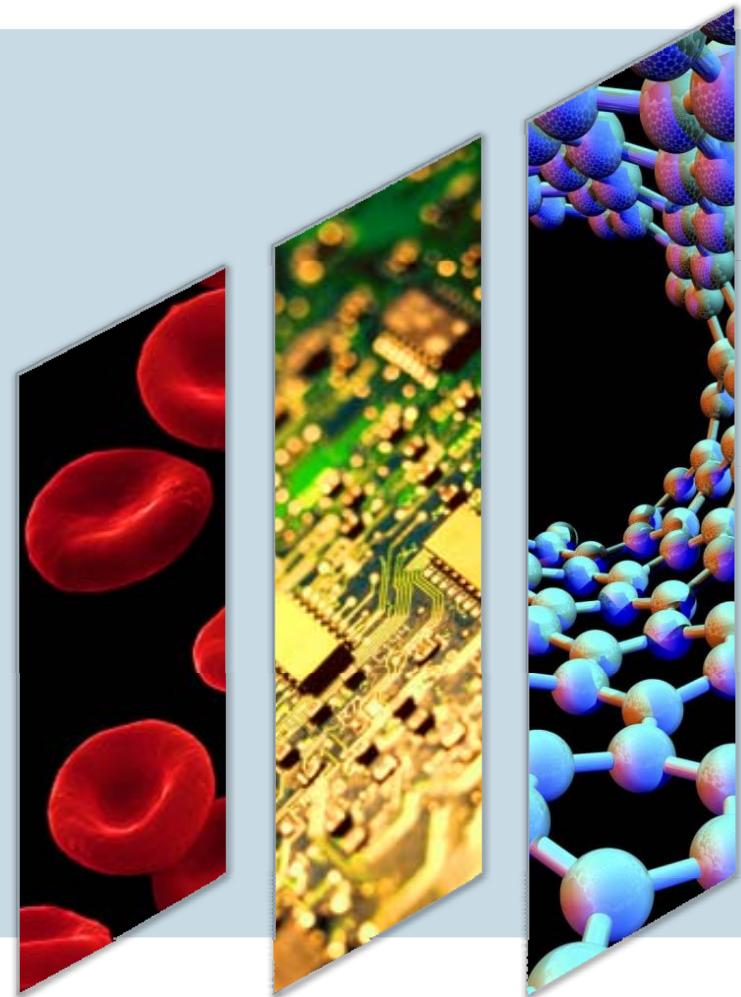


Patents and Startups

December 6, 2016

presented by:
Marc S. Johannes



A Patent ...



Gives the owner the right to **exclude others from making, using or selling, offering for sale, or importing his/her invention.**

Utility Patent ➔ **20 years from filing date**

Design Patent ➔ **14 years from issue date**

A Patent... *(cont)*

- Does not give its owner the right to make, use, sell, offer to sell, or import
 - (Common misconception)
- The right to make, use, etc. is the absence of non-licensed patents of others that the manufacture, use, etc. would infringe

Ownership

- **In the U.S., patent rights belong to the inventors.**
- **Assignment clause in employee/consultant agreement critical.**
- **Execute assignment document for every patent application, provisional and non-provisional.**

Employee/Consultant Agreement

▪ Consult IP attorney on Agreement

One take away:

Do:

I **hereby assign** to COMPANY all rights in the United States and throughout the world to inventions, discoveries, improvements, ideas, designs, processes, formulations, products, computer programs, works of authorship, databases, mask works, trade secrets, know-how, information, data, documentation, reports, research, creations and other products arising from or made in the performance my employment.

Don't:

I **hereby agree to assign** to COMPANY

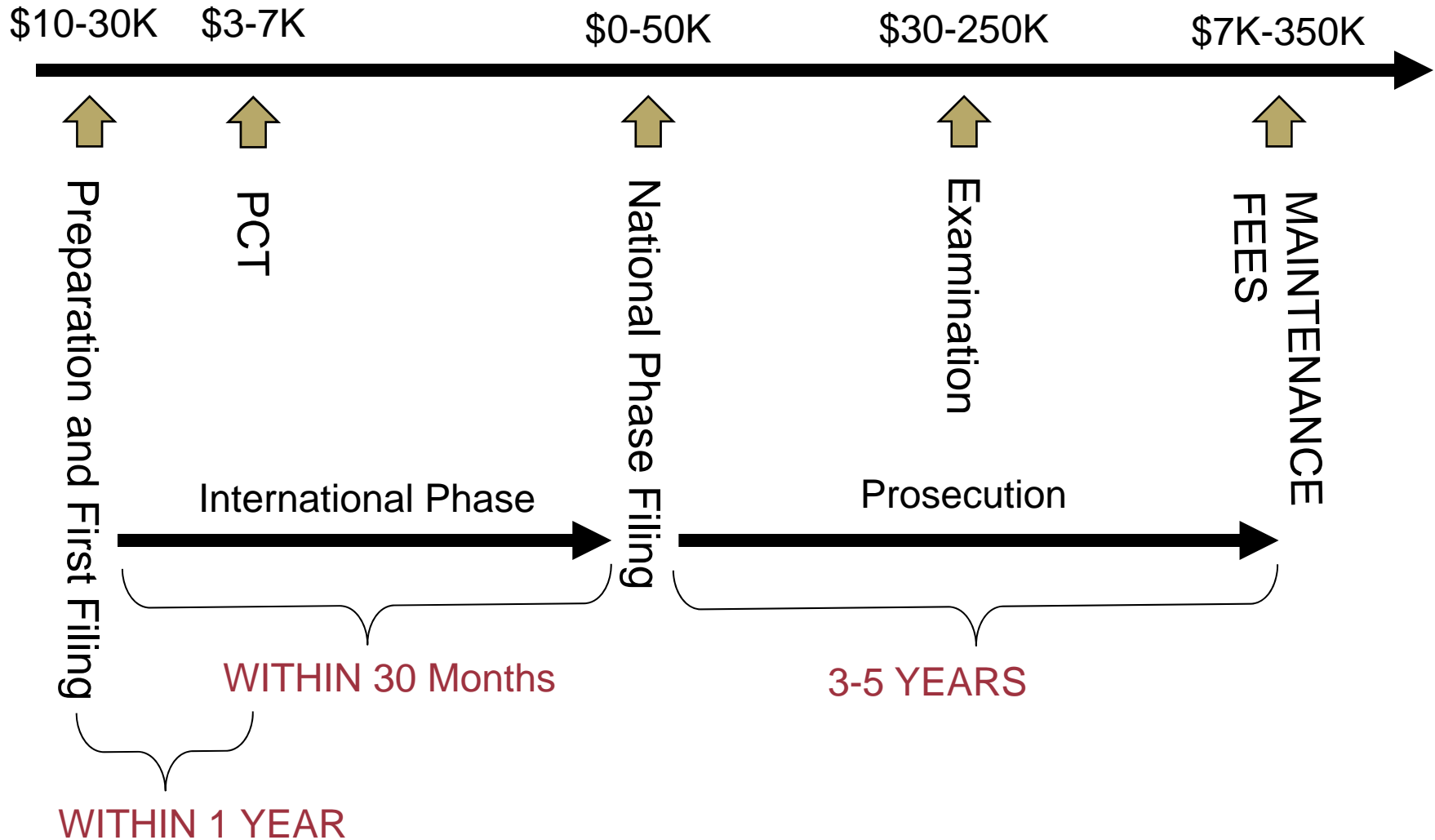
Important Considerations for Entrepreneurs:

- **Patents are time and activity sensitive**
 - **Keep it private!**
- **Action by Inventors**
 - **Public Disclosure**
 - **Publication**
 - **Public Use**
 - **Public Sale or Public Offer to Sell***
- **Patents are *expensive***
 - **Be smart about what you file on and where you file.**

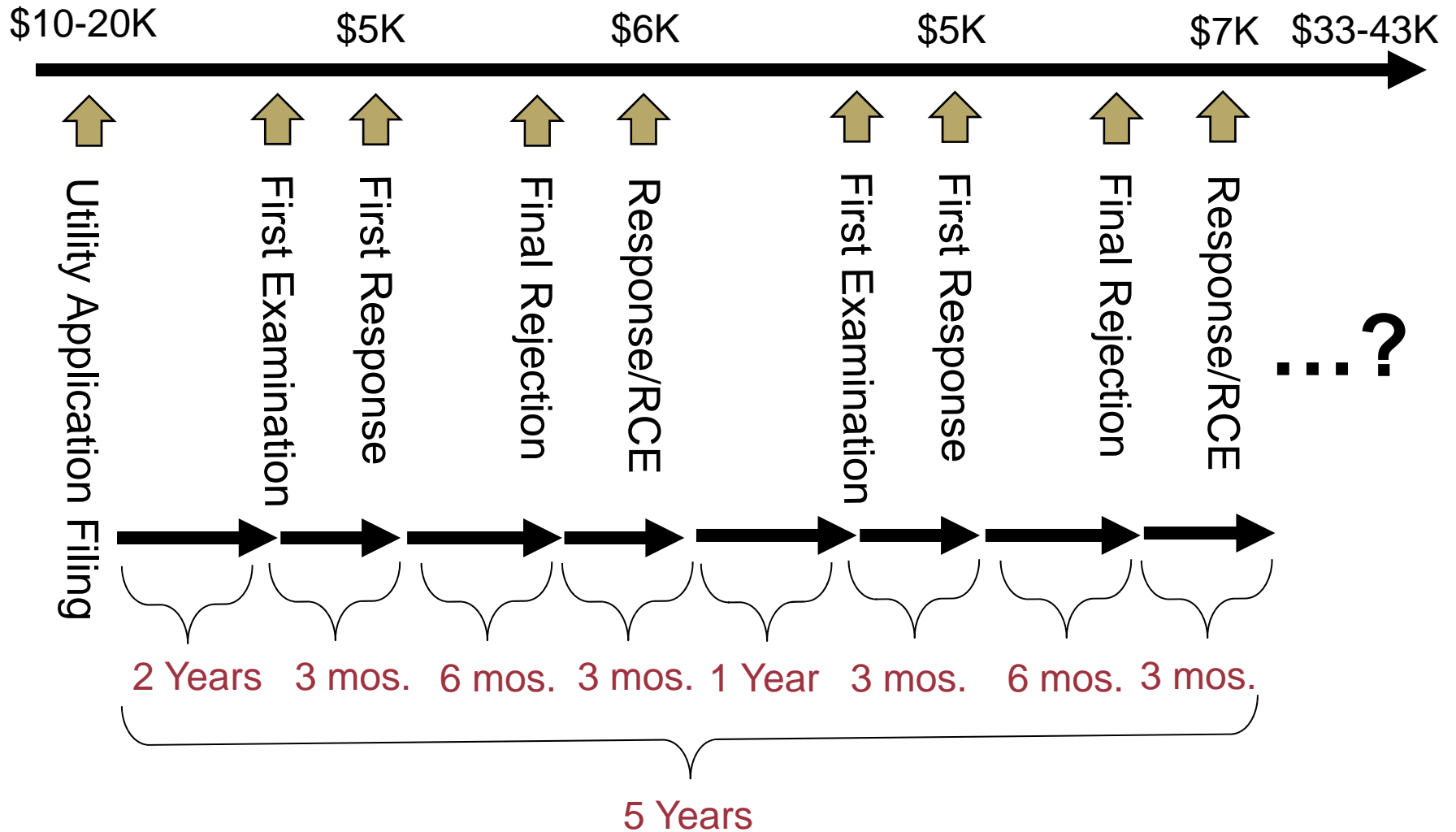
PATENT COSTS WORLDWIDE

Country	Prep.	Filing	Pros.	Issue/Grant	Ann./Maint.	Total
PCT	?	\$3-5K	N/A	N/A	N/A	\$5,000
U.S.		\$1K/\$2K	\$25K	\$1K/\$2K	\$7.5K/13K	\$30K/\$38K
Europe		\$5K	\$35K	\$5-50K*	\$31K	\$70-115K
Japan		\$9,000	\$40K	\$5K	\$25K	\$78K
China		\$6,000	\$20K	\$3K	\$13K	\$39K
Australia		\$4,000	\$10K*	\$2.5K	\$10K	\$26K
India		\$3,500	\$10K	\$1K	Neg.	\$15K
Canada		\$3,500	\$20K	\$2K	\$4,700	\$30K
South Korea		\$5,000	\$30K	\$2K	\$3,500	\$40K
Israel		\$2,500	\$30K	\$2K	\$2,300	\$37K
Total			\$53K	\$215K	\$23-70K	\$96-102K

Patent Process - Lifetime



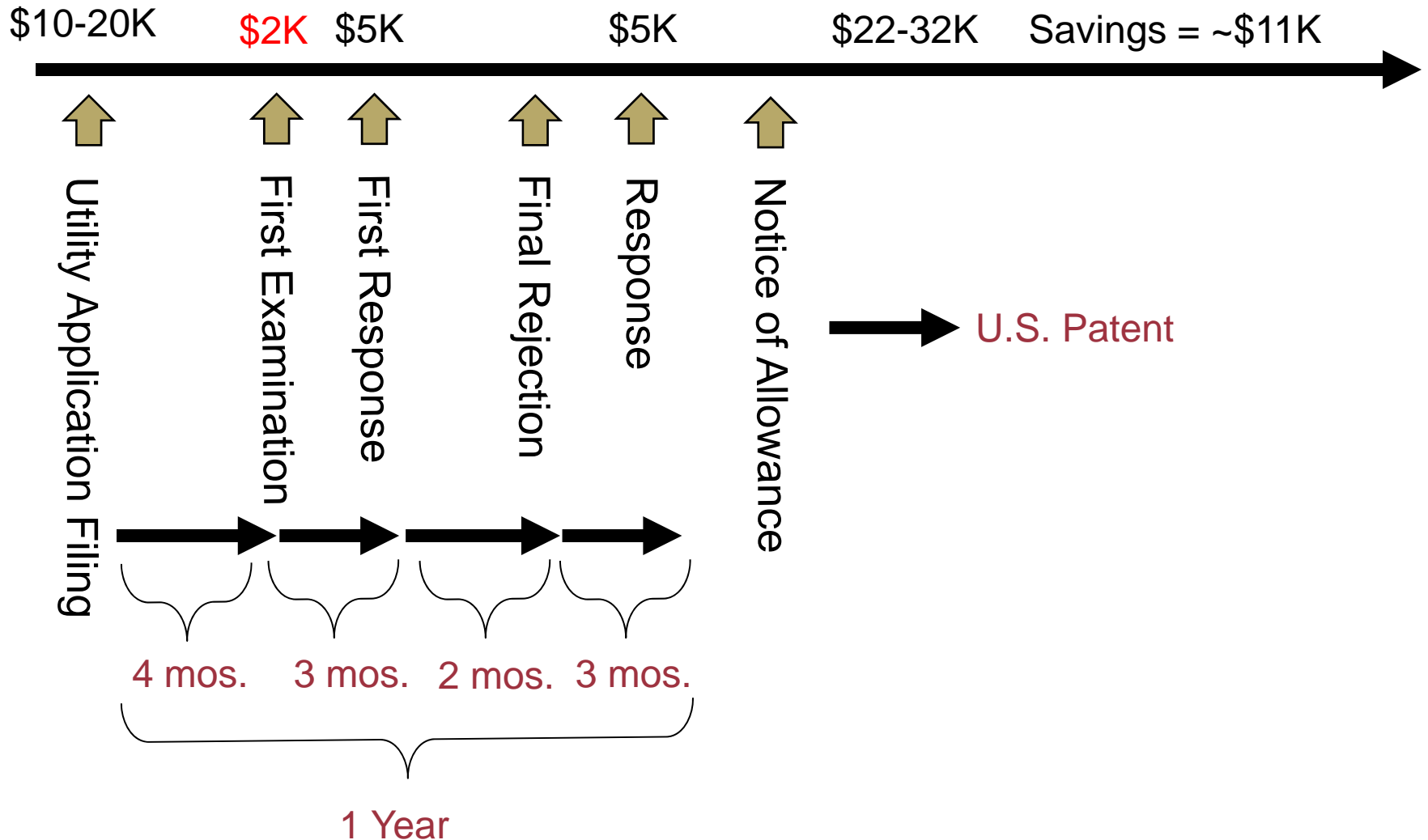
Typical U.S. Patent Prosecution



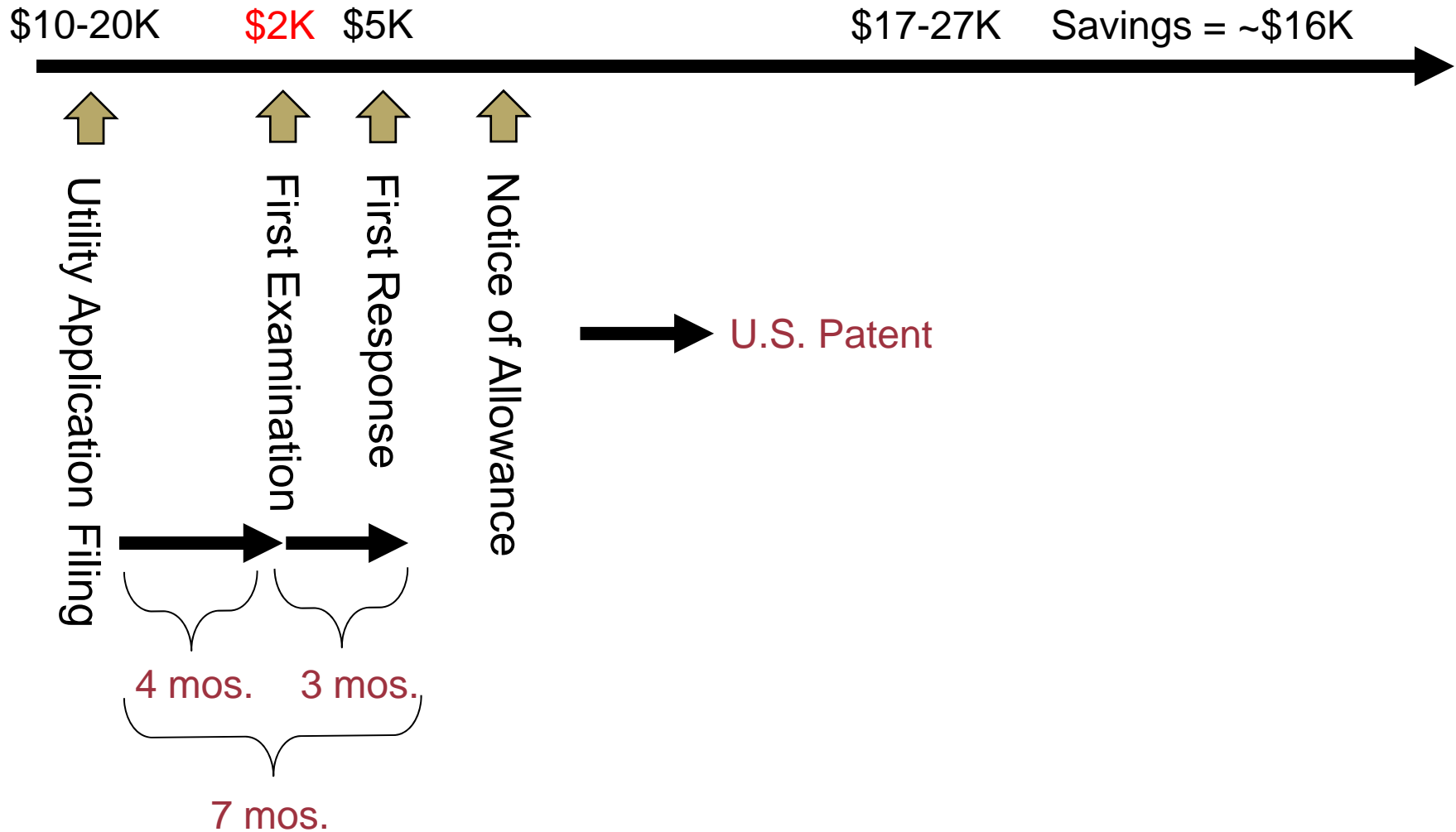
Simple Strategy

- 1. Request Track One Prioritized Examination in U.S.**
- 2. If foreign filing:**
 - **File Parallel PCT Application**
 - **Use Patent Prosecution Highway**

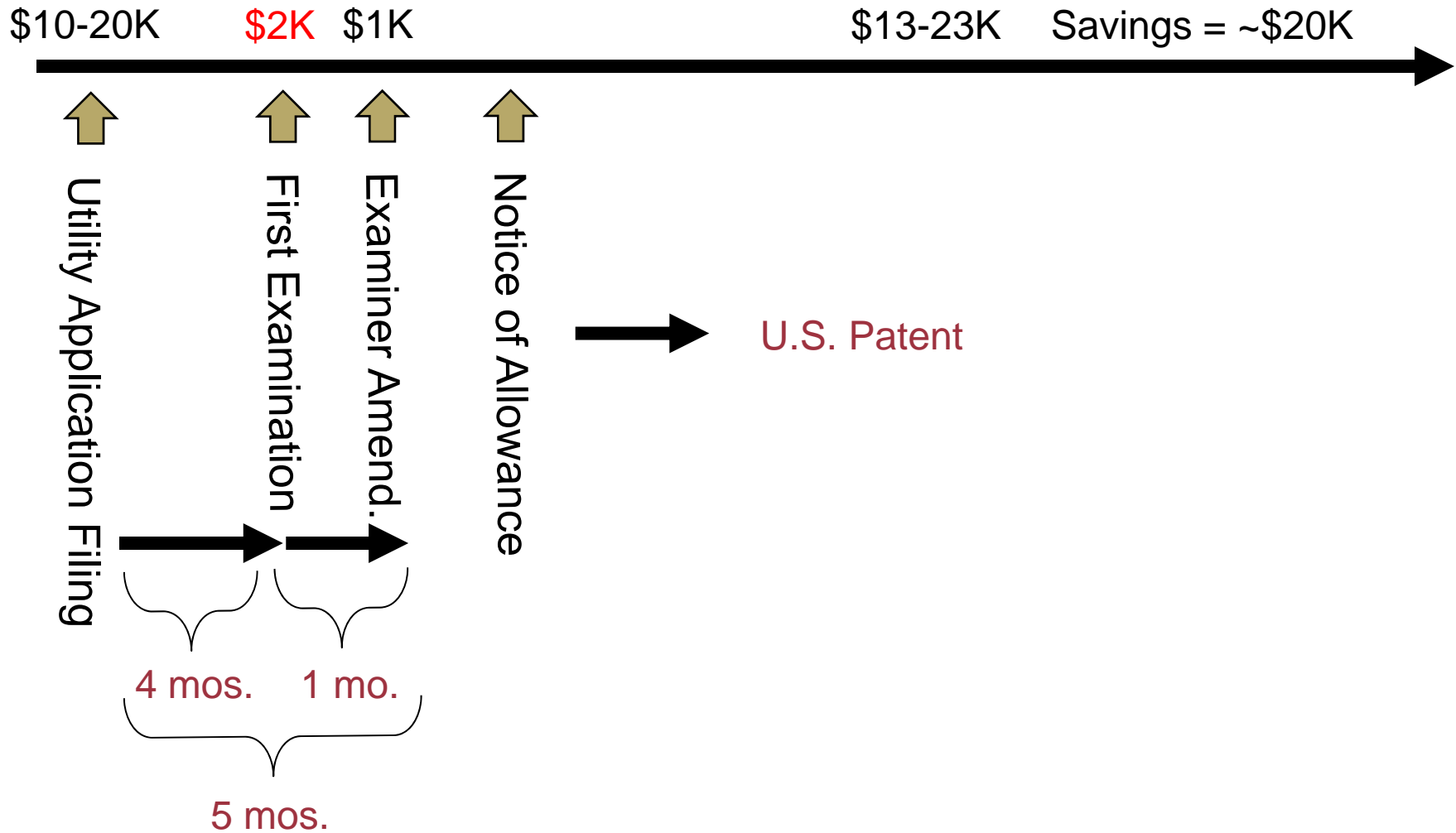
Expedited U.S. Patent Prosecution (Typical Case)



Expedited U.S. Patent Prosecution (Frequent Case)



Expedited U.S. Patent Prosecution (Best Case)



Patent Landscape – Vigilance and Diligence

- **Be familiar with the Prior Art**
- **Carve out your Protection**
- **Know your Competitors**
- **Understand where others have secured Protection**
- **Evaluate Freedom to Operate**
- **Understand IP Strength, Risks**

Trademarks

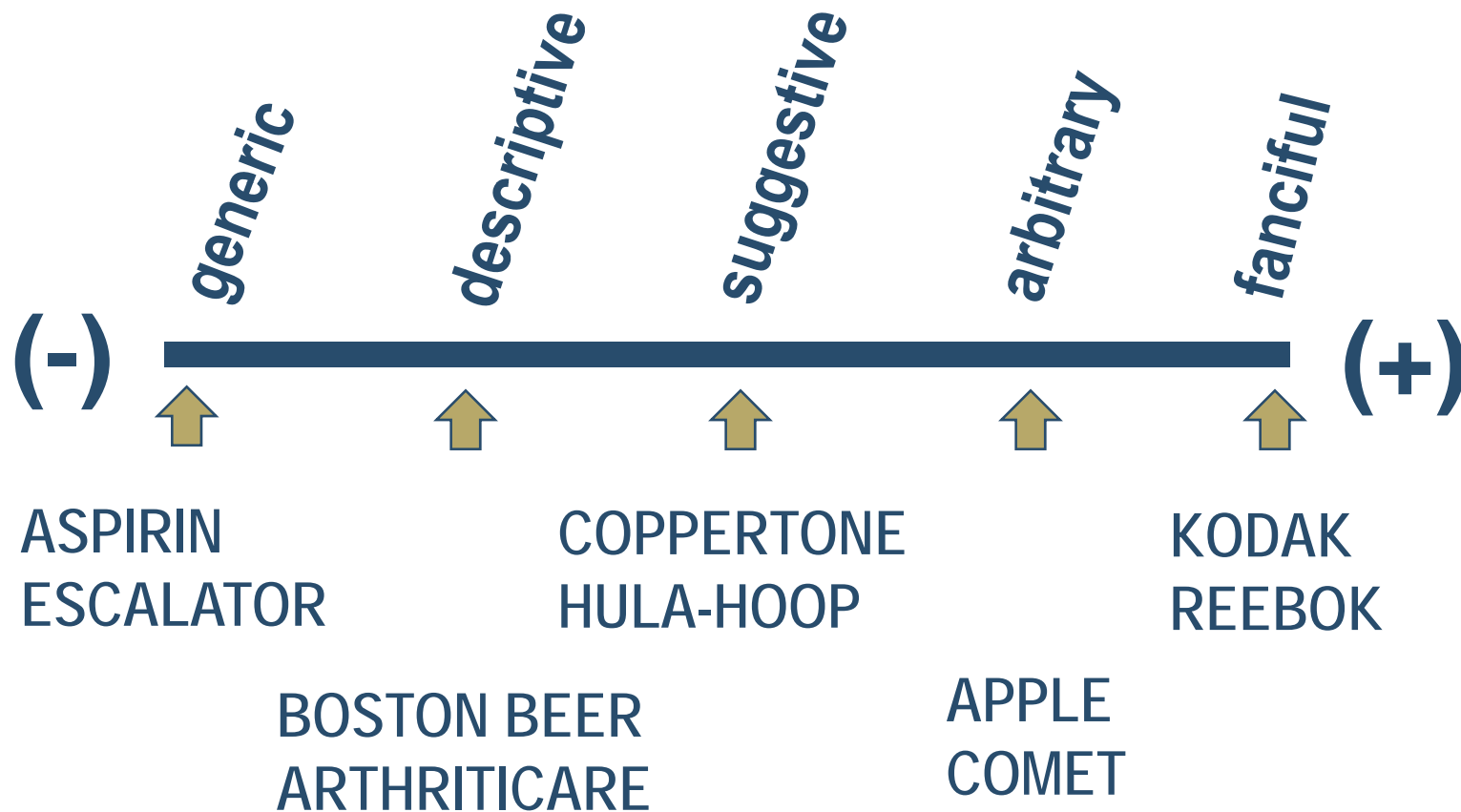
A Trademark Is A . . .

- **Word**
- **Name**
- **Symbol**
- **Design**
- **Slogan**
- **Word/design combination**
- **Distinctive sound**
- **Color**
- **Product shape**
- **Scent**

1. Make sure mark is not registered

2. Make sure mark is not generic

Trademark Selection



Questions/Discussion