Fall 2015


Potential Students: Graduate level students in Business Administration, Law, Engineering and Liberal Arts Science

Time: September 10, October 8, October 29, December 3, 6:30 PM – 8:30 PM, Room 206

Instructor: Robert Patino, J.D.
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Office Hours: By appointment

Text: We will be following several parts of Transactional Intellectual Property: From Startups to Public Companies by Gruner et al. All other course materials will be provided in pdf or made available online.

Course Delivery Methods: Course instructions and materials will be delivered online. Once every three to four weeks, a 2 hour instructional class will be conducted on Thursday evenings. Course deliverables/projects will be due before each class. A quiz during the second class and a final Exam will be included to examine your comprehension of the readings, presentations, interviews and workshops.

Course Description: Course (1) teaches substance & practice of commercializing products of scientific & technical research (2) provides a basic understanding of intellectual property laws in the commercialization context & how those laws are applied in various fields of technology. Students will learn how to value intangible assets, taking into account their commercial potential & legal status. The course will explore the legal & business issues surrounding marketing of new products that embody technology. Students will prepare & negotiate license agreements. Students will analyze legal & business issues surrounding whether & how to enforce intellectual property rights. Content & methods of course delivery & evaluation has been approved for provision by distance education.

Course Outcomes and Objectives:

Outcome 1: Students will be able to review an intellectual property portfolio and comprehend the extent of their protection.
- Objective A: Students will explain and comprehend the difference between a trademark, patent, copyright and trade secret.
- Objective B: Students will demonstrate their ability to know when to use trademarks, patents, copyrights and trade secrets for a given idea.
- Objective C: Students will explain the scope of protection for a given intellectual property portfolio.

Outcome 2: Students will be able to develop a business plan that advances the value of their intellectual property portfolio.

- Objective A: Students will demonstrate an understanding of the present state of their technology and comprehend “next steps” to advance its value.
- Objective B: Students will navigate set-backs such as disclosure mishaps or development complication scenarios.
- Objective C: Students will understand when to abandon their idea and when and how to seek additional funds to “ramp up” development or production.
- Objective D: Students will understand different valuation models that exist with intellectual property valuation.

Outcome 3: Students will be able to develop a strategy of marketing their intellectual property portfolio and understand some negotiation basics.

- Objective A: Students will comprehend a multitude of marketing strategies and match one that best fits their business model.
- Objective B: Students will understand the difference between assigning their interest, exclusive and non-exclusive licenses, and retaining important rights.
- Objective C: Students will draft a term sheet reflecting their business interests and their intellectual property value.
- Objective D: Students will present their term sheet and negotiate with the instructor.

Outcome 4: Students will be able to understand some of the limits of their intellectual property rights and comprehend some basic legal pitfalls.

- Objective A: Students will comprehend the risks of 3rd party challenges to their intellectual property rights such as patent claim exhaustion and claim invalidation.
- Objective B: Students will understand the risks when 3rd parties challenge their product development with their own intellectual property assets.
- Objective C: Students will demonstrate an understanding of some basic issues associated with commercializing university owned technologies.

Course Outline

Week 2: Introduction of Sample Business Considerations and Hypothetical Start Up: (1) Read pgs. 1 – 14, (2) Review Hypotheticals and select one hypothetical that interests you. Find the associated published issued patent(s) and/or patent application(s) and have them printed and ready for 1st in-class discussion [due Sept. 4], (3) Module 2 PowerPoint – Scope of Protection.

Week 3: Capturing Value Through IP: (1) Read pgs. 15 – 36, (2) Do Quiz #1 Answer Questions in Quiz #1 by Sept 10 at 10:00 PM, (3) Do Group Project #1 Business Plan (Due in 4 weeks at the beginning of next class).

[Patent Print Outs are due at the beginning of class on September 10. Bring an extra set for yourself.]


Week 5: Patent Claims – Construction and Scope: (1) Module 5 PowerPoint, (2) Read online assignment, (3) Do Writing Assignment #1 due at the beginning of the next class.

Week 6: Creating an Entity for IP Commercialization: (1) Read pgs. 73 – 97& Read pgs. 106 – 112, (2) Watch Singleton video, (3) Module 6 PowerPoint – Funding Sources.

Week 7: Approaching Companies and Investors: (1) Read Just a Simple CDA? By Jeffrey L. Newton, Les Nouvelles, (2) pgs. 655 – 688, (3) Module 8 PowerPoint – Approaching Companies and Investors, (4) Do Group Project #2 Term Sheets Due October 19, Negotiation is October 29.

[Writing Assignment #1 and Business Plan is due at the beginning of class on October 8]


Week 10: Ownership Issues related to IP: (1) Read pgs. 241 - 273 (2) See GSK video.

[License Negotiations will be performed on October 29]

Week 11: Due Diligence: (1) Read pgs. 623 – 655, (2) Read Good Patent Due Diligence By Miller et al, Les Nouvelles, (3) Do Project #3 Due December 3.


Week 14: Managing an IP Portfolio and the Notice Requirement: (1) Read pgs. 748 – 753, (2) Read Properly Marking Your IP and (3) Recent U.S. Court Decisions and Developments Affecting Licensing Paul et al., Les Nouvelles (Read only the sections with Headings: Already, LLC v. Nike; Kirtsaeng v. John Wiley & sons, Inc.; Tech. Licensing Corp. v. JVC Americas Corp).

[Project #3 Due on December 3 and Final Class]

Week 15: Acquiring and Using Government/University IP: (1) Read pgs. 893 – 913, (2) Moving Research to Patient Applications through Commercialization: Understanding and Evaluating the Role of Intellectual Property, Robert Patino. – This is optional reading material but may be required if you miss a class and want to make up the lost points -

Final Exam will be a Take Home Exam

Grading:

45% from class projects; 10% from class attendance; 15% from quiz/assignment; 30% from class final. If you have to miss a class, you will be given 1 opportunity to do a research project to make up for the attendance and quiz for the one class you might miss. Please see me in advance of missing this class to schedule this.

Emergency Procedures. Southern Illinois University Carbondale is committed to providing a safe and healthy environment for study and work. Because some health and safety circumstances are beyond our control, we ask that you become familiar with the SIUC Emergency Response Plan and Building Emergency Response Team (BERT)
program. Emergency response information is available on posters in buildings on campus, available on BERT’s website at www.bert.siu.edu, Department of Safety’s website www.dps.siu.edu (disaster drop down) and in Emergency Response Guideline pamphlet. Know how to respond to each type of emergency.

Instructors will provide guidance and direction to students in the classroom in the event of an emergency affecting your location. It is important that you follow these instructions and stay with your instructor during an evacuation or sheltering emergency. The Building Emergency Response Team will provide assistance to your instructor in evacuating the building or sheltering within the facility.

Recording Policy: All live classes will be recorded. Access to those classes may be provided by asking the instructor for permission. Tom Furby will then provide access to the recording on a limited basis.