

## Issues That Will Likely Be Examined by Investors

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### Identifying those with Knowledge of the IP

- Identify all individuals within the company and outside the company having knowledge about the IP issues that the company has faced
  - Determine each individual's role in connection with decision making and/or executing on decisions related to IP, including the role of all former employees and former patent counsel
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### Review of the Patent Portfolio

#### Portfolio Strategy

- Identify how the patents in the portfolio map to company products/services
- Identify the strategic approach used to determine when and where to seek patent protection
- Have there been any public disclosures (e.g., journal publications, PowerPoint presentations, discussions with potential customers not under NDA, etc.) about any aspect of the company's technology prior to filing a patent application on that aspect of the technology?

#### Ownership

- Review of employment history and employment agreements for all inventors
- Review of assignment documents associated with each patent or patent application
- Have there been any claims or disputes about inventorship on any company patent or patent application, e.g., has any person asserted that they should be named as an inventor on any application or patent on which they were not named?
- Are any of the patents or patent applications in the portfolio subject to co-ownership?
- Have there been any claims or disputes about ownership on any company patents or patent applications?

#### Encumbrances

- Any liens or security interests recorded against patents, patent applications or other IP?
- Identify whether any company-owned properties are subject to any outbound licenses to third parties and assess potential impact
- Are any company-owned properties subject to any government rights?

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### Identify Any Challenges to the Validity of the IP

- Identify any company or in-licensed patent that has been adjudged invalid or unenforceable or have been asserted to be invalid or unenforceable
- Identify any company or in-licensed patents or patent applications for which any inter partes reviews, reexaminations, oppositions, nullification actions, or other proceedings have been requested or initiated

### Enforcement

- Identify any company or in-licensed patent that has been asserted or has been determined to be potentially assertable against any third party for alleged infringement
- Review details of assertion/potential assertion

### Marking

- Describe the company's practices for marking any/all products sold by company and/or any licensee including any marking done on the web

### Supporting Documents/Information

- Up-to-date list of all company-owned and in-licensed patents or patent applications
- Copies of all assignments for company-owned properties and, if available, for all in-licensed properties
- List of all inventors named on company-owned/in-licensed patents or patent applications
- Copies of employment agreements and consulting agreements for all employees and consultants named as inventors on company-owned properties
- Copies of Notice of Recordation of Assignment for each patent or patent application

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### Inbound Licensing

- Review of all licenses to third party patents or patent applications to identify what company products, if any, are covered by the licensed patents and to assess compliance and termination conditions

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### Third Party IP Not Subject to License

- Has any third party asserted that company is, or would be, infringing any third-party patent rights by commercialization of its technology? If so, identify and assess the details regarding each such assertion

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- Is the company otherwise aware of any patents of any third party that the company would be, or might be, alleged to be infringing by commercialization of its technology? If so, identify and describe
- Has the company established any financial reserves specifically for patent infringement litigation expenses/damages? If so, describe
- Has the company conducted or commissioned freedom-to-operate evaluations of any of its products/technology? If so, describe
- Has the company obtained any non-infringement or invalidity opinions? What patent(s) and what product(s) are addressed by the opinion?
- Does the company monitor the patents of its competitors? If so, identify the competitors and describe the monitoring process. If not, does the company know of any companies commercializing (or planning to commercialize) products competitive with any of the company's products?