

Index

- “Accelerating returns,” 85
- Advantaged networks, 50–53
- Advantaged networks of IP (ANIP), 51
- Agriculture, 280–281, 284
- Ampex Corporation v. Eastman Kodak Co.*, 156
- Annual reports, 179–180
- Assets, 277. *See also* IP asset sales
- AT&T Corp., 106, 155
- Auctions, 201–202
- Auction houses, 88
- “Automatic-injunction” rule, 235–236
- Bankruptcy remote entity (BRE), 90
- Banks, 237
- Bayh—Dole Act of 1980, 24–26
- Biotechnology, 278–279, 287
- “Blocking” strategy, 118
- BP, 183–184
- Brand, 285
- Branding culture, 279
- Brand promise, 183–184
- Brand value, 177, 184–185, 188
- Business ecosystem, 47
- “Business method” technology, 237–238, 240–242
- Business models, 31, 86–93
- Business needs, 152, 153
- Business strategy, 10–13
- Business-to-business (B2B) licensing, 286–289
- Business-to-consumer (B2C) licensing, 289
- Buying patents, 87–88
- Capital, 35, 256–257, 269–271, 277
- Capitalistic economic systems, 276–277
- Cash-equivalent, 108
- Chief executive officer (CEO), 4–7
- Chief IP officer (CIPO), 14, 63, 226–227
- Coase, Ronald, 24, 37, 39, 40
- Collaboration, 41
- Collaborative innovation, 54–55
- Comiskey*, 243
- Commercialization, 32, 33
- Commoditization pricing, 55
- Communication, 13–14
- Competition, 82–85, 257–258
- Concept, value proposition based on, 285–286
- Consulting firms, 35
- Contingent counsel partnerships (CCP), 208, 209
- Contract research organizations (CROs), 178
- Coordination, 32–33
- Corporate pools, 208, 209
- Cost valuation, 110
- Courts, 25–27, 59–60, 76, 93, 170–173, 237. *See also*
 - Federal Circuit; U.S. Supreme Court
 - Court of Appeals for the Federal Circuit (CAFC), 26–27, 83, 242
- Cross-licensing agreements, 33, 118–119
- Cumulative innovation, 145
- Damage awards, 67, 94–95, 205–206
- “Dark pools of liquidity,” 84
- Dedicated business (DB), 208, 209
- Detectable art, 153–154
- Developing, patenting and enforcing inventions (DPEIs), 91–92
- Differentiation, 179–180
- Direct IP investors, 69, 71, 72, 74
- Discounted cash flow (DCF) model, 108–110
- Disney, 289–290
- Divestiture, of patents, 15–16
- “Drug addiction,” xvii, 156–157
- eBay v. MercExchange*, 67, 93, 163, 235
- Economic systems, 291
- Ehlsch, Thomas, 22–24, 67
- Employment Retirement Income Security Act (ERISA), 25
- Engineering degrees, 98
- Eolas Technologies Inc. v. Microsoft Corp.*, 146
- Exclusive field-of-use licenses, 228–230
- Expected cash flows, 108
- Fabless semiconductor manufacturers, 29–31
- Fair value reporting, 112
- Federal Circuit, 164, 243. *See also* Court of Appeals for the Federal Circuit
- Federally-funded research, 25–27
- Field-of-use licenses, 228–230
- Financial industry patents, 233–251
 - desirable attributes of, 238–244
 - and market-structure joint ventures, 244–250
 - risk management of, 234–238
 - valuation of, 250–251
- Financial objects, 277
- Financing, 255–272
 - case studies/examples, 262–270, 272
 - and competition, 257–258
 - cost comparison of, 269–271
 - growth of, 261–262
 - and hedge funds, 258–259
 - landscape for, 266–271
 - and leverage in acquisitions, 259–260
 - in new economy, 259–260
 - private-equity trends in, 257
 - resistance to, 261
 - and subprime credit crisis, 257–260
- First mover advantage, 4, 145

- “Freedom to practice,” 149
- Freeware, 40
- Gathering2.0, 225
- Generally Accepted Accounting Principles (GAAP), 70, 112, 179
- Global differentiation, 179–180
- Global Regulatory Information Database (GRID), 247–248
- GNU public license (GPL), 40
- Governance, 137–139
- Hedge funds, 258–259
- Hewlett-Packard (HP), 127–129, 149
- IBM, 5, 67, 145, 146, 149, 150
- Income valuation, 110
- Individual patent owners, xix, 8
- Industrial economy, 21–27
- Information and communication technology (ICT), 278, 280, 283, 286, 288–289
- Infringement damage recoveries, 94, 121
- Injunctive relief, 93
- In-licenses, 34
- Innovation, 31, 32, 72
- Innovation networks, 37, 38
- Innovation platform, 287–288
- In re Bilski*, 237, 248
- Intangibles, 177, 180–181
- Integrated device manufacturer (IDM), 28, 29, 31, 33
- Intellectual asset management (IAM), 277–278
- Intellectual capital management (ICM), 277, 278
- Intellectual property (IP), 4–7, 22, 23, 32–33, 39–40, 179–180, 282
- Intellectual Property Exchange International (IP Exchange), 202–203
- Intellectual property management (IPM), 277, 278
- Intellectual property rights (IPR), 61, 276–280
- Intellectual value chain (IVC), 282–283
- Intellectual Ventures (IV), 70, 75, 209
- International Accounting Standards, 181
- Internet, 37
- InterTrust, 222–223
- Inventions, 59
- Invention factory model, 22, 23, 33
- IP acquisition aggregators, 92–93
- IP asset sales, 193–211
 - evolution of, 194–196
 - and licensing process, 196–197
 - market momentum for, 205–206
 - marketplaces for, 197–203
 - new market participants in, 207–210
 - and R&D cuts, 203–205
 - technological enhancement of, 206–207
- IP-based analysis and advisory services, 87
- IP-based business models, 86–93
- IP cash, 130–132
- IP ecosystem re-engineering, 45–55
 - and advantaged networks, 50–53
 - and collaborative innovation, 54–55
 - and profit pool positioning, 47–50
 - and strategy vs. tactics, 46–47
- IP financial firms, 90–91
- IP holding company, 67, 228
- IPI Financial Services, 262, 265
- IP Innovations, 91
- IP investing, 57–78
 - CEO’s challenge with, 74–78
 - disagreement over, 58–60
 - diversity of, 61–63
 - and percentage of assets in IP, 63–67
 - and RoIP, 72–74
- IP investment banker, 227–231
- IP investors, motivations/expectations of, 68–71
- IP markets and marketplace, 197–203
- IP risk, 217–221
- IP strategic value, 130–132
- IP strategy:
 - alignment of business and, 16–17
 - in changing business environment, 8–10
 - changing role of, 127–129
 - considerations for, 152–157
 - ecosystem re-engineering, 46–47
 - evaluating, 157–158
 - licensing as, 8–10, 156–157
 - litigation as, 155–156
 - and overall business strategy, 10–13
 - purchasing as, 154
 - structuring, 23
- IP value, 130–132, 221–226
- Joint patent holdings, 51
- Joint ventures (JVs), 244–250
 - cur bias, 170
- Kamen, Dean, 33, 34
- Kevlar, 83
- Knowledge-based business models, 283–290
- Knowledge economy, 275–291
 - business models in, 283–290
 - future of, 290–291
 - IPR in, 276–280
 - transformation to, 280–283
- Kodak, 150, 156
- KSR v. Teleflex*, 93, 164
- Legislation, patent, *see* Patent legislation
- Leverage, 259–260, 288–290
- Licensing:
 - B2B vs. B2C, 288–289
 - capitalizing content through, 289–290
 - financial goals of, 135–136
 - governance process for, 137–139
 - growth of, 83–84
 - in industrial economy, 22, 23
 - in modern economy, 33–36
 - in open economy, 40–41
 - process of, 196–197
 - revenue recognition of, 132–135
 - structural cost differential imposed with, 150
 - valuation through, 116–118
 - “win-win,” 9–10
- Licensing agents, 88
- Licensing negotiations, 93
- Liquidity, 84, 239

- Litigation, 161–174
 changes in, 162–163
 investing in, 75–76
 quantity of, 85, 94
 recent awards/settlements in, 6, 95, 96
 as reform driver, 82
 risk/reward analysis with, 165–171
 rules of, 163–165
 statistics about, 171–173
 willingness to engage in, 155–156
- Litigation finance and investment firms, 89–90
- Madey v. Duke*, 8
- Market-structure joint ventures, 244–250
- Material value chain (MVC), 281–282, 290–291
- MedImmune v. Genentech*, 93
- Merchandising, 289–290
- Mergers and acquisitions (M&As), 215–231
 barriers to IP value analysis in, 223–226
 changing perceptions of IP assets in, 216–217
 CIPO's role in early-stage, 226–227
 IP as leverage in, 259–260
 IP-investment-banker's role in, 227–231
 IP-risk focus of first-generation, 217–221
 IP-value focus of second-generation, 221–223
- Metrics, 130–132
- Michelson v. Medtronic*, 206
- Microsoft, 62, 146, 150–151, 155, 197, 206
- Middlemen, 35
- Modern economy, 24–36
 disaggregation of, 24–25
 IP's role in, 32–33
 and licensing, 33–36
 nature of technology firm in, 27–32
 transition from industrial to, 24–27
- Monsanto Company v. McFarling*, 205
- Monte Carlo Method, 113
- Music industry, 283
- Myhrvold, Nathan, 209–210
- N-Compass, 51, 52
- Noninfringing alternative design, 110–111
- Non-practicing entities (NPEs), xix, 19, 57, 61, 62
- NTP, 8, 163–164, 207
- NW Patent (NWP) Funding, 90
- “Obviousness,” 93, 243
- Online exchanges, 88
- Online listing services, 199–201
- Open Document Format (ODF), 53
- “Open” economy, 36–41
- Open innovation, 36, 37, 39, 41, 288
- Open Innovation Network (OIN), 51
- Openness, 41
- Open source software (OSS), 39–40, 51
- Operational risk, 234
- Out-licenses, 34
- “Over-coverage,” 15
- Ownership rights, 277
- Paine Webber vs. Merrill Lynch*, 238
- Paradox Capital, 91, 265
- Passive IP investors, 69–72, 74
- Patents:
 as barriers to entry/competition, 146–149
 as exclusionary devices, 22
 incentivizing technology with, 246–247
 inventions vs., 59
 lapse of, 63–64
 number of U.S. utility, 9
 standards incorporated into, 154–155
- Patentable subject matter, 242–243, 248
- Patent allowance rate, 97
- Patent analytic tools, 87
- Patent applications, 96–97, 237–238, 240
- Patent-as-asset approach, 236, 239, 240
- Patent-as-hedge approach, 238, 239
- Patent-based licensing firms, 88–89
- Patent brokers, 87–88
- Patent brokerage, 12, 15
- Patent competition, 82–85
- Patent disclosure, 41
- Patent enforcement, 4–5
- Patent families, 12, 13
- “Patent importance,” 177
- Patent infringer, 169–170
- Patent lawyers, 13
- Patent legislation
 abuses of, 85
 as barriers to openness/innovation, 39
 industrial issues with, 22
 as infrastructure for productivity/innovation, 40–41
 proposed, 164–165
 reforming, 93–99
- Patent licensing and enforcement companies (PLECs),
 89, 207, 210
- Patent life, 146–149
- Patent owner, 166–168
- Patent pendency, 65, 237–238, 240–241
- Patent portfolios, xix, 149–153
- Patent protection, 153–154
- Patent ratings services, 87
- Patent reform, 81–100
 drivers of, 82–85
 and IP-based business models, 86–93
 legislation for, 93–99
 mythical claims about, 85–86
 Supreme Court's influence on, 93
- Patent sale information, 224–226
- Patent search services, 87
- Patent speculators, xix, 7–8. *See also* “Trolls”
- Patent valuation, 105–123
 approaches to, 110
 categorizing, 143–144
 DCF model of, 108–110
 of financial services patents, 243–244, 250–251
 GAAP requirements for reporting, 112
 by Monte Carlo method, 113
 practical application of, 121–123
 by proprietary/semi-proprietary methods, 111–112
 by relief-from-royalty method, 111
 by return-on-assets-employed method, 111
 and sources of value, 113–121
 synthesizing/reconciling values derived from, 110–111

- Patent valuation, (*Continued*)
 techniques of, 108–113
 technology valuation vs., 142–143
 by 25 Percent Rule, 112–113
 uncertainties about, 106–107
- Pension funds, 25
- Pfizer, 62, 178, 203
- Pharmaceuticals, 64, 66, 178
- Physical product, 284–286
- Porter, Michael, 24
- Portfolio diversification, 25
- Practicable alternatives (PA), 114–115
- Predictiv/CCW methodology, 188, 189
- Present value, 109
- Prior art, 59
- Private equity (PE), 257
- Private inventors (PI), 208
- Procter & Gamble (P&G), 37, 38, 54–55
- Product, 284–286
- Profit, vii, xviii
- Profit contribution ratio (PCR), 114
- Profit pool positioning, 47–50
- Property, 277
- Proprietary valuation, 111–112
- “Prudent man,” 25
- Public scrutiny, 170
- QUALCOMM, 35, 91
- Reasonable and non-discriminatory (RAND) rates, 154
- Re-engineering, of IP ecosystem, *See* IP ecosystem re-engineering
- Regulatory DataCorp. International LLC (RDC), 246–248
- Relief-from-royalty valuation, 111
- Remaining life of the patent, 108
- Rembrandt Management IP, LLC, 89–90
- Reputation, 175–189
 and brand promises, 183–184
 decision making about, 188–189
 as global differentiator, 179–180
 measurement of, 184–188
 perceptions of, 177
 quantifying, 181–183
 reemergence of, 176–178
 and stockholder value, 180–181
- Research and development (R&D):
 cuts in, 203–205
 federally-funded, 25–27
 inputs/outputs to, 31
 IP licensing for funding of, 34
 as product and business development platform, 286–288
 spending on, 59, 61–62, 66
 sustainability of pure, 151–152
 valuation of, 121
- Research institutions, 8
- Research tools, 287
- Return-on-assets-employed valuation, 111
- Return on intellectual assets, xviii
- Return on IP (RoIP), 57, 62, 68, 72–74
- Revenue recognition, 132–135
- “Right to exclude,” 146
- RIM, xviii, 8, 163, 207, 235
- Risk management, 234–238
- Risk/reward analysis, 165–171
- Royalties, xviii, 4
- Royalty securitization, 90
- Science, 97–99
- Scope, patent’s, 144–145
- Scrubbing methodology, 249–250
- Sears, 72, 73
- Second-pair-of-eyes review process, 242
- Selling patents, 87–88
- Semi-proprietary valuation, 111–112
- Silicon integrated circuit, 27–30
- Small businesses, xix, 31, 32, 38
- Small Business Administration (SBA), 31, 32
- Special purpose investment (SPI), 208, 209
- Standards, 120, 154–155
- Startup companies, 92
- State Street Bank decision, 237
- Stockholder value, 180–181
- Stock price, 170
- Stranded technology, 229–230
- Strategic IP investors, 69
- Strategy, IP, *See* IP strategy
- Subprime credit crisis, 257–260
- Substitution alternatives, 144, 146–149
- Sun Microsystems v. Microsoft*, 206
- Supply chain, 29, 31, 34
- Supreme Court, *see* U.S. Supreme Court
- Sustainable business model, 151–152
- Technological arts test, 242
- Technology, 99, 142–143, 171, 178, 246–247
- Technology acquisition, cultivation, and licensing (TACL), 229–231
- Technology factor method (TFM), 111–112
- Technology firms, 19–42
- Technology pools, 208, 209
- Texas Instruments (TI), 33, 67, 197
- 3M Company, 146–148
- Time value of money, 109
- Toyota, 51, 53
- Trade secrets, 242
- Transparency, 41, 71
- “Trolls,” xix, 7–8, 61, 81–82, 86, 155
- 25 Percent Rule, 112–113
- U.S. Congress, 60, 96
- U.S. Constitution, 7, 61, 62, 86, 100
- U.S. Patent and Trademark Office (USPTO), 59, 60, 85, 95–99, 237, 239–242
- U.S. Supreme Court, 67, 163–164, 234–236
- Universities, xix, 8, 27
- Valuation, patent, *see* Patent valuation
- Value chain, 29, 30, 280–283
- Value sources, 113–121
- Venture capital, 25, 27, 34, 92
- Virtual partners, 237
- Virtual products, 288–289
- Wealth formation, 276–277
- Wiki-economy, 37
- “Win-win” licensing, 9–10, 12
- Wright, Orville and Wilbur, 22, 23