Intellectual Property – 10 things to know

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Speaker

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1. Navigating the IP minefield

- Understand the IP landscape to mitigate and understand freedom to operate risks.
- Be proactive with simple and cheap searches.
- Learn what you can and be aware of competitor and third party IP.
- Understand what you do not or cannot know.

*There are things we do not know we don't know.* So when we do the best we can and we pull all this information together, and we then say well that's basically what we see as the situation, that is really only the known knowns and the known unknowns. And each year, we discover a few more of those unknown unknowns.

*Donald Rumsfeld*
Online patent resources

• Japan: https://www19.j-platpat.inpit.go.jp/PA1/cgi-bin/PA1INIT?1453491145544
• United States: http://patft.uspto.gov/
• Canada: http://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/h_wr00001.html
• WIPO (PCT): https://patentscope.wipo.int/search/en/search.jsf
• UK: https://www.gov.uk/search-for-patent
• Germany: http://www.dpma.de/english/
• Sweden: http://was.prv.se/spd/search?lang=en
• Google Patent Search https://www.google.ca/advanced_patent_search
Online trademark resources

• United States: http://www.uspto.gov/trademark
• WIPO: http://www.wipo.int/amc/en/trademark/output.html
• UK: https://www.gov.uk/topic/intellectual-property/trade-marks
2. Culture of innovation

- Showcase company IP to inspire creativity and innovation.
- Empower employees to identify, develop and improve IP assets.
- Provide awards, forums and contests for idea sharing.
  - “Day off” to invent or “15% program”
  - Include employees from all departments
- Implement in-house workflows to streamline IP registration process and recognize work required by inventors.
- Offer in-house seminars to educate team on IP and business strategy.
3. Get defensive

• Secure IP rights for core technology for cross-licensing and patent pools.

• Develop strategies for responding to and avoiding IP infringement complaints.

• Sometimes best defense is a good offense.

• Need chips to stay in the patent poker game.
4. Strategic offence

- Understand the costs, limits and constraints of IP enforcement. Consider alternative strategies to litigation.
- Understand forum and jurisdiction issues.
- Phases of enforcement over time.
- Interacting with competitors and customers.
5. Pick the winners

• Do not fall in love with your IP.
• Defer costs where possible until winners emerge.
• Consider ongoing costs over lifecycle of IP.
• Avoid being thinly spread. Drop the losers and fortify the winners.
• Review each IP asset at different stages of its lifecycle
  o formalization of provisional filings
  o foreign filings
  o examination
• Consider competitors, product roadmap and business strategy
6. Show me the money

- Identify value in IP by evaluating core technology and mapping to IP assets for investors and your balance sheet.
- Identify overall value of IP in a transaction.
- How to value?
  - Replacement cost
  - Royalty cash flow
  - Market incremental value
- What is not valued in money, is (usually) rarely valued in fact.
7. Own it!

- Understand the default position for ownership of all forms of IP.
  - Payment for work, does not mean ownership by default
  - Inventor or author first owner with obligation to assign
  - Get inventorship and authorship correct!
    - Moral rights must be waived

- IP rights transfer, feedback and confidentiality clauses and obligation to assist for creation team
  - Review and revise contracts
  - Adequate consideration for updates

- Do not “taint” your IP assets with 3rd party IP
8. People management

- Employees and inventors have access to valuable company knowledge
- keep trade secrets and confidential information secret
  - controlled disclosure
  - need to know basis
  - appropriate markings on key documents
- Clean technology development
  - access to 3rd party IP
  - obligations to 3rd parties (e.g. consultants, experts)
  - hiring from competitors
- Communication policies to avoid “loaded” comments on competitors and IP that may be discoverable
9. Get in control

• Control your brand by performing clearance searches.
• Register it! An essential platitude.
• Proactively monitoring use of your brand by others online in social media, hashtags, keyword ads, and domains. Don’t get carried away with enforcement. Think about positive and negative publicity.
10. Think globally

- IP protection is long-term.
- Global IP protection requires registration in multiple jurisdictions with separate government fees and different legal tests.
- Understand how treaties work to harmonize rights across jurisdictions and defer costs to concentrate on winners as they evolve over time.
  - Paris Convention - later filed foreign and domestic applications can claim priority date of earlier filed application if filed within time window
  - Patent Cooperation Treaty - International patent filing system to defer foreign filing costs and keep options open for 30 months from first filing
  - Madrid Protocol – International trademark system
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