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*WIPO TRAINING OF TRAINERS PROGRAM
ON EFFECTIVE INTELLECTUAL PROPERTY
ASSET MANAGEMENT BY SMALL AND
MEDIUM-SIZED ENTERPRISES IN DUBAI*

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IP Asset Management: IP Audit and IP Due Diligence

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Seven Rays of IP Exclusivity™



- Systematic management of different IP Assets that protect one or more product lines or business aspects
- It is the quantification of previously mysterious IP efforts, enabling measurement and objective evaluation of investment scenarios



A systematic review of the IP assets owned,
used or acquired by a business to:

- ✓ uncover under-utilized IP assets
- ✓ identify any threats to a company's bottom line

- Review of
 - ✓ company's IP assets
 - ✓ all Agreements
 - ✓ relevant policies
 - ✓ compliance procedures

- **General Purpose Audit**
 - ✓ The as-is scenario at the present state of time
 - ✓ At the time of introducing new process, policy, management change
 - ✓ Periodic updates

- Record the IP assets in use and those not in use
 - Use is by own business or by others
 - Any infringement risks by you on others assets or by others on your assets
- Streamline actions for all of the above in light of business strategy

- For Specific purpose such as
 - personnel turnover
 - Foreign IP Filings
 - Compliance on information from third parties
 - Changes in IP Law & Practice
 - Preparation for litigation

- Value and Risk of a part or all of company's IP Assets or IP portfolio

WHEN : At the time of M&A, buying/selling a business or investment, IP Transfer/Licensing, Launch of a new product

- Nature and Scope of IP assets is assessed
 - Ownership
 - Infringement or freedom to operate

IP ANALYSES AS DUE DILIGENCE

Offensive/Defensive Reviews:

- Invalidity
- Freedom-to-Operate
- Infringement
- Enforcement
- Patentability
- Others...

DUE DILIGENCE - RECORD OF INVENTION

- Important to establish inventorship
- Dated to establish date of invention in US
- Proof of diligence in following up of invention
- Precise record of observations
- Objective assessment of results
- Avoid negative characterizations
- No erasures
 - Strike through mistakes and rewriting
- Each page signed by a witness
 - Witness not associated with the project
 - Capable of understanding the invention
- Clear indication of page experiment continues from and page experiment continues to

- Identify infringing parties after thorough analysis
- Notify the alleged infringer - polite, friendly and firm
 - Notification clearly delineates the nature of infringement
 - Several rounds of talks and negotiations may ensue
- Injunction may be filed to cease any production with immediate effect
- If proved, can be used to obtain triple damages plus legal expenditure



Due Diligence - External Parties

Third parties may need to be engaged occasionally to:

- Exploit 3rd party's expertise in a research area
- Utilize critical resources unavailable in-house
- Obtain unbiased 3rd party results for processes developed in-house
- Engage contractors or contracting services

- Necessary while dealing with external parties
 - Limit information while giving or receiving only a need-to-know basis
 - Treat information provided with caution
 - Mark information appropriately before giving
- Needs to be appropriately drafted to invoke sufficient protection
 - Scope of protection and each parties' obligations need to be clearly specified
 - Periodically reviewed
- Various situations demand different types of agreements

- Non-Disclosure Agreements (NDA)
- Confidentiality Disclosure Agreements (CDA)
- Joint Disclosure Agreements (JDA)
- Research Agreements
- Consulting Agreements
- Technology Transfer Agreements
- Government Contracts
- ...

- The due diligence to inculcate a strong IP culture across the organization
- To recognize any IP generated within the organization
- To obtain adequate protection for all IP created in a timely manner
- To avoid incurring great expenses at a later stage due to ignorance, negligence or oversight
- To maximize the utilization of IP assets, thus ensuring vital resources are not wasted

Based on the outcome of the audits and diligence, businesses can:

- evolve **informed strategies** that will maintain and improve the company's market position
- Be confident of their position in wrongful infringement actions
- Ensure all the IP assets are adding value to the business



*“If you don’t measure it, you can’t
manage it”*

WIPO RESOURCES FOR SMEs

Small and Medium-Sized Enterprises (SMEs) - Windows Internet Explorer

http://www.wipo.int/sme/en/

Norton Phishing Protection on Identity Safe Log-ins

Google Go Bookmarks 13 blocked Check AutoLink AutoFill Send to Settings

Small and Medium-Sized Enterprises (SMEs)

WORLD INTELLECTUAL PROPERTY ORGANIZATION

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