Course Objectives

This course is designed for the business person or tech entrepreneur looking to get an overview of commercial opportunities in intellectual property, with a particular focus on technology patents. Whether you are an entrepreneur looking to commercialize your Next Big Idea, a corporate strategist in a tech company, or a business development executive within Big Pharma, patents are an increasingly important part of any business operation. With IT firms suing each other for patent infringement, so-called “patent trolls” changing the face of the mobile industry, and big pharma’s pipeline looking precarious as blockbuster drugs go off market, it isn’t surprising that patents have become part of the everyday news coverage for the Wall Street Journal, New York Times, and other general business publications.

Course Description

While some legal principles will be addressed, the primary focus of the class will be on leveraging intellectual property to create financial returns for start-ups. We will focus on practical hands-on tips over theoretical frameworks. Topics to be covered include: Reading, Writing, and Securing Patents; Evaluating Patent Strength and Commercial Potential; Software IP (Patents, Copyrights, and Trade Secrets); Navigating and Negotiating IP Licensing Agreements; How Investors View IP; Start-up IP War Stories; How So-Called “Trolls” Work; and Patent Enforcement & Monetization.

The course will feature guest speakers from start-ups, venture capital, Fortune 500 firms, and patent attorneys. Currently, we have guest speakers from Google, IBM, Nokia, the USPTO, multiple start-up companies, patent assertion entities, and more.

There will also be a heavy emphasis on negotiations, via an ongoing series of team-based interactive negotiation exercises throughout the semester. At the beginning of the semester, the class will be broken up into groups, and within each, further divided into a Licensee team and a Licensor team. The teams will be given an actual technology patent, and over the course of the semester will negotiate a term sheet for that technology.

Textbook and Materials

There is no textbook for this course. Weekly readings from current newspaper reports and commonly-available business paperbacks will be available on Canvas.
Methods of Evaluation

1. Writing and evaluating a patent (C, 20%)
2. IP Assessment (A, 20%)
3. The negotiation exercise (30%), including
   A. team grades for “pre-negotiation” submissions; (A, 10%, due 5pm each Friday)
   B. individual grades for post-negotiation written analysis; (C, 10%, due 5pm each Tuesday)
   C. team grades for the final presentations (A, 10%)
4. One mid-term quiz (C, 5%)
5. Class participation, including during the negotiation exercises (C, 25%)

Brief Faculty Bios

Orin Herskowitz

Orin is the executive director of Columbia Technology Ventures, as well as Columbia’s Vice President for Intellectual Property and Technology Transfer. As such, he directs Columbia’s technology commercialization office, overseeing a staff of 45+ full-time employees. Since he joined Columbia in 2006, Orin’s office has initiated over 350 licensing agreements and over 60 start-up companies based on Columbia technologies, generating over $750M in IP licensing revenues.

Prior to joining Columbia in 2006, Orin was with the Boston Consulting Group’s New York office for seven years, and prior to that was an entrepreneur. He has an undergraduate degree from Yale and an MBA from Wharton.

Jeff Sears

Jeff is Associate General Counsel and Chief Patent Counsel within the Office of the General Counsel at Columbia. His practice encompasses all aspects of patent law, including prosecution, portfolio management, strategic counseling, licensing and post-licensing compliance, litigation, and legislative and regulatory patent matters.

Jeff has practiced patent law for more than a dozen years. He joined Columbia in 2005, after having spent five years in private practice. Jeff holds an S.B. in physics from MIT, an M.A. and Ph.D. in physics from SUNY Stony Brook, and a J.D. from NYU. He is admitted to practice law in New York and before the U.S. Patent and Trademark Office.