

ASME

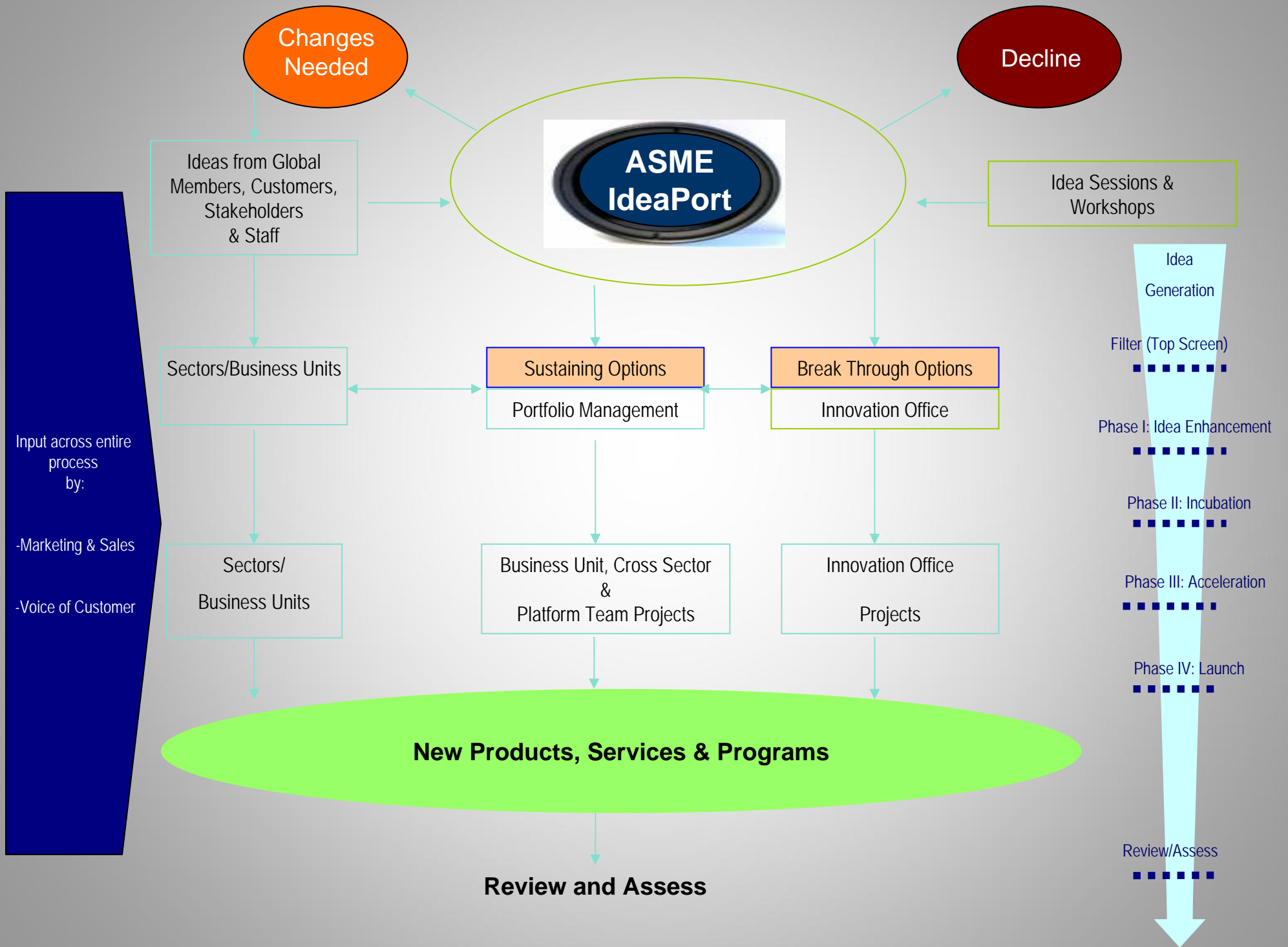
IP Issues in Innovation

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Disclosures

- I am not serving as your lawyer
- I am, however, pointing out some IP related issues ASME may face in its innovation initiatives

ASME Innovation Process



Interactions

- Improving operations of ASME
 - Sources
- Introducing new programs for ASME members
 - Sources
 - Income
- Introducing new programs for non-members
 - Sources
 - Income
- Providing funding for start-up operations of a new legal entity (not ASME, but possible partially or totally owned by ASME)
 - Sources
 - Income

IP Questions

- Who has the rights to the IP
- Who has the rights to the income stream (if any)?

What IP

- Patents
- Trademarks
 - Example: Innovation Showcase and I-Show
- Copyright
- Trade Secrets
- Web property

Patents

- Ownership defined in law (generally clear)
- Rights of use not necessarily the same as ownership (example: shop rights)
- ASME may see issues in start-ups and other “acquired activities”

Trademark

- Can be any mark used in commerce
- Use establishes the mark TM
- Federal Registration has significant advantages [®]
- ASME Innovation activities may create/protect trademarks

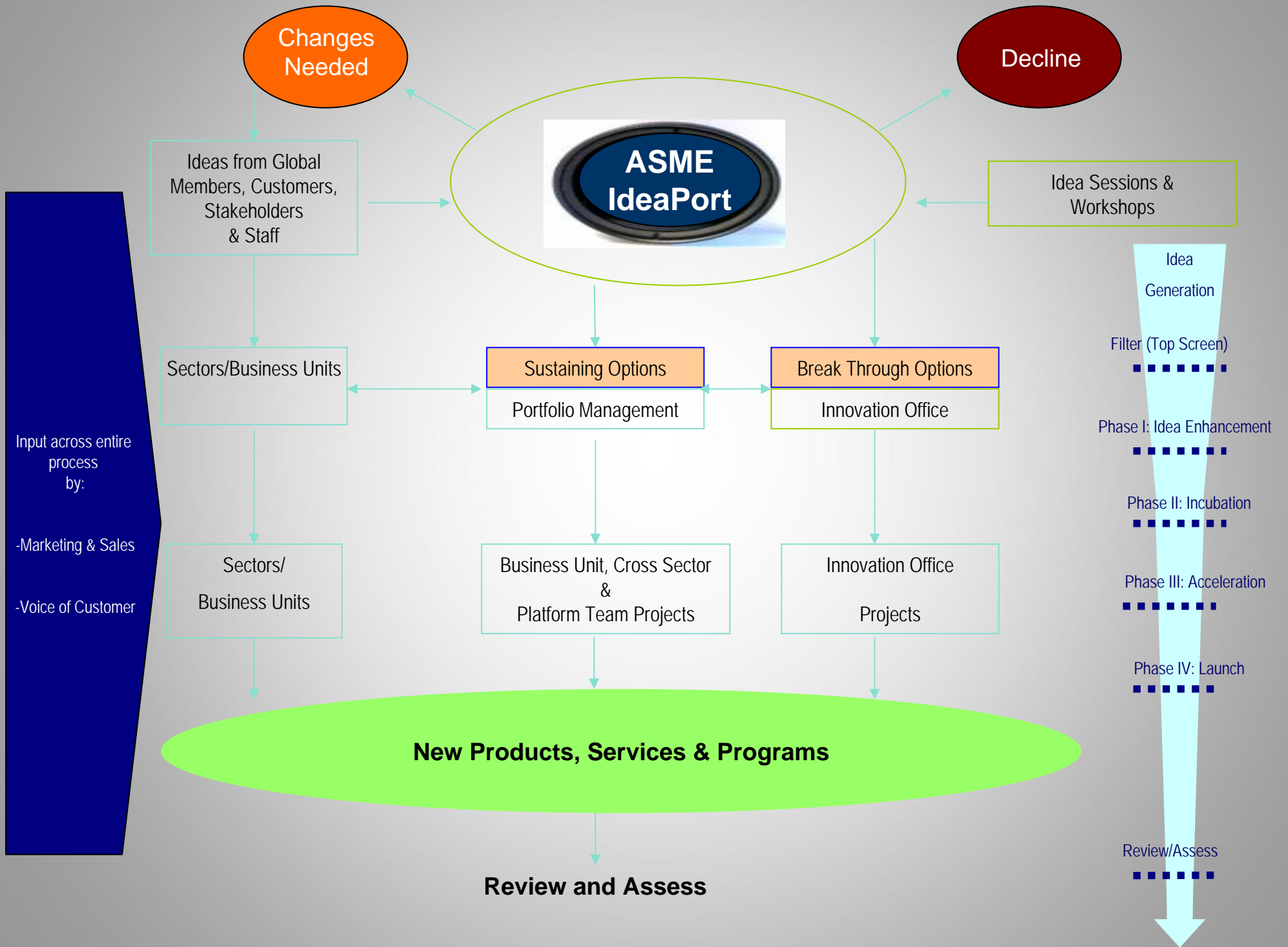
Copyrights

- Due to broad application and ease of creation, ownership is not always as clear as patents
- ASME will need to be disciplined in contracting © work to others to clearly define ownership and use
- Note: Federal Government does not create © work, but can acquire existing ©

Trade Secrets

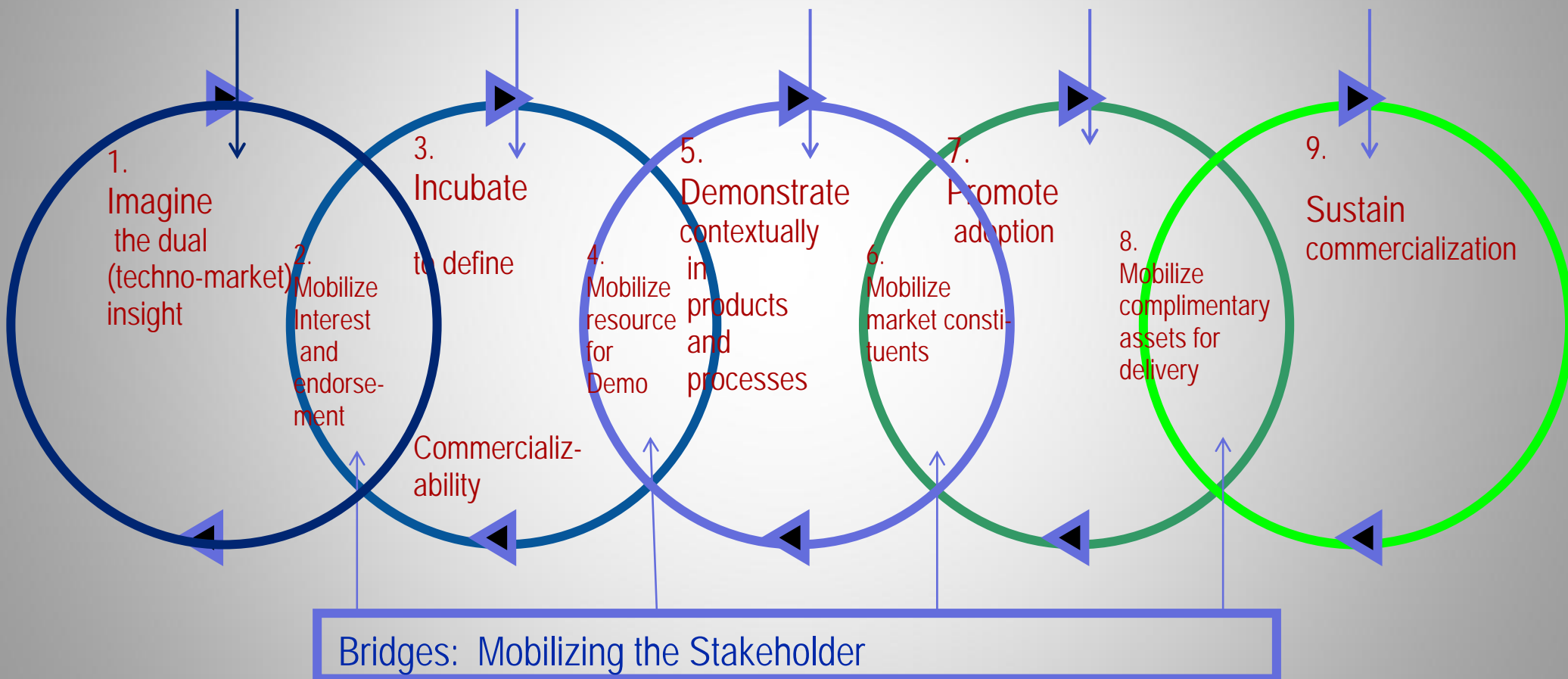
- Broad topic
- Protects secrets that provide a commercial advantage
- Requires reasonable efforts to protect
- Disclosures and confidentiality are two of the key issues
- Represents an area in which ASME should take some care in treating information provide by others

ASME Innovation Process



The Process of Technology Commercialization

Sub Processes: Building the Value of New Technology



Approaches

- Seek sound legal advice
 - Note: This presentation is not “sound legal advice”
- Provide clear communication
 - Examples:
 - Clearly disclose policies on the portal, on documents and at every entry
 - Don't execute NDA's on first discussion with a potential commercialization partner
 - Clearly express ownership in sponsorship/funding agreements
- Set expectations early in discussions
- Carefully train and monitor staff and volunteers
- Seek sound legal advice