

# Sharing & Protecting Your Mobile Healthy Intellectual Property

mHealth 2016 Summer Training Institute at UCLA  
August 11, 2016

Katherine Fibiger, J.D.  
Senior Licensing Officer

UCLA Office of Intellectual Property & Industry Sponsored Research



## What is OIP-ISR?

- Identify Inventions and Research ready for collaboration
- File Patent Applications
- Market Technologies
- Execute Agreements
  - Confidentiality Agreements
  - Option / LOI Agreements
  - License Agreements
  - Sponsored Research Agreements
  - Material Transfer Agreements

## Mission Statement

**Supports UCLA's research, education & service mission by:**

- Educating the academic community about appropriate methods for protecting intellectual property;
- Accelerating the development of UCLA discoveries for the public good;
- Promoting economic growth in California; and
- Facilitating collaborations with industry for next-generation scientific breakthroughs.

## IP Issues in mhealth, apps

- Intellectual property considerations:
  - Patents, Trade secrets, Trademarks, Copyrights
- IP Ownership concerns:
  - Founder issues
  - Employee vs independent contractor; volunteers
  - Work-for-hire and Outsourcing agreements
- Regulations and Privacy concerns:
  - Endorsements Guidelines, COPPA, HIPAA, FDA

## Types of Intellectual Property

- Copyrights – protects expression and communication of ideas reduced to a tangible form
- Trademarks, Tradedress, Servicemark – protects identifying symbols, used in trade to indicate origin or distinguish products and services
- Patents – protects ideas, concepts, inventions, function, compositions of matter, and design
- Trade secrets – protects proprietary material which, if kept secret provides a commercial advantage to the owner
- Right of Publicity – protects an individual's image and name from being mis-appropriated

## Copyrights



- An app may contain multiple copyrights
- Copyrightable works include the following categories so beware of potentially infringing content:
  1. literary works (software);
  2. musical works, including any accompanying words
  3. dramatic works, including any accompanying music
  4. pantomimes and choreographic works
  5. pictorial, graphic, and sculptural works
  6. motion pictures and other audiovisual works
  7. sound recordings
  8. architectural works



## What are copyright rights?

- Copyright protects an app's source code, artwork, design, and text
- Right to Display, Distribute, Perform, Copy, and Adapt
- Copyright protection attaches once the work has been reduced to a tangible medium
  - ie Working software, completed creative works
- No longer necessary to file with copyright office but is still a good idea to file in certain circumstances
  - Establishes a public record of copyright and creates a legal presumption that developer is its owner and application is true if registered within 5 years of an apps release
  - Registration is *required* in order to sue for infringement
  - Statutory benefits to registration in litigation

## What is a Trademark?

- Trademark identifies the source or origin of goods or services. It distinguishes the goods or services from competitors.
- Name, word, symbol, slogan, logo design, device shape, color, domain name (potentially), smells or sound can all be trademarks.
- Trademarks are created either by usage (Common law TM <sup>TM</sup>) or by Federally registering you mark with the USPTO (<sup>®</sup>)
- Federally registered marks have an exclusive, nationwide right to use the mark



# MH2 – Mobile Health for Mental Health

The screenshot shows a web browser window displaying the USPTO TESS search results page. The browser address bar shows the URL: `tmsearch.uspto.gov/bin/showfield?f=doc&state=4810:ro1rnq.2.1`. The page header includes navigation links such as Home, Site Index, Search, FAQ, Glossary, Guides, Contacts, eBusiness, eBiz alerts, News, and Help. The main content area displays the search results for the trademark 'MH2 MOBILE HEALTH FOR MENTAL HEALTH'. The results table lists various details including Goods and Services, Standard Characters Claimed, Mark Drawing Code, Serial Number, Filing Date, Current Basis, Original Filing Basis, Published for Opposition, Registration Number, Registration Date, Owner, Attorney of Record, Disclaimer, Type of Mark, Register, and Live/Dead Indicator.

Trademark Electronic Search System (TESS)

TESS was last updated on Mon Aug 8 03:22:08 EDT 2016

TESS HOME NEW USER STRUCTURED FREE FORM SHOWS DICT SEARCH OIG BOTTOM HELP PREV LIST CURR LIST NEXT LIST FIRST DOC PREV DOC NEXT DOC LAST DOC

Logout Please logout when you are done to release system resources allocated for you.

Start List At:  OR Jump to record:  Record 1 out of 3

TSDR ASSIGN Status TTAB Status (Use the "Back" button of the Internet Browser to return to TESS)

## MH2 MOBILE HEALTH FOR MENTAL HEALTH

Word Mark	MH2 MOBILE HEALTH FOR MENTAL HEALTH
Goods and Services	IC 044. US 100 101. G & S: Mental health services. FIRST USE: 20130523. FIRST USE IN COMMERCE: 20141103
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Serial Number	85946860
Filing Date	May 30, 2013
Current Basis	1A
Original Filing Basis	1B
Published for Opposition	November 5, 2013
Registration Number	4700490
Registration Date	March 10, 2015
Owner	(REGISTRANT) The Regents of the University of California CORPORATION CALIFORNIA 12th Floor 1111 Franklin Street Oakland CALIFORNIA 94607
Attorney of Record	John P. O'Banion
Disclaimer	NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "MOBILE HEALTH FOR MENTAL HEALTH" APART FROM THE MARK AS SHOWN
Type of Mark	SERVICE MARK
Register	PRINCIPAL
Live/Dead Indicator	LIVE

TESS HOME NEW USER STRUCTURED FREE FORM SHOWS DICT SEARCH OIG TOP HELP PREV LIST CURR LIST NEXT LIST FIRST DOC PREV DOC NEXT DOC LAST DOC

HOME | SITE INDEX | SEARCH | eBUSINESS | HELP | PRIVACY POLICY

## How to obtain a strong mark

- Creative and Branding Process – how to pick a mark:
  - Fanciful or unique name vs descriptive name so that users can easily recognize the app’s functionality.
  - Distinctive name is entitled to the strongest trademark protection.
  - Do a trademark search
  - Have a trademark strategy as part of your branding
- Fanciful: Ajax, Exxon, Kodak, Tivo (made-up words)
- Arbitrary: Amazon, Apple computers (no relation)
- Suggestive, but not descriptive: Caress (soap)
- Descriptive: eBookReader (refused b/c merely descriptive)
- Generic: Soap – would be refused

## Patents

- Two types of patents potentially applicable to mobile apps
  - Design patents – issued based on the look and design of an item (Apple’s iphone and ipad patents) and lasts for 14 years. No functionality.
  - Utility patents – issued for the invention of a new and useful process, machine, manufacture, or composition of matter, or a new and useful improvement thereof – permits its owner to exclude others from making, using, or selling the invention for up to 20 years from the date of application filing. Hard to get these days...
- Patent granted in exchange for full disclosure of how to practice the invention – balance of public and private interests

## Patents

### U.S. Statutory Requirements for Patenting

- **Be Novel** (must have not existed before)
- **Be Useful** (must have practical use)
- **Be Non-obviousness** (must be inventive/ not obvious to the skilled worker in the field)
- **Be enabled and have adequate written description** (applicant must provide information to allow someone of “ordinary skill” to understand that the inventor possessed the claimed subject AND, separately, must teach one of ordinary skill in the art how to make and use the invention)
- **Be Statutory Subject Matter –**
  - **Can Patent:** *useful process, machine, manufacture, or composition of matter* (includes: recombinant bacteria, isolated natural compounds, an asexually produced plant )
  - **Cannot Patent:** another human, **laws of nature**, abstract ideas, impossible inventions (i.e. a perpetual motion machine), artistic works (may be copyright protect), data

*Patent laws are changing rapidly around software and method patents. Be sure to consult with a patent attorney if this is your strategy*

*Driving Innovation to Market.*

## Trade Secrets

- Information that is generally not known and is not discoverable, which, if kept secret, provides an economic advantage to the owner (customer lists, strategy docs, financials)
- Must take measures to protect trade secrets:
  - Security – Physical, cybersecurity
  - Corporate policies
  - NDA's
- Once the secret is out, its value evaporates
- Sometimes a better strategy than patenting if you have an algorithm

## Right of Publicity

- A person has the right to control the use and exploitation of their image and likeness
- Varies from state to state
- Be careful if you use someone's image or likeness in your app, website, marketing, or otherwise particularly if they are **not** famous
- **ALWAYS** ask the person for a release to use their image



## Other legal considerations

- Ownership:
  - Be sure founders/employees assign all IP to the company
  - All contractors you hire should do work as a **work for hire** and must sign their contracts before they start working
- Be aware of what you need to comply with – privacy laws, COPA (protection of children online); HIPAA (particularly important), Apple and Google agreements
- FDA regulation
- Open source software – incorporation of open source could force you to release the source code of your app (gpl) under some circumstances.
- Have a terms of service and a DMCA policy – consult a lawyer if you have questions, or review others from other sites

## FDA Regulation

- FDA recently lowered the regulatory bar for apps
  - General wellness and fitness and activity apps will not be examined
- 2 categories
  - Apps that aim to improve overall health w/o specific diseases mention (music for stress)
  - Apps that do mention specific diseases but that can be aided by lifestyle choices (UV app)
  - Non-invasive, not implantable, pose no risk to patients
- Still HAVE to protect data



The screenshot shows the website for the 2016 App Competition. At the top, there is a navigation bar with the UCLA logo, the 'CODE for the MISSION' logo, and a 'LOGIN' button. Below this is a 'Menu' section with three main items: 'TEAM UP WITH UCLA CHANCELLOR GENE BLOCK', '3RD ANNUAL 2016 App Competition', and 'UCLA Depression Grand Challenge Mental Health Category App or App Design'. The main content area is divided into three tracks: Track 1 Education (Inspiring Women in STEM), Track 2 Research (mHealth: Sensors, Wearables, Data Dashboards), and Track 3 Service (Promoting Community Engagement and Civil Discourse). A pink banner below the tracks says 'JOIN A TEAM TODAY!'. At the bottom, there is an 'IMPORTANT DATES' timeline with five key events: Early February Kickoff, April 4-8 Bootcamp week, July 5 Team registration EXTENDED, August 31 Final entries due, and September 15 Winners announced @ MMWCON.

Annual app contest – [codeforthemission.ucla.edu](https://codeforthemission.ucla.edu)

Congrats to Bonnie Zima – who won last year with MH2

## Things to watch out for in summary...

- Have a plan for how you are going to protect your app – patents are incompatible with trade secrets
- Beware of incorporating open source software that could require you to disclose your source code (gpl)
- Be sure your policies are complete and comply with usage terms and you have passed regulatory issues
- Protect your trade secrets
- Ensure that you own the app's assets – code, photos, art, slogans, marks, Founder's IP, contractor work
- Ensure that none of the IP you are putting into your app is infringing or violates privacy of anyone

Questions?

Thanks!!!

Katherine Fibiger  
Senior Copyright Officer  
310 794-0205  
[kfibiger@research.ucla.edu](mailto:kfibiger@research.ucla.edu)  
[www.oip.ucla.edu](http://www.oip.ucla.edu)