

101 IP Case Study: Follow a New Product from Development to Launch

Nelson A. Blish

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American Home Products Corporation

Faculty Biographies

Nelson A. Blish

Nelson A. Blish is senior patent attorney for Eastman Kodak Company in Rochester, New York, where he is responsible for the Engineering Physics Lab. Mr. Blish has over 22 years experience in intellectual property law and has worked for a number of corporations including Philip Morris and Cooper Industries.

Mr. Blish has served on the board of directors of the ACCA Foundation, as president of ACCA's Houston Chapter, and as past president of ACCA's Rochester Chapter. He is president of the Western New York Chapter of the U.S. Naval Academy Alumni Association and has also served as president of the Gulf Coast Chapter U.S. Naval Academy Alumni Association. He served as the executive vice president of the Naval Reserve Association's Richmond Chapter and as president of the U.S. Naval Academy Alumni Association's Richmond Chapter.

Mr. Blish has received a number of awards including the Armed Forces Medal, Expert Rifle award, Expert Pistol award, the Navy Commendation Medal, and the American Jurisprudence Award for Excellence in Commercial Law. He is also listed as an inventor on a number of pending and issued patent applications including software patents, automotive patents, mechanical patents, and electrical patents. He is the author of numerous military and legal articles.

Mr. Blish received a BS from the United States Naval Academy. After commissioning as an Ensign in the United States Navy, he obtained an MS from Michigan State University and attended Nuclear Power School and Submarine School. He was assigned to the Polaris missile submarine, USS ALEXANDER HAMILTON (SSBN 617), where he served for three patrols. Mr. Blish remained in the Naval Reserves after leaving active duty and attended the College of William & Mary, Marshall Wythe School of Law, where he received his JD. While at law school, he worked at NASA's Research Center at Langley, Virginia, and was licensed as a Patent Agent.

Natalie Butto

Natalie Butto is counsel and assistant secretary with Tropicana Products, Inc. (a subsidiary of PepsiCo, Inc.) in Bradenton, Florida, where she has worked in-house for four years. She is responsible for Tropicana's intellectual property matters, as well as legal issues relating to marketing, technology, international, contracts, and corporate.

Prior to joining Tropicana, Ms. Butto was an attorney with an intellectual property law firm in New York for six years.

Ms. Butto is secretary of ACCA's Intellectual Property Committee and serves on the board of directors for the United Way of Manatee County and The Manatee Players theater (executive committee).

Ms. Butto earned a BA from Florida International University; a JD from Georgetown University; and an MBA from New York University.

John W. Hogan, Jr.

John W. Hogan, Jr. is patent counsel for American Home Products Corporation in Madison, New Jersey. His responsibilities include varied aspects of patent practice concentrating on prosecution, opinion, licensing, and counseling in the pharmaceutical area.

He was senior patent attorney for American Cyanamid Company prior to its merger with American Home Products working with the agricultural group.

He currently serves on the Executive Committee of ACCA's Intellectual Property Committee and is a member of the American Intellectual Property Law Association and the New Jersey Intellectual Property Law Association.

Mr. Hogan received his BS from the Pennsylvania State University and his JD from Franklin Pierce Law Center.

IP Case Study: New Product from Development to Launch

Outline/Checklist submitted by:

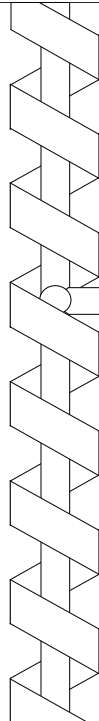
Nelson A. Blish, Senior Patent Attorney, Eastman Kodak Company
Natalie Butto, Counsel and Assistant Secretary, Tropicana Products, Inc.
John W. Hogan, Jr., Patent Counsel, American Home Products Corporation

Product Development - Patents & Trade Secrets

- Patent vs. Trade Secret
 - Definitions and Attributes
 - Trade Secret
 - Patent
 - Trade Secret Considerations
 - Confidentiality
 - Reverse Engineering
 - Hypothetical Product
 - Patent Considerations
 - Timeline
 - Drafting the application/Scope of Claims
 - provisional rights
 - literal infringement vs. doctrine of equivalents
 - protection needed for hypothetical product
 - Filing the Application
 - publication
 - assignment
 - International rights
- Patent Marking
 - United States
 - International
- Patent Clearance
 - Getting a patent does not guarantee right to use
 - Clearance early in product design
 - Design around
 - Opinion (or not)
- Patent Non-Infringement
 - Direct Infringement
 - Doctrine of equivalents
 - Means plus function claims
- Validity
 - File History
 - Prior art not considered by the examiner

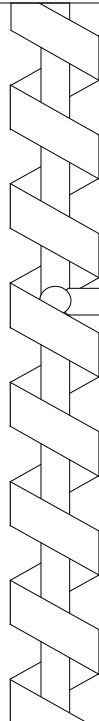
Product Launch Trademark & Copyright

- Trademark Clearance
 - Search/opinion
 - 3rd parties
- Trademark Registration
 - Use/Intention to use
 - Scope - classes of goods; countries
- Trade Dress
- Use of Trademark & Copyright in Marketing/Advertising
 - TM/® symbols
 - Brand equity
 - Copyright



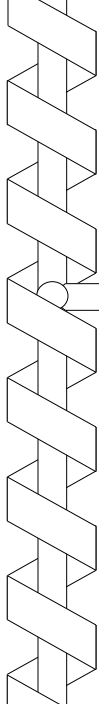
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Counsel Cooler An Educational Beverage



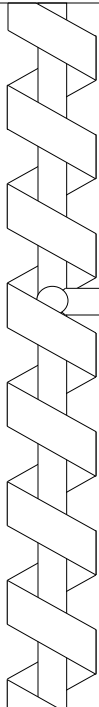
IP Case Study

Natalie Butto
John Hogan
Nelson Blish



Hypo product: Counsel Coolator

Machine that dispenses a neutraceutical beverage, which allows counsel to “digest” information learned in Continuing Legal Education Courses.



Definitions & Attributes Trade Secret

Means information, including a formula, pattern, compilation, program, device, method, technique, or process, that:

- (i) derives independent economic value, actual or potential, from not being generally known to, and



(Continued)

not being readily ascertainable by proper means by, other persons who can obtain economic value from its disclosure or use; and

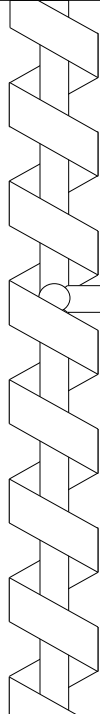
(ii) is the subject of efforts that are reasonable under the circumstances to maintain its secrecy.

Uniform Trade Secret Act, Section 1



Definitions & Attributes Trade Secret

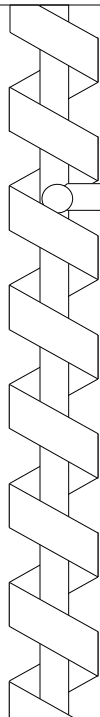
- State Law (UTSA, tort)
- No expiration date
- No protection from independent discovery
- Must be kept secret
- May be patentable, but not required



Definitions & Attributes
Patent

A patent is:

A grant from the Federal Government
which gives the patent owner an exclusive
right to prevent others from:



(continued)

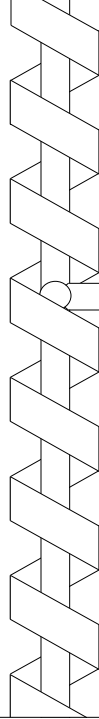
- Making;
- using; or
- selling

the patented invention.



Definitions & Attributes Patent

- Federal Law
- Limited duration (generally 20 years)
- Provides protection from independent discovery
- Must be disclosed in order to receive
- Must be patentable (new, useful, unobvious)



Trade Secret Considerations Confidentiality

Loss of trade secret by unprotected disclosure. Generally, must actively maintain its confidentiality. Examples:



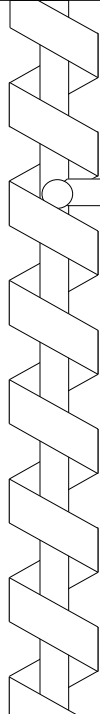
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- Put employees on notice
- Post cautionary signs or document legends
- Restrict visitors
- Divide process into steps
- Use unnamed or coded ingredients
- Lock up secret documents



Trade Secret Considerations Reverse Engineering

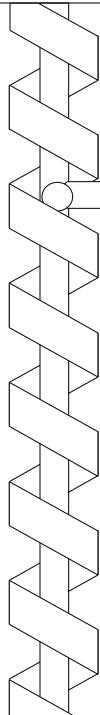
Competitors are entitled to buy your product and analyze it in detail in an attempt to copy it.



Trade Secret Considerations Reverse Engineering

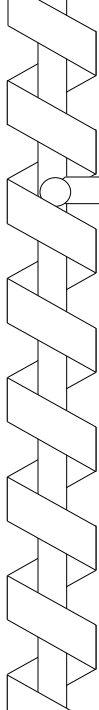
Will putting the hypothetical product on the market disclose the trade secret?

If yes, trade secret protection may not be the best protection.



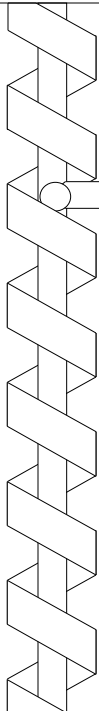
Trade Secret Considerations Hypothetical Product

- ☉ Counsel Coolator
- ☉ Counsel Cooler



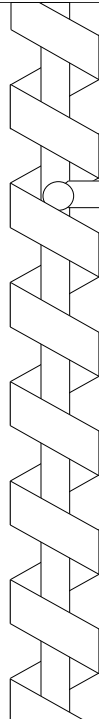
Patent Considerations Timeline

- Patents take time to grant (3-5+ years)
- Published after 18 months
- When is product launch planned?



Patent Considerations Timeline

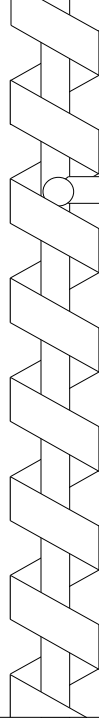
- Consider whether your product will be obsolete before the patent is granted.
- Provisional application or non-provisional application.



Patent Considerations Drafting the application/Scope of Claims

Provisional Rights

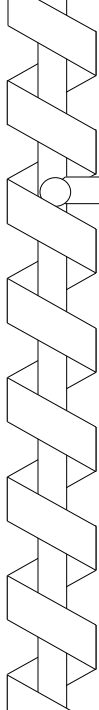
- available for applications filed on or after November 29, 2000
- must be published application
- must provide actual notice
- claims “substantially identical” in published application & granted patent.
- reasonable royalty



Patent Considerations Drafting the Application/Scope of Claims

Literal Infringement vs. Doctrine of Equivalents

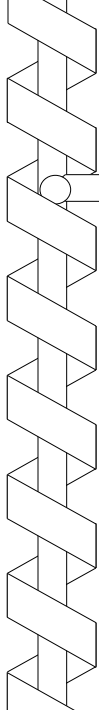
- Is D.O.E. D.O.A.?
- vary scope of claims
- try to “design around” claims and redraft



Patent Considerations
Drafting the Application/Scope of Claims

Counsel Cooler

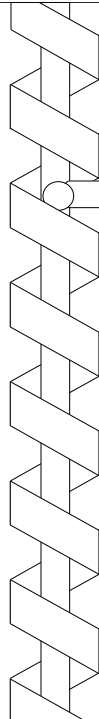
- provisional application
- claims to active ingredient, beverage containing active ingredient, process of making active ingredient method of using to enhance memory/learning.



Patent Considerations
Drafting the Application/Scope of Claims

Counsel Coolator

- provisional application
- claims to activation device, method of activating active ingredient, claims to dispenser having the activation device.

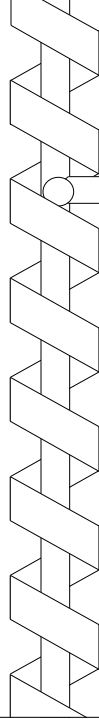


Patent Considerations Filing the Application - Publication

• U.S. applications filed after November 29, 2000
published after 18 months

Except

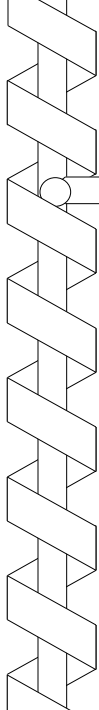
- provisionals
- abandoned applications
- applications under secrecy order
- design applications
- re-issues
- request not to publish*



Patent Considerations Filing the Application - Publication

Request Not to Publish

- invention has not and will not be filed in another country which publishes.
- CAREFUL - must notify PTO within 45 days if subsequently filed in another country or application will become **abandoned**.
- May be rescinded at any time.



Publication

Critical Decisions

- whether to publish (US only filed applications)
- whether to request early publication
- the claims to initially present
- whether to request republication after amendment

Practice Tip - Forget Redacted Publication



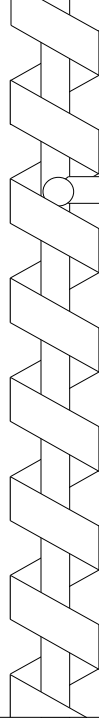
International Rights - Patent

- Requirements vary
- enforceability varies
- PCT



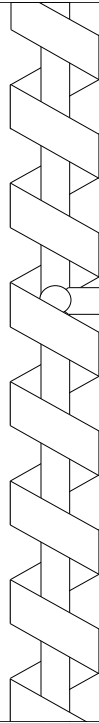
Patent Marking - U.S.

- Provides constructive notice
- Not required
- Applies to articles (not method patents)
- Benefit may be able to recover pre-filing damages
- Cost - must comply with statute:
 - consistent
 - licensees
 - no mismarking



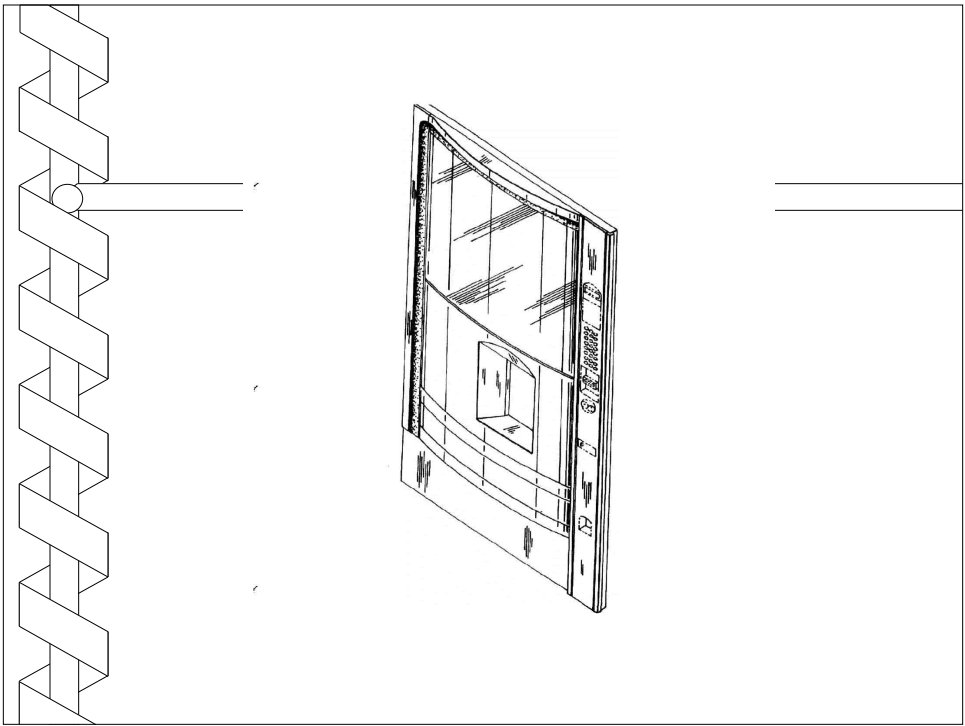
Patent Marking - International

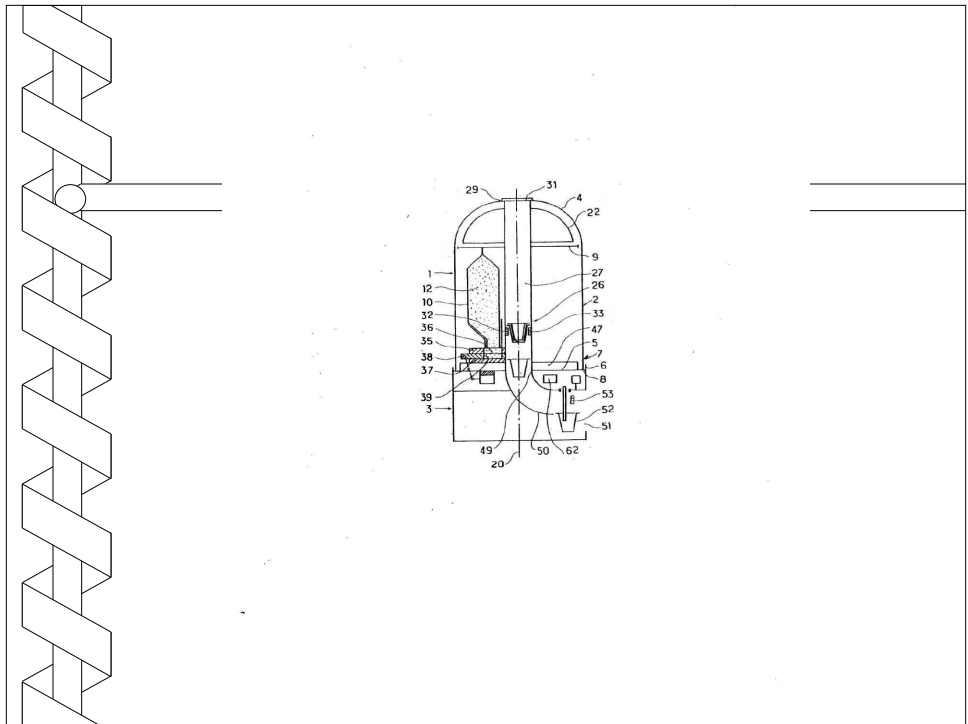
- Many countries - no benefit
 - May provide some benefit in GB, Ireland, New Zealand, Singapore, South Africa, Venezuela, Philippines, Taiwan.
- (not exhaustive list)



Patent Clearance

- Patent does not guarantee right to use
- Cost of infringement
- Early in product design

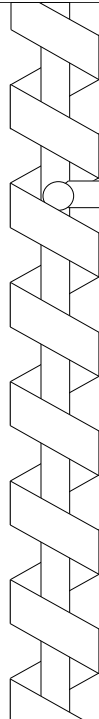




Non-Infringement

⚙️ **Direct infringement**

- A, B, C, and D



1. A method for the activation of a cognitive ingredient in a beverage during movement of the beverage:

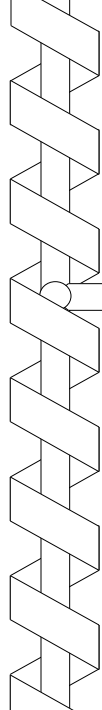
positioning an ultrasound beam generator on a first side of a transport path, wherein an axis of a beam of ultrasound energy produced intersects a plane in which the beverage passes at an acute angle;

selecting a frequency of the ultrasound energy such the transmitted ultrasound energy will activate the beverage.



Non-Infringement

- ⊙ Direct infringement
- ⊙ Doctrine of equivalents
 - Definitions
 - File history



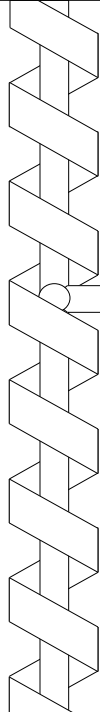
Non-Infringement

- Direct infringement
- Doctrine of equivalents
- Means plus function claims



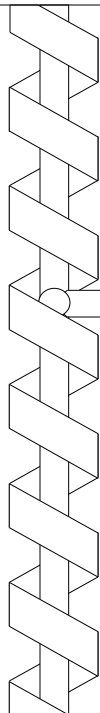
Validity

- File history



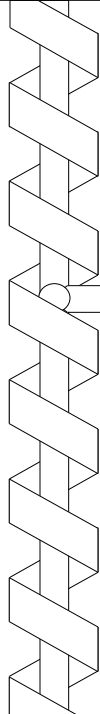
Validity

- File history
- Not considered by the examiner
 - Literature search
 - Foreign patents

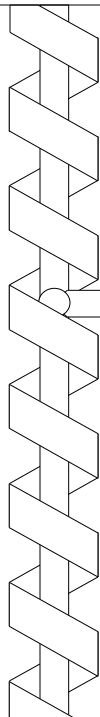


Validity

- File history
- Not considered by the examiner
- Cumulative prior art
- Product on sale

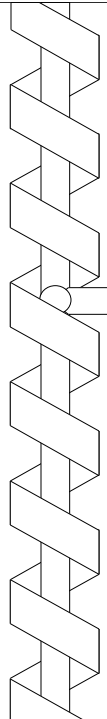


Activator Sold by XYZ, Inc.



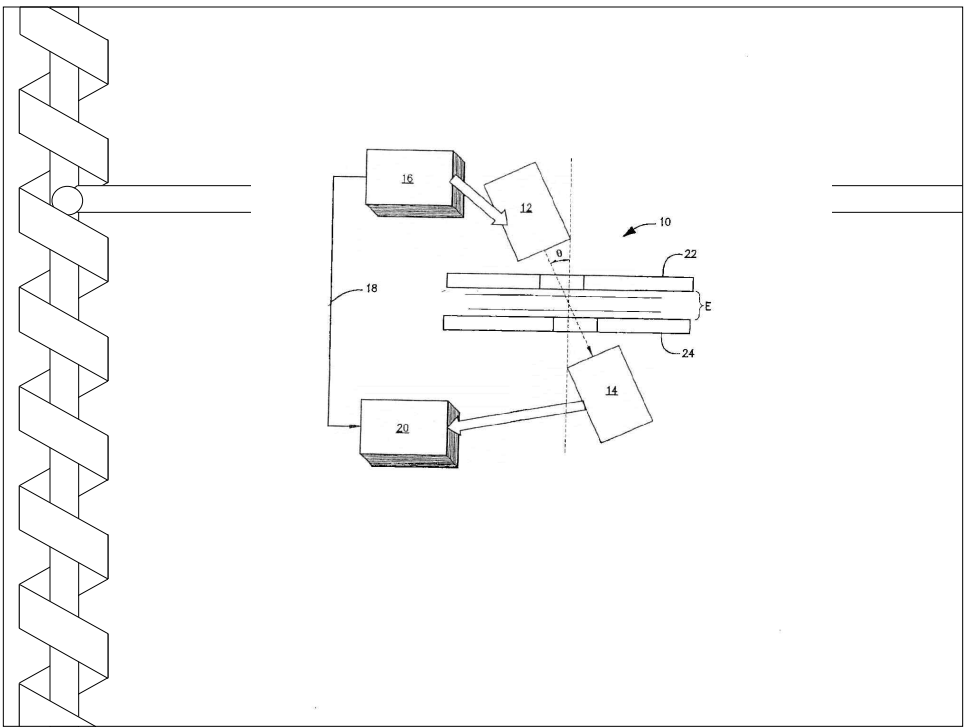
Opinion (or not)

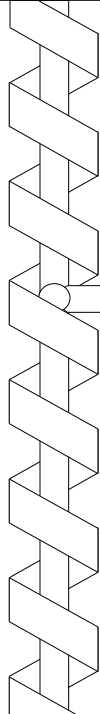
- Non-infringement - YES
- Invalidity -YES
- Smoking Guns (how to shoot yourself in the foot)
- email lasts forever
- Retention Policy



Design Around

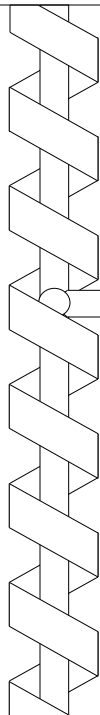
• The only way or another way?





Design Around

- The only way or another way?
- No way
 - Take a license
 - Cross license
 - Buy the company
 - KILL THE PROJECT



Remedies

- Injunction
- Lost profits
- Royalties
- Treble damages



Joint Development

- Confidentiality agreement
- Joint venture
- Contract out



Product Launch Trademark

Definition & Rights

- Word, phrase, symbol, and /or design identifying the source of goods
- Rights based on use in the U.S.
- Rights based on registration in many other countries



Trademark Clearance

- Search for conflicting marks
- 3rd parties
- Opinion
- Clearance



Trademark Registration

- Application
 - Based on Use or Intention to Use
 - Examiner review
 - Published for opposition



Trademark Registration

- Registration
 - 10 years, with renewal option
 - Year 5 - Affidavit of use
 - Use requirement



TM Usage in Marketing

- Proper form
 - Distinguish from generic product use
 - e.g. Enjoy a Counsel Cooler beverage
- Brand equity - Consistent usage
 - Wording
 - e.g. Avoid variations like Counsel Cool
 - Presentation/Style



Trademark Notice

- ® - when registered
- ◉ - when not yet registered
- Legal line
 - COUNSEL COOLER® and Counsel Coolator® are registered trademarks of Counselcooler, Inc.



Trade Dress

- “Look and feel”
- Counsel Coolator dispenser