

**2018 FICPI WORLD CONGRESS  
PLENARY #2: EXPANDING THE ROLE OF IP  
ATTORNEYS IN THE CHANGING WORLD**

**HOLISTIC TREATMENT OF INTELLECTUAL PROPERTY  
PORTFOLIOS FROM THE IN-HOUSE PERSPECTIVE –  
FIVE MAXIMS**

**JUNE 6, 2018 – TORONTO, CANADA**

**JAMES DONALD SMITH**

# **MAXIM ONE: IT IS NEVER REALLY ABOUT THE INTELLECTUAL PROPERTY ITSELF.**

**THE VARIOUS FORMS OF INTELLECTUAL PROPERTY ARE BUSINESS TOOLS, THEY ARE NOT THEMSELVES THE OBJECTIVE.**

## **CONVERSATION SNIPPET**

**BUSINESS PERSON:** HEY, IP LAWYER, MAYBE I AM GLAD WE HAVE [INSERT ANY PARTICULAR FORM OF IP HERE], BUT WHAT DOES HAVING IT COST ME, AND WHAT IS ITS ACTUAL VALUE TO MY BUSINESS?

**JAMES:** WE HAVE THE IP – IN WHATEVER FORM –TO HELP YOU MAKE MORE MONEY; THAT IS THE VALUE, AND THE COST OF THE IP PROTECTION IS MUCH LESS THAN THE AMOUNT OF ADDITIONAL MONEY IT WILL HELP YOU MAKE.

**MAXIM TWO: ANY INTELLECTUAL PROPERTY HELPING TO SERVE THE LARGER OBJECTIVE IS GOOD.**

**NO FORM OF INTELLECTUAL PROPERTY IS INHERENTLY MORE WORTHY THAN ANY OTHER ; WORTHINESS ARISES FROM IN-CONTEXT USEFULNESS .**

**CONVERSATION SNIPPET**

**RESEARCH & DEVELOPMENT PERSON: I AM SO DISAPPOINTED THAT WE ARE OPTING FOR TRADE SECRET RATHER THAN PATENT PROTECTION; I WANT MY NAME ON A PATENT.**

**JAMES: WHY? DO YOU WANT YOUR NAME ON A PATENT OR ON THE BIG MONEY THE SECRET WILL HELP THE COMPANY MAKE? THINK HIERARCHY OF DOLLARS NOT IP TYPES.**

**MAXIM THREE: INTELLECTUAL PROPERTY  
INDICATIVE OF SOURCE MAY BE MORE POWERFUL  
THAN IP BORNE OF TECHNICAL BRILLIANCE.**

**FOR POTENTIAL BUYERS, SOURCE IS ALMOST ALWAYS EASIER TO IDENTIFY THAN  
TO OBTAIN PRODUCT DETAILS – AND, IN A GIVEN CONTEXT, TRADEMARKS MAY BE  
THE IP THAT ACTUALLY DELIVERS THE BIG MONEY FOR THE IP OWNER.**

**CONVERSATION SNIPPET**

**RESEARCH & DEVELOPMENT PERSON: IP LAWYER, WHY ARE YOU ALWAYS  
RUNNING AROUND TRYING TO DEAL WITH THOSE MARKETING PEOPLE AND THEIR  
INANE MARKS, OUR GENIUS TECHNOLOGY IS WHAT DRIVES OUR SALES?**

**JAMES: HMM. ARE YOU SURE OF THIS? I HEARD THE CUSTOMER HAS ALREADY  
PUT IN A BIG ORDER FOR YOUR IMPROVED VERSION SIMPLY BECAUSE THE  
CUSTOMER KNOWS IT COMES FROM YOU.**

**MAXIM FOUR: OPERATIONALLY, IP SHOULD LESS OFTEN BE THOUGHT OF (I.E., GROUPED) BY TYPE AND MORE IN TERMS OF BUSINESS FRANCHISES.**

**IP ASSETS OF A PARTICULAR FORM AND OWNED BY THE SAME COMPANY ARE LIKELY LESS RELATED TO EACH OTHER THAN TO ASSETS OF ANOTHER FORM THAT CAN BE UTILIZED TO HELP THE SAME BUSINESS FRANCHISE MAKE MORE MONEY.**

#### **CONVERSATION SNIPPET**

**ELITIST PATENT:** LOOK, IP LAWYER, I ONLY SOCIALIZE WITH OTHER PATENTS; IF THOSE TRADE SECRETS AND TRADEMARKS CROSS OVER INTO OUR PATENT TURF, IT WON'T BE PRETTY.

**JAMES:** NO, ELITIST PATENT, DON'T BE A SEGREGATIONIST BY IP TYPE. EMBRACE THE IP MOSAIC ASSOCIATED WITH THE BUSINESS YOU SUPPORT. THE AFFILIATION WITH OTHER, SIMILARLY-PURPOSED IP IS THE AFFILIATION THAT REALLY MATTERS BECAUSE, WORKING TOGETHER, YOU CAN HELP THE COMPANY MAKE MORE MONEY FOR THAT BUSINESS.

**MAXIM FIVE: IN-HOUSE IP LAWYERS MUST KNOW THE PARTICULAR IP THAT IS OF A FRANCHISE, AND CAN HELP THAT PARTICULAR FRANCHISE.**

**THE IP LAWYER MUST KNOW TO WHICH FRANCHISES THE VARIOUS DIFFERENT IP ASSETS RELATE, BECAUSE . . . BEFORE THOSE ASSETS CAN BE THOUGHT OF TOGETHER, AND USED IN CONSORT ADVANTAGEOUSLY, ONE MUST KNOW OF THEIR EXISTENCE AND PRECISE RELATION TO THE BUSINESS' FRANCHISES.**

**CONVERSATION SNIPPET**

**BUSINESS PERSON: I DON'T KNOW ABOUT ALL THIS IP STUFF; DO WE NEED IT FOR MY PARTICULAR BUSINESS UNIT? CAN YOU TELL WHICH OF IT MATTERS FOR ME AND HOW WE CAN BETTER USE IT?**

**JAMES: OF COURSE; THAT IS WHAT WE DO. :O)**

Thank you!

**JAMES SMITH**