



Patent Opinion

Drafting and Business Applications

30. Oktober 2014, Copenhagen

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Program

Programme overview

- Patents and business
- Patent policies of companies
- Patent risks for companies
- What input does a company require, when and why?

Types of opinions

- Patentability of an invention
- Validity of a patent right
- Infringement opinion - or non-infringement opinion?
- Freedom-to-Operate
- Situations of use
- Due diligence, when it all comes together

Presentation per type of opinion

- Defining the purpose of the opinion in the light of the company's requirements
- Defining the facts for your opinion
- Finding arguments for your opinion
- Building up your opinion

Practical advice and pitfalls

- Know your public
- Know where to start and where to stop
- Finding facts and arguments
- Checklist

Case studies

- Infringement
- Company acquisition

Speaker: Jasper Groot Koerkamp

European Patent Attorney, AOMB IP Consultants, Den Haag (The Netherlands)

Jasper started his career as a patent attorney with Royal Philips Electronics in 2001, after he obtained his MSc degree at the faculty of Electrical Engineering and Computer Science of Delft University of Technology. In 2006, Jasper joined NXP Semiconductors. With Philips and NXP, he counseled business in various projects, including standardisation, licensing, infringement and M&A. Jasper moved to private practice in 2009, with an all-round practice including preparation and prosecution as well as litigation for small and medium sized companies. Jasper joined AOMB in 2013.



About us

The FORUM · Institut für Management GmbH was founded in Heidelberg, Germany, in 1979. In 2012 the FORUM Institut became a subsidiary of SRH. SRH is a leading private provider of educational and health-care services. SRH operates private universities, training centers, schools and hospitals in Germany.

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- Financial Services / Banking
- Intellectual Property Law
- Information Technology
- Insurance, Controlling, Taxation
- Law
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- Pharmaceutical

FORUM Institut is also involved in other fields of interest that have mid- or long-term effects on corporate management and strategy.

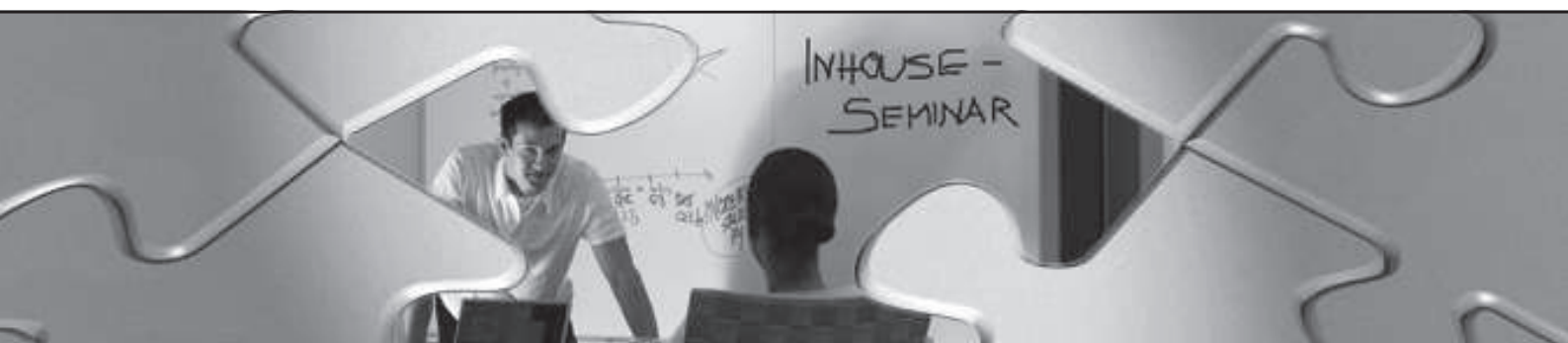
In addition, we organise special conferences such as the Tax-FORUM, the Product Liability Conference, the „Pharma Trends“ Conference and the International Trademark Conference. These conferences have become „jours fixes“ among experts.

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- Federal Chancellor Helmut Schmidt
- Former UNEP Exec. Director
Prof. Dr. Klaus Töpfer
- Daniel Goeudevert
- Pascal Couchepin
- Jean-Claude Trichet
- Dr. Murray M. Lumpkin, MD
- Sir Edward Heath
- The Hon. Lord Hoffmann
- Prof. Dr. Martin Feldstein
- Henry Kaufman
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Documentation

Your speaker

Jasper Groot Koerkamp

Patent opinions

Serving business as an expert

Patent opinions
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Me

- European and Dutch patent attorney
- Algemeen Octrooi- en Merkenbureau
- MSc. Electrical Engineering, Delft University
- Two years experience in semiconductor engineering
- Eight years as a patent attorney in industry
- Five years private practice

Patent opinions
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Fields of experience

- Preparation & prosecution
- Portfolio management
- Infringement analysis
- Validity analysis
- Litigation
- M&A
- IP aspects of standardisation

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You?

Patent opinions
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WHERE DO OPINIONS FIT IN - BUSINESS DISCUSSED

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Paradigm

Without a business, a patent is like a steamship in the
Sahara

Utterly useless

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Objective

- Connect the legal and technical world to the business world
- To enable decision makers to make a well founded decision
- To reduce risk; and
- Improve the bottom line

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How do patents fit in business

- Asset
 - Direct income
 - Indirect income
- Risk factor
 - Licensing cost
 - Jury/court
 - Shopstopper
 - Company image



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Patent policies - direct

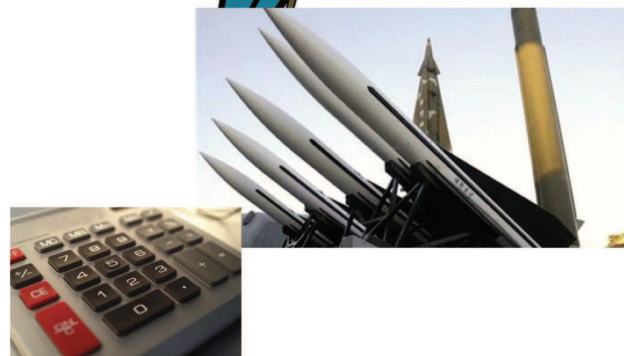
- Sale of patents
 - With technology, IBM
 - As such, Nokia
- Licensing
 - Standards, Ericsson, Qualcomm
 - Non standard, Intellectual Ventures



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Patent policies - indirect

- Monopoly
- Cross-licensing
- Deterrent
- Marketing
- Employee rewards
- Building assets portfolio
- Tax advantages



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Patent policies for have-nots

- Design, manufacture and/or sell, wait and see
- Evade (territorial)
- Design around
- Opposition

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Patent risk factors

- Direct income
 - Invalidity, non-infringement
- Indirect income
 - Invalidity, non-infringement
- Non-patent business
 - Validity, infringement



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Life is so simple...

... But the devil is in the details



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WHAT IS YOUR BUSINESS?

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Traditional business process

- R&D
 - Protection of innovation
 - Risk of infringement
- Production and sales
 - Product detention
 - Licensing cost
 - Cheap copies
- Corporate events
 - What value do patents attribute to the business?



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R&D

- Define milestones and checks per milestone
- Protection
 - Define invention - or inventions
 - Unity of invention
 - Patentability
- Risk assessment
 - Use of standards?
 - Known claims?



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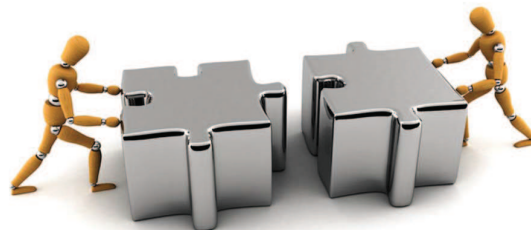
Production and sales

- Continuous process from development
 - Continue risk assessment? Or not?
 - Protection of further developments?
- But also the outside world
 - How to address (cheap) copies
 - How to handle allegations of infringement
 - Ruptures in supply

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Corporate events

- Buyers and investors want to know all
 - Income
 - Now
 - Future
 - Risks
- Bankruptcy?
 - Also the administrator wants to know all



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Licensing business

- Licensing programme development
 - Will technology be used?
 - Will the subject-matter apply to the standard?
- Offering of licences
 - Infringement
 - Validity
 - Circumvention risk?
- Enforcement
 - Injunction allowed?



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Preparing technology for licensing

- Develop towards standardisation?
- Is technology patentable?
- Will the technology end up in the standard?
 - Infringement assessment of draft specs
 - Lobbying for acceptance in the specification
- Will the technology be used in any other way?
- Non-standard essentials

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Preparing patents for licensing

- Does the technology infringe?
- Will counterparts license in or work around?
- How strong is the patent?
- What in-court enforcement is available?
 - Injunction?
 - Or damages only?
- For traditional business: backfire risk?

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THE NEED FOR YOUR OPINION IN BUSINESS

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What does the CEO need?

- Your opinion
 - As a legal expert
 - With a technical background
- To evaluate scenarios
 - Risks
 - Opportunities
- And take a decision
 - That you do not have to take



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Opinion

- As expected by your client:
"a formal expression of judgment or advice by an expert"
- As you may see it:
"belief stronger than impression and less strong than positive knowledge"

Source: Merriam-Webster dictionary

Do believe you hold the truth?

What opinion to provide?

- Each situation requires a bespoke approach
- Many situations are very similar
- Independent from which side your client is on
- But always tailor templates to your client's need

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What every opinion needs

- Input received
- Questions to assess
- Assessment of the input to answer the questions
- Conclusion
- Recommendation
- Executive summary?

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Your opinion should provide ready to digest input for decision makers

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TYPES OF OPINIONS

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Types of opinions

- Patentability
- Validity
- Infringement
- Freedom to operate
- (and many more)



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PATENTABILITY OPINION

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Patentability opinion

- Question: can I patent my...
 - Technology
 - Product
 - Idea
- Output
 - Yes
 - No
 - To this extent that...



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Basics

- Purpose
 - Decide on protection for future products
- Business input
 - Developed technology
 - Background information
 - Prior art (?)
- Legal input
 - The law

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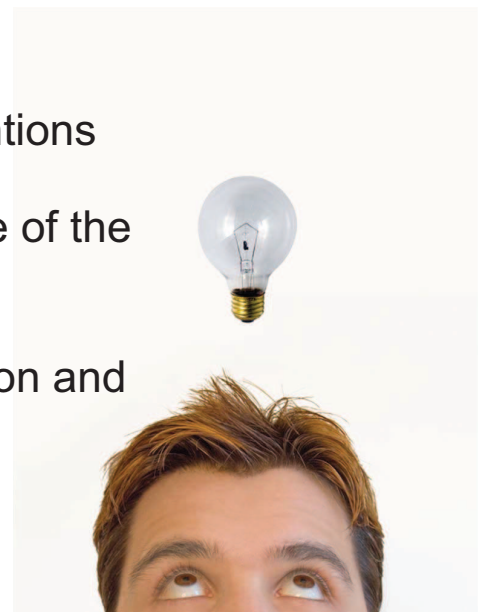
Specific contents

- Summary of invention(s)
- Limits for protecting the subject matter (medical treatment, aesthetics, ...)
- Reproducibility
- Background and prior art available
- Novelty and inventive step

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Inventions

- Firstly, discuss the invention or inventions
- The reader may not always be aware of the input you have received
- It clarifies what the opinion is based on and avoids misunderstandings
- Discuss unity a priori



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Subject matter limitations

- Every law specifies limits on what is patentable
 - Everything under the sun?
 - Medical treatments?
 - Aesthetics?
 - Computer programmes?
 - Life?
- Only in case relevant



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Reproducibility

- Except being a legal expert, a patent attorney is also a technically skilled person
- Does it work with information you have?
 - Process parameters
 - Perpetuum mobile?
- If in doubt, ask client for more information



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Novelty, inventive step

- Briefly summarise background information
 - Only discuss what you have received
 - Ask client whether to search or not
 - Stay as close as possible to the disclosure

- Discuss novelty per document

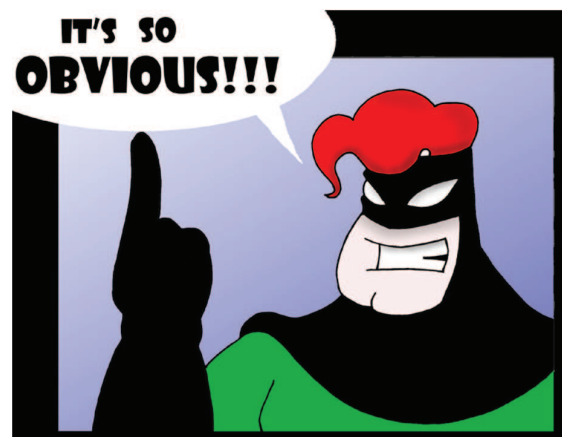
- Only discuss what is *not* disclosed by background

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Inventive step

- Inventive step? Non obviousness!
 - While novelty has a rather common basis and meaning, inventive step is different

- Take client's interests into account
 - Jurisdiction of interest
 - Level of detail required



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VALIDITY OPINION

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Validity opinion

- Question: Is this patent valid?
- Output:
 - Yes
 - No
 - Only for claims ...
 - With this amendment from the text



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Business need

- Why to check validity of a patent?
 - Ready for enforcement?
 - Allegation of infringement received
 - Valuation
- Validity is virtually never a stand-alone issue

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Basics

- Purpose
 - Check how strong a patent may be
- Business input
 - The patent as granted
 - Patent application as filed
 - Prior art
- Legal input
 - The law

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Specific contents

- Claims and claim construction
- Options for amendments
- Extension of subject-matter and/or protection
- Limits for protecting the subject matter (medical treatment, aesthetics, ...)
- Reproducibility
- Prior art available
- Novelty and inventive step

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Patentability vs. validity

- Structure of opinions is similar
- Objectives are similar
- Material is more confined
 - Application as filed; or
 - Description and claims as granted
- Applications vs. granted rights

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Claims and claim construction

- List the claims
- If a definition in the claims may be ambiguous, provide a definition based on the description
 - Objective?
 - Or purposeful?
- Do not go beyond the reasonable - provide at least reasonable alternatives



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Options for amendments

- Applications and patents may be amended
 - Different from the independent and dependent claims as on file or granted
 - Even with a broader scope (applications)
- This requires attention in the opinion as well

Application

- Claims may be narrower than subject-matter of the application as a whole
 - Main invention too narrowly claimed
 - Another invention
- Claims may be broader than may finally be allowed
 - Prior art
 - Exceptions for patentability
- How may the applicant amend?

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Don't get swamped

- Validity of an *application* may be a mer à boire (in particular if it is not your instructor's application)
- Discuss extent of the assessment with your instructor
 - What is relevant for the business
 - What amendments are realistic (business, law)

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Options to discuss

- If a third party, discuss with your instructor the characteristics of the applicant or proprietor
 - Product
 - Patent policy
- And discuss likely scenarios for amendments of the application
- If the application is with your instructor, limit to options that serve your instructor's purpose

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Patent

- Claims may only be narrowed
 - Not broader
 - No shift of scope
- Options are limited
 - Dependent claims
 - Unclaimed specific embodiments in description



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Extension of subject-matter or protection

- Amendments prior to grant
 - Literal wording from text?
 - Directly derivable from text? Or drawings?
 - Generalisation, new definitions?
- Amendments after grant
 - Independent claim or dependent claim?
 - Change of scope?

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Further contents of the opinion

- Similar as for patentability opinion
- However... the invention has already been defined:
 - Specific definitions in the text?
 - Few or many embodiments?
 - Broad or narrow claim language?
- More clear cut input

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Prior art, novelty and inventive step

- List all prior art
- Priority claim of patent (application) valid?
- More detailed argumentation may be required, for example when preparing for legal proceedings
- Use a claim chart
- Matrix with prior art

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To validate or to invalidate

- Your client wants to hold his or her patent to be held valid
- And the patent of the competitor to be held invalid
- Does this affect your argumentation?

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Specific recommendations for action

- Proprietor/applicant
 - Submit additional prior art and amend claims
 - File limitation request
- Other party
 - File third party observation
 - File opposition
- Or just do nothing



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INFRINGEMENT OPINION

Infringement opinion

- Question: does a product infringe?
- Output:
 - Yes
 - No
 - Unless/given that...



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Business need

- Why to check infringement?
 - Expectation of success of enforcement?
 - Allegation of infringement received - or expected
 - Valuation
- Translated to business language:
 - Opportunity?
 - Threat?

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Basics

- Purpose
 - Check whether a product infringes a specific patent
- Business input
 - Product or process
 - The patent
- Legal input
 - The law

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Specific contents

- Product or process
- Claims
- Claim construction
- Claim chart
- Options for design around
- Options for amendments



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Product and process

- Discuss the object of your assessment
- Differentiate key elements from features
- Be objective
 - No problem to discuss allegedly infringing parts
 - But do not provide ammunition to the other party (product owner or right holder)

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Claims and claim construction

- Not different from a validity opinion
But...
- Infringement goes hand in hand with validity
- Be consistent!
- File wrapper estoppel?



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Claim chart

- Split up claims per feature
- Compare the claim per feature to the product or process
- Level of detail?



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Design around

- A patent may not be as broad as granted - or as a proprietor would like it to be
 - Additional prior art
 - Invention description
 - Development of technology
 - Application drafting
- Room for something completely different with similar functionality?

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Design options

- A patent attorney has a technical background
- But is not an engineer
- Always ask for and discuss design around options
 - Developer
 - Market responsible

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Options for amendments

- Applications and patents may be amended
 - Different from the independent and dependent claims as on file or granted
 - Even with a broader scope (applications)
- This requires attention in the opinion as well
- As long as it is relevant to the product/process

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To infringe or to not infringe

- As with validity, there are two sides
- Different mindset of argumentation?
- The structure of the opinion is not different

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Specific recommendations

- Applicant/proprietor
 - Amend claims
 - Take legal enforcement action
- The other side
 - Design around
 - Reserve money for royalties
 - Invalidate
- Or just do nothing



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FREEDOM TO OPERATE OPINION

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Freedom to operate opinion

- Question: can I put my product on the market without the risk of infringement
- Output:
 - Yes
 - No
 - List of risks



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Business need

- Why to check freedom to operate?
 - Any risk of my product being removed from the market?
 - Can I start (building) my factory?
 - Any additional cost on licensing?
- Translated to business language:
 - Any threat?
 - Increased cost or total showstopper?

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Basics

- Purpose
 - Check whether a product infringes a larger amount of patents
- Business input
 - Product or process
 - One or more competitor names
- Legal input
 - The law

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Specific contents

- Way of working
- Product and process
- List of proprietors/applicants
- List of patents
- Infringement opinions per relevant right
 - Claims
 - Claim construction and claim chart
 - Options for design around

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Set of infringement opinions?

- Yes
 - Infringement is to be assessed to all patent rights
 - Business objective is the same or at least similar
- No
 - The amount of rights may be much, much larger
 - Not each patent will have to be assessed in such detail

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Way of working

- The potential amount of data to assess may be very large
- Business would have liked to have your opinion yesterday
- Business may dictate a balance between time and detail
- If so, discuss, agree and report how you have collected your data - and how and to what extent you have analysed it

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Product and process - what?

- Discuss the object of your assessment
- Differentiate key elements from features
- Discuss what is in and what it out
 - The handle of the scissors?
 - The joint?
 - The coating of the blades?
 - Or all?

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List of right holders

- Depends on client's requirements
 - Specific competitors
 - Specific aggressive patent holders
 - Or everything in the market?
- Thoroughly discuss this with your client
 - Amount of work
 - Risks when limiting the input for the assessment

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List of patent rights

- List all patents to your opinion
- Group patent rights
 - Per right holder
 - Per family or per jurisdiction? Or both?
 - Specific interest in one jurisdiction?
 - Per technical classification?
 - Are examiners infallible in their classification?
- Use it as an appendix...

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The big list

- One process
- Ten IPC codes
- 500 families
- 5000 patents

- One product
- Five companies
- 200 families



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The big list reduced

- Infringement opinions for 200+ patent rights?
- Iterate towards most relevant patent rights
- Remove prima facie irrelevant rights
 - Abandoned
 - Completely different technology
- Discuss what is left with engineers?
- Determine what is really relevant

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Cutting the numbers

- How much patents to analyse in detail?
 - How many rights are really relevant?
 - Which right holders may be a threat?
 - Which jurisdictions are of importance?
 - ...
- Explain instructor the balance between detail and time to spend.



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Infringement opinions

- Not every right requires full assessment
- For some rights, an argumentation of five lines may suffice
- For some rights, five pages may be required
- Document for each right why it is relevant - or not

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Specific recommendations

- Design around
 - Stop the project
 - Reserve money for royalties
 - Ask for licence?
 - Start invalidation actions
-
- Or just do nothing

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DUE DILIGENCE

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Due diligence is



One fool can ask more than seven wise men can answer

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- Please list all patent rights
- Please list all inventors
- Please list all licences taken
- Please list all patent threats
- Please provide extracts from registers that you are the right holder
- Please provide proof rights are in force
- ...

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Due diligence is also...

- Ask all you can
- Speak only when you are spoken to
- However...
- Check your warranties

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Due diligence is not

- A mere aggregation of opinions to answer each question
- Total openness
 - Not each LOI will result in an SPA
 - Beware of fishing expeditions
- A place to annoy the other party by asking to many questions

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What due diligence actually is

- A process to obtain as much relevant information as possible for determining value of a undertaking
- For:
 - Merger
 - Acquisition
 - Investment, including IPO

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Being the fool

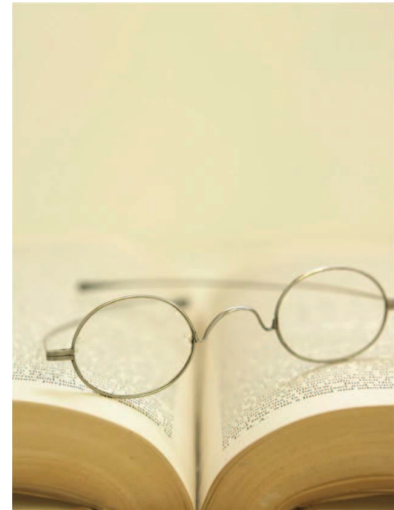
- YOU determine the questions
- Fire away?
- All you can eat dinner?
- Bite off more than you can chew?
- Better ask what you really need



Patent opinions
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An intelligent and knowledgeable fool

- Know the business
 - Technology
 - Competition
 - Patent policies and risks
- Determine risks and opportunities
 - Infringement
 - Validity
 - Ownership



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Determine your strategy

- Choose your battles
 - Which risks to assess
 - What data is required
- Collection of data
- Verification of the data

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Data collection

- List of patents
- List of licences in
- List of licences out
- List of infringement risks
- Allegations of infringement
- Pending conflicts
- Patenting policy
- Invention handling procedure

Data verification

- Ownership
- Registration
- Validity
- Limited rights, pledges?
- Laboratory notebooks?
- Cost of maintenance?
- Inventor contracts?

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How much to answer the other fool?

- Ask the other party why they need specific data
- All want to arrive at a deal within a not too long timeframe
- 100% certainty is not possible in the IP world - at least not for patents

(tough nut for M&A lawyers)

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Buyer

- Ask questions
- Assess possible outcome pending conflicts
- Find most important patents; and
- Assess validity
- Assess risk of infringement
- Contracts and the like?

Target

- Have the guts to say no
 - Pro-actively separate sense from nonsense
- Collect data
- Answer questions
 - Plain data
 - Provide assessment (?)

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Due diligence in the end...

- A mix of various opinions on risks and opportunities
 - Validity
 - Infringement
- Data verification
- A balance between knowing it all and a pragmatic view on what you *really* need

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Separate opinions?

- Your task in due diligence is usually a very small part of the whole process
- Nobody will read 200+ pages of IP opinions
- Provide one report, discuss each part (validity, infringement opportunities, data verification and risks) briefly and summarise the conclusions
- Recommendations for further investigation

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GUIDELINES AND PITFALLS

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Perimeter of the opinion

- What does your instructor want to know?
 - What does your instructor need to know?
 - What do you need to cover?
 - What shouldn't you cover?
-
- Check your public



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Your public

- The business manager
 - Investor
 - ...
-
- Even if you are instructed by a lawyer, your public is a business manager
 - Entrepreneur/majority shareholder
 - Executive manager
 - Investor

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A business manager...

- Only wants to hear yes or no
- Determines what information is relevant
 - For you to form your opinion
 - For business to take a decision
- Thinks lawyers are a necessary evil (except when you help generating cash in)
- Will know to find and blame you when things go bad



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CYA

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Be covered

- Ask for what you need
- Tell what you have
- Tell what you have done
- Answer the questions
- Do not take decisions
- Provide a reasonable disclaimer



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Basic guidelines

- Collecting information
- Building your arguments
- Drawing conclusions
- Providing recommendations

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INFORMATION

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Carefully collect your information

- Ask for your instructor's question
- Ask for the objective
- Reformulation of the question to the patent world

- Clearly identify what information you need for answering the question
- And ask for the information

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Ask questions

- If the information you receive is not clear, ask for clarification
- If the information is not sufficient to form your opinion, ask for more
- If you have a feeling you do not have all relevant information, ask for more

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Work with what you have

- List all information you have received
- Also list what information you do not have and what you missed while forming your opinion
- Do not interpret the information on what further relevant details there *may* be
- If you have to take assumptions, indicate you have done so

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ARGUMENTS

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Details should make sense

- Discuss the level of detail that is desired for your output
 - Patentability of an invention?
 - Preliminary risk assessment?
 - One step before summons to court?
- Determine what level of detail is required
 - Global analysis
 - Detailed discussion by means of the law for a specific jurisdiction?

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Specific jurisdiction?

- Are you allowed to provide a legal opinion pertaining to a specific jurisdiction?
- Do you know the law?
 - The code
 - The case law
 - Other rules and regulation
- For the situation
 - EQE only handles patentability and validity...

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Mind your jurisdiction...

- Inventive step
- Obviousness
- Equivalent infringement
- Direct/indirect/contributory infringement
- Grace period for disclosures
- Wilful infringement
- Legal privilege
- ...

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Do...

- ... Discuss the level of certainty required by your instructor
- ... Discuss the level of detail required in the conclusion
- ... Adapt the level of detail of the arguments to the previous two points

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Do...

- ... Know the limits of your knowledge
- ... Know the limits of your professional qualification
- ... Remain within those boundaries
- ... Refer to a better qualified person in case required
- ... Use legal input as much as technical and business input - in case required

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Do not...

- ...Bend your argumentation to wishful thinking
- ...Think the court (of appeal) was so very wrong in that decision - and you know it better
- ...Take your instructor for a fool



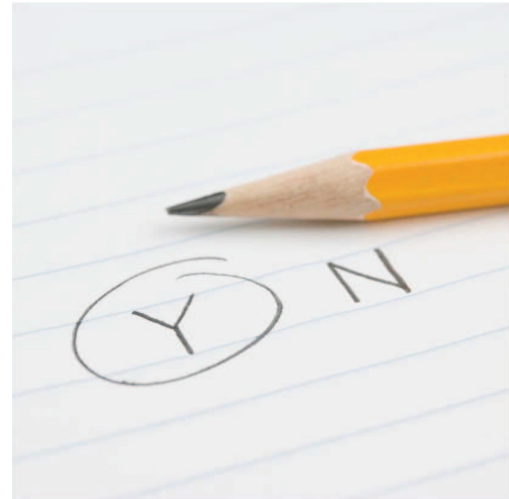
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CONCLUSIONS

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Conclusions

- Your client wants a yes or a no.
- And with a no, all means why and/or how to get to yes
- "Yes, but", "yes, if", "no, but"?
- Further details?



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Be complete

- Ask your instructor what type of conclusions he wants to hear in the end
- In the end, provide at least that part in the conclusions
- So know what to assess with arguments
- List all (partial) conclusions from your arguments

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Be consistent

- Avoid conflicts between conclusions
- Make sure your affirmative conclusions follow unambiguously from your arguments
- If this is not possible, indicate why

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Be brief

- Business manager, remember?
- If a partial conclusion does not make sense to the needs of your instructor, is it relevant?
- Do not repeat your arguments too much

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Be honest

- List uncertainties
- Do not colour a picture more beautiful than assessment of the facts tells you
- Do not provide risks or other odds as percentages

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RECOMMENDATIONS

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Recommendations

- Your instructor asks your opinion as guidance
- So *provide* guidance



- Be objective
- Provide multiple options
With consequences

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Do...

- Stay in your role as legal expert
 - Monitoring of registers
 - Investigation in more detail or other information
- In case of activities with business impact, always provide at least two options
 - List pros and cons
 - Leave the decision to your instructor
 - You *may* provide a preference



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Do not...

- ... Recommend with respect to specific jurisdictions outside your known jurisdiction
- ... Sit on the chair of your instructor
 - Do not recommend one single option
 - Do not expose yourself to liability for a decision
- ... Recommend options based on more business than legal arguments

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DISCLAIMERS

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No, you do not hold the truth

- Disclaim liability for what you could not have known
 - Information you have not received
 - Unpublished patent rights
 - Black spots in databases
- Disclaim liability for what you cannot predict
 - Court/jury
 - Actual course of action of another party

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Anything else?

- Indicate limitations you have encountered
 - Data collection
 - Data interpretations
- Indicate your own limitations
 - Your knowledge
 - Your qualification



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POINTS OF ATTENTION SUMMARISED

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When drafting your opinion,

- Discuss the needs of your instructor and your needs - and get them fulfilled at both sides
- Stay within **your** legal domain
- Be consistent
- Be complete
- Discuss ambiguities
- Offer a choice to your instructor, with potential consequences per option

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Mind major pitfalls

- You are a legal expert, not a salesman for court proceedings or an entertainer merely to please your instructor
(dare to be brutally honest)
- Do not make up information or points of law you do not have to get your opinion to an end
(keep asking)
- Check your legal privilege in case applicable

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Disclaimer

- This is not legal advice
- This is not business advice
- For each specific case, ask a qualified attorney for detailed advice

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Thank you for your attention

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