

PEARL COHEN

# Back to Basics- היבטים פרקטיים בקניין רוחני

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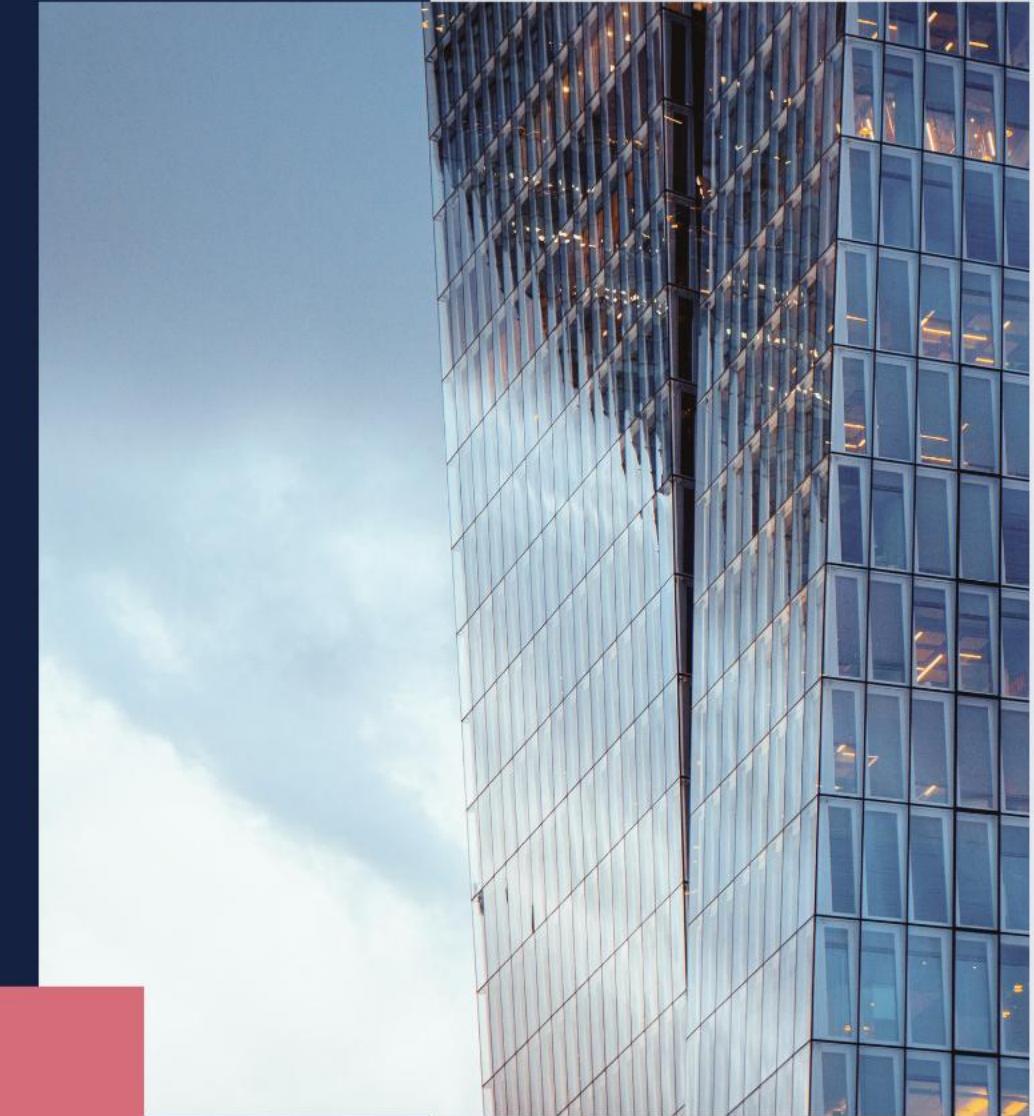
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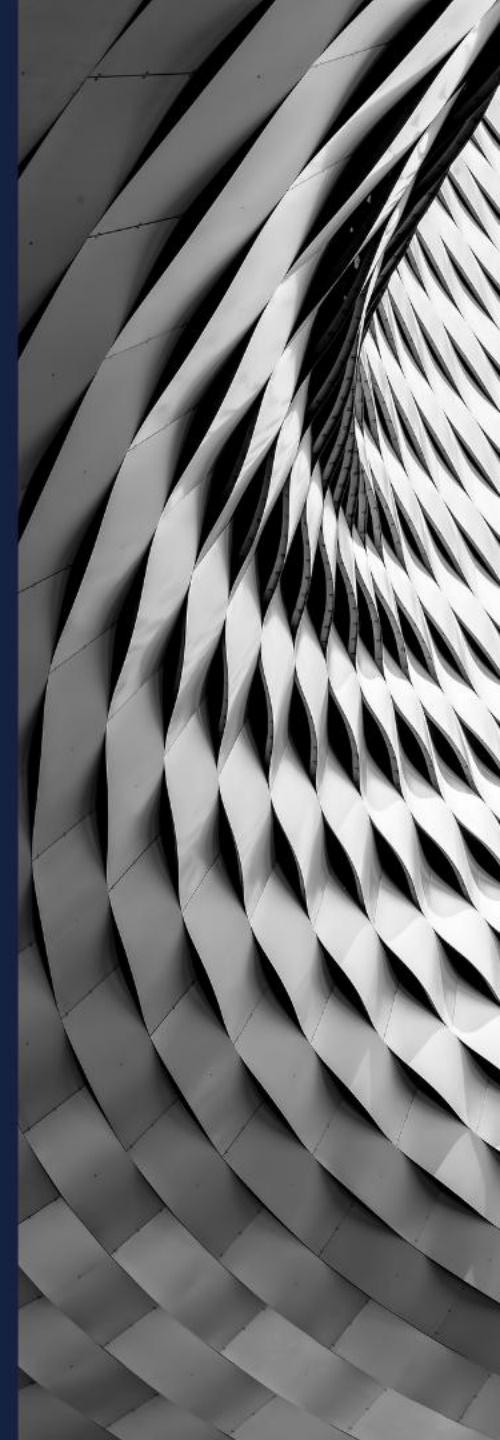
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## Contents

- IP protection in your entities – roles and responsibilities
- What is Intellectual Property?
- Key Questions in IP Due Diligence
  - Freedom To Operate
  - IP ownership
  - Inventorship
- IP indemnification
- Litigation threats (C&D Letters)



## IP protection in your entities – roles and responsibilities

### A typical day of an IP manager

- The internal interfaces of an IP manager
  - Inventors and R&D
  - Corp. Strategy
  - Legal
  - Finance
  - Employment
- Roles
  - Different approaches: hands-on vs. portfolio management
  - Budget and deadlines
  - Healthy processes and pipeline
  - Quality assurance

### What's expected from an IP manager?

- Not only patents...
- Not only IP...
- Experts wanted!

## What's in our tool bag?



## Build an Integrated IP Strategy

Consider the relevant IPR's

Develop a plan and tailor it to our capabilities

What is developed/created? What's the business plan?

We start with options and recommendations

What types of IPRs can be considered? How to fit the IP protection with the business plan?

Priorities and available resources (inventors' availability, budget)

Where should the IPR's be protected??

## IP Strategy: Basic Foundations

### Patents, copyrights or trade secrets?

- Protecting know-how that cannot be patented or cannot be discovered (e.g., manufacturing processes, etc.) with trade secrets
- Undiscoverable inventions – to patent or not?
- In some cases, copyright protection is the only feasible protection

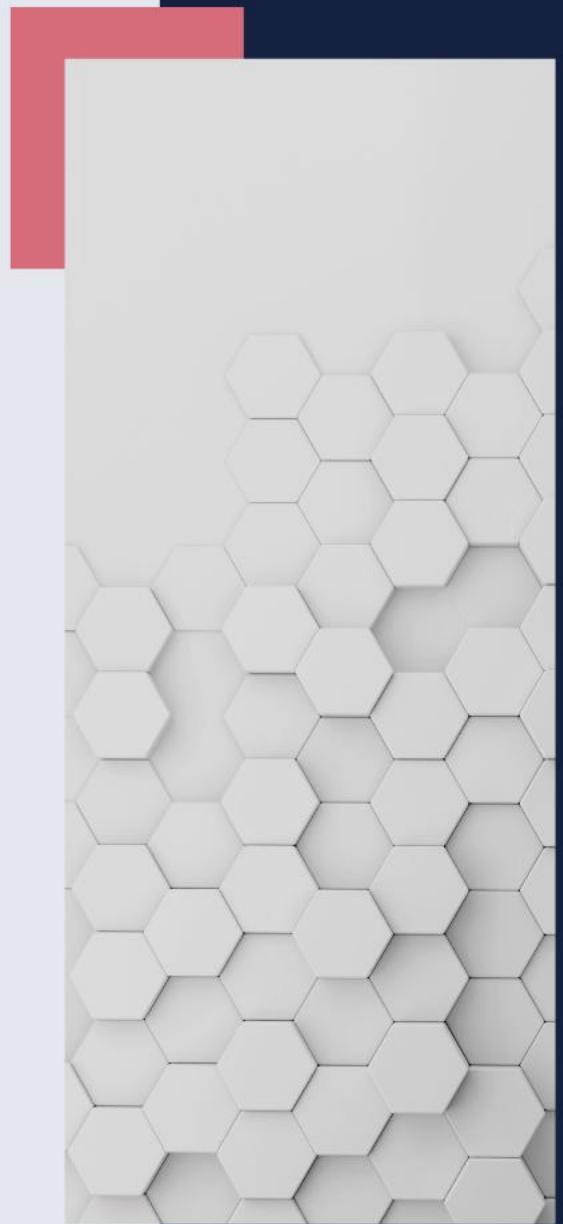
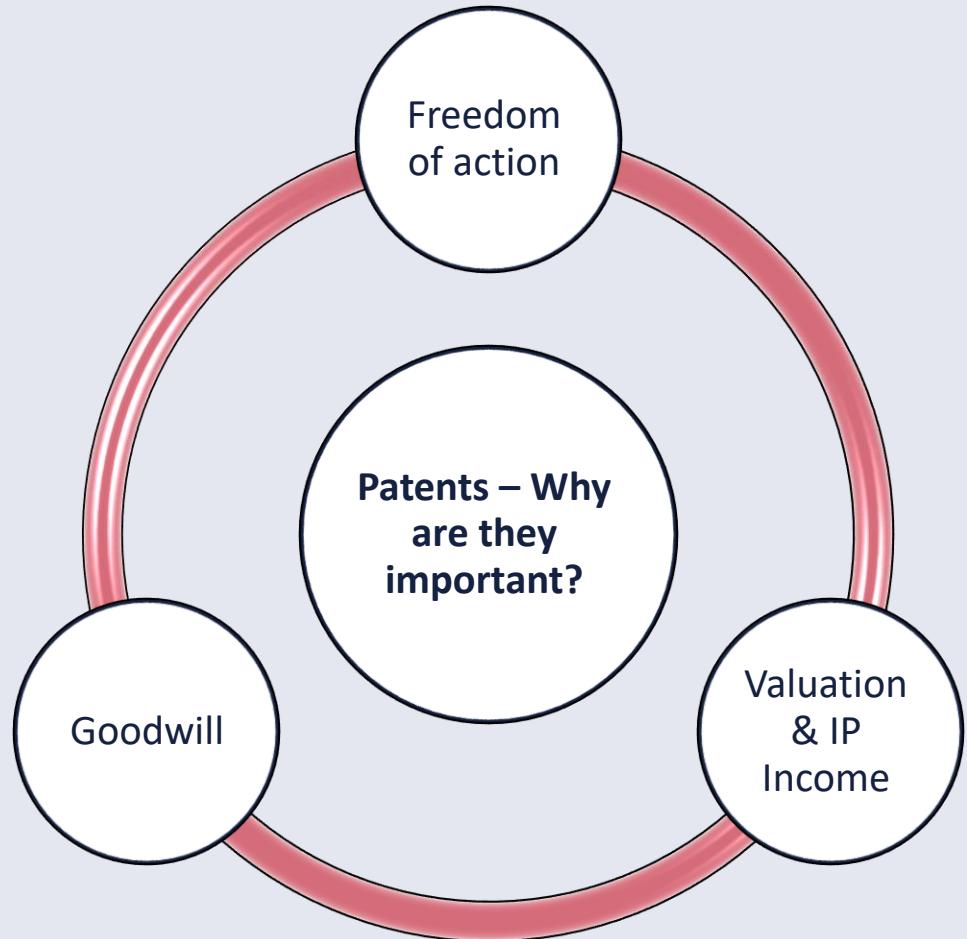
### Costs of protection - patents

- Initial costs for building the fence and the ammunition
  - Internal resource allocation
  - Budget allocation
- Enforcement costs, i.e., patent litigation, are significant

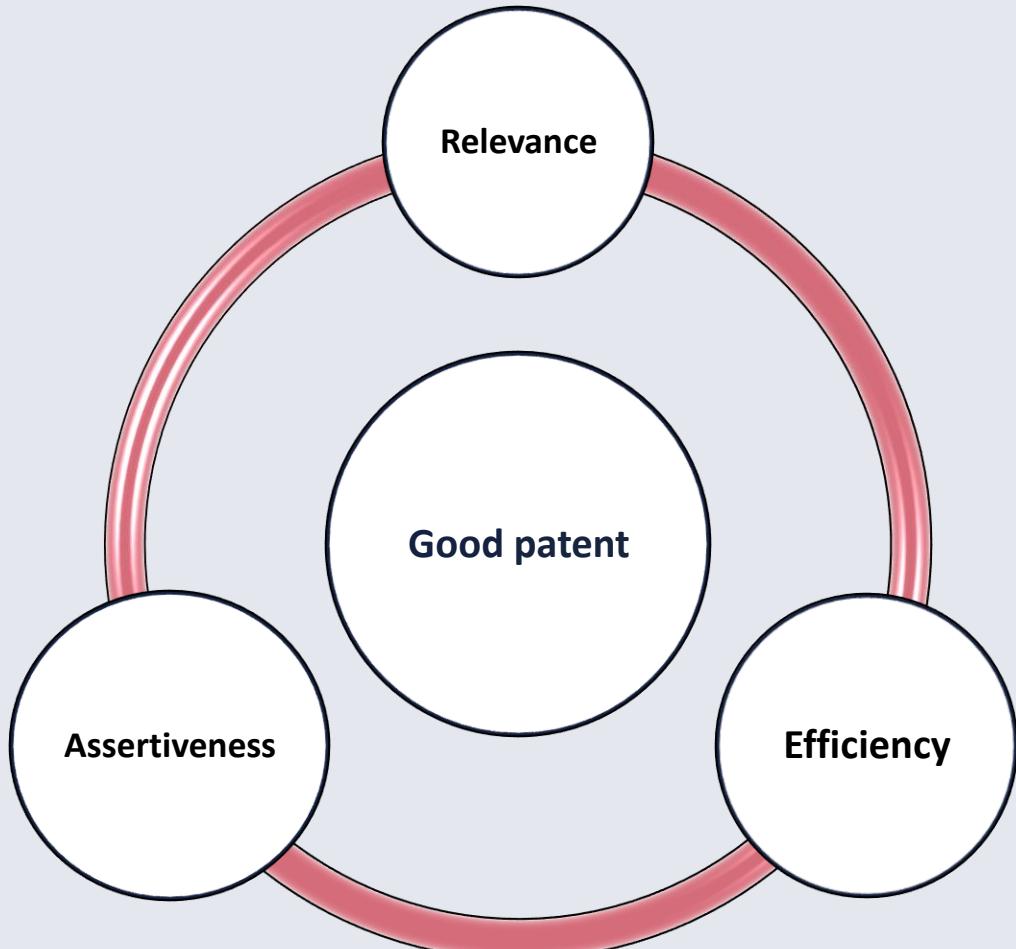
### Where should we file patents?

- Where is the \$\$\$? What are the key markets?
- Where are my competitors?
- Where are the manufacturers?
- Where are my key employees? R&D sites?

## Patents – Why are they important?



## Patents – What is a GOOD patent?



## Patents – Additional Points to Consider

### How can we assess if we will get the patent?

- Will the patent application be allowed?
- Breadth of the claims?
- Overall required budget?

### Timing – when should we file the application?

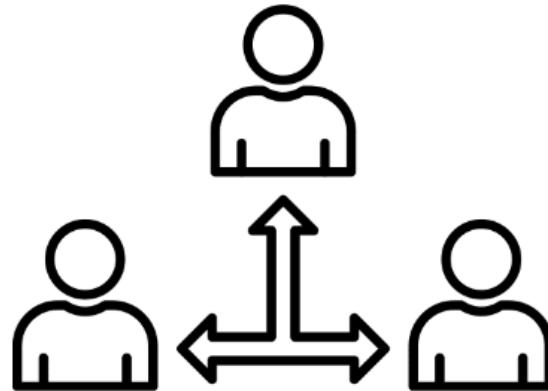
- As rule of thumb – the sooner the better:
- Before the competition
- Less prior art publications
  
- But sometimes it is better to wait:
- The invention will be more mature
- The 20 years protection will start at a later stage
- We will know more about the technology, the market, and the competition
- Postponing costs

## Key questions in IP Due Diligence

### Your IP



### 3<sup>rd</sup> Party IP



# IP Ownership and Inventorship

## Your IP



### Core Concepts of IP Ownership

- Default legal rules: employees and contractors don't automatically assign IP
- Assignment agreements: importance of clear "hereby assigns" language
- Jurisdictional differences and the limitations of "work made for hire"

### Managing Ownership Risks

- Joint ownership: legal risks and need for clear agreements
- M&A: verify chain of title and record assignments
- Open source and third-party IP: avoid contamination

### Trade Secrets and Confidential Information

- Implement NDAs, access control, and employee exit protocols
- Educate teams on public vs. proprietary data

# Your IP



## IP Ownership and Inventorship

### Inventorship Essentials

- Inventor = person who contributed to claim conception
- Not the same as authorship or contribution to execution
- Legal requirement to list correct inventors
- **Case Highlight:** In *HIP, Inc. v. Hormel Foods* (2023), the Federal Circuit ruled that suggesting a general idea (infrared preheating) wasn't enough for inventorship—reaffirming that inventorship hinges on specific, claim-level contributions.

### Inventorship in Practice

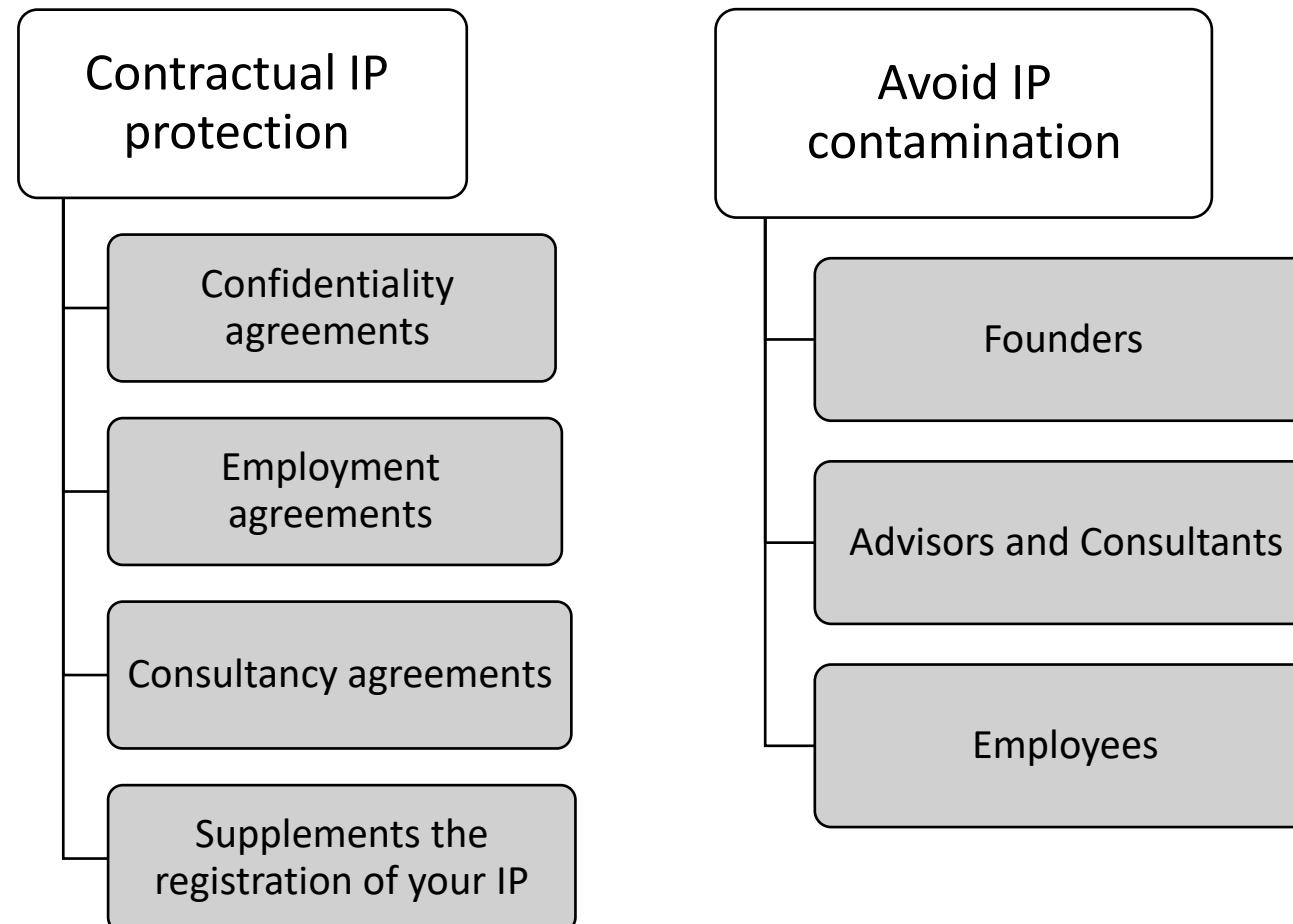
- Determine inventorship with IP counsel
- Use invention disclosures, interviews, and documentation
- Align incentive programs with inventorship standards
- **Cautionary Tale:** The ongoing *DABUS AI litigation* (2023–2026) illustrates the global insistence that only natural persons may be inventors, highlighting the importance of documenting human contributions, even with AI-assisted innovation.

### Recommendations and Best Practices

- Audit agreements, track assignments, maintain records
- Educate R&D and legal teams on inventorship and ownership
- Partner early with IP counsel; prevention is cheaper than correction

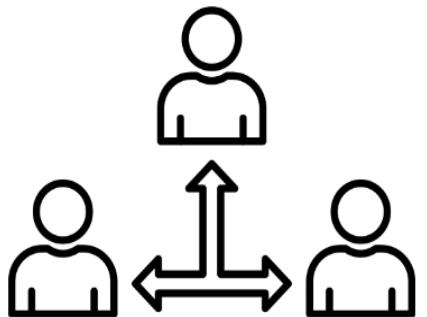
## IP Protection

# Your IP



## Freedom to Operate (FTO)

### 3<sup>rd</sup> Party



#### Tensions of FTO

- The risk of treble damages

#### Search yourself...

- Competitors
- Similar solutions

#### Phases of FTO

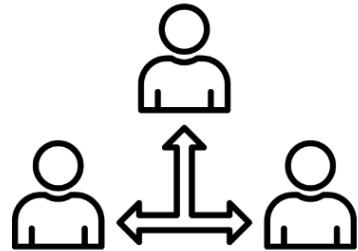
- Define the boundaries of the FTO
- Search
- Analysis and preparation of the FTO report
- Non-infringement / invalidity / design around

## IP Indemnification

Your IP



3<sup>rd</sup> Party IP



### Indemnitors (those subject to Indemnification Obligations)

- Risk of high-cost IP litigation and third-party claims
- Need to negotiate liability caps, exclusions, and control over defense strategy
- Push for precise indemnity scope (e.g., exclude use outside intended purpose)

### Indemnitees (those receiving the indemnification)

- Indemnity offers protection from infringement liability
- Expect comprehensive coverage for third-party claims, including legal fees
- Ensure clarity on process: notice, cooperation, and remedy expectations

### Recommendations

- Clearly define scope, triggers, and procedures
- Balance obligations with actual risk exposure and control
- Regularly revisit terms to align with evolving products and legal landscape

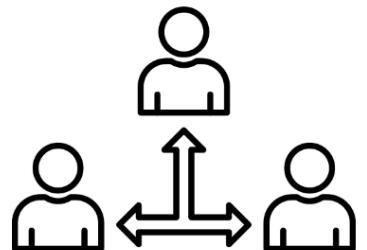
## Negotiating IP Indemnification – Key Considerations

### Your IP



- **Scope of Indemnity:** Clearly define covered IP rights and types of claims
- **Trigger Events:** Specify when indemnity applies (e.g., third-party claims, final judgments)
- **Remedies:** Include repair, replace, license, or refund options
- **Defense and Control:** Determine who controls the defense and settlement decisions

### 3<sup>rd</sup> Party IP

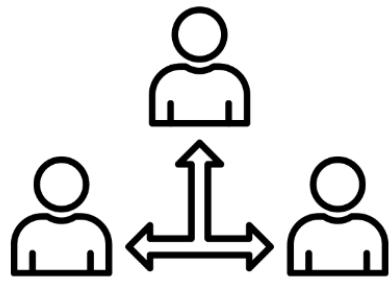


- **Exclusions:** Watch for exclusions around misuse, modifications, or combinations
- **Liability Limits:** Negotiate caps and aggregate limits appropriate to risk profile
- **Survival and Duration:** Define how long indemnity obligations persist post-contract



## Litigation threats and Cease and Desist Letters

### 3<sup>rd</sup> Party IP



- **Don't Ignore It:** Timely review is essential to manage exposure
  - **No Premature Responses:** Avoid admissions; acknowledge receipt if needed
- **Assess Credibility:** Evaluate sender's history, enforceability of IP, and litigation risk
- **Risk Evaluation:** Assess potential financial, reputational, and operational impact
- **Preserve Evidence:** Implement litigation hold if threat is credible
- **Engage Counsel Early:** Especially where risk of litigation or forum shopping exists
- **Check Existing Contracts:** Look for indemnification, licensing, or forum selection clauses
- **Strategic Options:** Consider licensing, redesigns, or business resolutions
- **Centralize Threat Tracking:** Maintain repository for C&D letters and responses
- **Develop Internal Playbooks:** Create templates and escalation protocols with counsel

# ABOUT US



Clients value excellence and innovation as much as entrepreneurship. Pearl Cohen embodies all. An international law firm with offices in the United States, Israel, and the United Kingdom, Pearl Cohen's priority is to provide excellent and innovative legal advice with maximum commercial impact.

For decades, our commitment to excellence, innovation, and technology has earned the confidence of innovation-driven enterprises, including Fortune 500 and small-cap emerging companies, start-ups and entrepreneurs, individual investors, academic institutions, and government-related entities.



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# AWARDS AND RECOGNITION

Clients value our "constant availability, guidance, and patience, ensuring their business needs are in the spotlight" (Chambers and Partners Global).

Clients are also reassured by our "comprehensive approach to doing business across multiple industries and deep understanding of the commercial, regulatory, and technical challenges they face". As such, they trust our ability to provide them with "integrated legal advice in commercial law, litigation, and intellectual property, covering the US, and Israel, together with aspects of European and Eurasian law" (Legal 500).



For 20 years, Yoav has been advising clients on various Intellectual Property matters, such as strategic patent portfolio development and management, patents monetization, IP due diligence for M&A deals, Standard Essential Patents (SEP's), and more.

His work includes managing and developing large patent portfolios, advising on patent strategies and monetization, conducting IP due diligence for M&A deals, counseling on Standard Essential Patents (SEP's), and more. He has been involved in IP due diligence matters on behalf of clients in both the buying and investing side, advising clients who were subject to the due diligence, patent litigations in Israel and in the US, negotiations and litigations of SEP's, and in strategic development and scaling of the patent portfolios of his clients, as well as of internal procedures for them to foster innovation.

Prior to joining Pearl Cohen, Yoav was in senior in-house positions, such as Head of IP at Amdocs and a patent attorney at the IP Law department of IBM in Israel and in the US. Under Yoav's leadership as Head of IP, Amdocs was listed among the top 1000 US assignees and won a post-Alice favorable decision with the Federal Circuit on patent eligibility (one of the first post-Alice favorable decisions to owners of software-implemented patents).

Yoav's clients range from entrepreneurs and startups to Fortune 500 companies. He represents global corporations, mid-size and private companies, as well as startups in diverse areas, ranging from telecommunications, IOT, AI, software and hardware chip design and processing, cyber, automotive, digital health and medical devices, agro-tech, and more.



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# THANK YOU

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