

# The Team – an external IP advisor perspective

**Tim Hargreaves**  
Marks & Clerk LLP

Patent and Trademark Attorneys

September 2019

# Examples of IP

Patents

Trade marks

Trade secrets

IC topography  
rights

Registered  
designs

Copyright

Database  
rights

Know-How

Unregistered  
Designs

# The IP team



# The IP team

- Vital that IP strategy is aligned with company strategy. The CEO/investors should know what the IP strategy is and be confident that it is being implemented
- IP can arise from many aspects of the business. A basic knowledge of IP can be very valuable for many roles (finance, marketing etc) - it should not just be left to the technical team
- Within the technical team itself, communication as to the importance of IP is vital – educate, motivate, reward
- IP is not easy to create and its value can easily be destroyed

## Examples – good/bad team communication

- EXAMPLE 1 New idea – can we patent it?
- Quick internet search – idea had been disclosed by the marketing team on the company's own website
- Still possible to obtain patent in US, but not Europe and most other countries



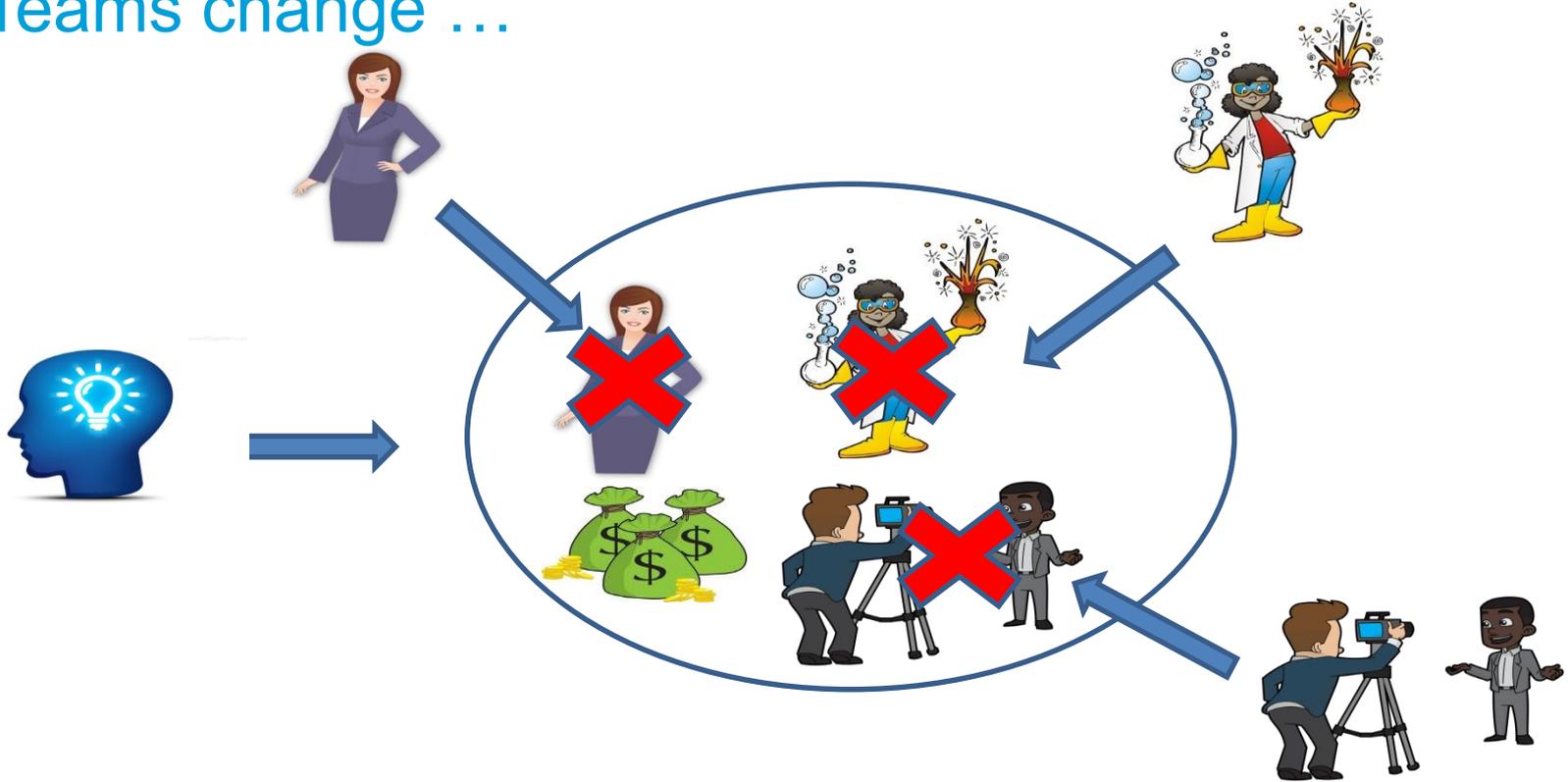
- EXAMPLE 2 New idea can we patent it?
- Patent application filed
- Search report – prior presentation given by inventor himself cited



- EXAMPLE 3 Sensing technology – oil industry
- Clear communication between management, finance and inventor(s)
- Large and highly focused patent portfolio
- Clear commercial strategy and target purchaser(s) - High value sale



# Teams change ...

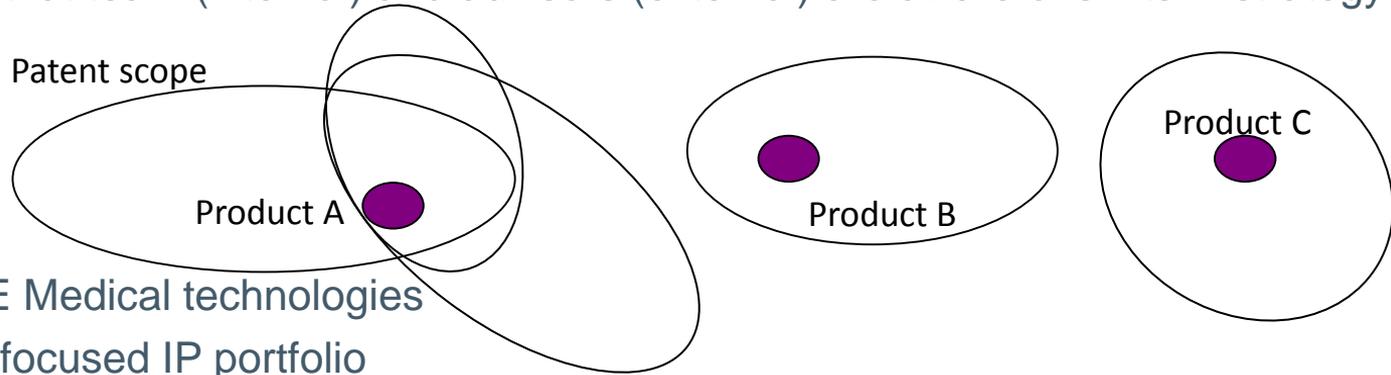


# Teams change

- Ensure that key knowledge/contacts/relationships do not work out of the door with employees
- Contracts
- Good records
- Good communication
- Role of external advisors
  
- EXAMPLE TV/entertainment systems for hospitality industry
- Heavily funded by private equity - Heavy investment in technology
- But, then change in CEO, CTO and other senior management in short period
- As external IP advisors we ended up being repository of most knowledge of IP strategy and technology

# Strategies change

- Patenting process is lengthy and multi-jurisdictional
- Important that IP strategy remains aligned with products and with business strategy
- Important that team (internal) and advisors (external) are aware of shifts in strategy



- EXAMPLE Medical technologies
- Small but focused IP portfolio
- Bought by large multinational - heavy investment in IP, heavy investment in technology team
- Successful retention and motivation of much of existing team despite large business and cultural shifts

## The external team – professional advisors

- As a young company do not underestimate your value as a client
- Professional advisors can add value beyond their core tasks (and without cost!)
- Keep your external advisors informed, not siloed
- Bear in mind that your professional advisors may be involved for longer than any individual (even senior) employees
- External advisors may end up being a very useful repository of knowledge about the company's history and strategy
- Professional advisors are usually very happy to share their knowledge – take advantage of this!
- Professional advisors generally have networks different from your own – use them
- With IP in particular, ensure that IP strategy keeps up to date with changes in the business

# Contacts

**Dr Tim Hargreaves**  
thargreaves@marks-clerk.com  
Phone: 0131 221 7000

Marks & Clerk  
40 Torphichen Street  
Edinburgh  
EH3 8JB