


Intellectual Property – The Basics

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
Trademarks [®]



Trademark

- A “source identifier” – a word, symbol, or device that identifies the origin of products or services
- Can include:
 - Colors, shapes, sounds, smells – or combinations of these elements

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Service Mark

- Same as a trademark; used to identify and distinguish services instead of products

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Trade Name

- Name of company or business
- May also be used as trademarks or service marks

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Trade Dress

- Product packaging or labeling that acts as a “source identifier”
- Can be the shape, texture, and color of a product, or...
- The consistent look and feel of services

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Obtaining Trademark Rights

- Use, without registration
- Registration

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Advantages of Registering a Trademark

- A registration is *prima facie* evidence that:
 - The mark is valid
 - The registrant is the owner
 - There is an exclusive right to use the mark

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Advantages of Registering a Trademark (cont.)

- Registration “reserves” United States for expanded use of the mark
- Allows claim to “incontestable” rights to mark
- Right to list your mark with U.S. Customs to bar importation of infringing products
- Included in records searched by someone considering a new mark

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Trademark Categories

- Arbitrary or Made-Up
- Suggestive
- Descriptive
- Generic

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Arbitrary or Made-Up

- Strongest most protectable marks
- Bears no relationship to and doesn't describe the goods or services
- Examples: *APPLE®* for computers; *CAMEL®* for cigarettes; *EXXON®* for gasoline

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Suggestive

- Suggests – but doesn't describe – something about the goods or services
- Strong marks
- Examples: *LONDON FOG®* or *DRIZZLE* for raincoats

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Descriptive

- Directly conveys information about the nature, characteristics or intended customers of the products or services
- Typically not protected as marks
- Example: *CRUNCHY* for peanuts

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Generic

- Common category name of product or service
- Not protected as marks
- Examples: *ASPRIN*, *SORBET*

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Federal Trademark Registration on the Principal Register

- File an application in the U.S. Patent and Trademark Office (USPTO) based on:
 - Use of your mark in commerce in the U.S.
 - Your bona fide intent to use the mark
 - A foreign registration or application

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Federal Trademark Registration on the Principal Register (cont.)

- Your registration will issue if:
 - No opposition is filed (or if filed, won)
 - Proof of use has been accepted

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Registration on Supplemental Register

- Can apply for this type of registration if mark is:
 - Descriptive
 - Is in use, and...
 - Capable of acquiring distinctiveness
- Registrations on this register *do not* enjoy all the advantages of the Principal Register, but may be eligible for the Principal Register upon proof of acquired distinctiveness

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How Long Does Registration Last?

- 10 years (15 U.S.C. § 1058)
- Renewable for additional ten-year terms if proven that the mark is still in use
- Make certain necessary filings with the USPTO

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Difference Between ®, ™, ℠

- ® means mark is registered with the USPTO
- ™ & ℠ often used with marks not registered with the USPTO
- Highlight owner's claim of exclusive rights

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Mark Ownership

- Belongs to the party/person controlling nature and extent of the mark's use
- Corporate parents can own and register marks used by subsidiaries or other corporate parties, as long as the "related party" using the mark is controlled by the owner/registrant

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Mark Ownership (cont.)

- Licensor remains the owner of the mark, as long as licensor adequately monitors and maintains control over the quality of the products or services the mark is used for
- Manufacturer, rather than distributor, is presumed to be the owner of a mark used by both in connection with the same products, unless they have agreed otherwise

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Licensing & Selling

- Marks can be sold or licensed
- Marks in use must be sold or transferred with their goodwill, or they may be deemed to be abandoned
- Must maintain control over quality of products or services using licensed mark

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Mark Infringement

- Based upon the same or similar mark being used so as to confuse consumers/purchasers about the product or service origins, or whether there is an affiliation between owner and alleged infringer

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Typical Infringement Factors

- Similarity of the marks in:
 - Appearance
 - Sound
 - Meaning
 - Commercial impression
 - Relatedness of the products or services
- Similarity of the prospective purchasers, marketing methods and channels of trade
- Whether or not actual confusion has occurred

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Useful Trademark Links

- The United States Patent and Trademark Office:
<http://www.uspto.gov>
- Trademark Trial and Appeal Board:
<http://www.uspto.gov/web/offices/dcom/ttab>
- USPTO Trademark Applications and Registrations Retrieval (TARR): <http://tarr.uspto.gov/>
- USPTO Trademark Electronic Search System (TESS):
<http://www.uspto.gov/main/trademarks.htm>
- The Lanham Act:
<http://www.law.cornell.edu/topics/trademark.html>
- World Intellectual Property Organization:
<http://www.wipo.org>
- International Trademark Association (INTA):
<http://www.inta.org>

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Copyright Protection

- 17 U.S.C. § 101 et seq. based on the Copyright Clause of the United States Constitution
- Protects “original works of authorship” fixed in a “tangible medium of expression”
- Federal statutory copyright protection attaches to a work the moment it attains tangible form


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A Copyright ...

- Creates an exclusive right to:
 - Reproduce a work
 - Create adaptations of a work (“derivative works”)
 - Distribute copies of a work
 - Publicly perform a work
 - Publicly display a work
 - Digitally perform sound recordings


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Subject Matter of Copyright, 17 U.S.C. § 102(a)

- Literary works
- Musical works, including accompanying words
- Dramatic works, including any accompanying music
- Pantomimes and choreographic works
- Pictorial, graphic, and sculptural works
- Motion pictures and other audiovisual works
- Sound recordings
- Architectural works

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Exceptions to Copyright Protection, 17 U.S.C. § 102(b)

- In no case does copyright protection for an original work of authorship extend to any:
 - Idea
 - Procedure
 - Process
 - System
 - Method of operation
 - Concept
 - Principle, or
 - Discovery,
- Regardless of the form in which it is described, explained, illustrated, or embodied in such work

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Registering Copyright with the Copyright Office of the Library of Congress Provides Specific Enforceable Rights

- Right to file suit for infringement
- Right to recover your attorney's fees from infringer
- Right to recover statutory damages of \$750 to \$30,000
- Up to \$150,000 per infringement for "willful" infringement

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Registering a Copyright

- Registration may involve complex issues such as:
 - Which version of a work is being registered,
 - What form the required sample copies should be in,
 - Whether previous registrations exist, and
 - Whether the written agreements underlying the registration are correctly drafted and executed according to the requirements of the Copyright Act.
- Requires an official application and a fee of \$45.00 beginning July 1, 2006

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Use of © Copyright Symbol

- Requirement of a copyright notice was abolished on March 1, 1989
- But still advantages for using the notice

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Elements of Copyright Notice

- Visually Perceptible Copies:
 - Symbol © , or the word "Copyright," and
 - Year of first publication of the work, and
 - The name of the owner of copyright
- Published sound recordings:
 - Symbol ℗, and
 - Year of first publication, and
 - The name of the owner of copyright

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Copyright Length

- Current duration of copyright protection is the life of the author plus 70 years
- Exceptions for work for hire and works created before 1978

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Copyright Ownership, 17 U.S.C. 106A

- Person who creates a work
- Only exception is works made for hire, which are defined as:
 - Works created by employees within scope of employment
 - Works created by agreement with independent contractor who agreed in writing to work made for hire
 - Remember, calling a work a "work for hire" does not make it one

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Termination Rights

- Copyright law acknowledges that it is often difficult to predict which creative works will turn out to have long-term commercial potential
- Copyright law has built into it the right for an author to reclaim his/her copyright, even after sale, called a "termination right"
- Termination rights differ for works created before or after 1978

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Fair Use

- Exception to needing permission to use copyrighted work
- Factors to consider for assessing fair use
 - Nature and character of the use
 - Nature of the copyrighted work
 - Amount and substantiality of the copying
 - Effect of the use on the market for the underlying work

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Limited Situations Under Copyright Act

- For purposes of:
 - Criticism,
 - Comment,
 - News reporting,
 - Teaching,
 - Scholarship,
 - Research
- Certain reproductions by libraries and archives
- Certain performances and displays

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How does copyright work with trademark and patent protection?

- Trademark and unfair competition laws protect your commercial identity as a uniquely identifiable source of goods and/or services, and may protect the unique trade dress of your products
- Copyrights protect any tangible expression created by you or your company

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Copyrights in the Digital Era

- Digital Millennium Copyright Act provides new protections for digital uses of copyright, including protection for digital security measures designed to prevent unlicensed uses of digitized works

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Enforcement of Copyrights

- Monitoring for infringing uses
- Monitoring of royalty and license agreements and payments due
- Cease and desist letters
- Civil litigation in federal court seeking actual and statutory damages
- Criminal prosecution where applicable under federal law

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Useful Copyright Links

- The United States Copyright Office:
<http://www.copyright.gov>
- Fee Changes Effective July 1, 2006 from U.S. Copyright Office:
<http://www.copyright.gov/reports/fees2006.html>
- The Copyright Society of the U.S.A.: <http://www.csusa.org>
- The Copyright Act:
<http://www.law.cornell.edu/topics/copyright.html>
- The Copyright Clearance Center: <http://www.copyright.com>
- The World Intellectual Property Organization:
<http://www.wipo.org>
- United States Senate Committee on the Judiciary:
<http://judiciary.senate.gov>
- United States House of Representatives Committee on the Judiciary: <http://www.house.gov/judiciary>

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Trade Secrets



What is a trade secret?

- A type of intellectual property protected by law
- It can be virtually anything, provided:
 - It gives you an advantage over competitors who do not know or use it;
 - You use reasonable measures to keep it secret; and
 - It is generally not known or disclosed to the public

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Trade Secrets Can Include:

- Customer lists
- Pricing formulas
- Computer programs and databases
- Manufacturing processes or techniques
- Marketing or product plans
- Names of vendors and suppliers
- Product formulas, ingredients and recipes
- Instructional and training methods
- Dates when shipments will arrive

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What is the benefit of having a trade secret?

- Competitive economic advantage
- It is a protectable property right
- Trade secret protection can be perpetual
 - A trade secret can be protected until the information is known
 - A secret can become known through the actual disclosure to the public or through the failure to take the adequate measures to protect it

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Trade Secrets are Property

- Can be valued
- Sold
- Licensed
- Used as security
- Protected

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Trade Secret Protection?

- Is theoretically, protected forever...
- As long as it gives you competitive advantage, and...
- Reasonable measures are taken to protect it through use of:
 - Contracts
 - Physical measures
 - Notices
- Protected status maintained, in most cases, if confidentially disclosed

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Most Significant Factor in Determining if Information is a Trade Secret is...

... the extent to which the owner has taken steps to guard the information's secrecy.

Contract Protection

- Agreements with your employees, licensees, outside contractors, or vendors restricting their ability to disclose your trade secrets
- Examples:
 - Non-Disclosure Agreement – no disclosure of trade secret
 - Non-Compete Agreements – promise not to work for a competitor

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Physical Measures

- Restrict access to locations where the trade secret is kept
- Examples:
 - Store secret documents in locked areas
 - Restrict access to location/computer of protected documents/items
 - Use digital couriers to encrypt, track and protect information sent via email
 - Use unnamed or coded ingredients used in trade secret recipes or formulas
 - Screen speeches and publications by employees to prevent disclosure of confidential information

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Notices

- Designating sensitive documents and areas as confidential or restricted.
- Examples:
 - Distribute to employees a formal, written statement or policy manual
 - Inform employees who have access to confidential information
 - Warning signs on all documents and computer files containing trade secret information
 - Alert employees through implementation of software, email, and internet policies to the confidentiality of certain information

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Federal Protection

- Recognized existence of trade secrets with Economic Espionage Act of 1996 (EEA), 18 U.S.C. § 1831-1839
- The EEA makes the intentional theft, copying, or receiving of trade secrets a crime punishable by heavy fines and imprisonment (DOJ enforcement)
- Recent amendments to the Computer Fraud and Abuse Act (CFAA), 18 U.S.C. § 1030 have broadened the scope of federal protection for computers used in interstate and foreign commerce

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State Protection

- Degree of protection differs from state to state, but all states protect. Many states adopted a version of Uniform Trade Secrets Act (UTSA), 14 U.L.A. § 1, et seq.
- Other states rely on common law

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Remedies for Misappropriation of Trade Secrets

- Vary from state to state
- Damages for loss
- Possible punitive damages if misappropriator acted intentionally or with evil motive
- Injunction to prevent further unauthorized use or disclosure
- Return

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Differences Between Patents & Trade Secrets

<ul style="list-style-type: none"> □ Patents □ Patent owner can prevent others from making, using or selling patented item □ U.S. patent application is made public during application process □ Expense of patent process & maintenance fees required after a patent is obtained □ Governed by federal law 	<ul style="list-style-type: none"> □ Trade Secrets □ Lose protected status if disclosed/otherwise becomes publicly known through legitimate means □ Cost associated with instituting measures to protect trade secret □ Trade secret law comes from the states
--	--

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Useful Trade Secret Links:

- www.cybercrime.gov
- www.usdoj.gov/criminal/cybercrime/eea.html

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Patents

Patent

- 35 U.S.C. § 101 et seq.
- Rights of a patent owner include exclusive right to prevent others from
 - Making,
 - Using,
 - Selling, or
 - Importing (into the United States) the invention
- Once a patent expires the invention becomes part of the public domain

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Patentable Inventions

- Only *new*, useful inventions of patentable subject matter
- Underlying invention must be original in:
 - Conception
 - Style

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Three Types of Patents

- Utility Patent
- Design Patent
- Plant Patent

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Utility Patent

- Processes, machines, products, and compositions of matter that are shown to be capable of performing an intended purpose
- Can be obtained for
 - Things, method for *making* a thing, method for *using* a thing
- Examples:
 - Cigarette lighter, method for refining sugar, genetically engineered bacteria

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Design Patent

- Covers appearance or shape of manufactured article
- Subject of a design patent may be configuration or shape of the product, surface ornamentation applied to the product, combination of both
- Examples:
 - Shape of a telephone handset, decorative base for a lamp, pitcher with a stylized handle

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Difference Between Design & Utility Patents

- | | |
|--|---|
| <ul style="list-style-type: none">□ Design patent<ul style="list-style-type: none">■ Way something LOOKS■ Design is not required to be useful | <ul style="list-style-type: none">□ Utility patent<ul style="list-style-type: none">■ Way something is USED or WORKS |
|--|---|

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Plant Patent

- For asexually reproduced, distinct new plant varieties
- It covers a living plant organism that can be duplicated through asexual reproduction, but cannot otherwise be "made or manufactured"
- It can also be obtained for hybrids of plants

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Unpatentable Inventions

- Already
 - in a publication anywhere in the world, or
 - in public use, or
 - on sale in the United States
- New inventions if they only differ in a way that would be obvious to a person of ordinary skill in the relevant field of technology

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Patent Ownership

- General Rule: Inventors own the patent rights On their inventions, but...
- Employers often require assignment of rights as condition of employment

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Forfeiture of Patent Rights

- U. S.
 - Inventor doesn't file for protection within one year after describing the invention in a printed publication
 - Using it publicly
 - Offering it for sale
 - There are exceptions to this rule if:
 - Public use was experimental
 - Improvements have been made since disclosure
- International
 - In many foreign countries, patent rights are lost if the inventor doesn't file for patent protection on the *first* day of public use or disclosure

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Non- Provisional Patent Applications

- Written document that includes cover page, specification, drawing of invention, claims, and an oath/declaration
- Specification describes the invention, the preferred embodiment of the invention, and how to make and use it, so public can practice the invention
- Must be made in name of inventor; assignee involvement allowed
- Denial may be appealed
- Filing fee

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Provisional Patent Applications

- Lower-cost initial filing to preserve rights in the U.S.
- Not examined
- Patent not be granted from a provisional application
- Specifications not required
- If non-provisional patent is not filed within 12 months provisional application will be deemed abandoned
- Non-provisional application entitled to original filing date of provisional application
- Not available for design patents

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Patent Terms

- A U.S. patent only protects against infringing activities within the United States or its territories
- Utility/Plant Patent
 - 20 years from date on which the patent application was filed in the United States
- Design Patent
 - 14 years from grant

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Utility Patent Maintenance Fees

- Fees are due from the date the patent is granted:
 - Payment one due: 3 to 3.5 years,
 - Payment two due: 7 to 7.5 years
 - Payment three due: 11 to 11.5 years
- Failure to pay the maintenance fees can result in the expiration of the patent
- No maintenance fees required for design or plant patents

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International Patents

- Patent Cooperation Treaty (PCT) makes it possible to apply for protection of an invention in several countries
- A PCT application can cover over 100 countries
- First to file concept

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Selling/Licensing a Patent

- Patent can be shared or transferred through assignment
- Patent right assignment valid only if in writing
- Assignee acquires same rights of the original patent owner
- Assignment should be recorded with the USPTO
- Can license to:
 - Make, use, sell, or import patented invention

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Infringement

- Infringement includes the importation of a patented invention into the U.S.
- Patent enjoy presumption of validity
- But may be attacked as invalid
- Single holding of invalidity usually fatal to a patent

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Litigation

- Jurisdiction in federal courts
- Possible remedies include:
 - Injunctive relief
 - Monetary damages - lost profits/ royalties
 - Punitive damages and attorneys' fees available in exceptional cases
- Relief from the International Trade Commission (ITC), under § 337 of the Tariff Act of 1930 to exclude infringing goods from entering the country

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Using Terms "Patent Pending" or "Patent Applied For"

- These designations are notices to the public and application for a patent has been filed with the USPTO
- In order to use either one, an application must have been filed with the USPTO
- Patent claims must cover what is being labeled with the designation

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Third Party Attacks on Party

- Declaratory judgment that patent is invalid, unenforceable, or infringed can be brought when two conditions satisfied –
 - Potential plaintiff must have engaged in act that may be asserted to be infringing
 - Patent owner acted to cause reasonable apprehension that patent owner will assert infringement

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Patent Application's Impact on Trade Secrets

- If a trade secret is disclosed in a published patent application or issued patent, the trade secret will be lost

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Useful Patent Links

- United States Patent and Trademark office:
<http://www.uspto.gov/>
- USPTO Fee Schedule:
<http://www.uspto.gov/web/offices/ac/qs/ope/fee2006may15.htm>
- Canadian Intellectual Property Office: <http://patents1.ic.gc.ca/>
- European Patent Office:
<http://www.european-patent-office.org/index.en.php>
- Manual of Patent Examining Procedure (MPEP):
<http://www.uspto.gov/web/offices/pac/mpep/mpep.htm>
- USPTO Electronic Filing System:
<http://www.uspto.gov/main/trademarks.htm>
- American Intellectual Property Law Association: <http://www.aipla.org/>
- World Intellectual Property Organization: <http://www.wipo.int>
- Yahoo! © Patent Directory:
http://dir.yahoo.com/Government/Law/Intellectual_Property/Patents

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