



Creating, Managing, and Exploiting a Corporate IP Portfolio

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Major Forms of Intellectual Property

- Copyrights
- Trade Secrets
- Trademarks
- Patents



Creation and Protection of IP

- **Copyright:** some protection just upon creation of a copyrightable work; notice; registration
- **Trade Secret:** can arise with no involvement of the legal department; must be kept secret in order to be protected
- **Trademark:** common law TM rights; state registration; federal registration
- **Patent:** exclusively federal law; prosecution required for meaningful rights

Scope of Protection

- **Copyright:** expression of an idea; defense of independent creation
- **Trade Secret:** protection lost if not kept secret
- **Trademark:** identify source of products or services; protect the public from confusion
- **Patent:** protection of the idea itself; no defense of independent creation

Mechanisms to Manage IP

General

- File Patent, Trademark, Copyright, and Mask Work applications
- Employment Agreements
- Non Disclosure Agreements

Trade Secrets

- Marking

Mechanisms to Manage IP

Copyright

- Affixing notices

Patents

- Laboratory notebooks
- Invention disclosures
- Patent committees
- Incentive award programs

Laboratory Notebooks

- Document dates of conception and reduction to practice; show diligence
- U.S. is a first-to-invent country
- “Patent reform” legislation may convert U.S. to “first-to-file”
- Bound; signed and dated; witnessed
- Important in all fields of technology



Invention Disclosures

- Written description of invention
- Names and addresses of inventors
- Whether government contract funds used
- Dates of conception, first build, first test
- Publications or other public divulgations
- Sales or offers for sale



Patent Committees

- Decide what to patent, what to keep as trade secret
- Combination of economic importance and ability to get broad legal protection
- Defensive economic reason -- enable company to practice what it has invented; limited prior user right in U.S. law
- Offensive economic reason -- can assert patents against competitors; patent what they are likely to do
- Maintain budgetary discipline
- Composition -- CTO, Patent Counsel



Incentive Award Programs

- Cash and/or stock
- Submission of invention disclosure; filing of patent application; issuance of patent; use of invention



- Plaques; dinners; write-ups



Monetizing an IP Portfolio

- Satisfy investors that their investments are protected -- angel, VC, IPO
- Sold or licensed, cross-licensed
- Standalone (except in trademarks) or as part of a business

Defending Against Patent Assertions

- Doctrine of Willful Infringement
- Opinions of Counsel
 - the In Re Seagate Rule
- Declaratory Judgment Actions
 - the MedImmune decision



Impact of the new November 1, 2007 Patent Rules

- Check for 5/25 (independent/total claims) now
- Can file unlimited continuations prior to November 1, 2007
- File Overlap Statements between November 1, 2007 and January 31, 2008

Thank you for coming!

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