

Intellectual Property Management for Innovation Companies & Entrepreneurs

2011 Series - Course Information



UNIVERSITY of HAWAII®
KAPĪ'OLANI
COMMUNITY COLLEGE

This [10-week course on Intellectual Property Management](#) is specifically designed for innovation companies and entrepreneurs to help you gain practical and in-depth knowledge on:

- protecting your intellectual property (IP) assets
- establishing internal practices to best manage your IP
- optimizing your IP strategies in the U.S. and globally

This series covers the main areas of IP protection such as patents, trademarks, copyrights, trade secrets and company information. It will also focus on IP requirements for businesses in technology, innovation products, strong product brands, media, music and software, and IP monetization. All course materials will be provided as handouts and/or by visual presentations during each class.

This series is offered through Kapiolani Community College's Continuing Education Department and is brought to you in partnership with the Intellectual Property and Technology Law (IPTL) Section, an unincorporated membership association of attorneys and other members of the legal community operating under the auspices of the Hawaii State Bar Association (HSBA). The parent organization, HSBA, is not a sponsor of this course.

This course may qualify for Continuing Legal Education (CLE) credits in Hawaii and California. The IPTL will provide an update when state CLE certification is approved.

COURSE OUTLINE

DATE	INSTRUCTOR	TOPIC
9/15/2011	Martin Hsia, Attorney	<u>Intellectual Property (IP) Management Overview:</u> <ul style="list-style-type: none">• How IP protections protect major business assets and enterprise value• Technology, product designs, brands, copyrighted works, business information• Importance of establishing internal company management of IP• How strong IP management adds to and protects enterprise value• Real-life examples: what to do, what not to do
9/22/2011	Leighton Chong, Attorney	<u>Patenting Technology & Innovation Products:</u> <ul style="list-style-type: none">• What can be patented?• Defining what is "new" and "non-obvious" from what is "old"• Process for filing for patent: prior art search, completing research and development (R&D), documentation• Types of patents: provisional vs. formal; utility; design; plant patent• Patent prosecution: examination before the U.S. Patent Office over prior art• Company patent management: R&D reporting; documenting inventions; clearing right-to-use

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9/29/2011	Seth Reiss, Attorney	<u>Trademarking Product Designators & Consumer Brands:</u> <ul style="list-style-type: none"> • What kind of protection does a trademark offer? • When is a new trademark “distinct” from prior trademarks? • How does a trademark acquire value? • How do you secure and register a trademark? • How are trademark rights enforced? • Company trademark management: clearance, filing, use, maintenance
10/6/2011	Stephen Street, Attorney	<u>Copyrights: What Creators & Users Need to Know:</u> <ul style="list-style-type: none"> • What can be protected by copyright? • “Original” work versus “pre-existing” or “unprotectible” matter? • How are copyright rights enforced? • What is “fair use”? How much can you use without infringing another’s work? • Perils of loss of rights to independent contractors; work-for-hire agreements • Company copyright management: clearance, title, registration, notice
10/13/2011	Martin Hsia, Attorney	<u>Protecting Trade Secrets & Company Information:</u> <ul style="list-style-type: none"> • How are trade secrets and company proprietary information protected? • What are reasonable measures to protect secrecy? • Company employee agreements, confidentiality obligations • Confidentiality in joint development, supply, subcontractor agreements • Licensing of confidential engineering data, manufacturing know-how, databases • Company information management: employees, security, inventory/audits
10/20/2011	Dr. Rob Yonover, Inventor	<u>IP Management for Inventors/Creators:</u> <ul style="list-style-type: none"> • Securing IP rights early • Proof-of-concept: prototype, product mock-up, beta website • Preparing a business case: expected revenues, costs, profits, markets • Finding, contacting, negotiating w/ potential purchasers, licensees • Profiting from your ideas: negotiating terms for sale or licensing
10/27/2011	Leighton Chong, Attorney	<u>IP Management of Technology & Product Innovation:</u> <ul style="list-style-type: none"> • Securing IP rights early; developing a strategic portfolio for technology or product • Adding value: expanding the scope of product exclusivity • Dealing with competitors: competitive monitoring, strategic alliances, enforcement • IP monetization options: licensing, sale, investor-backed enforcement of infringement claims • IP valuation methodologies: depends on context of IP use or assertion

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11/3/2011	Paul Maki, Attorney	<u>IP Management of Product Brands:</u> <ul style="list-style-type: none">• House brand, main product brand, secondary brands, reserved brands• Trademark clearance, resolving conflicts, registration, policing of brands• Monitoring encroachment by others: opposing dilutive registrations• Protecting corresponding domain names; evicting cybersquatters• Insurance coverage of claims for advertising of conflicting brands
11/10/2011	Martin Hsia, Attorney	<u>IP Management of Copyrighted Media & Works:</u> <ul style="list-style-type: none">• Expanding registration of copyright to modified or improved works• Giving notice of copyright; policing infringements, counterfeits, takedowns• Digital rights management: watermarks, tracers, lockouts, encryption, monitor bots• Shrink-wrap licensing; limited use licensing; differential pricing• Civil and criminal enforcement procedures; U.S. Customs & International Trade Commission exclusion orders
11/17/2011	Leighton Chong, Attorney	<u>IP Management of Foreign IP Rights:</u> <ul style="list-style-type: none">• Developing an international IP strategy early: strict time requirements & budgeting costs• Multiplied costs: individual countries, foreign IP agents, translations, annual fees• Business options: licensing, supply contracts, spinning off rights to foreign partners• Time management: home country filing, international reservation of rights, foreign filings• Finding foreign partners: trade councils, export services, foreign IP firms, brokers

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LEIGHTON K. CHONG is an intellectual property and patent attorney with over 35 years of experience, specializing in electronics, computers, software, IT, e-commerce, and bioinformatics. He is a registered patent attorney with the U.S. Patent Office and a licensed attorney in New York and Hawaii. After entering law practice in 1974 as a patent attorney with law firms in New York City, he became a founding partner of the intellectual property law firm of Ostrager, Chong, Flaherty & Broitman, PC, to which he remains Of Counsel. After returning to Hawaii, he became a partner with the firm of Godbey, Griffiths, Reiss & Chong in Honolulu, prior to opening his solo law practice in intellectual property law and patenting. Mr. Chong is past Chair of the Intellectual Property & Technology Section of the Hawaii State Bar Association, and also founder and Chair of the Annual Hawaii Intellectual Property Conference.

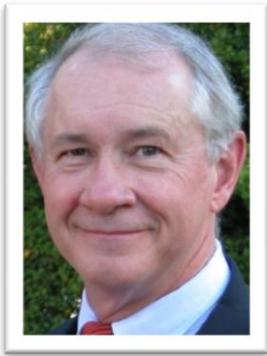


MARTIN HSIA is a registered patent attorney and intellectual property attorney practicing in patents, trademarks, copyrights, trade secrets, computer, licensing and entertainment law at Cades Schutte. He graduated *cum laude* from Georgetown University Law Center and with honors from Brown University with a specialized major, *Technology and Its Effects on Society: A Multi-Disciplinary Approach*. Mr. Hsia is listed in *Best Lawyers in America*, *Martindale-Hubbell Bar Register of Preeminent Lawyers* and *Who's Who in American Law*. Mr. Hsia previously worked as a consultant to the Office of Technology Assessment of the United States Congress on patent and energy law projects and is a member of the Patent and Trademark Office Society, the American Intellectual Property Law Association, the International Trademark Association, the Licensing Executives Society, the Intellectual Property Section of the American Bar Association and the Computer Law Association. He is past chair of the Intellectual Property and Technology Section of the Hawaii State Bar Association.



SETH M. REISS is an intellectual property and registered patent attorney with over 22 years of experience in private law practice. Seth received a BA in Biology and Chemistry from New College of Florida, a MS degree in Biochemistry from the University of Hawai'i, a JD degree from the University of Hawai'i School of Law where he served on the law review, and a LLM degree in international and comparative law from the University of Cambridge in England. Seth clerked for the Hawai'i Supreme Court and served as its staff attorney, taught law at the universities of Malaya and Hawai'i, and practiced law in the public and private sectors. His practice emphasizes patent, trademark, copyright, technology and Internet law while also providing services in business law, commercial litigation and dispute resolution. Seth is a member of the bars of the states of Hawai'i and California, is admitted before the U.S. Supreme Court, and the Federal and Ninth Circuit Courts of Appeal, and is a registered patent attorney with the USPTO. Seth help found and served as chairperson of the Intellectual Property & Technology Section of the HSBA. Seth serves as an arbitration panelist for WIPO; is a delegate to ICANN; and a fellow of the American Bar Foundation.

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J. STEPHEN STREET has more than 37 years of litigation experience in a broad variety of matters including complex business litigation, copyright and trademark infringement and trade secret litigation, officers and directors' liability, legal malpractice defense, contracts, real property, antitrust and trade regulation, franchisor/franchisee disputes, wrongful termination actions and other employment claims. His experience includes jury and bench trials, appeals, private arbitrations, mediations and administrative hearings and he has served as an arbitrator. He has represented clients in copyright and trademark infringement matters for over 25 years, including work for photographers and other visual artists, writers and technology companies. Mr. Street is the current Chair of the Hawaii State Bar Association's Intellectual Property and Technology Law Section (2010-2011).



DR. ROBERT YONOVER is a Ph.D. geochemist/volcanologist with a history of innovative scientific contributions, technologies and patents. Dr. Yonover's unique background arose from his roots as a non-talking child with a strong connection to nature and the ability to approach problems in a primitive yet creative fashion. Using life and death situations with the ocean as his laboratory, he has invented a multitude of survival technologies, including the military-approved RescueStreamer® (www.RescueStreamer.com), which is an emergency distress signaling device now in use by all branches of the U.S. Military. Dr. Yonover's media credits include appearances on CNN, PBS, Discovery Channel, with most major magazines covering the RescueStreamer® technology.



PAUL MAKI is an intellectual property practitioner and litigator with a legal practice that emphasizes resolution of business and commercial disputes (through litigation, mediation and arbitration), and the full scope of trademark and copyright law, including registration, vigilance, licensing and enforcement. He graduated cum laude from The University of Michigan Law School, and received his undergraduate degree from Cornell University.



The Intellectual Property and Technology Law (IPTL) Section is a membership association of attorneys and other members of the legal community under the auspices of the Hawaii State Bar Association. We sponsor informational, educational and legal training programs and meeting venues for our members and for the public to learn about, discuss, and update skills and knowledge of intellectual property issues affecting the State of Hawai'i, including the protection and promotion of Hawaii's unique resources in research, technology and the cultural arts.