



Making Innovation Pay: Capitalizing on Your Intellectual Property

Andrea M. Augustine
Debbie D. Nye
Cynthia B. Stevens

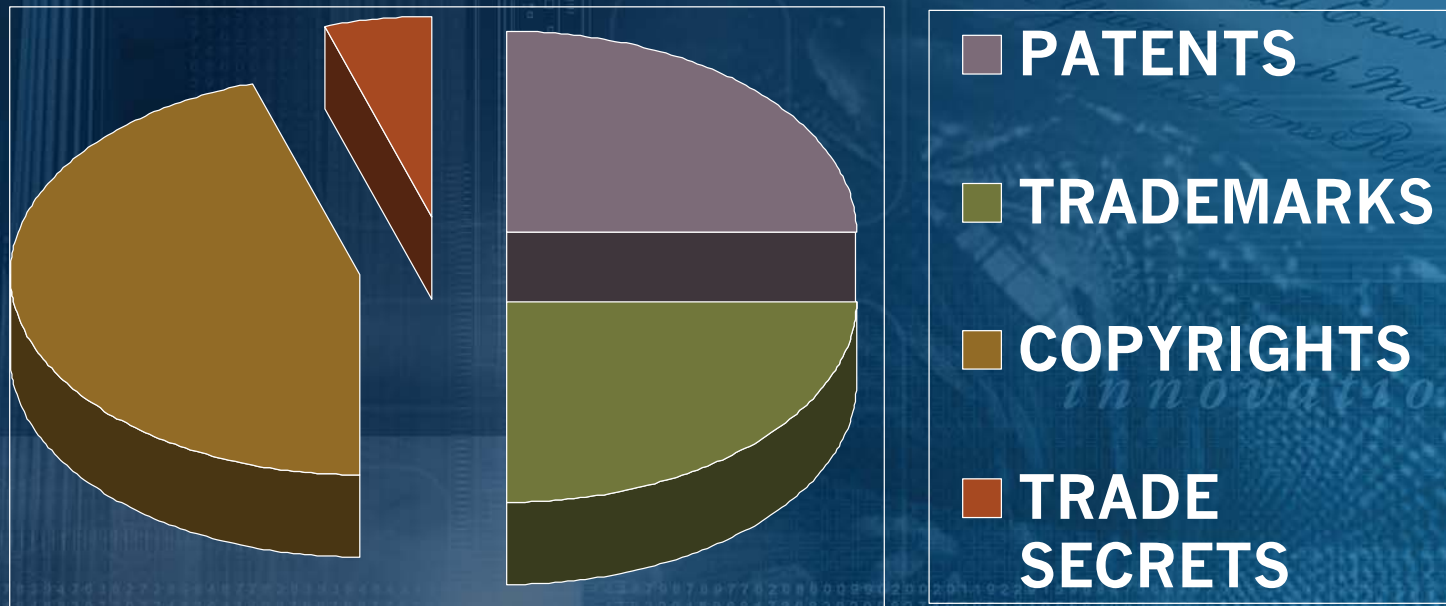
LIFE, LIBERTY, AND THE PURSUIT OF IP

“To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”

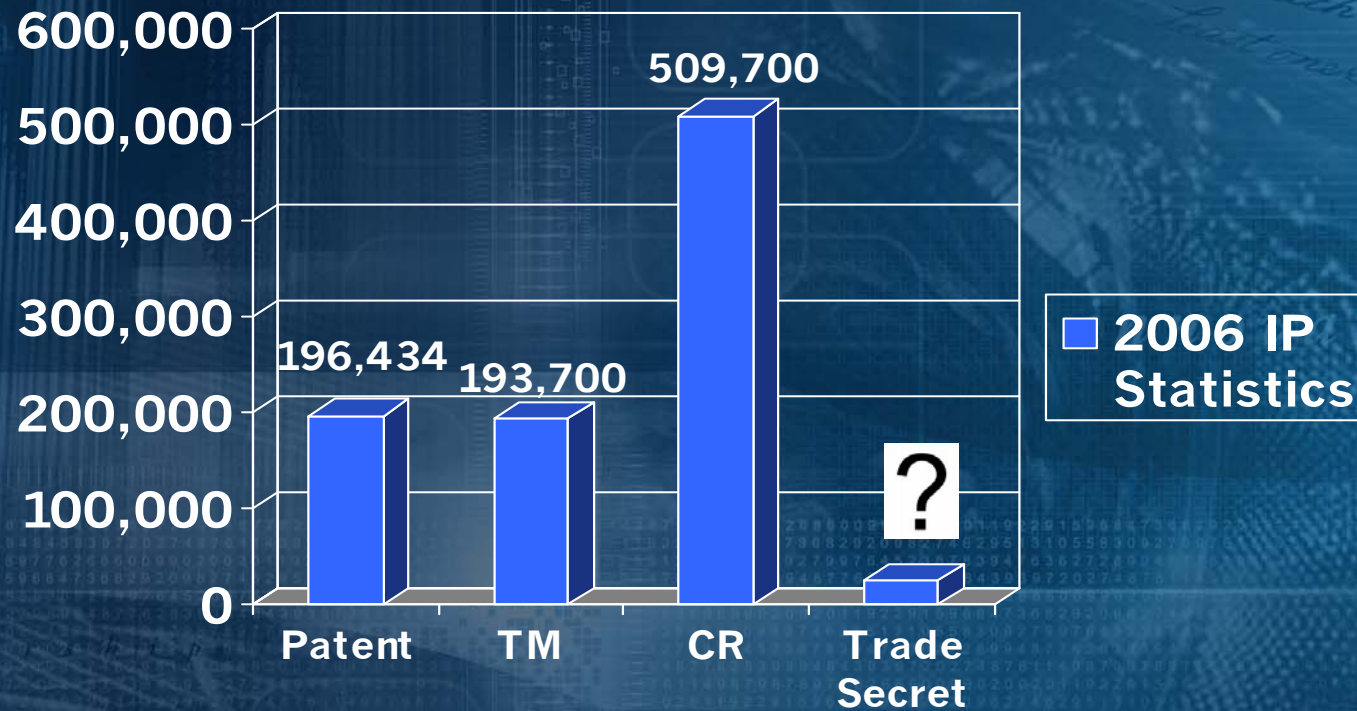
(United States
Constitution Article I,
Section 8, Clause 8)



FOUR BASIC TYPES OF IP RIGHTS

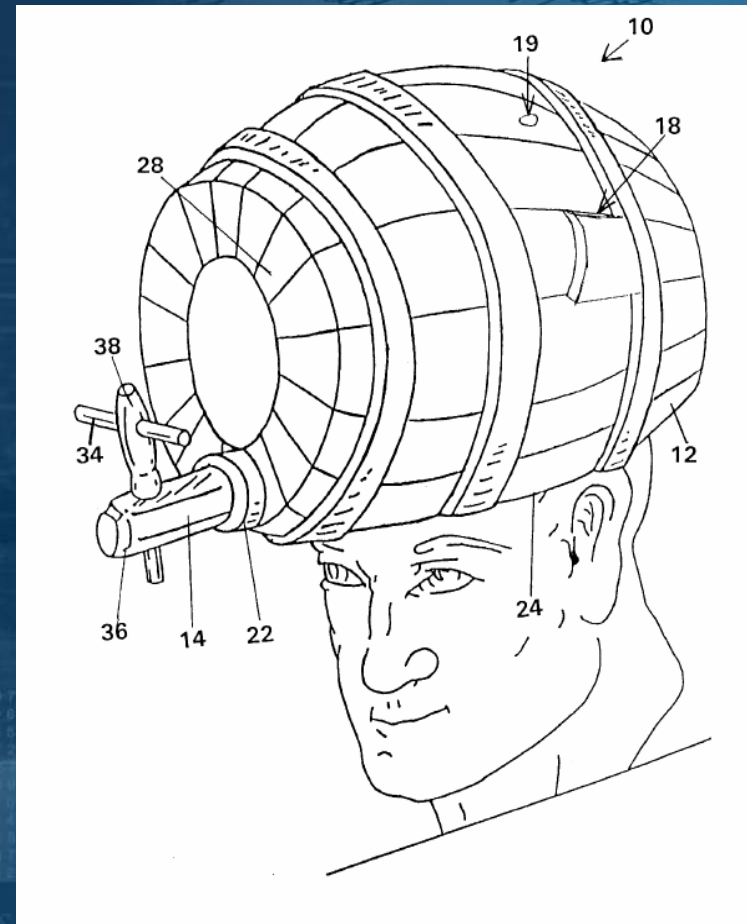


U.S. CENSUS BUREAU STATISTICS – IP ISSUED/REGISTERED

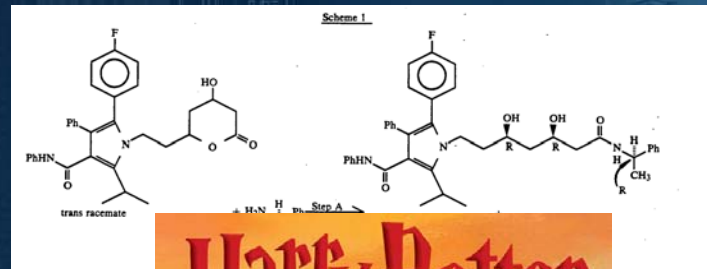
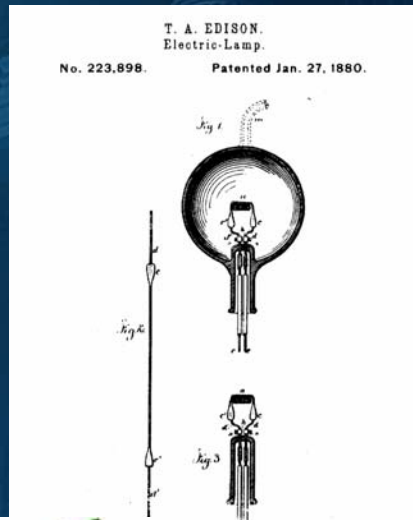


YOU DON'T NEED TO BE A GENIUS TO HAVE IP RIGHTS

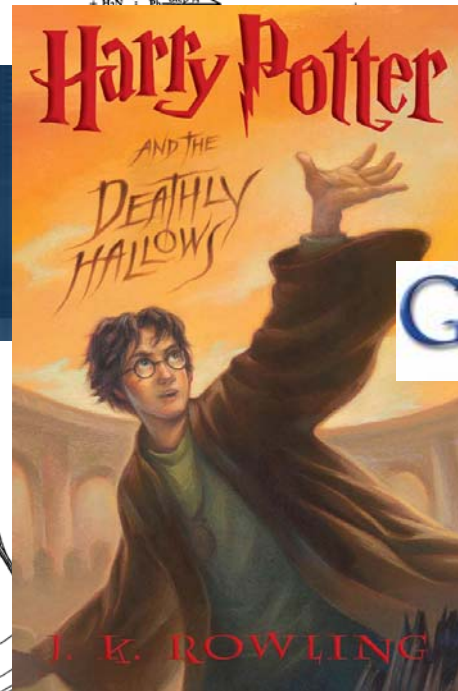
- **U.S. Patent No. 5,966,743: “Substance Dispensing Headgear”**



YOU JUST NEED TO BE INNOVATIVE AND CREATIVE...



Inventor
Thomas U. Edison
for Leonard M. Perrotti



...AND IP SAVVY!

- Conduct IP “Audit”
- Identify IP in new ideas/creations
- File for protection, as necessary
- Spend money wisely – be realistic
- Mine IP portfolio
- Keep track of competitor IP
- Get clearance, if necessary
- Don't forget IP terms in agreements
- Be diligent – claiming and enforcing IPR

Patent, Copyright and Trade Identity Subject Matter

The image shows a screenshot of the HangsRite website with various intellectual property elements highlighted by callouts:

- Service mark for domain name:** Points to the URL <http://www.hangsrite.com>.
- Product claim clearance:** Points to the text "New and improved Neutralizer Sticks now last 5 times longer!!".
- Trade dress and trademark for the tag:** Points to the circular tag on the left with the HangsRite logo and contact information.
- Utility patent and design patent numbers:** Points to the tag's text: "40% recycled plastic USA Patent No. 1294647e USA Patent No. 1294647a".
- Registered word trademark and logo trademark for the brand name and logo:** Points to the "HangsRite®" logo at the top.
- Copyright and trademark for the tagline:** Points to the tagline "When you hang it In style It HangsRite®".
- Trademark for product colors:** Points to a circular graphic of six colored dots representing color options.
- Trade secrets for product formulation (special resin coating resists moths and dust mites):** Points to the text "HangsRite® hangers are available in 6 different color choices to keep your different fabrics organized and separated!".
- Utility patents for special product features (roll date recorder and neutralizer vent bars):** Points to callouts 1, 2, and 3 on the hanger.
- Trade dress and design patent for overall product design and shape:** Points to the overall shape of the hanger.
- Copyright for Web page design:** Points to the bottom of the page.
- Statutory compliance for the promotional offer:** Points to a pink button that says "ENTER to win free HangsRite® products".
- Trademark for 800 number:** Points to the "1.800.HANGERS" text at the bottom.



TRADEMARKS AND TRADE DRESS TIPS FOR PROPER USE, CLEARANCE AND FILING

Cynthia B. Stevens

TRADEMARKS, SERVICE MARKS AND TRADEDRESS

A **trademark** is any word, phrase, symbol, design, sound, color, or non-functional appearance of an article which identifies the source of goods and distinguishes that source from other sources (ex. Verizon, MGM lion roar, UPS color (brown))

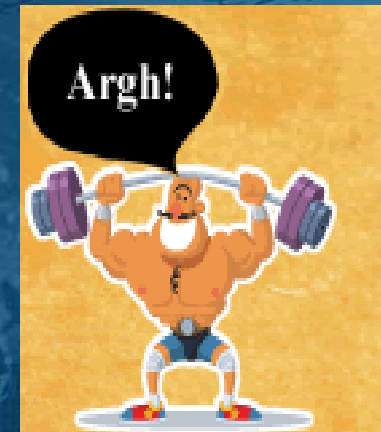
A **service mark** serves to distinguish specific services of one entity from the services of others

Tradedress - the total commercial image of a product -- or place of business -- is known by the term "tradedress"

TYPES OF TRADEMARKS AND SERVICE MARKS

Arbitrary/Fanciful

Strongest
Protection



Suggestive

Weakest
Protection

*Descriptive /
Laudatory*

No Protection

Generic

EXAMPLES OF ARBITRARY OR FANCIFUL MARKS

-  for film
-  computers
- POLAROID for cameras
- KLEENEX for facial tissue
-  for coffee

EXAMPLES OF SUGGESTIVE MARKS



for window cleaners



for bus lines



for automobiles

EXAMPLES OF DESCRIPTIVE MARKS

- COMPUTERLAND for computer store
- READER'S DIGEST for magazines
- FRUIT COOLER for fruit flavored semi-frozen beverage
- VISION CENTER for optical goods and services

TIPS FOR PROPER TRADEMARK USE

- Adherence to the following rules will help to strengthen rights in trademarks, to avoid losing rights in them.
 - Do use the mark as an adjective
- Do not make use of a mark that suggests it is a generic term:
 - Use the mark as a noun
 - Do not pluralize the mark

TIPS FOR PROPER TRADEMARK USE

- Do not modify the mark:
 - Do not abbreviate the mark
 - Do not combine the mark with names or marks of others
 - Do not combine the mark with any other words, numerals or other symbols
- Use the appropriate trademark registration notice, symbol or legend, i.e. “®”, “TM” or “sm”

TIPS FOR PROPER TRADEMARK USE

Many famous marks have been destroyed or damaged in value by improper trademark use. For example:

- “I’ll xerox you a copy” versus “I’ll make you a copy on our XEROX® photocopier”
- “Take an aspirin” versus “Take a BAYER ASPIRIN tablet”
- “Use a kleenex” versus “Use a KLEENEX® FACIAL TISSUE”

TIPS TO ENHANCE AND MAINTAIN TRADEMARK VALUE



- Use of a trademark watch service –
- Check out the competition
- Audit your company's use of its trademarks, industries and

TIPS TO ENHANCE AND MAINTAIN TRADEMARK VALUE

- Trademark license agreement (e.g. Kellogg's and Disney)
- Use of trademark in connection with additional goods or services
- Expansion of geographic zone of protection of rights
 - United States
 - Internationally



TIPS TO AVOID LOSS OF TRADEMARK RIGHTS

- Naked license – failure to control quality of goods or services
- Failure to police rights – allowing confusingly similar third party use
- Genericism – mark used as a noun

TRADEMARK CLEARANCE

WHY BOTHER?

- Trademarks are a valuable asset. Full trademark searches are the best way to avoid objections to use and/or registration to your mark.
- If marks are similar in appearance, sound and/or meaning and used for related goods or services a likelihood of confusion may exist.
- Marks don't need to be identical to be confusingly similar.
- Goods and/or services do not need to be competitive (ex. Beer vs. Restaurants)



Tip – If you were first, would you object to third party's use or registration? If answer is yes, pick another mark!

TIPS FOR TRADEMARK CLEARANCE

Coordinate Efforts

■ Leftover Names

- Look to prior naming projects for marks that cleared, but were not elected
- Does the company own any approved applications for other marks that are adaptable?

■ Licensing Options Among Parents and Subsidiaries

- Are there any marks, or elements from a family of marks, that can be borrowed from within the organization
- Opportunities through joint venture agreements

■ Opportunities to Borrow Elements from Strategic Partners

- Assignment of marks among members of a joint venture

TIPS FOR TRADEMARK CLEARANCE

Involve Legal Counsel Early

■ Perform knock-out searches

- Perform preliminary screening searches simultaneous with creative efforts
- Performing preliminary screening searches after the list of preliminary candidates is generated will result in increased creative efforts
- Facilitates creation of informed alternatives
- Rule out direct conflicts to move the creative process along
- Early identification of direct hits removes common themes from consideration

□ Don't wait until last minute!

TIPS FOR TRADEMARK CLEARANCE

Geographic Scope and Timing

- The broader the anticipated market, the longer the timeline that will be required to clear a new mark. Focus on primary markets.
- Since each country has its own trademark laws, it is important to evaluate each country as if it is a separate mark.
 - i.e. four (4) potential marks x U.S. (1) and European Union (27 + CTM) = Clearance of 116 Marks.

TIPS FOR TRADEMARK CLEARANCE

Comprehensive Search Considerations

■ Translations and Meanings

- Does the proposed mark have a different meaning in a foreign language
- Be aware of cultural or slang connotations

■ Pronunciation

- Silent consonant and vowels
- Different letter emphasis

■ Pattern Matching

- Vowel / Consonant combinations that yield similarities
 - Examples: “xy” versus “zi”
 - “ks” versus “x”

TRADEMARK REGISTRATIONS WHY BOTHER?

Benefits of Federal Registration

- Trademarks are a valuable asset
- Nationwide rights
- Incontestable registration – limits grounds for challenge (abandonment, functionality, genericness or fraud)
- Registrant presumed to be owner of mark covered in registration
- Constructive notice

Benefits of Foreign Registration

- In many foreign jurisdictions the first to file has trademark rights

TIPS FOR FILING TRADEMARK APPLICATIONS

Where and What Type of Application To File

- U.S.

- Intent-to-Use application through U.S. Patent and Trademark Office

- Use based applications

TIPS FOR FILING TRADEMARK APPLICATIONS

Where and what type of application to file

■ European Community Trade Mark

- Filed with the Office for Harmonization of the Internal Market
- Allows registration for broader identification of goods than in U.S.
- Subject to superior rights in any EU member nation – all or nothing
- Transfer with priority filing date into desired member nations available
- Covers 27 countries in one application

■ European National Filings

- Many countries provide expedited examination
- Regulatory perspectives

TIPS FOR FILING TRADEMARK APPLICATIONS

Where and What Type of Application To File

■ Madrid Protocol

— Benefits

- Single application, in one language and currency
- Over 50 countries and intergovernmental organizations
- Assignment requires a single filing

— Drawbacks

- Description of goods only as broad as the underlying (“basic”) application
- Reliance or dependency upon underlying registration for five years

— Comments

- U.S. companies slow to adopt Community Trade Mark
- Now U.S. companies outpace European companies for CTM filings
- Although U.S. companies are not presently using Madrid pervasively, it may gain in popularity and become part of standard filing program

SUMMARY OF TIPS FOR FILING TRADEMARK APPLICATIONS

- File Intent-to-Use (“ITU”) applications with U.S. Patent and Trademark Office immediately upon clearance
 - To the extent the application matures to registration, the filing date of an ITU is deemed “constructive” use date for purposes of determining priority in disputes
- File in Priority Geographic Areas
 - Consider Community Trade Mark
Austria; Belgium; Bulgaria; Cyprus; Czech Republic; Denmark; Estonia; Finland; France; Germany; Greece; Hungary; Ireland; Italy; Latvia; Lithuania; Luxembourg; Malta; Netherlands; Poland; Portugal; Romania; Slovakia; Slovenia; Spain; Sweden; United Kingdom of Great Britain
 - Consider filing under the Madrid Protocol
- File National Applications in Treaty Member Countries
 - Faster examination yields prompt registration
- File Supplemental Applications Within Six Months
 - Priority filing date preserved for filings in other treaty member countries when filed within six months

TIPS FOR DOMAIN NAME FILING

- Register major marks as domain names
 - Also register under .net, .org and other TLDs
- Maintain central list of domain names
- Evaluate new TLDs promptly to determine if additional domain names should be registered
- Search new third party domain names regularly
- File UDRP domain name Complaint, if necessary



COPYRIGHTS & PATENTS

Debra D. Nye

WHAT IS COPYRIGHT?

- Protects original works of authorship that are fixed in any tangible form
- The copyright owner has the exclusive right to do the following with the work:
 - *Reproduce
 - *Publish
 - *Distribute
 - *Publicly display
 - *Create derivative works
 - *Publicly perform

WHAT WORKS ARE PROTECTED?

- Literary works;
 - Musical works, including any accompanying words ;
 - Dramatic works, including any accompanying music;
 - Pantomimes and choreographic works;
 - Pictorial, graphic, and sculptural works;
 - Motion pictures and other audiovisual works;
 - Sound recordings; and
 - Architectural works.
- **THINK BROADLY!!!**

WHAT IS NOT PROTECTED BY COPYRIGHT?

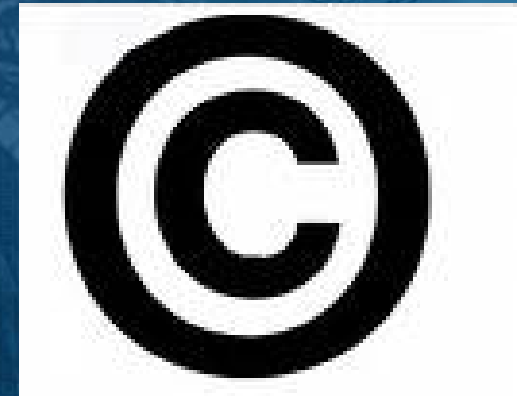
- Copyright does not protect the underlying idea or principle, but rather only the specific manner in which the idea is expressed
- For example: standard calendars, height and weight charts, tape measures or rulers etc. are not eligible.

NATURE AND ACQUISITION OF COPYRIGHTS

- A copyright exists in a work upon its CREATION regardless of registration or use of a copyright © notice.
- No publication or registration or other action in the Copyright Office is required to secure a copyright.
- Registration of a copyright with the U.S. Copyright Office is a legal formality that establishes a public record of a copyright claim and is required before filing a copyright infringement suit in a Court.

NOTICE OF COPYRIGHT

- Use of a copyright notice is NOT required under U.S. law, but it is beneficial and can protect against the “innocent infringer” defense.
- Proper copyright notice informs the public that the work is protected and includes © [year of first publication] [copyright owner name]
- For example: © 2008 Nye



OWNERSHIP OF COPYRIGHT

- The copyright in a work of authorship immediately becomes the property of the author who created the work with the exception of:
 - Works made for Hire
 - Some specially ordered or commissioned work

EXAMPLES OF MATERIAL THAT MAY HAVE COPYRIGHT PROTECTION

- *Web content
- *Product Packaging
- *Advertising and Promotional materials
- *Operations Manuals
- *Company proposals
- *Training Manuals
- *Software
- *Graphics
- *Movies
- *Photographs
- *Drawings
- *Articles
- *Audio works

COPYRIGHT TIPS

- Provide copyright notices on your copyrighted works and keep them updated.
- Contract provisions with third-parties and with employees providing that any copyrighted work belongs to the company – “works made for hire”

WHAT IS A PATENT?

- A limited grant from the U.S. government giving the inventor the right to exclude others from making, using offering to sell, selling or importing the patented invention
- Only in the U.S.
- The right to exclude is measured by how the claims of the patent define the invention.

(12) **United States Patent**
Plew

(10) **Patent No.:** US 6,733,362 B2
(45) **Date of Patent:** May 11, 2004

(54) **BRASSIERE**

(76) **Inventor:** Katerina Plew, 220 Adirondack Dr., Selden, NY (US) 11784

(*) **Notice:** Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 0 days.

(21) **Appl. No.:** 10/173,946
(22) **Filed:** Jun. 18, 2002
(65) **Prior Publication Data**
US 2003/0232573 A1 Dec. 18, 2003
(51) **Int. Cl. 7** A41C 3/00
(52) **U.S. Cl.** 450/86; 450/1; 2/67
(58) **Field of Search** 450/1, 81, 90, 450/86, 88; 2/67, 255, 258, 260, 274, 73, 78.1-78.3

(56) **References Cited**
U.S. PATENT DOCUMENTS
2,289,679 A * 7/1942 Porter 2/67
2,524,620 A * 10/1950 Cadoux 450/81
2,628,356 A * 2/1953 Rosenfield et al. 450/81
2,753,569 A * 7/1956 Schmalz 450/86

2,780,418 A * 2/1957 Garson 450/86
2,988,287 A * 6/1961 Krieger 450/81
3,244,175 A * 4/1966 Sturges 450/90
3,254,653 A * 6/1966 Krieger 450/81
3,306,299 A * 2/1967 Paramore 450/86
3,527,231 A * 9/1970 Catanese et al. 450/86
6,086,451 A * 7/2000 Fernandes 450/86
6,332,825 B1 * 12/2001 Hennicksen 450/81

* cited by examiner
Primary Examiner—Gloria M. Hale

(57) **ABSTRACT**
An improved brassiere of the type having a pair of cups, torso bands, and shoulder strap, and apparatus for connecting the pair of shoulder straps. The improvement includes the apparatus including a strip of fabric loops extending along free upper edges of the pair of torso bands and free upper edges of the pair of cups, a pair of fabric loops that are overlying aligned with each other, and are disposed in a space between the pair of cups at free upper edges of the pair of cups, an upper strip of material that is preferably silicon and overlies the strip of fabric loops and the pair of fabric loops for preventing discomfort to a wearer and keeping the brassiere in place, and a lower strip of material that is preferably silicon and overlies free lower edges of the pair of torso bands for further keeping the brassiere in place.

9 Claims, 2 Drawing Sheets

WHAT IS THE PUBLIC POLICY?

- To encourage inventors to disclose their inventions to the public in return for the limited right to exclude others from practicing the invention.

WHY GET PATENTS?

- To protect the investment in research and development of your product or process and prevent others from copying your invention.
- To license your invention to others and thereby generate licensing revenues.
- To have bargaining chips for cross licensing
- Defensive prior art – keep your competitors from getting a patent.
- To increase your company's value

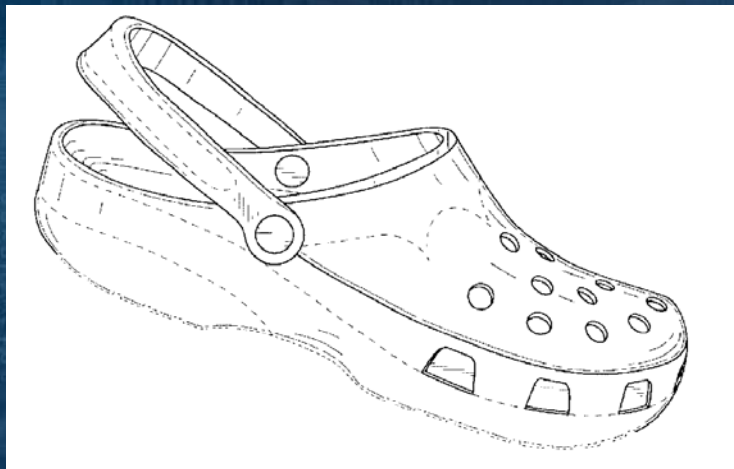
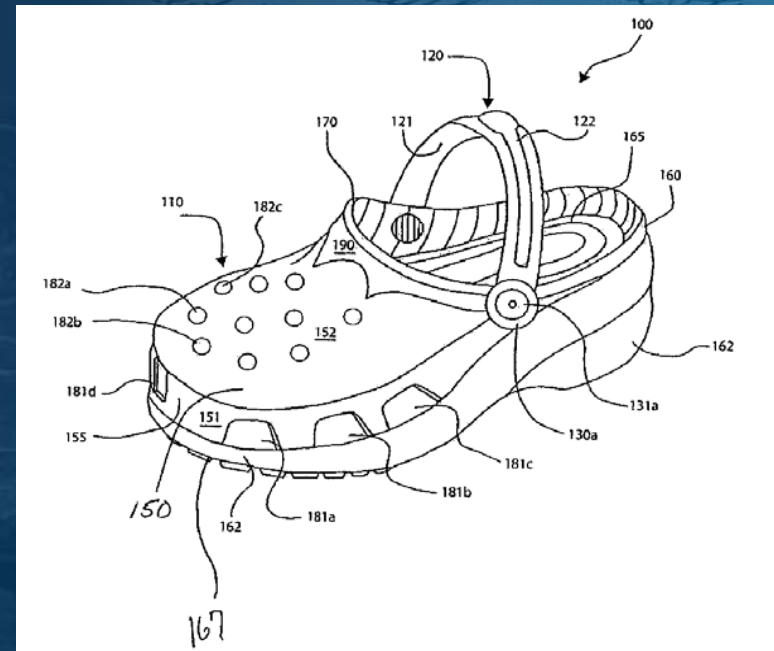
TYPES OF PATENTS

- Utility – processes, machines, articles of manufacture, compositions of matter, methods of manufacture, methods of use, and business methods.
- Design – ornamental aspects of an article.
- Plant – plants that can be asexually reproduced.
- Plant Variety – novel varieties of sexually reproduced plants.

WHAT IS THE DURATION OF A PATENT?

UTILITY PATENT = 20 years from the date the patent application is filed.

U.S. 6,993,858: Breathable Footwear Pieces



DESIGN PATENT = 14 years from the date of issuance.

U.S. Des. 517,789: Footwear

WHAT ARE THE REQUIREMENTS FOR PATENTABILITY?

- **New** – It has not already been invented by someone else.
- **Non-obvious** – It is not an obvious variation of a prior invention
- **Useful** – It has a useful purpose
- **Disclosure** – Patent specification must describe the invention in detail and enable one of skill in the art how to make and use it.
- **Time Bars**

ONE YEAR STATUTORY BAR

- Must apply for a U.S. patent within one year after you use it or offer it for sale in the U.S. or you disclose it in a publication.
- The time bar is part of the give and take philosophy for a Patent.





US006293874B1

(12) United States Patent
Armstrong

(10) **Patent No.:** **US 6,293,874 B1**
(45) **Date of Patent:** **Sep. 25, 2001**

(54) USER-OPERATED AMUSEMENT APPARATUS FOR KICKING THE USER'S BUTTOCKS

Primary Examiner—Joe H. Cheng
Assistant Examiner—Kim T. Nguyen
(74) *Attorney, Agent, or Firm*—Pitts & Brittan, P.C.

(76) **Inventor:** **Joe W. Armstrong**, 306 Kingston St., Lenoir, TN (US) 37771-2408

(57) **ABSTRACT**

(*) **Notice:** Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 0 days.

An amusement apparatus including a user-operated and controlled apparatus for self-infliction of repetitive blows to the user's buttocks by a plurality of elongated arms bearing flexible extensions that rotate under the user's control. The apparatus includes a platform foldable at a mid-section, having first post and second upstanding posts detachably mounted thereon. The first post is provided with a crank positioned at a height thereon which requires the user to bend forward toward the first post while grasping the crank with both hands, to prominently present his buttocks toward the second post. The second post is provided with a plurality of rotating arms detachably mounted thereon, with a central axis of the rotating arms positioned at a height generally level with the user's buttocks. The elongated arms are propelled by the user's movement of the crank, which is operatively connected by a drive train to the central axis of the rotating arms. As the user rotates the crank, the user's buttocks are paddled by flexible shoes located on each outboard end of the elongated arms to provide amusement to the user and viewers of the paddling. The amusement apparatus is foldable into a self-contained package for storage or shipping.

(21) **Appl. No.:** **09/477,175**

(22) **Filed:** **Jan. 4, 2000**

(51) **Int. Cl.:** **A63H 37/00**

(52) **U.S. Cl.:** **472/51; 472/55**

(58) **Field of Search:** **472/51, 55, 137; 482/51, 72, 148**

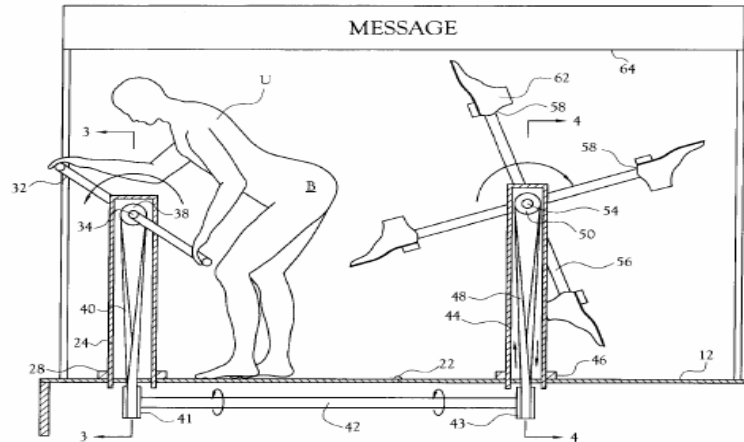
(56) References Cited

U.S. PATENT DOCUMENTS

654,611	7/1900	De Moulin .	
920,837	5/1909	De Moulin .	
953,411	3/1910	De Moulin .	
966,935	8/1910	Mamaux .	
976,851	11/1910	De Moulin .	
1,175,372	3/1916	Newcomb .	
4,457,100 *	7/1984	Nightingale .	446/333
5,785,601 *	7/1998	Kubsheski et al. .	472/135

* cited by examiner

14 Claims, 7 Drawing Sheets



PATENT PROSECUTION PROCESS

- Patent application is filed in the U.S. Patent & Trademark Office along with prior art disclosure.
- Application is assigned to an examiner in the technical art to which it pertains.
- Examiner determines whether the application meets patentability requirements and issues an Office Action setting forth the reasons for rejection or allowance.
- Applicant responds with arguments & optionally amendments to the claims and specification.
- Examiner issues a second Office Action; if reasons for rejection are not new then the Action is FINAL.
- Applicant has various options after FINAL rejection, including response, appeal, and RCE.

WHAT HAPPENS WHEN CLAIMS ARE ALLOWED AND PATENT ISSUES?

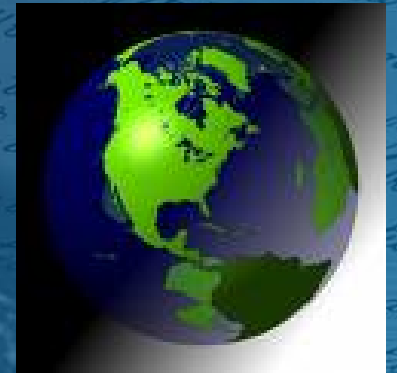
- If the Examiner issues a Notice of Allowance, then the patent issues after payment of fees.
- After allowance, maintenance fees must be paid at 3 ½ , 7 ½ and 11 ½ years after the patent issues.

U.S. VS FOREIGN PATENTS

- U.S. has a First-to-Invent system
- All other countries have a First-to-File system
- Otherwise patentability requirements are substantially similar to the U.S.
- Foreign patents usually obtained through Patent Cooperation Treaty (PCT) application process

TIP: THINK GLOBALLY!

- Which countries?
 - In “core business” countries
 - Where the customers are
 - Where the competitors are
 - In countries that have strong patent laws and patent law enforcement.
- Foreign patents may be more expensive than U.S. patents.
- One application for all PCT member countries can be filed in any PCT Receiving Office.

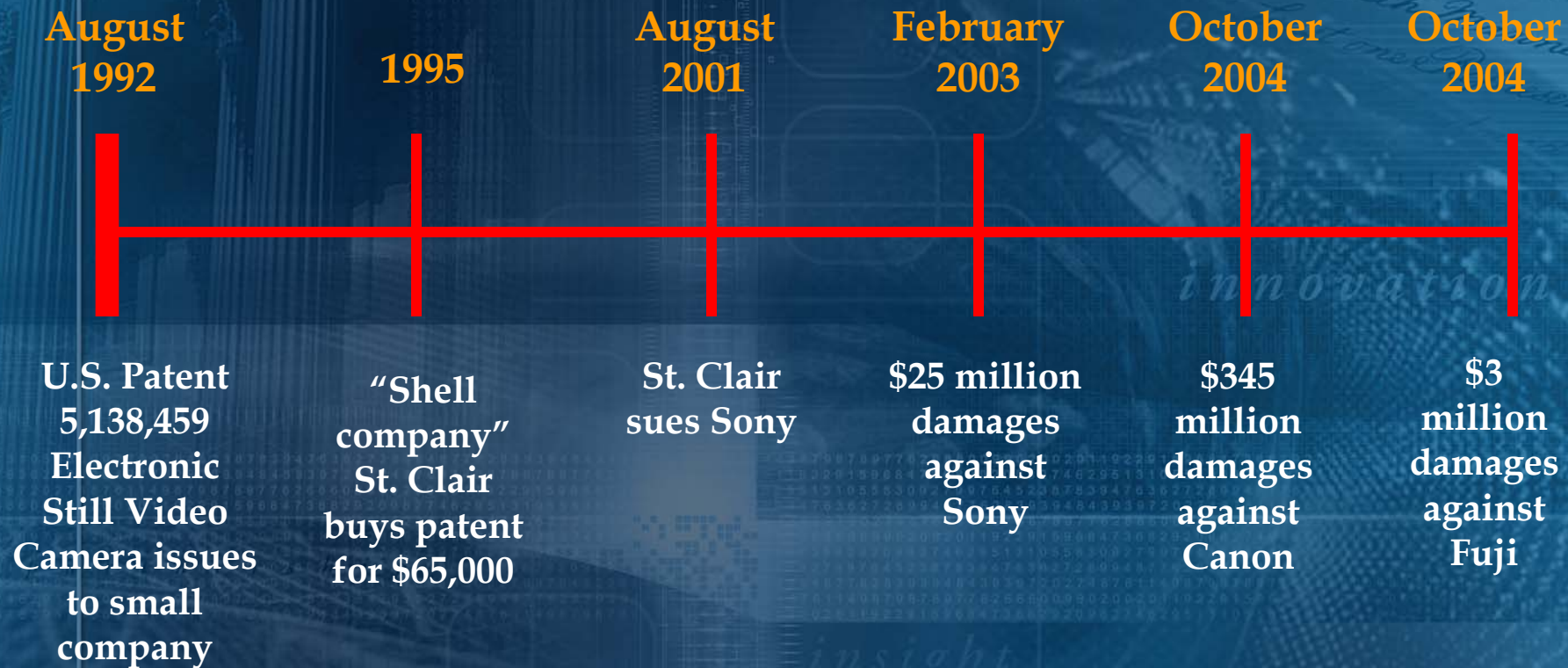


ENFORCEMENT OF PATENTS

- Enforcement of patents through litigation can be very expensive.
- Patents may be licensed or sold to others, who can also enforce the patent.
- Infringement of patents by others may be hard to police.

WHAT IS THE POTENTIAL VALUE OF A PATENT?

The History of the St. Clair Patent



TIPS FOR PATENT PROCUREMENT

- What is your invention?
 - New product or machine
 - New method of using a new or preexisting product
 - Improvement to pre-existing product
- Consider merits of patenting versus trade secret protection
- Patentability Search
- How to do the IP portfolio buildup – where is your industry going?

TIPS FOR GOOD COMPANY PRACTICES

- Keep Up-to-Date and Accurate Records – laboratory notebooks for documenting dates of conception and reduction to practice of invention.
- Provide Invention Disclosure Forms to employees – to describe invention and disclose inventors – mini patent application.
- Don't delay!
- Don't disclose to third-parties!

DON'T FORGET YOUR COMPETITORS' PATENTS

- Did someone already obtain a patent on your product or method?
- Search U.S. and foreign issued patents and published patent applications early in product development
- Can you “design around” or take a license from your competitor? – cross-license your IP?



TRADE SECRETS & AGREEMENTS

Andrea M. Augustine

WHAT IS A TRADE SECRET?

Trade secret information is:
(1) information; (2) that has value because it is not generally known; and (3) that is maintained in secrecy.

HOW LONG DOES A TRADE SECRET LAST?

Indefinitely, as long as you can keep it a secret!

[insert shhh symbol]

TRADE SECRET EXAMPLES

- Predictions,
- Opinions,
- Reports,
- Scientific processes of all kinds,
- Product blueprints,
- Algorithms,
- Database compilations,
- Manufacturing processes,
- Technical data (such as the result of tests),
- Negative know-how (knowledge that certain approach does not work),
- Customer lists,
- Formulae,
- Recipes,
- Plans and drawings,
- Pricing information,
- Business strategies.

FAMOUS TRADE SECRETS?

- Coke formula (i.e., Merchandise 7X)
- KFC recipe (i.e., 11 herbs and spices)
- McDonald's Big Mac special sauce
- Oreo cookie cream
- Owens-Corning Fiberglass formula
- Reality Show winner (e.g., Survivor)

TRADE SECRET ANALYSIS

1. Is the information in question known outside your business?
2. Is the information in question known by employees and others involved in your business?
3. What measures are you taking to safeguard the secrecy of the information?
4. How valuable is the information to you and your competitors?
5. How expensive was it to develop or compile the information?
6. How difficult would it be to reverse engineer or otherwise acquire the information legally?

TRADE SECRET PROTECTION

Three-stage approach

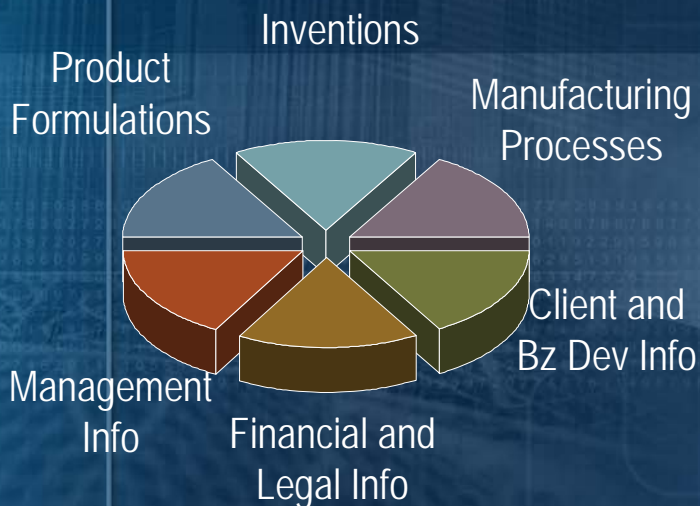
Identify and categorize information



Establish policies, procedures and agreements



Adopt an on-going management plan



- Physical plant security
- Interior security
- Third-party security
- Employee security

- Verify legal obligations
- Regularly update confidential info
- Confirm adherence

WHAT HAPPENS IF SOMEONE STEALS MY TRADE SECRET?

- Sue for trade secret misappropriation (injunction and damages)
- Theft of trade secrets is a federal criminal offense. (The Economic Espionage Act of 1996).
- Crime to convert a trade secret for own benefit or benefit of others – intending or knowing it will injure the owner
- Crime to receive, buy or possess trade secret information of another knowing it was stolen



TRADE SECRET TIPS

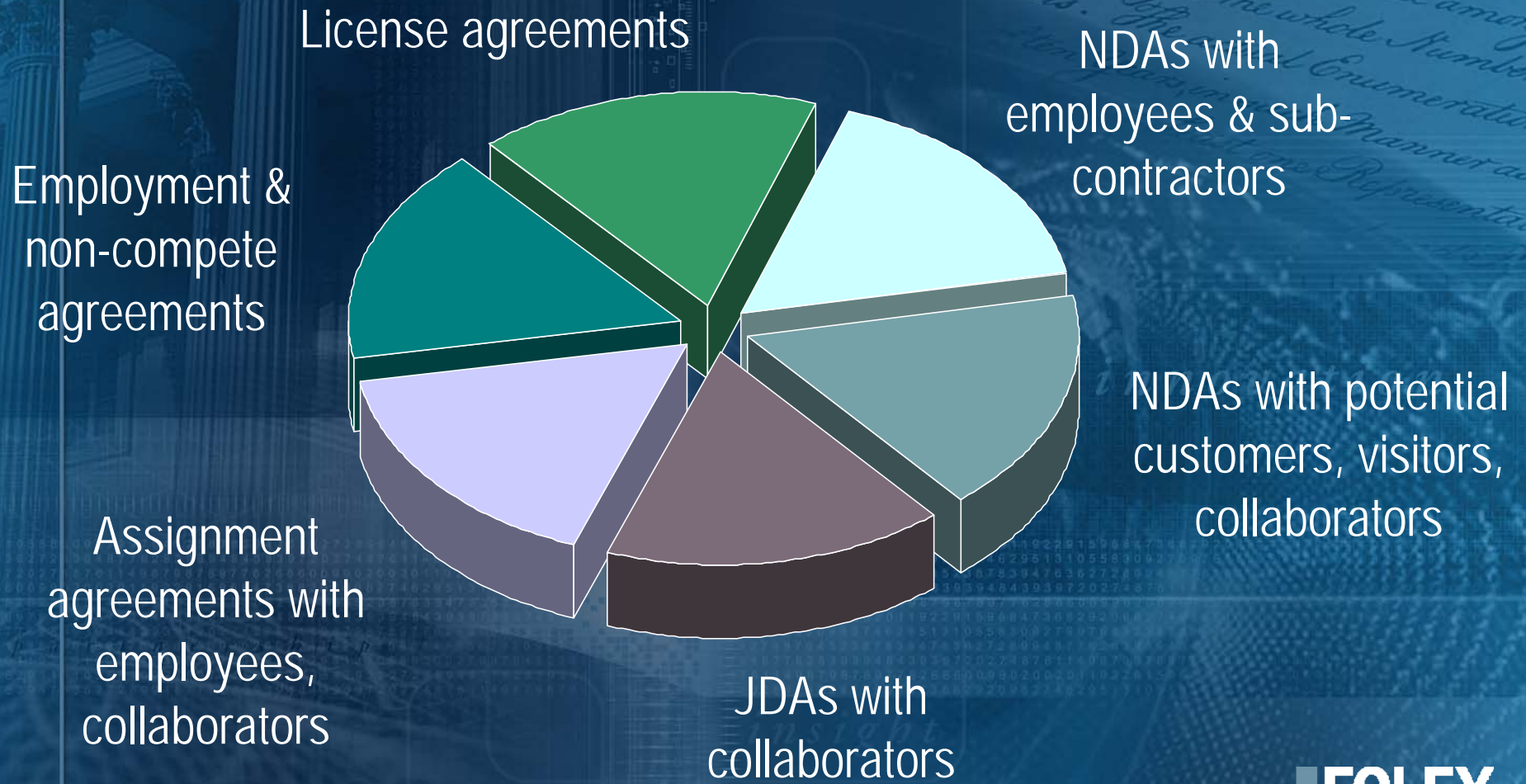
- Obtain confidentiality agreements and establish confidential relationship with employees
- Code information and use passwords
- All third party agreements should acknowledge and respect confidentiality
- Install and use effective building security
- Restrict access/visitors/keep to “need to know”
- Segregate trade secret processes into steps and divide among various employees or departments
- Use appropriate confidentiality markings/signage
- Control dissemination of information
- Consistency for multinational employees and joint venture partners

MOST IMPORTANT TIP

- KEEP YOUR TRADE SECRET A SECRET!
- Once it's disclosed, it's not a trade secret anymore!!!!



IP-RELATED AGREEMENTS



DON'T FORGET IP-RELATED TERMS IN NON-IP AGREEMENTS

- Confidentiality
- Indemnification
- Reps & Warranties
- Disclaimers



CONTRACTING TIPS:

- Implement pre-hiring checklist
- Collection of standard agreements
- Collection of standard IP-related terms
- Policy re: IP-related agreements/IP terms
- Train employees on policy and importance of IP terms
- Establish repository for all executed agreements
- Monitor expiration dates of agreements
- Create recognizable look-and-feel

CONTRACTING TIPS:

- Prepare standard warning letters
- Identify opportunities to generate revenue
- Establish novel ways of licensing
- Identify appropriate licensees
- Conduct royalty audits
- Determine whether IP donations are appropriate

FOLEY
FOLEY & LARDNER LLP

QUESTIONS?

innovation

insight



THANK YOU!

Andrea M. Augustine
Foley & Lardner LLP
321 N. Clark Street
Suite 2800
Chicago, Illinois 60610
312-832-4582

Cynthia B. Stevens
Foley & Lardner LLP
321 N. Clark Street
Suite 2800
Chicago, Illinois 60610
312-832-4556

Debbie D. Nye
Foley & Lardner LLP
11250 El Camino Real
Suite 200
San Diego, CA 92130
858-847-6730