

IP Issues and Opportunities

Startup Leadership Program

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November 3, 2014

What is Intellectual Property?

- Patent
- Trademark
- Copyright
- Trade Secret

Awareness of IP Value

- Companies can destroy value.
 - Lack of patents covering company innovations.
 - Lack of protection of trade secrets.
 - Failing to protect proprietary information of customers or partners.
 - Lack of an inventory of IP.
 - Lack of a database that matches products and services to the IP.
 - Retaining patents that do not relate to current or potential business.
 - Failure to monitor IP agreements.
 - Putting only cash into partnering agreements.
- Companies can realize value by organizing IP, innovating/inventing, and having an external focus.

Adapted from Edison in the Boardroom Revisited, Harrison and Sullivan, 2012.

The Environment for IP – trends and issues

- Significant events and changes in the last 12 years affecting IP:
 - Rise of the Nonpracticing Entity
 - Technology Convergence
 - Corporate Structures
 - Globalization
 - National IP Policies
 - Harmonization
 - Changing Legal Environment
 - Patent Investors

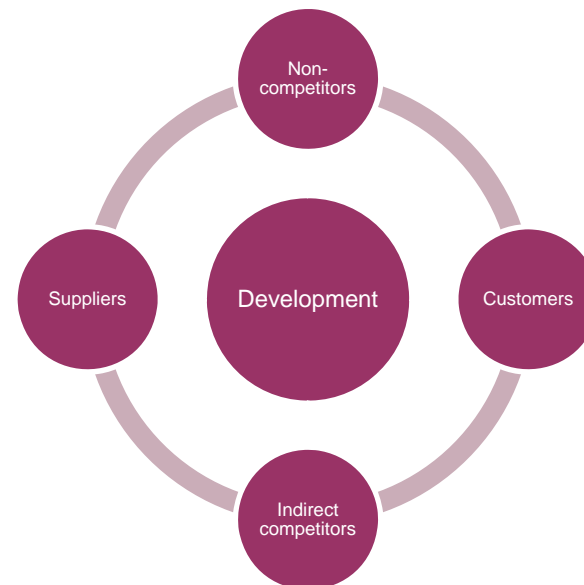
Moving Toward Collaborative IP

- All about relationships:
 - Can be more important than money.
 - Innovation has become more heterogeneous, technologies more interconnected.
 - A top strategy for accelerating innovation is to increase IP-enabled collaboration with others.

“New Rules for Licensing In A New World,” Marshall Phelps, les Nouvelles, March 2008

Moving Toward Collaborative IP

- Relationships – making and nurturing them – will drive collaborations:
 - IP should serve the business.
 - Look beyond the usual suspects:
 - Non-competitors
 - Indirect competitors
 - Suppliers
 - Customers



IP Protection During Collaborative Research

- File a “complete” patent application prior to interactions with third parties.
 - Complete applications (provisional or original) should be able to support later-filed claims and, therefore, priority date.
 - If invention is partially developed, file a series of applications before interactions.
- All third party interactions should be under an obligation of confidentiality.
 - Balance what to disclose – and what not to disclose – under the obligation of confidentiality.
 - Do not disclose trade secrets, even with confidentiality.

IP Protection During Collaborative Research

- Brainstorm, record and witness laboratory notebooks prior to interactions with third parties.
- Confidentiality agreements with broad description of your invention(s).
- Do not rely on the one-year grace period.
- Keep timely, accurate internal records, as well as with regard to what is shared with third parties.
 - Designate custodian of information.
 - Carefully document what was conceived prior to any disclosure.

IP Protection During Collaborative Research

- Include provisions in collaborative research agreements to review and coordinate patent filings and process.
 - May help to eliminate certain references of either party during prosecution.
- Review existing agreements to ensure that future patent application claims fall within the scope of the joint research.
- Monitor third party patent publications.
 - Increase competitive intelligence activity, and focus on competitor technology as well as patents.