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IN-DEPTH PATENT MONETIZATION COVERAGE

Clinton, Trump administrations seen as more neutral on patents, unlikely to push Silicon Valley's reform agenda

A Hillary Rodham Clinton administration or a Donald Trump administration is unlikely to continue the unfinished patent reform agenda pushed by the Obama administration and Republicans in Congress including venue reform, discovery reform, fee shifting, joinder and customer stays, patent market observers and lobbyists say.

So far only the Clinton campaign has put out any substantive policy prescription on patent issues, though it was only a few paragraphs of a broad agenda for promoting technology and innovation in the U.S. economy.

Mrs. Clinton's prescription, under the broad heading: "Improve the Patent System to Reward Innovators, called for ensuring the patent system continues to reward innovators by enacting reforms to reduce excessive patent litigation and strengthen the U.S. Patent and Trademark Office's operational capacity.

"The Obama Administration made critical updates to our patent system through the America Invents Act, which created the Patent Trial and Appeals Board, and through other efforts to rein in frivolous suits by patent trolls. But costly and abusive litigation remains, which is why Hillary supports additional targeted rule changes."

Those targeted rule changes include laws to curb forum shopping and ensure that patent litigants have a nexus to the venue in which they are suing. Mrs. Clinton also would require that specific allegations be made in demand letters and pleadings. In addition, she called for increasing transparency in patent ownership by making litigants disclose the real party in interest.

Mrs. Clinton's prescription for strengthening the PTO's operational capacity include legislation to allow the PTO to retain the fees it collects from patent applicants in a separate fund—ending the practice of fee diversion by Congress. She also supports allowing the PTO to invest funds left over from its annual operations in new technologies, personnel, and training.

Still, the fact that the campaign mentioned patent issues at all and didn't include any mention of fee shifting, joinder or other reforms suggests an administration that will not be as aggressive in pushing that agenda, patent market observers and lobbyists say.

In September, a number of patent market observers attended a fund raising event for Mrs. Clinton in Washington, D.C. that raised \$150,000 and provided an opportunity to discuss IP

issues with senior campaign staff including Clinton Campaign Director John Podesta and domestic policy adviser Sara Solow.

In an Oct. 17 email briefing called “New Global Patent Landscape #10, 2016,” Rob Sterne, a partner with **Sterne Kessler Goldstein & Fox** in Washington, D.C., said Podesta and Solow briefed the attendees on Clinton's views of the importance of IP to the U.S. economy, especially for small business, which she views as essential for creation of high-paying jobs.

“Many asked questions including me about whether Clinton understood the current state of the U.S. patent system and why it is not fully supporting the small business, university, and the start-up communities. Podesta and Solow seemed genuinely surprised by this negative feedback and sought further input on how the U.S. patent system can again assist the engine of high-tech growth in the U.S.”

Sterne couldn't be reached for additional comment.

A representative of small inventors is said by one of the attendees to have complained to Podesta and Solow, the campaign's IP expert, that **Google Inc.**'s lobbyists had visited the White House twice a week for the past 7 and half years. “How do small businesses compete with that?” he is said to have asked.

Obama appointed former Google deputy general counsel Michelle Lee as Undersecretary of Commerce and Intellectual Property and director of the U.S. Patent and Trademark Office in 2012 and ever since, some patent market observers have complained that Google has outsized influence in the administration.

Officials from Google declined to comment for this story.

“It's likely a Clinton administration would regard Silicon Valley differently than the Obama administration did,” one of the attendees said.

Meanwhile, the Trump campaign hasn't been nearly as proactive on intellectual property issues as the Clinton campaign. Indeed, the GOP candidate's only published remarks on IP issues cite a three-year old report published by the Commission on the Theft of American Intellectual Property in May 2013.

“According to the U.S. International Trade Commission, improved protection of America's intellectual property in China would produce more than 2 million more jobs right here in the United States,” the campaign says on the website www.donaldjtrump.com/policies/trade.

The commission, also known as the IP Commission, was co-chaired by Dennis Blair, a retired U.S. Navy Admiral and former Director of National Intelligence, and Jon Huntsman Jr., a former Utah governor and U.S. Ambassador to China.

The Trump campaign website does not elaborate on how a Trump administration would improve protection of America's IP in China or on how that would create 2 million jobs.

The IP Commission report itself covers patent violations, trade secret theft, and trademark infringement. It makes a number of executive branch and legislative branch recommendations for reforms to put pressure on China to curtail its theft of U.S. intellectual property rights.

Among the recommendations of the IP Commission are:

- Designate the National Security Advisor as the principal policy coordinator for all actions on the protection of American IP;
- Provide statutory responsibility and authority to the secretary of commerce to serve as the principal official to manage all aspects of IP protection;
- Strengthen the International Trade Commission's 337 process to sequester goods containing stolen IP;
- Empower the Secretary of the Treasury, on the recommendation of the Secretary of Commerce, to deny the use of the American banking system to foreign companies that repeatedly use or benefit from the theft of American IP.

The IP Commission also recommends the following legislative and legal reforms:

- Amend the Economic Espionage Act (EEA) to provide a federal private right of action for trade secret theft;
- Make the Court of Appeals for the Federal Circuit (CAFC) the appellate court for all actions under the EEA;
- Instruct the Federal Trade Commission (FTC) to obtain meaningful sanctions against foreign companies using stolen IP;
- Strengthen American diplomatic priorities in the protection of American IP.

"That kind of angle never gets any traction," said a patent market lobbyist, who also spoke on condition of anonymity.

Mrs. Clinton is much more of a known quantity than Mr. Trump. Her more than 20 year career in the public sector as First Lady, Senator from New York and Secretary of State means she's been lobbied for years, which may insulate her from the influence of special interests, the lobbyist said.

"Sure she's been influenced, she's a politician. But there's a much more massive thicket to invest in with her than there was with Obama. Google invested early in Obama when he was running for Senate in Illinois. It can't have the same early influence with Clinton."

Mrs. Clinton also may not forget that Google and Silicon Valley backed Obama against her during the 2008 election, he said.

Mr. Trump is much less of a known quantity on issues related to the economy, trade and intellectual property and his understanding of the issues is most likely superficial, he said.

To be sure, Mr. Trump may have been influenced on IP issues by his uncle John G. Trump, who was an electrical engineer, inventor and professor of electrical engineering at the Massachusetts Institute of Technology from 1936 to 1973.

Dr. Trump was a recipient of President Ronald Reagan's National Medal of Science, and a member of the National Academy of Engineering. His inventions included rotational radiation therapy, and together with Robert Van de Graaff, the development of the first million-volt X-ray generators, used for sterilizing food and other process materials.

The billionaire real estate developer also may have been influenced by his sister Maryanne Barry, 79, who previously was a Circuit Judge on the U.S. Court of Appeals for the Third Circuit from 1999 to 2011.

Trump probably doesn't care much about patents but he might use IP as a tool for changing free trade deals of the past, the lobbyist said

Silicon Valley has largely backed Mrs. Clinton over Trump because of his policy statements on free trade and immigration. Billionaire venture capitalist Peter Thiel is one of the few Silicon Valley investors to publicly back Trump, having contributed \$1.25 million to Trump's campaign.

As such, Silicon Valley patent reform is not likely to be a priority for a Trump administration either, the lobbyist said.

Patent market observers see little chance of activism by either a Clinton or Trump administration on patent issues compared with the Obama administration.

"Neither Mrs. Clinton nor Mr. Trump have expressed any activist positions regarding patent issues, so we would hope that their tenures would represent a change from what we've seen," said Patrick Van de Wille, a spokesman for **InterDigital Inc. (IDCC)**.

Indeed, Van de Wille said he expects that the recommendations of the Federal Trade Commission's recent report on patent assertion entity activity would likely structure part of the discussion in the next Congress. Those recommendations include allowing for customer stays on patent enforcement actions.

"Whether it's customer stay or any other legislative measure, the important thing is that it target things that are actual problems, with targeted solutions based on clear research."

He noted, however, that InterDigital is cognizant that the argument for policy making can sometimes end up being different than the wording of the actual policy rule.

"What's held up as a reason for some of the proposed changes, whether it's protecting consumers or curbing bad business practices, is never an issue, but the proposed wording of specific regulations often goes far beyond that, and threatens to damage good business practices and important research."

Regardless of who wins, "I don't think we'll see very much more legislative change," said Chandran Iyer, a partner in the Washington, D.C. office of **Sughrue Mion PLLC**. "I don't see anything more coming down the pike."

Efforts to enact some kind of loser pays reform are unlikely to get much traction regardless of who becomes president, he said.

Moreover, Iyer also predicted that regardless of who becomes president there's going to be a continued erosion of patent holder rights driven by the judiciary and especially the U.S. Supreme Court's rulings on patent eligibility.

"The Supreme Court will continue to take up patent cases and I don't think they'll handle them very well. I don't think they understand the patent landscape and what they've done to it."

If the nation faces issues it deems to be higher-priority, IP could be left as an afterthought – under either administration, said Mark Gober, a senior director at **3LP Advisors**, in the IP advisory firm's Silicon Valley office.

The countervailing factor is the extent to which people begin to publicize the declining value of U.S. patents, Gober said.

If a Clinton or Trump administration believes that German and possibly even Chinese patents are becoming more valuable than U.S. patents, it's possible that it'd be more likely to step in to improve patent rights domestically.

"However, the prevailing sentiment in the U.S. has been that U.S. patents are hurting innovation, and if that sentiment persists then we could see increased pressure for reforms that reduce patent values."

In the meantime, the election also will have an impact on the make up of the U.S. Supreme Court, which currently has a 10-month vacancy from the death of Justice Antonin Scalia and the opposition of Senate Republican's to President Obama's nominee.

Justices Stephen Breyer, 78, Ruth Bader Ginsburg, 83 and Anthony Kennedy are the most likely to retire during the next administration, giving either Mrs. Clinton or Mr. Trump the opportunity to shape the court for decades to come.

Among the three, Justice Kennedy is alone in criticizing so-called patent trolls, or those who use patents as a sword to go after defendants for money even when their claims are frivolous. The anti-patent troll rhetoric came in a 6-2 decision he wrote in *Commil USA v. Cisco*.

Justice Scalia went even farther in his criticism of trolls in the dissent signed by Chief Justice John Roberts, saying the majority's rejection of the good-faith belief in invalidity as a defense against induced infringement "increases the in terrorem power of patent trolls."

Academics including Lisa Larrimore Ouellette, an assistant professor of law and expert on intellectual property law at **Stanford Law School** in Palo Alto, California, has said no one on the high court would currently consider intellectual property his or her field of expertise.

Authorship of patent related cases has been distributed fairly evenly and Justice Scalia himself authored only nine patent related opinions, she has said.

Probably at least some of the other justices share Justices Kennedy's and Scalia's concern about patent trolls, Ouellette has said. They've heard many cases over the past 10 years, and in almost all of them, they've limited the rights of patent holders. That suggests some underlying concern with patent trolls. That's what's behind the patentable subject matter issue.

With justices appointed by Democratic and Republican presidents both seemingly in favor of limiting patent holder rights, it's not clear whether the election of Mrs. Clinton or Mr. Trump will make much difference for patent holders at least as far as the high court is concerned.

Finally, the patent market observers and lobbyists told The Patent Investor that in their view a new USPTO director in either a Clinton or Trump administration is unlikely to come from a major corporation and more likely to come from inside the USPTO, from Capitol Hill staff, or from a past director.

Among the names circulating are former directors David Kappos, a partner with **Cravath Swaine & Moore LLP**, and Q. Todd Dickinson, a partner with **Polsinelli LLP**.

Both Kappos and Dickinson declined to comment.

InterDigital is reaching out to like-minded small companies to help it educate possible Clinton administration on patents

InterDigital Inc. (IDCC), the technology licensing company run by CEO Bill Merritt, has recently reached out to small companies in Silicon Valley, who share its pro-patent rights agenda, in an effort to educate and shape a possible Hillary Rodham Clinton administration on the subject of U.S. patent policy and the choice of a director of the U.S. Patent and Trademark Office.

That's according to InterDigital officials and a person who attended one of two executive briefings entitled "The Next Four Years: Washington DC at the Ready," which the company hosted with **BGR Group**, the Washington, D.C. lobbying firm founded by former Mississippi Republican Gov. Haley Barbour. The briefings were held on Oct. 18th and 19th at the **Madera Restaurant Rosewood** at the **Sand Hill Hotel and Resort** in Menlo Park, California.

The briefing was led by Blair Watters, a senior director at InterDigital, who is one of two in-house lobbyists along with Rob Stien, vice president of government relations and regulatory affairs. It also featured Jonathan Mantz, who leads BGR's Democratic outreach efforts. Mantz has helped raise about \$500 million for Democrats overall during his career.

Watters said the briefings came together because she and Mantz had been in Silicon Valley to attend a fund raiser for Kamala Harris, the Democratic Attorney General of California, who is running for the U.S. Senate.

InterDigital's effort to reach out to other small companies, who are similarly pro-patent, appears to be an effort to counter the outsized influence of about five or six large Silicon Valley companies, such as **Google Inc.**, **Apple Inc.** and **Facebook Inc.**, who have shaped the public policy debate about patents over the last 8 years.

Indeed, these companies were hugely influential in getting Congress and President Obama to enact the America Invents Act of 2011, which created the inter partes review and covered

business method review processes overseen by the Patent Trial and Appeal Board as a cheaper and more efficient way to challenge weak patents than the district courts.

The person who attended the briefing said Watters and Mantz expressed the hope that Mrs. Clinton would seek advice from different industry advocates than have advised President Obama.

President Obama named former Google deputy general counsel Michelle Lee as director of the USPTO in 2012. Since then, patent owner advocates have complained that the administration has ignored their fears about patent rights being eroded by the U.S. Supreme Court's rulings on patentable subject matter and the AIA.

Mantz could not be reached for comment.

InterDigital's political action committee has contributed \$15,000 each to Mrs. Clinton, the Democratic presidential nominee, and to Donald Trump, the Republican nominee.

InterDigital employees also individually contributed \$12,350 to Mrs. Clinton as of Sept. 12, the latest figures available, according to data from OpenSecrets.org

InterDigital also has spent \$694,762 on lobbying in 2016, compared with \$1.23 million in 2015 and \$686,166 in 2014, according to OpenSecrets.org. The lobbying figures for 2016 were as of Aug. 9.

InterDigital's lobbying spending included spending on its internal lobbyists Watters and Stien, \$180,000 on lobbying by Lloyd Hand & Associates, and \$160,000 on lobbying by Kelley Drye & Warren.

The company's lobbying involved H.R. 9, the Innovation Act, S. 1137, the PATENT Act and S. 2733, the Venue Equity and Non-Uniformity Elimination Act of 2016.

In 2015, InterDigital's spending included lobbying by Watters and Stien, \$460,000 on lobbying by Lloyd Hand and \$220,000 on lobbying by Kelley Drye.

In 2014, the company's spending included \$430,000 on lobbying by Lloyd Hand, and \$40,000 on lobbying by King & Spalding.

PTAB rejects Google challenge to Network-1 patent allowing district court action to restart

Network-1 Technologies Inc. (NTIP), the patent licensing company run by CEO Corey Horowitz, said on Wednesday, Oct. 19, the Patent Trial and Appeal Board rejected a **Google Inc.** and **YouTube LLC** covered business method (CBM) challenge of one of the patents of Network-1's Cox Patent Portfolio.

New York-based Network-1 said the PTAB ruled that Google had failed to show that any of the thirty-four claims of U.S. Patent 8,904,464 were invalid.

In April 2015, Google and YouTube petitioned the PTAB to cancel the claims of the patent which is one of 12 issued patents of Network-1's Cox Patent Portfolio. In October 2015, the PTAB agreed to review all of the claims. A hearing on the merits of the CBM proceeding was held in May 2016.

"We are extremely pleased with today's PTAB decision," Horowitz said. "We have worked very hard with Professor Ingemar Cox to develop and protect the value of his inventions and we will continue to do so."

This isn't the first time Network-1 has beaten back a challenge of its patents by Google and YouTube. In June 2016, the PTAB upheld most of the claims of four of Network-1's Cox patents challenged in four inter partes reviews proceedings.

Network-1 said as a result of the PTAB's decisions in the CBM proceeding and the four prior IPRs, 120 claims have been found to be valid, and in total, 153 out of 163 claims or 93% of the challenged claims of the patents have survived Google's patent challenges in the IPRs and the CBM. None of Network-1's asserted claims from the patents in its pending litigations against Google and YouTube in the U.S. District Court for the Southern District of New York were found invalid.

In April 2014 and December 2014, Network-1 initiated litigation against Google and YouTube in the U.S. District Court for the Southern District of New York for infringement of several of its patents within the Cox Patent Portfolio acquired from Dr. Ingemar Cox which relate to the identification of media content on the Internet.

The lawsuits allege that Google and YouTube have infringed and continue to infringe certain of the Network-1's patents by making, using, selling and offering to sell unlicensed systems and related products and services, which include YouTube's Content ID system. The actions are currently subject to a stay which has been in effect since July 2015 as a result of the then pending IPRs and CBM proceedings at the PTAB. The PTAB ruling means that the actions against Google and YouTube will continue.

Network-1 has been successful this year in winning licensing settlements from infringers. Earlier this month, the company won a settlement from **Polycom Inc.** for more than \$5 million. It was at least the fifth major settlement achieved by Network-1 this year and followed a \$25 million settlement with **Apple Inc.** over infringement of a patent entitled "Document stream operating system," a \$6 million settlement with **Dell Inc.**, a \$4.3 million settlement with **Alcatel-Lucent**, and another with **Sony Corp.** The terms of the Sony settlement weren't disclosed.

The Cox Patent Portfolio includes patents relating to enabling technology for identifying media content, such as music and videos, and taking further actions to be performed based on such identification. Since the acquisition of the portfolio, Network-1 has filed 12 additional patent applications, 7 of which have been issued, bringing the total portfolio of granted patents to 12. Another 5 applications relating to the original specification are still pending and Network-1 anticipates further issuances of additional claims for this portfolio.

Finjan takes its enforcement campaign against Blue Coat to Germany where injunctive relief may pressure settlement

Finjan Holdings Inc. (FNJN), the cybersecurity licensing company run by CEO Phil Hartstein, said today it filed a patent infringement lawsuit on Friday, Oct. 14 in District Court in Dusseldorf, Germany against the German subsidiary of **Blue Coat Systems Inc.**, the third action filed by Finjan against Blue Coat.

The enforcement action was filed against Blue Coat's its subsidiary, Blue Coat Systems GmbH located in Munich, Germany. The complaint alleges Blue Coat Systems GmbH infringes Finjan's European patent EP 0 965 094 B1. The company may be hoping that injunctive relief, which is more available in Germany than in the U.S., may pressure Blue Coat to settle in the wake of the \$39.5 million award Finjan won earlier this year.

East Palo Alto, California-based Finjan said it also filed a preliminary injunction in a related enforcement action against Blue Coat filed on July 28 in U.S. District Court in San Jose, California before Judge Beth Labson Freeman. That trial is expected to start on Nov. 10.

Both moves are designed to put more pressure on Blue Coat to settle in the wake of the award Finjan won earlier this year and upheld by Judge Freeman in July. Blue Coat is appealing the award.

"The impetus for our third suit against Blue Coat and its subsidiary, Blue Coat GmbH, is that we believe that they continue to infringe other patents in our portfolio, including Finjan's European patent, even after we obtained a \$39.5M jury verdict and judgment against Blue Coat for infringement last August," Hartstein said in a statement.

"We have essentially two options when dealing with an unwilling licensee -- seek the courts' assistance to enforce our patents on the merits, or abandon those patent rights. For Finjan, the latter is simply not an option."

Finjan has pending infringement lawsuits against **FireEye, Inc., Symantec Corp., Palo Alto Networks**, and **ESET** and its affiliates relating to, collectively, more than 20 patents in the Finjan portfolio.

Spherix to offer advisory service to inventors, small companies on patent enforcement

Spherix Inc. (SPEX), which turned its patent enforcement efforts over to Dean Becker's **Equitable IP Holdings Corp.** earlier this year, has become the latest patent licensing company to offer a new service to help inventors and small companies monetize their patents.

Bethesda, Maryland-based Spherix, which has had few successes in bringing enforcement actions on its own, has now brought 10 new enforcement actions funded by Equitable IP. Such actions typically cost upwards of \$3 million a piece and will take many years before Spherix and Equitable IP can expect a recovery.

Spherix CEO Anthony Hayes said in a statement the new initiative called Spherix Management Services was formed “in response to the market demand that we have received from industry participants.”

Hayes said the initiative will help clients grow their businesses and generate revenue by successfully monetizing their patent portfolios. “We believe this is a unique opportunity that will prove mutually-beneficial for our clients and our company as a whole.”

To be sure, many other licensing companies provide such services including **Marathon Patent Group (MARA)**, run by CEO Doug Croxall, and **Dominion Harbor Group**, run by CEO David Pridham.

“Spherix will not add any additional costs to its current operations as part of this strategic direction,” Hayes said. “Instead, we will leverage the considerable scale and talent that we have built at our organization into a fee for services based revenue stream that will augment our existing business. We hope to have new clients shortly.”

Hayes said the company does not intend to invest in or finance any third party intellectual property. He said the new subsidiary will aim to provide strategic advice, legal and other back office support to the rapidly growing number of investors and small firms that seek to monetize their intellectual property.

"It's unclear what the additional revenue potential might be for Spherix," said Mark Gober, a senior director at **3LP Advisors** in the IP firm's Silicon Valley office. "Ostensibly it seems like their core licensing business will need to be successful if Spherix plans to survive and thrive. This new licensing initiative seems like an incremental avenue to explore but perhaps not a core one or a 'game-changer.'"

Gober noted that Spherix has had limited success monetizing its own patents and that will be a hurdle in explaining its value proposition – particularly when there are other licensing firms that have a stronger track record of generating revenue, and doing it over a longer period of time such as **Acacia Research Corp. (ACTG)**, **Wi-Lan Inc. (WILN)** and others.

Spherix shares, which soared more than 27% on Tuesday, Oct. 18, fell as much as 12.5% or 19 cents in trading today. They are currently down 13 cents or 8.75% to \$1.38 in afternoon trading. They have traded between \$1.05 and \$8.93 over the past year.

Marathon's Croxall cancels 80,000 options as stock remains well below conversion price

Marathon Patent Group (MARA) CEO Doug Croxall returned 80,000 of the 300,000 options he was given in November 2014 for cancellation because shares of the patent licensing company are trading at a fraction of the conversion price.

The transaction involving the cancelled options occurred on Oct. 13. The conversion price of the options, which expire Nov. 3, 2024 was \$12.80. Shares of Marathon closed today at \$2.36. They've traded between \$1.29 and \$3.44 over the past year. They touched a 5-year high of \$9.18 on Dec. 15, 2014.

Croxall declined to comment.

He is cancelling options at a time when Marathon is having its best year ever. Earlier this year, the Los Angeles company said it expected revenue in 2016 to exceed \$40 million.

The company has announced several significant licensing settlements recently including a \$24.5 million settlement its Dynamic Advances and partner **Rensselaer Polytechnic Institute** reached with **Apple Inc.** Other recent settlements with **Titanium2Bone** and **DFine** have involved Marathon's Orthophoenix unit, which also has now settled pending litigation with **Stryker Corp.** and **Wright Medical Technology Inc.**

The company's Signal IP unit which sued a number of car manufacturers for infringement also has reached settlements with 10 car makers. It still has pending enforcement actions against **Fiat Chrysler, Kia, Hyundai** and **Nissan.**

In other news, Richard Molineaux Tyler III, and Edward Kovalik, both Marathon directors, each received 20,000 options to purchase Marathon shares at \$2.41 each. The transactions also occurred on Oct. 13. The options vest pro rata on a monthly basis over 12 months beginning Oct. 14 and expire on Oct. 13, 2021.

Upcoming conferences and events in the IP space

The International IP Commercialization Council is hosting a conference entitled "Entrepreneurship, Innovation and Patenting in the U.S. on Wednesday, Oct. 26 from 5:30 pm to 8:30 pm at Hewlett Packard's headquarters in Palo Alto, California.

For more information, go to: <https://www.eventbrite.com/e/entrepreneurship-innovation-andpatenting-in-the-us-tickets-28067593929>

The IP Dealmakers Forum 2016 – November 17 & 18 – New York City – Now in its third year, the IP Dealmaker Forum has become one of the most anticipated IP event of the year. The IP Dealmakers Forum is designed to connect investors with intellectual property information and opportunities. Check out the agenda, speaker line-up, and new dealmaker deep dive sessions.

<http://www.ipdealmakersforum.com/patentinvestor16/>. Special Offer for The Patent Investor Readers: Use promo code "PatentInvestor_Offer16" for \$100 off the registration price.

Editor and Publisher Dan Lonkevich is available for public commentary and speaking engagements. Connect with him on LinkedIn.

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