

IP Asset Management

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IP Audit

- IP as key business resource – enhances competitiveness and effectiveness
- Managing IP requires identifying and quantifying intellectual property of an organization

IPRs in TRIPS

1. Copyrights
2. Patents
3. Trade Marks
4. Industrial Designs
5. Lay Out Designs (Topographies) of IC
6. Protection of Undisclosed Information

Due diligence and Audit

Focus on these risk areas:

- ❖ Adequacy of IP protection for existing products/processes
- ❖ Anticipate claims of IP infringement
- ❖ Identify opportunities for strengthening IP protection

Due diligence and Audit

- Acquisition of IP rights
- Establish policies for personnel, publications and procurement of technology and other materials from and to outside agencies
- Review IPR clauses in all agreements with suitable protection clauses, choice of law for dispute resolution other appropriate safeguarding clauses
- Advise on ways for data base protection, confidentiality protection, collaboration policies
- Identify all contracts, licenses, collaboration agreements and other legal arrangements that may effect or distribute its own IP and/or third party IP

IP Spotting & Invention Mining

- ✓ ‘Scoping Report’ – understanding the requirements and mapping the issues relevant for the audit
- ✓ Based on an initial ‘scoping’ report – a comprehensive audit report is made exploring new and hidden information.
- ✓ Guidelines for IP management to ensure optimum and appropriate use, access and protection of existing and future IP

Why do you need to do an IP Audit

Because

- Most products and services are today protected by duplication of IP areas
- IP Rights are territorial so due diligence must be international in scope

Key Areas of Review

- Understanding of all significant areas of IP including
 - i. Licensing
 - ii. Assignment
 - iii. Enforcement
 - iv. Valuation
 - v. Security encumbrances
 - vi. Other agreements – research and development agreements, partnerships joint ventures, government grants, non-complete and non-solicitation agreements
- in respect of major IP like patents, trademarks, copyrights and trade marks

Patents

- Do you have an Invention Mining Mechanism in Place
 - Questionnaire
 - Invention Disclosure Statements
 - Lab Books
 - Prior Art Searches
 - Competitive Analysis Searches
 - Inventory of material proprietary products or process
 - Checking the extent and time validity of protection and – whether term could be extended by innovative means.
 - Document Retention - Filing date, issue date, status, country of issuance, claims coverage,
 - References including assignments from inventors, patent office communications, maintenance fee records and provide for file wrappers

Undisclosed Information

- Non-public business information which derives economic value by remaining confidential
 - Technology and manufacturing know-how
 - Formulas
 - Software code and pending patent application

Undisclosed Information

- ➔ Inventions which are not subject to patent but may be the subject of a future application
- ➔ All software developed by or for the entity
- ➔ All other material business information
- ➔ Documents relating to hiring and exit in view of sensitive technology
- ➔ Confidential disclosure

Securing IPRs

Patents for Computer Program Products	Patents for Software Per Se	Business Method Patents
Copyrights for computer programs	Protecting Undisclosed Information	Trade Mark for Products/Services
Patents for software coupled to hardware	Combination IPRs	Copyright for User Interfaces

IP Audit therefore enables you.....

- ❁ to understand, evaluate and place a meaningful value on your IP assets
- ❁ to understand that the value of IP depends on their level of protection under different areas and various regimes
- ❁ To understand that with the recent changes in IP legislation in India and in view of globalization, it is correct time for introspection and gearing up for the challenges ahead