

Patent Considerations for Startups

When evaluating outside patent counsel, startups should look for a firm with experience advising companies across all stages – from seed to mature. Experienced patent counsel can help you advance business goals through patent strategy by providing services and advice geared towards increasing business value, attracting investors and strategic partners, deterring competition, generating revenue and positioning your company for long-term growth and success.

Patent Filing Services

What you need	What a patent lawyer can offer
Educate yourself on how to think about patent strategy	Initial consultation
Determine what, if anything, should be patented	Identify and evaluate technology differentiators to develop patenting recommendations <ul style="list-style-type: none"> • Discuss business plan and underlying technology with corporate leadership • Review related documentation • Prepare assessment report including patenting plan as appropriate
Assess whether your technology is patentable	Patentability evaluation <ul style="list-style-type: none"> • Review invention and conduct prior art search of existing third party patents • Prepare patentability report describing scope of protection available
Initiate patenting process and put stake in the ground to: <ul style="list-style-type: none"> • Establish earliest filing date (US is a "first to file" system) • Attract investors • Protect technology while development is in progress 	Prepare and file provisional application <ul style="list-style-type: none"> • Discuss invention with inventors • Draft description and drawings • Finalize with inventors • File with United States Patent and Trademark Office (USPTO)
If you have already filed a provisional application: <ul style="list-style-type: none"> • Confirm that your filing achieves its intended purpose 	Counseling re provisional application that is already filed <ul style="list-style-type: none"> • Review application and provide feedback/recommendations • Strategize with inventors and management to determine if re-filing is recommended
Commence full USPTO patenting process	Prepare and file non-provisional application <ul style="list-style-type: none"> • Review disclosure documents • Discuss invention with inventors • Draft description, drawings and claims • Finalize with inventor and management input • File at USPTO

What you need

What a patent lawyer can offer

Filing a patent application outside of the US

Pursue foreign filing process

- Identify non-US jurisdictions where IP is desirable for company and given its industry
- Revise US patent application to meet requirements of each selected non-US jurisdiction
- Coordinate filings with country counsel in each selected non-US jurisdiction as appropriate

Patent Counseling Services

What you need

What a patent lawyer can offer

Establish a process that captures inventions and assesses whether to pursue patent protection

Invention harvesting program

- Establish invention review process
- Basic patent education presentation to employees
- Advanced patent education presentation to those reviewing inventions
- Participate in invention review meetings
- Template documentation including invention disclosure records

Evaluate the effectiveness of your patent procurement strategy and modify as appropriate

Strategic portfolio analysis

- Analyze relevance of the patent portfolio to current and planned products
- Review known prior art
- Analysis report describing findings and providing plan and proposed budget to adjust procurement strategy

Assess how your patent portfolio measures up to the patents of others in your space

Patent landscape analysis

- Survey prior art and assess patent portfolio in view of prior art
- Prepare landscape report describing findings and providing recommendations for positioning portfolio

Confirm your patent portfolio is in good order prior to a funding event

Portfolio audit

- Evaluate patent filings, including ownership
- Provide oral feedback on quality and scope of portfolio
- Plan and budget to address any issues uncovered

Assistance in extracting value from your patent portfolio

Patent monetization

- Assessing the strength of the portfolio for potential licensing and/or enforcement by litigation
- Developing a roadmap to monetize the portfolio based on the assessment

Assess whether your company is free to sell its products and/or services

Freedom to operate analysis

- Review current or planned products/services
- Conduct search for potentially relevant third party patents
- Analyze any such relevant patents for risk to company
- Provide oral report of findings

Assistance if you have received a cease and desist letter

Strategic review of assertion

- Review assertion letter and identified IP
- Analyze applicability of IP to company product and/or services to develop potential non-infringement positions
- Consider vulnerability of IP to validity challenges
- Develop strategic response to letter

What you need	What a patent lawyer can offer
Assistance with patent licensing, outbound and inbound	Develop licensing practices and protocols <ul style="list-style-type: none"> Identify company IP rights for potential licensing Strategize with company on appropriate licensing scope for such IP Identify third-party IP desired or necessary to achieve corporate goals Assist in efforts to license identified third party IP
Performing infringement and/or validity analyses	IP analysis <ul style="list-style-type: none"> Review of applicable patent(s) including related activity at USPTO Conduct review with company, of applicability of patent(s) to company or third-party offerings depending on whether this is an analysis for defensive or offensive purposes Conduct validity study of patent(s) and analyze results of same Provide report of findings and strategies for moving forward

Patent Due Diligence Services

What you need	What a patent lawyer can offer
Assess patent assets of potential acquisition target	Patent portfolio review <ul style="list-style-type: none"> Determine whether target company owns all relevant rights Assess strength and reach of portfolio and its relevance to key current or planned products and services Portfolio review report describing findings
License analysis	License analysis <ul style="list-style-type: none"> Assess licensing of target company's patents Assess target company's licensing of third party patents
Patent scope analysis	Strategic portfolio analysis <ul style="list-style-type: none"> Assess strength and reach of target company's portfolio and its relevance to key current or planned products/services
Assess whether the target company is free to sell its products and/or services	Freedom to operate analysis <ul style="list-style-type: none"> Review target company's current or planned products/services Conduct search for potentially relevant third party patents Analyze any such relevant patents for risk to target company Provide oral report of findings

Shadow Counsel Services

Even if you are already working with a patent lawyer to draft and file your patent applications, it can be beneficial to have experienced co-counselors assisting you so that value is maximized in a cost-effective manner. Look for a team that is experienced in partnering with companies and their patent service providers to make sure your patent assets get the attention they need.

What you need	What a patent lawyer can offer
Assistance with developing strategies for patent filings	<ul style="list-style-type: none"> Evaluating existing patent portfolio against company's product/service roadmap Providing evaluation report and strategic plan for proceeding Participating in quarterly review of invention disclosures and develop/adjust filing strategies accordingly Developing strategies for pursuing patent protection outside of the US

What you need

What a patent lawyer can offer

Assistance with execution on filing strategies

- Drafting initial claims for new applications to implement filing strategy
- Conducting monthly calls to discuss important cases and upcoming decisions regarding the same
- Participating in developing patent prosecution strategies, including responses to office actions, appeals and continuation practice

Assistance in extracting value from your patent portfolio

- Assessing the strength of the portfolio for potential licensing and/or enforcement opportunities
- Developing a roadmap to monetize the portfolio based on the assessment