



# **Championing Your Ideas with Coordinated IP Strategies**

A GC3 Startup Network Webinar

**February 19, 2019**

**GC3** GREEN CHEMISTRY &  
COMMERCE COUNCIL

# What is the GC3?

The Green Chemistry & Commerce Council (GC3) is a multi-stakeholder collaborative that drives the commercial adoption of green chemistry by catalyzing and guiding action across all industries, sectors and supply chains.



# Our Vision and Mission

**Vision:** A world where green chemistry is standard practice throughout the value chain.

**Mission:** To drive the commercial adoption of green chemistry by catalyzing and guiding action across all industries, sectors and supply chains.



# More than 120 Members Across Sectors and the Value Chain

amazon.com<sup>®</sup> EASTMAN Steelcase Johnson & Johnson Walmart 

LOWE'S  SHERWIN WILLIAMS  DOW ESTÉE LAUDER COMPANIES  THE HOME DEPOT 

 Chemours L'ORÉAL  TARGET Kingfisher  CVS Health

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  BASF   
 The Chemical Company seventh generation   covestro  COLGATE-PALMOLIVE

 GC3





# GC3 Startup Network

*Creating an innovation ecosystem for green and bio-based chemistry technologies*

## Goals:

- Support green and bio-based chemistry start-ups
- Introduce large strategics to new chemical technologies, partnership and investment opportunities

# Members of the GC3 Startup Network Include:



# GC3 Startup Network Technology Showcases

## Workshop on Leveraging Partnerships to Accelerate Green & Bio-Based Chemistry Innovation



February 1, 2017  
Hosted by  
**LEVI STRAUSS & CO.**

[www.greenchemistryandcommerce.org/startup-network](http://www.greenchemistryandcommerce.org/startup-network)



# GC3 INNOVATORS ROUNDTABLE

MAY 7-9, 2019 | HOSTED BY P&G FABRIC CARE, CINCINNATI, OHIO



**4<sup>th</sup> Annual  
GC3 Technology Showcase**  
May 7, 2019

**14<sup>th</sup> Annual  
GC3 Innovators Roundtable**  
May 7-9, 2019

Registration is now open, please visit [www.greenchemistryandcommerce.org](http://www.greenchemistryandcommerce.org).



# Ground Rules

- Due to the number of participants in the webinar, all lines will be muted
- If you have a question or comment, please type it in the “Questions” box located in the control panel
- Questions will be answered at the end of the presentation

# Today's Lineup



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# FINNEGAN

Finnegan, Henderson, Farabow, Garrett & Dunner, LLP

## Championing Your Ideas with Coordinated IP Strategies

Shana K. Cyr, Ph.D., J.D., and M. David Weingarten, Ph.D., J.D.



- Use
- Exclude
- Transfer





- How are ideas different?
- Do you own your ideas?

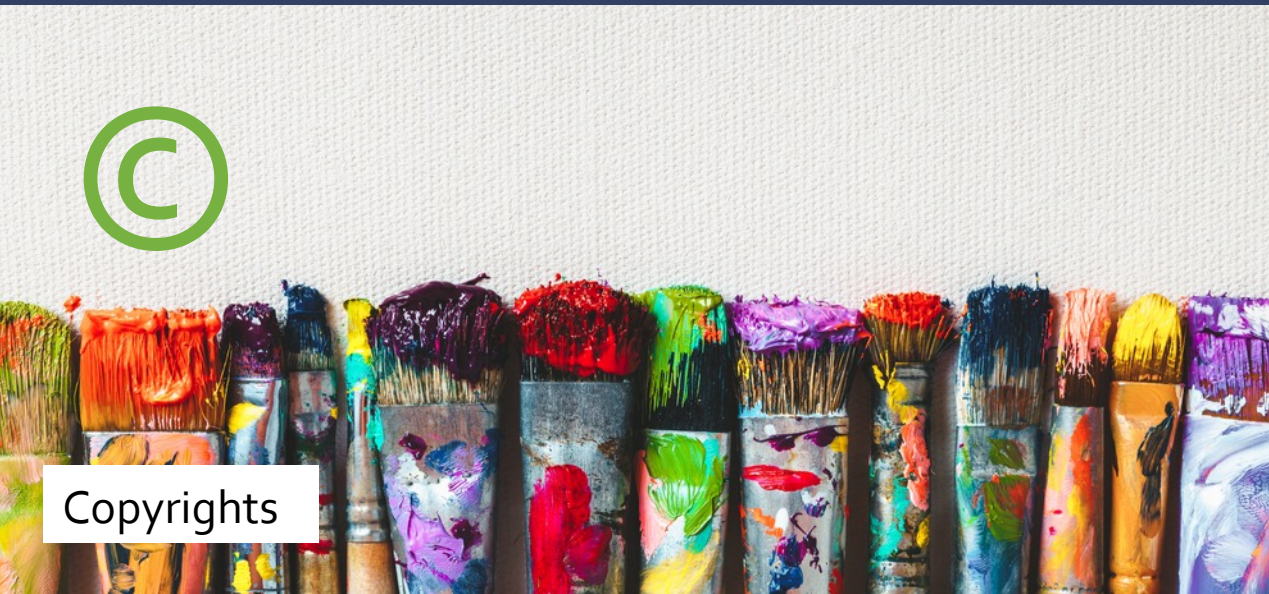
# Intellectual Property



Patents



Trade Secrets



Copyrights



Trademarks





- You
- Competitors
- Investors
- Licensees



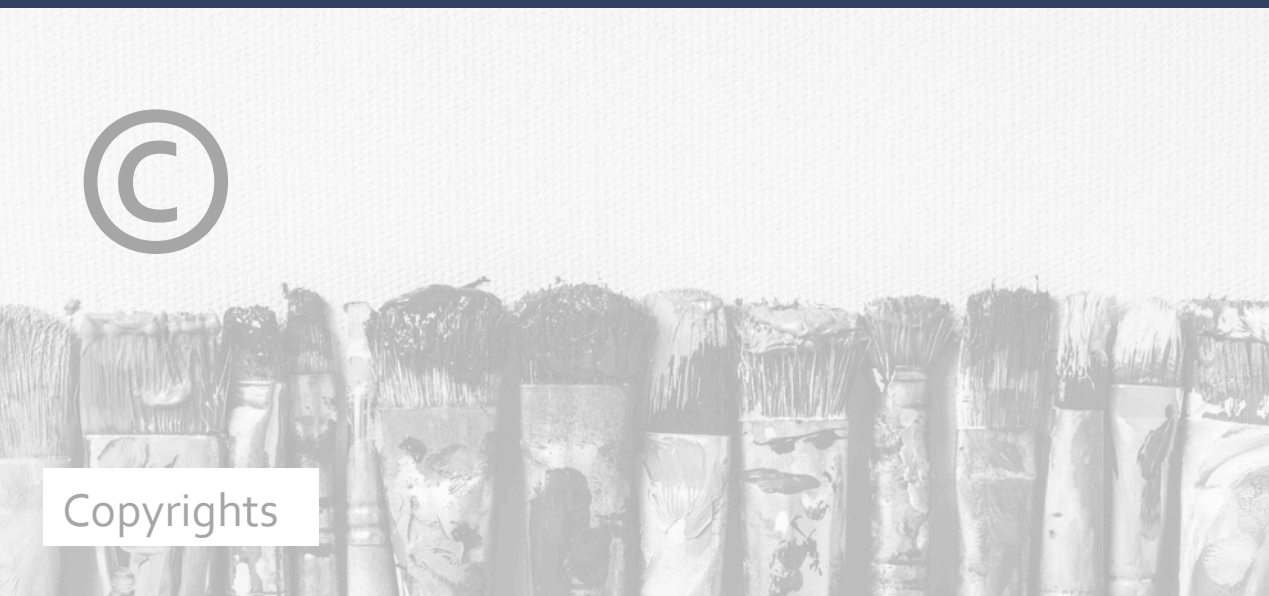
# Intellectual Property



Patents



Trade Secrets



Copyrights



Trademarks


# Patent Types

Plant

Design

Utility



  
 US00PP27640P3

**(12) United States Plant Patent** (10) Patent No.: **US PP27,640 P3**  
**Trees** (45) Date of Patent: **Feb. 7, 2017**

(54) **ROSA PLANT NAMED 'SFROSA128'** Related U.S. Application Data  
 (50) Latin Name: *Rosa hybrida* Provisional application No. 62/178,086, filed on Mar. 31, 2015.  
 Varietal Denomination: **SFROSA128** (51) Int. Cl. (2006.01) **A01H 5/02**  
 (71) Applicant: **Scott Trees, Arroyo Grande, CA (US)** (52) U.S. Cl. (2013.01) **PL/114**  
 (72) Inventor: **Scott Trees, Arroyo Grande, CA (US)** (53) Field of Classification Search  
 (73) Assignee: **Scott Trees, Arroyo Grande, CA (US)** USPC: 2013.01 **PL/114**  
 CPC: 2013.01 **A01H 5/0222**  
 See application file for complete search history.

(\* ) Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 0 days.

(21) Appl. No.: **14/756,578**  
 (22) Filed: **Sep. 18, 2015**  
 (65) **Prior Publication Data**  
 US 2016/0295758 P1 Oct. 6, 2016

**1 Drawing Sheet**

Latin name of genus and species of plant claimed: *Rosa hybrida*  
 Variety denomination: "SFROSA128".

**1** SUMMARY OF THE INVENTION

The following characteristics of the new cultivar have been repeatedly observed and can be used to distinguish "SFROSA128" as a new and distinct cultivar of shrub rose.

**BACKGROUND OF THE INVENTION**

The present invention relates to a new and distinct cultivar of shrub rose plant named "SFROSA128". The new cultivar will hereinafter be referred to by its cultivar name, "SFROSA128". The new cultivar of shrub rose is a landscape shrub.

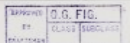
The new cultivar originated in a sex program in Arroyo Grande, Calif. during objective of the breeding program was to rose cultivars with disease resistance, ever unique brightly colored flowers that can gaud on their own roots.

The new shrub rose cultivar is the result of a cross between a female parent of the new cultivar, "SFROSA128", and a male parent of the new cultivar, "SFROSA128". The new cultivar was discovered and selected during October 2010 in a cross in Arroyo Grande, Calif.

Asexual reproduction of the new cultivar since October 2010 in Arroyo Grande, Calif. revealed that the new cultivar reproduces in the characteristics, as herein described retained through successive generations propagation.



FIG. 2

  
 US00PP27640P3

**(14) United States Design Patent** (10) Patent No.: **US D6,211,111**  
**Shoe** (45) Date of Patent: **Feb. 7, 2017**

(54) **SHOE** Related U.S. Application Data  
 (50) Provisional application No. 62/178,086, filed on Mar. 31, 2015.  
 (51) Int. Cl. (2006.01) **A63H 17/00**  
 (52) U.S. Cl. (2013.01) **36/220**  
 (53) Field of Classification Search  
 USPC: 2013.01 **36/220**  
 CPC: 2013.01 **A63H 17/00**  
 See application file for complete search history.

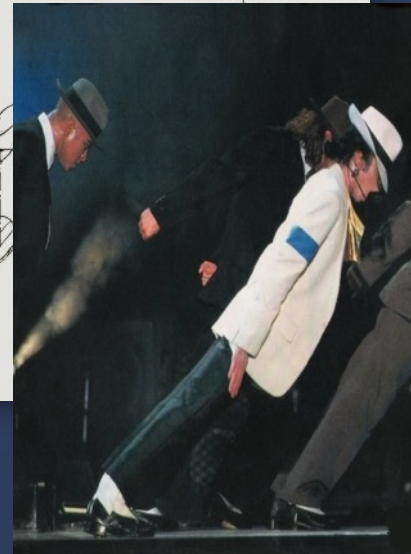
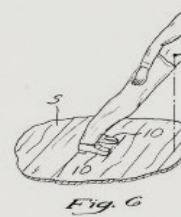
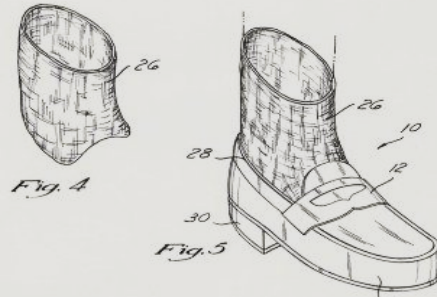
(\*) Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 0 days.


(21) Appl. No.: **14/756,578**  
 (22) Filed: **Sep. 18, 2015**  
 (65) **Prior Publication Data**  
 US 2016/0295758 P1 Oct. 6, 2016

**1 Drawing Sheet**

**SUMMARY OF THE INVENTION**

The following characteristics of the new design have been repeatedly observed and can be used to distinguish "SFROSA128" as a new and distinct design of shoe.



  
 US00PP27640P3

**(12) United States Patent** (19) Patent Number: **4,516,948**  
**Obara** (45) Date of Patent: **May 14, 1985**

(54) **RECONFIGURABLE TOY ASSEMBLY** References Cited  
 U.S. PATENT DOCUMENTS  
 4,206,564 6/1980 Ogawa 446/94  
 4,382,347 5/1983 Murakami 446/433  
 4,391,060 7/1983 Nakane 446/94  
 4,435,919 3/1984 Iwao et al. 446/470

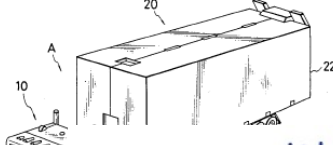

(75) Inventor: **Hiroaki Obara, Tokyo, Japan**  
 (73) Assignee: **Takara Co., Ltd., Tokyo, Japan**  
 (21) Appl. No.: **584,460**  
 (22) Filed: **Feb. 28, 1984**  
 (30) **Foreign Application Priority Data**  
 Sep. 22, 1983 [JP] Japan 58-146783[U]

(51) Int. Cl. **A63H 17/00**  
 (52) U.S. Cl. **446/95; 446/97; 446/376; 446/434; 446/487**  
 (58) **Field of Search** **446/95, 94, 93, 97, 446/99, 268, 376, 431, 433, 434, 465, 470, 478, 487**

**11 Claims, 7 Drawing Figures**

**ABSTRACT**

A reconfigurable toy assembly having foldable portions to allow the toy assembly to simulate a toy combination vehicle having a tractor unit and a trailer unit separately connected to each other. The tractor unit when separated from the trailer unit is reversibly reconfigurable into a robotic humanoid form, while the trailer unit is reversibly reconfigurable into a play space for the robotic humanoid.



- File application with USPTO
- Patentable subject matter, utility, described, enabled, definite, novel, nonobvious
- Withstand examination at USPTO
- Withstand challenges at USPTO and in court



- 20 years from effective filing date



*United  
States  
of  
America*

*To Promote the Progress of*

*Science and the Useful Arts*

*The Director*

*of the United States Patent and Trademark Office has received an application for a patent for a new and useful invention. The title and description of the invention are enclosed. The requirements of law have been complied with, and it has been determined that a patent on the invention shall be granted under the law.*

*Therefore, this United States*

- Summary Page: Title, inventor(s), assignee(s)
- Specification: Describe invention and object of invention
- Claims: Particularly point out invention

*Therefore, this United States*  
title to this patent the right to exclude others from making, using, offering for sale, or selling the invention throughout the United States of America or importing the invention into the United States of America, and if the invention is a process,

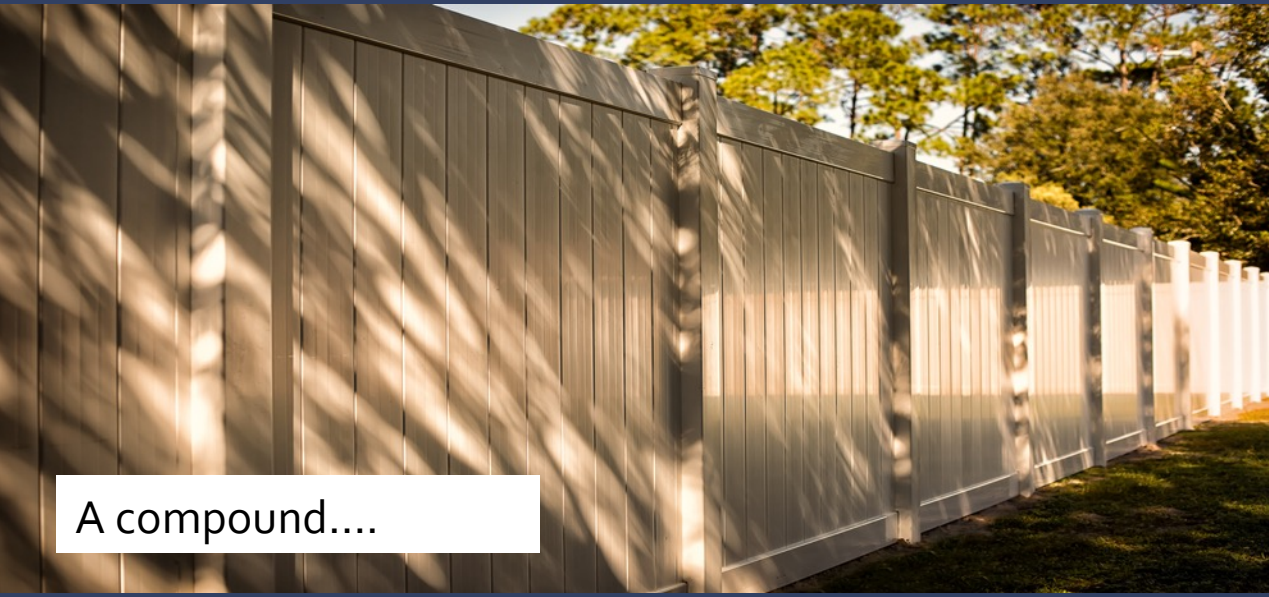


# Scope of Protection

- A compound of the formula shown where X is...
  - a chlorine atom
  - a chlorine atom or a fluorine atom
  - a halogen atom



# Varied Protection



A compound....



A composition comprising a compound....



A method of using a compound....



A method of making a compound....



1. A pharmaceutical formulation for oral administration comprising a pure solid state **alkaline salt** of the (-)-enantiomer of 5-methoxy-2-[(4-methoxy-3,5-dimethyl-2-pyridinyl)methyl]sulfinyl]-1H-benzimidazole and a pharmaceutically acceptable carrier.



*AstraZeneca AB v. Hanmi USA, Inc.,  
554 Fed. App'x 912 (Fed. Cir. 2013)*

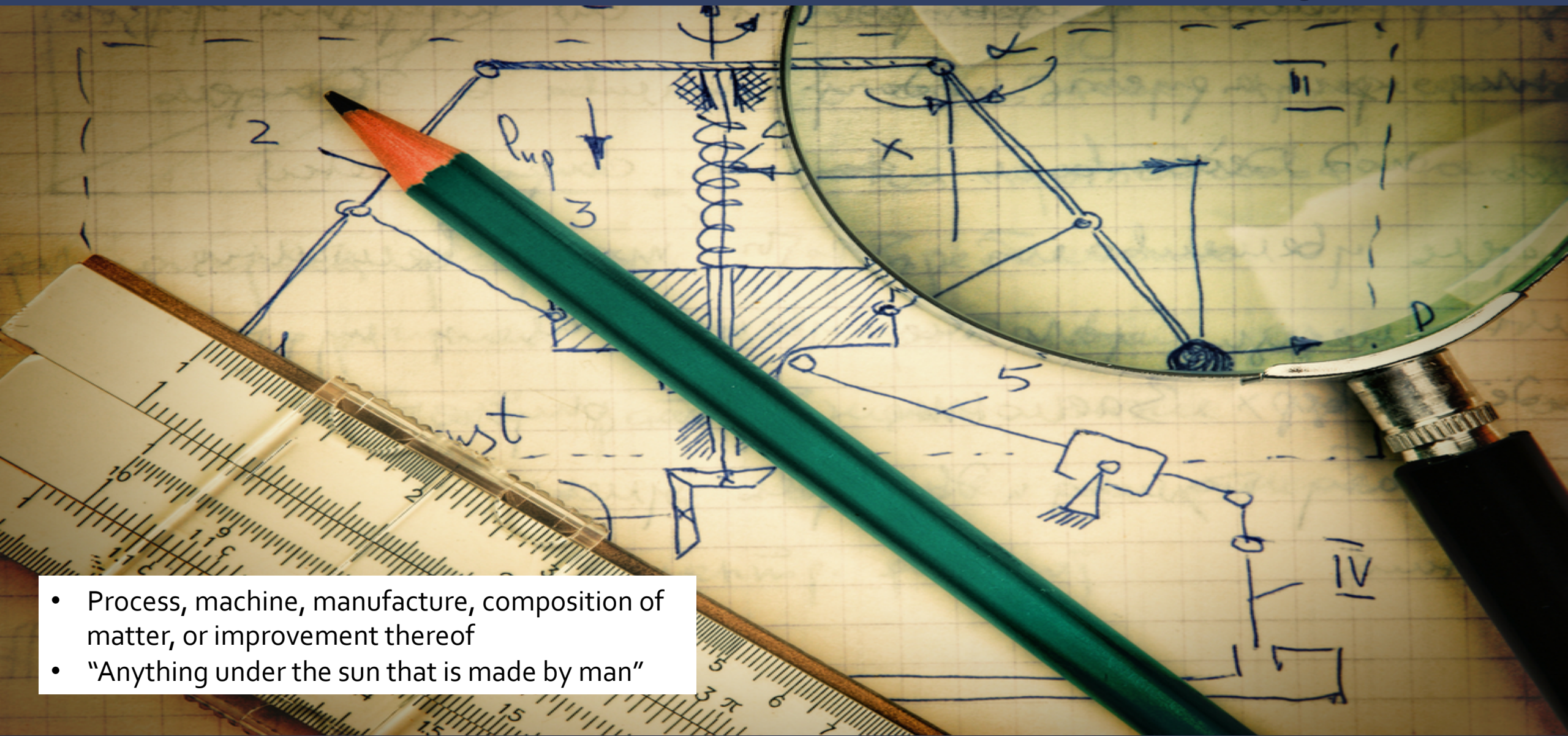
# A Careful Balance



- Patentable subject matter
- Utility
- Described, enabled, definite
- Novel
- Not obvious



# Patentable Subject Matter



- Process, machine, manufacture, composition of matter, or improvement thereof
- “Anything under the sun that is made by man”

# Not an Abstract Idea or Product of Nature

1. An isolated DNA coding for a BRCA1 polypeptide, said polypeptide having the amino acid sequence set forth in SEQ ID NO:2.

2. The isolated DNA of claim 1, wherein said DNA has the nucleotide sequence set forth in SEQ ID NO:1.



## INFORMATION FOR SEQ ID NO:1:

### ( i ) SEQUENCE CHARACTERISTICS:

- ( A ) LENGTH: 5914 base pairs
- ( B ) TYPE: nucleic acid
- ( C ) STRANDEDNESS: double
- ( D ) TOPOLOGY: linear

( i i ) MOLECULE TYPE: cDNA

## INFORMATION FOR SEQ ID NO:2:

### ( i ) SEQUENCE CHARACTERISTICS:

- ( A ) LENGTH: 1863 amino acids
- ( B ) TYPE: amino acid
- ( D ) TOPOLOGY: linear

( i i ) MOLECULE TYPE: protein

*Association for Molecular Pathology v. Myriad Genetics, Inc.,  
133 S. Ct. 2107 (2013)*



# USPTO Examples

## Vaccines (Example 28)

3. A vaccine comprising: Peptide F; and a pharmaceutically acceptable carrier.

Ineligible

4. A vaccine comprising: Peptide F; and a pharmaceutically acceptable carrier selected from the group consisting of a cream, emulsion, gel, liposome, nanoparticle, or ointment.

Eligible

## Dietary Sweeteners (Example 30)

2. A dietary sweetener comprising: 1-5 percent texiol; and at least 90 percent water.

Ineligible

3. A dietary sweetener comprising: 1-5 percent texiol; at least 90 percent water; and 1-2 percent Compound N.

Eligible

## Diagnosing and Treating Julitis (Example 29)

2. A method of diagnosing julitis in a patient, said method comprising: a) obtaining a plasma sample from a human patient; b) detecting whether JUL-1 is present in the plasma sample by contacting the plasma sample with an anti-JUL-1 antibody and detecting binding between JUL-1 and the antibody; and c) diagnosing the patient with julitis when the presence of JUL-1 in the plasma sample is detected.

Ineligible

3. A method of diagnosing julitis in a patient, said method comprising: a) obtaining a plasma sample from a human patient; b) detecting whether JUL-1 is present in the plasma sample by contacting the plasma sample with a porcine anti-JUL-1 antibody and detecting binding between JUL-1 and the porcine antibody; and c) diagnosing the patient with julitis when the presence of JUL-1 in the plasma sample is detected.

Eligible

USPTO Subject Matter Eligibility Examples: Life Science  
(May 2016)



- Specific and substantial unless well-established
- Not wholly inoperative

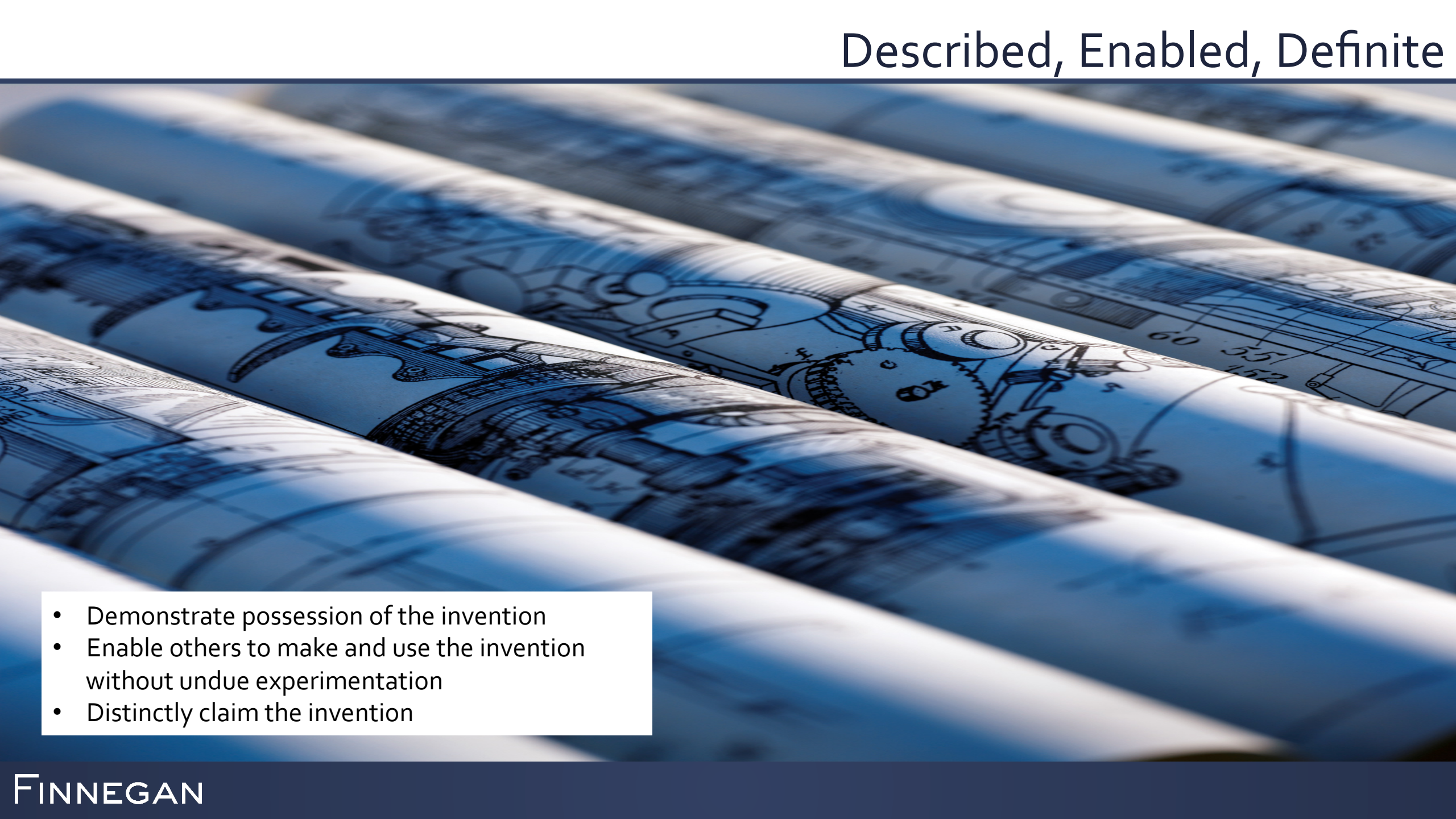
27. A beverage selected from the group consisting essentially of ethyl alcohol containing liquids, fruit juices, coffee, tea, extruded soy protein, and **chicken soup**, the beverage having enhanced flavor, obtained by practicing the method steps consisting essentially of establishing a substantially constant **magnetic field** with a minimum strength of about 3,000 Gauss, and passing the beverage through the field so that **the flavor thereof is enhanced**.



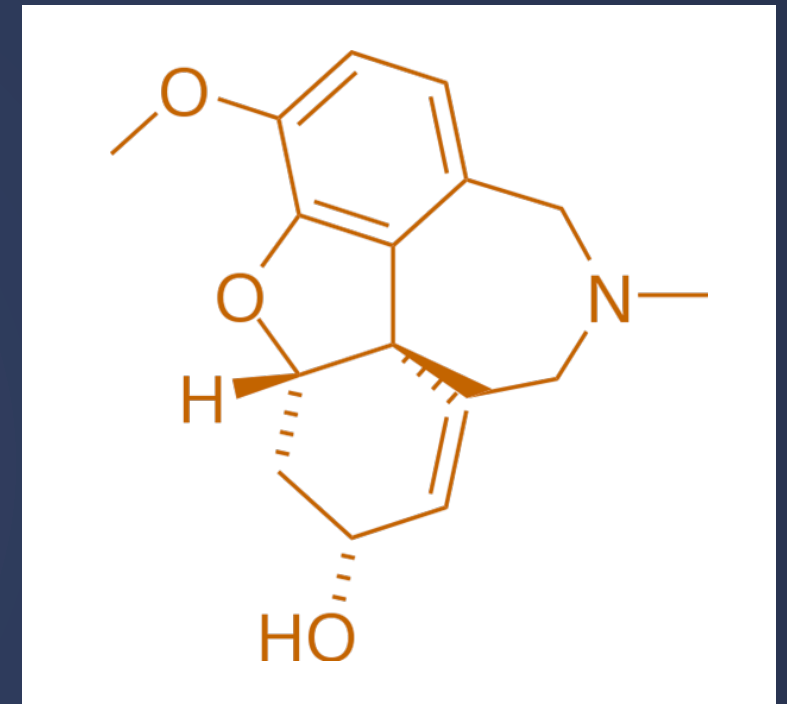
*Fregeau v. Mossinghoff*,  
776 F.2d 1034 (Fed. Cir. 1985)



# Described, Enabled, Definite

- 
- Demonstrate possession of the invention
  - Enable others to make and use the invention without undue experimentation
  - Distinctly claim the invention

1. A method of treating Alzheimer's disease and related dementias which comprises administering to a patient suffering from such a disease a therapeutically effective amount of galanthamine or a pharmaceutically-acceptable acid addition salt thereof.



*In re '318 Patent Litigation,*  
583 F.3d 1317 (Fed. Cir. 2009)



# Terms with Multiple Meanings

1. A method for administering pemetrexed disodium to a patient in need thereof comprising administering an effective amount of folic acid and an effective amount of a methylmalonic acid lowering agent followed by administering an effective amount of pemetrexed disodium, wherein the methylmalonic acid lowering agent is selected from the group consisting of **vitamin B12**, hydroxycobalamin, cyano-10-chlorocobalamin, aquocobalamin perchlorate, aquo-10-cobalamin perchlorate, azidocobalamin, cobalamin, cyanocobalamin, or chlorocobalamin.

Cyanocobalamin specifically?

More broadly, a class of compounds including pharmaceutical derivatives of cyanocobalamin?

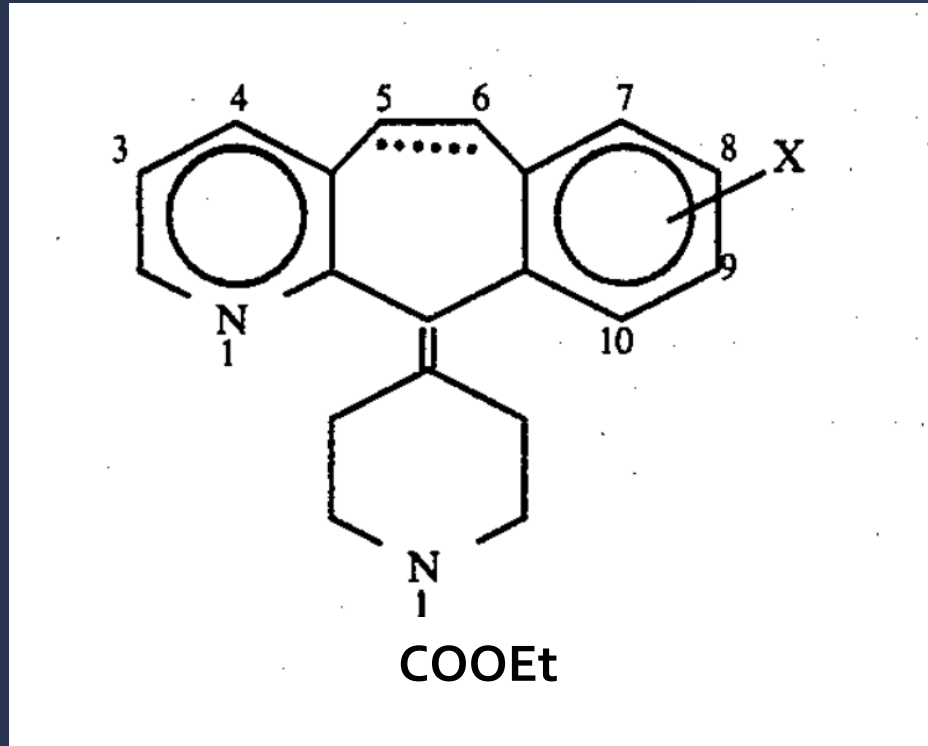


*Eli Lilly & Co. v. Teva Parenteral Medicines, Inc.,  
845 F.3d 1357 (Fed. Cir. 2017)*

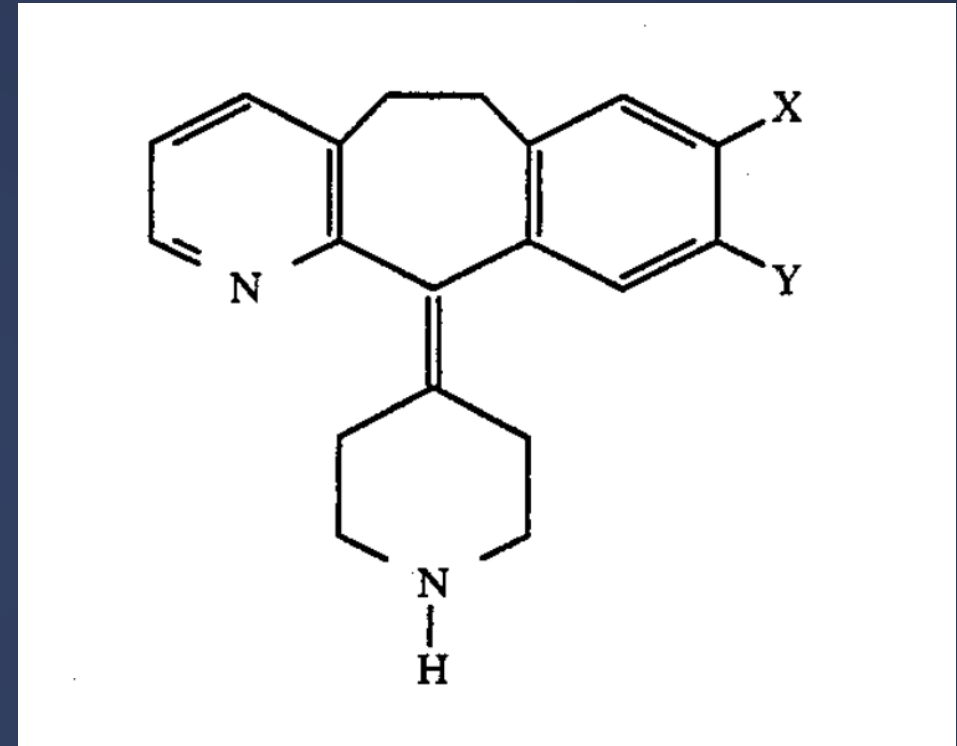
- Not anticipated expressly or inherently
- Not barred by statute



# Inherent Anticipation



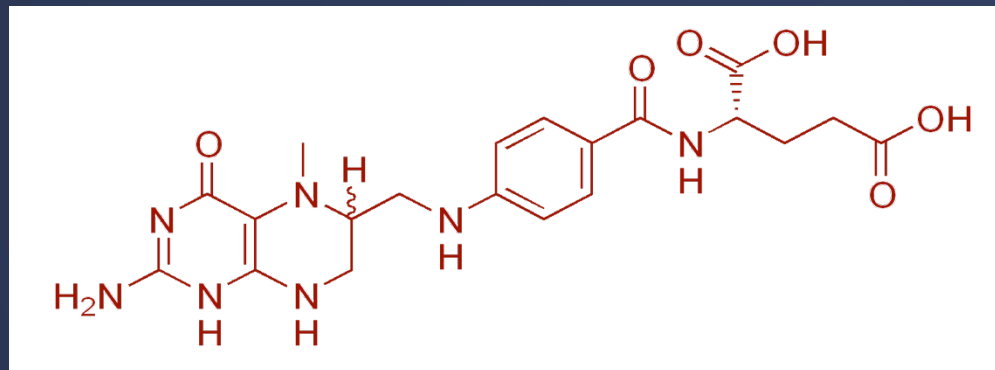
Digestion



Non-Drowsy  
**Claritin**<sup>®</sup>  
Allergy Products

*Schering Corp. v. Geneva Pharmaceuticals,*  
339 F.3d 1373 (Fed. Cir. 2003)

4. A crystalline calcium salt of 5-methyl-(6S)-tetrahydrofolic acid with 2 theta values of 6.5, 13.3, 16.8 and 20.1 (Type I) said crystalline salt having a water of crystallization of at least one equivalent per equivalent of 5-methyltetrahydrofolic acid.



*Merck & Cie v. Watson Laboratories, Inc.,*  
822 F.3d 1347 (Fed. Cir. 2016)



**3. A method for use in the investigation of nuclear magnetic resonance in a specimen, the method comprising:**

- exciting transient radio-frequency resonance signals in the specimen by means of a train of radio-frequency pulses successive ones of which are in relative phase quadrature;**
- deriving from said resonance signals two substantially identical sinusoidal transient signals having the same transient form as said resonance signals;**
- producing two sinusoidal reference signals which are substantially identical except for being in phase quadrature and which have a frequency close to that of said two sinusoidal transient signals;**
- multiplying each of said sinusoidal transient signals by a different one of said reference signals to produce two output signals each having sum and difference frequency components which correspond to the sum and difference respectively of the frequencies of said sinusoidal transient signals and said reference signals; and**
- selecting said difference frequency component from each of said two output signals.**



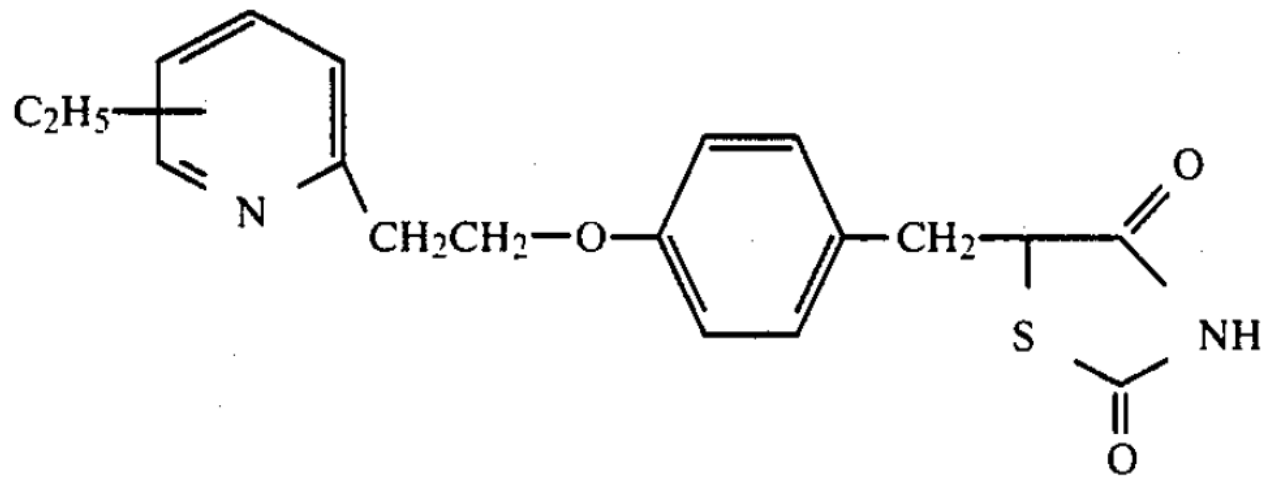
- Differences between invention and prior art not obvious to person having ordinary skill in the art





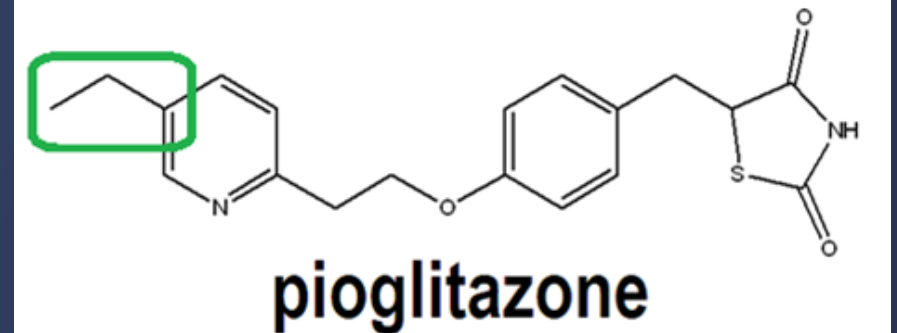
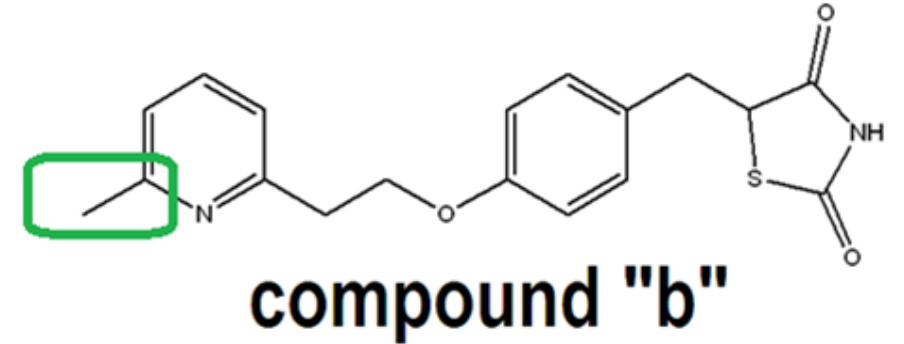
# Lead Compound

1. A compound of the formula:



or a pharmacologically acceptable salt thereof.

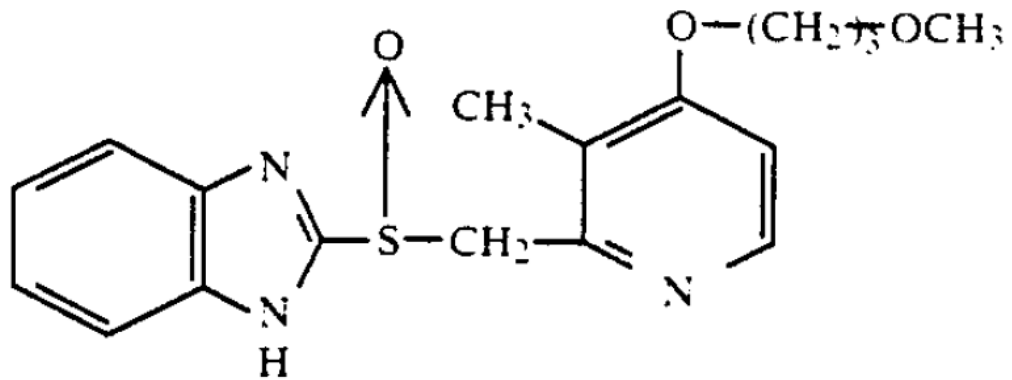
2. A compound as claimed in claim 1, wherein the compound is 5-{4-[2-(5-ethyl-2-pyridyl)ethoxy]benzyl}-2,4-thiazolidinedione.



*Takeda Chemical Industries, Ltd. v. Alphapharm Pty.,*  
492 F.3d 1350 (Fed. Cir. 2007)

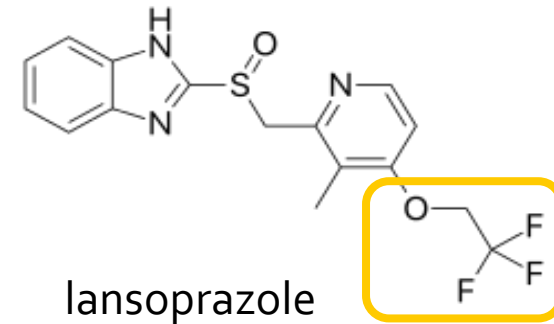
# Reason to Modify

1. A compound represented by the formula:

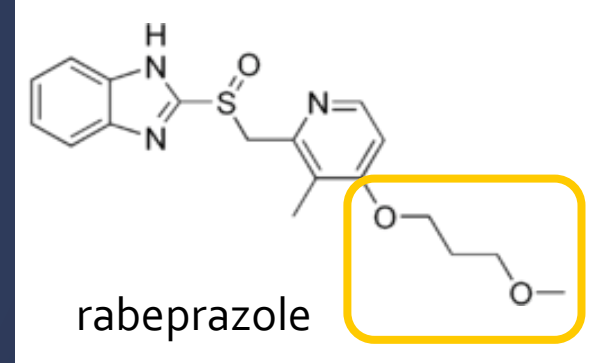


or a pharmaceutically acceptable salt thereof.

2. The compound of claim 1 as the sodium salt.



lansoprazole



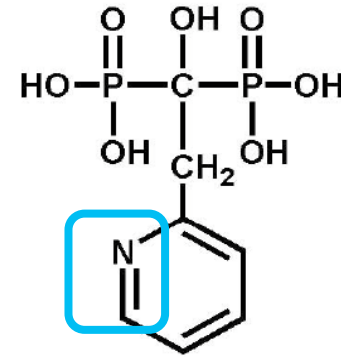
rabeprazole

*Eisai Co. v. Dr. Reddy's Laboratories, Ltd.,*  
533 F.3d 1353 (Fed. Cir. 2008)

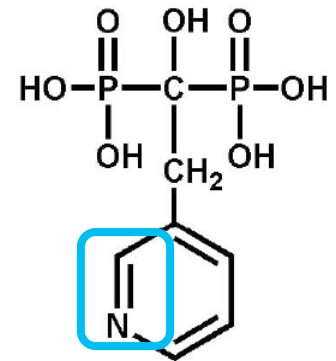
# Reasonable Expectation of Success

4. A diphosphonic and acid compound, or pharmaceutically-acceptable salt or ester thereof, which is 2-(3-pyridyl)-1-hydroxyethane diphosphonic acid.

2-pyr EHDP



risedronate



*Procter & Gamble Co. v. Teva Pharmaceuticals USA, Inc.,*  
566 F.3d 989 (Fed. Cir. 2009)

Long-Felt But Unmet Need

Failure of Others

Teaching Away by Others

Skepticism by Experts

Praise by Others

Copying by Competitors

Commercial Success

# Patent Strategies

- Harvest inventions
- Strategically time filings
- Obtain claims of varying scope
- Identify continuation opportunities
- Use patent marking
- Develop a monetization program
- Monitor use by others
- Enforce





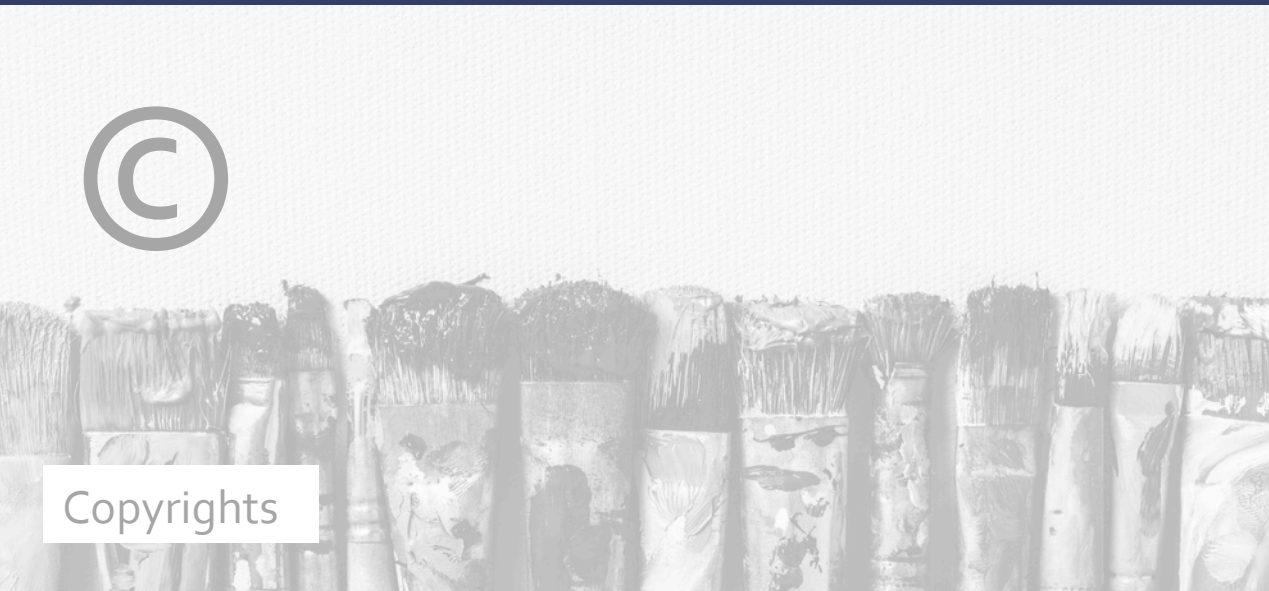
# Intellectual Property



Patents



Trade Secrets

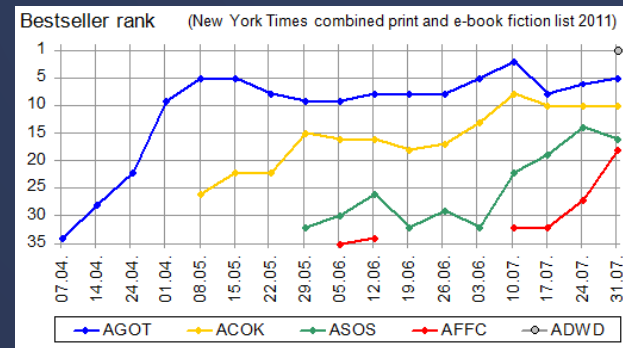
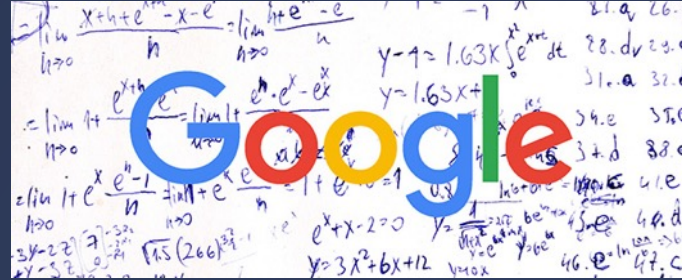


Copyrights



Trademarks

# Secret and Valuable Information





# Protect Confidential Business Information

- Information that is secret and valuable
- Reasonable steps to maintain secrecy



- No longer secret

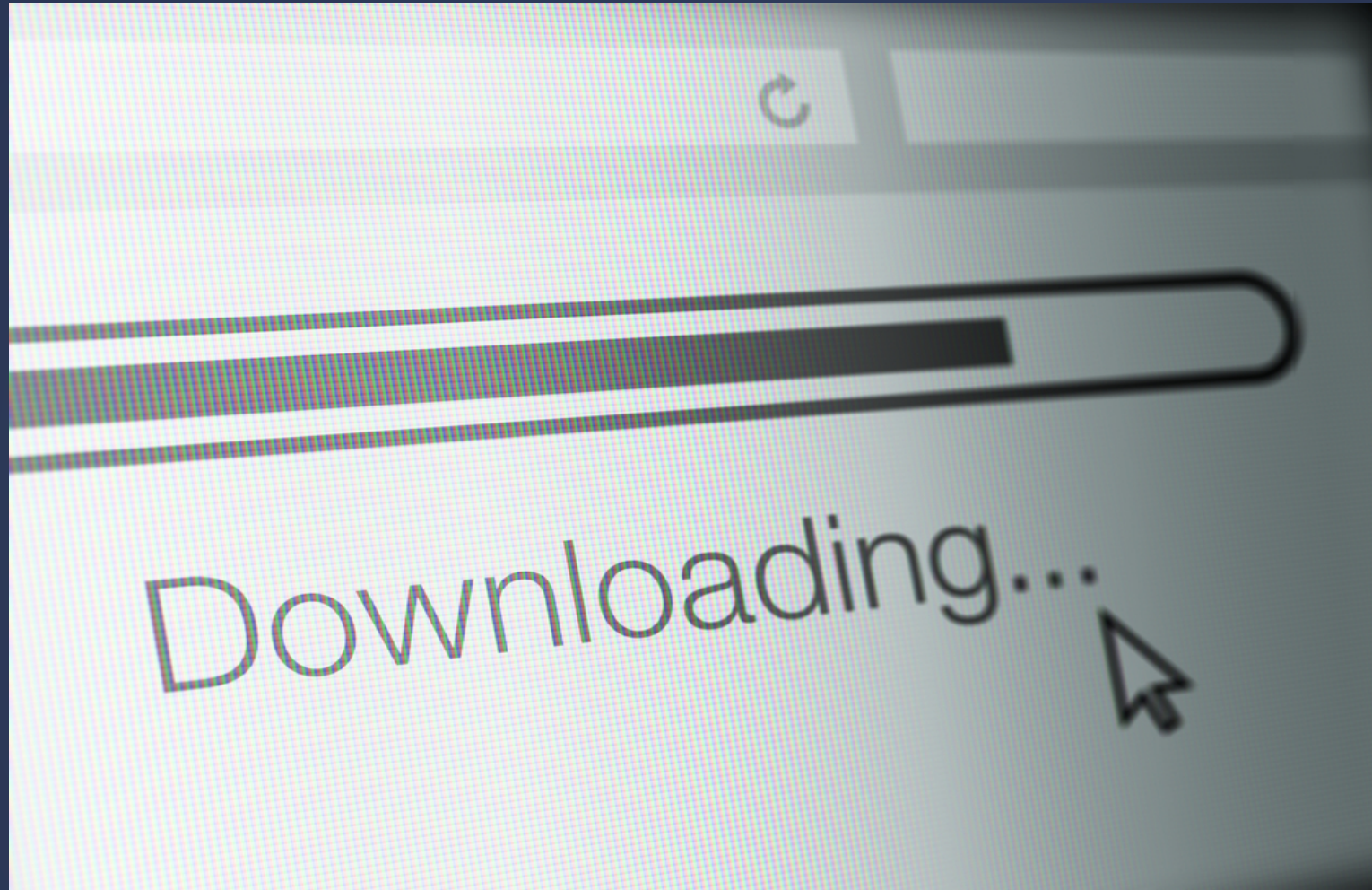




# Reasonable Efforts to Maintain Secrecy



*E.I. DuPont DeNemours & Co. v. Christopher,*  
431 F.2d 1012 (5th Cir. 1970)



*United States v. Nosal,*  
844 F.3d 1024 (9th Cir. 2016)





- Readily ascertainable from publicly available information

*Chicago Lock Co. v. Fanberg,*  
676 F.2d 400 (9th Cir. 1982)

# Using Patents and Trade Secrets


## Trade Secret

- Not patent eligible
- Commercial value <2 or >20 years

## Patent

- Can be reverse engineered
- Difficult to keep secret

# Trade Secret Strategies

- 
- Restrict access
  - Establish written trade secret policy
  - Use confidentiality agreements
  - Train employees
  - Use legending
  - Monitor authorized and unauthorized access
  - Enforce



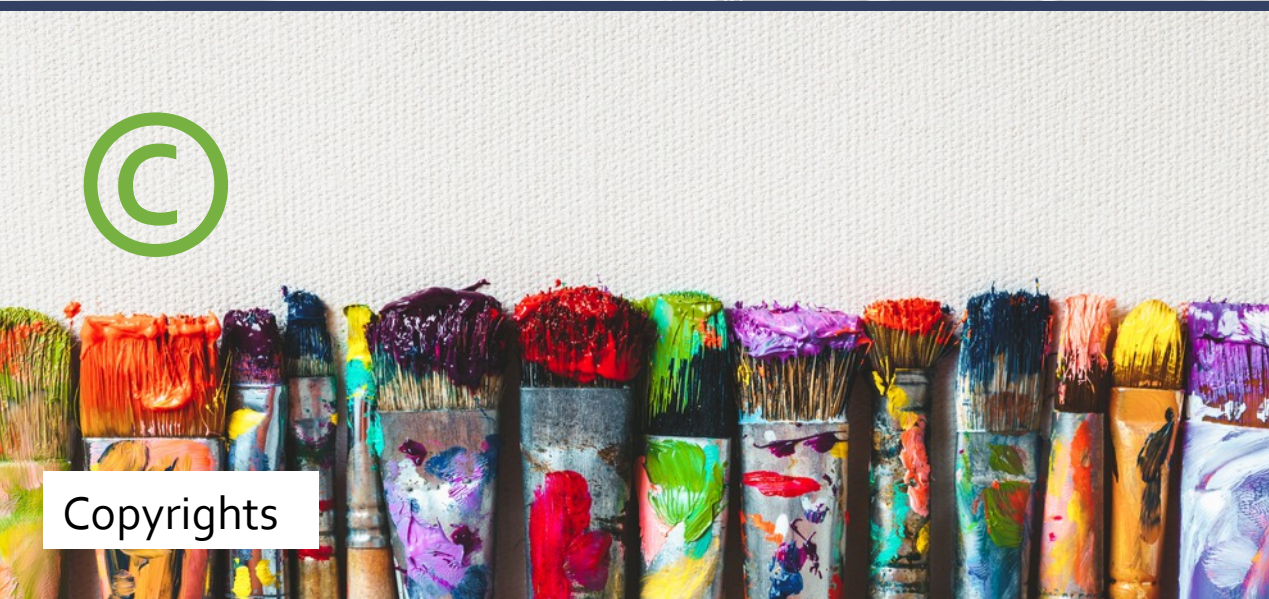
# Intellectual Property



Patents



Trade Secrets



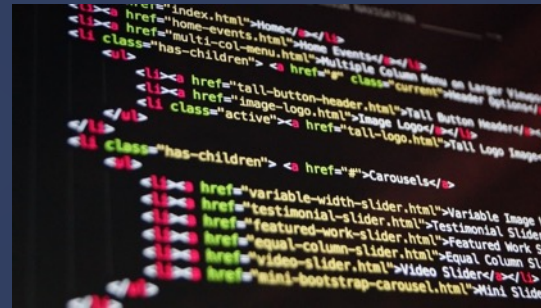
Copyrights



Trademarks

# Creative Works

More poetry  
is needed.





- Creative work fixed in a tangible medium



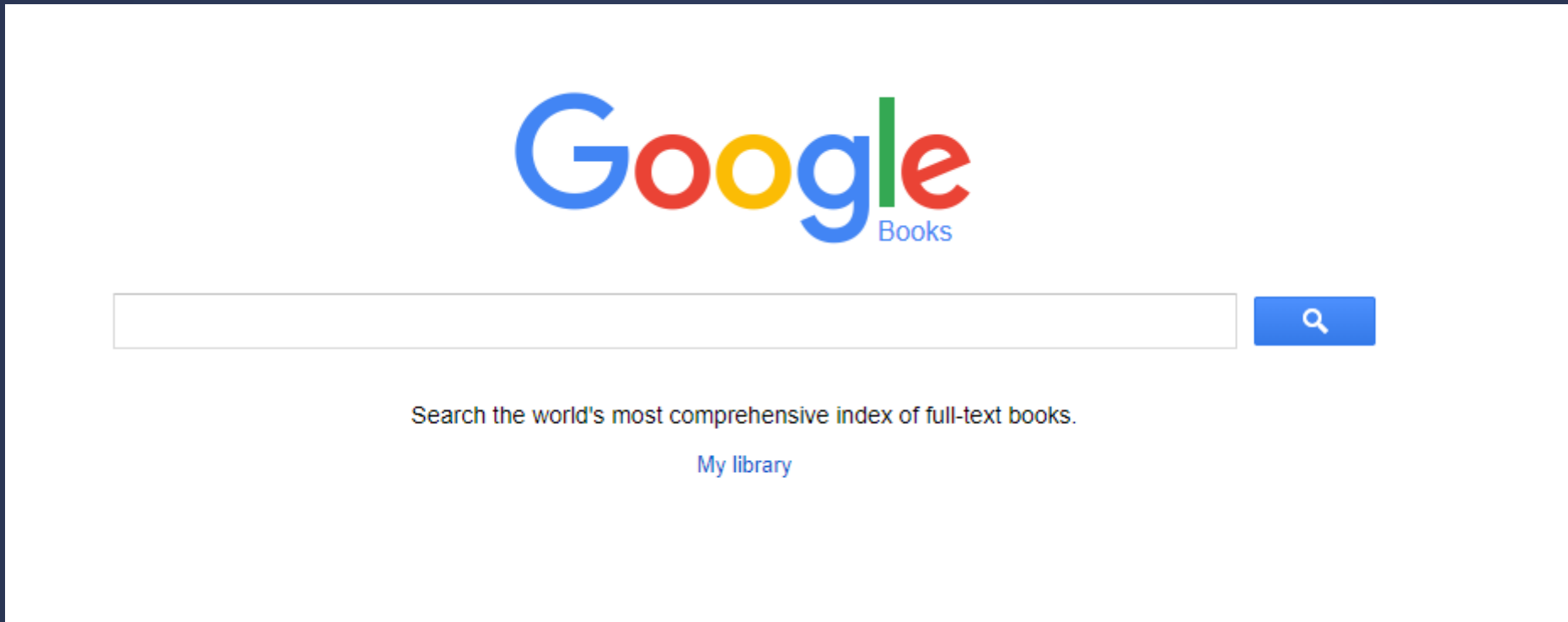
- Life plus 70 years
- Or shorter of 120 years from creation or 95 years from first publication







*American Geophysical Union v. Texaco Inc.,  
60 F.3d 913 (2d Cir. 1994)*





# Copyright Strategies



- Register copyright for benefits
- Use copyright notice
- Monitor use by others
- Enforce





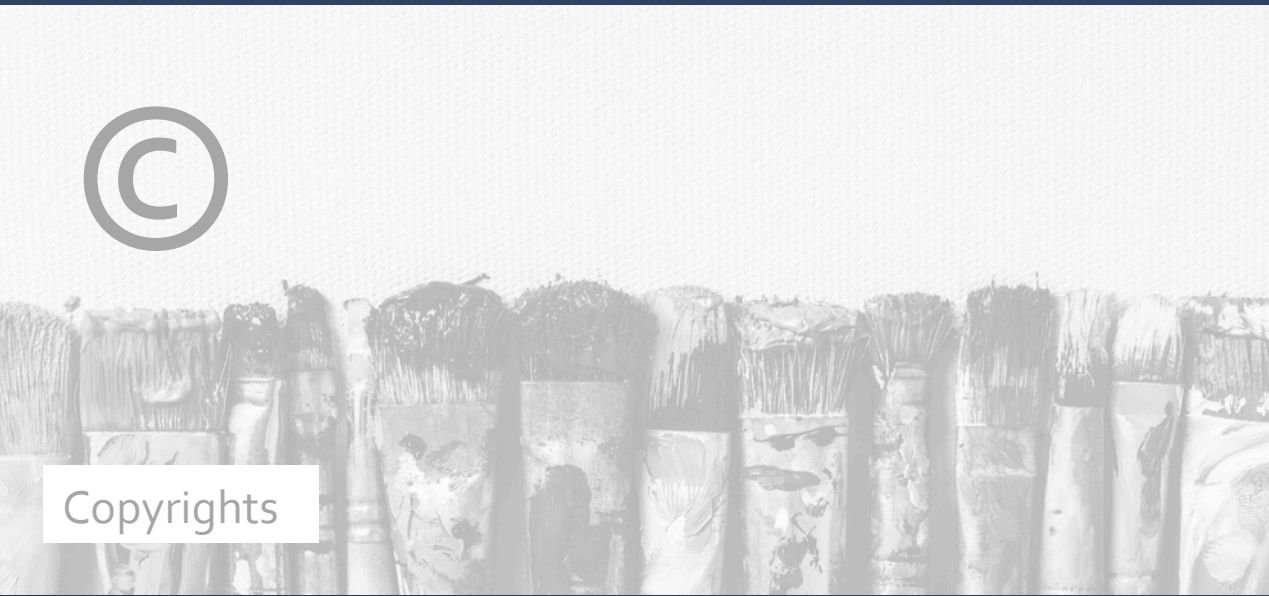
# Intellectual Property



Patents



Trade Secrets



Copyrights



Trademarks

# Source Identifiers





- Mark that identifies and distinguishes a source



- Abandoned
- No longer identifies and distinguishes source





# Strength of Word Marks



## Generic

- Common name
- “Apple,” “Bicycle”
- Cannot be protected



## Descriptive

- Immediately identifies good’s nature
- “Home Depot,” “Sharp,” “Windows”
- Requires secondary meaning



## Suggestive

- Identifies good’s nature with imagination
- “Coppertone,” “Chicken of the Sea,” “PlayStation,” “Microsoft”
- Inherently distinctive



## Arbitrary

- Common word used in unique way
- “Apple,” “Starbucks,” “Blackberry,” “Gap”
- Inherently distinctive



## Fanciful

- Invented word
- “Kodak,” “Xerox,” “Exxon,” “Buick”
- Inherently distinctive

No Similar Name for Competing Product

Advicor

Altocor

*Kos Pharmaceuticals, Inc. v. Andrx Corp.,  
369 F.3d 700 (2004)*

# No Similar Appearance for Competing Product



Nexium® capsules with either two or three gold-colored bands



Pfizer's Nexium® OTC capsules

Teva



Mylan



First wave Nexium® generics



Second wave Camber Nexium® generic

*AstraZeneca AB v. Camber Pharmaceuticals, Inc.,  
2015 WL 7307101 (D. Del. 2015)*



# No Blurring or Tarnishing



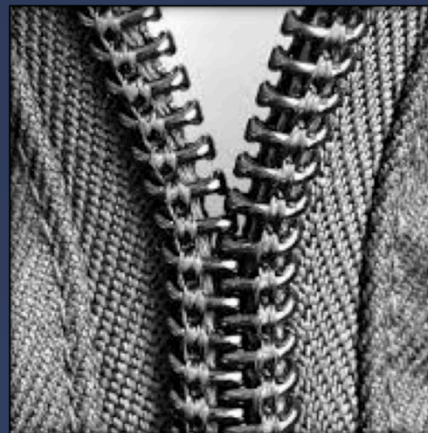
© Coca-Cola Ltd.



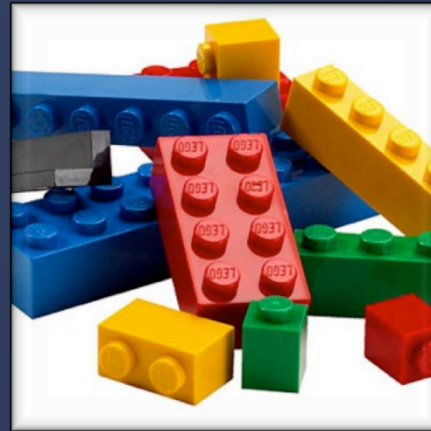
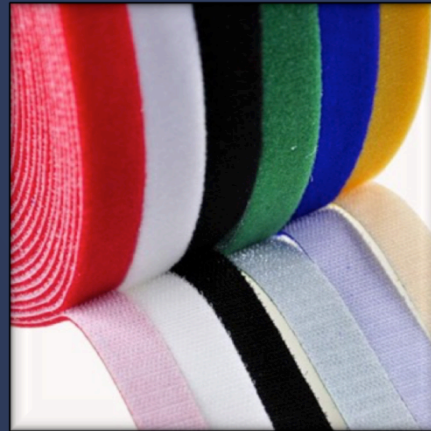
"To associate such a noxious substance as cocaine with plaintiff's wholesome beverage... would clearly have a tendency to impugn that product and injure plaintiff's business reputation...."

*Coca-Cola Co. v. Gemini Rising, Inc.*,  
345 F. Supp. 1183 (E.D.N.Y. 1972)

# Trademark Erosion

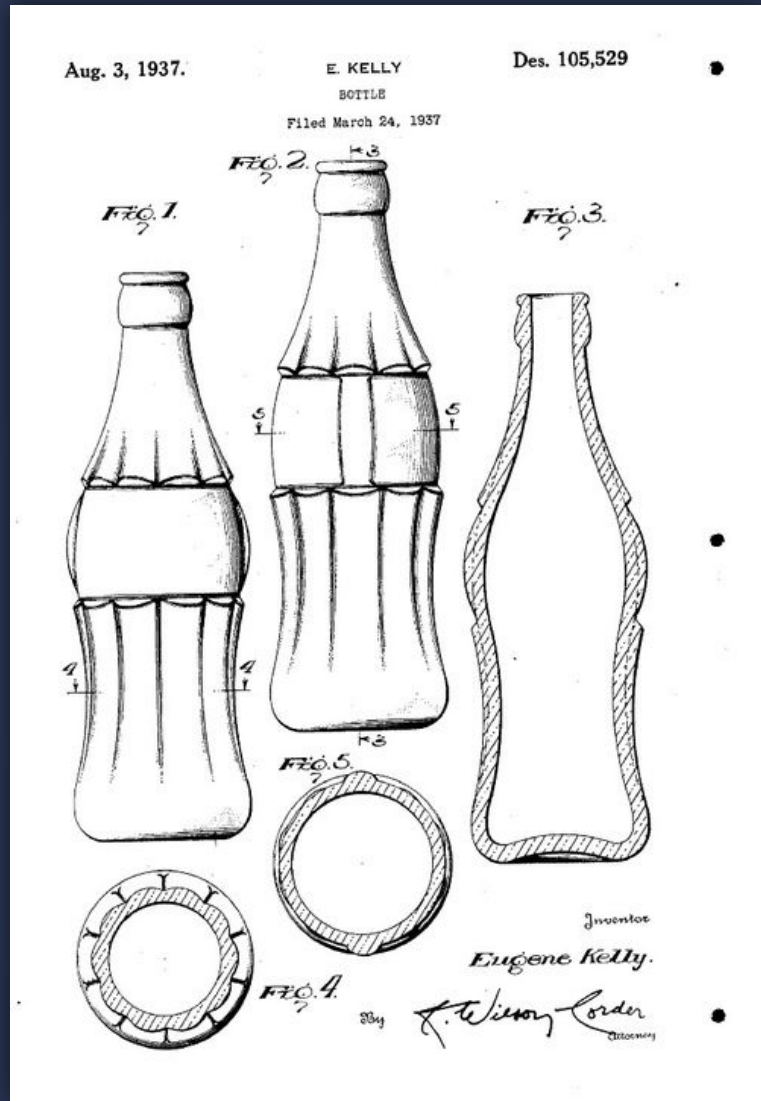


# Trademark Erosion?





# Using Design Patents and Trademark



# Trademark Strategies

- Strategically develop marks
- Conduct clearance search
- Register with USPTO
- Protect against erosion
- Monitor use by others
- Enforce

TM ®





# Coordinated Strategies



1. Carefully choose IP
2. Run business with IP in mind
3. Monitor others' IP
4. Remember that timing is critical



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# Thank You



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# Question & Answer

Please enter questions or comments in the “Questions” box located in the control panel.



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