

Index

- acquired distinctiveness 68
- antitrust 148–152
 - enforcement guidelines 149
 - essential facilities doctrine 150
 - in Europe 149
 - in Japan 149
 - in US 148–149
 - refusals to license 150–151
 - tie-ins 150
 - tie-outs 150
- arbitration 108–109
- assignments
 - generally 119–120
 - of copyright 73, 80
 - of patents 80
- attorney–client privilege 117; *see also* common interest agreement
- automated patent analysis 97–98
 - inventor reports 98
 - patent hit counts 97
 - patent landscapes 97
 - prior-art citations 97
- bankruptcy 154
 - bankrupt licensee
 - assignment of license 154
 - assumption of license 155
 - bankrupt licensor
 - effect on licensee 155
- Bayh–Dole Act x, 129
- Berne Convention 17
- best-testing requirement 31
- beta testing and agreements 87, 125; *see also* patents, novelty requirement
- biotechnology
 - patent protection for ix, x, 58
- business methods
 - exception to forfeiture for 36
 - patent protection for 4, 39, 58
- Chakrabarty* case x
- civil law 26
- claims, *see* patent claims
- clean room 20
- clearance search 130–133
- co-exclusive licenses 140
- common interest agreement 117
- common law 26
- compulsory licensing 7, 129, 130
- computer software
 - copyright of xi, 37–39
 - licensing of ix
 - patents for ix, 3, 58
- consequential damages 124
- consulting agreements 120
- “copyleft” 126, 127
- copyright
 - advantages and disadvantages of 21
 - assignment of 73, 80
 - computer software xi, 37–39
 - derivative works 16, 126
 - defined 1
 - duration 16
 - eligibility criteria 15 *et seq.*
 - eligible subject matter 15
 - fixation requirement 16
 - idea *v.* expression 20, 38, 40
 - information *v.* function 37
 - Internet and 3–4, 17
 - interoperability and 39
 - merger 20, 38, 40
 - national treatment 18
 - originality requirement 16
 - procedures for 18 *et seq.*
 - deposit 18, 40
 - registration 18
 - reverse engineering and 21, 39
 - rights of copyright owner 16 *et seq.*
 - screen displays 37, 39
 - statutory damages 18
 - v.* patent 37 *et seq.*

- v. trade secrets 40 *et seq.*
 - work for hire 72, 80
- copyright infringement
 - access requirement 20
 - fair use as defense against 20
 - independent creation as defense against 19
 - substantial similarity requirement 19, 38
- copyright misuse 149, 150
- copyright notice 18
- cybersquatters 68
- declaratory judgment 107
- Dell Computer 94
- derivative works 16, 126
- design patents 23–24
- Digital Millennium Copyright Act 17
- discovery, *see* pre-trial discovery
- doctrine of equivalents, *see* patent infringement
- domain names 68
 - v. trademarks 68
- employment agreements 72, 120
- end-user license agreements 124
- equivalents, doctrine of, *see* patent infringement
- European Patent Office 13, 111
- evidence, tampering with 102
- exclusion orders 57
- exclusive licenses 139, 151
- exhaustion 2, 7
- fair use
 - factors in determining 20
 - reverse engineering and 21
- Federal Trade Commission 94
- file destruction 102
- first-sale doctrine 2, 7
- foreign-filing licenses 9–10, 122
- forfeiture of patent rights 36
- free software, *see* open-source software
- Free Software Foundation 128
- “freedom-to-create” laws 72
- General Public License (GPL) 127–128
- Goldscheider’s rule 146
- government rights 129–130
- grantbacks, *see* licenses
- indemnifications 124, 145
- industry standards x, 83
 - and licensing 53, 155 *et seq.*
 - managing participation in 93–95
 - reasonable and nondiscriminatory terms 155–156
- inevitable disclosure doctrine 122 *see also*
 - noncompetition agreements
- injunction 6, 22
- innovation patent, *see* utility models
- integrity, right of 16
- intellectual property (IP) strategy
 - alignment with business objectives 45
 - blocking IP 46
 - “core technology” strategy 44
 - defensive 46–47
 - disputes, possibility of 50
 - international
 - generally 119
 - preserving rights 52
 - selecting countries for protection 56–60, 83
 - licensing and 51
 - offensive 46
 - patents and 92, 115
 - “picket fence” strategy 44
 - “target” strategy 44
 - uses of IP 45 *et seq.*
- International Chamber of Commerce 108
- Internet Corporation for Assigned Names and Numbers (ICANN) 68
- inventions
 - assignments of 72, 80; *see also*
 - assignments
 - conception 74
 - disclosures 74–75, 76, 77–80
 - notebook procedures for 72
- inventorship 105, 120
- Library of Congress (U.S.) 18
- licenses
 - assignability 152–153
 - definition 139
 - change-of-control restriction 153
 - co-exclusive 140
 - compulsory 7, 129, 130
 - cross-license 140
 - exclusive 139
 - antitrust concerns 151
 - foreign-filing 9–10, 122
 - grant 141
 - grantbacks 125, 137, 140, 156
 - antitrust concerns 151, 157
 - milestone payments 144
 - nonexclusive 140
 - paid-up 140
 - refusals to license 150–151
 - royalties 143–144
 - royalty stacking 143

- licenses (*cont.*)
 - sole 140
 - sublicenses 141
 - royalty rates for 143
- licensing
 - by universities x, 157 *et seq.*
 - compulsory 7, 129, 130
 - IBM (International Business Machines) Corp.
 - and x
 - market segmentation 52
- literature citations 92–93
- litigation
 - costs 27
 - declaratory judgment 107
 - discovery, *see* pre-trial discovery
 - insurance 113
 - obligation or right to sue 106
 - risks 35
 - summary judgment 27
 - trial 27
- lost profits, as measure of damages 7
- “march-in” rights 7, 129, 130
- mask works 24
- material transfer agreements 125
- mediation 107–108
- merger doctrine 20, 38, 40
- Microsoft Corp. 95
- misuse
 - copyright misuse 149, 150
 - patent misuse 94, 149, 150, 151, 161
- moral rights 16–17, 73
- noncompetition agreements 122
- nondisclosure agreements 22, 76, 118, 120
- nonexclusive license 140
- notebook date 8, 12, 73
- notebook procedures 72
- open-source software 126–128
 - General Public License (GPL) 127–128
 - Lesser General Public License (LGPL) 127
 - viral effect 127
- oppositions (to patents) 13, 109–111
- ownership of intellectual property (IP) (*see also* assignments)
 - obligations to academic institutions 121
 - obligations to former employers 120, 121–122
 - obligations to government agencies 129–130
- Paris Convention 8, 9
- patent analysis, automated, *see* automated patent analysis
- patent applications 10–13
 - best-mode requirement 31
 - continuation applications 54
 - continuation-in-part applications 54
 - costs 11
 - disclosure requirements 31
 - divisional applications 54
 - examination of 13
 - literature citations 92–93
 - nonprovisional applications 8
 - prosecution of 13, 89
 - provisional applications 8–9
 - publication of 11–12, 132
 - restriction practice 54, 55
 - sufficiency of 9
- patent claims 11, 91
- patent committee 76, 77
- Patent Cooperation Treaty (PCT) 8, 10, 12–13, 52, 59, 142
 - costs 12
 - international search report 12
- patent infringement
 - direct 6
 - doctrine of equivalents 6
 - independent development no defense to 3
 - indirect 6, 91
 - remedies for 6–7
 - willful 100, 102
- patent laws
 - differences among countries 3–4, 17, 58
 - first-to-invent *v.* first-to-file 72
 - extraterritorial reach 60–62
- patent misuse, *see* misuse
- “patent pending” designation 3
- patent prosecution, *see* patent applications
- patent searches
 - freedom to operate 130–133
 - patentability 31, 51, 83, 84, 104, 116–118
- patents
 - advantages and disadvantages of 14
 - defined 1, 2
 - design 23–24
 - dominating 2
 - eligibility criteria 3 *et seq.*
 - field-specific coverage 51
 - for business methods 4, 39, 58
 - for computer software ix, 3, 58
 - for life forms 3, 58
 - for medical methods 3, 58
 - for pharmaceutical compositions 58, 59
 - for research tools 59
 - for software code 40, 58
 - invalidation trials 111

- inventiveness requirement 6
- inventorship 105, 120
- issuance 3
- licensing 33
- monopoly distinguished 2
- non-obviousness 6
- novelty requirement 4–5
 - beta agreements and 5
 - divulgation 5
 - one-year grace period in US 4–5
 - public disclosure defined 4–5
 - “strict novelty” countries 4–5
- oppositions to 13, 109–111
- petty, *see* utility models
- priority date of 8, 12, 73
- procedures for obtaining 10 *et seq.*
- re-examination 104, 112
- reissue 104, 113
- rights of patentee 6
- term of 3
- utility requirement 58–59
- validity, presumption of 105, 111
- validity study 102–103
- v.* copyright 37 *et seq.*
- v.* trade secrets 29 *et seq.*
- paternity, right of 16
- petty patents, *see* utility models
- pre-trial discovery
 - depositions 26
 - expert witnesses 26
 - in civil law countries 26
 - interrogatories 26
- profits, lost 7
- publication
 - defensive 36
 - of patent applications 11–12, 132
- publicly available software, *see* open-source software
- Rambus Inc. 94
- reach-through royalties 160–162
- reasonable royalties, as measure of damages 7
- re-examination 104, 112
- reissue 104, 113
- representations, *see* warranties
- royalties, *see also* licenses
 - copyright royalties ix
 - rates 146 *et seq.*
 - based on special profits 147
 - Goldscheider’s rule 146
 - reach-through royalties 160–162
 - reasonable 7
- scènes à faire* doctrine 20
- searches, *see* patent searches
- secondary meaning 68
- security interests 122
- “small entity” status 135
- software, *see* computer software
- standards, *see* industry standards
- State Street* case 4
- Statute of Anne 15
- strategy, *see* intellectual property strategy
- Sun Microsystems Inc. 95
- trade names 65
- trade secrets
 - advantages and disadvantages of 23
 - defined 1
 - eligible subject matter 22
 - procedures for 22–23
 - v.* patents 29 *et seq.*
 - v.* copyright 40 *et seq.*
- trademarks
 - availability 65
 - choice of name 65
 - defined 1
 - dilution 67
 - likelihood of confusion 66
 - registration 69
 - registry, searching 65
 - secondary meaning 68
 - strength of 67
 - strategies 69
 - suggestive 67
 - trade names distinguished 65
 - v.* domain names 68
- Treaty of Rome 57, 149
- Uniform Commercial Code 124
- US Customs Service 57
 - recordal procedure 57
- US Department of Justice 148
- US Federal Trade Commission 148
- US International Trade Commission 57
 - exclusion orders 57
- US Patent and Trademark Office 4–5, 10, 85
- Universal Copyright Convention 17
- universities
 - and licensing x, 157 *et seq.*
 - spin-outs 158, 159
 - sponsored research 158, 159
- utility models 62 *et seq.*
 - strategic uses 64

Cambridge University Press

0521851068 - Intellectual Property for Managers and Investors: A Guide to Evaluating, Protecting and Exploiting IP

Steven J. Frank

Index

[More information](#)

170

Index

-
- validity of patents, *see* patents
 - valuation of intellectual property 162 *et seq.*
 - cost approach 165
 - income approaches 163
 - premium profit 164
 - relief from royalty 164
 - market approach 165
 - option pricing 165
 - problems with 162–163
 - value chain 47
 - relationship of patents to 82
 - warranties
 - and representations 145
 - breach of 124
 - implied 124, 145
 - non-infringement
 - withdrawal, right of 16
 - work for hire 72, 80