

IP Law Update:

Top Intellectual Property Mistakes and Pitfalls of 2019

Ed Cavazos | Partner

Pillsbury Winthrop Shaw Pittman LLP



Top Intellectual Property Mistakes and Pitfalls

1. Mishandling the Patent Troll Letter
2. Failing to Secure IP Ownership from Contractors
3. Agreeing to Partial or Incomplete IP Indemnity
4. Believing the Open Source Software Myths
5. Forgetting to Properly Police Trademarks
6. Procuring Insufficient IP Insurance Coverage
7. Getting Burned by “Exclusive” Licenses
8. Entering into “Half-Baked” IP Agreements
9. Overlooking Hidden Risks in Non-disclosure Agreements
10. Taking the “Joint Ownership” Shortcut in Negotiations



#1. Mishandling the Patent Troll Letter

- The Problem:

- The licensing letter from a non-practicing entity is the beginning of a story that can end many ways
- There is no “one-size fits” all strategy on how to respond
 - Ignore?
 - Request more info?
 - Respond with a substantive defense?
 - Look for ways to bring a declaratory judgment action?



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#1. Mishandling the Patent Troll Letter

- Practice Tips:

- Learn as much as you can about the plaintiff and its lawyers
 - Litigation history. How often? Where?
 - Settlements History
- Learn enough about patent to have a baseline as to how much risk is posed
 - Do the claims read on your client's business?
 - Has the validity of the patents been challenged and if not, is it vulnerable?
 - Business Method / CBM Review possible?
 - Inter Partes Review (prior art)

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