This management text seeks to help intellectual property law practitioners relate law and legal practice to their clients’ business objectives. It is written for insiders by an insider who believes that the devil is often in the detail of which an outsider is unaware. Effecting a grand strategy may often depend on the details of a law, on the details of claim and agreement drafting, and even on what boxes (“fields”) are available on computer screens. A consequence of this perspective is, it is hoped, that the book will be of immediate practical value to practitioners, building on what they already know rather than imposing some external philosophy with unnecessary novel concepts.

This book is written after 3 years’ work in private practice and 32 years’ work in industry, 21 years of the latter as an intellectual property department head for multinational companies in a variety of business sectors (packaging, telecommunications products and services, and aerospace and defence). The book addresses practitioners serving all business sectors save for publishing and the media. The book will in addition be an invaluable resource for academics and policy-makers.
Inside Intellectual Property
Best Practice in Intellectual Property Law, Management, and Strategy
Written by Michael Jewess and published by CIPA in 2013

ABBREVIATED CONTENTS

PART A – BASICS

CHAPTER 1, LEGAL PROFESSIONAL QUALITY: Action-due dates; peer review; practice disciplines; skill and knowledge; quality management systems and standards.

CHAPTER 2, ETHICS AND PRIVILEGE: Ethics: higher ethical obligations trumping the client’s interests; conflict of interest; special problems in licensing and in disposal of IPRs; in-house job titles. Privilege: relevance to all practitioners; practical guidelines; special problems for IP practitioners; EU competition law; future prospects.

CHAPTER 3, SYSTEMS: Managing systems projects; case management systems; financial systems; “paperless office”; dictation and voice recognition; e-business; renewals.

PART B – CASEWORK

CHAPTER 4, RESEARCH AND DEVELOPMENT (R&D) AND TECHNICAL INNOVATION: “Invention” and “innovation”; short-termism and R&D; the uncertainty of innovation; R&D strategy and management tools and models; the R&D function in the larger company; R&D in Universities; collaboration and “open innovation”.

CHAPTER 5, PATENTING: Role of patent attorneys and other IP practitioners; prior art searching; filing routes; drafting for international filing; uses of patents; patenting strategy guidelines; patenting strategy processes; benchmarking against competitors; important patents.

CHAPTER 6, EMPLOYEE INVENTORS: Practicalities of inventorship and entitlement; non-compliant inventors; voluntary incentives; statutory awards; special case of university academics.

CHAPTER 7, UNSOLICITED TECHNICAL SUGGESTIONS: A possible, purely legal response (not recommended); a more practical approach (recommended).

CHAPTER 8, BRANDING: Definition of, investment in, and value of brands; cluttering; brand architecture; choice of marks; corporate brand (“identity”); company names; domain names; trade mark portfolio management; important trade marks.

CHAPTER 9, OTHER INTELLECTUAL PROPERTY RIGHTS: Second-tier patents; industrial designs; unregistered design right; copyright; sector specific rights (eg regulatory data exclusivity).

CHAPTER 10, INTELLECTUAL PROPERTY DISPUTES – AVOIDANCE AND HANDLING: Avoiding and curtailing IP disputes (both as defendant and claimant); patent clearance searching and general competitor patent awareness; commencing and handling disputes; documentation.

CHAPTER 11, INTELLECTUAL PROPERTY AGREEMENTS: Selected legal and drafting technicalities; confidentiality agreements; licensing agreements; R&D and procurement contracts; R&D collaboration; strategic patent agreements; mergers and acquisitions; taxation; administration.

CHAPTER 12, PAEs/NPEs/PATENT TROLLS, MARKING TROLLS, AND UNSOLICITED APPROACHES RELATING TO INTELLECTUAL PROPERTY RIGHTS REQUESTING PAYMENT

CHAPTER 13, INTELLECTUAL PROPERTY WITHIN THE COMPANY STRUCTURE OR GROUP: Legal options; managerial principles; technology transfer and licensing of brands between tax jurisdictions.

PART C – OTHER TOPICS

CHAPTER 14, EDUCATING THE CLIENT: Presentations to R&D, marketing, commercial, and contracts functions and to general lawyers; literature.

CHAPTER 15, THE FINANCIAL MODEL: The practice’s financial model; the paying client’s financial model; accountants.

CHAPTER 16, INFORMATION SECURITY: Basic protection for all information; unfiled patent applications; national security; commercially sensitive non-patenting information.

CHAPTER 17, BUSINESS CONTINUITY PLANNING (DISASTER RECOVERY): Computer backups; hardware and accommodation; the core team; storage; staff awareness; testing.

CHAPTER 18, PEOPLE AND ORGANISATIONS: Practice organisation – client-facing vs functional; practitioners and their “comfort zone”; paralegals/formalities staff; secretarial staff; training for effectiveness; in-house practices and the company.

CHAPTER 19, INTELLECTUAL PROPERTY POLICIES: Formal policies; informal policies; policy compliance.

CHAPTER 20, LOBBYING ON INTELLECTUAL PROPERTY LAW: Lobbying guidelines; case studies, eg the EPC, TRIPS, and in IP and competition law; ethics and regulation of lobbying.

APPENDICES, ABBREVIATIONS, REFERENCES, INDEX

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