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PERSPECTIVE

Eyeing the intellectual property of wearable tech

By Rod S. Berman and Alexandra Jia

The 21st century has brought a new term to consumers and cadres of manufacturers and lawyers: wearable technology. But technology that is worn has been around for a long time — consider wristwatches and eyeglasses.

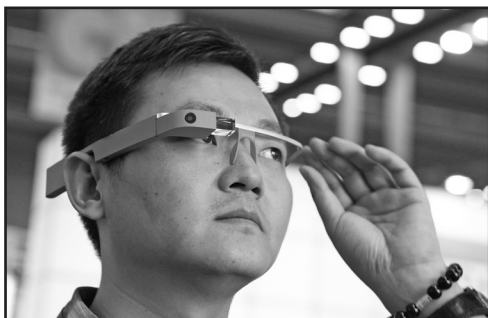
Today's wearables take many forms. One example is Google Glass, an Internet-connected wearable eyepiece that includes a screen to visualize images and voice activated technology. Glass has recently been used in surgery to allow surgeons to visualize information about the patient without having to stop watching the patient. Intel is said to be supplying the chip for a new version of Google Glass expected to launch next year. An accessory to Glass, SCOTTeVest, provides a battery pack in a vest pocket for convenient charging.

Wearables venture even further in the medical field (the Microsoft MS Health App with a smartwatch armed with 10 sensors and biometric monitoring devices with light guides embedded in earbuds for accurate optical monitoring of biometric information); the sports field (bike sensors for body position and motion analysis and Nike GPS watches that act like personal trainers); and police fields (cameras worn by police for enhancing situational awareness and bettering real time decision-making).

Intellectual property strategies for wearables encompass approaching the devices from all sides: considering IP inside and outside for each component, method step, functionality, appearance and content. Those interested in protecting wearable IP rights must consider patents (utility and design), copyrights, trade dress, trademarks and trade secrets. Given the speed the wearable landscape is maturing and expanding, one should consider expedited IP filings, as well as varied scopes of IP protection available in different territorialities under different treaties.

Patents offer the best way to fend off competitive functional technology and to develop market share because patents provide the right to exclude others from making, selling, using and importing devices with technology that infringe the patent's claims. A Google patent application titled "Wearable Device with Input and Output Structures" discloses and claims the Glass system — the display, frames, image projection and capture, wireless connection and related sensors. Likewise, Lenovo filed a patent application titled "Electronic Device and Sound Capturing Method" for a head-mounted wearable intended to directly compete with Glass.

Components such as software, sensors, actuators, materials, interfaces, controls, methods, kits, mechanical components, fabrics, stability, placement



Associated Press
A man tries out Reed Glass, a Google Glass-like wearable device manufactured in China, on Nov. 29.

and improved batteries are all candidates for a patent portfolio guarding wearable technology.

If the technology can be kept secret, consider trade secret protection; however, given modern skills of reverse engineering, trade secret protection other than for some magical details of materials used to make the device (e.g., a polymer or alloy), is not likely to adequately protect investment in developing the technology.

A wearable technology IP portfolio should be comprehensive, but must be selective depending upon the novelty of the wearable device, the cost of obtaining the protection, how soon protection is sought and in what geographic regions. One must be mindful of different patent statutory requirements, the requirements of patent notices, deadlines for patent filings and statutory methods to speed up patent issuance, as well as the different scopes of IP protection afforded in different countries and the terms of such forms of protection.

The question in litigation is whether rights for wearables are meant as a competitive tool or a revenue driver. In *Adidas AG v. Under Armour Inc.* and *MapMyFitness Inc.*, 14-00130 (D. Del., filed Feb. 4, 2014), Adidas sued Under Armour and its wholly owned subsidiary MapMyFitness for infringement of patents related to "performance monitoring" apparatus, methods and systems. The accused products are training devices and services offering real time audible coaching and web applications to assist people to optimize their workout sessions in form of detecting, evaluating, analyzing body movements, and providing performance information.

Trademarks, logos and taglines also must be considered when developing a brand of wearables. In the U.S., many forms of trademarks are statutorily protectable — color, shape, scent, touch, sound, motion — and some are unregistered "common law" trademarks. However, in many foreign countries they are not, so alternative forms of protection must be sought. Trademarks must be properly used so

they do not become generic. Google has established extensive branding guidelines for using what otherwise might be a fairly descriptive term, "Glass." Branding guidelines typically set forth how a trademark should be used in text, how to tag content using a term, and what are the correct and incorrect ways of referring to a trademark.

When launching a new wearable, it is critical to assess the availability of the brand by conducting trademark clearance searches in every territory where the wearable is to be sold, made and distributed. Such a search might have made a difference in a lawsuit brought by the makers of the "Fitbug" — a "health coaching device" in production since 2005 — against the makers of now-popular "Fitbit."

Trade dress, such as the shape of a Coca-Cola bottle, is also important for wearables. Trade dress may protect key nonfunctional features of the wearable's appearance, its configuration, packaging, and so on. The wearable's trade dress may be subject to trademark registration if the trade dress is not functional and is distinctive, for example by marketing the wearable with advertisements that engage the consumer to "look for" a wearable that has a particular look.

Wearables also give rise to design patent concerns as they become more fashionable. Design patents are less expensive to obtain than utility patents. A design patent may also be a good alternative for trade dress, because design patents do not require proof of distinctiveness. Apple reportedly hired Paul Deneve from Yves Saint Laurent to design ergonomic concepts coupled with functionality. Taking advantage of design patents, Google has obtained one for a sleeker Glass device.

A wearable device provider must also be cognizant of copyright issues related to any media used with the device and written instructions on how to operate the device. Because of the ubiquity and ease of use in the recording capabilities of wearables, the Motion Picture Association of America and the National Association of Theatre Owners recently announced a "zero-tolerance" policy towards "using any recording device while movies are being shown," stating that "all phones must be silenced and other recording devices, including wearable devices, must be turned off and put away at show time."

Wearable devices present countless IP issues and demand the attention of in-house and outside counsel familiar with the panoply of IP laws, both domestically and worldwide.

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