



## Intellectual Property: Practical Aspects

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<http://www.sfu.ca/~mvolker/biz/ipm.htm>

### Two new patent law webinars address indemnification provisions, reissue strategy

Technology Transfer Tactics [info@technologytransfertactics.com]

Sent: Fri 10/06/2011 9:38 AM

To: mvolker@sfu.ca



Announcing two new upcoming webinars from our partner **Stafford**

**ATTENTION IP ATTORNEYS: Don't miss these two information-packed, CLE-eligible webinars on critical issues in patent law:**

#### Patent Indemnification Provisions

Tuesday, June 28, 1:00pm-2:30pm EDT

[REGISTER NOW](#)

or [learn more](#)

Indemnification provisions are a critical, but often overlooked, part of any patent agreement. Effective drafting and negotiation of indemnification provisions

#### Patent Reissue: Benefits, Limitations and Strategies

Tuesday, July 12, 1:00pm-2:30pm EDT

[REGISTER NOW](#)

[Register Now & Save \\$50: Early Registration Discount Deadline, Friday, June 17](#)

In 2010, there were more reissued patents than in any year in history. While patent holders can benefit

**ICAP Patent Brokerage June 2011 Deal Book Available Today**

ICAP Patent Brokerage [dean.becker=us.icap.com@mail284.us2.mcsv.net] on behalf of ICAP Patent Brokerage

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Available patent portfolios range from automotive technology to medical devices to advanced mobile communication techniques. Technologies for sale include:

- Advertising
- Automotive
- Bio Pharma
- Computers
- Consumer Electronics

**Supreme Court says Microsoft must pay \$290 million to Toronto's i4i in patent suit**

awerenko [awerenko@shaw.ca]

Sent: Thu 09/06/2011 7:54 AM  
To: 'Mike Volker'; 'Bob de Wit'

Guys,  
Nice payday finally for i4i .... yeh for the little guy!  
Al

**Microsoft must pay Toronto's i4i in patent suit**

10:29 EST Thursday, Jun 09, 2011

Washington — The Supreme Court says Microsoft Corp . must pay a \$290-million patent infringement judgment awarded to a small Toronto software company in a patent lawsuit.

The high court on Thursday refused to throw out the judgment against the world's largest software maker.

Toronto-based i4i sued Microsoft in 2007, saying it owned the technology behind a tool used in Microsoft Word. The technology in question gave Word 2003 and Word 2007 users an improved way to edit XML, which is computer code that tells the program how to interpret and display a document's contents.

The lower courts say Microsoft willfully infringed on the patent, and ordered the software maker to pay i4i \$290-million and stop selling versions of Word containing the infringing technology. The high court upheld that judgment.

**Exciting New Lots Available in ICAP Ocean Tomo's Spring 2011 Live IP Auction Catalog**

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**Exciting New Lots Added to Our Spring 2011 Live IP Auction Catalog**

New lots have been added to our [Spring 2011 Live IP Auction Catalog](#) including eight additional lots from QinetiQ Ltd. and four historic Covenants not to Sue from Round Rock Research LLC. These portfolios have applications in many large and growing markets such as consumer electronics, healthcare, security, and energy.

The new QinetiQ Ltd. lots will be listed in the catalog as follows:

- **Lot 102 - Infrared & Optical Systems**
- **Lot 103 - Infrared & Photovoltaic Devices**
- **Lot 104 - Semiconductor Devices**
- **Lot 105 - LED**



*A little background....*

u so who is Jerome Lemelson?  
and what does he have in common with  
Hoyle Schweitzer

u IP issues are cropping up more frequently



## *IP.... is between your ears!*

- u IP is the asset on which high tech is built
- u IP is the asset on which most firms are built
- u IP is...*knowhow*
- u IP Management is... *Profit Maximization*
- u IP must be protected, managed, nurtured
- u IP turns investors on



## *Types of IP*

- u Product or Process Innovations (Patents)
- u Expression of thought:
  - literary work
  - music/artistic work or various forms
  - recordings
  - architectural works
  - logos, trademarks, etc
- u Computer Programs
  - copyright and/or patent



## *Types of IP Protection*

- u Legal
  - u patent (Defensive vs Offensive)
  - u copyright
  - u trademarks & corporate names
  - u agreements
- u Non-Legal
  - u trade Secret
  - u disclosure?
  - u employee training & education



## *Legal IP Protection*

- u Patents
  - Jurisdictional (different rules)
  - Grants a Monopoly to the owner
  - 3 criteria: new, useful, non-obvious
- u Copyright
  - Automatic (50 years - Can & USA)
- u Trademarks
  - US & Can - registered vs unregistered?
  - Corp names, web names, etc?
- u Industrial Designs
  - May register styles, forms



## *The Patent "Game"*

- u It's not about the technology
- u It's about the legal game is played
- u Easy to get; hard to enforce
- u Prove: validity and infringement
- u \$Millions\$ at stake



## *Choice of IP Protection*

- u choice of IP protection depends on...
  - u type of technology
  - u competitive environment
  - u economic life of the technology
  - u corporate strategy & philosophy
- u some factors to consider...
  - u market potential
  - u how broad a technology
  - u investment made & to be made



## *IP Valuation depends on....*

- u strength of protection
- u stage of development
- u cost - what counts?
- u comparable rates (market)
- u profit potential
- u controlled greed



## *IP Liability Issues*

- u are you liable for....
  - copyright infringement?
  - patent violation?
- u how to avoid liability?
  - get permission
  - use until caught
- u litigation defense...
  - financial exposure?
  - legal costs?
- u Don't be paranoid



## *IP Practical Considerations*

- u to tell or not to tell?
  - ideas?
  - disclosures? (NDAs)
- u competitors or partners?
  - co-opetition?
  - who has the power?
- u plan for financial contingencies
  - e.g. IP budgeting
- u get a lawyer you can trust!



## *Links...*

- u <http://www.sfu.ca/~mvolker/biz/ipm.htm>
- u <http://www.wipo.int> (World I.P. Org)
- u <http://www.cipo.gc.ca>  
**Canadian Intellectual Property Office:**
  - Guide to Patents**
  - Guide to Trademarks**
  - Guide to Copyrights**