

Patent Research & Strategy Seminar

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Law 797

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Jay Kesan, Chirag Shah, Binal Patel, and Louis DiSanto

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Agenda

- 1. Making business decisions with patent research**
2. Patent research strategies in litigation

Understand the Business and Key Business Goals

- What is the Business?
- In what position is the business regarding:
 - maturity, financial health, competitors, competitive position, customers, partners, stage of innovation cycle, etc.
- Identify key business goals
 - IP strategy should align with key business goals

Understand the Patent Portfolio of the Business

- Content and Quality of Portfolio
 - Foundational and/or surrounding patents
 - Scientific and legal quality of patents
- How is the patent portfolio used
 - offensively, defensively, preventively
 - licensing

Understand the Pertinent Patent Landscapes & Portfolios

- Pioneering technology
 - Foundation patents
- Crowded technology
 - Foundation and surrounding patents
- Third party patent portfolios
 - competitors, suppliers, customers, NPEs
 - aggressive players (NPEs)

Patent Research and Business Strategy

CONCEPTUALIZATION

- Novelty Search
- Technology Landscapes
- State-of-the-art Search
- Patent / Technology Watch

PROTECTION

- Patent Drafting
- Patent Filing

MANAGEMENT

- Landscape Analysis
- Portfolio Mapping & Analysis
- Overlap Analysis
- Invalidation Search
- Freedom-to-operate Study
- Claims Mapping
- Litigation Support
- Assertion Strategies

COMMERCIALIZATION

- Patent Valuation
- In-licensing Need Identification
- Out-licensing Opportunity Identification
- Licensing Partner Analysis
- Due Diligence



Timing

- Before product launch
- After notice of patent infringement

Before Product is Launched

- Product Clearance
 - Purpose: identify and resolve potential infringement risks
 - Most frequently performed patent search
 - Generally limited to patents and printed publications
 - Strategic options in view of identified risks
 - Design around
 - Consider licensing blocking patents
 - Opinion of counsel

Before Product is Launched

- Opinion of Counsel
 - Definition: written legal advice on a point of law
 - For patents, generally non-infringement or invalidity
 - Purposes for obtaining opinion of counsel
 - Defense against willful infringement
 - Memorialize clearance analysis
 - Protect reputation

Before Product is Launched

- Opinion of Counsel (continued)
 - Privileged Attorney-Client Communication
 - Waiver of privileged required to rely on opinion
 - Practice note: attorney's reputation at stake

After Notice of Patent Infringement

- Non-infringement vs. Invalidity
 - Assess need for invalidity search
- Patent search to learn about opponent
 - Who are they (practicing or NPE), what other patents do they have, assess strength of same, do they present an ongoing risk

Agenda

1. Making business decisions with patent research
- 2. Patent research strategies in litigation**



Types of “Litigation”

- U.S. District Court
- International Trade Commission (ITC)
- Reexamination before USPTO (*ex parte* & *inter partes*)
- Alternative Dispute Resolution (ADR)



Players

- Accused Infringer
- Patent Holder



Patent Strategies for the Accused Infringer

- Invalidity search
- Claim construction
- Offensive search for patents to counter-assert
- Offensive patenting

Invalidity search

- Patent/non-patent prior art
- On-sale activity
- Commercial use
- Technical experts

Claim construction

- Evidence of how claim term is used in the industry
- Non-patent art

Offensive patent search

- Patents already owned
- Pending patent applications
- Third party patents & published patent applications
- Landscape search
- Engage experts

Offensive patenting

- Study landscape
- Study direction of technology
- Study direction of the business
- Patent the future

Patent Strategies for the Patent Holder

- Preliminary invalidity/inequitable conduct analysis
 - Reexamination / Reissue
 - Certificate of correction
 - Continuation
- Identification of who to sue
- Assessment of accused infringer's patents
- Venue analysis

Patent Strategies for BOTH Litigants

- Opposing counsel investigation
- Local counsel investigation
- Judge investigation
- Jury investigation