



11.5.2011

## **Managing Intellectual Property Rights :**

How to maximize IP and minimize costs

## Missing the boat on IP protection:

### Public Disclosure Triggers One Year Clock in US:



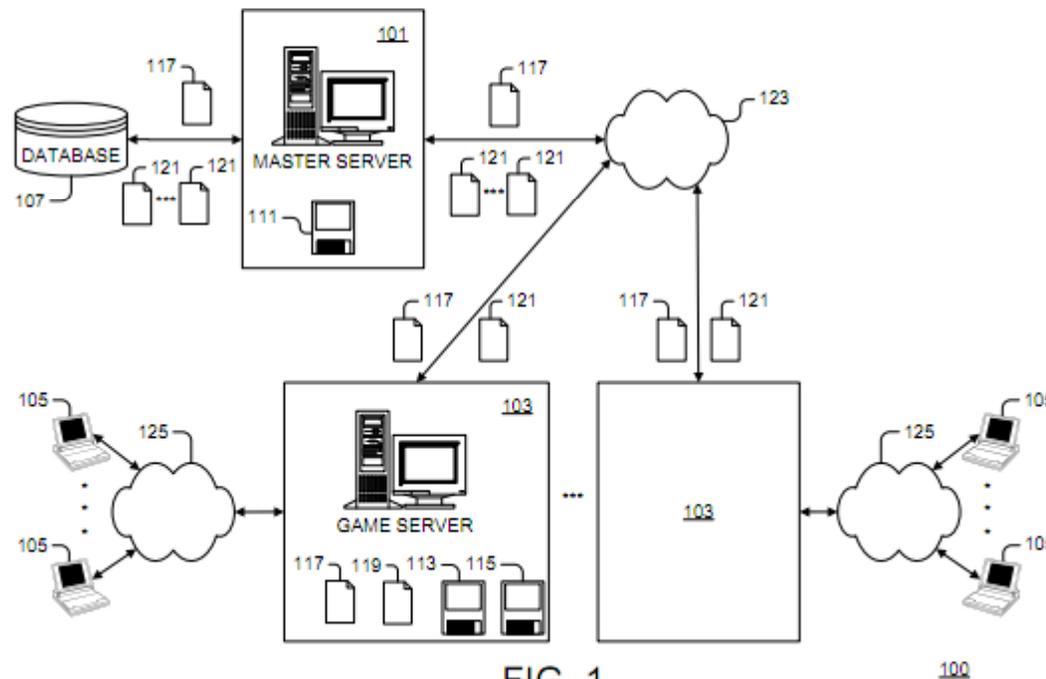
- Trade shows
- Public demonstrations
- Publication of white papers



- Absolute Novelty

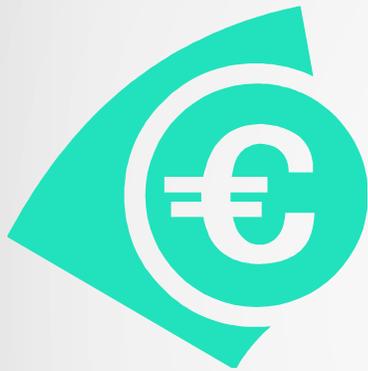
## Missing the boat on IP protection:

### “Online Gaming Cheating Prevention System and Method,” USP 7,169,050



## Missing the boat on IP protection:

### In the rush to capitalize on innovation:



- Not considering global IP protection
- Failing to solve the IP protection puzzle



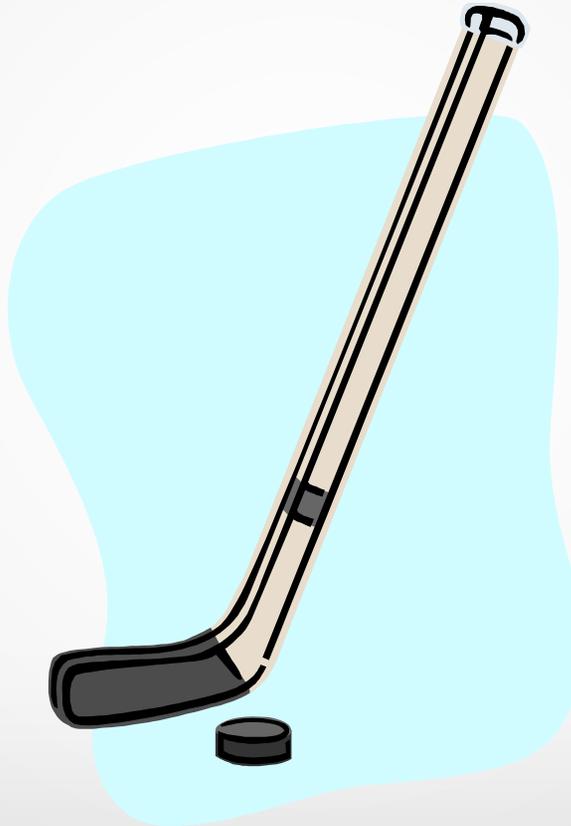
## Letting your patent sink with the Inventorship:

- Claiming proper Inventorship is important:
  - The CEO is not always the inventor
  - The thesis advisor is not always the inventor
  - Improper Inventorship can lead to patent invalidity



## Letting your patent sink with the Inventorship:

- Example:



## Avoiding the joint venture nightmare scenario:

A clear joint venture agreement with IP rights must be in place:

- Relationships can go bad
- Who gets what IP?
  - In “work for hire” situation, contractor may want generic code and modules
  - Employer may want all project specific IP, code and modules
  - Common problem in video game development



## Maximizing IP:

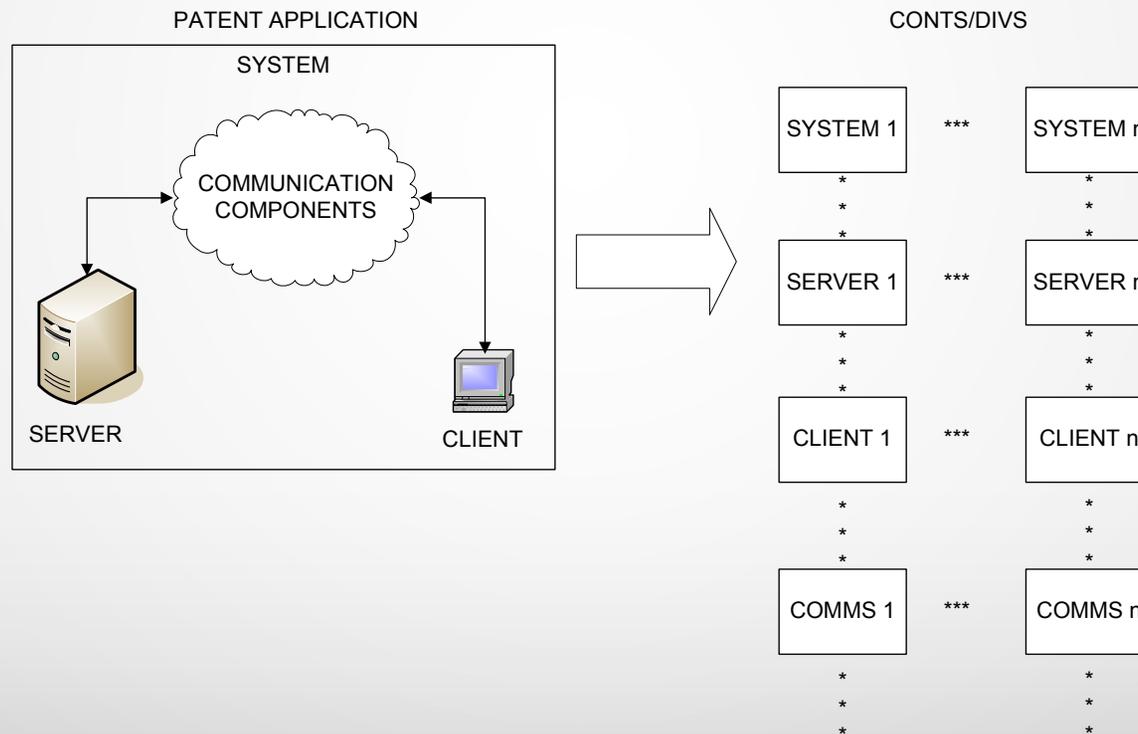
### Do your due diligence:

- Return on Investment (ROI)
- Invention disclosure procedures:
  - Profit sharing with inventors
- Provisional filings before third party disclosures:
  - When solving customer's problems
  - Prior to publishing white papers and giving conferences
- Consider world wide IP protection for important technologies
- Develop a licensing model



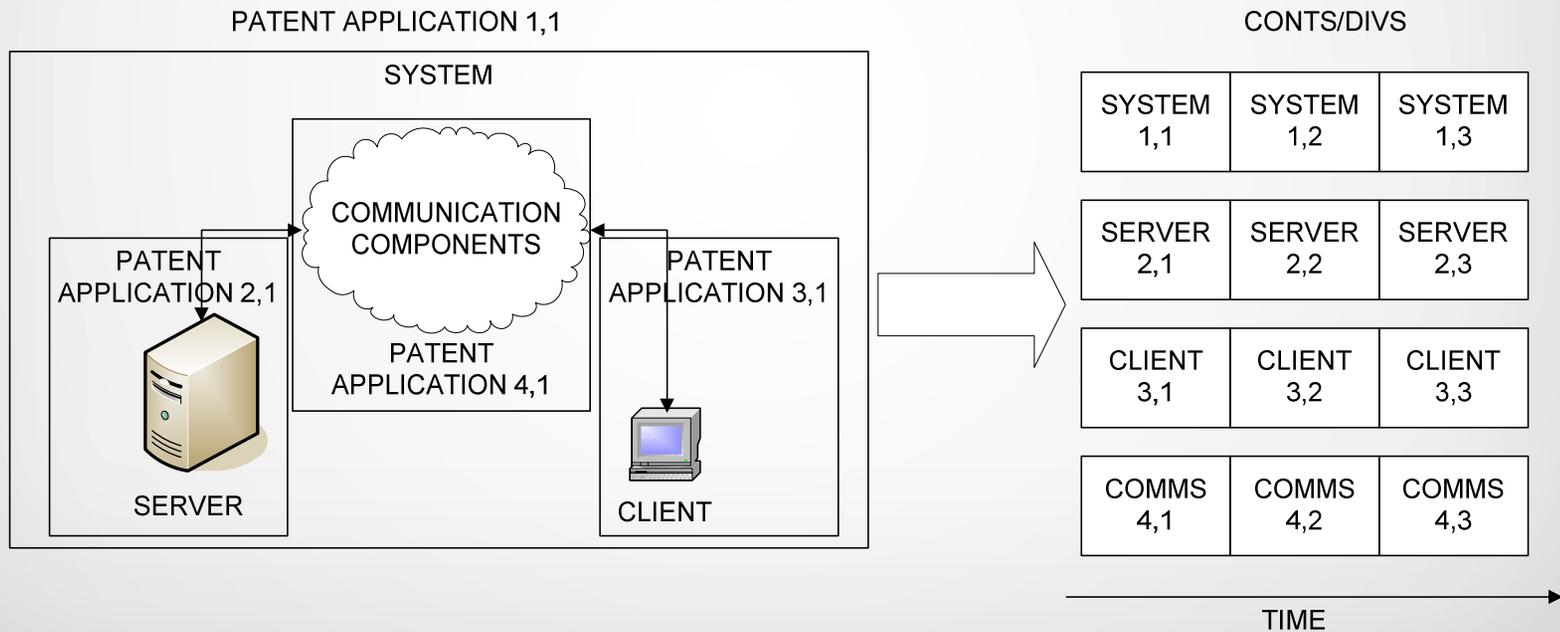
# Maximizing IP:

## Traditional approach:



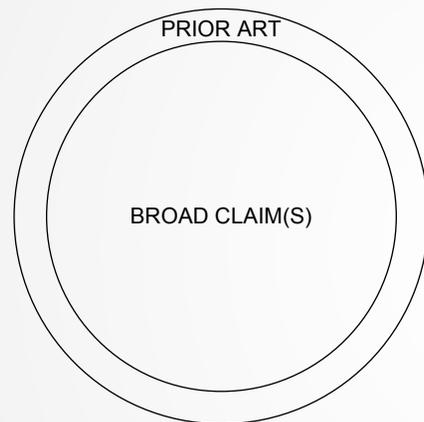
# Maximizing IP:

## Maximizing approach:

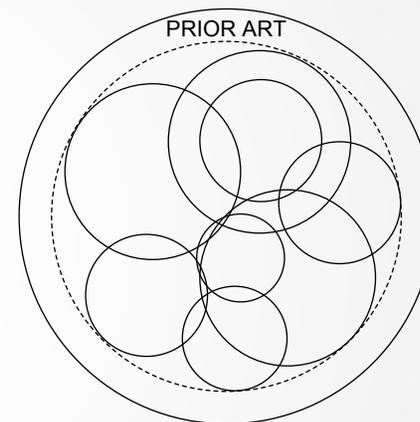


# Maximizing IP:

- Picket fence approach to IP protection:



- Pros:
  - Captures more infringers
  - Reduces costs
  - Favors high tech
- Cons:
  - Easier to invalidate
  - Harder to prosecute
  - Disfavors low tech



- Pros:
  - Harder to invalidate
  - Easier to prosecute
  - Favors low tech
- Cons:
  - Easier to design around
  - Increases costs
  - Disfavors high tech

## Minimizing IP Costs:

- Prepare patent-like disclosures:
  - Use patent application and drawing templates
  - Use published patent applications as samples
  - Patent attorney feedback for learning process
  - Develop an in-house patent preparation capability
  - Patent attorney only for “value add” tasks, like claim drafting, word smithing, legal and technical analysis, etc.
  - This strategy depends on whether or not you have “more time than money or more money than time”



## US developments & technological implications



- KSR
- Bilski
- America Invents Act
  - Prior art dates
  - Narrow grace period
  - First to File
  - No prior use rights
  - Non-Obvious subject matter

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Thank you!