

Introduction to Patents & other Intellectual Properties (IP)

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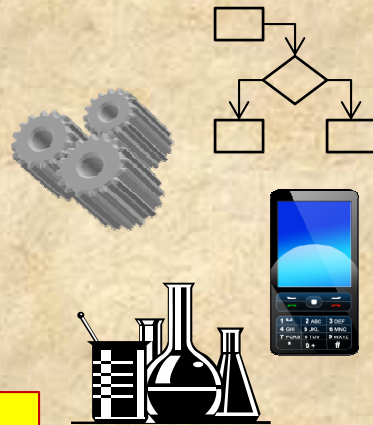
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Intellectual Property (IP) = Intangible

Patent

- Process
- Machine
- Manufacture
- Composition of Matter



Novel & Non-obvious

Copyright

- Literary, dramatic, musical, choreography
- Pictorial, graphic, sculpture
- Audio-visual,
- Sound recording
- Architectural



Original & Fixed

Trade Secrets

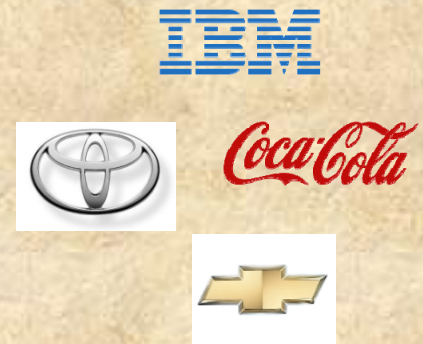
- Customer List
- Know how
- Marketing Plans
- Technology
- Secret formula



Commercial Value Derived from Secrecy

Trademark

- Words
- Names
- Symbols
- Slogan
- Sounds / Colors
- Trade dress

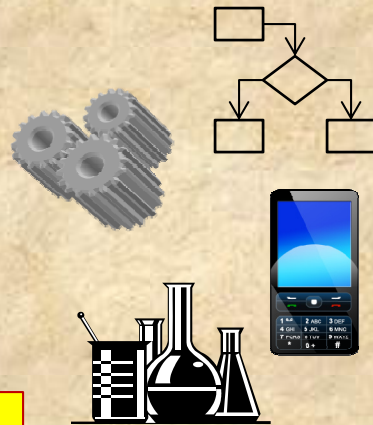


Use of Mark to Distinguish Goods/Services

Protection (against) & Term

Patent

- Making
- Selling (or offer to sale)
- Using
- Importation



20 years *

Copyright

- Reproduction (copying)
- Distribution
- Public Display/Performance
- Transmission
- Derivative work



Life of Author + 70 yr *

Trade Secrets

- Copying, Using, Benefiting, Disclosing

BUT:

- Can NOT prevent back engineering
- Lost if publically disclosed
- Others may independently discover

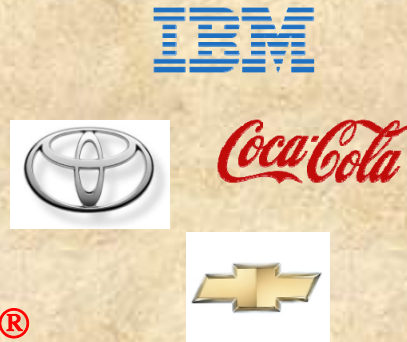
As long as value & secrecy maintained

Trademark

- Unfair competition
- Consumer confusion
- Importation (Federal)

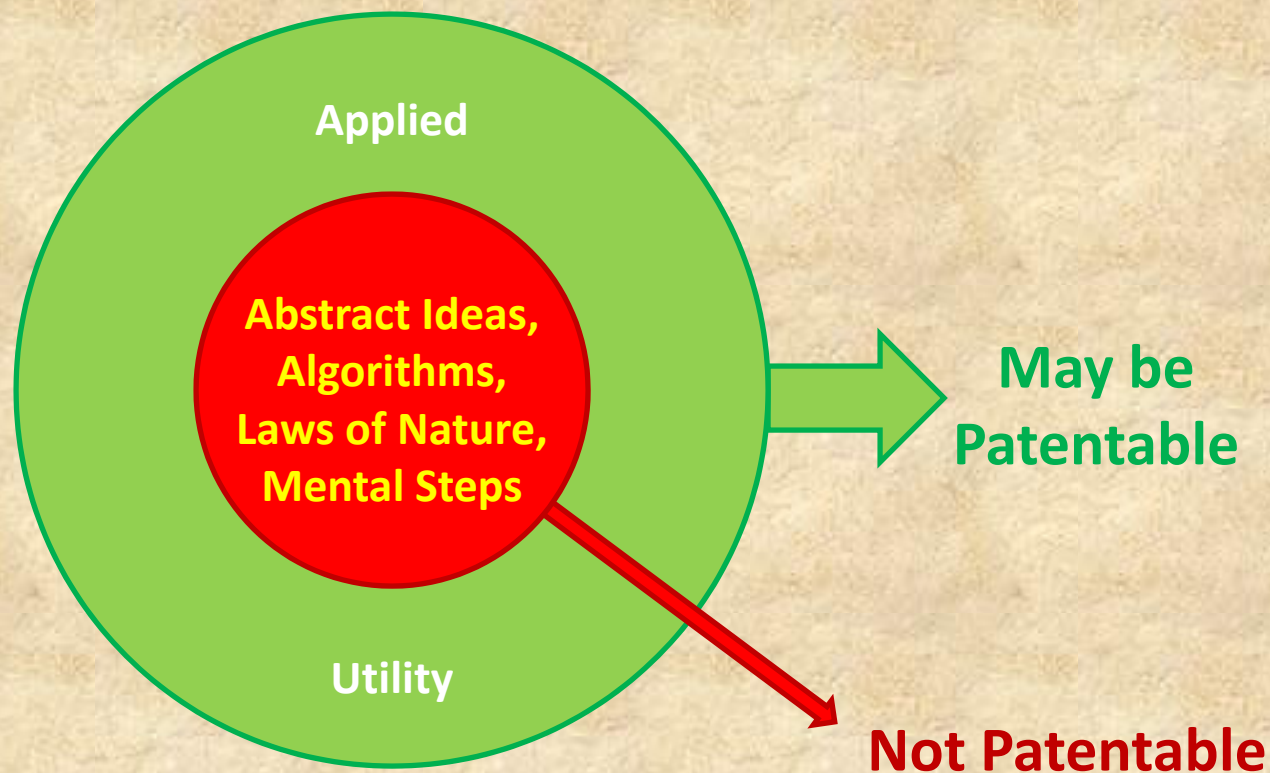
COVERAGE:

- State (local)
- Federal (nationwide) ®



Until use is discontinued or mark becomes generic

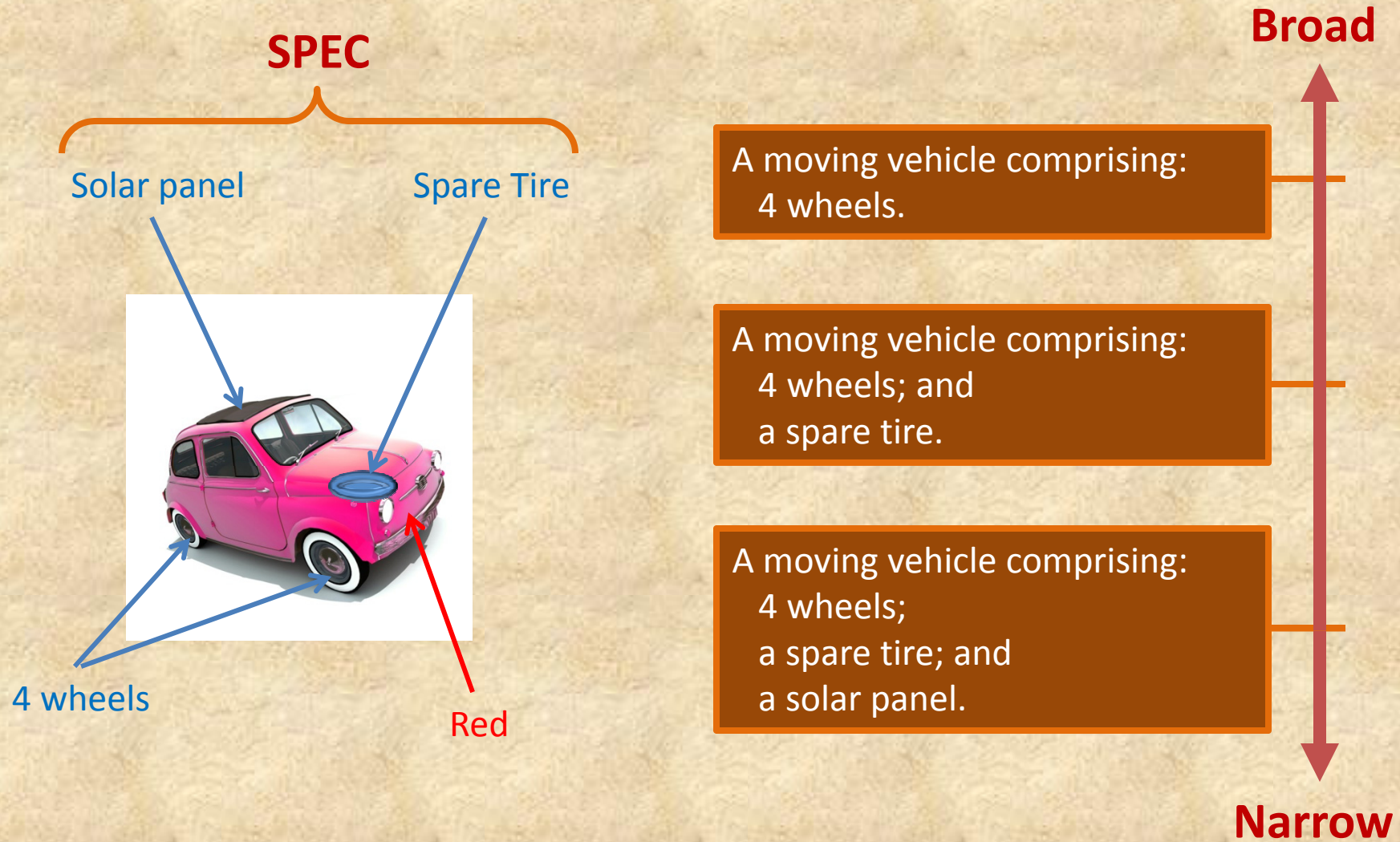
Allowable Subject Matter



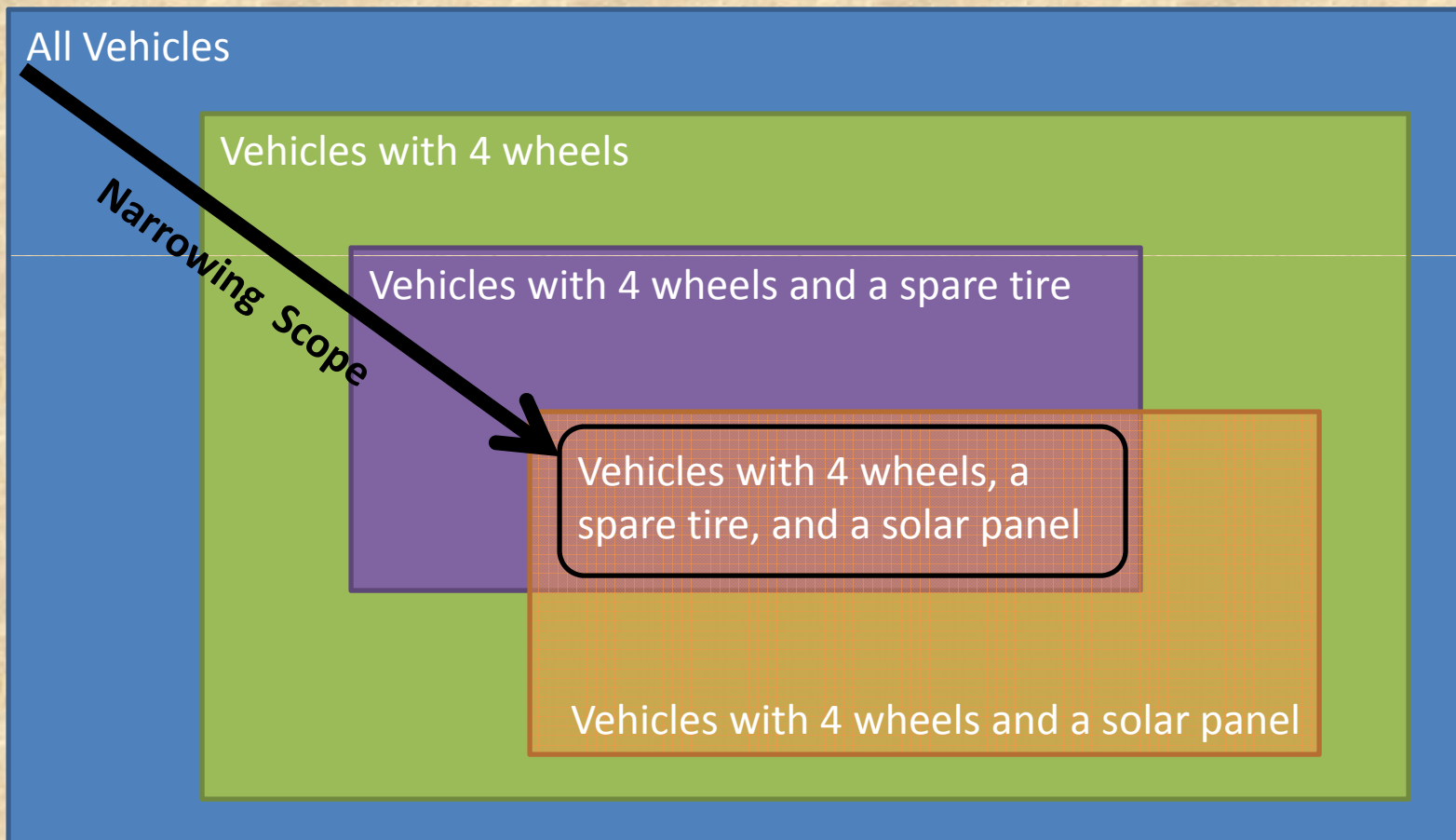
Anatomy of Patent Application



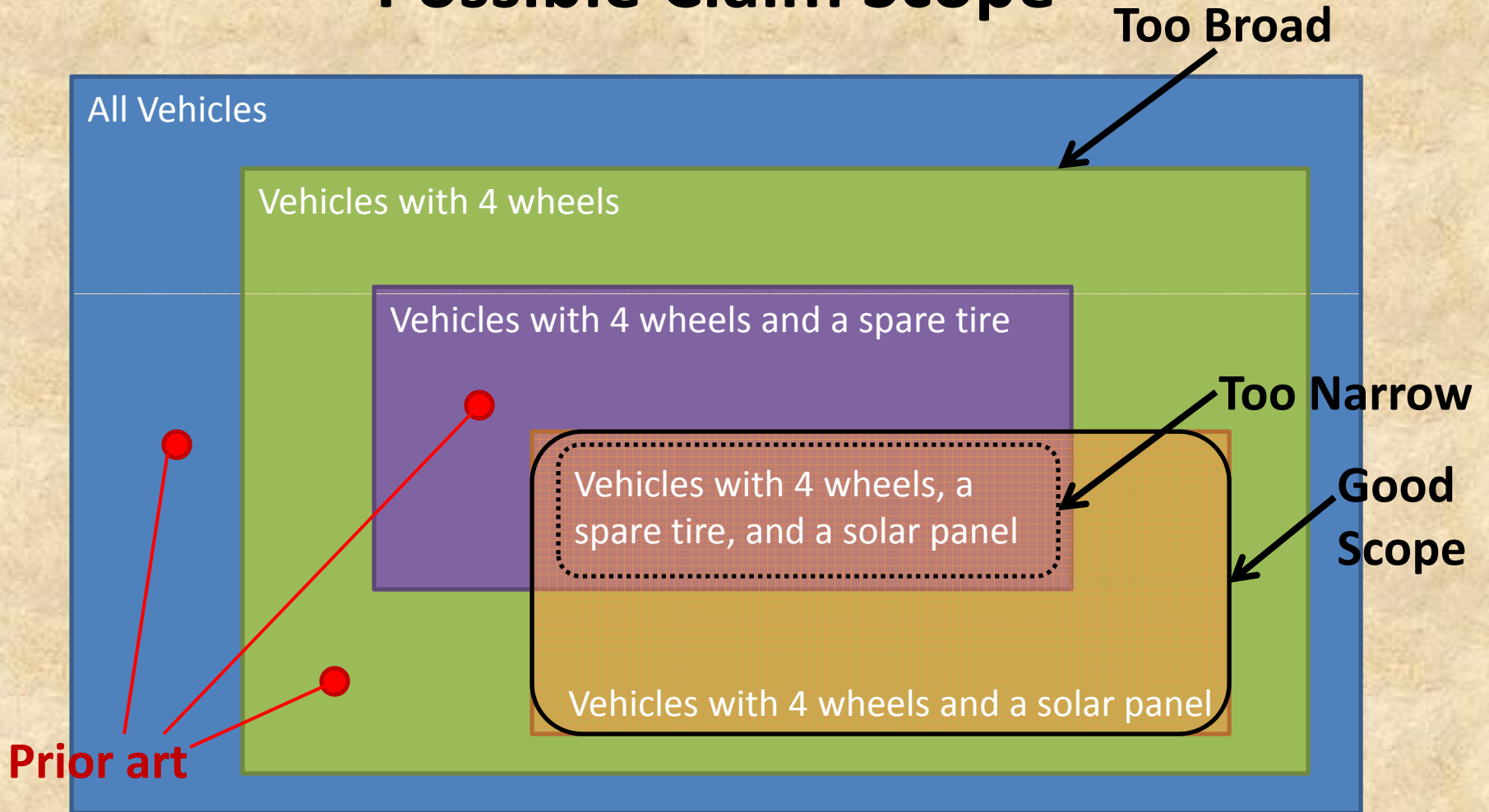
Examples of Claim Scope



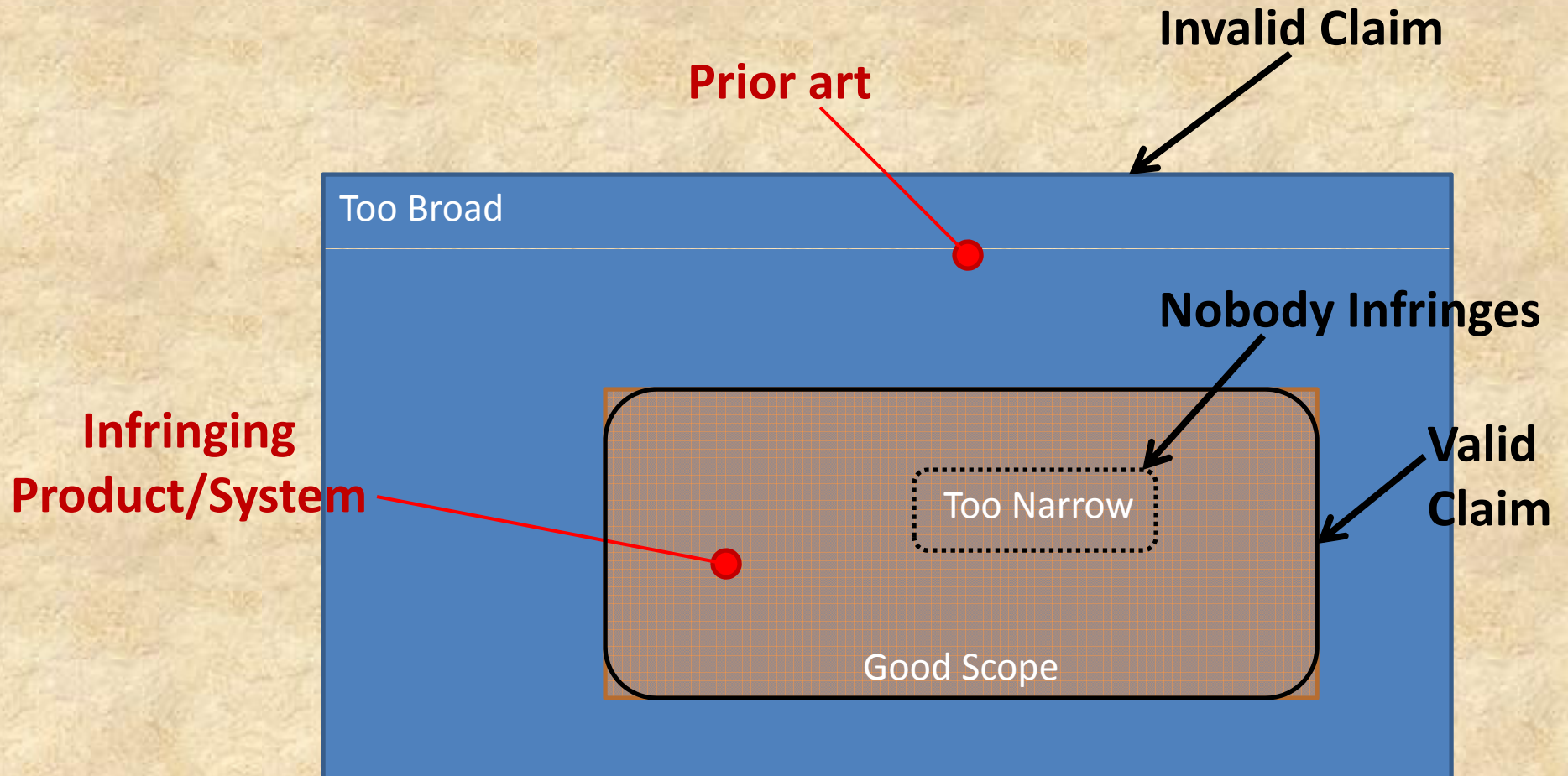
Claim Feature or Element = Limitation in Claim Scope



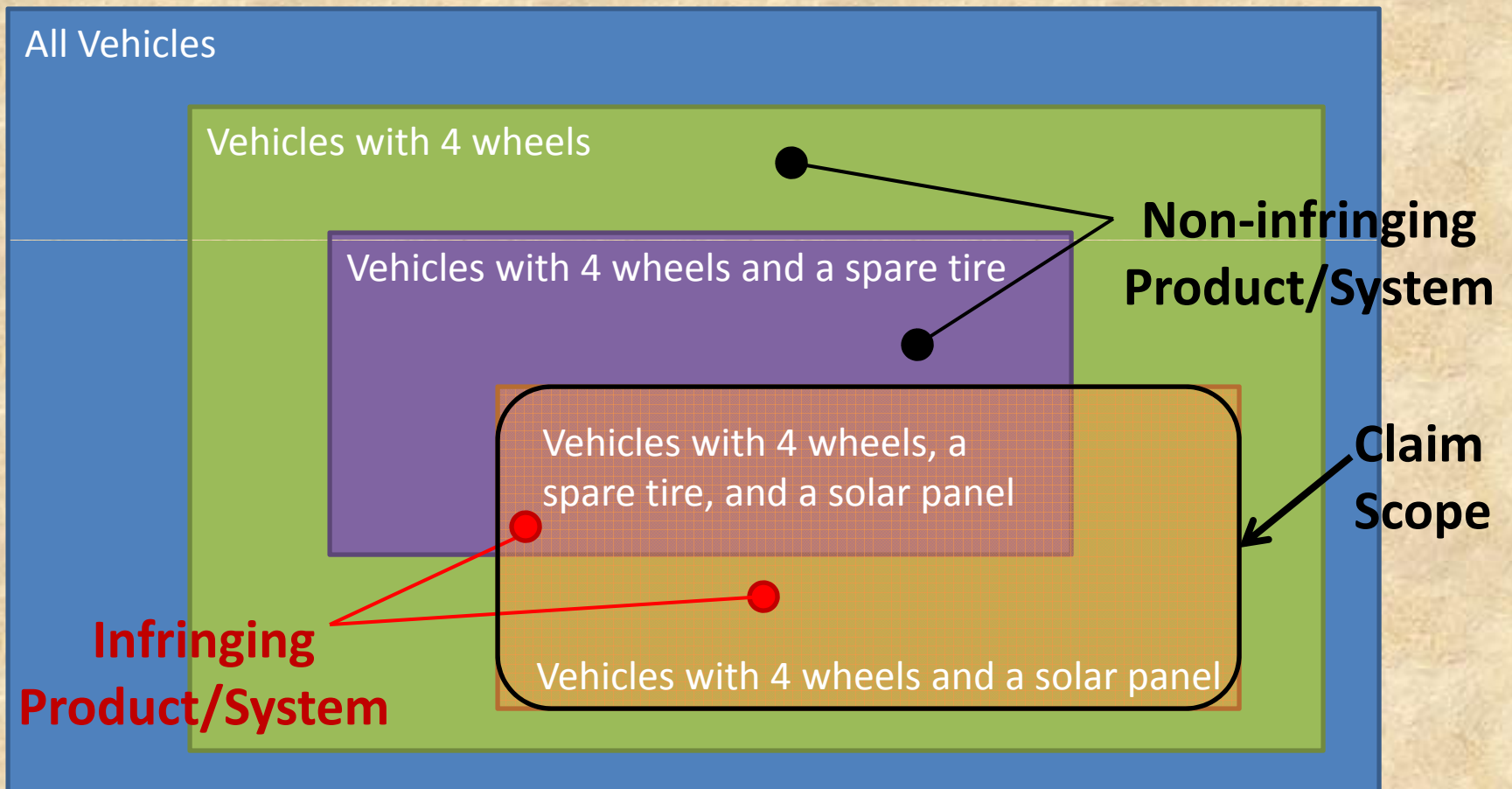
GOAL: To Avoid Prior Art Using the Largest Possible Claim Scope



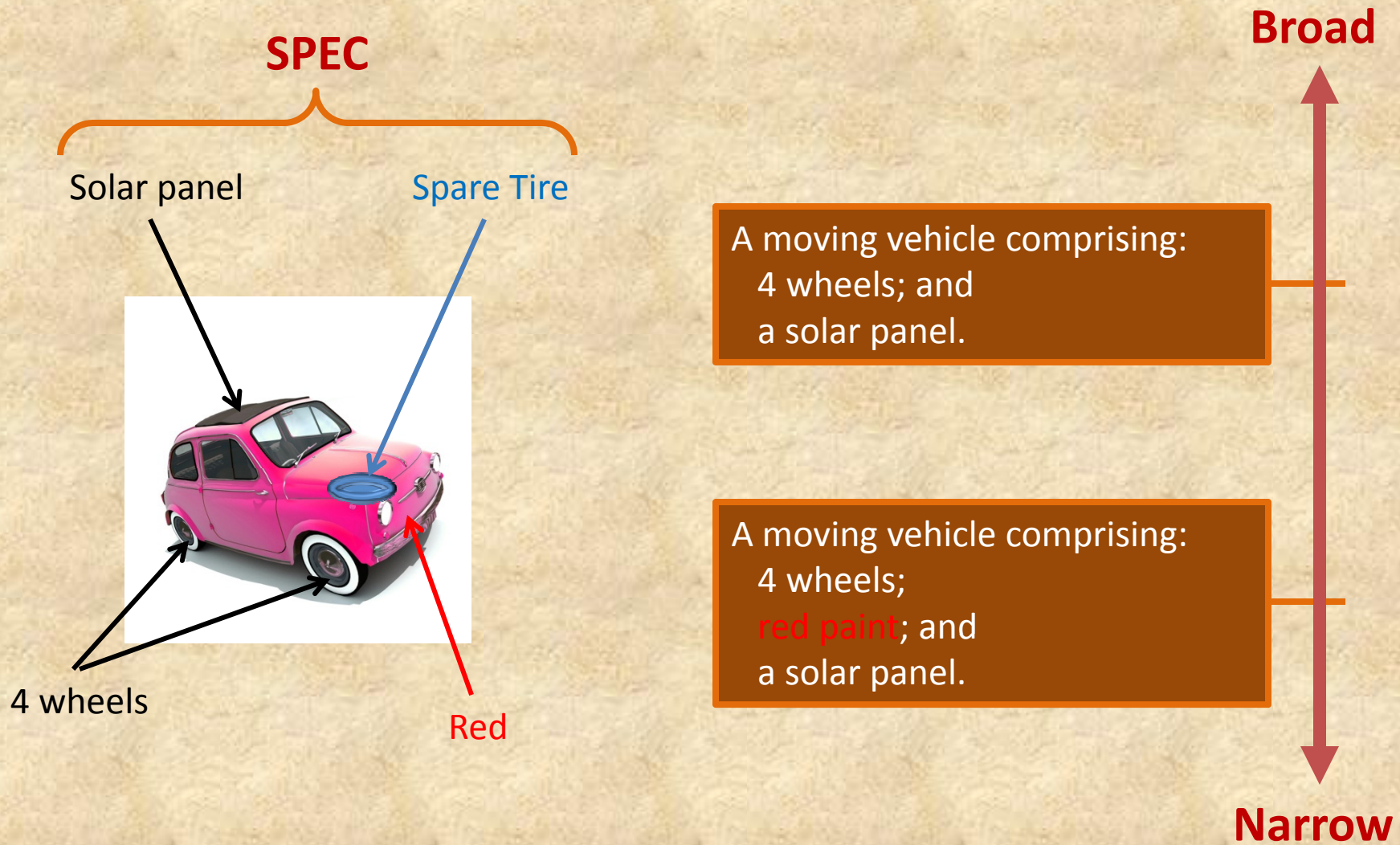
GOAL: Largest Possible Valid Claim Scope



Infringement Requires All Claim Limitations



Unnecessary Scope Limitation



Example of Infringement Analysis



A moving vehicle comprising:
4 wheels.

Met

Met

Met

A moving vehicle comprising:
4 wheels; and
a spare tire.

No

Met

Met

A moving vehicle comprising:
4 wheels;
a spare tire; and
a solar panel.

No

No

Met

Patent Strategy

- Startups (critical)
 - Compete with large companies
 - Increase value for investors and potential buyers
- Large Companies
 - Defensive patents & Cross Licensing
 - Licensing revenue
 - Competitive edge in the market
 - Spin-off

Patent Strategy

- Design an IP portfolio
 - Identify the holes in IP coverage
 - Fill up the holes: file patent applications
- Identify infringers or potential licensees
 - Injunction → market share
 - Licensing revenue
 - low overhead
 - long-term income
 - Increase value in stock market

Patent Strategy

- University Tech Transfer
 - Source of revenue for University & research
 - ROI based on shares in startup licensees
 - Encourage research → business opportunities

Patent Strategy

- Patent Pooling
- Limited Licensing
 - Time
 - Location
 - Scope
 - Application
- Exclusive License
- Sale with License back to itself
- Sale of IP that is no longer needed for cash
 - Auction / private sale

Thank You!