



Patent Resources Group

Management of Intellectual Property – The Use of IP in Business

Course Syllabus

- I. INTRODUCTION TO INTELLECTUAL PROPERTY STRATEGIES**
- II. SUBJECT MATTER FALLING WITHIN THE INTELLECTUAL PROPERTY RUBRIC**
- III. DEFINING “INTELLECTUAL PROPERTY”**
 - A. Specific Intellectual Property Vehicles
 - 1. Patents
 - 2. Trademarks, Service Marks and Unfair Competition
 - 3. Copyrights
 - 4. Trade Secrets
 - B. Selecting the Form of Intellectual Property Protection to Use
- IV. THE GENERATION OF ENFORCEABLE INTELLECTUAL PROPERTY ASSETS**
 - A. Objectives of IP Management
 - B. Strategic Development of Intellectual Property as Part of the Business Model
 - C. The Efficient Disgorgement of Patentable and Otherwise Protectable Intellectual Property
 - D. Criteria in Determining What Should Be Submitted for Patent Protection
 - E. Analyzing the Patentability Search
 - F. Business Factors Considered in Determining Whether to Obtain Patent Protection
 - 1. Importance of the Technology
 - 2. Competitive Advantage
 - 3. Enforceability
 - 4. Commercial Value
 - 5. Licensing Value
 - 6. Foreign Markets
 - 7. Defensive Patenting
 - 8. Timing of Public Disclosure of the Invention
 - G. Determining an Appropriate Licensee to Exploit the Invention
 - H. Drafting Strategic Patent Claims
 - I. Determining Where to Obtain Patents
 - J. Determining Other Industries Which May Benefit From a License Under Your Intellectual Property



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- K. Ensuring Your Product Does Not Violate the Patent Rights of Others
- L. Policing the Market for Potential Infringements of Your Patents
- M. The Enforcement of Process Patent Claims Against an Importer of a Product Made Abroad
- N. Trimming the Intellectual Property Tree
- O. Essay on Innovation Management
- V. OWNERSHIP, LICENSING AND TRANSFER OF PATENT RIGHTS**
 - A. Inventorship, Ownership and Assignment of Patent Rights
 - B. The Patent Right as an Asset
 - C. Initial Ownership of the Patent Rights
 - D. Shop Rights
 - E. Patent Licensing
 - 1. Difference Between a Patent Assignment and a License
 - 2. When to Think “License”
 - 3. Developing a Relationship with a Licensee
 - 4. The Selection of an Appropriate Licensee
 - 5. Primary License Negotiation and Agreement Considerations
 - a. Exclusivity or Non-Exclusivity in the Covered Territory
 - b. Advance Against Royalties at Signing
 - c. Royalty Rates as Quid Pro Quo for the Grant of the License
 - d. To What Is a Royalty Rate Applied?
 - e. Minimum Royalty Payments
 - f. Sales Goals or Minimum Production Goals
 - g. Territorial Extent of the License
 - 6. Additional License Considerations
 - a. The Time and Form of Payment
 - b. Enforcement of the Patent Against Infringers
 - c. Defense of the Licensed Product Against a Charge of Infringement of a Third Party Patent
 - d. Term of the License
 - e. Indemnification



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7. Acts Causing Termination of the License
 - a. Breach of Contract
 - b. Insolvency
8. Confidentiality
9. Grant Back Clauses
10. General License Comments

VI. SUGGESTED ACTIVITY LEVELS TO ACHIEVE PROFITABLE IP LICENSING GOALS

- A. An Overview of a Management System for Intellectual Property
- B. The Defensive Level
 1. Level One Goals
 2. Recommendations on Defending Intellectual Property Assets
 - a. Determine the Intellectual Property You Own
 - b. Obtain Intellectual Property While Ensuring Design Freedom Among Your Employees
 - c. Avoid Infringing the Intellectual Property Rights of Others
 - d. If You Obtained Patents, You Must Be Willing to Enforce Them
 - e. Summary of the Defensive Nature of Patents
- C. Cost Control Level
 1. The Importance of Integrating the Intellectual Property Portfolio to the Business of the Company
 2. The Establishment and Operation of an Intellectual Property Committee
 3. A Screening Process to Determine Which Patents Should Be Kept and Which Should Be Abandoned
 4. Guidelines to Follow for Filing Patents and Maintaining Patents
 - a. Establishing Country Filing Guidelines
 - b. Minimizing the Patent Agent Universe
 - c. Decisions Regarding Renewals
 - d. Pruning the Patent Tree – Abandoning Those Patents That Are Not Worth Maintaining



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- D. Your Patent Portfolio as a Profit Center
 - 1. Management Acceptance
 - 2. Establishing an Active Licensing Organization
 - 3. Royalty Audits and Intellectual Property Donations
 - 4. Extracting Value From Your Intellectual Property Through a Proper Organization
 - 5. Advanced Screening Criteria