

A WOLF GREENFIELD SEMINAR

# Navigating the IP Landscape: Implications and Considerations for Start-Up Success

Presented by Usha Parker & Ryan Van Olst

September 19, 2024





# Your Presentation Team



**Usha Parker**

COUNSEL

Electrical & Computer Technologies

- 
- BSc, Electrical Engineering, Tennessee Tech University
  - MSc, Electrical Engineering, Virginia Tech
  - JD, The Ohio State University, Moritz College of Law



**Ryan Van Olst**

COUNSEL

Trademark & Copyright

- 
- BA, Florida State University
  - BS, Florida State University
  - JD, American University Washington College of Law



# What We Do

SERVICES & TECHNOLOGIES

PATENT

LITIGATION

POST-GRANT PROCEEDINGS

TRADEMARK & COPYRIGHT

LICENSING & TRANSACTIONS

CHEMICAL & MATERIALS  
TECHNOLOGIES

MECHANICAL  
TECHNOLOGIES

BIOTECHNOLOGY

ELECTRICAL & COMPUTER  
TECHNOLOGIES

PHARMACEUTICAL

“

It is one of the most talented top-to-bottom firms we have engaged over the years. They seem to have a specialist for every technology area, and all of their lawyers are current on relevant legal issues, not to mention smart. They are also hardworking and diligent with the client's best interests at heart.

— Client, Chambers USA



# Unparalleled Technical Experience

SUITED TO HANDLE ANY COMPLEX TECHNOLOGY

**163**

attorneys &  
technology specialists

One of the 10 largest IP  
firms in the country.

**69%**

with advanced degrees  
(MS, PhD, MD)

Highest percentage of advanced  
degrees of any US firm.

**53%**

with industry  
experience

We speak your language  
and ask the right questions.

**59**

different technical areas of advanced degrees

We are suited to handle any complex technology.  
We don't spend time or money getting up to speed.  
We contribute from the start.



# Key Areas of Intellectual Property

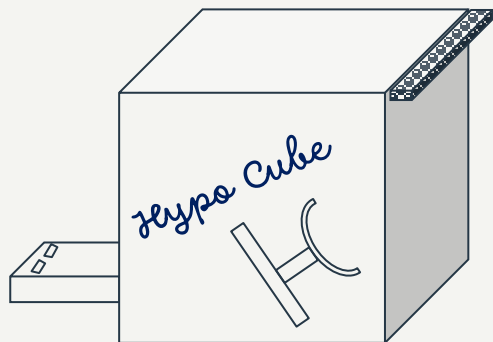
Patents

Trade Secrets

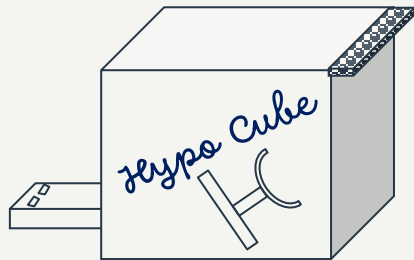
Trademarks

Copyrights

# Introducing...The Hypo Cube by Hypo Co.



- The Hypo Cube is a plug-and play, personal AI assistant that offers productivity tools.
- Users can plug it in, and the cube scans and runs its own machine learning models in real time to assist with tasks.
- Auto-generates reports, presentations, graphs, etc. based on data.



- software
- cooling fin
- licensed patent for chip in current product
- developed new chip and new fabrication step

Patents

Trade Secrets

Trademarks

Copyrights

## Upcoming Events

investor meeting in 3 weeks

invitation to showcase Hypo Cube at INVENTpreneur in a month



# Hypo Co. – IP Considerations

## Patents

- Design patent
- Utility patent
  - provisional
  - non-provisional

## Trade Secrets

- Should new fabrication step be a trade secret?
- How about the software?

## Trademarks

## Copyrights





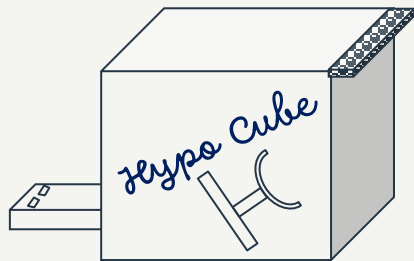
# Trade Secrets (Generally)

- Consider trade secret protection for: designs, process, instruments, formula, data/compilation of information, etc. not generally known or reasonably ascertainable by others
- **Document** and **mark**: show that you viewed/treated as trade secret (“Confidential Information of \_\_\_\_”)
- Must be **maintained as secret** by **reasonable efforts**
  - develop procedures for new/departing employees, outsiders
- Variety of protections by state and federal laws
- Importance in the life sciences
  - E.g., *Amgen (NEULASTA®) v. Coherus (UDENYCA®)* (about theft of secret methods of manufacturing antibodies)





# Trade Secrets (Hypo Co.)



- software
- cooling fin
- licensed patent for chip in current product
- developed new chip and new fabrication step

Should the new fabrication step be a trade secret?

- ✓ difficult for others to discover (can't see/reverse engineer)
- ✓ difficult to discover infringer
- ✓ can be designed around/omitted
- ✓ control as trade secret is feasible

What about software?



# Design Patents (Generally)

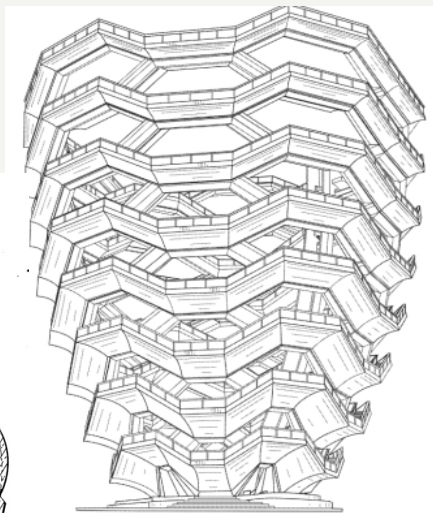
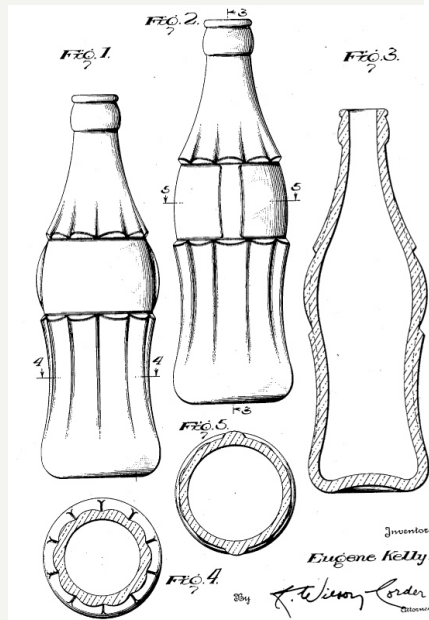
35 U.S.C. 171 Patents for designs. Whoever invents any new, original, and ornamental design for an article of manufacture . . .

- **new** – according to “average observer test”
- **original** – inventors must be originators
  - even if true inventor is unknown or willing
  - can reassemble or regroup familiar forms and decorations
- **ornamental** – distinct appearance is not dictated by function alone
  - function of article vs functionality of design
- **article of manufacture** – must be a tangible object
  - can’t be a picture or print applied to an object
  - can be water pattern of a fountain



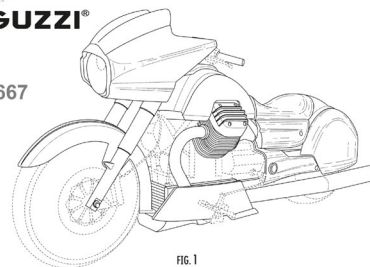
# Design Patents (Generally)

- 15 year term (from issue date)
  - no maintenance fees
- drawings and a claim
  - typically \$2-5k (with fees)
  - prosecution typically easy
  - not much to translate



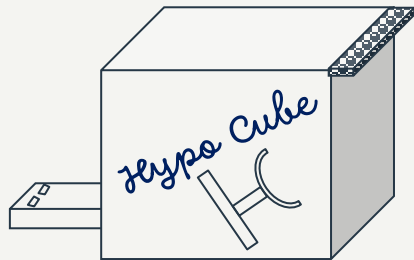
**MOTO GUZZI**

U.S. D879,667





# Design Patents (Hypo Co.)



Should Hypo Co. consider a design patent?

- is the visual appearance important (to distinction/marketing)?
- is the shape integral to the cooling function?
  - if purely functional, can't obtain design patent
  - if too much variation is possible, is there any value?

- software
- cooling fin
- licensed patent for chip in current product
- developed new chip and new fabrication step



# Utility Patents





# Utility Patents (Provisional)

- will never become a patent
- will expire in 1 year
- will not become public
  - can't be used to stop someone else's patent
  - can't be enforced (there is no infringement of a provisional)



- Benefits:
  - it anchors a filing date - allows up to a year for developments
  - can file just about anything
  - cheap way to obtain a filing date
- **Caveat:**
  - any later filing that isn't supported will not benefit from this earlier date



## Utility Patents (Non-Provisional)

- can become a patent
- will generally expire 20 years from the earliest filing date
- will become public at least after patenting
  - so it can be used by the USPTO to stop/limit someone else's patent
  - can be enforced against an infringer





# Patents (Hypo Co.)

- reflect before you reveal
  - disclosing your invention first can be problematic
- the claims are what determine protection
  - they set the bounds of what you can stop others from doing
  - doing *more* than what's claimed won't help an infringer

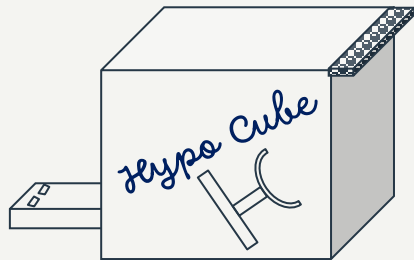
## Upcoming Events

investor meeting in 3 weeks

invitation to showcase Hypo Cube at INVENTpreneur in a month

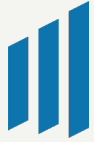


# Patents (Hypo Co.)



- plug-and-play via USB
- cooling fin
- licensed patent for chip in current product
- developed new chip and new fabrication step

- Provisional or non-provisional?
  - still developing? about to go to market?
  - need to discuss with investors or in showcase?
  - need to delay costs?  
(don't forget the caveat!)
  - need to attract investors?
  - see a potential competitor?
- PCT?
  - can be first or can follow provisional or non-provisional (within a year of first application)
  - can act as a placeholder in multiple countries
    - does Hypo Co. expect significant customers/competitors outside the US?



# Hypo Co. – IP Considerations





# A Trademark Is A...

Word(s)

NESTLE  
HYPO CUBE

Name

SAM ADAMS

Symbol



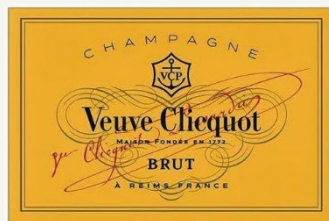
Slogan

i'm lovin' it®

Distinctive Sound



Color



Product Shape



Scent














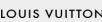



...which identifies and distinguishes goods and services of one seller from those of another



# Why are Trademarks Important?

- Valuable corporate asset – brand equity
- Represent “brand promise”
- Provide consumer recognition
- Help maintain reputation among customers and competitors

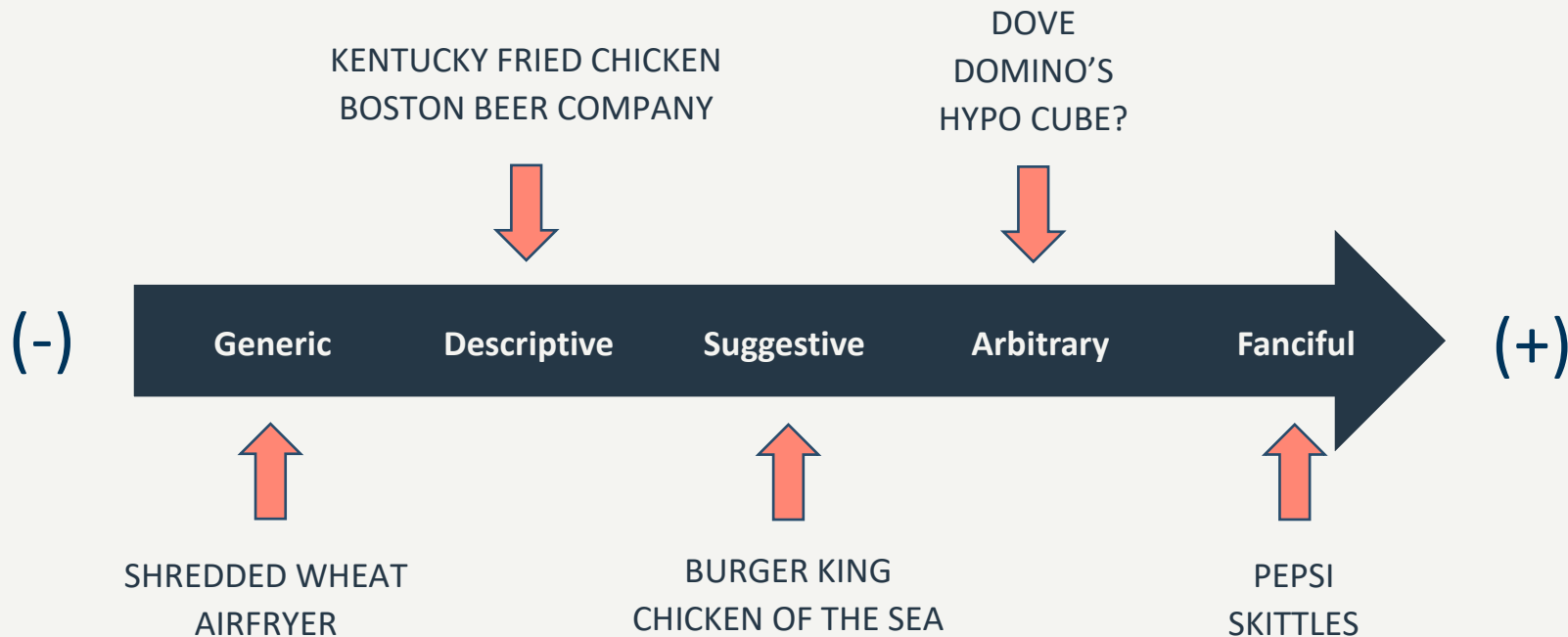
01 Apple  +4% 502,680 \$m	02 Microsoft  +14% 316,659 \$m	03 Amazon  +1% 276,929 \$m	04 Google  +3% 260,260 \$m	05 Samsung  +4% 91,407 \$m
06 Toyota  +9% 64,504 \$m	07 Mercedes-Benz  +9% 61,414 \$m	08 Coca-Cola  +1% 58,046 \$m	09 Nike  +7% 53,773 \$m	10 BMW  +10% 51,157 \$m
11 McDonald's  +5% 50,999 \$m	12 Tesla  +4% 49,937 \$m	13 Disney  -4% 48,258 \$m	14 Louis Vuitton  +5% 46,543 \$m	15 Cisco  +5% 43,345 \$m



From <https://interbrand.com/best-global-brands/>



# Selection Basics: Types of Terms





# When To Start Thinking About Trademarks

## The Beginning

- Important to pick a mark that communicates your brand promise
- Make sure the mark is clear prior to use
  - You don't want to change after you have some renown

## Why?

- For many companies, trademarks are their most valuable assets
- Relatively inexpensive IP right
  - Have secured TM rights shows investors that you are serious



# Selection Basics: Trademark Selection Considerations



Strength,  
distinctiveness



Brand promise



Easily remembered  
or pronounced



No adverse or slang  
meaning



Foreign equivalents



Legally registrable



Non-traditional  
marks





# Selection Basics: Clearance Searches

- Clear the mark before using it by searching the internet for similar uses
  - D-I-Y as a first pass

Select A Search Option
<p>▶ <b>Basic Word Mark Search (New User)</b> This option cannot be used to search design marks.</p>
<p>▶ <b>Word and/or Design Mark Search (Structured)</b> This option is used to search word and/or design marks. <b>NOTE:</b> You must first use the <a href="#">Design Search Code Manual</a> to look up the relevant Design Codes.</p>
<p>▶ <b>Word and/or Design Mark Search (Free Form)</b> This option allows you to construct word and/or design searches using Boolean logic and multiple search fields. <b>NOTE:</b> You must first use the <a href="#">Design Search Code Manual</a> to look up the relevant Design Codes.</p>

- Then, have a trademark clearance search conducted by counsel
- Trademark attorneys specialize in evaluating trademark searches and helping clients choose trademarks



# Prosecution Basics: Why Register My Mark?

## Advantages of Registration

- Filing date is constructive date of first use
- Nationwide rights
- Right to sue in Federal Court for trademark infringement
- Right to have US Customs police and seize
- Priority for foreign filing



## Duration of a TM

- Perpetual, if in use
- Timing for renewal of a U.S. registration: 5<sup>th</sup> year after registration, then every 10 years, so long as mark is in use



# Prosecution Basics: Protection and Filing Strategy

- Common filing strategy order of priority, but it depends:
  - Company name
  - Company logo
  - Key product and service names
  - Slogans
- TM rights attach to specific goods/services, so be sure to apply for your core goods and services.
- Don't worry about ancillary/promotional products (t-shirts, pens, stress balls, etc.)



# Prosecution Basics: Filing An Application

- **Clearance**: determine whether mark is available to use and register (is anyone using anything close?)
  - Basic test of trademark infringement: whether use is “*likely* to cause confusion or to cause mistake or to deceive”
- **Filing Bases**
  - Use
  - Intent-to-Use
  - Foreign registration
- **Potential rejections from the USPTO**
  - Likelihood of confusion
  - Descriptiveness / Genericness
  - Functional
  - Insufficient description of goods/services



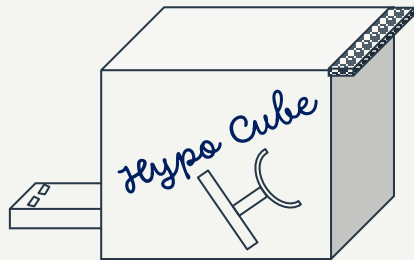
# Best Practices: Tips for How to Use a Mark

## Once you have a trademark, use it correctly

- Use the generic name of the product/service after the trademark (e.g. Nike sneakers)
- Give proper notice of a registered trademark to consumers by using “®” (or for an unregistered mark, use “TM” or “SM”)
- Always distinguish the trademark from surrounding text by capitalizing the trademark
- Consider using a distinctive typeface to further offset the trademark from surrounding text
- Do not abbreviate the trademark or otherwise alter it
- Consult your internal guidelines on proper use of a TM



# Trademarks (Hypo Co.)

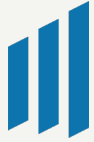


- software
- cooling fin
- licensed patent for chip in current product
- developed new chip and new fabrication step

Hypo Co. may consider trademark applications for:

- **COMPANY NAME:** Hypo Co.
- **SOFTWARE/HARDWARE PRODUCT:** Hypo Cube
- **PRODUCT LOGO:**





# A Copyright is...

...an original work of authorship that has been fixed in any tangible medium of expression.

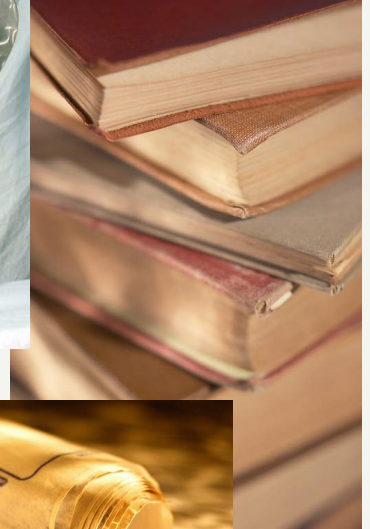
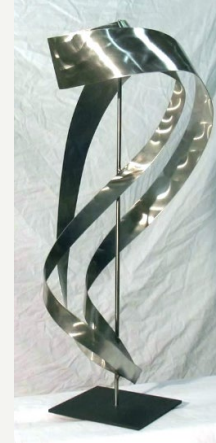
- Photographs
- Software/databases
- Manuals
- Models
- Video
- Website
- Advertising/marketing materials
- Catalogs
- Product documentation
- Specification drawings
- Prototypes





# Copyright Protections

- Right to:
  - Reproduce the work (make copies)
  - Prepare derivative works
  - Distribute copies
  - Perform the work publicly
  - Display the work publicly
- Notice is not required...but recommended:
  - Indicates work is protected by copyright
  - Can be used to show that the infringement was not “innocent”
  - e.g. © Wolf Greenfield 2024





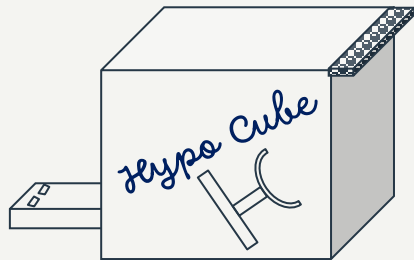


# Copyright Ownership

- Copyright belongs to the author/creator unless:
  - Work for hire: created by an employee in the ordinary course of employment
- People outside the company are not “employees”
  - Independent contractors, consultants, designers, computer programmers, etc.
  - Get an assignment



# Copyrights (Hypo Co.)



Hypo Co. may consider copyright applications for:

- software source code
- user interface (UI)
- product descriptions, promotional videos, promotional images, and other media

Is a license needed?

- software
- cooling fin
- licensed patent for chip in current product
- developed new chip and new fabrication step



# Instituting an IP Program

- Need to understand the company's perspective on this and where you fit in
- Depending on company's current stage and resources, this will be prioritized
- Need to have a clear understanding of all your current technology, your development plan, and tailor your IP program to align
- Includes:
  - Building your infrastructure to support IP
  - Taking stock of your current IP
  - Understanding the IP landscape
  - Building your IP portfolio



# Building An IP Infrastructure

- Training
  - Train all personnel on what IP is
  - Train all personnel on importance of IP to the organization
  - Train all personnel on confidentiality matters
- Good record keeping
  - Encourage detailed and regular record keeping
  - Lab records/meeting records/3<sup>rd</sup> party (purchase orders)
  - Establish an IT infrastructure
- Establish a communication mechanism/protocol
  - Invention disclosure reports
  - Regular review/evaluation/meetings



# Taking Stock Of Your IP

- What technology are you using now?
- What technology will you develop?
- What technology has value (in or out of your primary business goals)?
- What additional technology might you need access to?
- Are there potential partners who provide value added technology/expertise?



# Understanding The IP Landscape

- Is the work you are currently doing covered by any of your IP rights?
- Is the work you are currently doing covered by any third-party IP rights?
- Who are your commercial competitors?
- Do you have freedom-to-operate (FTO) with your contemplated commercial products or practices?

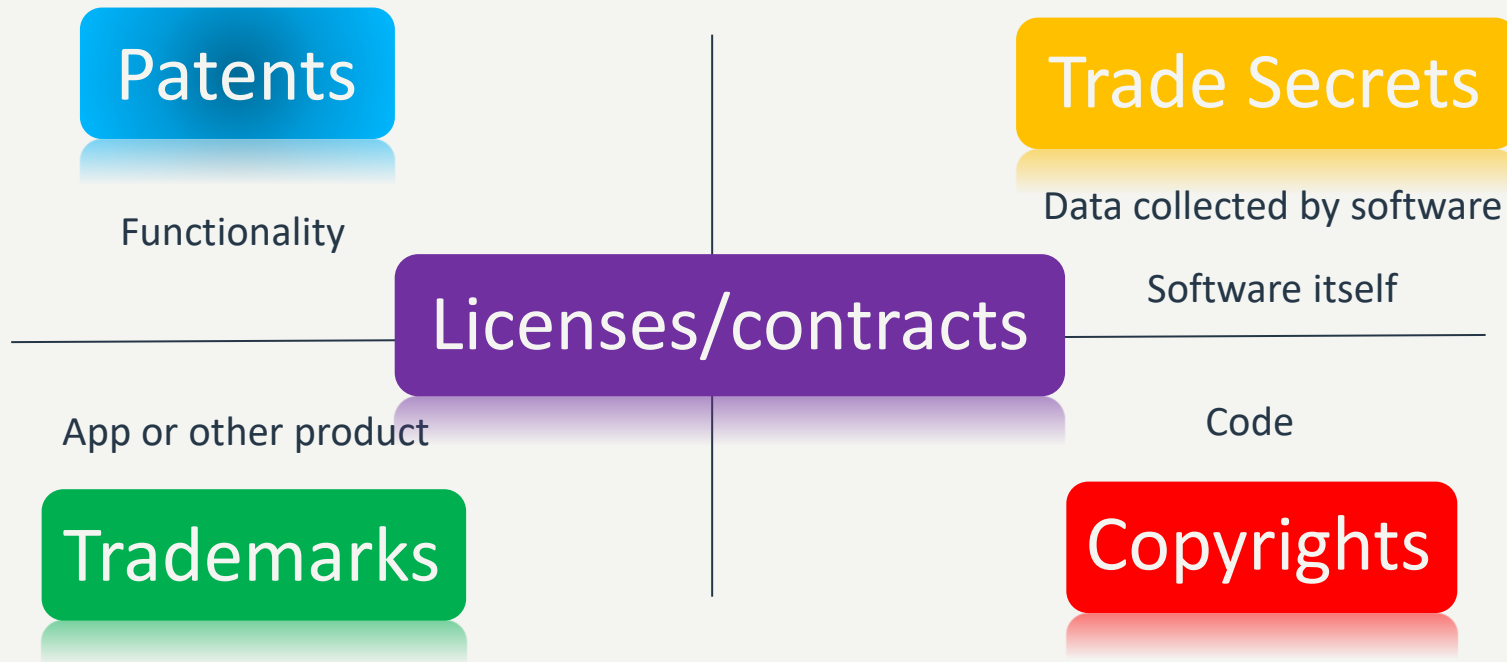


# Building Your IP Portfolio

- This is continually evolving and will inevitably change over time
- Existing technology – how to appropriately protect
- Future technology – how to appropriately protect
- **Primary IP** – how to protect/exploit it
  - Core business technology
  - Stage to address potential partner(s)
- **Secondary IP** – how to protect/exploit it
  - Non-core business technology
  - Stage to address potential partner(s)



# IP Considerations for Software







# IP Considerations for Software

- Patenting software
  - Why?
    - Hardware involved is mostly or entirely conventional
    - End result/goal is not new or protectable
  - How?
    - Claim core functionality: improvement to technology, significantly more than an abstract idea
    - Inextricable link to a device or system (*e.g.*, GPS, radar, internet)
    - Try to separate devices (*e.g.*, client – server)



# IP Considerations for Software

- Patenting AI
  - Development in AI itself (*e.g.*, new machine learning algorithm)
  - Difference in training
  - Application of AI (*e.g.*, characterize tumor via AI trained on images)
    - Focus is on the practical application
      - Replacing an expert can be patentable
    - Is another technology improved?



Navigating the IP Landscape: Implications and Considerations for Early-Stage Success

# Questions?



BOSTON | NEW YORK | WASHINGTON DC