

FLC - Making a Difference Thru T²

Legislative and Case Law Updates in Intellectual Property

Boris Zelkind



August 30, 2017

- BZ intro

Defensive Publishing vs. Trade Secrets

- **What is Defensive Publishing?**
 - Disclosing rather than patenting
- **Why do we do it?**
 - To prevent others from patenting
 - To manage costs
 - To get more time to file a patent application
 - To increase public storehouse of knowledge

Defensive Publishing vs. Trade Secrets

What is a Trade Secret?

- information
- that derives economic value from being secret
- is the subject of reasonable efforts to maintain secrecy

New Federal Trade Secret Misappropriation Law

May 11, 2016 - President Obama signed DTSA into law



Defensive Publishing vs. Trade Secrets

DTSA - Civil Seizure Procedure



Boris Zelkind

boris.zelkind@knobbe.com



Orange County



San Diego



San Francisco



Silicon Valley



Los Angeles



Riverside



Seattle



Washington DC

Defensive Publishing vs. Trade Secrets

- **Trade Secrets Pros**
 - Can Last Indefinitely
 - Protects virtually any kind of information
 - Do not need government approval
- **Trade Secrets Cons**
 - Do not stop reverse engineering or independent discovery
 - Do not prevent others from patenting
 - Can be expensive to enforce

Defensive Publishing vs. Trade Secrets

- So which is right for you?
 - Consider ultimate goal: maintain secret vs. prevent others from patenting
 - Consider subject matter: how easy is it to reverse engineer; how close are others to discovery
 - Ask if you will ever want to patent the idea
 - Keep in mind the new “Prior Commercial Use Defense” to patent infringement
 - Consider newly available trade secrets protections