



# Heading to Market? An IP Checklist for Product Launch

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ACC California Summit

# Your Presenters

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## Panel

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## Moderator



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# Product Launch – Now What?

# Product Launch

- A global product launch is often a series of complex processes requiring high levels of coordination and communication between many different internal and external participants
  - R&D
  - Manufacturing
  - Sales
  - Marketing
  - Legal/IP
  - Finance
  - Management
  - Outside Parties



## Getting to the Launch Pad

- Product development processes can vary in time significantly
- Depending on the industry and technology, moving from concept through feasibility to commercialization can be measured in years or months
- IP-related activities need to recognize these time scales

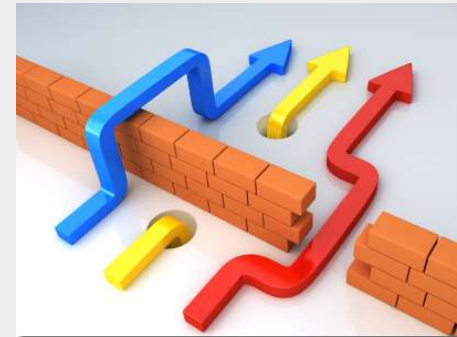


# IP Issues to Consider

- Defensive
  - FTO - Identification of relevant 3<sup>rd</sup> party IP and possible mitigation
- Offensive
  - Selection of best mix of IP rights and protection strategies
- Market & Competitors
  - How does the market deal with IP issues?
- Timing
  - What is possible in the time available?

# Defensive - Freedom to Operate

- **What is Freedom to Operate (“FTO”)?**
  - The freedom to develop and market a product or to acquire/use a technology without infringing the IP rights of third parties
  - Achieved by understanding the IP landscape in desired technology field
- **Why is it valuable?**
  - Limits on product design and/or manufacture
  - Ability to compete and freely market product
  - Identifies need to obtain technology licenses
  - Risk of infringement suits (damages or injunctions)
- **Thorough FTO analysis can reduce uncertainty, help manage risks and prevent avoidable losses**



# FTO

- **Why It Matters in California**

- High employee mobility increases risk of inadvertent infringement
- Especially relevant when hiring from competitors or entering crowded markets



# FTO – Due Diligence Checklist for Product Launches

- **Proactive**

- Embed IP Risk Analysis in Product Development Phase Gates
- Set “Rules of Engagement” expectations with design teams
- Ask for invites to team meetings – learn the business and maintain visibility

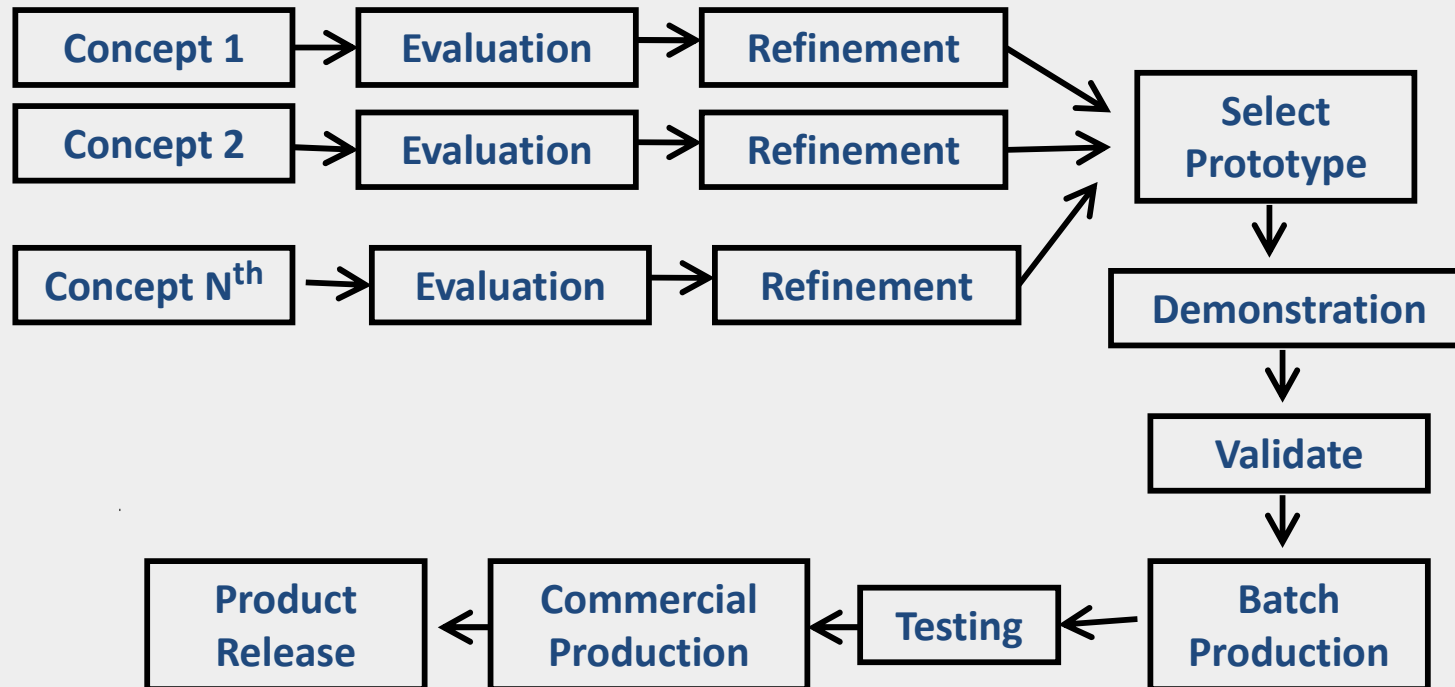
- **Iterative**

- Timely Analysis: if too early - design may be too fluid, if too late - barrier patents can cause costly design changes
- Create Input forms with instructions - containing all that is needed from the team for IP Analysis
- Monitor any design changes throughout development – amend patent infringement search as needed

- **Continuous Engagement**

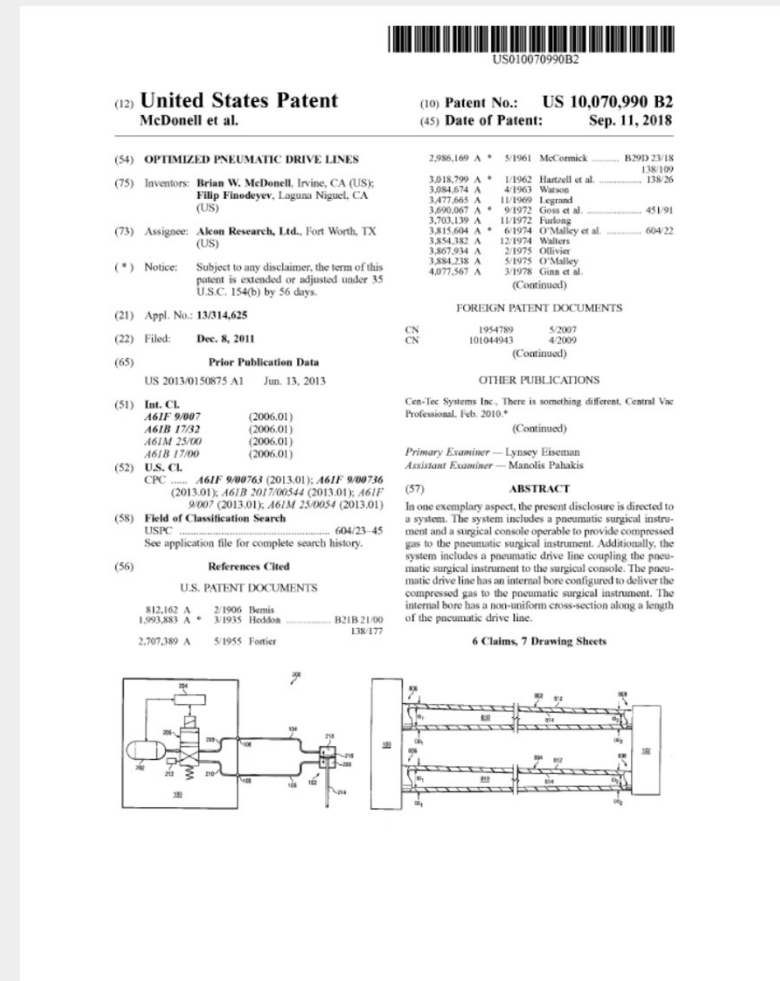
- Remote Collaboration Challenges – build strong relationships with individuals (monthly or quarterly meetings)
- Attend their meetings to understand new features, marketing claims, design challenges, timelines

# Offensive - When & What Do We File?



# Patents – What is a patent?

- Legal document issued by the USPTO
- The owner discloses the details of the invention so the public can learn and improve from it
- A patent (or a pool of patents) can be licensed, assigned, or otherwise exploited to generate value
- Patents' significant value came from:
  - its claims defining the owners' rights to exclude
  - its detailed disclosure of what the invention is about and can be practiced
  - USPTO's granting them after searching and reviewing prior art



# Patents — Types of Patents

## Utility

Protects functional aspects of the invention

Most common type of patent

## Design

Protects new, original, and ornamental designs for a product

# Patents — Types of Patents (Example Utility Patent)

(12) United States Patent  
Chaudhri et al.

**UNLOCKING A DEVICE BY PERFORMING  
GESTURES ON AN UNLOCK IMAGE**

(10) Patent No.: US 8,046,721 B2  
(45) Date of Patent: \*Oct. 25, 2011

Forrestal, Mountain View, CA (US)  
Greg Christie, San Jose, CA (US)

Publication Date  
11 Sep. 24, 2009

Application Data  
Application No. 11/722,549, filed on  
Pat. No. 7,657,849.

(2009.01)  
715/863; 345/173; 345/179  
715/863; 345/156  
for complete search history.

**References Cited**

**U.S. PATENT DOCUMENTS**

485,084	A	11/1995	Cantrell	340,825	31
559,961	A	9/1996	Blander	395	108.01
677,710	A	10/1997	Thompson-Rohlfach	345	173
831,033	A	10/1998	Keller et al.	345	148
987,327	A	5/1999	Ogata et al.	345	139
1,112,268	A	11/2000	Burford	341	043
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IBM, "AccessControl (Access Keys)," IBM Technical Disclosure Bulletin, No. 38, No. 4, Apr. 1995.  
(Continued)

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**ABSTRACT**  
(57)  
A device with a touch-sensitive display may be unlocked via gestures performed on the touch-sensitive display. The device is unlocked if contact with the display corresponds to a predefined posture for unlocking the device. The device displays one or more unlock images with respect to which the predefined gesture is to be performed in order to unlock the device. The performance of the predefined gesture with respect to the unlock image may include moving the unlock image to a predefined location and/or moving the unlock image along a predefined path. The device may also display visual cues of the predefined gesture on the touch screen to remind a user of the gesture.

**15 Claims, 15 Drawing Sheets**

Device 400

Touch Screen 500

404 402

502 Movement 504

Menu Button 410

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# Patents — Types of Patents (Example Design Patent)



# Utility Patents — Nature and Length of Protection

- What can be protected?

- New and useful **processes, machines, methods** of manufacture, and **compositions** of matter
- No protection for abstract ideas, laws of nature, or natural phenomena

- Length of protection

- 20 years from filing
- Possible to get longer if get compensation for PTO delays

# Utility Patents — Types of Patent Applications?

## **PROVISIONAL APPLICATIONS**

Low-cost application for inventors to preserve patent rights. Faster and cheaper, but no protection without later filing of non-provisional application.

## **NON-PROVISIONAL APPLICATIONS**

Full application that includes all required sections and is reviewed by the PTO.



# Trade Secrets

- A trade secret can be any business or technical information that:
  - Has **economic value** to the user
  - Is **not generally known** by or available to the public
  - Is subject to **reasonable efforts to preserve its secrecy**



# Trade Secrets

- A trade secret will be protected from exploitation by those who either:
  - Obtain access through improper means, or
  - Misuse secrets gained through lawful access
- Advantages of Trade Secret:
  - No expiration
  - Do not have to publicly disclose the information
  - Protected when created, but must be with reasonable efforts to maintain its confidentiality (upfront & ongoing costs)
- Disadvantages:
  - No recourse if reverse engineered
  - Vulnerable to employee mobility

# Trade Secrets—Examples

- Trade secrets come in an endless array of types:
  - R&D information
  - Software algorithms
  - Inventions not patented or otherwise disclosed
  - Designs
  - Formulas (WD-40)
  - Recipes/ingredients (Coca-Cola recipe)
  - Devices
  - Methods
  - Manufacturing/computational processes

# Trade Secrets - Framework

- Legal Framework for Trade Secrets
  - CUTSA (California)
  - DTSA (Federal)
  - Requires reasonable steps to maintain secrecy
- Safeguarding Trade Secrets
  - Use NDAs and access controls
  - Employee training and documentation
  - Limit exposure to sensitive information

# Trade Secret Misappropriation: Recent Example



*Versus*



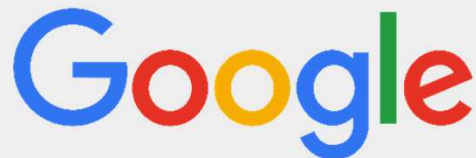
**TRADE SECRET**

Uber Technologies Inc. paid about \$245 million worth of its own shares to Waymo (Google's self-driving car company) to settle a trade secret misappropriation suit, in which Waymo alleged that its former employees took 10,000+ Waymo electronic files and used them at Uber. Feb. 9, 2018



# Branding, Advertising, and Privacy Considerations


# What is a Trademark?

- A trademark is a word, name, symbol, or device, or combination thereof, used by a business to identify its goods and to distinguish them from those of others
- A service mark identifies the origin or source of services
- Trademarks are adjectives not nouns



# Types of Trademarks

- **Words**
  - *COKE, GOOGLE*
- **Word-Names**
  - *RALPH LAUREN, KATE SPADE*
- **Letters**
  - *IBM, AT&T*
- **Logos/design marks**
  -  
- **Slogans**
  - *DON'T LEAVE HOME WITHOUT IT*

- **Single Colors**
  - 
- **Sound marks**
  - *NBC Chimes, Darth Vader Breathing*
- **Smell marks**
- **Domain names**
  - *EXPEDIA.COM*
- **Trade dress**
  - *COCA-COLA bottle shape,*
  - *Apple store*





# Trademark Adoption Considerations

#1

## SELECTION

Is the mark capable of identifying and distinguishing your products or services from those of a competitor, i.e., is it **protectable**?

#2

## AVAILABILITY

Is the mark **available** for the contemplated use?

What about for future expansion?

# Selection: Protectability

## *Selection Considerations:*

- Is the mark unique or different from others in the marketplace?
- Is the mark creative?
- Are others in the industry using similar marks?
- Does the terms have an industry meaning?

*Less Distinctive*



Generic

- Aspirin
- Beer
- Shirt



Descriptive

- Play-Doh
- Vision Center



Suggestive

- Greyhound
- Coppertone
- Jaguar



Arbitrary

- Apple
- Shell Oil



Fanciful

- Xerox
- Lexus
- Kodak
- Enron

*More Distinctive*



# Availability: Clearing Mark for Use and Registration

Ensure that the necessary clearance work is completed **before** you fall in love with a mark



## Clearance Considerations:

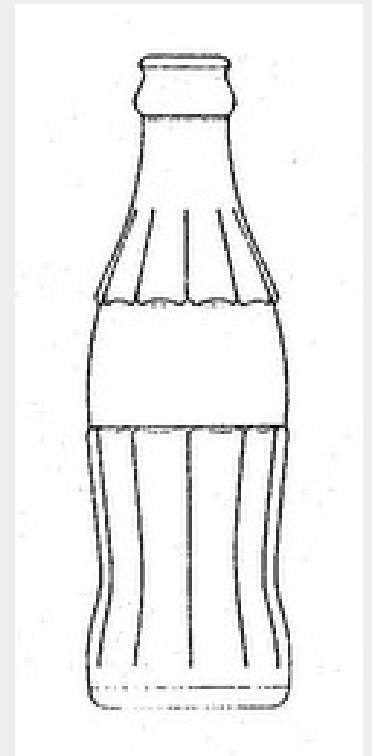
- Where do you want to use the mark?
- Do third parties have registrations for the same or similar mark?
- What are the common law uses of the mark(s)?
- Are third parties using the mark(s) in connection with similar goods or services to yours?
- How similar are their marks?
- How closely related are the goods and services?
- Knock out search v. full clearance search

# Protecting Your Brand with Trademark Filings

- Some things to consider:
  - In what jurisdictions are you launching the product/service that uses the trademark?
  - Is the mark intended for just **domestic** use or will be used **internationally**?
  - Do you plan on licensing the trademark to others?
  - Will you be using the same trademark outside of the United States?

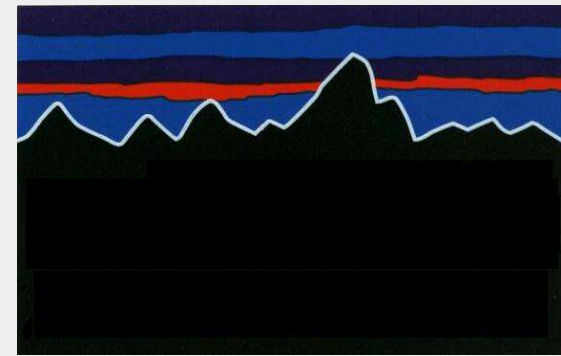
# Product Design: Trade Dress and Patents

- Trade dress is the overall look and feel of a product
- Product design, product packaging, store layouts
- Not protectable if it is functional
- Patent protection can make or break trade dress



# Logos: Trademark and Copyright Protection

- Logos can be eligible for both trademark and copyright protection
- If using graphic designers, ensure they assign copyright rights
- Something is not a “work made for hire” just because you paid someone to do it



# Enforcement

- **What** is enforcement?
  - Identifying and objecting to third-party marks that infringe or dilute the trademark owner's rights
- **Why** enforce your rights?
  - Protect your rights and your investment
    - Trademark law essentially *requires* enforcement
    - Can become victim of “genericide”
    - Mark can become so diluted that it loses all value



# How to Enforce Effectively

- **Register** trademarks
- **Monitor** the marketplace
- **Educate** internal teams
- Enforcement **mechanisms**
  - Cease and desist letters
  - Administrative actions (e.g., TTAB oppositions, cancellations, UDRPs for domain name disputes)
  - Litigation
  - Customs enforcement and marketplace takedowns



# Advertising Considerations

- What is **substantiation**?
  - Legal foundation
  - Risks of non-compliance
  - Substantiation **standards**
  - Best practices
- **Endorsement Guidelines**
  - 2023 FTC Guidelines
  - When endorsements arise
  - Unexpected “material connection” disclosure requirements
  - Clear and conspicuous disclosure
  - Best practices
  - Importance of compliance
- **Subscription Cancellations**



# CCPA Consumer Rights

## ***Right to opt out***

of the sale or sharing of  
data for cross-contextual  
advertising

## ***Right to correct***

inaccurate personal  
information

## ***Right to limit***

the use and disclosure of  
sensitive personal  
information

## ***Right to know and access***

data the company holds  
about them

## ***Right to delete***

personal data (subject to  
some exceptions, i.e., legal  
requirements)

## ***Right not to be penalized***

for exercising CCPA rights

## Businesses collecting CA consumer information must disclose, at or before collection:



The categories and purposes for collecting personal information



Whether the information will be sold or shared



The categories and purposes for collecting sensitive personal information



The retention period for personal information the company collects



How consumers can exercise their rights granted by the CCPA

Questions?

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