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IP Litigator

Hidden Leverage in Plain Sight – Reassessing Mature Patent Value in the Current Enforcement Environment

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Historically, some operating companies treated older patents in their portfolio as background assets—useful for defensive signaling, occasionally relevant in licensing discussions if a particular technology later found commercial relevance and necessary to maintain good intellectual property (IP) hygiene. But many assets were treated as rarely meriting another in-depth look once issued. In the past, that approach was understandable. Enforcement outcomes felt uncertain, venues unpredictable or excessively expensive, and invalidation risk at the Patent Trial and Appeal Board (PTAB) too high compared to the potential return, so the marginal value of revisiting mature assets often seemed low. Many in-house counsel teams prioritized new filings, product-aligned coverage, and controlling costs, which are all reasonable strategies.

However, patent portfolios do not exist in a static environment, and when enforcement conditions shift, the strategic value of existing patents can increase quickly. New filings take time to work through the United States Patent and Trademark Office (USPTO), even under accelerated programs such as **Track One**, and so a periodic, disciplined reevaluation of already-existing assets can be a valuable exercise.

Even modest portfolios might contain so-called “Rembrandts in the attic”: patents that were never designed as litigation centerpieces, but that now—because of market evolution, competitor behavior, or changes in enforcement dynamics—may support meaningful deterrence or commercial leverage if properly understood and, in some cases, selectively enforced or identified for further development through continuing application practice. Dusting off patents that issued six or more years ago in view of the “settled expectations” policy development at the PTAB can add fuel to discretionary denial arguments if a patent is challenged in an inter partes review (IPR). Coupled with quick, strategically prosecuted “new” patents, enforcement in a fast-moving district court or the International Trade Commission (ITC) can be an attractive option for companies looking to minimize delay, and finding non-U.S. counterparts where competitors manufacture or sell can quickly turn into global leverage.

The goal of revisiting mature patents is not strictly to gear up for litigation. Companies that understand which assets could credibly be asserted, which can be upgraded, and which are truly maintenance-only are better positioned to navigate unpredictable competitive dynamics. This is true no matter a company's IP portfolio goals and can provide a meaningful audit for current and future prosecution efforts, whether the next challenge comes from a direct

competitor, a disrupted supply chain, or a shifting regulatory environment.

Why ReEvaluating Is Beneficial

Patent portfolios are often managed as if all assets depreciate at the same rate. But a patent's current strategic value depends on more than its issue date, remaining term, or initial perceived value. Asking (1) whether the claims still map to commercially relevant products, (2) whether the specification supports evolving technology for mining, and (3) whether competitors have converged on similar technical solutions where they may not have done so in the past are all practical questions to raise when re-evaluating a mature portfolio.

Consider a consumer products/electronics company that obtained platform patents eight or ten years ago covering a core mechanical or electromechanical subsystem. At the time, the market may not have fully converged on that solution, or the company may have lacked a compelling reason to assert against competitors. Fastforward to today: competitors may now be implementing nearly identical structures, sourcing components from the same manufacturers outside of the United States for import, or shipping finished products through other jurisdictions where remedies may be even more meaningful (consider potential jurisdictions that carry a credible threat of quick injunctions or seizures for global small and medium-sized enterprises, close-copy and gray markets, or “knockoffs”). The patent and its related counterparts around the globe themselves have not changed, but their strategic context has.

Medical devices can produce similar patterns, where older patents directed to system architectures, user interfaces, or treatment workflows may suddenly become more valuable when competitors adopt comparable designs to satisfy now-existing regulatory or usability constraints. A patent that once felt narrow or niche may now sit squarely on the commercial path competitors must travel.

One practical challenge is that many companies do not have a framework for distinguishing these assets from the rest of the portfolio. Without triage, everything looks equally important (or unimportant). Additionally, treating this re-assessment as a strictly in-house effort could risk bias due to internal company politics or favored business units.

A Practical Audit Framework

A useful way to approach mature portfolio review is to audit and sort assets into three categories: 1) enforcementgrade assets, 2) upgradeable assets, and 3) maintenanceonly or retire candidates. The exercise is not about perfection; it is about clarity and focused triage.

1. Enforcement-grade assets

The first category consists of enforcementgrade assets—patents that, today, could credibly support assertion, licensing, deal leverage, or deterrence (with a bonus if they issued six or more years ago to bolster “settled expectations” arguments). These patents often share a few characteristics. They map cleanly to commercially relevant products or features (the company's own or third parties'). The invention(s) (as claimed) can be explained clearly, even to a nontechnical decisionmaker. The specification provides enough detail to support reasonable claim interpretation flexibility while maintaining appropriate definiteness and controlling potential design arounds. And importantly, the prosecution record does not contain statements that would limit the scope or undermine the credibility of a creative infringement read.

2. Upgradeable assets

The second category includes upgradeable assets. These patents may have gaps or weaknesses, but have a solid foundation and the ability to continue prosecution. Perhaps the independent claims are too narrow, but the family is

still alive, and targeted Track One continuation claims can quickly be drafted, filed, and allowed to aggressively pursue better coverage of competitor products. Perhaps the claims were drafted before the market converged on a particular implementation, and continuations could now be even more narrowly tailored to current product realities and take some of the better prior art off the table. In these families, focused investment can materially improve strategic value. And while we've previously acknowledged that strategic prosecution typically costs more, if a company is in a position to consider upgradeable assets, it is often worth the investment. Compared to "routine" prosecution, strategic prosecution on this level requires deeper technical engagement, closer coordination with product experts and between in-house and outside counsel, more careful and creative claim drafting, and additional forethought that considers other patent families and family members. But in the current and foreseeable environment, a company can achieve a significant return on investment.

3. Maintenance-only or retire candidates

The third category covers maintenance-only or retired candidates. These patents may still provide defensive comfort or incremental coverage, but they are unlikely to move the needle in a competitive dispute. Treating them as such could free both budget and attention for assets that matter more—enforcement-grade or upgradeable assets.

This periodic re-evaluation can replace potential vague confidence ("we have a large portfolio") with actionable understanding ("these five families are where leverage actually lives"). Once you have categorized your assets, you can define clear next steps and focus resources where they matter most.

What "EnforcementGrade" Patents Really Look Like

Importantly, enforcementgrade does not mean "perfect," and, of course, no patent is immune from challenges. But certain qualities can be identified as thematic of "enforcement-grade" patents as you work through re-evaluating your mature portfolio.

One is jurylevel clarity. Even in highly technical fields, the core invention(s) should be explainable in plain language, and so should the benefits. For example, a medical device patent covering a particular treatment sequence could be more powerful when the narrative can focus on workflow efficiency, patient outcomes, or measurable benefits rather than circuitlevel minutiae. Similarly, in consumer products, patents that capture how components interact to deliver a userperceivable benefit may resonate more than those tied to obscure optimizations for a specific manufacturing process, not likely to be replicated or design specifications without much explanation in the specification as to why those matter.

Another is credible product mapping. Enforcementgrade patents must, of course, align with real products. At the audit stage, a full infringement analysis isn't required. But being able to point to specific features or structures competitors include (and cannot easily avoid without sacrificing value) is a good part of this initial triage process. A strong patent does not need to cover every conceivable alternative, but it should at least force competitors or other third parties (e.g., contract manufacturers) into uncomfortable choices. If competitors are forced into higher-cost alternatives, reduced performance, delayed product launch, or increased regulatory risk, that can be a win in the competitive marketplace. In the medical device space, for example, claims that tie together physical structure with a particular clinical workflow that is, in essence, a requirement can be especially difficult to route around.

Finally, enforcementgrade patents typically have strong, clear specifications that have room for additional mining. Remember that the audit phase does not presuppose immediate enforcement of existing patents. Rather, identifying mature assets of value is one of the first steps in either building an enforcement effort or meaningfully auditing current strategic prosecution efforts. A mature patent asset that was drafted to anticipate variation (e.g., by having a robust specification) and lends itself to future mining can be ripe for Track One, targeted continuing applications. Such

flexibility often matters more years later than initial claim breadth, particularly if market or enforcement conditions are now different from when the initial foundations were laid. Additionally, if portfolios have changed hands to different outside counsel that is now tasked with additional mining, the specification is locked in, and a flexible specification is a tangible benefit.

Selective Investment, Not Portfolio Overhaul

Upgradeable assets are often the most attractive targets for reinvestment because they combine sunk cost with future potential. But one mistake companies sometimes make is trying to upgrade too many assets at once. A suggested approach is to identify a small number of families—often three to five—that sit closest to current known targets or key technology.

For example, a consumer product company may hold a pending, decadeold patent family covering a mechanical coupling mechanism. At the time of filing, the claims focused on features relating to increasing durability. Today, competitors may be using nearly identical couplings to enable modularity or easier assembly. If the specification supports it, continuations can be crafted to capture those additional use cases, or different features that relate to those use cases that may not have been viewed as valuable years prior.

Companies can upgrade where commercial and competitive signals are strongest, and after an audit, decide not to upgrade families even where sunk cost is highest if there is not a further opportunity for economic or competitive benefits.

Not every patent needs to carry strategic weight, and maintenanceonly assets still have a role. They can support freedomtooperate narratives, preserve defensive options, or simply protect incremental innovations. But treating them as equivalent to enforcementgrade or upgradeable assets doesn't give the company an accurate picture of its IP and could result in unnecessary costs. Rationalizing maintenance decisions is not just a budgeting exercise when strategic thought is put into it. And reasonable pruning of lowleverage assets can allow companies to deepen strategic prosecution investment where it counts. Moreover, allocating legal spend rationally can allow in-house teams to reduce any potential internal friction that might come from managing a portfolio that is larger than it needs to be.

An Audit Outline

Companies often delay portfolio audits because they sound time and resource consuming. In reality, a firstpass reevaluating can be done efficiently, if those performing it are keyed in to the right questions. Some potentially useful questions include:

- Does this patent map to a product or feature the company and/or competitors actually sell today?
- Can the inventive concept be explained clearly without relying on industry jargon?
- Would a competitor face meaningful tradeoffs trying to design around it?
- Does the specification support claim refinement based on the market's evolution?
- If this were the only patent available in a negotiation, would it matter?

During the initial audit, answers do not need to be perfect. The initial exercise is about identifying candidates for deeper review, not rendering final judgments. The more detailed work of Track One claim drafting, claim charting, and file history review can begin afterward. Companies that understand which of their assets matter (now), which can be

strengthened, and which are unlikely to carry weight are better positioned to respond when competitive dynamics shift—whether through enforcement, licensing, or strategic negotiation.

Portfolios should not be treated as static artifacts of past innovation. They are living strategic tools. The question is not whether valuable patents exist in the portfolio, but whether the company has taken the time to identify them and decide how they fit into a broader competitive strategy.

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