

OVERVIEW OF INTELLECTUAL PROPERTY

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Intellectual Property The Big Four

- Patents
- Copyrights
- Trademarks
- Trade Secrets

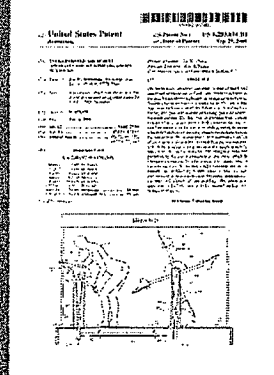
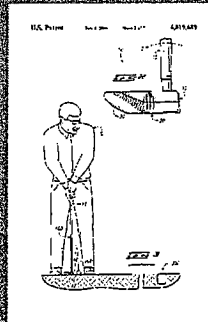
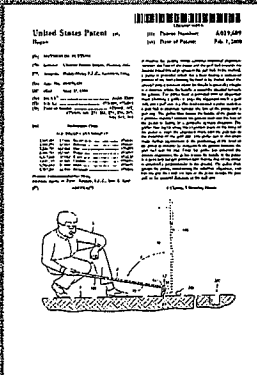
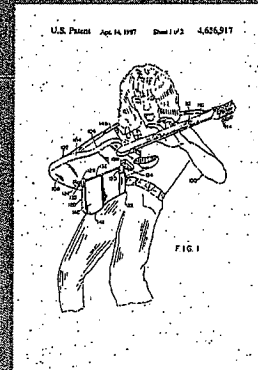
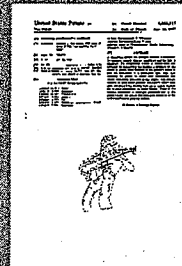
What is patentable?

“Anything under the sun” that is
made or done by human beings.

Diamond v. Chakrabarty, 447 U.S. 303 (1980)

Excludes laws of nature, natural
phenomena, and abstract ideas

U.S. Patent No. 4,656,917
to Edward Eddie
Van Halch



USER-OPERATED AMUSEMENT
APPARATUS FOR KICKING THE USER'S
BUTTOCKS

Love Patent

Computer dating firm secures lock on matchmaking process

May 28, 2004 SAN JOSE, Calif. (AP) — Chemists, biologists, psychologists and statisticians best determine whether two people will have a happy marriage. At least so claims an online dating service that patented its matchmaking formula.

eHarmony.com Inc. this month received U.S. Patent No. 6,733,368 which describes a "method and system for identifying people who are likely to have a successful relationship." Not surprisingly, critics and commentators trash eHarmony's process as overly scientific, some dismissing the so-called "love patent" as gimmicky.

State Street Bank and Trust Company v. Signature Financial Group, Inc. 149 F.3d 1368 (Fed. Cir. 1998).

CLAIMS

1. A method for determining a credit score for a borrower, comprising:

a) receiving a request for a credit score;

b) determining a credit score for the borrower based on a set of credit factors;

c) outputting the credit score to the requester.

U.S. Patent No. 5,193,056

State Street Bank v. Signature Financial Group

FIG. 1

Internet Patents

- Amazon.com (one-click purchasing): U.S. Patent No. 5,960,411
- Priceline.com (on-line reverse auction system): U.S. Patent No. 5,794,207
- eBay.com (on-line auctioning driven by users): U.S. Patent No. 6,058,417
- CyberGold, Inc. (payment to users in exchange for viewing on-line ads): U.S. Patent No. 5,794,210
- **USPTO granted 1600 Internet-related patents in 1998. 9 were granted in 1997.**

Bilski v. Kappos 561 US ___ - Supreme Court 2010



One-year clock v. Absolute novelty

- After a public disclosure, you have one year to file a patent application in the United States
- However, rights elsewhere in the world are compromised or irrevocably lost.

NDAs: Impact on Patent and Trade Secret Rights

- Prevents one-year patent clock from starting
- Maintains confidentiality ("integrity") of a trade secret.

Common provisions of NDAs

- Receiving Party agrees to safeguard and hold in confidence all of the Confidential Information and to neither directly nor indirectly disclose nor use the same, other than for the purpose for which such disclosure is being made per this agreement.
- Receiving Party agrees to safeguard the Confidential Information with the same degree of care it uses to protect its own confidential information.

Common provisions of NDAs

- Receiving Party shall take all reasonable measures including, but not limited to, court proceeding, at their own expense, to restrain their employees or former employees from unauthorized disclosure or use of the Confidential Information.
- All of the Confidential Information disclosed, delivered to, or acquired by Receiving Party from Disclosing Party, and all inventions and developments which arise therefrom, shall be and remain the sole property of Disclosing Party.

First-to-invent vs. first-to-file

- All other countries have first-to-file rules.
- Only the U.S. honors the first to invent.
- Invention consists of conception of the idea and then working to reduce the idea to practice.
- Have clients document the R&D process in case they have to substantiate an earlier date for the invention than a competitor.

Obtaining Rights

- Patents:
 - Inventors are the original owners of an invention
 - Assignments and recordation at the USPTO
 - Employment agreements
- Copyright:
 - work for hire
 - Employees v. contractors

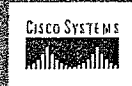
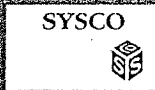
Trademarks Federal Registration

- What can serve as a trademark?
 - TM, v. ©
- Prevent others from using a confusingly similar mark

Trademarks

Rights Granted

- Does not necessarily prevent use of a similar mark on an unrelated product or service



Trade Secrets

- Any information, data, and know-how which is not public knowledge in the relevant industry and which gives a business a competitive advantage
- Must be incapable of reverse engineering

Trade Secrets

When Protection Granted

- Information is secret
- Steps are taken to protect secrecy
 - Information marked "CONFIDENTIAL"
 - Information segregated
 - Access to information on "need to know" basis

Thank You

Questions???