



Patent Portfolio Management

Intellectual Property- 301

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Meet the Faculty

Panelists

[Ted Behm](#) - Saul Ewing LLP

[Mitchell Weinstein](#) - Levenfeld Pearlstein

Moderator

[Ellyar Barazesh](#) - Baker Botts L.L.P.

About This Webinar

Patent Portfolio Management

Patent portfolio management starts at the inventive stage and doesn't end until a patent is no longer active. Strategies vary widely and goals may evolve over time. Future events, such as those relating to licensing and litigation, can greatly affect such strategies. As patent portfolios grow, management becomes more difficult as does ensuring that the efforts (and expenditures) being made are appropriate. This webinar provides a variety of perspectives that will be useful in ensuring that your patent portfolio is robust, purposeful, and managed effectively.

Learning Objectives:

- Understand the role of patent portfolio management from the invention stage to the expiration of a patent
- Explore strategies for building and maintaining a robust and purposeful patent portfolio
- Learn how to adapt portfolio management strategies to evolving business goals, including licensing and litigation considerations
- Identify best practices for managing the increasing complexity of growing patent portfolios
- Gain insights into optimizing efforts and expenditures to ensure effective portfolio management and alignment with long-term objectives

About This Series

INTELLECTUAL PROPERTY- 301

Using outside counsel to assist in patent application preparation and prosecution is an incredibly valuable manner in which to generate and maintain a robust patent portfolio. Having patent applications prepared and prosecuted by outside counsel can improve short-term workflow management and provide many long-term advantages once a patent has issued. However, utilizing outside counsel can be costly, ensuring quality can be challenging and managing patent portfolios can require a balance of information not always available to all involved. Whether working with a small or large number of outside firms and whether they are small or large in size, this series provides insight that will assist both inside and outside counsel in creating a more effective working relationship. Each episode is delivered in Plain English understandable to business owners and executives without much background in these areas. Yet, each episode is proven to be valuable to seasoned professionals. As with all Financial Poise Webinars, each episode in the series brings you into engaging, sometimes humorous, conversations designed to entertain as it teaches. And, as with all Financial Poise Webinars, each episode in the series is designed to be viewed independently of the other episodes, so that participants will enhance their knowledge of this area whether they attend one, some, or all of the episodes.

Episodes In This Series

1. Patent Application Preparation

Premiere date: 05/22/25

2. Patent Prosecution

Premiere date: 6/26/25

3. Patent Portfolio Management

Premiere date: 7/24/25

Episode #3

Patent Portfolio Management

Each Financial Poise Webinar is delivered in Plain English, understandable to investors, business owners, & executives without much background in these areas, yet is of primary value to attorneys, accountants, & other seasoned professionals. Each episode brings you into engaging, sometimes humorous, conversations designed to entertain as it teaches. Each episode in the series is designed to be viewed independently of the other episodes so that participants will enhance their knowledge of this area whether they attend one, some, or all episodes.

Patent Basics

- A patent involves conveyance of a right or title to exclude others from making, using or selling what is characterized as an invention, for a limited time period
- A patent for an invention is the grant of a property right to the inventor, issued by the United States Patent and Trademark Office. Generally, the term of a new patent is 20 years from the date on which the application for the patent was filed in the United States, or from an earlier priority date (if applicable).

Types of Patents

- Utility patents may be granted to anyone who invents or discovers any new and useful process, machine, article of manufacture, or composition of matter, or any new and useful improvement thereof;
- Design patents may be granted to anyone who invents a new, original, and ornamental design for an article of manufacture; and
- Plant patents may be granted to anyone who invents or discovers and asexually reproduces any distinct and new variety of plant

Patent Basics

(cont'd)

What Is A “Patent Portfolio”?

- Generally, what it says – the patents that you or an entity owns.
- Portfolios may be viewed by entity, by business area within an entity, by technology or otherwise.
- Portfolios should be developed, viewed, and managed based on the specifics pertinent to one or more of the entity, the portfolio itself, and related technological areas.
- Determine the “identity” of your portfolio to help make management decisions.
 - Is it mainly defensive? But what if you need to be offensive?
 - Does it cover core business needs?
 - Does it cover competitor’s core business needs?

These and many other questions should be asked and considered.

Business First!

- Decisions made with regard to which patents to pursue, and during patent preparation and prosecution should be business-driven, as should decisions regarding an issued patent.
- Keeping business needs in mind and tracking changing in business needs is a must.
- What are your competitors doing?
- How much financial commitment should you make to patent applications in your portfolio?

Who Are You?

What Are Your Business Needs?

Define a budget and focus on the importance of protecting certain technologies; this may involve considering how contentious the market/competitors are, or how critical your technologies are to success.

Tailor your patent portfolio to the budget, focusing on bang for the buck.

Set budgets for attorneys; ensure there is ample communication

Consider strategies that suit your needs. Is rapid allowance important?
Would multiple patents be desirable (e.g., as may warrant taking allowed claims and filing a continuation)?

How are needs evolving?

Communication is key.

The prosecuting attorney should be in tune with these needs (and if not, should be asking the right questions).

What Does A Patent Portfolio Mean To You?

Questions to ponder:

- How IP-focused are we, and why?
- Who are we (start-up, mid-size, large corporation)?
- Patents may give “cred” for funding.
- How important is patent protection from a core business perspective?
- What finances are available, and how should we allocate them?
- Is patent protection important in the technical field/business area?

There is no right answer.

Honest, in-depth evaluation, and the counsel of a learned IP attorney are key.

How Important Is Patent Protection?

Securing patents is an important, but expensive, endeavor.

Before setting forth, consider:



Defensive protection: a strong patent portfolio, even if not centric to core-business, can stave off litigation and related challenges to your business, help in negotiation, and provide an upper hand when under fire.



Offensive protection: as with the above, a strong patent portfolio provides related advantages when being challenged/attacked, or when avoiding the same.



How litigious are your competitors? Consider researching this aspect for your top expected competitors and evaluating the need (and related value) of patent protection.

How Important Is Patent Protection?

Large portfolios can act as a detriment.

Portfolios can foster negotiation and, potential licensing benefits.

How likely is litigation? Consider competitive landscape.

How easy is infringement proved (both offensively and defensively)?

New applications and/or claims in current applications can be filed to support litigation efforts.

Mining! Dig, mine and draw from your existing portfolio.

Acquiring new IP supporting your needs can be valuable.

How Important Is Patent Protection?

(cont'd)

- **A Enforceability:** How enforceable are patents in the pertinent area(s) in which you reside? This question applies not only to you, but your competitors, and can weigh heavily upon portfolio management decisions.
- **Design-arounds:** Is your technology subject to easy design-arounds? Does this help and/or hurt? Consider both offensive and defensive positions.
- **Evolution of technology:** how fast are things changing and how relevant will your patent portfolio, or that of your competitors, be in 5 years? 10 years?
- **Cost/balance** is important to consider and varies based on your business approach.

Portfolio Strategy & Prep & Pros

- A patent portfolio strategy should be considered during the patent preparation and patent prosecution stages
- Failing to consider, develop and use a patent portfolio strategy can be a waste of resources and risk affecting your business objectives and long-term viability
- Claim drafting, amendment and other prosecution-related strategies can be used to achieve portfolio goals
- Obtaining allowances can be highly valuable to bolstering a portfolio; drafting and/or amending claims to facilitate allowance, while also going after broader core subject matter can be highly valuable.
- Refer to strategic discussion in the general slides above, for consideration in connection with portfolio development and management.

Evolution of a portfolio strategy:

- Is the technology still relevant to important business needs?
- Are there new technologies that warrant greater focus?
- What is the current state of the technology generally (e.g., has the technology in actual use evolved)?
- For prosecution, If there are allowed claims that are valuable and core to business needs, this may affect decisions as to how hard to pursue rejected claims, possibly cancelling claims for fast allowance
- For some entities, obtaining allowed claims can be important from a portfolio perspective, justifying the cost. For those looking to shave costs, decisions as to how much effort to put in, whether to amend, and how to tailor arguments can also play in.

Portfolio Strategy & Prep & Pros *(cont'd)*

Portfolio Strategy & Prep & Pros *(cont'd)*

Post-allowance:

- Maintenance fees can add up
- Technology can evolve
- Certain countries can be quite expensive; evaluate continued value over time
- Allocate funds accordingly; funds saved in unnecessary maintenance fees can be used to foster applications with new technologies
- Always be dynamic, always evolve

Portfolio Strategy With Litigation In Mind

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Cost Control



- Ensure a proper understanding at the outset
- Employ a process to monitor costs
- Attorneys carrying out patent prosecution should be all over this and communicating regarding the same
- Budgeting is important, whether as a flat fee for large-volume patent prosecution or targeted to individual efforts.

- Patent prep & pros direction should be controlled from the outset with efficiency in mind and with early buy-in from all sides
- Focus attorney time on critical aspects, including efforts to find allowable subject matter early
- Law firms may use a mix of attorneys with lower and higher billing rates; done correctly, this can result in great value, but care should be taken to understand who is doing what work, and a related comfort level
- Minimize back-and forth during prosecution

Cost Control

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Cost Control

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- Establish solid relationships to help avoid micromanaging, whether within a firm or entity, or between a client/owner and outside counsel carrying out the work
- Prepare for time with the attorney (and prepare your inventors)
- Educate your inventors about cost and goals regarding attorney time

Questions or Comments?

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Meet The Faculty

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Ellyar Y. Barazesh is a Senior Associate in Baker Botts' Intellectual Property Practice group. His practice focuses on patent prosecution and counseling, post-grant proceedings before the Patent Trial and Appeal Board (PTAB), and patent litigation.

He has significant experience working with clients in a wide range of technology areas, including computer hardware and software, control systems, networking technologies, location tracking systems, video and image processing, semiconductor devices, data encryption, graphical user interfaces, and medical devices.

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Mr. Behm's patent preparation and prosecution work includes both domestic and foreign patents, trademarks and copyrights. He represents clients in disputes involving patent, trademark, trade dress, trade secrets, copyright, domain name and contract litigation. He also has extensive experience with reexamination, reissue, and inter partes review proceedings before the U.S. Patent and Trademark Office.

Established and startup companies also look to Mr. Behm for IP opinions and counseling on intellectual property-related transactional matters, including mergers and acquisitions, IP valuations and fundraising strategies.

Mr. Behm earned a J.D. from Rutgers University School of Law-Camden. He also has both a B.A. in Chemistry and a B.S. in Environmental Science from Virginia Polytechnic Institute and State University.

Mitchell Weinstein - mweinstein@lplegal.com



Mitch's passion is helping clients carve out and protect niches for their innovations moving to market. Through strategic planning in patents, trademarks and trade secrets, Mitch partners with clients to identify and work around potential barriers to market entry and to secure protection for their intellectual property assets.

As a partner in the firm's Intellectual Property Group, Mitch prepares and prosecutes U.S. and foreign patent and trademark applications, with a focus on achieving his clients' goals. He has extensive experience in patentability and infringement analyses and opinions, patent and trademark licensing, and client counseling relating to retaining and transferring intellectual property rights. Mitch has extensive experience in international patent strategies, filings and prosecution. He has assisted clients in introducing new products and services to their respective marketplaces in the U.S. and abroad through strategic counseling, state-of-the-art searching, design around strategies and opinions. Recently, he assisted clients in carrying out worldwide patent programs spanning the Americas, Europe and Asia. [Read More](#)

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