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**We will start momentarily at 2pm ET**



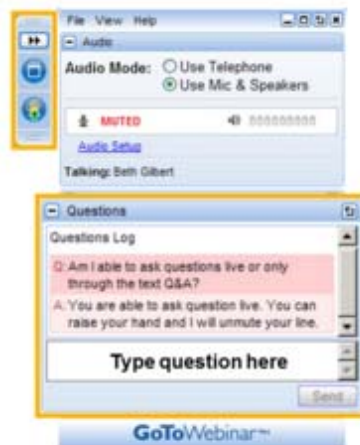
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## *Global Patent Protection and International Business Strategies*



Presenter: Michael Brodowski, Ph.D., Attorney at Law  
K&L Gates LLP



Moderator: Andrew Gilicinski, Ph.D.  
The Clorox Company

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# Global Patent Protection and International Business Strategies

Michael H. Brodowski, Ph.D.  
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September 30, 2010

[www.klgates.com](http://www.klgates.com)

## Intellectual Property and Business

- Intellectual property (IP) is a valuable business asset that can provide a competitive advantage and increase the value of a company
- Need to understand the business objectives to protect properly the IP
  - Nexus between the patent rights and commercial applications, not merely technology
- If envision international markets, should consider international IP protection
  - One year from filing first application in patent family

## Global Patent Protection

- World domination not practical nor necessary
  - Create sufficient barrier for entry into marketplace
  - Pursue protection in major markets of commerce
    - Where product/services will be sold
    - Where competitors are located or manufacture
    - United States, Europe, and Japan are most common
    - China, India, and Russia considered growth markets
- Technologies not all of equal commercial value
  - Cost-benefit or return on investment analysis
  - Different “tiers” or ranking of patent applications
    - International strategy for filing applications

## Global Patent Protection (cont'd)

- Considerations among different jurisdictions
  - Different scope of protection available
    - Availability of prior art used to judge patentability
    - Examination is subjective
  - Different timing of actions
    - Requesting examination
    - Challenging patent rights
- Changing legal landscape and its impact on patent position
- International collaborations and inventions
  - Foreign filing licenses

## Coordinated Patent-Related Efforts

- To manage most efficiently and cost effectively a growing patent portfolio, need mechanisms to coordinate efforts
  - Regular review and evaluation of patent portfolio
    - Patent portfolio status charts
  - Patent/IP Committee
    - Include outside patent/IP counsel and management from sales, marketing, manufacturing, research and development, and legal
    - Can manage overall portfolio and keep aligned with business plan of company
    - Keep apprised of competitive activities and IP rights
  - Gatekeeper for public disclosures to ensure not jeopardizing patent rights

## Ownership of Patent Rights

- Do not undervalue ownership
  - Employee agreements
    - Present assignment of IP/patent rights to company
  - Explicit assignment of patent rights to the company by each inventor of each application
    - Recordable, clean chain of title from named inventors
    - Non-employees, e.g., consultants and service providers
    - Obtain assignment early in process
- Licenses and other agreements

## Clearance of Patent Rights of Others

- Conduct patent clearance (freedom-to-operate) study to determine whether others' patent rights may impact business plan
  - A patent landscape study can identify potentially problematic patent(s)
    - Published patent applications can provide guidance
  - Question arises during due diligence for financing
  - Scope of rights may vary by country
  - Patent opinion regarding infringement and/or invalidity as defense to willful infringement

## Monitoring Patent Activity of Competitors

- Monitor patent grants, published U.S. and PCT applications, and press releases
  - Permits early notice of competitive activity
  - Can consider and react knowledgeably in procuring patents and development of products
  - Can challenge patent rights that may be problematic
- Knowledge is power

## Thank you for your time

- Questions and Answers
- If not now, please contact me at:

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# Q&A SESSION



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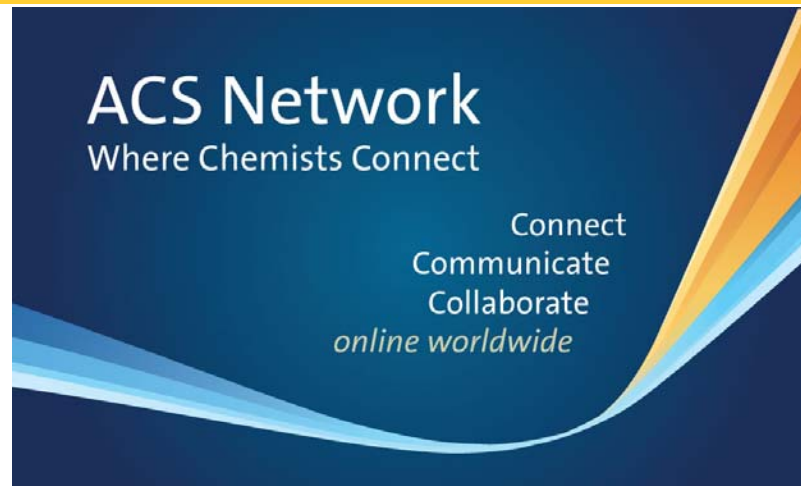
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- **Careers in Intellectual Property for Chemists**
- Robert J. Koch, Attorney at Law, Milbank LLP.



- Thursday, October 14, 2010, 2-3 p.m. EDT
- **Navigating U.S. Immigration – Updates for International Scientists**
- Kelly McCown, Attorney at Law, McCown and Evans.

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