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Patent Portfolio Management: Strategies in Uncertain Times

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Agenda

- Background
- Managing the current portfolio
 - Pending
 - Issued
- Managing protection for new innovations
- The Bigger Picture

The Setting

BACKGROUND

KSR v. Teleflex (2007)

TABLE 6. TECHNOLOGIES ANALYZED FOR OBVIOUSNESS BY THE FEDERAL CIRCUIT PRE- AND POST-KSR BY RESULT IN APPEALS FROM DISTRICT COURTS AND ITC¹⁶⁶

	Nonobvious	Obvious
Pre-Certiorari		
Biological	3 (75%)	1 (25%)
Chemical	14 (61%)	9 (39%)
Electronic	24 (53%)	21 (47%)
Mechanical	51 (53%)	46 (47%)
Post-Opinion		
Biological	4 (67%)	2 (33%)
Chemical	14 (52%)	13 (48%)
Electronic	21 (36%)	37 (64%)
Mechanical	18 (44%)	23 (56%)

TABLE 7. TYPE OF "REASON TO COMBINE" ARTICULATION

	Total Opinions	Prior art only	Prior art, PHOSITA, or problem	Particular sources not specified
Pre-Certiorari	241	14 (6%)	50 (21%)	79 (33%)
Post-Opinion	147	0 (0%)	4 (3%)	71 (48%)

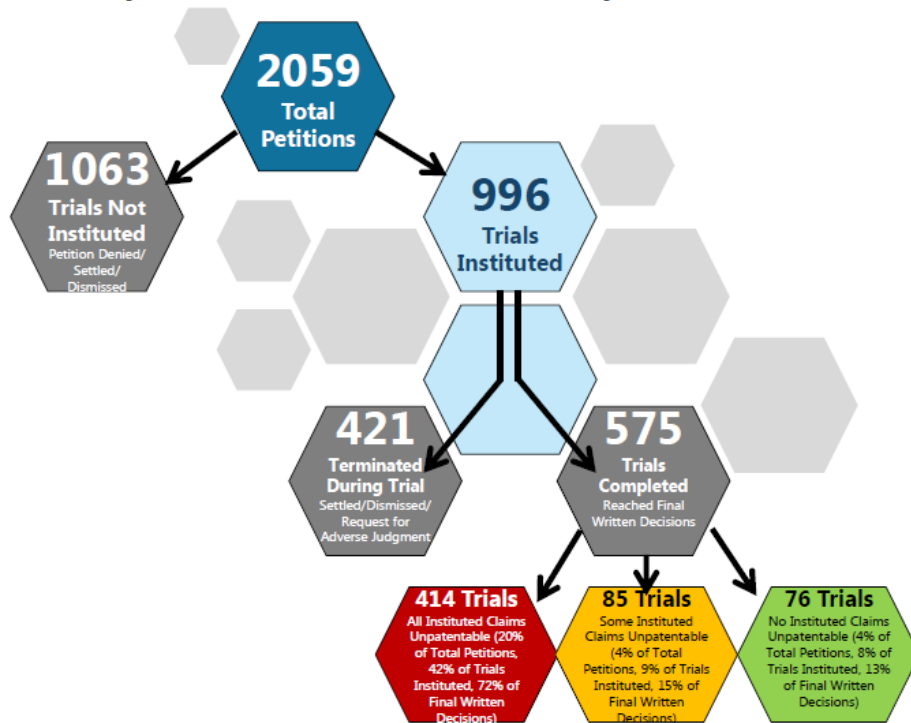
Jason Rantanen, Associate Professor of Law, University of Iowa College of Law
Stanford Technology Law Review:
16 STAN. TECH. L. REV. 709 (2013)
<http://stlr.stanford.edu/pdf/newobviousness.pdf>

AIA Proceedings Before the PTAB (2012)

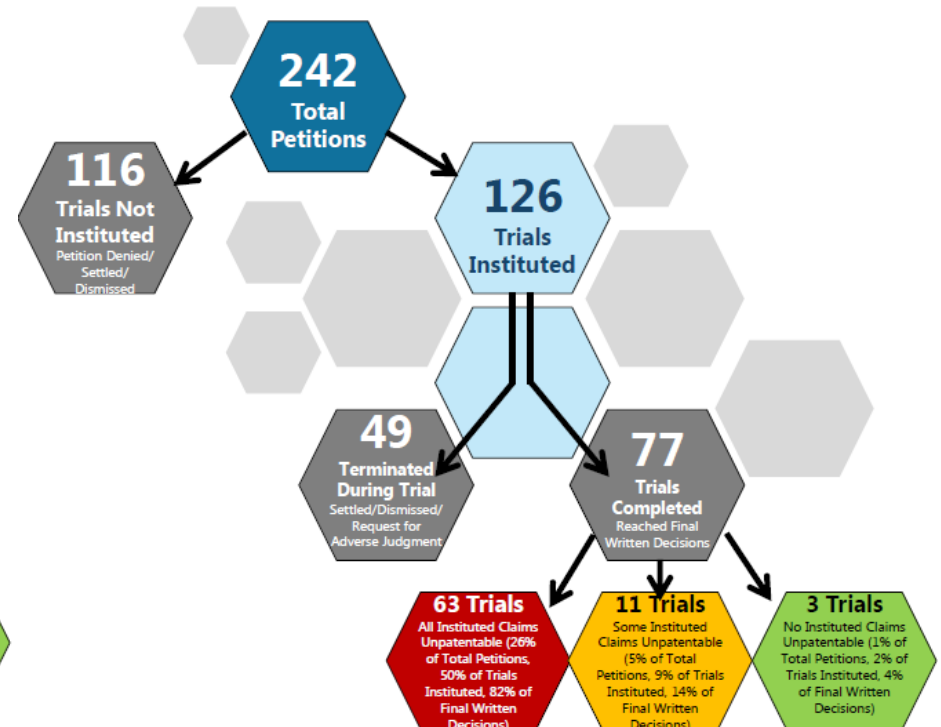


AIA Proceedings Before the PTAB (2012)

Disposition of IPR Petitions Completed to Date*



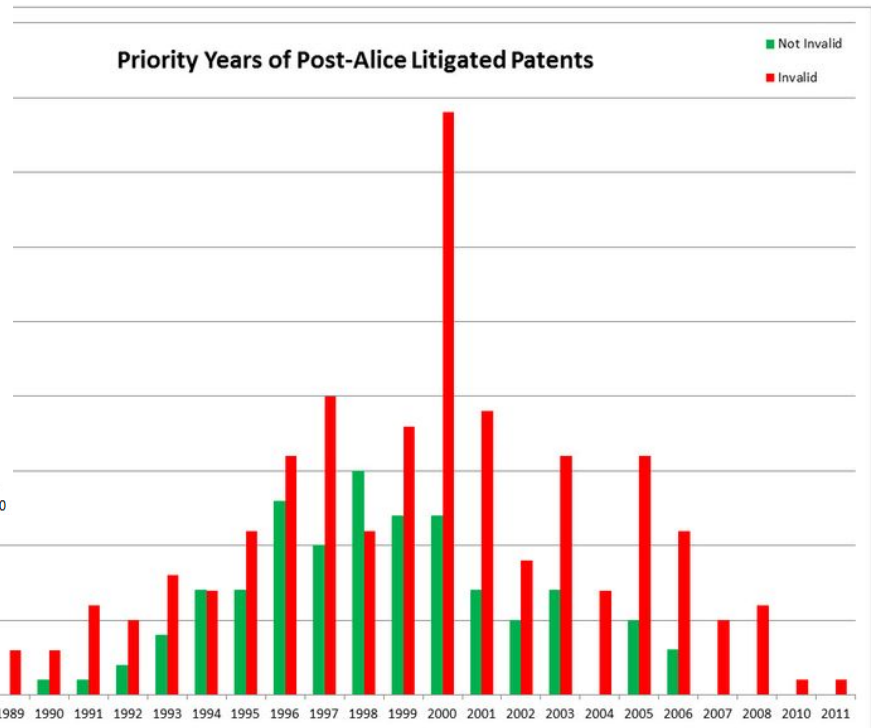
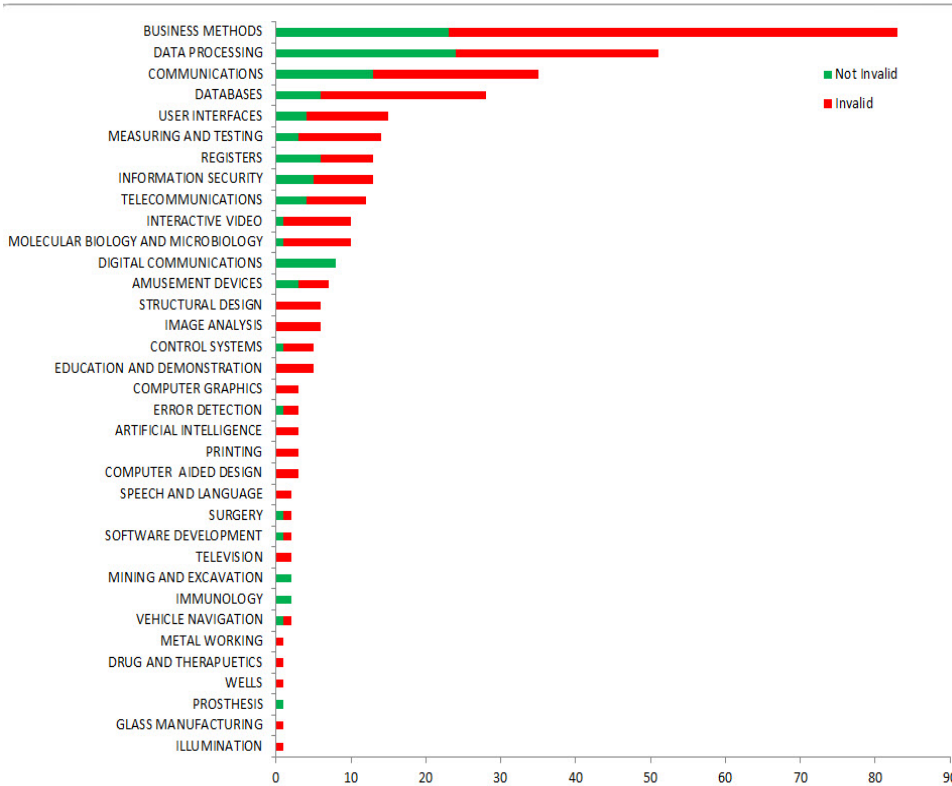
Disposition of CBM Petitions Completed to Date*



Post *Alice* (2014)

	Total	Total Invalid Under §101	% Invalid
Fed. Ct. Decisions	174	127	73.0%
Federal Circuit	19	18	94.7%
District Courts	155	109	70.3%
Patents	354	243	68.6%
Claims	11444	7132	62.3%
Motions on Pleadings	89	64	71.9%
PTAB CBM Institutions	92	77	83.7%
PTAB CMB Final	34	34	100%

Post Alice (2014)



The Current Portfolio

MANAGING THE PORTFOLIO

Current Pending Portfolio

- Assuming you have a growing portfolio of pending U.S. cases:
 - For your pending cases, how do you approach examination strategy from an in-house perspective?
 - What is the evaluation for appeal strategy?
 - What is the evaluation for continuation strategy?

Developing New Portfolio

- Assuming you are developing a new portfolio or augmenting an existing portfolio of U.S cases:
 - What mechanisms have you employed to evaluate filings?
 - What is you decide against filing?
 - What approaches are you taking to drafting specifications? Claims?
 - Where is the “third rail”?

Issued Portfolio

- Assuming we have a set of issued cases that may be affected by 101:
 - How do you set out to access the portfolio?
 - When is this exercise a worthwhile investment?
 - How do you break it down?
 - How do you determine whether to use reexamination or reissue strategy?
 - When would you apply each strategy?

The Bigger Picture

- What is the budget impact on this?
- What do you tell management?
 - How do you fix the portfolio?
 - How do you justify your portfolio going forward?
- Is there a political answer?
 - Should 101 and 103 be revisited?
 - Have we become the United States of Europe with respect to patent law?
 - Inventive step (problem-solution), technical effect
- Has patent quality improved or are there more big levers that may need to be turned (e.g., written description)?

Thank you!



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