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Post details: Making Innovation Pay

Posted by Jay Kesan on October 4th, 2006

I have been reading a new book, *Making Innovation Pay: People Who Turn IP into Shareholder Value*, edited by Bruce Berman (John Wiley & Sons 2006), that is both informative and insightful. This edited compendium contains eleven chapters featuring easy-to-read contributions by Bruce Berman, Marshall Phelps, Daniel McCurdy, Peter Detkin, James Malackowski, Ray Niro, Bruce Lehman and Ron Schutz among others. The book is laid out well, and it is a breezy read. Although the target audience is senior executives and managers in the world of business, the book is a very good collection for anyone interested in intellectual property.

The contributors are carefully chosen to provide a wide variety of perspectives topics such as IP management, protecting IP assets, capitalizing on one's patent portfolio, effective corporate patent strategies, the fiduciary obligations of management related to IP, the costs and risks associated with patent enforcement, the uneven playing field for small companies and individual inventors, the quality and uncertainty in patent examination including the lack of international harmonization of patent prosecution rules and examination, and the associated need for reform. Worth the time, money and effort.

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Professor Kesan's (kesan@uiuc.edu) academic interests are in the areas of intellectual property, specifically patent law, and law and technology. He has written extensively (recent publications are on SSRN at <http://ssrn.com/author=261086>) in the areas of patent law and patent institutions, law and the regulation of cyberspace, intellectual property, and law and economics. Intellectual property, patent law, and regulatory issues in computer software and agricultural biotechnology have been the focus of much of his recent writings.

At the University of Illinois, Professor Kesan holds positions in the College of Law, the Coordinated Science Laboratory, the Department of Electrical & Computer Engineering, and the Department of Agricultural and Consumer Economics. He was a JSPS Invited Fellow and Visiting Associate Professor at the University of Tokyo, Japan and has also served as a Foreign Research Fellow at the Institute of Intellectual Property (IIP) in Tokyo, Japan. He has also served as a Visiting Assistant Professor at Georgetown University Law Center, and as the Jerold Hosier Distinguished Visiting Professor in Intellectual Property at DePaul University. He frequently serves as an invited faculty member at the CASRIP Summer Institute at the University of Washington. Professor Kesan is a Co-Director of the International and Comparative Intellectual Property Law Summer Program sponsored by the University of Illinois College of Law, Oxford

University, and the University of Victoria, British Columbia.

He has received numerous, multi-year, research grants for his work in the areas of intellectual property and technology regulation from the National Science Foundation, the U.S. Department of Agriculture, the Net Institute, the Coleman Foundation, and the University of Illinois Campus Research Board.

He serves as the faculty Editor-in-Chief of the University of Illinois Journal of Law, Technology and Policy, which published its inaugural issue in Spring 2001. He has also developed an online course on “Legal Issues in Technology Entrepreneurship,” supported by a grant from the Coleman Foundation.

Professor Kesan continues to be professionally active in the areas of patent litigation and technology entrepreneurship. He was appointed by two federal judges to serve as a Special Master in patent litigations, and has served as a technical and legal expert in patent matters. He participated twice in panels at the Federal Trade Commission and the Department of Justice Hearings on the Implications of Competition and Patent Law and Policy. He has also worked with the U.S. Department of Commerce and the U.S. Civilian Research & Development Foundation on their intellectual property protection and technology commercialization activities in the former Soviet Union countries.

He received his J.D. summa cum laude from Georgetown University, where he received several awards including Order of the Coif, and served as Associate Editor of the Georgetown Law Journal. After graduation, he clerked for Judge Patrick E. Higginbotham of the U.S. Court of Appeals for the Fifth Circuit.

Prior to attending law school, Jay Kesan—who also holds a Ph.D. in electrical and computer engineering—worked as a research scientist at the IBM T.J. Watson Research Center in New York. He is a registered patent attorney and practiced at the former firm of Pennie & Edmonds LLP in the areas of patent litigation and patent prosecution. In addition, he has published numerous scientific papers and obtained several patents in the U.S. and abroad.