

5 KEY TAKEAWAYS

From the Ground Up: Building and Maintaining a Patent Portfolio Tailored to your Company's Needs

Starting and maintaining a patent portfolio for your company is a daunting task regardless the size of the company. Where do you begin? How do you ensure the intellectual property assets you are outlaying capital to acquire fit corporate objectives? Kilpatrick Townsend's [Karam J. Saab](#) recently presented the webinar "From the Ground Up: Building and Maintaining a Patent Portfolio Tailored to your Company's Needs." Mr. Saab addressed getting ideas from your company's thought leaders; identifying what ideas to protect and how best to protect them; how to continuously audit your patent portfolio; and how in-house counsel should work with outside counsel to maximize value.

Key takeaways from the presentation, include:

1

When building a company's patent program, having both real-time and periodic idea submission arrangements are key. A real-time submission arrangement allows employees to submit ideas for patenting consideration whenever convenient to the employee. A periodic idea submission arrangement involves scheduling time in front of teams of employees to question them about their projects and where they see the company headed in the future. Many employees are not focused on intellectual property, so having a scheduled time to remind and question them, even if only annually, can yield significant patentable material.

2

Once potentially patentable ideas have been collected, a company needs a systematic method of deciding which ideas should be pursued for patenting. In many companies, this method takes the form of a patent review board (PRB) composed of a small group of senior thought leaders within the company. These leaders decide for which ideas patent applications should be filed. In other companies, a single trusted advisor, such as an in-house counsel makes the decision unilaterally or in combination with advice from outside counsel. While the former method has the benefit of getting buy-in from multiple leaders, the latter method is streamlined and more efficient.

3

A defined scoring system is essential for successful patent portfolio management. When ideas are selected for patenting, the ideas should be ranked according to various factors such as: importance to the company's product line and competitors' product lines; the perceived significance of the idea; how easy it will be to detect infringement; and how difficult it will be for a competitor to accomplish the same outcome a different way. This scoring system should be continuously updated during prosecution of the patent application and even after the patent issues.

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The defined score can help in-house counsel decide on a course for any patent applications to be filed outside the US, how much budget should be invested in prosecution of the application, and whether maintenance fees or annuities should continue to be paid. Further, by having a coherent scoring system, identifying the most important filings for a company in a particular technology area becomes a relatively easy task. When a trusted and maintained scoring system is used across a portfolio, obtaining a list of the most valuable assets in a particular technology area can be a ten-minute task instead of a multi-day project.

5

Continuation and divisional application filing decisions are critical to successful portfolio management. Failure to file a continuation or divisional application for an allowed patent application essentially closes the application's subject matter from future claims being pursued. Frequently, continuations and divisional applications become the most valuable members of a patent family when compared to the initial filing due to more successful targeting of allowable material, targeting of your company's products, and targeting of competitors' products. These decisions should be made carefully with significant communication between in-house counsel and patent counsel.

For more information, please contact Karam J. Saab:

ksaab@kilpatricktownsend.com

www.kilpatricktownsend.com