

Insights: Publications

5 Key Takeaways | From Invention to Strategic Portfolios – Following the Lifecycle of a Patent through Corporate Transactions

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Kilpatrick's [Tyler McAllister](#) and [Siegmar Pohl](#) recently presented "**From Invention to Strategic Portfolios – Following the Lifecycle of a Patent through Corporate Transactions**" at the firm's annual SEA-LE in Seattle. Their session explored how strategic, multi-layered patent portfolio development drives value at every stage of a company's growth. Tyler and Siegmar traced the lifecycle of a patent, from early-stage startup innovations to mature corporate patent portfolios. Integrating perspectives from both patent prosecution and corporate transaction specialists, the session demonstrated how a well-reasoned filing strategy directly impacts funding rounds and venture capital investment. Attendees gained practical insights into building and managing a cohesive patent portfolio that aligns technical protection with key corporate milestones. M&A events, filing and enforcement strategies as well as licensing policies hugely impact the roll out of a technology and success of an industry.

Key takeaways from the presentation include:

1. File Early, and File with a Plan

A provisional buys priority cheaply. Stop thinking of it as "just a placeholder." Priority runs only to what the application actually describes and enables. File a thin provisional and you have a priority date for the slide deck, not for the claims you need twelve months later. For platform companies, multiple provisionals usually beat one comprehensive filing. Each invention gets captured when it is real, and six applications tell an investor you have an R&D engine rather than one idea. Even with first Office Action pendency rates going down at the USPTO, filing on Track One before financing should be strongly considered. An issued patent in the data room is a different asset than a pending application.

2. FTO Opinions Reduce Risk

Someone in every room says it. Do not get the opinion, because a written record of knowledge hands the other side willfulness. Congress already answered that. Section 298 bars a patentee from using the absence of advice of counsel to prove willfulness, and courts have been closing any loopholes. Halo did not open the floodgates either. In Halo itself, a jury found willfulness and the district court still refused to enhance. A willfulness verdict is a gateway, not an entitlement. Enhancement is reserved for conduct that is "characteristic of a pirate." A client who reads the patent, hires competent counsel, and relies on a reasoned opinion is the opposite of a pirate. Remember also that owning a patent is not permission to practice. Those are two different questions.

3. Structure Matters in IP Transactions

Early-stage venture deal documents typically include basic IP representations and warranties. Later stage investments and M&A agreements contain more comprehensive IP representations. Adding qualifiers like "to the knowledge of the company" to representations that the Company's IP is owned by the company, valid, sufficient, and does not infringe third party rights can allocate risk. Some of these representations can have, directly or indirectly, the same scope as Freedom-to-Operate opinions. Asset deals require filing individual assignments of all registered IP which can be a logistical burden that does not exist in stock deals. When combining portfolios or licenses through M&A deals, antitrust safeguards can make or break a transaction.

4. Chain of Title is Everything

Broken assignment chains are the #1 diligence failure. Companies and investors should verify present assignment language from the inventor to the company. Particular attention should be given to the assignment of pre-incorporation IP, and of IP developed while working for the company. "Work for hire" language may not be sufficient. It is important that the inventor and any other individuals working for the company assign all their IP related to the company's business and not only registered patents. IP assignment agreements are broader than the invention assignments filed with a patent application, and the agreements need to comply with carve-outs for pre-existing IP required by state-specific employment laws.

5. Portfolios Drive Enterprise Value

Depth is what moves price, and depth is not the same as volume. Overlapping claims across a family, multiple claim types, genus plus species, and design patents all change the arithmetic on the other side of the table. A competitor's engineers ask one question. What does it cost to design around this? Against one patent that is a project. Against a layered family it is a rewrite, and at some point the license is cheaper than the rebuild. Present it that way. A schedule of numbers is table stakes and persuades no one. Claim maps showing coverage of the buyer's products and its competitors' products convert the portfolio from a cost line into an asset. Filing a burst of continuations before a process opens is a tell, not a strategy, and since January 2025 those late filings carry a surcharge of \$2,700 at six years and \$4,000 at nine. Build the blockers before the six-year mark.

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