Uber (includes UATC)	1100+	\$58.9 B	2009	18.68	100
Genesys Telecom	650+	\$1.80 B	1990	361.11	22
Vonage/Nexmo	235+	\$2.76 B	2001	87.04	12
Company X	190+	\$39.8 B	2008	4.77	16
8x8	180+	\$1.77 B	1987	100.00	5
Bandwidth.com	50+	\$3.77 B	1999	13.16	2
Stripe	34+	\$35 B	2010	0.97	3
MessageBird	0	\$~300 M	2011	n/a	n/a
Plivo	0	?	2011	n/a	n/a
SendinBlue	0	?	2007	n/a	n/a

Public Comparison

June 30, 2020 - Active US Matters - Organic v Acquired



OUTPUTS

| What



Objectives

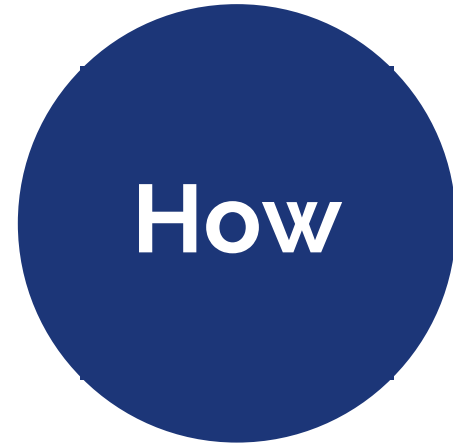
- Portfolio Level
- Case Level



Goals

- Quantity
- Quality
- Timing

Patent Curation: Questions to Answer



How do we build the patent portfolio to maximize ROI?

Patent Management Flow

| **How** |



ORGANIC - Build
INORGANIC - Build
JOIN - Defensive patent
aggregators



Inventory
Organize
Prioritize
Action



Back to the why!

OBTAIN: ORGANIC

HOW



Portfolio Curation

- Customized to the need of the client
- Organizes and classifies patents by product or technology
- Automated and hands-on categorization and ranking

Title		Patent Title	Patent Title	Patent Title	Patent Title
Patent#		Patent No.	Patent No.	Patent No.	Patent No.
Current Assignee		Patent Owner	Patent Owner	Patent Owner	Patent Owner
Filing Date		Mar 21, 2019	Nov 22, 2017	Oct 29, 2018	Aug 08, 2017
Total Claims		20	25	20	20
No. Of Claims (Independent)		3	4	3	3
Technology Category (Sorted A-Z, Asc.)	Patents Mapped	5	6	6	6
01. Tech Category 1	62				
02. Tech Category 2	19				
03. Tech Category 3	14				
04. Tech Category 4	29				
05. Tech Category 5	33				
Importance: High	54				
Importance: Medium	80				
Importance: Low	89				
Primary Product: Product 1	7				
Primary Product: Product 2	116				
Primary Product: Product 3	38				
Secondary Product: Product A	7				
Secondary Product: Product B	11				
Secondary Product: Product C	11				
Status: Allowed	11				
Status: Granted	39				
Status: Pending	176				
Scope Concepts (Sorted A-Z, Asc.)	Patents Mapped	2	1	1	1
batch ingestion of data using remote device	42				
hydration filter using charcoal or sand	21				
Key Words (Sorted A-Z, Asc.)	Patents Mapped	1	2	1	2
batch ingestion	17				
filter	70				
hydration	65				



Thank you for your interest.

Questions?





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.