

KramerAmado Clearance Studies

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Overview

- ▶ Clearance generally
- ▶ The KramerAmado Difference
- ▶ AIA as applied to Clearance

K&A Objectives

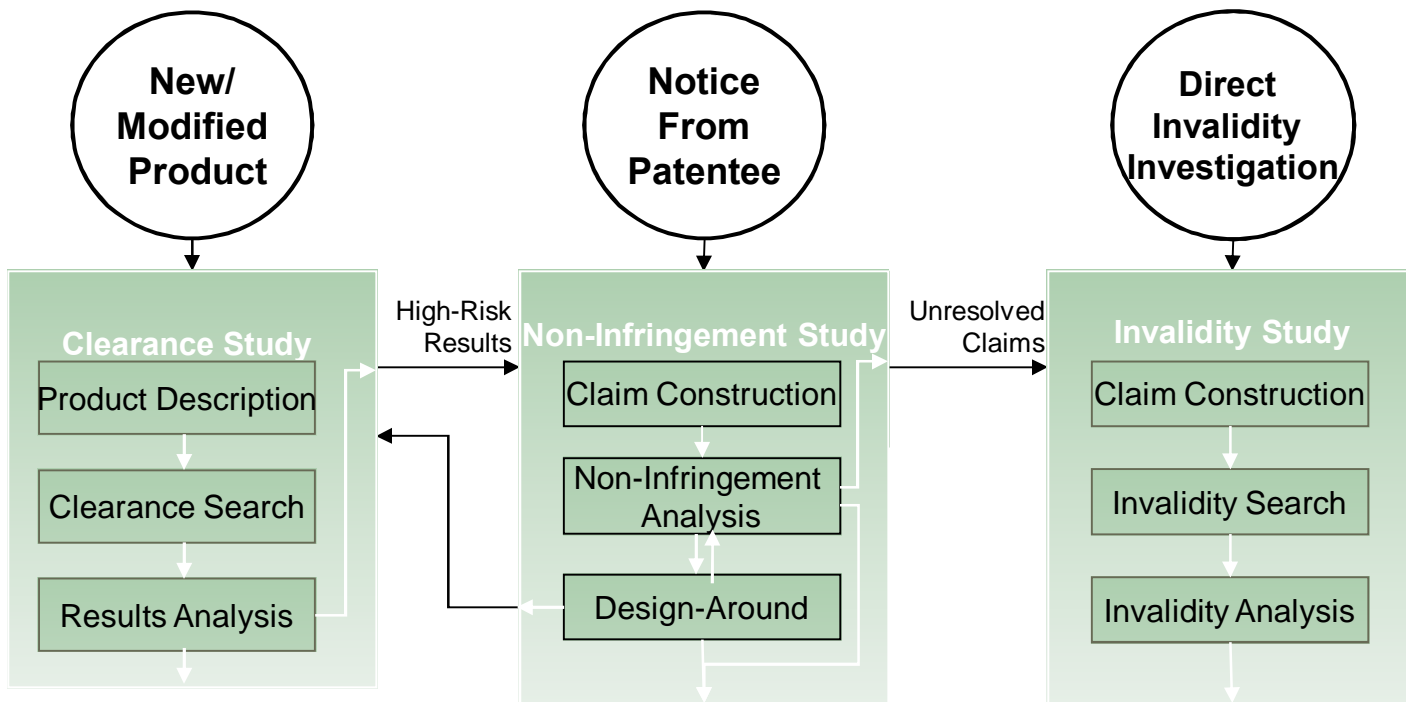
- ▶ **Primary Objectives:**

- ▶ Help in-house counsel advise internal clients with regard to Right-to-Market
- ▶ Identify risks early in the commercialization process
- ▶ Design-Around if possible

- ▶ **Secondary Objectives:**

- ▶ Competitor activity
- ▶ Prior art for patent applications
- ▶ Licensing targets

Clearance Flow-Chart



Benefits of Opinions

- ▶ Preemptively manage risk
- ▶ Minimizing enhanced damages
- ▶ Removing unknowns and streamlining product development
- ▶ Memorializing analysis for next-generation products
- ▶ Facilitating valuations for licensing

The KramerAmado Difference

- ▶ Timeliness
- ▶ Certainty
- ▶ Guidance

Timeliness

- ▶ Meet all deadlines
- ▶ Docketed Items
 - ▶ Confirmation of product description
 - ▶ Completion of in-house patent search
 - ▶ Follow-up questions if necessary
 - ▶ Preliminary Analysis/Opinion
 - ▶ Written Opinion

Certainty

- ▶ **Technical Understanding**

- ▶ Clear understanding of the product exemplified by the Product Description
- ▶ What are the features of the product and their alternatives?
- ▶ What are the end customer uses of the product?

- ▶ **Market Understanding**

- ▶ Who are the competitors in this field?
- ▶ Who are the main IP holders?
- ▶ Is there NPE activity in this technology area?

Guidance

- ▶ Preliminary Analysis/Opinion
- ▶ Spin-off opinions if necessary
- ▶ Written Opinion
 - ▶ Product description
 - ▶ Search scope
 - ▶ Classification search
 - ▶ Keywords, assignees, inventor names
 - ▶ Discussion of relevant documents including literal and DOE analysis
 - ▶ Discussion of applications including current claims, status, and monitoring

Guidance

- ▶ **What is highlighted for discussion?**
 - ▶ Claims requiring interpretation
 - ▶ Considerations for future designs
 - ▶ Competitor assigned
 - ▶ Expired patents disclosing technology

- ▶ **Overly broad applications**
 - ▶ Brief discussion of prior art
 - ▶ Monitoring

AIA

- ▶ Monitoring technology sectors
 - ▶ Preissuance submissions
 - ▶ Must be filed by the later of 6 months after publication or first Office Action
 - ▶ Anonymous
 - ▶ Highlight prior art listed in IDS
 - ▶ Claim chart
 - ▶ Post-Grant Review
 - ▶ Applications filed after March 16, 2013
 - ▶ Must be filed within 9 months of issue
- ▶ Ex parte Reexamination unchanged

Questions?

- ▶ Thank you!