

Additional Topics Related to Patent Landscape Reports

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Additional Topics Related to the Strategic Use of Patent Information

- Valuing patent documents
- Prosecution history or file wrapper analysis
- Mapping patents to products
- Litigation analysis
- Predictive models

Valuing Patent Documents – Economic or Market Approaches

- Cost-based approach, which seeks to capture the value of a patent by estimating the cost of replacing the patented technology with another technology
- Market-based approach that values a patent by comparing it with other transactions that involve similar patents

Valuing Patent Documents – Economic or Market Approaches

- Income-based approach values a patent on the basis of the future income derived from utilizing the patented technology
- Option-based approach is based on the option pricing theory developed for use in pricing financial options

Prosecution History or File Wrapper Analysis

- File wrapper statistics
- How many Office Actions
- How many requests for continuing examinations or appeals to the BPAI
- Are the cases open for continued prosecution
- Are there multiple US family members
- Are there foreign equivalents associated with the US granted patent cases
- Foreign equivalents signal higher investment and value

Looking briefly at the file wrappers associated with an example US collection of granted patents we find mostly clean prosecution

Metric	Avg. / patent	Max	Min	Total	Value indication	Comment
Number of Rejections	2	7	0	-	High	44 of 93 granted patents prosecuted with one or zero rejections
RCEs	0	3	0	-	High	
BPAIs	0	1	0	-	High	Only one granted patent found with an appeal in portfolio
Number of Patents Open for Prosecution	-	-	-	3	Low	Two continuing applications ready for examination; Notice of Allowance mailed for third application

So what do indicators say about the portfolio

Forward citation patterns

Large companies are citing this portfolio frequently

There is sustained interest from these companies over an extended period

This suggests a high value portfolio

File wrapper statistics

The portfolio has a very clean prosecution history with an average of 2 office actions per document and 10 first office action allowances

Almost no RCEs and only one appeal to BPAI

Unfortunately, there are only three cases open for prosecution

Suggests a high value portfolio

Are there foreign equivalents associated with the US granted patent cases

More than 75% of the cases have a very small number of foreign equivalents – **this suggests a lower value portfolio**

Data on most heavily cited patents

Most highly cited patents have significant life remaining – **suggests high value**

Public PAIR Use is Example of Micro Level Analysis of Individual Patents

- Uninformed people complain all the time about patents that are quite limited in scope and have significant limitations imposed upon them in order to put them in condition for allowance
- A quick look at a few items in the file wrapper can offer some idea of how broad and potentially valuable a patent is
- Any conclusions, especially business critical ones, should be confirmed by a patent attorney
- This review can assist with that conversation

What is US Public PAIR and How can I Access the Information?

- PAIR (Patent Application Information Retrieval) is the USPTO Registry system for information on the prosecution of patent applications
- Once the application publishes or the patent grants this information is made available to the public
- Most cases available with electronic Image File Wrapper since 2002
- <http://portal.uspto.gov/external/portal/pair>

Once past the reCAPTCHA you Enter the Patent or Application Number

- No kind or country codes necessary
- Application number should include / after series number but no comma in serial number
- Publication Number is for pre-grant apps

The screenshot shows a web browser window titled "Patent Application Information Retrieval". At the top left, there is a button labeled "Select New Case". Below this, the page has a section header "Select New Case". A note in red text states "* indicates a required field". Below this, a paragraph reads "You may search for a specific application or conduct a search related to a customer number." The main section is titled "Search for Application:" and contains the text "Choose type of number:". There are five radio button options, each with an information icon (i) to its right: "Application Number (EXAMPLE: 99999999 or 99/999999)", "Control Number", "Patent Number", "PCT Number (EXAMPLE: PCT/CCYY/99999 or PCT/CCYYYY/999999)", and "Publication Number". At the bottom left, there is a label "* Enter number:" followed by a text input field and a "SEARCH" button.

PAIR is Organized Using a Tabbed Interface - Application Data Tab

- When was the application filed?
- What is the status - is it still in-force?
- Does the location say Electronic or File Repository?
- Is there a pre-grant app?

The screenshot shows the PAIR interface for application 09/180,558, titled "AUTOMATED TRANSACTION MACHINE". The interface includes a navigation bar with tabs for "Select New Case", "Application Data", "Transaction History", "Patent Term Extension History", "Continuity Data", "Fees", "Published Documents", "Address & Attorney/Agent", and "Display References". The "Application Data" tab is active, displaying "Bibliographic Data".

Bibliographic Data			
Application Number:	09/180,558	Customer Number:	-
Filing or 371 (c) Date:	11-06-1998	Status:	Patented Case
Application Type:	Utility	Status Date:	08-31-2005
Examiner Name:	LE, THIEN MINH	Location:	TECH CENTER 2800 - JEF-00C05
Group Art Unit:	2876	Location Date:	02-21-2006
Confirmation Number:	6921	Earliest Publication No:	-
Attorney Docket Number:	62225-002	Earliest Publication Date:	-
Class / Subclass:	235/380	Patent Number:	6,945,457
First Named Inventor:	DAVID M. BARCELOU , HUNTINGDON VALLEY, PA (US)	Issue Date of Patent:	09-20-2005

Title of Invention: AUTOMATED TRANSACTION MACHINE

Continuity Data Tab

- Is there a PCT filing?
- Is the family still open for prosecution?
- Are there additional US family members?

Parent Continuity Data				
Description	Parent Number	Parent Filing or 371(c) Date	Parent Status	Patent Number
This application is National Stage Entry of	PCT/US97/08089	05-09-1997	Published	-
Claims Priority from Provisional Application	60/017,533	05-10-1996	Expired	-
Child Continuity Data				
11/123,982 filed on 05-06-2005 which is Pending claims the benefit of 09/180,558				
11/982,045 filed on 10-31-2007 which is Pending claims the benefit of 09/180,558				
11/982,044 filed on 10-31-2007 which is Pending claims the benefit of 09/180,558				
11/982,043 filed on 10-31-2007 which is Pending claims the benefit of 09/180,558				
11/981,993 filed on 10-31-2007 which is Patented claims the benefit of 09/180,558				
11/981,994 filed on 10-31-2007 which is Pending claims the benefit of 09/180,558				
11/981,992 filed on 10-31-2007 which is Pending claims the benefit of 09/180,558				
11/981,991 filed on 10-31-2007 which is Pending claims the benefit of 09/180,558				
11/981,988 filed on 10-31-2007 which is Pending claims the benefit of 09/180,558				
11/981,963 filed on 10-31-2007 which is Pending claims the benefit of 09/180,558				
11/981,959 filed on 10-31-2007 which is Pending claims the benefit of 09/180,558				
11/981,966 filed on 10-31-2007 which is Patented claims the benefit of 09/180,558				
11/981,965 filed on 10-31-2007 which is Patented claims the benefit of 09/180,558				
11/981,964 filed on 10-31-2007 which is Pending claims the benefit of 09/180,558				
11/981,961 filed on 10-31-2007 which is Patented claims the benefit of 09/180,558				
11/981,967 filed on 10-31-2007 which is Patented claims the benefit of 09/180,558				
11/982,187 filed on 10-31-2007 which is Pending claims the benefit of 09/180,558				
11/982,186 filed on 10-31-2007 which is Patented claims the benefit of 09/180,558				
11/982,244 filed on 10-31-2007 which is Patented claims the benefit of 09/180,558				
11/982,240 filed on 10-31-2007 which is Patented claims the benefit of 09/180,558				
11/982,243 filed on 10-31-2007 which is Patented claims the benefit of 09/180,558				
11/982,241 filed on 10-31-2007 which is Patented claims the benefit of 09/180,558				
11/981,920 filed on 10-31-2007 which is Patented claims the benefit of 09/180,558				
11/982,024 filed on 10-31-2007 which is Patented claims the benefit of 09/180,558				
11/981,968 filed on 10-31-2007 which is Patented claims the benefit of 09/180,558				
11/981,962 filed on 10-31-2007 which is Patented claims the benefit of 09/180,558				
11/981,969 filed on 10-31-2007 which is Pending claims the benefit of 09/180,558				
12/951,866 filed on 11-22-2010 which is Patented claims the benefit of 09/180,558				
13/621,193 filed on 09-15-2012 which is Pending claims the benefit of 09/180,558				
13/621,196 filed on 09-15-2012 which is Pending claims the benefit of 09/180,558				
13/621,200 filed on 09-15-2012 which is Pending claims the benefit of 09/180,558				

Patent Term Extension History Tab

- Previously called Patent Term Adjustment (PTA)
- In this case the patent was not extended
- Displays delays by applicant and by the Patent Office

The screenshot shows the PAIR system interface for application 09/180,558. The main title is "AUTOMATED TRANSACTION MACHINE" with the application number 09/180,558 on the left and the serial number 62225-002 on the right. A navigation bar contains buttons for "Select New Case", "Application Data", "Transaction History", "Patent Term Extension History", "Continuity Data", "Fees", "Published Documents", "Address & Attorney/Agent", and "Display References". The "Patent Term Extension" section shows a filing date of 11-06-1998 and a USPTO adjustment of +0 days, resulting in a total extension of 0 days. The "Patent Term Extension History" table lists two events: "Mail Notice of Allowance" on 02-08-2005 and "Notice of Allowance Data Verification Completed" on 02-07-2005, both with 0 days of PTO or APPL delay.

Patent Application Information Retrieval			
09/180,558		AUTOMATED TRANSACTION MACHINE	
		62225-002	
Select New Case	Application Data	Transaction History	Patent Term Extension History
Continuity Data	Fees	Published Documents	Address & Attorney/Agent
Display References			
Patent Term Extension			
Filing or 371(c) Date:	11-06-1998	USPTO Delay (PTO) Delay (days):	0
USPTO Adjustment (days):	+0	Corrections (APPL) Delay (days):	0
Explanation Of Calculations		Total Patent Term Extension (days):	0
Patent Term Extension History			
Date	Contents Description	PTO(Days)	APPL(Days)
02-08-2005	Mail Notice of Allowance		
02-07-2005	Notice of Allowance Data Verification Completed		

Display References Tab

- How much prior art did the applicant make available to the examiner?
- Are there any 892 or examiner citations associated with case?
- Are there NPLs?

14/084 966		AUTOMATED TRANSACTION MACHINE							ATL1CON9		
1Password		Select New Case	Application Data	Transaction History	Image File Wrapper	Patent Term Adjustments	Continuity Data	Fees	Published Documents	Address & Attorney/Agent	Display References
Reference Forms											
Mail Room	Date	Document Code	Document Description	Page Count	<input type="checkbox"/>	PDF					
05-19-2009		1449	List of References cited by applicant and considered by examiner	11	<input type="checkbox"/>						
05-19-2009		1449	List of References cited by applicant and considered by examiner	11	<input type="checkbox"/>						
05-19-2009		1449	List of References cited by applicant and considered by examiner	11	<input type="checkbox"/>						
05-19-2009		1449	List of References cited by applicant and considered by examiner	1	<input type="checkbox"/>						
05-19-2009		1449	List of References cited by applicant and considered by examiner	10	<input type="checkbox"/>						
05-19-2009		1449	List of References cited by applicant and considered by examiner	6	<input type="checkbox"/>						
05-19-2009		1449	List of References cited by applicant and considered by examiner	6	<input type="checkbox"/>						
05-19-2009		1449	List of References cited by applicant and considered by examiner	6	<input type="checkbox"/>						
05-19-2009		1449	List of References cited by applicant and considered by examiner	6	<input type="checkbox"/>						
10-17-2008		IDS	Information Disclosure Statement (IDS) Form (SB08)	6	<input type="checkbox"/>						
10-17-2008		IDS	Information Disclosure Statement (IDS) Form (SB08)	6	<input type="checkbox"/>						
10-17-2008		IDS	Information Disclosure Statement (IDS) Form (SB08)	6	<input type="checkbox"/>						
10-17-2008		IDS	Information Disclosure Statement (IDS) Form (SB08)	6	<input type="checkbox"/>						
10-17-2008		IDS	Information Disclosure Statement (IDS) Form (SB08)	10	<input type="checkbox"/>						
10-17-2008		IDS	Information Disclosure Statement (IDS) Form (SB08)	1	<input type="checkbox"/>						
10-08-2008		IDS	Information Disclosure Statement (IDS) Form (SB08)	11	<input type="checkbox"/>						
10-06-2008		IDS	Information Disclosure Statement (IDS) Form (SB08)	11	<input type="checkbox"/>						
10-03-2008		IDS	Information Disclosure Statement (IDS) Form (SB08)	11	<input type="checkbox"/>						
09-11-2008		892	List of references cited by examiner	1	<input type="checkbox"/>						
09-11-2008		1449	List of References cited by applicant and considered by examiner	1	<input type="checkbox"/>						
10-31-2007		IDS	Information Disclosure Statement (IDS) Form (SB08)	1	<input type="checkbox"/>						
Foreign Patent and Non-Patent Documents											

Image File Wrapper Tab

- Are there Terminal Disclaimers?
- How many Office Actions until an allowance?
- Are there any abandonments in the file?
- Did the claims change?

05-21-2009	DISQ	Terminal Disclaimer review decision	PROSECUTION	1	<input type="checkbox"/>
05-19-2009	NOA	Notice of Allowance and Fees Due (PTOL-85)	PROSECUTION	7	<input type="checkbox"/>
05-19-2009	FWCLM	Index of Claims	PROSECUTION	1	<input type="checkbox"/>
05-19-2009	IIFW	Issue Information including classification, examiner, name, claim, renumbering, etc.	PROSECUTION	1	<input type="checkbox"/>
05-19-2009	SRFW	Search information including classification, databases and other search related notes	PROSECUTION	1	<input type="checkbox"/>
05-19-2009	BIB	Bibliographic Data Sheet	PROSECUTION	1	<input type="checkbox"/>
05-19-2009	SRNT	Examiner's search strategy and results	PROSECUTION	2	<input type="checkbox"/>
05-19-2009	1449	List of References cited by applicant and considered by examiner	PROSECUTION	11	<input type="checkbox"/>
05-19-2009	1449	List of References cited by applicant and considered by examiner	PROSECUTION	11	<input type="checkbox"/>
05-19-2009	1449	List of References cited by applicant and considered by examiner	PROSECUTION	11	<input type="checkbox"/>
05-19-2009	1449	List of References cited by applicant and considered by examiner	PROSECUTION	1	<input type="checkbox"/>
05-19-2009	1449	List of References cited by applicant and considered by examiner	PROSECUTION	10	<input type="checkbox"/>
05-19-2009	1449	List of References cited by applicant and considered by examiner	PROSECUTION	6	<input type="checkbox"/>
05-19-2009	1449	List of References cited by applicant and considered by examiner	PROSECUTION	6	<input type="checkbox"/>
05-19-2009	1449	List of References cited by applicant and considered by examiner	PROSECUTION	6	<input type="checkbox"/>
05-19-2009	1449	List of References cited by applicant and considered by examiner	PROSECUTION	6	<input type="checkbox"/>
03-10-2009	A...	Amendment/Req. Reconsideration-After Non-Final Reject	PROSECUTION	1	<input type="checkbox"/>
03-10-2009	REM	Applicant Arguments/Remarks Made in an Amendment	PROSECUTION	1	<input type="checkbox"/>
03-10-2009	DIST	Terminal Disclaimer Filed	PROSECUTION	1	<input type="checkbox"/>

Notice of Allowance Provides Reasons for Granting the Patent Document

- First 15 claims canceled - presumably double patenting
- Claim 16 has many steps including - “selectively dispense encodable credit”
- Pretty specific claim overall

Allowable Subject Matter

Claims 16-31 are allowed.

The following is a statement of reasons for the indication of allowable subject matter:

The prior art fails to disclose an integrated banking and transaction machine comprising: (i) an automated teller machine; (ii) a user interface to the automated teller machine; (iii) means for identifying the user to the automated teller machine; (iv) an Internet interface to an Intranet connection; (iv) access to the automated teller machine user interface whereupon the consumer may selectively dispense encodable credit using the integrated banking and transaction machine providing the retail ATM service; and having functions and characteristics in the manners as recited in claim 16.

Conclusions from Analysis

- The original patent is still in-force with a 1998 priority date
- At least 15 US granted patents in the family
- Open for continued prosecution
- At least 10 applications still pending
- PCT filing suggests possibility of international filings
- Significant number of patent and non-patent literature references considered during examination
- Likely a valuable portfolio

Mapping Patents to Products

- With a patent to product mapping, you start assigning a true value to patents. With that improved capability you have a greater capacity to maximize the return on your intellectual property investment.
- You would have a better understanding of which patents are your most valuable and which have very little value. If you could tie your patents to your products the actual assessment could be performed with greater accuracy and precision, which in turn could help you

Litigation Analysis

- The reality of patent monetization is that in order to be taken seriously it is sometimes necessary to engage in litigation over patent infringement. The threat of legal action is sometimes required even when the goal of the patent owner is to engage in a negotiation for a reasonable license for the technology developed. Understanding the patent litigation environment, and how it operates, is a key requirement for organizations who intend to operate in technology driven industries.
- Reports available from RPX and PriceWaterhouseCoopers

Litigation Alerts – PriorSmart

- <http://news.priorsmart.com/>
- Best known for US litigation daily email
- Let me know if you would like an invitation
- Provides free searching
- Provides list of new patent litigations in the US
- Provides list of patent related Twitter activity
- Provides list of patent related blog posts
- Other services available by request

Litigation Alerts – PriorSmart

The screenshot shows the PriorSmart website interface. At the top, there are navigation links for 'Patent search', 'Patent & IP news', and 'Document monitoring'. The main header features the 'PRIORSMART.com' logo, a 'Follow us on Twitter here!' button, and links for 'Latest', 'Yesterday', and 'Archives'. Below the header, the date 'Patent & IP news for February 22, 2011' is displayed.

The page is divided into several sections:

- USPTO Weekly Stats:** A bar chart showing 5,370 published applications, 5,075 granted patents, and 102 BPAI decisions.
- Latest Patent Tweets:** A list of tweets including: 'Google Asks Patent Office for Second Opinion on Oracle's Android Claims - Application Development', 'Austin Entrepreneurs IP Blog: The First Three Things That Entrepreneurs Need To ...', 'You have to see this invention! I want to know who was the lucky patent attorney who got to file this application.', 'RT @SocMfgEng: Patent Office Struggles To Keep Up With Technology', 'Senate to debate patent reform legislation Feb. 28: "first major overhaul of U.S. patent law in nearly 60 years."', 'RT @seedmag: Rethinking IP: James Moody on how patent law can help both the developed and the developing world.', 'Sony, Activision, among those named in patent infringement lawsuit ...', and 'RT @uspto: Building a Better Patent Office -- In case you missed this weekend's New York Times:'.
- Recent Patent & IP Blogs:** A list of blog posts including: 'Updating IP tax book - what would you like it to include?' from ipfinance.blogspot.com, 'State manufacturing centers - and managing intangibles' from www.athenaalliance.org, and 'Patented Group Discounts Are Only Logical' from gametimeip.com.
- New Patent Litigations:** A list of recent court cases including: 'Tex Pat, LLC v. Tyco International Ltd et. al.' filed today in Texas Eastern, 'Patent Group LLC v. Haws Corporation' filed yesterday in Texas Eastern, 'Vellata LLC v. Ciena Corporation' filed 4 days ago in California Central, 'Gonzales v. Tristar Products, Inc et. al.' filed 4 days ago in California Southern, and 'Seal Aftermarket Products, LLC v. GFX, Inc. d/b/a GFX Corp.' filed 4 days ago in Florida Southern.

Predictive Models

- Various models have been generated that use patent information to predict future behavior of one type or another. One of the most famous uses US maintenance data to predict how valuable patents are, compared to one another, and how valuable a recently granted patent might be.
- Theoretically, a model can also be built based on the likelihood that an assignee will allow a patent to be abandoned by not paying a maintenance fee at some point during the life of the document