

Teaming Up with US/EU Patent Attorney in Tech Transfer

Joseph Chang

Vice President, Technical Analysis Group, Transpacific IP
Singapore

Takamitsu Shigetomi

Partner Attorney at Law (Japan/New York), Patent Attorney
Oh-Ebashi LPC
Osaka, Japan

Robert L. Norton (Moderator)

Attorney, Fox Rothschild LLP
New York, NY

Introduction / Panel



- **Joseph Chang**

Joseph manages Transpacific IP's Technical Analysis Group, responsible for supporting the company's initiatives across its entire spectrum of offerings - focusing on invention mining, patent development, and patent monetization.

Joseph's technical experience is expansive, including knowledge of and expertise in semiconductor manufacturing, optical electronics, image processing, computer/system architecture, networking and wireless technologies. Prior to joining Transpacific IP, Joseph worked at notable Taiwanese patent law firms, where he handled more than 600 inventions patent drafting work for major Taiwanese companies and research institutions, such as AUO, TSMC, ITRI and MediaTek.

With more than 10 years experience in IP focusing on engineering and technology, Joseph is frequently asked to speak at universities in Taiwan and around the region to address IP related topics. Joseph earned a Bachelor of Arts in Applied Chemistry from the National Chiao Tung University (NCTU) with a specialty in Optical Electronics.

Introduction / Panel

- Takamitsu Shigetomi



Mr. Takamitsu Shigetomi is a partner of Oh-Ebashi LPC & Partners and is in charge of intellectual property practice department.

Mr. Shigetomi is specialized in intellectual property licensing (including technology transfer matters) and litigation of all types and has prepared, tried and argued intellectual property cases in various fields including mechanical engineering, electric engineering, computer software, pharmaceuticals, biotechnology and chemistry.

Mr. Shigetomi is a frequent author and lecturer on intellectual property practice topics, and an adjunct assistant professor of Graduate School of Intellectual Property at Osaka Institute of Technology.

Introduction / Moderator

- Robert Norton



B.A. in Biological Sciences from University of Connecticut and J.D. from St. John's University School of Law.

For over a decade, he has helped clients, ranging from individuals to major corporations, protect and maximize intellectual property rights.

Robert handles patent prosecutions, licensing, opinion drafting and litigation and has extensive experience obtaining patent and trademark registrations and negotiating and drafting various licensing agreements and validity and non-infringement opinions.

Further, he has served as primary U.S. counsel to many Japanese corporations with various legal matters outside of intellectual property.

Selecting and Working with Counsel

A) Prosecution

1)US

2)EU

-Cost, technological expertise, docket management responsibility, direct/indirect communication, language capability, and billing flexibility.

Selecting and Working with Counsel

B) Licensing

1)US

2)EU

- Initial inquiry, marketing, exclusive/non-exclusive, conflicts issue, lead in negotiation, meeting, cost (contingency), and global license.

Selecting and Working with Counsel

C) Litigation

1)US

2)EU

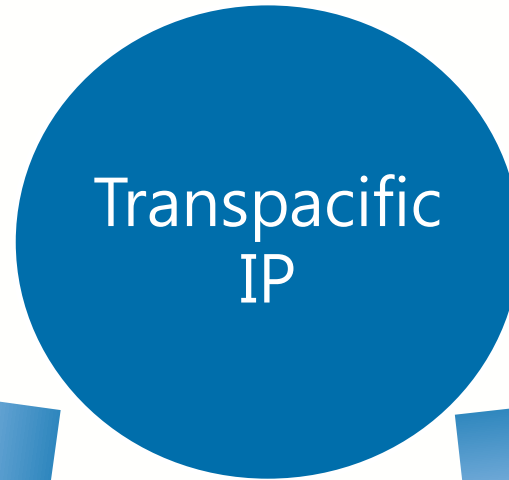
- Cost, licensee, contingency, cease and desist letter (warning), venue selection, language capabilities, and settlement.

TEAMING UP WITH US/EU PATENT ATTORNEY IN TECH TRANSFER

Joseph Chang
Vice President
Technical Analysis Group



- THE FASTEST GROWING
- IP MARKET IS HERE.
- FORTUNATELY, SO ARE WE.



More than 100 employees

- Patent engineers
- Technical & market analyst
- Attorneys & business specialists

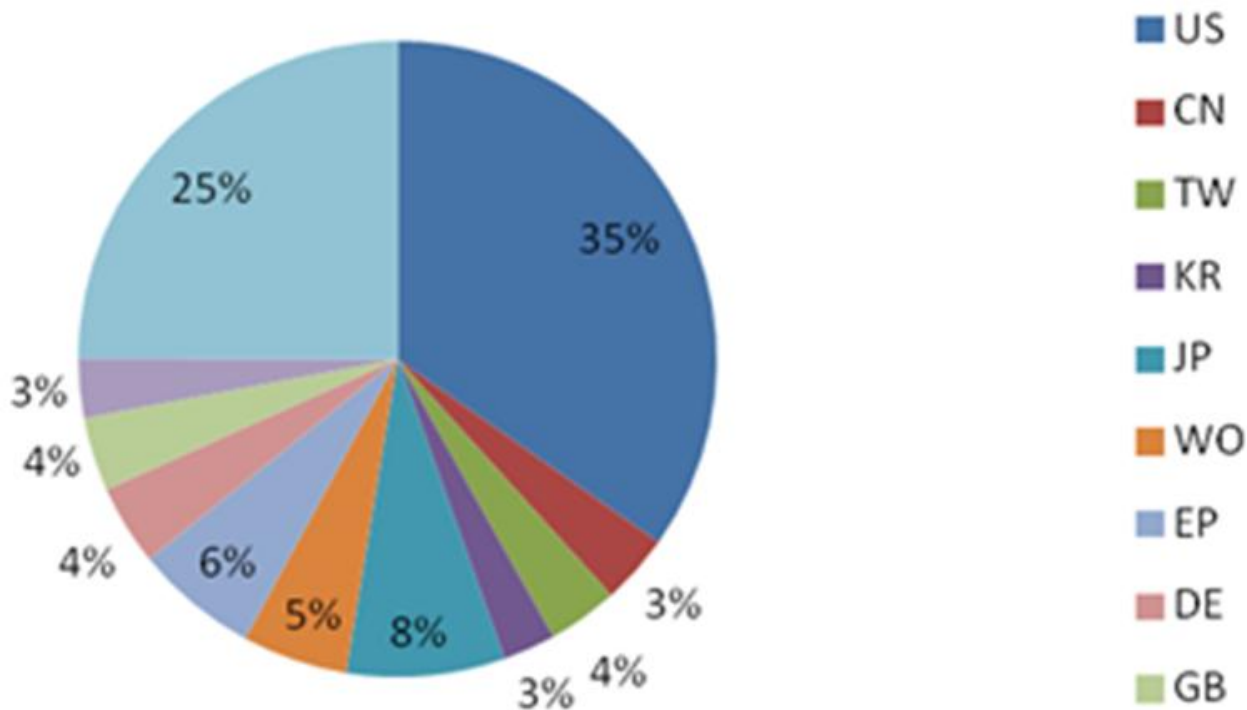
More than 100 external experts

- Technology & field experts

Technologies

- Telecommunications
- Consumer electronics
- Information technology
- Software/hardware
- Biomedical
- Green technologies

	DD service	Deal + DD services/experiences	total
# Deals	450+	200+	650+
# Patent Families	10,000+	7,000+	17,000+
# Patent Assets	44,000+	18,000+	62,000+



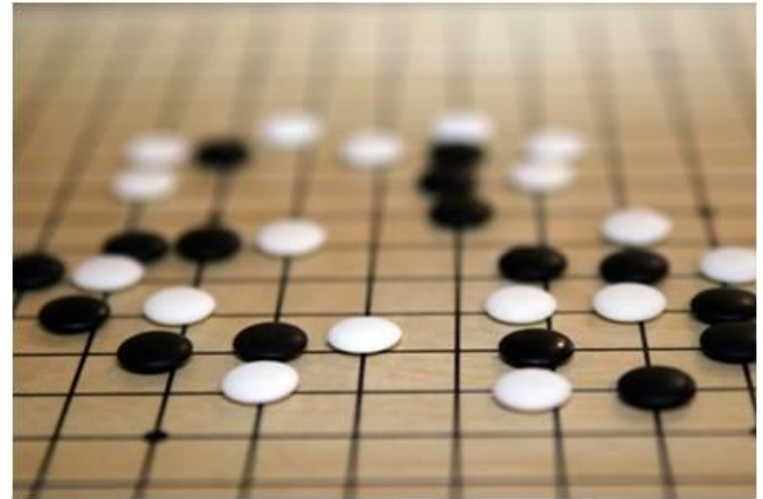
TRANSACTIONS

- Patent & Technology Acquisitions
- Patent & Technology Sales
- Patent & Technology Licensing
- Brand Licensing



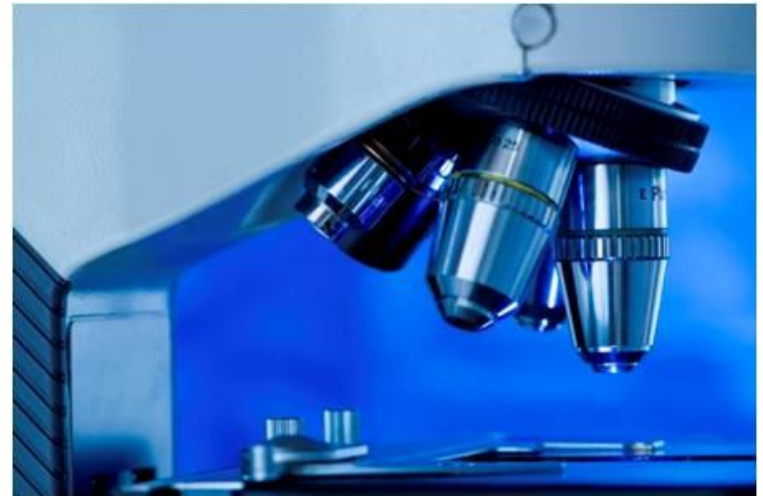
STRATEGY

- Portfolio Development
- Portfolio Management
- Commercialization
- Competitive Intelligence
- Technology
Landscaping/Mapping



ANALYTICS

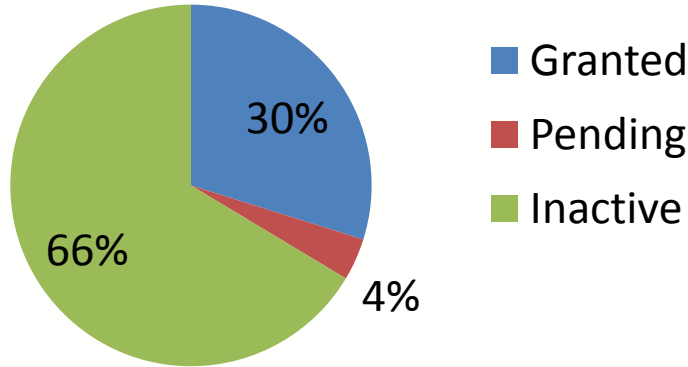
- Claims Analysis
- Prior Art Search
- Due Diligence
- Valuation
- Litigation Support



PATENT LAW FIRM PERFORMANCE EVALUATION (SAMPLE)

For Period Q2 2012 to Q3 2012

ALL BY CASE STATUS Count



PENDING BY COUNTRY

Country	JP	TW	CN	US	KR	PCT	EU	HK	AU	GE	GR	CA	FR	IN	MA	RU
Count	284	148	56	56	36	7	4	3	2	2	2	1	1	1	1	1

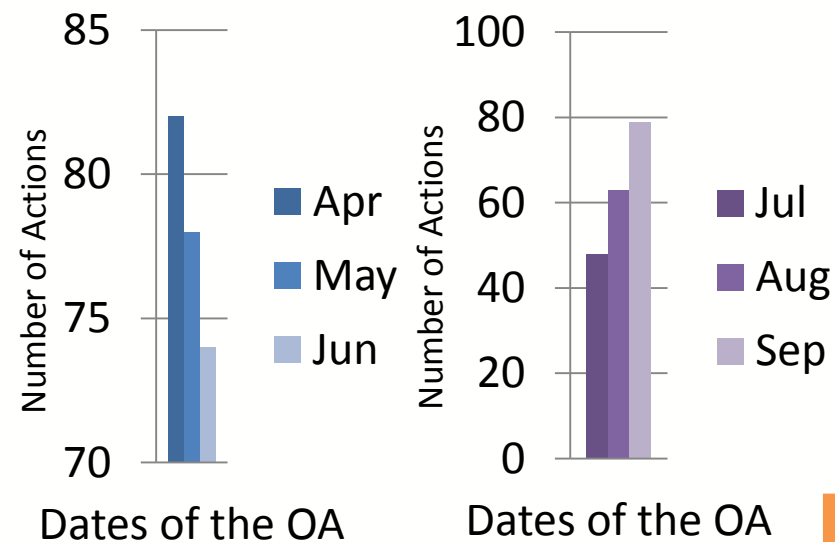
PENDING BY PORTFOLIO MANAGER

Portfolio Manager	PM #1	PM #2	PM #3	PM #4	PM #5	PM #6	PM #7	PM #8
Count	254	122	74	51	38	29	26	11

SUBMISSIONS

Q2 2012

Q3 2012



SUBMISSIONS BY TYPE

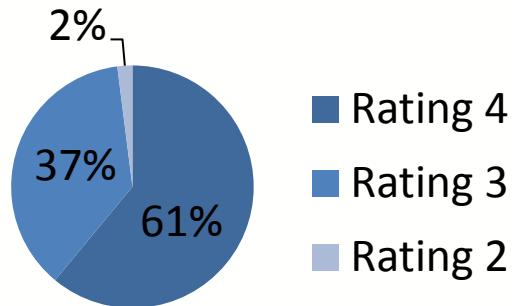
Action Type	2012					
	Q2			Q3		
	Apr	May	Jun	Jul	Aug	Sep
Office Action	53	57	37	22	36	45
Final OA	11	4	8	6	4	1
NOA/ Cont'n/ Div'l	15	12	18	16	17	25
Other	3	5	11	4	6	8
Grand Total	82	78	74	48	63	79

SUBMISSIONS BY P.M.

Portfolio Manager	Previous Qtr	This Qtr	Total
PM #1	81	82	163
PM #2	41	37	78
PM #3	39	28	67
PM #4	23	9	32
PM #5	19	13	32
PM #6	18	8	26
PM #7	9	4	13
PM #8	5	8	13

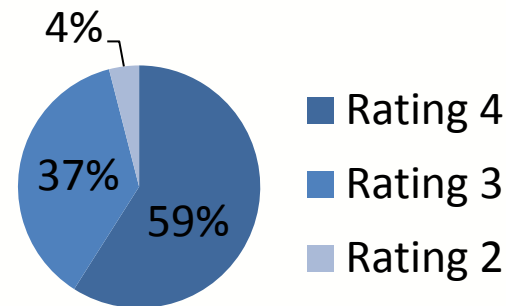
Q2 2012*

Your Firm

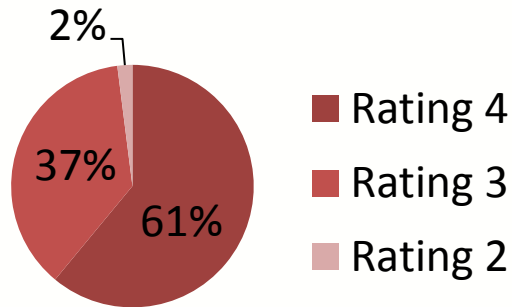


Q3 2012**

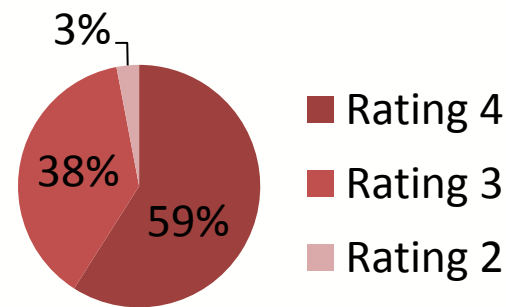
Your Firm



All Firms

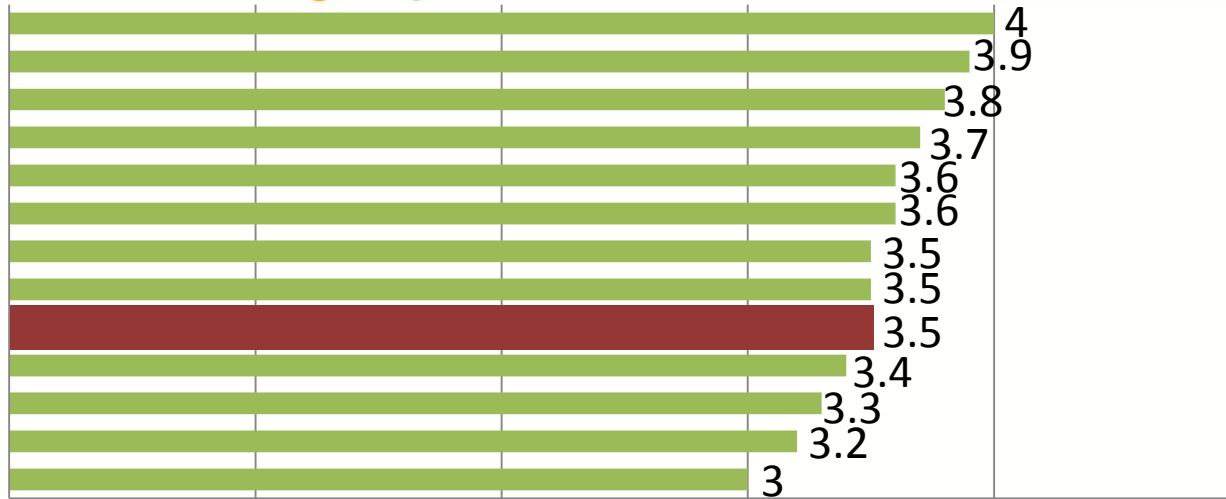


All Firms



*Data shown for comparison purposes.

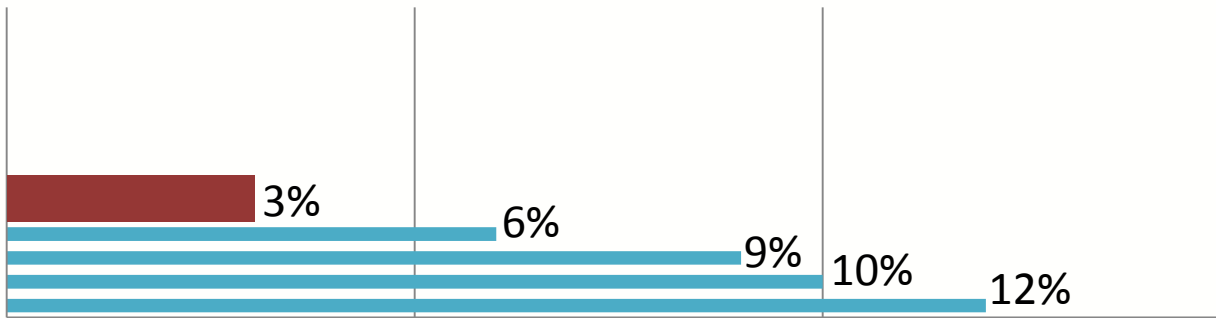
**Quality data in this report is based on this period.



Average Quality

0 1 2 3 4 5

Average of Normalized Quality rating for each Outside Counsel, showing ranking among firms for the time period.



Defect Rate

0% 5% 10% 15%

Defect is any action rated less than 3.