

Protecting Economic Drivers Because All Roads Lead To The U.S.

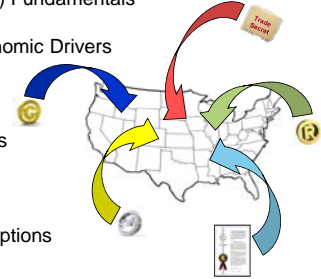
November 3, 2010
 PAMA Retreat
 San Francisco, California

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Overview

- ▶ Economic Drivers
- ▶ Intellectual Property (IP) Fundamentals
- ▶ IP = Protection for Economic Drivers
- ▶ Leveraging IP
- ▶ IP Strategies and Issues
- ▶ Foreign Operations
- ▶ U.S. Litigation Forum Options



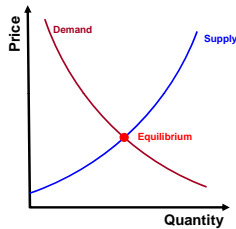
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1

Economic Drivers

- ▶ Efficient manufacturing processes
- ▶ Innovative products
- ▶ Consistent product quality



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2

IP Fundamentals

- ▶ Patent ("what")
 - ▶ Utility
 - ▶ Design
- ▶ Trade secret ("what")
- ▶ Trademark ("who")
- ▶ Copyright ("how")



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3

IP = Protection for Economic Drivers

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4

Leveraging IP

- ▶ Use (trademarks are unique)
- ▶ License
- ▶ Cross-license **IP ↔ IP**
- ▶ Sell **\$ ↔ IP**
- ▶ Enforce




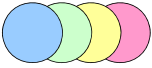


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5

IP Strategies and Issues

- ▶ Inventory IP assets 
- ▶ ROI 
- ▶ Implement policies and procedures 
- ▶ Overlapping IP 






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IP Strategies and Issues

- ▶ Patents
 - ▶ Core technology
 - ▶ "Statutory bar" 
- ▶ Trade Secrets
 - ▶ Reasonable measures 
- ▶ Document/IT management 
- ▶ HR's IP awareness 





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IP Strategies and Issues: Patent or Trade Secret?

- ▶ Patentable or not 
- ▶ Pioneer or improved technology 
- ▶ Utilized or next best alternative 
- ▶ Pace of technological advances 
- ▶ Reverse engineering or independent development 

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Foreign Operations

- ▶ Foreign licensee, partner or subsidiary
 - ▶ IP transfer
 - ▶ Use written agreements 
 - ▶ IP ownership
 - ▶ IP licenses
 - ▶ U.S. management/employee "nexus" 
 - ▶ For trade secrets: "U.S." reasonable efforts
 - ▶ Inherent risks
 - ▶ Express risks
 - ▶ technology transfer  market access 


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Foreign Operations

- ▶ What if there is an "unauthorized technology transfer"? 
- ▶ Protect U.S. operations from unfair competition
 - ▶ District court litigation 
 - ▶ State court litigation
 - ▶ International Trade Commission (ITC) litigation
- ▶ Consider foreign litigation

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U.S. Litigation Forum Options

- ▶ Courts
 - ▶ Trade secret or trademark case: federal or state court
 - ▶ Patent or copyright case: federal court
- ▶ ITC
 - ▶ IP and other unfair competition cases
 - ▶ Can prevent illegal imports
 - ▶ No damages
 - ▶ Rapid pace
 - ▶ Major differences between trade secret and patent cases:
 - ▶ Domestic Industry
 - ▶ Injury
- ▶ ADR (e.g., arbitration, mediation) 

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Thank you. . . any questions?

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