

**“Intellectual Property Protection & Licensing Strategies
for Small Business” WEBINAR**

Presentation Sponsored by



**Presentation by
James Gatto
Partner**

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- **The Center for Innovative Technology (CIT)** helps to accelerate the next generation of technology and technology companies in the commonwealth of Virginia.
- **CIT Entrepreneur** -- Assists early-stage Virginia based technology companies in their efforts to secure private and federal funding sources:
 - Federal Funding Assistance Program
 - GAP Fund



CIT GAP Fund – Invests in early stage Virginia based tech firms to provide seed stage funding to leverage additional outside private capital. Reps visit Blacksburg, Charlottesville, Norfolk, Richmond, Northern Va, and other regions monthly.

Federal Funding Assistance Program – CIT is the lead SBIR/STTR support organization in Virginia. FFAP works with Virginia based tech firms in their efforts to secure early stage federal R&D Grants, like SBIR and STTR grants. We provide training, mentoring, proposal development assistance, Phase 0 awards to assist proposal development, & more.

Upcoming Training

- **Sept. 14, 2015**
 - “NSF SBIR/STTR Workshop”, Hampton, VA
- **Sept. 15-16, 2015**
 - NSF SBIR/STTR Workshop w/ Commercialization planning session, Norfolk, VA
- **Nov. 2, 2015**
 - SBIR Lunch & Learn with NSF Program Manager, George Mason Univ.
- **Dec. 8, 2015**
 - SBIR Lunch & Learn with SBIR Program Manager Panel (*NASA, NAVY, NIH, DARPA*), Tysons Corner, VA
- **Dec. 15, 2015**
 - “DOD SBIR Proposal Prep Workshop”, Herndon, VA

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Pre-Recorded Webinar Training

- **PRE-RECORDED SESSIONS:**
 - **SBIR/STTR Overview Webinar**
 - **Feasibility Project Scope Webinar**
 - **Eligibility Requirements Webinar**
 - **Building Teams for your Startup Webinar**
 - **SBIR/STTR Commercialization Plans Webinar**
 - **NSF/DOD SBIR Competitive Checklist Webinar**
 - **Quickbooks & Compliance Webinar**
 - **SBIR/STTR For PostDocs & Grad Students**
 - **Writing NIH Research Strategy & Demonstrating Impact**
 - **Tips on Preparing NIH Biosketches & Facilities Sections**

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RECORDED WEBINARS**

<http://www.cit.org/service-lines/cit-entrepreneur-webinars/>

Today's PRESENTATION:

- **Questions:** Use the **Question function** to ask a question. We'll answer the question at the appropriate time. Lengthy questions, or if we need to stay on time, will be deferred to after the presentation during Q&A.
- **Today's Speaker:**

James Gatto
Partner, Intellectual Property Practice Group
Sheppard Mullin





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Intellectual Property Protection & Licensing Strategies For Small Business

Presented to Center for Innovative Technology SBIR/STTR Assistance Program – September 10, 2015

By James Gatto, Partner

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Overview

- Best practices for protecting your Intellectual Property
- Current patent trends
- Overview of open source license issues and the impact on your IP
- How University Tech Transfer & intellectual Property Offices work
- Strategies and tactics for licensing university IP
- How to identify and protect IP (what is yours, what is the universities)

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Overview of IP Issues

- Patent
- Copyrights
- Trademarks
- Trade Secrets

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Who Invented Facebook?



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Best Practice #1

OWN IT!

- Absent an agreement or other legal obligation, Patents are owned by the inventors
- But you must file for protection!!!
- You have One Year (or less)!

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Best Practice #1

OWN IT!

Work for Hire?

Business Partners?

Founders?

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Best Practice #1

OWN IT!

Government Funding?

Does Government Own?

Not if you timely take proper steps!

Disclose and elect to retain title

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Best Practice #2

Identify it!

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Best Practice #3

Protect it!

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Best Practice #4

**Develop Comprehensive IP Strategy
Aligned with Business Strategy!**

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Best Practice # 5

Update it!

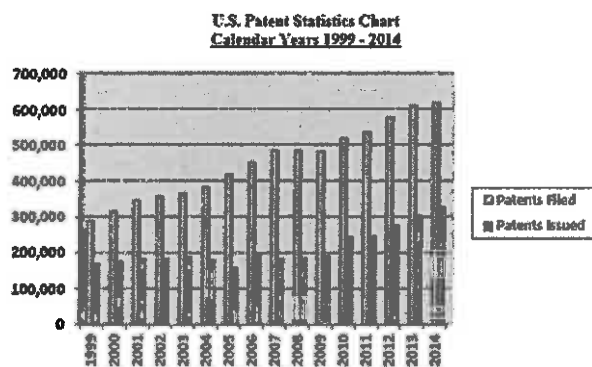
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Best Practice #6

Leverage It!

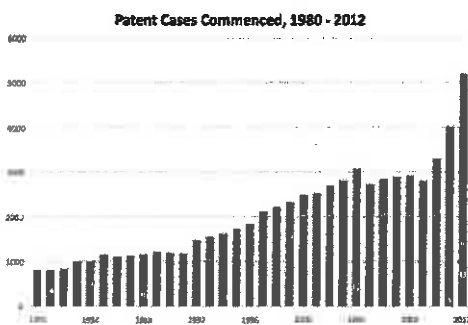
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Patent Trends - Filings



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Patent Trends – Litigation



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Current Patent Trends

Fundamental Changes to Patent Laws

First to File!

Track One

IPRs

Patentability of
Software/Business Method Patents

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Open Source License Issues

Use of Open Source is pervasive and growing

many advantages/many risks

- tainting (OS impacting proprietary sw)
- patent license grants

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Open Source License Issues

many misconceptions (SaaS/Cloud)

increasing law suits

overlap of open source/patent issues

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Open Source License Issues

Develop Open Source Policy

approval process

document uses

ensure compliance

If in doubt, can do code scan (e.g., Black Duck)

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UNIVERSITY IP

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University Technology Transfer

University technology transfer is the engine that has propelled the growth of the American economy today and tomorrow.

Over 100,000 R&D employees at 2,000 universities and colleges

Over 4,000 patents issued

5.7M

3 million jobs and wages paid to workers in university patenting

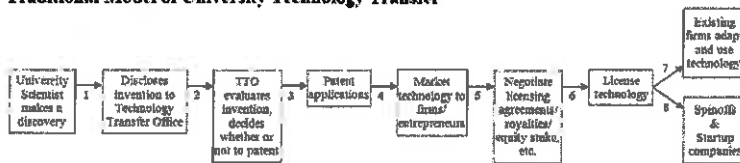
AUTM
Association to Advance Auto-Termination of University-Multinational Trade

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University IP Structures

Figure 1
Traditional Model of University Technology Transfer



From Models and Methods of University IP, Bradley et al.

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Ownership of University IP

When seeking to commercialize University IP,
 make sure you understand ownership rights

Stanford Case

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Strategies and Tactics for Licensing University IP

How to identify and protect IP
what is yours?
what is the universities?

KNOW THE FACTS
BE STRATEGIC
DOCUMENT

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Questions?

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