

Essentiality of Standard Essential Patents (SEPs) in Patent Portfolio Assessment

Recently, we were given an opportunity by a client that is a pioneer in its field to evaluate its patent portfolio vis a vis other player in the market.

While evaluating a portfolio, the most challenging task is to identify the hidden gems in a river full of pebbles. But with the right strategy, methodology, and an experienced team, this arduous task can be a cinch.

We put together a team of 5-6 infringement experts in the **technology domain to analyze** the client portfolio.

TTC Approach – We at TTC follow the 5-step approach.

Product Clustering of Competitor's Product	<ul style="list-style-type: none"> • Web Crawling and Web Scraping the website of the competition to extract product data for ingestion into the system. • Product clustering using human inputs in multiple technology domains.
Client's Patent Extraction & Categorization	<ul style="list-style-type: none"> • Formulating queries on patent databases, extracting a list of patents that form the client portfolio, and clustering them into multiple technology domains.
Technology Overlap	<ul style="list-style-type: none"> • Comparing the product technology domain with the patent technology domain to identify overlapping technology areas.
Identification of Top patents for Potential Infringement through Ranking	<ul style="list-style-type: none"> • Extracting Gold & Silver patents for targets using a proprietary automated tool. Gold & Silver Patents are those with a high probability of getting infringed. • This is followed by manual and automated ranking of patents, and deep manual analysis through various parameters like Claim Broadness, SEP, Ease of Design Around, Infringement Likelihood, Validity Check, etc. and each patent is given a cumulative score.
Detailed Infringement Search & Patent Product Mapping	<ul style="list-style-type: none"> • The most important part is to identify infringing products in the competitive marketplace. A detailed infringement search on the top-ranked patents is performed by the team and use claim charts are prepared based on solid evidence and factors such as the revenue generated by the product and the earliest launch date of the product.



How TTC Added Value

Our 5-step approach is a well-researched, structured, foolproof approach that has been developed and has always worked well for us and our clients. The result of this **portfolio assessment** was ten comprehensive evidence of use claim charts that were shared with the client. The client was happy, consequently, so were we.

But we wanted to give the client more than was asked for. But the client's query had been answered. What more could we do? We sat down as a team and went back to the drawing board to brainstorm on how we could add more value to our client's business. Ideas flowed aplenty. Until someone suggested the exploration of the **SEPs** in the client portfolio.

This got the team excited and fired up. We all know the value Standard Essential Patents add to a company. The value addition phase began with us checking the standards covered in the client's **portfolio**. It was tougher than we thought it would be, but we were relentless. Armed with the information we unearthed, extracted Standard Essential **Patents** from the client portfolio, and identified corresponding standard-compliant products of competitors in the marketplace.

Our next step was to compare the claims of patents with the specifications of a declared standard.

While checking the essentiality of the patent, the most important point is to identify whether the claimed subject matter is an optional or mandatory feature to the standard (as this would greatly influence the positive availability of the same feature in the target product) and if there is any licensing agreement between the target competitors and the patent holder. After verifying this and before preparing claim charts, we checked all versions of the standards for the relevant subject matter considering the date restrictions. With this strategy, we were able to prepare 8 new claim charts, and increase the value of our client's portfolio.

By going the extra mile, not only did we have a happy client, but we also had a happy client whose happiness translated into an increased budget for the project.

We came away with a lesson for ourselves too! **Standard Essential Patents**, which are so often taken for granted play a significant role in a Patent Portfolio Assessment Project and serve to strengthen a patent portfolio more than they are given credit for.

For us at TTC adding value is an important part of everything we do. This leads to us customizing roach for each client by constantly developing strategies and methods that work best.



Get in touch with TT Consultants for a Patent Portfolio Assessment that shows you all the hidden gems in your patent portfolio.

Author

Shivani Mittal