

# **BUSMHR 7194.61: Intellectual Property Strategy**

Instructor: Dipanjan Nag, PhD, MBA, CLP, RTTP  
Coordinating Instructor: Alex J Turo, MS, PhD(c)

Tuesdays & Thursdays, 6:15-9:30 PM in Gerlach 285  
Summer 2018 (May 24<sup>th</sup> through July 17<sup>th</sup>)

## **Course Description**

This course provides essential knowledge for science and engineering students who have a drive to be successful in inventions or who have an interest to work in intellectual property (IP) related professions. The course covers the fundamentals of intellectual property, with a major emphasis on intellectual property strategies. Topics include forms of intellectual property, IP strategy, IP markets, startups, negotiations involving IP, IP due diligence, and technology transfer, licensing and commercialization, valuation and metrics based quality assessment of IP. There will be emphasis on IP strategy from a standpoint of corporations and university.

## **Course Objectives**

The objectives of this course include:

- Offer training on various forms of IP with a special emphasis on patents;
  - IP Primer – Patents, Copyrights, Trademarks, Trade-Secrets
- IP strategy for startups and corporations
- Performing portfolio analysis
- Marketing strategy for licensing IP assets;
- IP markets
- Litigation of IP
- Negotiations involving IP in contracts such as licenses and research agreements
- Overall training on protection, marketing, assessment, valuation, commercialization and monetization of IP assets

## **Grades**

Grading will be based on:

1. Attendance of class (5%)
2. Class participation (10%)
  - a. In-class
  - b. Carmen Forum discussions
3. Quiz (10%)
4. Midterm examination – testing in class and reading materials provided (25%)

5. Final project (50%) – The final project will be based on IP portfolio evaluation, selection of IP assets, commercialization strategy, and marketing plan. The Final Project will be a group effort with two deliverables:
  - a. Project report (30%)
  - b. Final presentation (20%)

## Your Reading Material

1. What is a patent?
  - a. <http://www.uspto.gov/patents/index.jsp>
  - b. <http://www.uspto.gov/inventors/patents.jsp>
  - c. Process of obtaining a patent -  
<http://www.uspto.gov/patents/process/index.jsp>
  - d. Case study – The history of the basic telephone patent (MIT Openware Course – Create of Perish Ch. 4) [http://ocw.mit.edu/courses/electrical-engineering-and-computer-science/6-931-development-of-inventions-and-creative-ideas-spring-2008/readings/create\\_or\\_perish.pdf](http://ocw.mit.edu/courses/electrical-engineering-and-computer-science/6-931-development-of-inventions-and-creative-ideas-spring-2008/readings/create_or_perish.pdf)
2. Online training for patents
  - a. <http://www.uspto.gov/video/cbt/GIPA-English/Patents/index.htm>
3. Online training for Copyrights
  - a. <http://www.uspto.gov/video/cbt/GIPA-English/copyright/index.htm>
4. Online training for trademarks
  - a. <http://www.uspto.gov/video/cbt/GIPA-English/copyright/index.htm>
5. The TRIPs agreement
  - a. [http://www.uspto.gov/ip/global/trademarks/ir\\_trips.jsp](http://www.uspto.gov/ip/global/trademarks/ir_trips.jsp)
6. Patents and IP Creation cycle
  - a. [http://www.wipo.int/export/sites/www/about-ip/en/studies/publications/wipo\\_pub\\_489/pdf/wipo\\_pub\\_489\\_ch2.pdf](http://www.wipo.int/export/sites/www/about-ip/en/studies/publications/wipo_pub_489/pdf/wipo_pub_489_ch2.pdf)
7. Corporate Patent Strategy
  - a. [http://www.wipo.int/export/sites/www/about-ip/en/studies/publications/wipo\\_pub\\_489/pdf/wipo\\_pub\\_489\\_ch4.pdf](http://www.wipo.int/export/sites/www/about-ip/en/studies/publications/wipo_pub_489/pdf/wipo_pub_489_ch4.pdf)
8. Creating a Patent Market
  - a. [http://www.wipo.int/export/sites/www/about-ip/en/studies/publications/wipo\\_pub\\_489/pdf/wipo\\_pub\\_489\\_ch9.pdf](http://www.wipo.int/export/sites/www/about-ip/en/studies/publications/wipo_pub_489/pdf/wipo_pub_489_ch9.pdf)
  - b. [http://www.oceantomo.com/system/files/MIParticle\\_Malackowski\\_Interview\\_Dec08\\_Jan09.pdf](http://www.oceantomo.com/system/files/MIParticle_Malackowski_Interview_Dec08_Jan09.pdf)
9. Startups
  - a. <http://www.business-strategy-innovation.com/wordpress/2011/04/when-university-start-ups-begin-to-patent-like-corporations/>

**If a link for a PDF, including book chapters, does not work, it is also available for download in Carmen. More reading materials may be posted on Carmen during the course of the semester.**

## Course Schedule

### Unit 1: May 24, 2018 6:15-9:30pm

**Speaker Location:** Ohio State University

**Topic:** Introduction to Intellectual Property/Patents 101

**Speaker:** Professor Dipanjan Nag, PhD, MBA, CLP

**\*\*No class meeting: May 29\*\***

### Unit 2: May 31, 2018 6:15-9:30pm

**Speaker Location:** Ohio State University

**Topic:** IP Licensing Strategy

**Speaker:** Professor Dipanjan Nag, PhD, MBA, CLP

**Notes:**

- Technology Focus Group allocation

### Unit 3: June 5, 2018 6:15-9:30pm

**Speaker Location:** Rutgers University

**Topic:** Patent Drafting and Quality, Part One

**Invited Speaker:** Harry Gwinnell, JD (Counsel, Greenblum & Bernstein, P.L.C.)

### Unit 4: June 7, 2018 6:15-9:30pm

**Speaker Location:** Rutgers University

**Topic:** Patent Drafting and Quality, Part Two

**Invited Speaker:** Harry Gwinnell, JD (Counsel, Greenblum & Bernstein, P.L.C.)

**Due on this day:**

- Technology Focus Groups: Choose IP
- Patent Drafting Assignment

### Unit 5 & 6: June 11, 2018 6:15-9:30pm (OPTIONAL)

**Location:** Onsite at United States Patent and Trademark Office, Alexandria, Virginia

**Notes:**

- If unable to attend USPTO Trip, students *must* attend Units 12 & 13.
- USPTO Trip Agenda will be available on Carmen

**\*\*No class meeting June 12\*\***

### Unit 7: June 14, 2018 6:15-9:30pm

**Speaker Location:** Rutgers University

**Topic:** IP Litigation/Markman Hearings

**Invited Speakers:** Tony Volpe, JD (Patent Attorney, Volpe and Koenig, P.C.) and Ryan O'Donnell, JD (Patent Attorney, Volpe and Koenig)

**Due on this day:**

- Technology Focus Groups: Proposal Part 1 (electronic copy must be submitted to Carmen Drop Box)

### Unit 8: June 19, 2018 6:15-9:30pm

**Speaker Location:** Ohio State University

**Topic:** IP Monetization

**Invited Speakers:** Erich Spangenberg (Managing Director, SK14 Advisors; Co-founder, IPwe.com)

**Notes:**

- In-Class Quiz on this day

**Unit 9: June 21, 2018 6:15-9:30pm**

**Speaker Location:** Ohio State University

**Topic:** IP Strategies in Industry

**Invited Speaker:** Francisco Sanchez (Vice President, General Counsel, Honda Patents & Technologies North America, LLC)

**Unit 10: June 26, 2018 6:15-9:30pm**

**Speaker Location:** Ohio State University

**Topic:** Tech Transfer & Negotiations

**Invited Speaker:** Lita Nelsen (Former Director of MIT Tech Licensing Office) (joining by videoconference)

**Invited Speaker:** Vince Smeraglia (Executive Director of Strategic Alliances, Office of Research Commercialization, Rutgers University)

**Notes:**

- Take Home Midterm Exam Available on Carmen - Due: July 3, 2018

**Due on this day:**

- Technology Focus Groups: Proposal Part 2 (electronic copy must be submitted to Carmen Drop Box)

**Unit 11: June 28, 2018 6:15-9:30pm**

**Speaker Location:** Ohio State University

**Topic:** IP Valuation

**Invited Speaker:** Mike Pellegrino (Founder and President, Pellegrino & Associates)

**Unit 12: July 3, 2018 6:15-9:30pm**

**Speaker Location:** Ohio State University

**Topic:** TBD

**Invited Speaker:** Isaac Molnar (Ohio Attorney General IP Counsel)

**Due on this day:**

- Take Home Midterm

**Unit 13: July 5, 2018 6:15-9:30pm**

**Speaker Location:** Ohio State University

**Topic:** IP Negotiation Activity

**Speaker:** Professor Dipanjan Nag, PhD, MBA, CLP

**Unit 14: July 10, 2018 6:15-9:30pm**

**Speaker Location:** Rutgers University

**Topic:** IP Management

**Invited Speaker:** Sudeep Basu, PhD (Practice Leader, Innovation Services, Frost & Sullivan)

**Unit 15: July 12, 2018 6:15-9:30pm**

**Speaker Location:** Ohio State University

**Topic:** Patent Prosecution Strategy

**Invited Speaker:** Kevin Noonan (Partner, McDonnell Boehnen Hulbert & Berghoff LLP)

**Unit 16: July 17, 2018 6:15-9:30pm**

**Speaker Location:** Ohio State University

**Topic:** Final Project Presentations

**Notes:**

- Electronic copy of final paper must be submitted to Carmen Drop Box

## Course Policies

### Extenuating Circumstances

If you have extenuating circumstances that prevent you from completing projects, quizzes or participating in the class, please contact the instructor to make alternative arrangements. The possibility of alternative arrangements is at the discretion of the instructor. Active communication is the key to overcoming any hurdles you may encounter during the term.

### Late Work Policy

No projects will be accepted after the deadlines mentioned in curriculum. If there are extenuating circumstances, then the course instructor's permission must be explicitly requested ahead of time.

### Missed Class Policy

Students are expected to attend all class sessions, lectures and seminars. If due to extenuating circumstances a student has to miss a class instructor must be informed in advance that the class will be missed by the student. To make up for that missed class the student has to write an additional paper covering the topic missed during class. It would be the student's responsibility to find out about the material covered during that session and understand the material. No more than ONE class can be missed during the term of the course and will be reflected by deduction of substantial points at the discretion of the instructor which WILL result in lower grade for the overall course.

A request for remote attendance may be requested to the course instructors. Requests must be submitted in advance so that arrangements can be made. Remote access will be granted on a case by case basis. The course instructors reserve the right to determine which cases will be granted access to remote attendance.

## Plagiarism Policy

There is zero tolerance for plagiarism in the course. Plagiarism checks will be made on submitted assignments using online tools.

## OSU Disability Policy

The University strives to make all learning experiences as accessible as possible. If you anticipate or experience academic barriers based on your disability (including mental health, chronic or temporary medical conditions), please let me know immediately so that we can privately discuss options. You are also welcome to register with Student Life Disability Services to establish reasonable accommodations. After registration, make arrangements with me as soon as possible to discuss your accommodations so that they may be implemented in a timely fashion. SLDS contact information: [slds@osu.edu](mailto:slds@osu.edu); 614-292-3307; [slds.osu.edu](http://slds.osu.edu); 098 Baker Hall, 113 W. 12th Avenue.

## Academic Misconduct

The Ohio State University's Code of Student Conduct, Section 3335-23-04 defines academic misconduct as: "Any activity that tends to compromise the academic integrity of the University, or subvert the educational process." Examples of academic misconduct include (but are not limited to) plagiarism, collusion (unauthorized collaboration), copying the work of another student, and possession of unauthorized materials during an examination. Ignorance of the University's Code of Student Conduct is never considered an "excuse" for academic misconduct. The Ohio State University and the Committee on Academic Misconduct (COAM) expect that all students have read and understand the University's Code of Student Conduct, and that all students will complete all academic and scholarly assignments with fairness and honesty. Failure to follow the rules and guidelines established in the University's Code of Student Conduct may constitute "Academic Misconduct." Sanctions for the misconduct could include a failing grade in this course and suspension or dismissal from the University. For more information, please reference: <http://oaa.osu.edu/coamfaqs.html#academicmisconductstatement>

## Final Project Instructions

### Overview:

The final project will be a group project. Each member of the group is expected to contribute substantially and meaningfully toward the completion of the project. Each group will be requested to select an IP asset and utilizing knowledge acquired from the class.

### Schedule:

- May 31 – Technology Focus Group allocation
- June 7 – Choose IP due
- June 14 – Proposal Part 1 due

- June 26 – Proposal Part 2 due
- July 17 - Final project
  - Presentation
  - Paper submission

### **Choose IP: due June 7, 2018**

Each group must choose and submit their chosen IP for the project by June 7, 2018. The group liaison must submit the Patent Number and a short name describing the technology. In Carmen Resources, see Final Project>Choose IP Resources.

### **Proposal Part 1: due June 14, 2018**

Proposal Part 1 (no less than 3 pages) and team makeup must be submitted by each team by June 14, 2018. The proposal should clearly outline the scope of the project, should include a cover sheet listing the members of the team, and should identify a team leader who will serve as the main contact person. A preliminary plan for the project's development should be addressed in the proposal.

In Carmen Resources, see Final Project>Proposal Part 1 Resources. Please submit an electronic copy to the Carmen Drop Box; each group leader must turn in one copy of the Preliminary Proposal on behalf of their group. Each group will be requested to select a patented technology. For your Preliminary Proposal, please discuss the technology you have selected and develop:

- a. An IP Protection Strategy
  - i. Decide if your group entity is a small startup, larger company or an academic institution (i.e. a University TTO)
  - ii. How would you protect your technology? What kind of IP would you consider and why?
  - iii. What type of budget considerations do you have? How does this affect the type of IP you apply for?

### **Proposal Part 2: due June 26, 2018**

Proposal Part 2 should provide the instructor a clear indication of the final project deliverable. This will be your last chance to ensure that the final project has all or most of the elements required in final project submission.

In Carmen Resources, see Final Project>Proposal Part 2 Resources. You will provide additional information about the actual IP that has been developed for each technology. Using the real world information about the real active IP for your technology, each group will develop:

- b. A Licensing Strategy
  - i. Based on your type of group entity, decide whether your strategy should include In-licensing the IP or Out-licensing the IP. It could be that you would want to do both, i.e., after you in-license the IP you could choose to out-license a part of that IP.
  - ii. What type of entity your group would like to enter into license negotiations with?

c. Licensing Exercise

- i. Provide a possible term sheet that would be characteristic of a term sheet between your group entity and the entity you selected.
- ii. Provide an analysis of the term sheet negotiation, including what factors your group considered and how the negotiations would likely proceed?
- iii. Provide scenario analysis of the negotiation. A template term sheet has been provided in Carmen, but you may choose your own template.
- iv. Discuss key areas of negotiation and key factors considered in licensing the IP. Provide scenario analysis for negotiating the contract.
- v. Were other agreements negotiated in the process?
- vi. What areas of the license agreement were negotiated? Here you need to provide understanding of how your technology vertical is licensed based on at least one similar product which is already there in the marketplace.

### **Final Project Report & Presentation: July 17, 2018**

The final project will be a report which will be approximately 20-25 pages long (without the reference section). This report must target all or most areas delineated during class and the final projection discussions during the term. The final project would be a dedicated effort by students to incorporate most of the areas covered during class lecture and guest speaker seminars.

In Carmen Resources, see Final Project>Final Paper Resources folder and Final Project>Templates. All sections must be submitted in the Drop Box by the group leader on Carmen. It is strongly encouraged to update all sections if there have been any changes in your project to ensure consistency throughout the whole Final Paper. Use the real world IP information for your technology. For your final paper, you will additionally address:

d. The Quality Assessment of the IP portfolio or IP assets

- i. Using information from your Patent Analysis Tool, discuss the quality assessment of your IP portfolio (i.e. strengths, weaknesses, and statistics of note).
- ii. Use one IP search method to discuss the status of the IP in the IP portfolio.
- iii. Download and discuss the file wrapper information for the IP (see Public PAIR - File Wrapper.pdf in Carmen Resources>Final Project>Final Paper Resources)

e. Perform Due Diligence Analysis

- i. Assignment of IP – Does anything else needs to be done?
- ii. Is there Past Litigation on the IP assets? Are there contributory factors towards potential litigation?



- iii. Show proficiency in searching for relevant prior art in the field. Is there anything that is problematic or limiting?
    - iv. Discuss other areas of due diligence for your IP (i.e. infringement).
  - f. IP Litigation
    - i. Decide if your group entity will have their IP litigated or will need to file for infringement.
    - ii. What would you predict the licensee of the patent will do? What will you do as the assignee of the patent?
  - g. IP Aggregators
    - i. What would be your strategy if you had to monetize the IP?
    - ii. If you are faced with dire consequences and had to divest the assets, provide a scenario of how to monetize the IP assets.
    - iii. What would be your method of choice for performing valuation of the asset before divestiture?

A project presentation will be required at the end of the course. This presentation may be given by a single member of the team or by the entire team (tag presentation). The presentation must provide the instructor and the class a clear indication of the strategy taken by the team to build the final project. Each major area of the final project must be covered in the final presentation delineating **CLEARLY** each area of the project without going over time. A critical aspect of this exercise is to keep your presentation on time as is required when you present in front of venture capital organizations.

### **Project Assessment:**

Your grade will be based on the quality of work produced and how well the work produced matched the initial project specifications, not on the time spent (so use your energy wisely!). In addition, a final assessment will be performed by each student rating all of the other projects. It is important that project reports be submitted on time (to enable the project to stay on schedule and to give the instructor(s) time to evaluate your work). Late work will be penalized.

### **Notes on Documentation:**

Although project reports will not be directly graded on writing style, organizing your thoughts and writing clearly will enable the instructor(s) get more out of your reports. It is important that each report have only one editor even though it will contain contributions from all the team members. The responsibility of the editor includes turning in the final document, setting deadline for individual submissions within the group and incorporating individual submissions into a single coherent and complete document.

## **Current Topics in Intellectual Property: Forum Discussions**

There will be three Discussion Sessions during the course of the semester, each lasting two weeks. A set of discussion topics related to current issues and events related to the field of IP will be posted in the forum specified by the instructors to allow you and the students from Rutgers to establish a scholarly dialogue. You are expected to participate in at least one discussion topic. Grades will be based on the quality of engagement: describe

your position, respond to others in agreement or posing a different opinion, and always defend your stance with valid sources. The discussions will occur online and you may contribute any time you wish before each session is closed.

## Contact Information

Instructor: Dipanjan Nag, PhD, MBA, CLP ([nag.18@osu.edu](mailto:nag.18@osu.edu))

Executive Assistant to Dr. Nag: Emily G. Sandvik ([sandvik.3@osu.edu](mailto:sandvik.3@osu.edu))

**For ALL course related inquiries, please contact:**

Coordinating Instructor: Alex Turo, MS, PhD(c) ([turo.1@osu.edu](mailto:turo.1@osu.edu))