

Additional Topics Related to Patent Landscape Reports

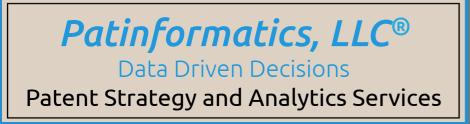
Anthony Trippe

Managing Director – Patinformatics, LLC

WIPO Regional Workshop on Patent Analytics

National Institute of Industrial Property (INPI)

Rio de Janeiro, Brazil – 28 August 2013



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	I	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

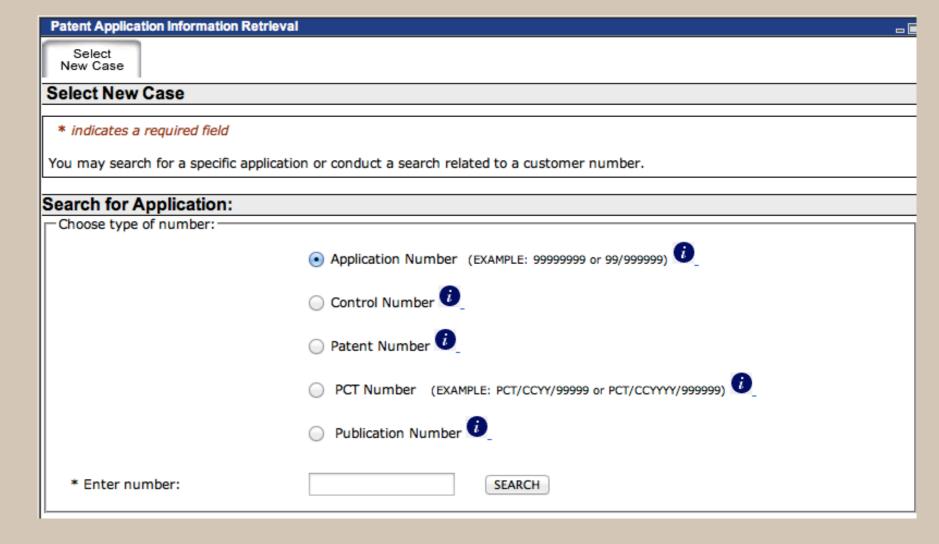
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Once past the reCAPTCHA you Enter the Patent or Application Number

- 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



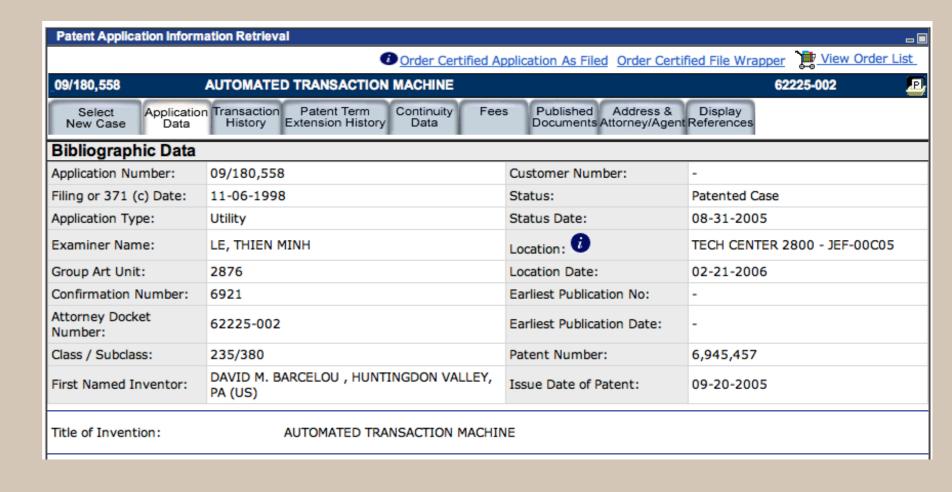
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PAIR is Organized Using a Tabbed Interface - Application Data Tab

- 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 pregrant app?



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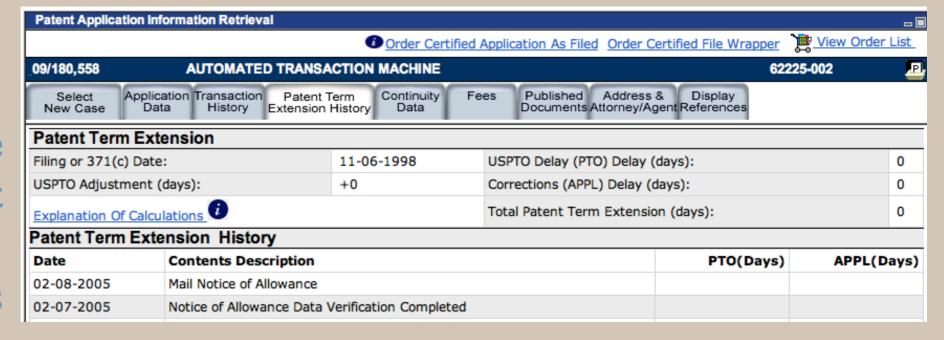
Continuity Data Tab

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

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 Per	nding claims the benefi	t of <u>09/180,558</u>		
11/982,045 filed on 10-31-2007 which is Per	nding claims the benefi	t of <u>09/180,558</u>		
11/982,044 filed on 10-31-2007 which is Per	nding claims the benefi	t of <u>09/180,558</u>		
11/982,043 filed on 10-31-2007 which is Per	nding claims the benefi	t of <u>09/180,558</u>		
11/981,993 filed on 10-31-2007 which is Pat	ented claims the bene	fit of <u>09/180,558</u>		
11/981,994 filed on 10-31-2007 which is Per	nding claims the benefi	t of <u>09/180,558</u>		
11/981,992 filed on 10-31-2007 which is Per	_			
11/981,991 filed on 10-31-2007 which is Per	_			
11/981,988 filed on 10-31-2007 which is Per				
11/981,963 filed on 10-31-2007 which is Per	_			
11/981,959 filed on 10-31-2007 which is Per	_			
11/981,966 filed on 10-31-2007 which is Pat				
11/981,965 filed on 10-31-2007 which is Pat				
11/981,964 filed on 10-31-2007 which is Per	_			
11/981,961 filed on 10-31-2007 which is Pat				
11/981,967 filed on 10-31-2007 which is Pat				
11/982,187 filed on 10-31-2007 which is Per				
11/982,186 filed on 10-31-2007 which is Pat				
11/982,244 filed on 10-31-2007 which is Pat				
11/982,240 filed on 10-31-2007 which is Pat				
11/982,243 filed on 10-31-2007 which is Pat				
11/982,241 filed on 10-31-2007 which is Pat				
11/981,920 filed on 10-31-2007 which is Pat				
11/982,024 filed on 10-31-2007 which is Pat				
11/981,968 filed on 10-31-2007 which is Pat				
11/981,962 filed on 10-31-2007 which is Pat				
11/981,969 filed on 10-31-2007 which is Per				
12/951,866 filed on 11-22-2010 which is Pat				
13/621,193 filed on 09-15-2012 which is Per	_			
13/621,196 filed on 09-15-2012 which is Per	_			
13/621,200 filed on 09-15-2012 which is Per	nding claims the benefi	t of 09/180,558		

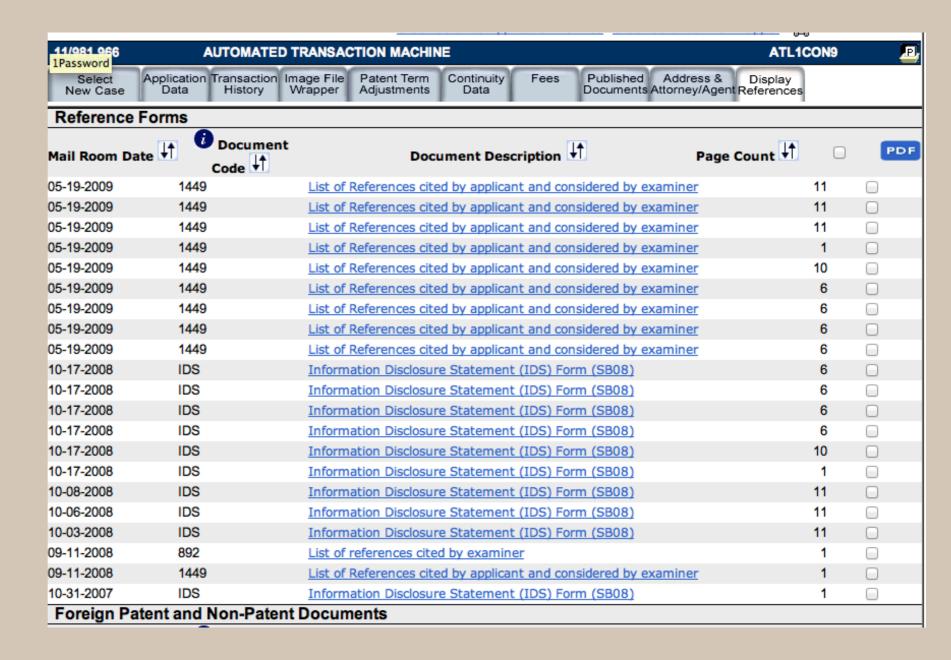
Patent Term Extension History Tab

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



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 thereNPLs?



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

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Notice of Allowance Provides Reasons for Granting the Patent Document

- First I5 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.

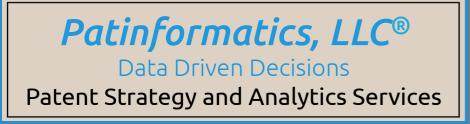
Conclusions from Analysis

- 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

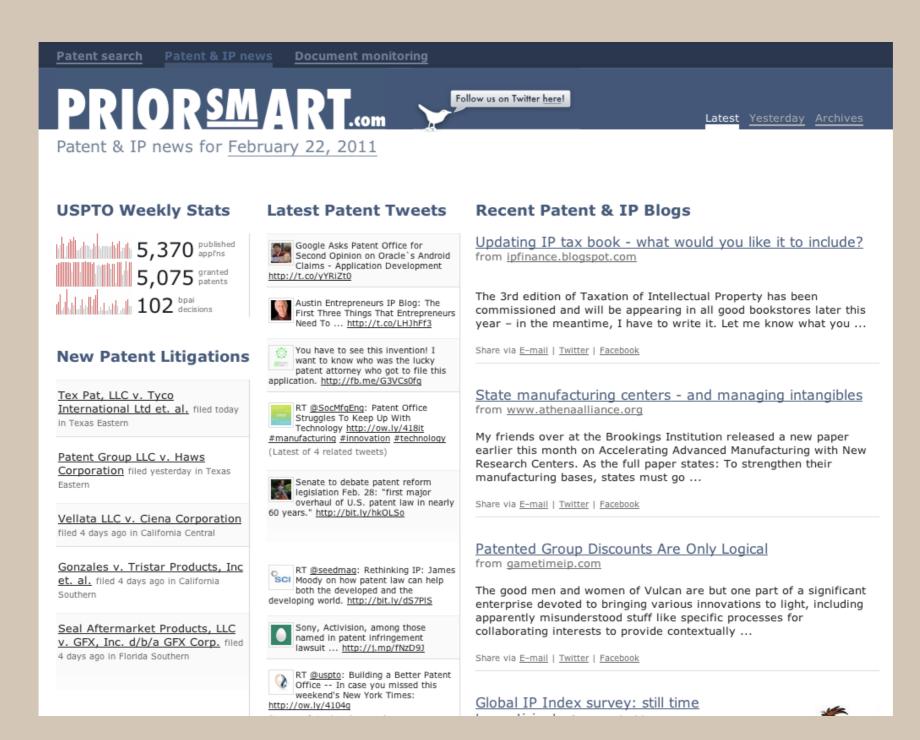
- http://news.priorsmart.com/
- Best known for US litigation daily email
- Let me know if you would like an invitation
- Provides free searching
- Provides list of new patent litigations in the US
- Provides list of patent related Twitter activity
- Provides list of patent related blog posts
- Other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

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Litigation Alerts – PriorSmart





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