

I. Enforceability - Review and Analysis of Existing IP Portfolio

A. Identify and Verify Inventorship

- Identity inventors for each patent
- Identify any potential issues related to improper inventorship, omitted inventors or violations of jurisdictional rules regarding inventorship
- Confirm assignments cover future filings (e.g., continuation applications, international applications, etc.).

B. Verify Ownership of Intellectual Property

- Investigate and verify no chain of title issues. Verify recordation of assignments (in USPTO database for US patents). Correct if needed.
- Confirm that assignments are properly prepared and executed. Assess scope of grants to verify the past claims/damages are also assigned.
- Determine whether there are any joint ownership issues with other companies.
- Search for all recorded or unrecorded licenses involving the patents.
- Conduct UCC-1 lien search.

C. Confirm Maintenance of Issued Intellectual Property

- Identify proper class of payment (e.g., large entity vs. small entity).
- Determine whether proper maintenance fees were paid based on existing license agreement. Correct any missed fees and improperly paid fees.
- Identify any upcoming maintenance fee obligations. Ensure fees are paid during transition.

D. Verify Patent Term

- Confirm expiration date for each patent.
- Identify any potential issues with regard to filed Terminal Disclaimers. Correct as necessary.
- Verify whether Patent Office made any errors with regard to PTA calculations.

E. Develop/Verify Patent Information

- Independently verify the list identifies all patents, applications, and publications.
- Generate patent family trees.
- Identify any priority claims (e.g., provisional applications). Correct if any issue identified.
- Identify all submitted ideas and application in process and confirm intent to protect ideas.

F. Identify Existing Legal Decisions

- Identify all lawsuits / IPRs filed by or against the company, including any opinions/orders or Settlement agreements.
 - Identify communications relating to enforcement of the patents or interpretation of claim terms.
- G. Review Potential for Antitrust/Anti-competition Claims
- Determination of participation in standards organizations. Also investigate all companies having ownership interest in patents as indicated by chain of title.
 - Review of known attendance/submissions to working groups for applicable standards (if any).
 - Review IP licensing with competitors.
- H. Review Existing Licenses and License Obligations
- Identify and review any obligation that target company may have to license the patents including individual license agreements and industry/standards group terms.
 - Review and identify terms of licenses granted by target company.
- I. Review Existing Communications (Miscellaneous)
- Internet keyword search based on patent numbers, patent titles, assignees and inventors.
 - Determine if there are any issues concerning laches, estoppel, or res judicata. These could result from prior enforcements, communications with potential targets, prior litigations involving the patents, *etc.*
 - Conduct internal search for any correspondence originated by target company (or otherwise attributed to target company) regarding the patents or previous attempts to license the patent.

II. Applicability to Competitor - Review and Analysis of Existing IP Portfolio

- A. Verify Representative Patent/Claim(s) (Applicability and Scope):
- Prepare/Confirm that the mapping of the representative claim is accurate and detailed.
 - Verify that claim chart mapping includes accurate quotations and citations to standards documents (if applicable).
- B. Prosecution History Review and Summaries (Applicability and Scope):
- Prepare/obtain file history summary for each patent in the patent family.
 - Generate summary report (per patent) of relevant prosecution.
- C. Specification Review and Review Citations from Patent Specification (Applicability and Scope):

- Identify issues of prosecution history estoppel, best mode analysis and the identification of potential 112 issues.
 - Also identify any locations in the file history that include arguments or amendments to each limitation of the representative claim(s)
- D. Claim Construction
- Identify potential claim terms that may have ambiguous meaning.
 - Identify support from specification.
 - Identify potential external reference sources required
- E. Duty of Disclosure: Citation of Known Prior Art Considered (Validity):
- Confirm submitted prior art was considered by patent office (for U.S., verify Examiner initials in Form 1449); and
 - Confirm all prior art cited in related family patents/applications was properly submitted and considered in patent within family.
 - Result should be a Prior Art Table identifying all prior art cited in each patent of the patent family.
- F. Search for Prior Art (Validity):
- Conduct internal search for all known prior art. Search may be limited according to confidentiality obligations.
 - Search should consider publications, uses, disclosures, sales, offers for sale, and public knowledge.
 - Search will be based on representative claim(s).
 - Geographic scope should be considered.
- G. Claim Difference Mapping (Applicability and Scope):
- Identify any difference between the representative claim and the related claims of the other patents in the patent family.

III. Risk from Third-Party IP

- A. Landscape Analysis Determination
- Identify key technical and business areas that may impact business and legal interactions.
 - Identify key competitors and IP holders that may impact landscape analysis.
 - Establish risk profile and decision making logic for processing results.
- B. Search Parameters
- Determine regional requirements (US, Europe, Asia, etc.).
 - Identify available service providers and cost parameters. Determine expected work product from service providers.
 - Identify time restraints for results.
- C. Work Product and Recommendations

- Identify key stakeholders and information required.
- Construct work product in view of willfulness and “need to know” basis (e.g., scorecards vs. claim charts).
- Filter recommendations based on business and organizational limitations/needs

D. Risk Mitigation

- Identify IP owner and marketplace role.
- Identify design around and invalidity positions.
- Identify licensing and acquired rights alternatives.
- Identify offensive IP filing “greenspace” for building defensive portfolio.