

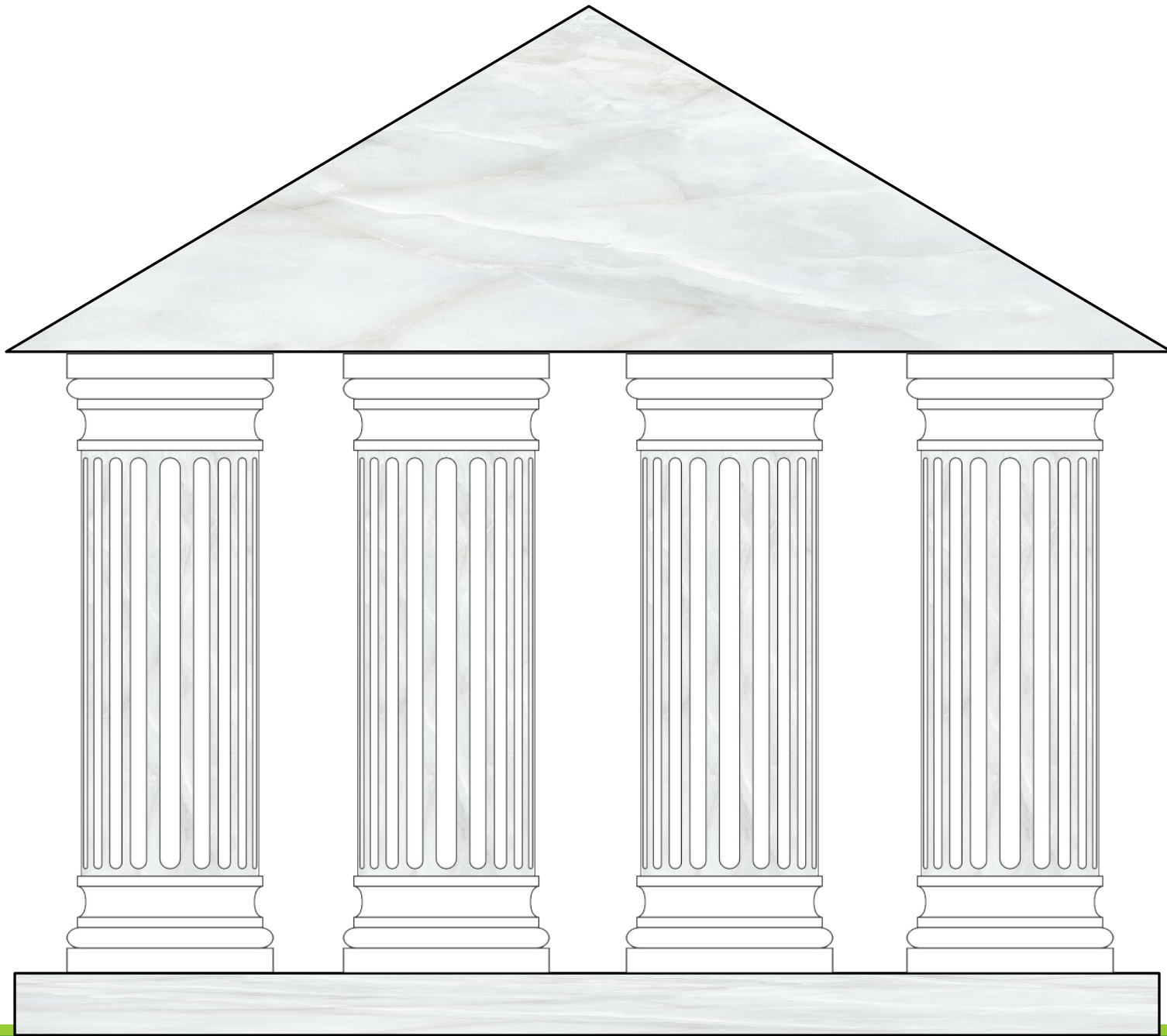
IP 201: Business Planning for Patents, Trademarks, Copyrights and Trade Secrets

Welcome to the Surf Incubator and to our class!

Please help yourself to:

- coffee in the mini-kitchen right outside this room
- filtered water from the fountain down the hall, outside the restrooms
- snacks in the back

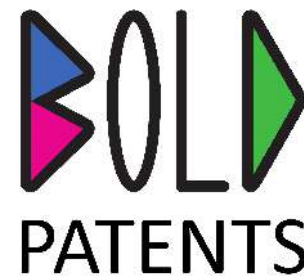
We will get started at 8am!



IP 201: Business Planning for Patents, Trademarks, Copyrights and Trade Secrets

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Founder of Bold IP, PLLC

March 2, 2018



Intellectual Property Series: 101,201, and 301

February 2, 2018

March 2, 2018

April 6, 2018

May 4, 2018



IP 101:
Learning the Law of
Patents, Trademarks,
Copyrights and Trade
Secrets and how they
apply to your
business/startup

IP 201:
Creating a plan for
Patents, Trademarks,
Copyrights and Trade
Secrets into your
business/startup

IP 301:
Implementing Patents,
Trademarks, Copyrights
and Trade Secrets into
your business/startup

IP 101:
Learning the Law of
Patents, Trademarks,
Copyrights and Trade
Secrets and how they
apply to your
business/startup

Agenda:

8:00-8:05: Gather, Coffee, and Get Seated

8:05-8:15: Around-the-Room Introductions

8:15-9:00: Refresher on Basics of the Laws

9:00-9:20: Legal Foundations Workshop

9:20-9:30: 10-Minute Networking Break

9:30-10:20: Business & IP Plan Components I

10:20-10:40: Business & IP Plan Workshop I

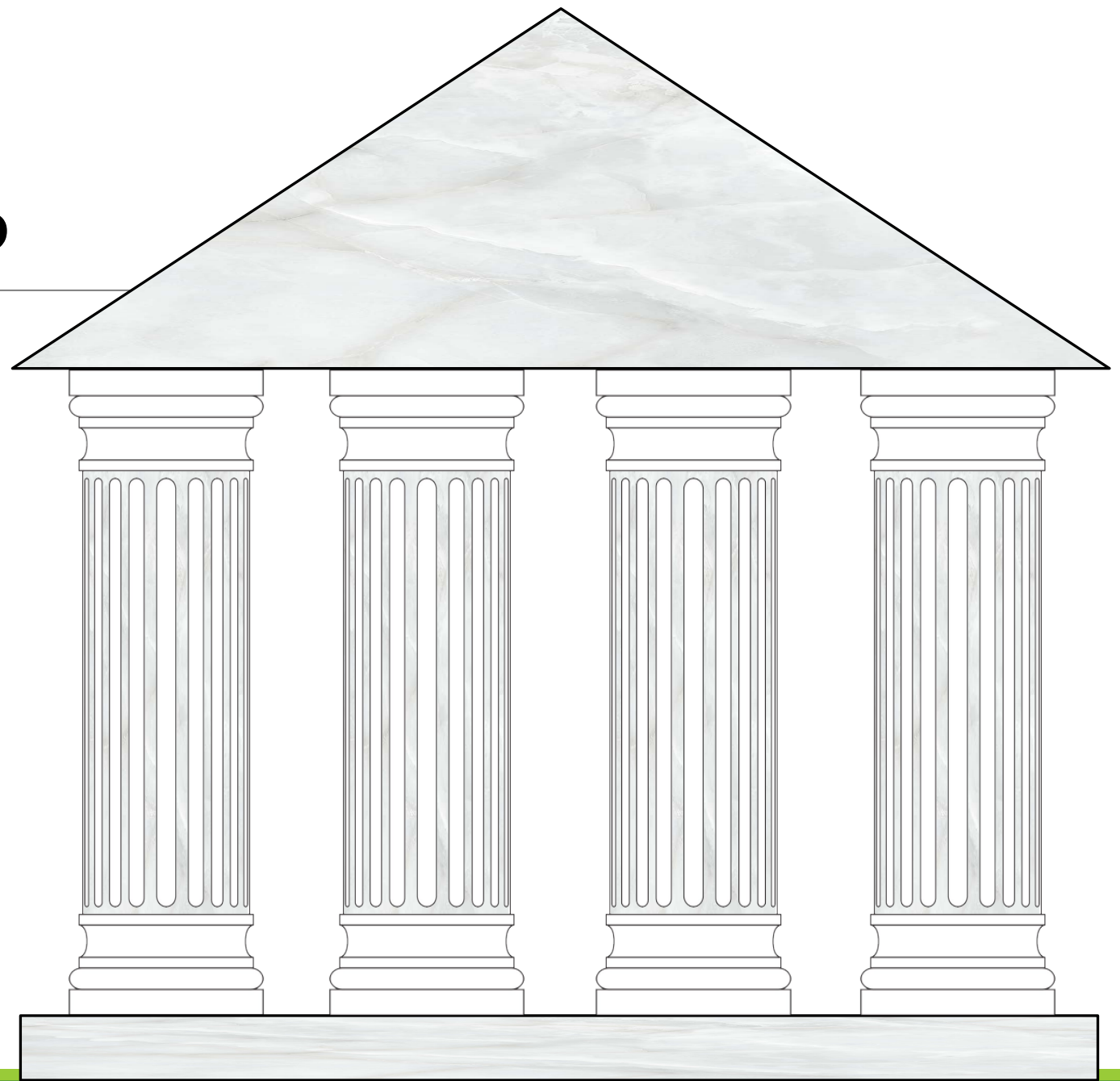
10:40-10:50 – 10-Minute Break

10:50-11:40 – Business & IP Plan Components II

11:40-12:00: Business & IP Plan Workshop II

The 4 Pillars of IP

- Patents
- Trademarks
- Copyrights
- Trade Secrets



Patent Law Primer

A Patent gives an inventor the right to exclude others from making, using, selling, or importing the invention into the US (or other countries) for a period of 20 years from the date of filing.

Three requirements to get a patent

- Novelty
- Non-obviousness
- Utility (or 3D/Aesthetic Shape for Design)

Types of Patents

- Utility Patents
 - Eligibility: Device, Manufacture, Composition of Matter or Process/Method
- Design Patents
- Plant Patents

American Invents Act

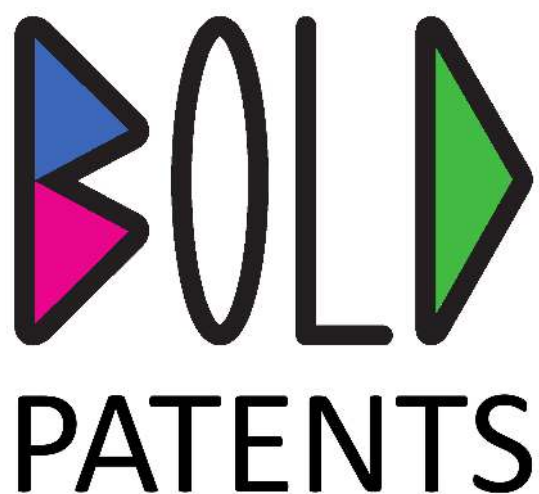
- First to File vs. First to Invent
- Worldwide Prior Art
- Patent Trial and Appeal Board (PTAB)

Timing is Critical

- Best to FILE before public disclosure
 - Use NDA if you must disclose
- Statutory Bars for Selling or Publicly Disclosing
- 1-Year Grace Period for US

Enforcement

- Federal Court
- PTAB
- Settlement/License



Simplified

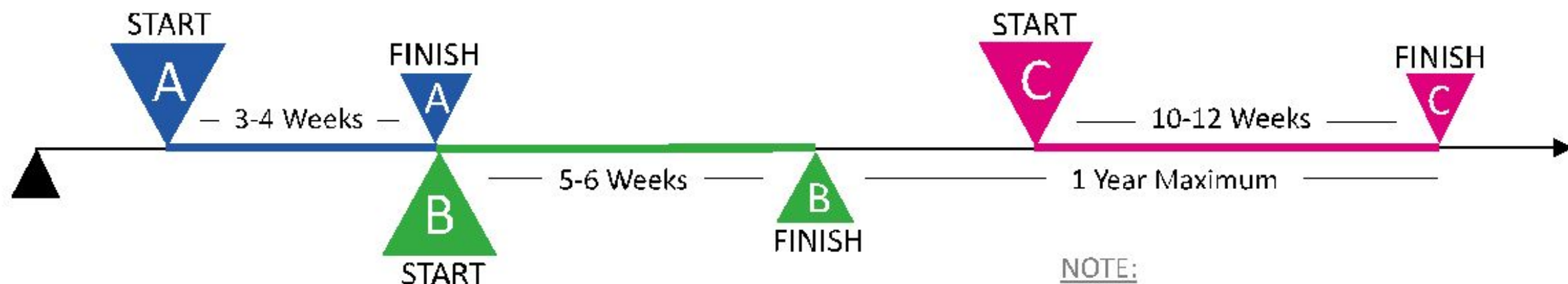
A-B-C Patent Application Process Flow

Patentability Search:

- Takes 3-4 Weeks
- Answer on Patentability/Scope
- Recommended Path Forward

Nonprovisional Patent Application:

- Takes 10-12 Weeks
- Update Specification/Drawings
- Draft Claim Language



Initial Consultation:

- Eligibility Issues
- Inventorship/Ownership
- Long-Term Business Goals

Provisional Patent Application:

- Takes 5-6 Weeks
- "Patent Pending" status
- Develop *Enabling* Disclosure

NOTE:

Submittal of the Nonprovisional Patent Application "C" must be done within 1 year of submittal of the Provisional Patent Application "B" date.

Trademark Law Primer

A Federal Trademark registration gives a business or brand owner the right to exclude others from using a word or design mark within one or more legal classifications for as long as the mark is in use.

Three requirements to get a trademark

- Distinctiveness / Not Confusingly Similar
- Used in Commerce
- Source Identifying

Types of Trademarks

- Word Marks
- Design Marks
- Service Marks
- State Marks

Lanham Act

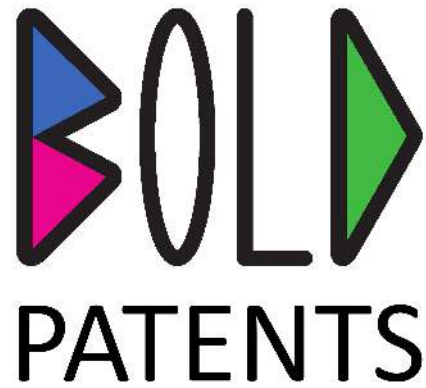
- First in Use Get Priority
- USPTO Search & Examination
- Trademark Trial and Appeal Board (TTAB)
- Common Law rights prior to registration

Timing is Critical

- Best to FILE even before use as an “intent-to-use” to make sure no one else files before you or shows evidence of use in commerce
- USPTO will Publish for Opposition (30 days)
- Must show *Continuous use* throughout

Enforcement

- State and Federal Court
- TTAB
- Settlement/License



Simplified

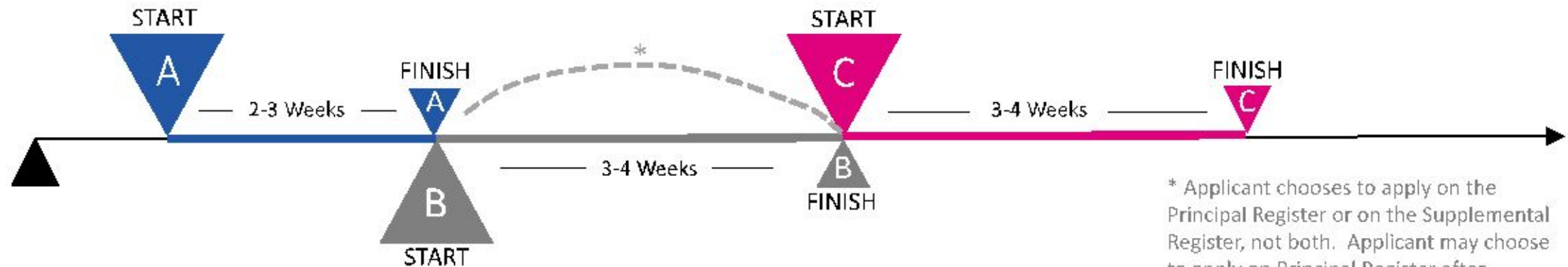
A-B-C Trademark Application Process Flow

Trademark Search:

- Takes 2-3 Weeks
- Answer on Trademark Availability
- Recommended Path Forward

Principal Register Trademark Application:

- Takes 3-4 Weeks
- Detailed list of goods/services **
- Description of the mark
- Grants trademark national recognition and protects from infringement throughout US



Initial Consultation:

- Eligibility Issues
- Ownership
- Areas of Commerce
- Goals of Business

Supplemental Register Trademark Application:

- Takes 3-4 Weeks
- Detailed list of goods/services
- Description of the mark
- Grants trademark recognition in specific state and protects from infringement in that state

* Applicant chooses to apply on the Principal Register or on the Supplemental Register, not both. Applicant may choose to apply on Principal Register after trademark is registered on Supplemental Register, but usually not vice versa.

**When applying for a trademark on the Principal Register, can apply for a mark already in use or can apply on an intent to use basis.

Copyright Law Primer

A Copyright registration provides prima facie evidence for at least one author of a creative work with regard to content, timing, ownership, and use requirements.

Three requirements to get a copyright

- Independent Original Creation
- Fixed in Tangible Means
- Artistic Expression

Types of Copyrights

- Written
- Visual
- Sculptural
- Musical
- Performing

Copyright Act

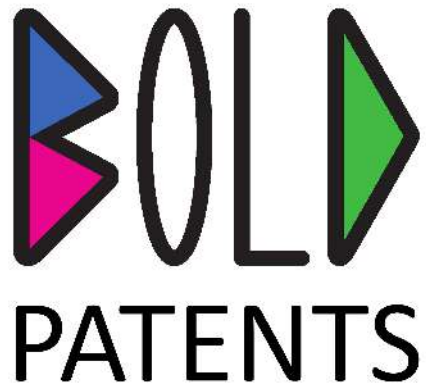
- Constructive Notice via Publication
- Fair use Doctrine
- No requirement of novelty
- Proper notice of copyright © “Copyright, 2018”

Timing is Critical

- Who created the original work (looking at derivatives and look-alikes) it's important who created the original first
- Filing a copyright *prior* to court case/suit will allow much easier time for plaintiff asserting infringement
- 1-Year Grace Period for US

Enforcement

- Federal Court
- Settlement/License



Simplified

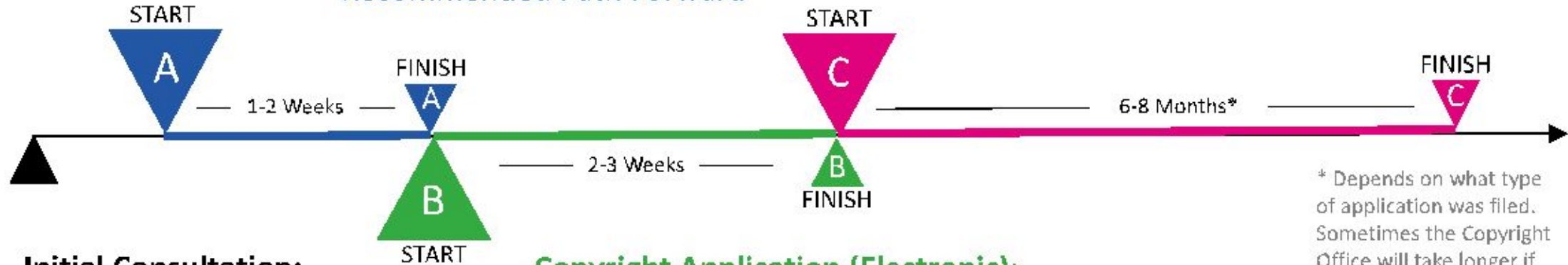
A-B-C Copyright Application Process Flow

Authorship/Creation Information:

- Takes 1-2 Weeks
- Collect Information about Creation
- Recommended Path Forward

Registration:

- Takes 6-8 Months*
- Confirm Registration Information



Initial Consultation:

- Eligibility Issues
- Ownership/Authorship
- Goals of Individual/Business
- eCO (Electronic Registration)

Copyright Application (Electronic):

- Takes 2-3 Weeks
- Title, Publication Description, Author, Claimants, Limitations, Rights, Correspondent, Mail Certificate, Handling, Certification
- Payment of Fee

* Depends on what type of application was filed. Sometimes the Copyright Office will take longer if physical specimens are submitted. Electronic Submissions take typically 6-8 months and paper submissions take around 8-10 months

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Trade Secret Law Primer

A Trade Secret gives its owner the right to prevent misappropriation (theft) of that information by anyone who has access or should not have access and for a certain time after employment.

Three requirements to a trade secret

- Not readily ascertainable
- Security measures taken
- Economic value

Types of Trade Secrets

- Product Manufacturing Method/Process
- Business Method/Process
- Information
- Know-How

State Trade Secret Statutes

- Notice to employees
- Constructive/Implied Access
- Employment Law Implications (Hiring/Firing)
- Non-compete Law

Timing is Critical

- Identify whether the good/service should be protected under Patent Law – 1 year window from first sale or publication
- Immediately when employee joins company – signs confidentiality documents

Enforcement

- State Court
- Federal Court (Defend Trade Secrets Act)
- Settlement/License

Legal Primer: Workshop

- Break into 4 Teams (Count off)
- Designate one spokesperson to speak on behalf of your Team
- Take 5 minutes to think and write down an answer
- Go around the room to each of the 4 Spokespersons

Legal Primer: Workshop

TEAM 1

Sammy takes his invention to a tradeshow on January 10, 2017 and people love it, but he doesn't sell any. He makes some improvements to it and files his provisional on January 20, 2018, when should he file the non-provisional?

TEAM 2

Sammy opens up his new business called "Tasty Burgers" in Everett on February 1, 2018 but didn't sell his first burger until February 20, 2018. He is the first company in the country to have this name, what will the trademark office award him rights to?

TEAM 3

Sammy is an artist and on weekends, he loves to paint. One day, while at Starbucks, he fell in love with this picture of coffee beans that was on the wall – so he got out his paint brushes and painted his version of it, and now wants to sell it on eBay, should he get a copyright first?

TEAM 4

While on the job at Big Tech, Sammy signed an NDA with his boss to learn about the secret project called "Neptune" that contained information about all of the employee's allergies. He later decided to share the spreadsheet with all employees to help raise awareness. Is Sammy liable?

10 – Minute Networking Break

Business Planning: Why?

- Documents Path Forward
- Communicates Internally/Externally
- Unifies for Employees
- Forces Research
- Critical for Investors, Banks, Professional Services
- Mandatory for ALL stages of a business
 - Start-up
 - Growth
 - Maturity

Business Planning: Key Components

- Business Planning Part I
 - Company Description
 - Industry Analysis
 - Target Market/Customers

Business Planning: Company Description

- Start-up
 - Initial Members and Shareholders
 - Aligns Operating Agreement
 - First Goods/Services
- Growth
 - Confirms current line of business
 - Outlines New Areas of Innovation
- Maturity
 - Definitive lines of business
 - Confirms specialized areas of innovation

Company Description & IP

- Start-up
 - Explore Patentability of Technology
 - Initial Trademark for business name
- Growth
 - File New Marks for New Brands
 - Explore Patentability of Improvements
 - File Copyrights for Monetized Art
 - Document and Organize Processes, Data, and Systems
- Maturity
 - Enforce/Monitor for Infringement of brands and lines of business as well as protected technology and art creations
 - Continue to Protect Sub-Specialty tech
 - Enforce Trade Secrets

Business Planning: Industry Analysis

- Start-up
 - Market Trends: Quantitative Assessment
 - Geographic Trend: Where to Locate First
 - Demographic Trends: Who to Serve First
- Growth
 - Market Trends: Qualitative Assessment
 - Geographic Trends: New/Different Locations
 - Demographic Trends: Who not to serve
- Maturity
 - Market Trends: Independent Studies
 - Geographic Trends: Strategic Locations
 - Demographic Trends: Target Clients/Niche

Industry Analysis & IP

- Start-up
 - Get an idea on how quickly products/services are innovating
 - Understand how the customers perceive industry products/services (photos, stories, news, media, ads, etc.)
- Growth
 - Document what creative content customers respond to
 - Protect data gathered on customers, and specifically how you are serving clients
 - Explore R&D in areas no one else is – find gaps
- Maturity
 - Only publicize what is required – keep as many trade secrets as you can while in this stage
 - Create license agreements for those in the industry to keep industry alive
 - Pick the smart battles with Patent enforcements

Business Planning: Target Market

- Start-up
 - Creating your perfect client and all attributes (Avatar)
 - Aligns all communication to serve one audience
 - Target client readiness analysis (product fit)
- Growth
 - Redefining Target Market based on feedback
 - Utilizing key influencers and referral partners
 - New Product or Service launch for New Market
- Maturity
 - Updating Media and Message to reach Target Market
 - Creating new Content to attract Target Market

Target Market & IP

- Start-up
 - Look at what your consumers are demanding, what they are buying
 - Figure out exactly what they are reading, and create content and protect there
 - Figure out what problems are being talked about by the community
- Growth
 - File copyrights for artwork and written/visual content specific customers enjoy
 - Protect data gathered on referral partners, customers, and specifically processes how products interact with clients
 - Assess Patentability for R&D Solutions for target market
- Maturity
 - Document and Protect internal data on customers
 - Create contracts with suppliers based on target customer data and allow them to innovate and take on risk of investing in risky technology

Business & IP Plan Workshop I: Part One

1) Company Description

- What are you selling?
- Who are you selling to?
- How will you deliver?

2) Industry Analysis

- How has market changed in past 5 years?
- What are major technology changes?
- Barriers to Entry?

3) Target Market

- Who is your Perfect Client?
- Where are they served now?
- What problems do they have?

Business & IP Plan Workshop I: Part Two

1) Company Description

- Is what you are selling different enough to explore patenting?
- How are you protecting your messaging content you are communicating with?
- How have you protected your marks/brands?

2) Industry Analysis

- Where is your customer data stored? Is it secure?
- How do you design around your industry's barriers?

3) Target Market

- What marketing/advertising has been successful with this group?
- Have you sought protection for solving customers problems with innovative solutions?

10 – Minute Networking Break

Business Planning: Key Components

Business Planning Part II

- Competitive Analysis
- Marketing/Sales Plan
- Operations Plan

Business Planning: Competitive Analysis

- Start-up
 - Look at the industry leaders and what they are doing
 - Identify different channels of service
 - Distinguish what skills/attributes separates the competitors
- Growth
 - Evaluate which companies or channels are emerging / slowing
 - Breakout local competition and longer-term competition
 - Identify new competitors in new/expanding lines of biz
- Maturity
 - Identify one main competitor and find specific ways to win
 - SWOT Analysis for each product/service line
 - Watch market share for each product/service line

Competitive Analysis & IP

- Start-up
 - Initial technology differentiator should be evaluated as potentially patentable
 - Conduct Trademark Search and Application to lock in business and brand name/logo for desired area of business/classification
- Growth
 - Create images, video and ways to stimulate emotional reaction to steer customers away from competitors to yours (Copyright filings)
 - Assess Patentability for R&D Solutions to design around competitor patents/publications
- Maturity
 - Acquire companies that have trademarks/patents that would help take away market share from main competitor
 - Dedicated teams to explore new areas and products internally
 - Invest in research grants, institutions and outreach programs to gather talent

Business Planning: Marketing/Sales Plan

- Start-up
 - Determine the most effective method to get your product/service in front of the target client
 - Provide clear definition of why your product/service is better
- Growth
 - Explore new ways to get your product/service to your target client
 - Explore referral channels to get referred to have clients buy your product/service
 - Develop metrics to measure performance of leads and sales
- Maturity
 - Invest in researched media and messaging to your target clients
 - Incentivize sales team to hit specific numbers on metrics to drive profitability

Marketing/Sales Plan & IP

- Start-up
 - Use logo, image, creative approach to differentiate your business from competitors
 - Determine whether your business method and approach to serving clients is potentially patentable
- Growth
 - File patents on business methods for how to do the business they do
 - File patents on products and services to exclude any competitors from making, using, selling, or importing that invention
 - Retain trade secret data and information on products, assembly, methods of processing and make sure employees are trained on security measures
- Maturity
 - Present patent portfolios on specific technologies that key competitors cannot offer
 - Drive more sales through brand loyalty

Business Planning: Operations Plan

- Start-up
 - Decide whether you are going to be solo owned or diversified ownership initially; Operating Agreement /Members
 - Employees or Independent Contractor powered
- Growth
 - Hierarchical or Flat Org Structure
 - Virtual or Brick & Mortar
 - What to outsource/insource
- Maturity
 - Communication of Leadership Messages, Vision, Culture
 - Geographic limitations/Policy/Trade Barriers

Operations Plan & IP

- Start-up
 - Contracts are important and IP ownership clauses are huge even on initial prototyping jobs
 - International contracts for development and manufacturing overseas
- Growth
 - Assure trade secrets are maintained as company and employee count rises
 - Delegation of tasks must also mean additional compliance audits
 - Incentivize innovation as workforce grows
 - Customer feedback loop is huge as products are tested to capture new R&D
- Maturity
 - License and Sell off brands and product lines that are not in alignment with growth of company
 - Double-down on what aspects of the company are core and where heart is

Business & IP Plan Workshop II: Part One

1) Competitive Analysis

- How is your product/service different?
- Conduct a SWOT analysis

2) Marketing/Sales Plan

- Where do your Target Clients Spend Time?
- How much do Leads Cost (Time)?
- How do you incentivize Sales Team?

3) Operations Plan

- How will you get the work done?
- What work is your “core”?
- Where will you serve clients?

Business & IP Plan Workshop I: Part Two

1) Competitive Analysis

- What products or services are potentially patentable?
- What methods or internal processes are not yet documented?
- Can you reverse engineer any of your competitor's products?

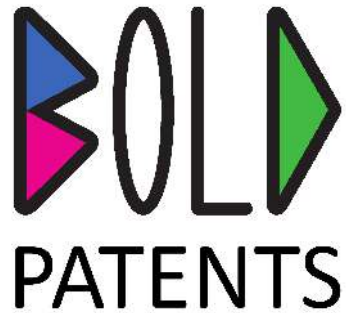
2) Marketing/Sales Plan

- What creative content have you protected that is yours?
- What do customers think of when they see/hear your brand?

3) Operating Plan

- How are you encouraging your employees to innovate?
- What parts of your business are you focused on continuing to develop?

Thank you! Questions?



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let's
DISCUSS

