



Return on Invention

EU-JP Technology Transfer Helpdesk

Enterprise Patent Portfolio Commercialization: Trends and Opportunities

8 December 2016

George Park



Historical Approach to Commercializing Patents

To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.

Article I, Section 8, Clause 8 of the United States Constitution empowers the United States Congress:
“To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”

Using Patents by to Defend Products

1799: James Watt wins patent litigation against Jonathan Hornblower for infringement of steam engine patents

1806: Eli Whitney wins litigation on cotton gin patent

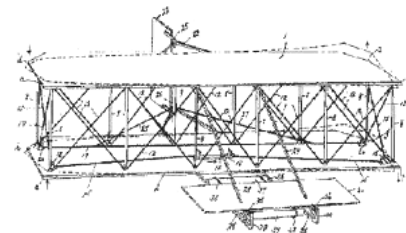
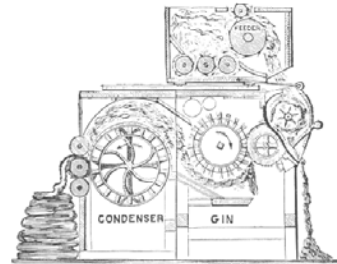
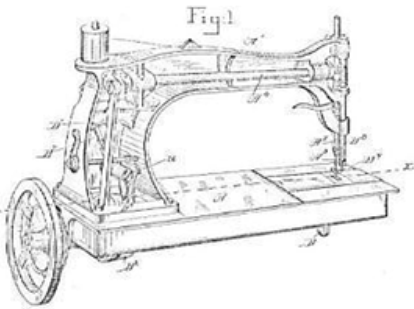
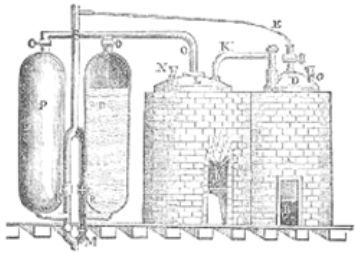
1811: Robert Fulton engaged in lawsuits involving steam boat patents and related commercial rights

1854: Elias Howe wins dispute over patents related to sewing machines from Isaac Merritt Singer

1909: Orville and Wilbur Wright files lawsuit against Glenn Curtiss for infringement of aircraft patent

1915: Nikola Tesla sues Marconi for infringement of radio patents

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From Product Focused Commercialization to Direct Financial Returns from Patents

Microsoft: Smartphone Patent Licensing



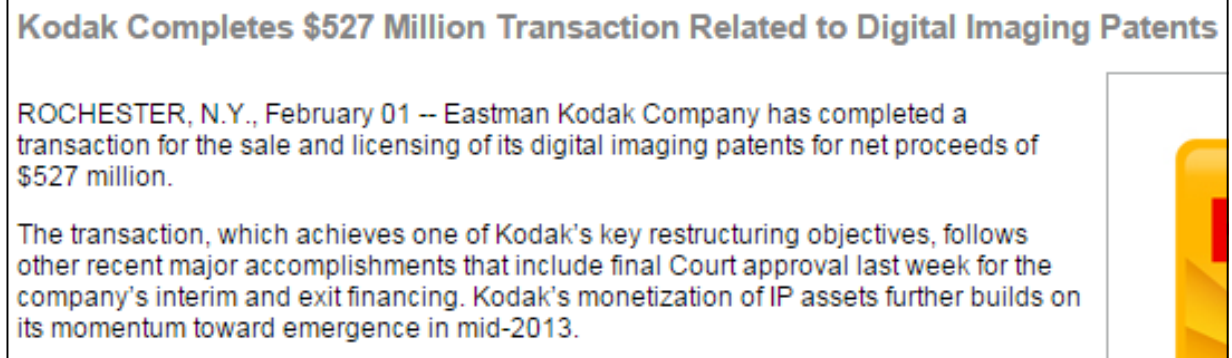
← → ↻ www.zdnet.com/article/microsoft-is-making-2bn-a-year-on-android-licensing-five-times-more-than-windows-phone/ ☆

Microsoft is making \$2bn a year on Android licensing - five times more than Windows Phone

If analyst numbers are right, Android will still make more money for Microsoft than its own mobile OS in the next couple of years.

 By Liam Tung | November 7, 2013 -- 12:36 GMT (04:36 PST) | Topic: Mobility

Kodak: Digital Image Patent Sales



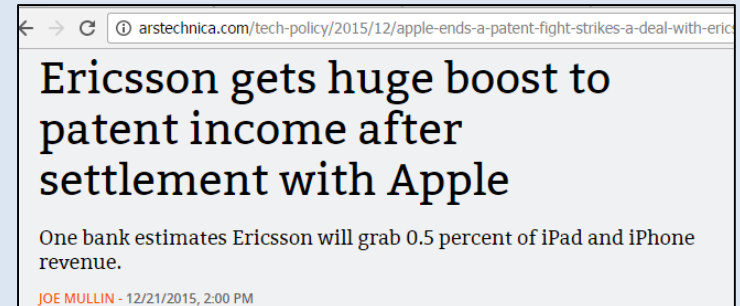
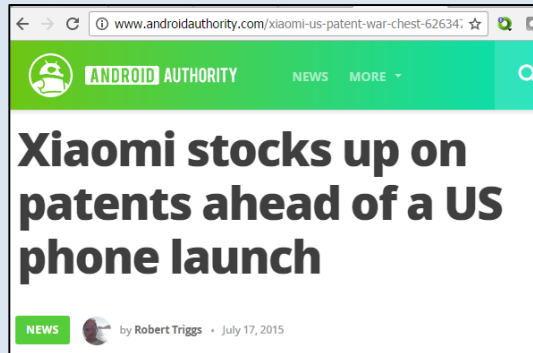
Kodak Completes \$527 Million Transaction Related to Digital Imaging Patents

ROCHESTER, N.Y., February 01 -- Eastman Kodak Company has completed a transaction for the sale and licensing of its digital imaging patents for net proceeds of \$527 million.

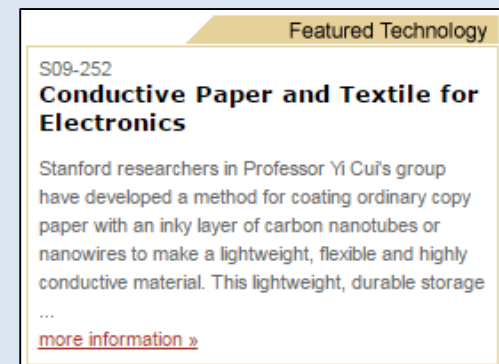
The transaction, which achieves one of Kodak's key restructuring objectives, follows other recent major accomplishments that include final Court approval last week for the company's interim and exit financing. Kodak's monetization of IP assets further builds on its momentum toward emergence in mid-2013.

Broad Range of Approaches to Leveraging Enterprise Patent Portfolios

Enforcement



Development

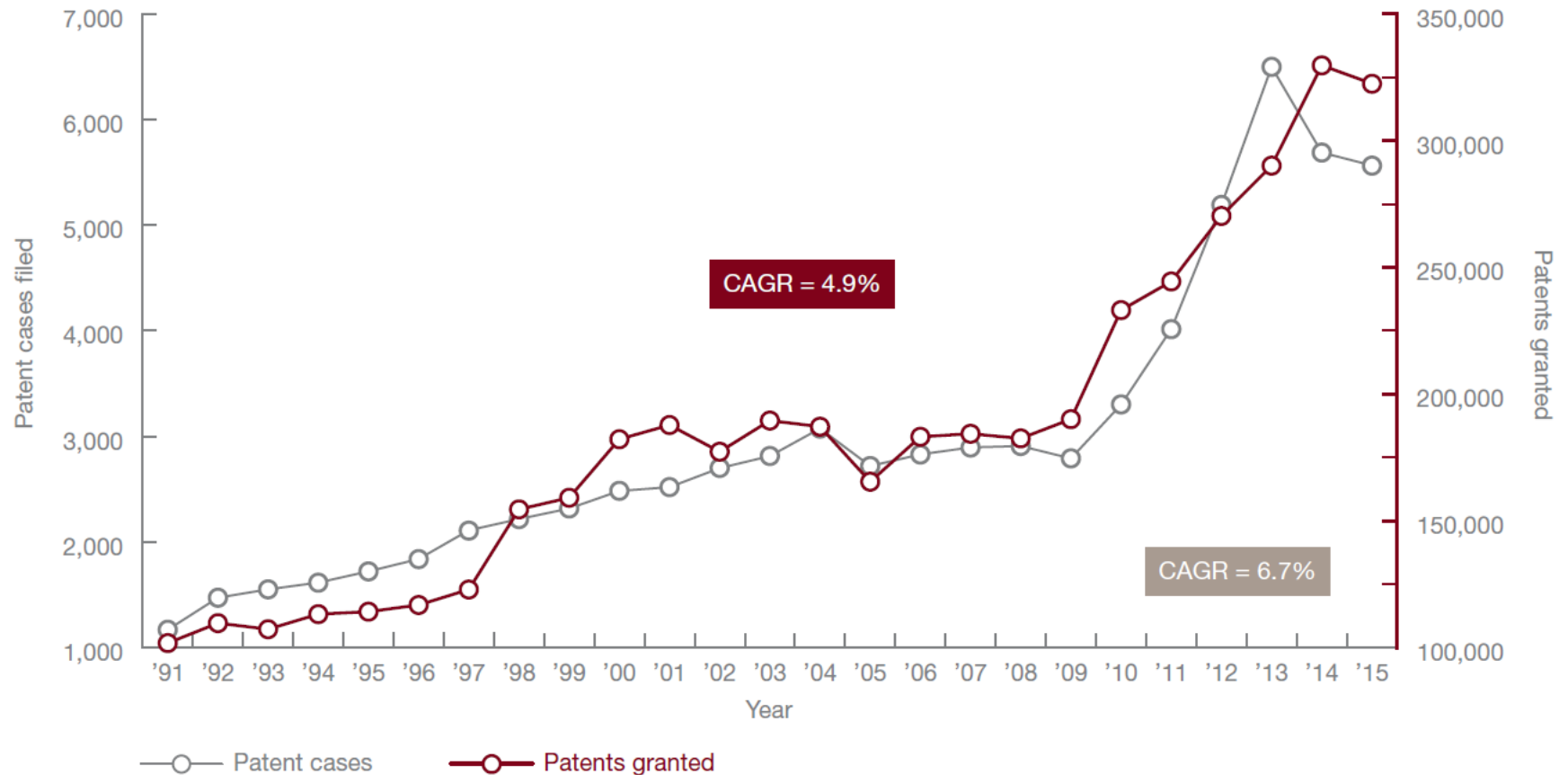


Defense

Commercialization

Long Term Trends in Patent Prosecution and Litigation in the U.S.

Fig 1: Patent case filings and grants



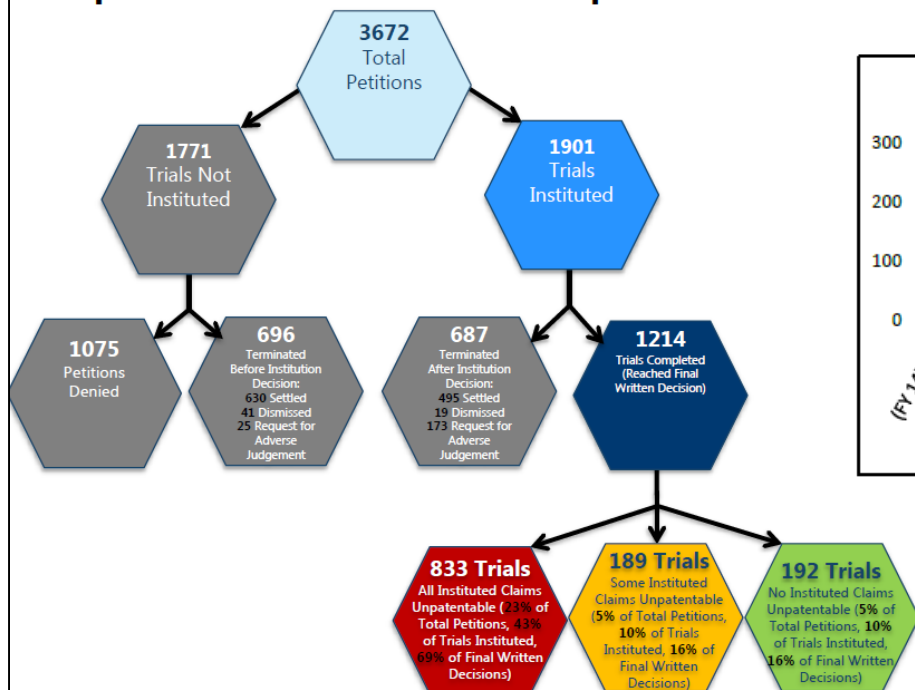


Developments In the U.S. - Legislative

America Invents Act (2011)

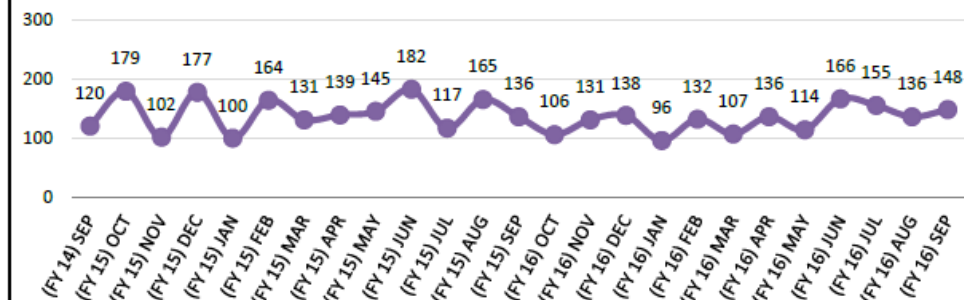
- Switches from “first-to-invent” system to “first-inventor-to-file”
- Expands inter parties review
- Creates administrative proceeding for covered business method (CBM) patents

Disposition of IPR Petitions Completed to Date*



*Data current as of: 9/30/2016

Number of IPR Petitions Filed by Month*



uspto



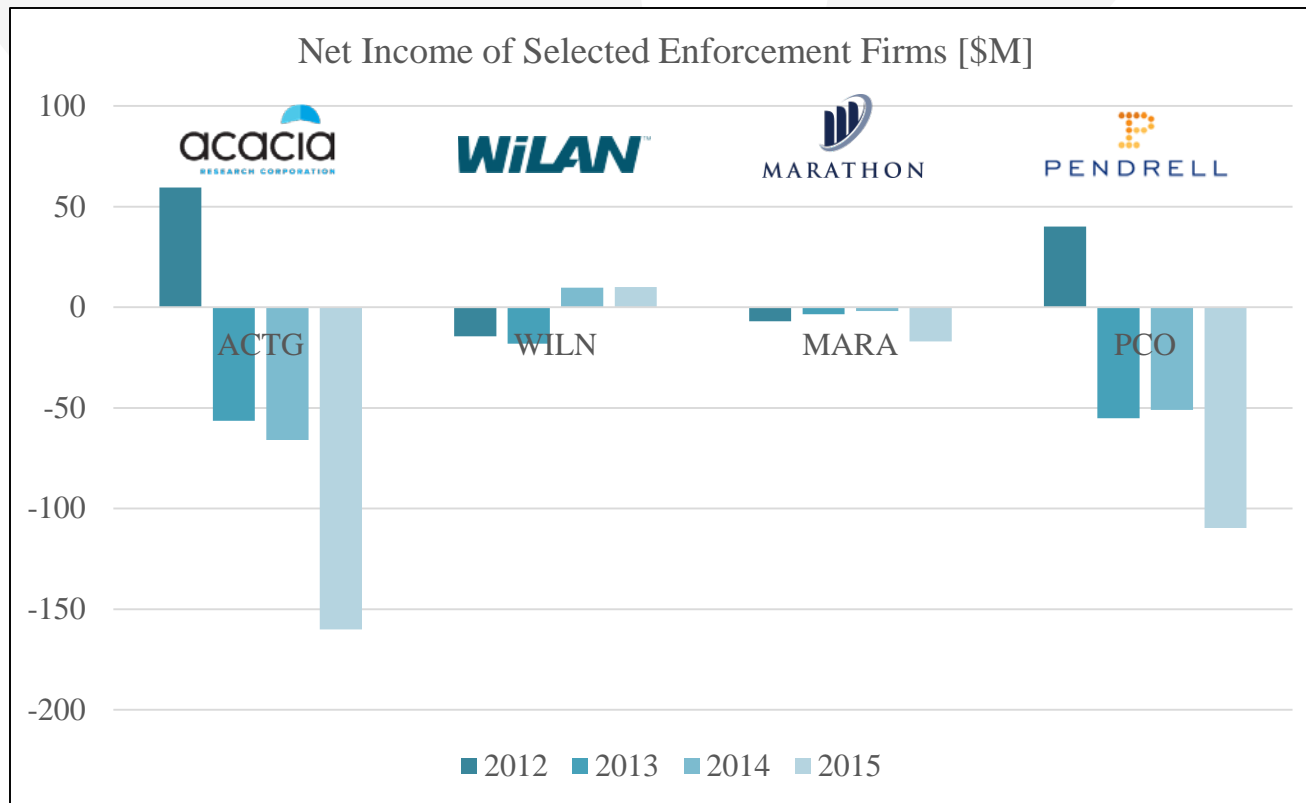
Developments In the U.S. - Judicial

- Example litigation matters this decade
 - Uniloc v. Microsoft (2011) – Elimination of 25% rule of thumb
 - Laser Dynamics v Quanta (2012) – Damages based on smallest salable unit
 - Motorola v Apple (2012) – Sufficiency of damages expert opinions
 - Motorola v Microsoft (2013) – Valuation of Standards Essential Patents
 - Alice v CLS Bank (2014) – Eligibility of software patents
- Other earlier decisions: eBay (2006, injunctions), SanDisk (2007, declaratory judgments), KSR (2007, obviousness), Seagate (2007, willful infringement), Quanta (2008, exhaustion), Lucent (2009, entire market value rule)



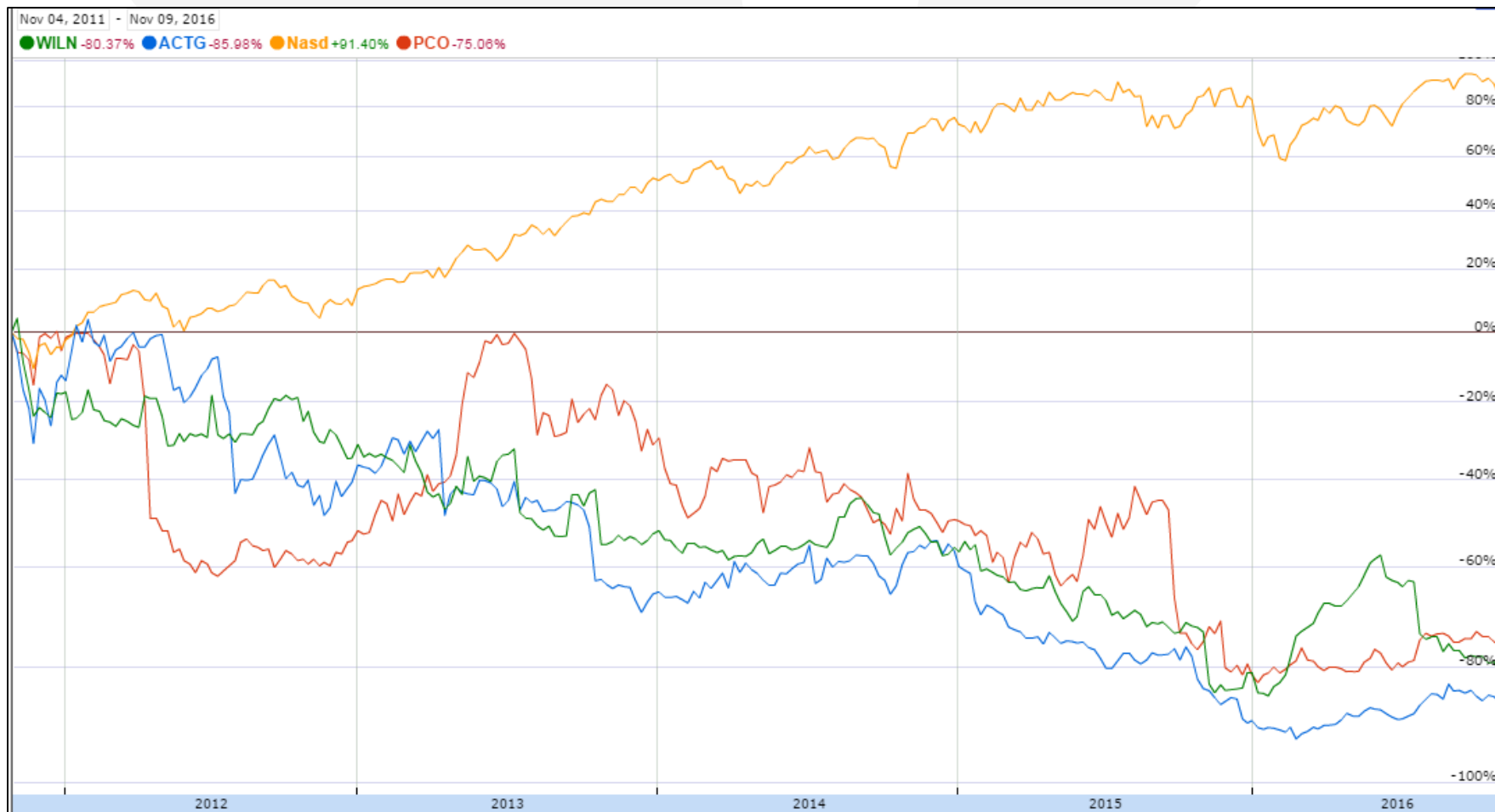


Impacts on Focused Patent Enforcement Firms





Impacts on Focused Patent Enforcement Firms



Recent News in US – Possible Shift Back to Stronger Patents, though with Uncertainties

United States Court of Appeals for the Federal Circuit

AMDOCS (ISRAEL) LIMITED,
Plaintiff-Appellant

v.

OPENET TELECOM, INC.,
OPENET TELECOM LTD.,
Defendants-Appellees

2015-1180

Appeal from the United States District Court for the
Eastern District of Virginia in No. 1:10-cv-00910-LMB-
TRJ, Judge Leonie M. Brinkema.

① www.nationallawjournal.com/printerfriendly/id=1202771413554

Federal Circuit Softens Stance on Patent Eligibility

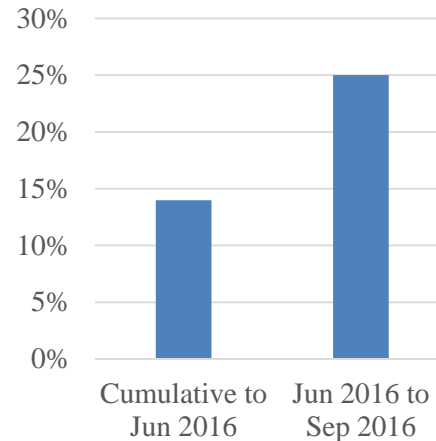
Scott Graham, Law.com

November 2, 2016

For the fourth time this year, the U.S. Court of Appeals for the Federal Circuit has rescued software patents that a district found ineligible for patenting.

Tuesday's decision in [Amdocs v. Openet Telecom](#) also widened a rift between Federal Circuit judges over whether a patent claim's specification—the written description of an invention that provides a backdrop for the actual patent claims—can be considered when making an eligibility determination.

PTAB Completed Trials Upholding All Claims



Recent News in Europe – Continued Attraction as Venue, though with Uncertainties

→ <https://www.dlapiper.com/en/uk/insights/publications/2015/0>

'Huawei v ZTE' - CJEU landmark decision provides new ground rules for asserting standard-essential patents in Europe

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17 JUL 2015

By: Dr Markus C. ...

In a landmark decision of the European Court of Justice, the court has ruled that patent proprietors seeking an injunction on the basis of an alleged (SEP) if those SE standards body

← → ↻ www.businesswire.com/news/home/2016012100541 ☆ [Google](#) [YouTube](#)

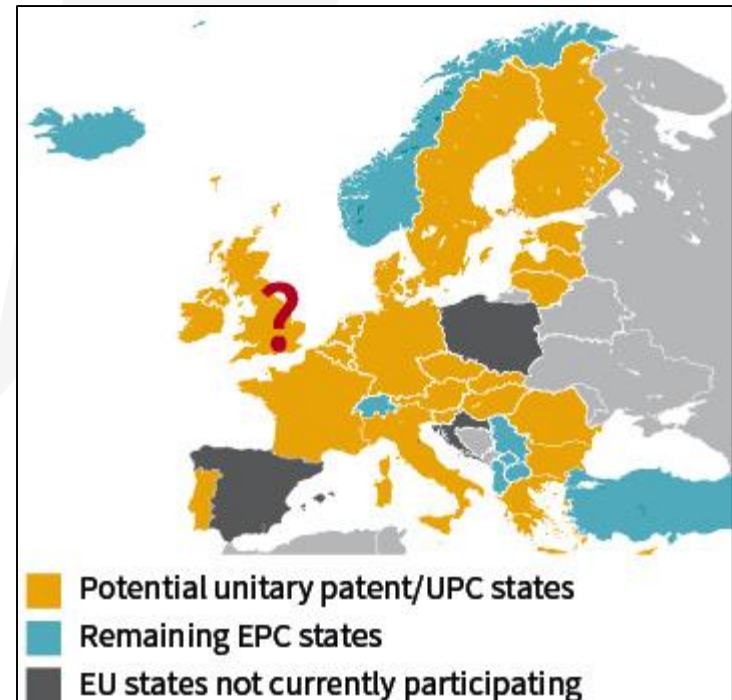
BusinessWire
A Berkshire Hathaway Company

Log In Sign Up

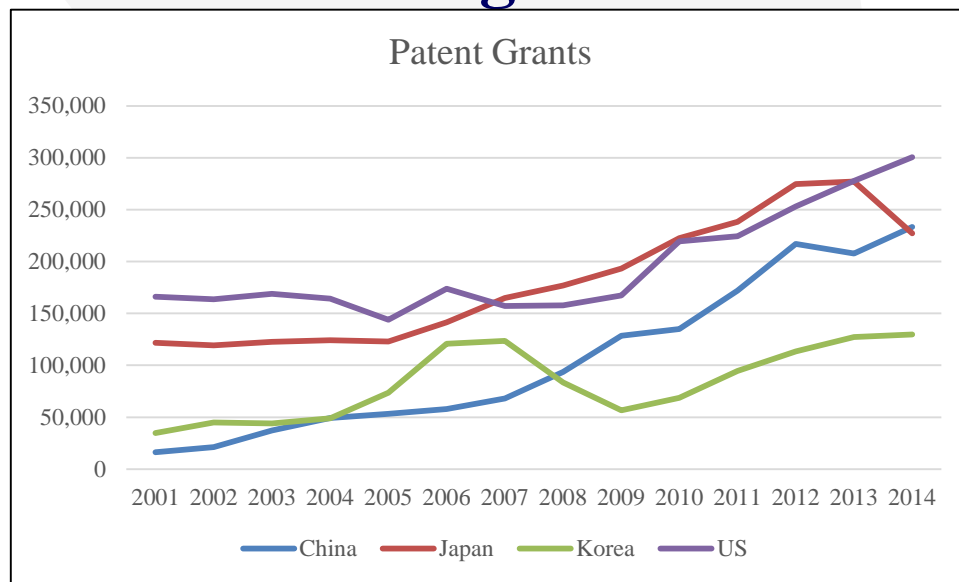
Unwired Planet Wins German Cellular Essential Patent Infringement Case Against Samsung, LG Electronics and Huawei

January 21, 2016 06:30 AM Eastern Standard Time

LOS ALTOS, Calif.--(BUSINESS WIRE)--Unwired Planet, Inc. (NASDAQ:UPIP) today announced that the Düsseldorf District Court in Germany issued its judgments that cell phone and infrastructure manufacturers Samsung, LG Electronics and Huawei each infringe multiple Unwired Planet patents. The judgments come after an initial trial held in June 2015 against Huawei, and a multi-day trial held in late November and December 2015 against the other defendants.



Recent News in Asia – Continued Growth in Patenting and Commercialization



From the 7 Nov 2016 issue of “The Patent Investor”

WiLAN's Wireless Futures Technology unit files enforcement action in China against Sony Corp.

Dolby Laboratories files patent enforcement actions against Vivo, OPPO and producers in High Court of Delhi, India

Qualcomm fiscal 4th-Qtr profit increases 51% on new China licensing deals and chipset sales

Japan Remains Actively Engaged in Patent Commercialization Activities

https://www.ft.com/content/f7e8690a-a3

FINANCIAL TIMES

Sony Corp + Add to myFT

Sony sued in China for patent infringement

Wilan's move threatens to stop Japanese group from selling LTE smartphones in country

https://www.iam-market.com/blog-entry/sharp-patents-sale

Sharp patents for sale on IAM Market as new owner Foxconn initiates turnaround strategy

IAM Market vendor MiiCs & Partners – an IP consulting firm that is exclusively authorised to monetise the patent portfolios of Foxconn Group and its affiliates – has listed a number of packages from Japanese electronics giant Sharp over the past few weeks.

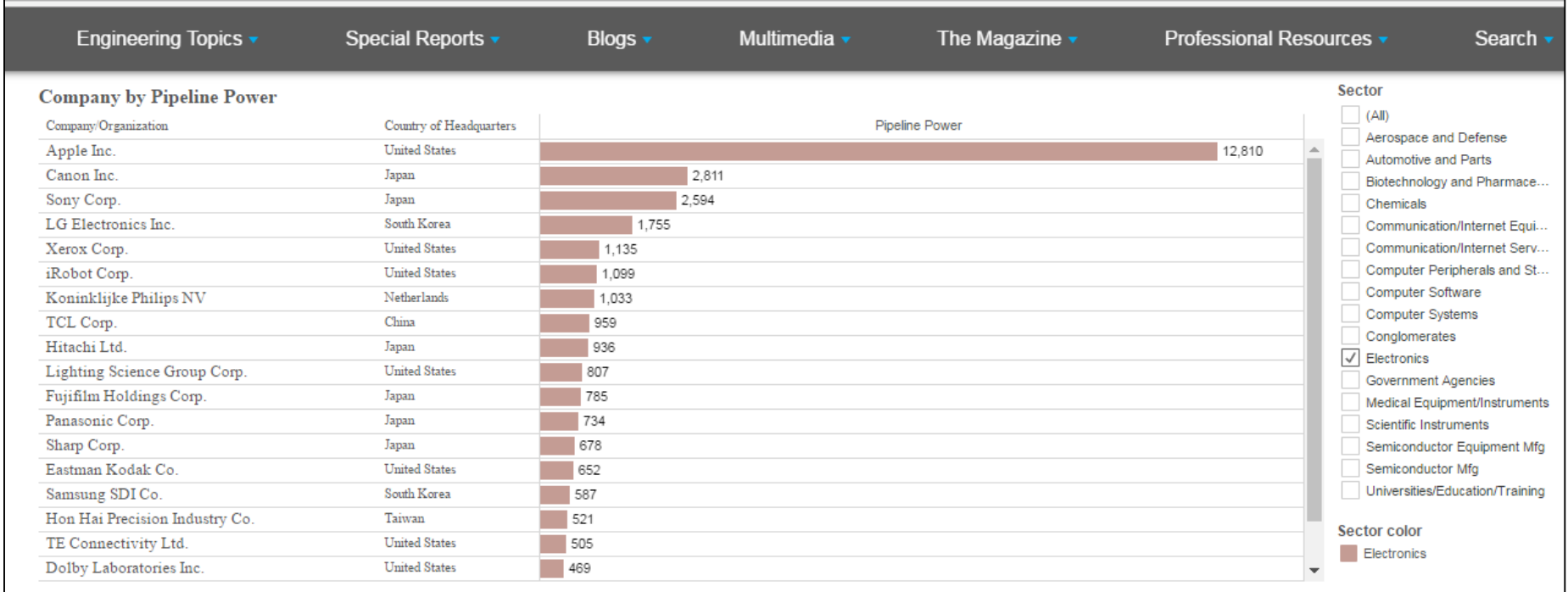
www.wilan.com/news/news-releases/news-release-details

WiLAN Acquires Third Patent Portfolio From Panasonic

11/07/2016

OTTAWA, CANADA -- (Marketwired) -- 11/07/16 -- WILAN (TSX:WIN)(NASDAQ:WILN) today announced that the Company's wholly-owned subsidiary, Micro-Optimus Technologies, Inc., has acquired a portfolio of patents from Panasonic Corporation. The portfolio covers motion sensing microelectromechanical systems (MEMS) technologies used in a variety of consumer devices, including fitness trackers and handsets.

spectrum.ieee.org/static/interactive-patent-power-2015





Options for Patent Owners

Use patents
to support
operations

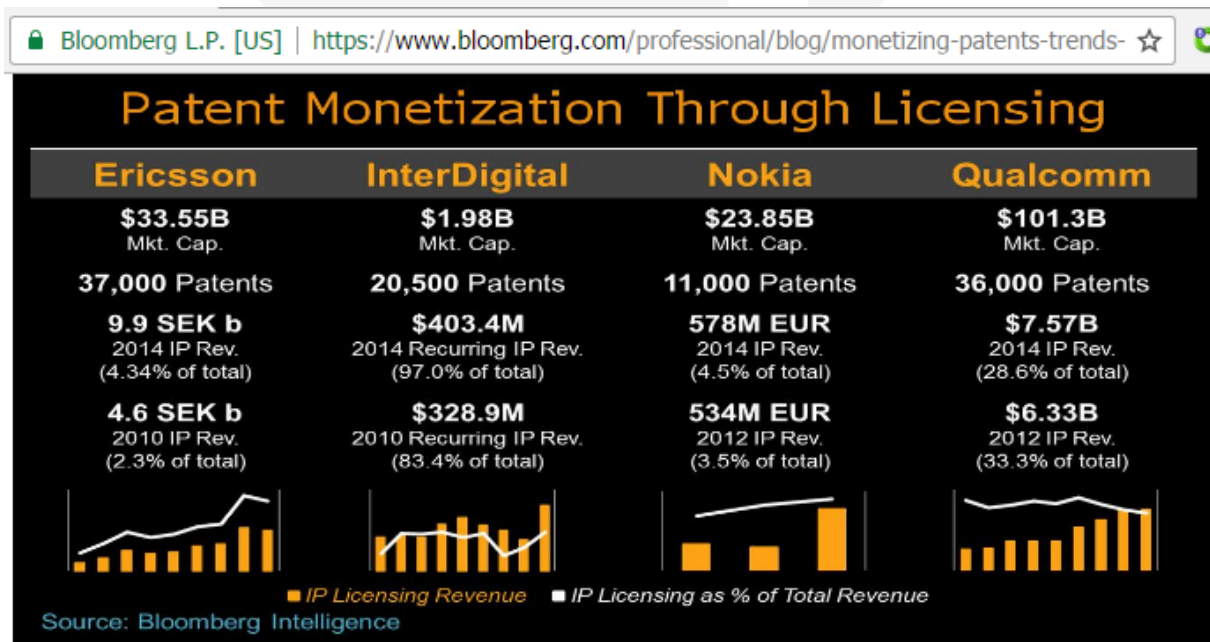
- Product differentiation
- Defensive use
- Currency for deals

Use patents
to generate
revenues

- Technology Transfer
- Enforcement
 - Licensing
 - Litigation
- Sale

Factors Used to Consider Potential for an Enforcement Program

- Demonstrable infringement (multiple cases)
- Relevant market
- Encumbrances
- Portfolio size and coverage
- Innovation history





Potential Risks When Considering Enforcement


- Counter-assertion
- Business relationships
- Resource and expense commitment
- Risks to asserted patents





Enforcement Campaign Process



- 
- Royalty fee
 - Other consideration
 - Royalty structure
 - Back damages
 - Covered products
 - Named patents
 - Exclusivity
 - License term
 - etc.



IPVALUE

End of Presentation



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