

THE SEVEN DEADLY SINS OF IP

BY MICHELLE CIOTOLA, ESQ. AND TINA DORR, PH.D., ESQ.



MICHELLE CIOTOLA, ESQ.



TINA DORR, PH.D., ESQ.

Intellectual property (IP), including trademarks and patents, is a tangible and valuable asset that not only protects a business but also can help it grow. Trademarks protect words, phrases, images, designs, and other marks used in connection with the sale of goods or services. Patents protect inventions and provide owners the right to keep others from making, using, or selling their inventions. When considering filing for patent or trademark protection for your business, keep in mind the following Seven Deadly Sins of IP.

1 | “Patent pending” ≠ Enforceable Patent

Although you can, and should, mark your product as “patent pending” as soon as you file your patent application, a pending patent application is not an enforceable patent. Marking your product “patent pending” is important to put the public on notice that you have filed a patent application covering your product, which could mature into an enforceable patent.

The patenting process generally includes the following general steps:

- Patent Pending: preparation and filing of the patent application
- Prosecution Stage: negotiation with the U.S. Patent and Trademark Office (USPTO) on the allowable scope of protection
- Allowance: agreement on scope of patent protection
- Enforceable Patent: issuance of patent application into patent

The patent process can take anywhere from 1 - 5 years and, in some cases, even up to 10 years. Until you have an enforceable patent, you do not have the right to enforce your patent. Once you have an enforceable patent, you have the right to keep others from making, using, selling, or offering your invention for sale in the country in which you have the patent. For example, if you have a U.S. patent, then your right to exclude others only extends to others in the U.S.

2 | No Market Research

Patents should reflect the geographical market for your business. Once you have an enforceable patent, you have the right to keep others from making, using, selling, or offering your invention for sale in the country in which you have the patent. As above, your U.S. patent rights are enforceable in the U.S. only. If your market is not the U.S., then spending money to obtain a patent in the U.S. is not economical.

Do your market research before filing a patent application to determine:

- what countries will the product be made, sold, or used in?
- can infringing products be identified?

Determining the market or countries where the product will be made, sold, or used helps to determine where potential infringers could be detrimental to your business. Having patents in key markets can prevent would-be infringers from encroaching on your business market. Patents in key markets also provide business security, as they prevent competitors from stealing your invention, filing for a patent, and then preventing you from practicing your own invention.

Identifying infringing products can be challenging, depending on the technology. While identifying whether a competitor's fishing hook infringes your patent for a new fishing line hook may be straightforward, identifying whether a competitor's chemical composition infringes your patent for a new insecticide is more challenging, as well as costly. If you cannot identify potential infringers in a given market, it may not be worthwhile to file for patent protection.

3 | Public Disclosures

Before you file your patent application, a non-confidential communication of your invention, called a public disclosure, can lead to loss of patent rights. Public disclosures include any verbal conversations, for example with inventors or vendors, internet postings, publicly available conference abstracts, or any other printed publications.

Therefore, to prevent potential loss of patent rights, consider filing your patent application for your invention before you have any non-confidential conversations with investors, vendors, or anyone outside of your organization. If you do have any conversations before filing, simply have the other

parties sign a confidentiality agreement / non-disclosure agreement. You can find samples online, which will suffice.

Alternatively, or in addition, make sure that your disclosures / conversations describe your invention are at a very high level. In order to be considered a public disclosure that could lead to loss of patent rights, the communication must be "enabling," or provide enough information for a "person of ordinary skill in the relevant art" to practice the invention.

In the U.S., while an inventor has a one (1) year grace period after they communicate or publicly disclose their own work to file for a patent application, most other countries do not recognize such a grace period, and the disclosure can prevent you from obtaining a foreign patent. Therefore, best practice is to always file your patent application before making a public disclosure.

4 | Forgetting a Prior Art Search

The legal requirements for patentability are:

- Novelty: the invention should be new to the world
- Utility: the invention should be useful
- Non-obvious: the invention should not be an obvious variant of something that already exists

Even after a patent is granted, providing an enforceable right, the patent and right can be revoked if it is later determined that the patented invention was disclosed/available anywhere in the world before the patent application filing date.

Conducting a thorough "prior art" search before filing your patent application is the best way to reveal existing prior art pertaining to an invention. Inventors are best suited for conducting such a search, as they are the experts, but a patent attorney can also conduct a search. A great place to start searching for prior art is the internet, as Google and Google Patents allow for simple keyword searching.

A prior art search allows you to:

- monitor competitor activities
- prevent infringement actions by becoming aware of protected technology
- avoid duplication of research already conducted by others
- assess patentability of your invention
- identify state-of-the-art technologies
- plan for new products

5 | Selecting a Mark that Generally Describes the Product and Failing to Consider the Domain Name

When selecting the name of a new product, there is a natural tendency to select a brand name that somehow describes the product. When a product is released, conveying information about it through the brand name may seem desirable. From a trademark perspective it is anything but desirable for several reasons. Descriptive marks are more likely to have been used by competitors, thus increasing the risk of unnecessary battles over a brand. On the flipside, descriptive words must remain available for others to use to describe their own products or services. This allows competitors to come closer to a brand.

The selection of a coined, arbitrary, or even suggestive mark will result in a stronger brand at inception. Stronger brands are more valuable assets. A “coined” mark is a word that does not exist in the English language - for example, EXXON for gasoline. An “arbitrary” mark is a word that exists in the English language, but with a meaning entirely unrelated to the product or service with which it is used - for example, APPLE for computers. A coined and arbitrary mark is considered the strongest type of trademark. A “suggestive” mark uses a word that suggests a characteristic of the product or service, but still requires some imagination to understand the connection - for example, COPPERTONE for suntan lotion.

A key consideration in the selection of a new brand is the availability of suitable domain names. Given the importance of the online marketplace, securing a domain name (if one is needed) early in the process can save costs and aggravation. Since the cost to register a domain name can be nominal, it may make sense to register one or more possible domain names for each mark being considered. Early registration of a domain name will limit the likelihood that a third party (legitimately or not) will register the domain name. The cost of early registration of a domain name pales in comparison to the need to purchase a domain name legitimately owned by a third party or use legal remedies available to enforce rights against cybersquatters.

Even if there are no plans to use a separate domain name for a new product, it is advisable to review domain names featuring the potential marks to see whether they redirect to a website. Keep in mind that consumers looking for a product may naturally go to a domain name featuring the mark. If the domain name redirects to a controversial website, this may warrant selection of a new trademark (or attempts to proactively obtain that domain name).

6 | Failing to Clear a Mark Before It Is Adopted

Clearing a mark before it is adopted is a vital step in building a new brand. Proper clearance of a mark at the outset can reduce the risk that a competitor or other third party will object to the registration or use of a new mark. A trademark clearance search will locate earlier identical and similar marks, which are analyzed to determine whether they pose an obstacle to use or registration.

While it can be tempting to avoid the costs associated with clearance, especially before the commercial success of a new product is fully appreciated, the consequences of not properly

clearing a mark can be devastating. A company could begin building significant goodwill in the new brand name and wide-spread recognition amongst consumers, only to find itself faced with a claim of trademark infringement which can threaten all of the time and money invested in developing that brand equity.

7 | Not Obtaining Trademark Registrations or Preparing for the Online Marketplace

Trademark rights in the U.S. are based on use in commerce, meaning that rights are acquired once the goods or services have been sold. However, to achieve the strongest protection and rights in a brand, federal registration is desirable. Federal registration comes with many advantages, including:

- the right to use the ® symbol
- nationwide rights (versus rights limited to the geographic territory of use)
- a visible deterrent and constructive notice to potential infringer
- possible prevention of federal registration of third party marks
- and many others

A federally registered mark can also be recorded with the U.S. Customs and Border Protection (CBP). The CBP has the authority to detain, seize, forfeit, and ultimately destroy counterfeit goods coming into the U.S., where a registered trademark (or copyright) has been recorded. This can be a valuable strategy to prevent the influx of infringing and/or counterfeit products into the marketplace.

A federal trademark registration is a valuable tool in both selling in the online marketplace and in taking down infringing listings. Most major platforms have takedown mechanisms in place, and trademark registrations allow for faster verification of trademark ownership and takedown.

Although there are many other considerations for patent and trademark filings, avoiding the above Seven Deadly Sins of IP are best practices and business considerations for organizations of all sizes.

For more detailed questions about IP, contact Michelle Ciotola, trademark and copyright lawyer, or Tina Dorr, patent lawyer.

Michelle Ciotola, Esq.

Partner, Trademark & Copyright Lawyer
e: MCiotola@cantorcolburn.com
p: 860-286-2929, ext. 1229
c: www.linkedin.com/in/michellepciotola/

Tina Dorr, Ph.D., Esq.

Partner, Patent Lawyer
e: TDorr@cantorcolburn.com
p: 404-607-9991, ext. 2103
c: www.linkedin.com/in/tinadorr/

