

Protecting Your Company's Intellectual Property Assets

Presented by:
Peter Dichiara, Partner

 **#WHQSU**

WILMERHALE® 

WILMER CUTLER PICKERING HALE AND DORR LLP ©



Why Should I Care About IP Protection?

- Build defensible competitive advantage
- Protection against imitation or copying
- Drives investment and enterprise value
- Ensure Company can continue business if personnel leave
- Defense in IP litigation
- Potential licensing revenue





Categories of Intellectual Property

- Patents covering inventions



- Copyrights covering “works of authorship”



- Trade secret rights covering your “secret sauce”



- Trademarks covering your Company and product/service branding





Patents

- Protects inventive products, systems, and methods including software
- Must be novel, non-obvious, and useful
- Protection defined by patent “claims”



What To Patent

- Inventions
- Technology at core of your business
- Technology important to competitors
- Consider patents for technology with important marketing or business advantages



Types of Patent Applications

Provisional

- Less formal application – no requirements for format
- Can establish priority date for invention; no other rights
- Can be much less expensive than utility

Utility

- Formal application
- Examined by PTO
- Provides legal rights to exclude others from making, using, selling the claimed invention



Saving Costs on Patent Applications

The company can draft most of the provisional application to save attorney costs:

- The specification: can be as simple as a whitepaper or presentation
 - The more detail, the better
 - Be sure to describe invention so one of “skill in the art” (i.e., a person like you) can make and use it





America Invents Act (AIA)

First-to-File System (applications filed after March 16, 2013)

- Patent rights awarded to first inventor to make United States or foreign patent filing
 - Who invented first no longer important
 - Inventors can no longer “swear behind” applications or prior art
- Prior art now includes all prior patents and published applications (U.S. or foreign)
- Prior art now includes public uses and sales outside the United States, and inventions “otherwise available to the public”



Trade Secrets vs. Patents

- Trade secret advantages over patents
 - Can essentially cover anything of value, e.g., customer lists, Coca-cola recipe.
 - No time limits (compared to 20 years for patents)
- Trade secret disadvantages to patents
 - Monetary value to company: patents are easily licensed and/or transferred upon merger or acquisition
 - Trade secrets can be licensed, but it is much more difficult and complex; also more difficult to transfer in a merger or acquisition
 - Disclosure of trade secret defeats the company's rights
 - Competitors can hire away key employees, reverse-engineer products, or independently replicate the trade secret



Choosing Your Brand

- Search to ensure no close trademarks
 - Patent and Trademark Office search engine
 - Google
- More abstract marks provide broader protection
 - A meaningless word (Zynga) or a word that is unrelated to the business (Apple) will get broader protection
 - Words that are descriptive of the business (Pets.com) will get narrower protection



Common Law vs. Registered Trademarks

- Common law— a company can establish rights in a mark based on use of the mark in commerce
 - May allow company to challenge a trademark registration or application
 - Typically geographically restricted to actual use
- Federal Registration
 - A legal presumption of ownership, nationwide rights for listed categories of goods/services
 - Easier to enforce your rights
 - Investor comfort
 - Relatively low cost (if there is no opposition)



Copyrights

- Protects expression against copying
- Rights automatically vest upon creation – registration not required (although advisable)
- Provide copyright notices on:
 - GUIs/screen displays
 - Manuals, brochures, and other documents that are generally published or going to particular third parties
 - For software-based product/service offerings, the company should embed plain language copyright notices in (1) un-compiled source code and (2) user interface



Open Source

Pros:

- Free (in terms of \$)
- Faster than doing it yourself
- Many high quality projects

Cons:

- Viral “copyleft” licenses such as GNU General Public License (GPL) and Lesser General Public License (LGPL) can “infect” your proprietary code
- Potential customer/partner concerns



Open Source

- Internal policy/training/re-training
- Track everything
- Comply with attribution/flow-down requirements
- Consult with attorney regarding usage of GPL/LGPL code



Questions?

Peter Dichiara

Partner, Intellectual Property
Department

+1 617 526 6466

Peter.Dichiara@wilmerhale.com

 **#WHQSU**