

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

November 3, 2010

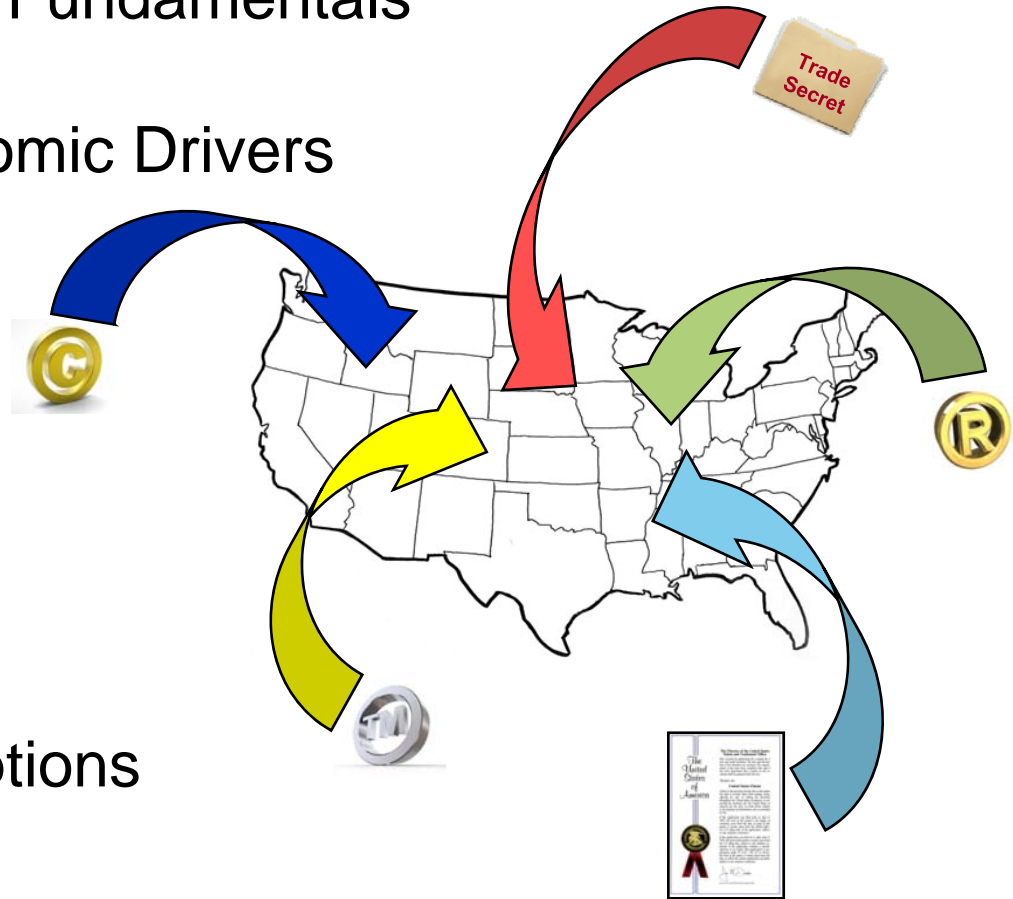
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San Francisco, California

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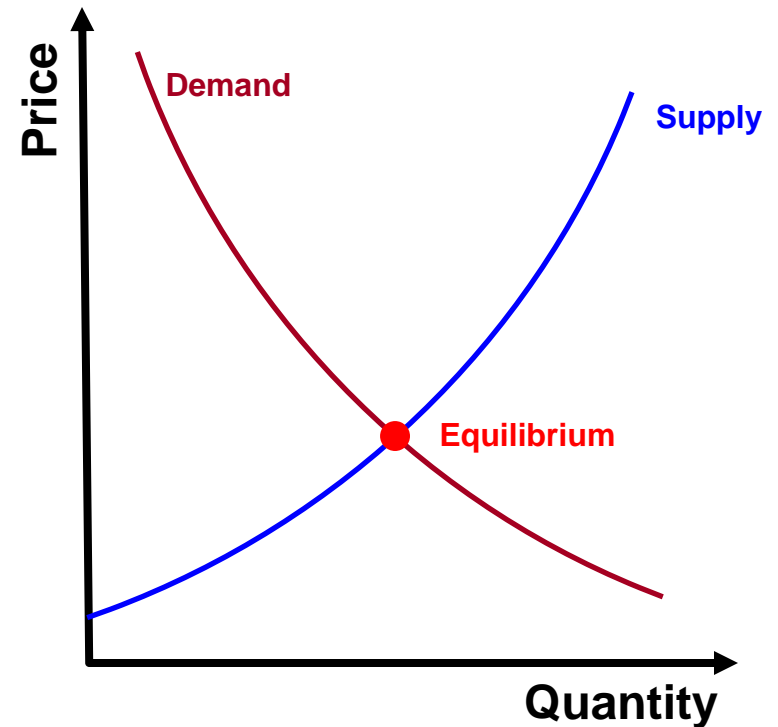
Overview

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



Economic Drivers

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



IP Fundamentals

▶ Patent (“what”)

▶ Utility

▶ Design



▶ Trade secret (“what”)



▶ Trademark (“who”)



▶ Copyright (“how”)



IP = Protection for Economic Drivers

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



Leveraging IP

- ▶ Use (trademarks are unique)



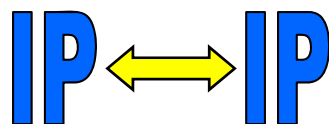
- ▶ License

Consent to the professional having been obtained, the right to include others from making, using, offering for sale, or selling the invention throughout the United States of America or in carrying the invention into the United States of America for the term and forth herein, subject to the payment of maintenance fees as provided by law.

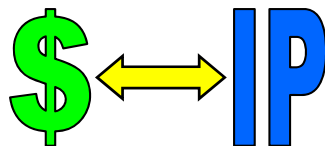
If this application was filed prior to June 1995, the term of this patent is the longer, seventeen years from the date of grant of the patent or twenty years from the earliest effective U.S. filing date of the application, subject to any statutory extensions.

If this application was filed on or after June 1995, the term of this patent is twenty years from the U.S. filing date, subject to any statutory extension. If the application contains a special reference to an earlier filed application or application under 35 U.S.C. 120, 121 or 363, the term of the patent is twenty years from the date on which the earlier application was filed, subject to any statutory extension.

- ▶ Cross-license



- ▶ Sell



- ▶ Enforce

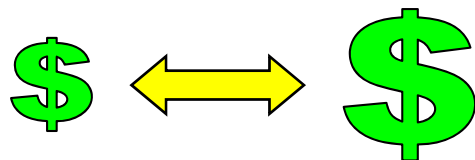


IP Strategies and Issues

- ▶ Inventory IP assets



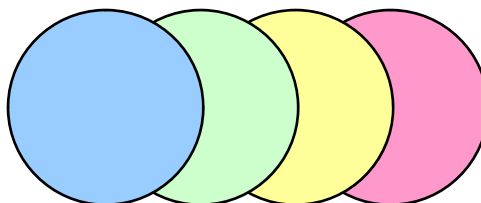
- ▶ ROI



- ▶ Implement policies and procedures



- ▶ Overlapping IP



IP Strategies and Issues

▶ Patents

- ▶ Core technology
- ▶ “Statutory bar



▶ Document/IT management



▶ Trade Secrets

- ▶ Reasonable measures



▶ HR's IP awareness

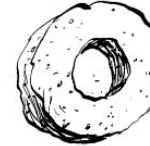


IP Strategies and Issues: Patent or Trade Secret?

- ▶ Patentable or not



- ▶ Pioneer or improved technology



- ▶ Utilized or next best alternative



- ▶ Pace of technological advances



- ▶ Reverse engineering or independent development



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



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



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)



Thank you. . . any questions?

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