



PROGRAM MATERIALS

Program #3044

March 12, 2020

**Bon Appetite- New Patent and
Trademark strategies for protecting
Food and Beverages**

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GEARHART LAW

Bon Appetite- New Patent and Trademark Strategies for Protecting Food and Beverages

Celesq

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March 2020



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- Scenario 1

I have an innovative food product that involves a naturally occurring product with an innovative methodology. Can I get a patent?

Topics to Discuss:

- Food Scientist
- Studies
- Unexpected Results
- Transformation
- Naturally Occurring Products: Collagen, Algae, Fenugreek, Pumpkin Seeds etc.
- Searching/International Protection





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PTO PROCESS

PATENTABILITY REQUIREMENTS:

- **Novelty**
- **Obviousness**
- **Written Description Requirement**
- **Enablement Requirement**
- **Best Mode Requirement**





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IDEA VS. INVENTION

United States– Previously: FIRST TO INVENT COUNTRY (since 1790)

America Invents Act- September 16, 2011

- AS OF MARCH 16, 2013, FIRST INVENTOR TO FILE- the patent will go to whoever filed the application (or published) first.

DO YOU THINK THIS IS FAIR?

- NO MORE INTERFERENCE PROCEEDINGS
- BUT SMALL INVENTORS HAVE A ONE YEAR GRACE PERIOD AFTER A PUBLIC DISCLOSURE





- Scenario 2

Should I be pursuing Trade Secret or Patent Protection for my food or beverage?

Pros and Cons of TS

Strategies for TS



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TRADE SECRET

- Formula, practice, recipes, process, design, instrument, pattern, or compilation of information which is not generally known or reasonably ascertainable, by which a business can obtain an economic advantage over competitors or customers.
- **Secret Sauce; Confidential information, Classified information**

Advantages:

- not limited in time- Patent is limited to 20 years
- continues indefinitely as long as the secret is not revealed – Must disclose everything in a Patent to the public
- No registration costs
- Immediate effect- no formalities

IT'S YOUR CHOICE!



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- No patent for its formula
- Has protection for many more years than 20
- Refused to reveal its trade secret under at least two judges' orders
- No Protection if reverse engineered
- **FDA will keep your Trade Secret!**

The iconic Coca-Cola logo in its signature red script font.



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- Scenario 3

My food or beverage product may not be protectable under utility patent but do I have any sort of protection under Design?

Packaging, Shapes, thinking outside of the “box”



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- Scenario 4

Sophies Kitchen- sell Seafood Products but its not Seafood

- Goods/Services Identification
- Knockout/Preliminary Search
- Comprehensive Search
- Thoughtful analysis



Idea (Intent) vs. Use

- 15 U.S.C. (The Lanham Act)
- Use in Commerce
 - Transportation/Sale across state or federal borders
 - Product tags, labels, packaging, point-of-sale displays (including ecommerce sites)
 - Service advertising or marketing or shown in the course of providing the services
 - Common law (unregistered) trademarks
 - State trademark registrations
 - Federal trademark registrations





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**A mark should be
DISTINCTIVE**

**Less
Distinctive**

**More
Distinctive**



Generic

**Merely
Descriptive**

Suggestive / Arbitrary / Fanciful

Registrable

**COMMONLY USED
TERM FOR THE
CLASS OF
GOODS/SERVICES
IN CONNECTION
WITH WHICH IT IS
USED**

GENERIC





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- **Food and beverage victims of genericide:**
 - Shredded Wheat
 - Butterscotch
 - TV Dinner
 - Saltine
 - Broccolini

DESCRIPTIVE

**A MARK DESCRIBES A
CHARACTERISTIC OF
THE GOODS/SERVICES**

AQUA:



LEAK:



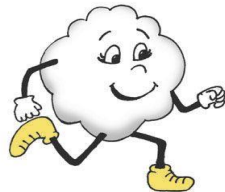
SUGGESTIVE

**INDICATES THE NATURE OR QUALITY OF
THE GOODS/SERVICES BUT DOES NOT
DESCRIBE THE CHARACTERISTICS
WITHOUT FURTHER THOUGHT**

...Is a bus an airplane?

No, but...

AIR:



BUS:





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ARBITRARY

**MEANING OF THE
WORD HAS NO
CONNECTION
WITH THE
RELATED
GOODS/SERVICES**





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FANCIFUL

INVENTED OR “FANCIFUL” SIGN

The term KODAK had no meaning before it was adopted and used in relation to the goods/services

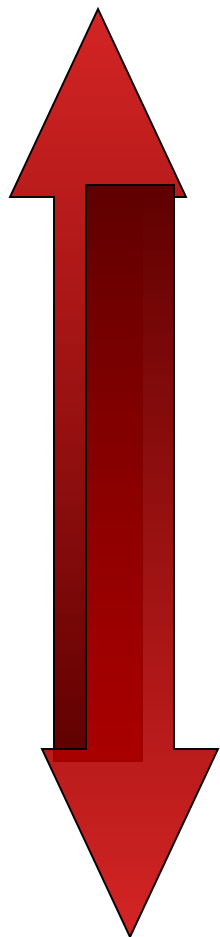




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Spectrum of Distinctiveness

Five categories



	Development Costs	Protection/ Enforcement Costs
Fanciful/Coined	\$\$\$\$	\$
Arbitrary	\$\$\$	\$\$
Suggestive	\$\$	\$\$\$
Descriptive	\$	\$\$\$\$
Generic	\$	\$\$\$\$\$



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- Deception:

“Applicant is advised that, if applicant’s response to the request for information indicates that the goods identified in the application are not or will not be made of _____, registration may be refused on the ground that the applied-for mark is deceptive.”



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- Scenario 5

My Client Sells an Edible with THC and CBD- can they get a TM?



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2018 farm bill

- On December 12, 2018, Congress passed the [2018 Farm Bill](#), which was signed into law by President Trump
- The 2018 Farm Bill defines hemp as the plant *Cannabis sativa L.* and any part of the plant with a delta-9 THC concentration of not more than 0.3 percent by dry weight. This definition is consistent with the definition of “industrial hemp” in the 2014 version bill, which created a limited agricultural pilot program regarding research into industrial hemp.
- The 2018 Farm Bill removes hemp from the Controlled Substances Act, paving the way for the wholly legal cultivation, possession, sale and distribution of the hemp plant.
- The 2018 Farm Bill delegates to states and Indian tribes the broad authority to regulate and limit the production and sale of hemp and hemp products within their borders. States and Indian tribes cannot, however, limit the transportation or shipment of hemp and hemp products through their respective jurisdictions.





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David Postolski, a partner at Gearhart Law, is a registered patent attorney and Intellectual Property attorney. With over 15 years' experience, David specializes in assisting inventors, creators, artists, start-ups, entrepreneurs, early stage companies and emerging companies with their U.S and International intellectual property strategy, protection, enforcement and monetization. David remains very involved in the creation of New York State's first federally approved patent pro bono program in conjunction with Volunteer Lawyers for the Arts. David is a frequent speaker and author on intellectual property issues surrounding raising capital, business formation, licensing, and reward and equity based crowd funding. David is also a Professor at Parsons School of Design where he teaches master level students about IP, ethics and other regulatory considerations in starting business ventures and products around design. David is the current chair of the Professional Issues Division of the ABA Section of Intellectual Property law as well as a member of the CLE Board, Sponsorship Board, and founder of the International Action Group. david@gearhartlaw.com

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