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INTELLECTUAL PROPERTY OVERVIEW

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IDEAS AND CONCEPTS

- Are *not protectable* in and of themselves
- Legal protection extends to the *tangible expression* of ideas and concepts
- This tangible expression is known as *Intellectual Property* ("IP")

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INTELLECTUAL PROPERTY

- What?
 - *Tangible Expression* of creative human endeavor
 - *Protected* by
 - *Patents*
 - *Trademarks*
 - *Copyrights*
 - *Trade Secrets*

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Can I Patent a Trademark For a Copyright?

NO, because:

Terms *patent*, *trademark* and *copyright* are not synonyms, but distinct intellectual property rights





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Intellectual Property...

- Transportation Analogy
 - Cars drive on land 
 - Ships sail on water 
 - Planes fly in air 
 - Hydroplanes travel on water and in air 

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Intellectual Property...

- *Patents* = Inventions or Discoveries
- *Trademarks* = Indicators of Source
- *Copyrights* = Original Works
- *Trade Secrets* = Confidential Information

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Intellectual Property...

- Rights?
 - *Limited term, private property right* in exchange for promotion of the useful arts and sciences

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Intellectual Property...

- How Long?
 - Until becomes *Public Domain*
 - Available for all to use
 - **Caveat:**
 - Public Availability \neq Public Domain

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PATENTS

- What?
 - *Inventions* or *Discoveries*
 - Three Types
 - *Utility*
 - *Design*
 - *Plant*

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Utility Patent

Any *new, useful* and *nonobvious*

- *Process* (making an aluminum can)
- *Machine* (aluminum can making machine)
- *Manufacture* (aluminum can)
- *Composition of Matter* (alloy - steel)
- *Improvement thereof* (pop-top can)

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United States Patent
Annotated

Patent No. 6,202,714 B1
Date of Patent: Sep. 23, 2003

INVENTOR: JAMES W. SPENCER, JR., BOSTON, MA
ATTORNEY: BL SPEER & ASSOCIATES, BOSTON, MA

ABSTRACT: A method for manufacturing a beverage container, including a method for forming a neck of the container, a method for forming a body of the container, and a method for forming a top of the container. The method includes forming a neck of the container by extruding a neck blank, forming a body of the container by extruding a body blank, and forming a top of the container by extruding a top blank. The neck blank, body blank, and top blank are formed from a material that is suitable for forming a beverage container. The neck blank, body blank, and top blank are formed from a material that is suitable for forming a beverage container. The neck blank, body blank, and top blank are formed from a material that is suitable for forming a beverage container.

FIG. 1 is a perspective view of a beverage container 10. The beverage container 10 includes a neck 12, a body 14, and a top 16. The neck 12 is formed by extruding a neck blank. The body 14 is formed by extruding a body blank. The top 16 is formed by extruding a top blank. The neck 12, body 14, and top 16 are formed from a material that is suitable for forming a beverage container.

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Design Patent


Any *new, original* and *ornamental design* for an article of manufacture (silverware pattern; range hood)

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United States Design Patent US Patent No. US 6,648,263 S
1999 Date of Grant: Nov. 19, 2001

INVENTOR: Nathan B. Nagel, et al. (USA)
APPLICANT: Spoor, Phillips, Goldstein & Fishbein, LLP
ATTORNEYS: Nathan B. Nagel, et al. (USA)
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WWW: WWW.SPGF.COM

ABSTRACT: A rose plant, characterized by its color and shape, and by its ability to produce new varieties of rose plants.



Plant Patents

Any *distinct* and *new* variety of plant, which is *asexually reproduced* (newly grafted rose plant)

including:

- Cultivated Spores
- Mutants
- Hybrids
- Newly Found Seedlings (other than a tuber propagated plant or a plant found in an uncultivated state)

United States Plant Patent US Patent No. US 5,913,807 P2
1999 Date of Grant: Nov. 11, 2000

INVENTOR: Nathan B. Nagel, et al. (USA)
APPLICANT: Spoor, Phillips, Goldstein & Fishbein, LLP
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Patents...

- Rights?
– *Exclusive* right to
• *Make*
• *Use* and
• *Sell*

Patents...

- Where?
– National Border

Patents...

- How Long?
– Utility: 20 years from filing date
– Design: 15 years from grant date
– Plant: 20 years from filing date

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Patents...

- **Public Domain?**
 - *Expiration* of grant

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Patents...

- **Marking?**
 - U.S. Patent No. 10,000,00 (utility)
 - U.S. Patent No. D800,000 (design)
 - U.S. Patent No. PP30,000 (plant)
 - U.S. Pat. Pend. (pending application)

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Patents...

- **Acquisition of Rights?**
 - Upon grant
 - US Patent & Trademark Office
 - Registration *required*

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Patents...Practice Pointers

- **Disclosure** can be fatal
 - First to File as of 16 March 2013
- **Provisional Patent**
 - Priority date placeholder
 - No rights

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TRADEMARKS

- **What?**
 - **Trademark:** Indicator of source or origin of a good or service
 - Trademarks may consist of:

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Words



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Phrases



It's the real thing.
Coke.

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Designs



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Combinations Thereof



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Scents, Sounds & Colors

- *Scent*
 - Smead
 - Vanilla and others for office supplies
- *Sound*
 - NBC
 - Chimes for broadcasting services
- *Color*
 - Owens Corning
 - Pink for insulation

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Trademarks...

- **Proper Format**
 - *Always* use as an **ADJECTIVE**
 - Trademark brand noun
 - *Big Chief*® brand writing tablet
 - **Not** as a **noun**
 - Please make a Xerox of this document.
 - **Not** as a **verb**
 - Let's go rollerblading in the park.

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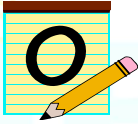
Trademarks...

Types of Trademarks
in order of
Ascending Legal Strength...

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Generic Trademarks

- Common name of good or service
 - Car (good) 
 - Accounting (service) 

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Descriptive Trademarks

- Describes nature or quality
 - Half Price Books® (new & used bookstore) 

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Suggestive Trademarks

- Suggests nature or quality
 - Coppertone® (nice tan) 
 - Edge® (close shave) 

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Arbitrary Trademarks

- Intrinsic meaning, unrelated context
 - Apple® (computers for educational market) 
 - BlackBerry® (multi-purpose electronic device) 

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Coined/Fanciful Trademarks

- Invented
 - Kodak® (film, imaging) 
 - Xerox® (reproduction machines) 

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Trademarks...

- What?
 - *Exclusive right* to use trademark with *particular* goods and services.

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Trademarks...

- **Types?**
 - Trademark
 - Service Mark
 - Certification Mark (third parties)
 - Collective Mark (members)

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Trademarks...

- **Where?**
 - *Common Law Usage:* Demonstrated territory
 - *State Registration:* State border
 - *Federal Registration:* National border

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Trademarks...

- **How Long?**
 - *Common Law Usage:* As long as continuously used
 - *State Registration:* Usually 5 or 10 years (subject to renewal and continuous use)
 - *Federal Registration:* 10 years (subject to renewal and continuous use)

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Trademarks...

- **Public Domain?**
 - *No longer in continual use*
 - At least 3 years of non-use

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Trademarks...

- **Marking?**
 - MARK® (*Federal Registration*)
 - MARK™ (*State Registration and/or Common Law Usage*)

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Trademarks...

- **Acquisition of Rights?**
 - Upon *use* of the mark in *commerce*
 - US Patent & Trademark Office
 - Secretary of State

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Trademarks...

- Acquisition of Rights...
 - Registration *not* required, *but*
 - Proof of *rights*
 - Proof of *ownership*
 - Public *record*

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Trademarks...

- Infringement?
 - Likelihood of *Confusion*
 - Same or similar mark
 - Same or similar goods or services

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Trademarks...Practice Pointers

- Clearance before launch
 - Do-overs are expensive
- Pick a good mark
 - Legally weak marks are hard to protect
- *Genericide*

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TRADE DRESS

- What?
 - Image or overall appearance of a good or service
 - Can include all or part of the total image or overall impression

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TRADEMARKS vs. TRADE NAMES

From a Legal Perspective:

Trademark
≠
Trade Name
≠
Entity Name

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Entity Name

Formal name by which your *entity* (corporation, LLC, etc.) is registered with the state

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Trade Name

Name, *other than entity name*,
under which entity *does business*;
whose purpose is to trace back
to the *true entity*
(also registered with state)

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From a Marketing Perspective...

- Are the Same
IBM Corporation
dba *IBM*
sells *IBM*[®] brand computers

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From a Marketing Perspective:

- Not the Same
The Procter & Gamble Company
dba *P&G*
sells *Bounty*[®] brand paper towels

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Entities...Practice Pointers

Entity Formation
≠
Trademark Protection

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COPYRIGHTS

- What?
 - *Original works of authorship*
fixed in any *tangible* medium of
expression

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Copyrights...


- Works?
 - *Literary* works 
 - *Musical* works 
(including any accompanying words)
 - *Dramatic* works 
(including any accompanying music)

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Copyrights...

- Works?
 - Pantomimes and Choreographic works




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Copyrights...

- Works...
 - Pictorial, Graphic and Sculptural works
 - Motion Pictures and other Audiovisual works




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Copyrights...

- Works...
 - Sound Recordings
 - Architectural Works




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Copyrights...

- Rights?
 - Exclusive Rights
 - Reproduce the work
 - Prepare derivative works
 - Distribute copies
 - Perform publicly
 - Display publicly

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Copyrights...

- Where?
 - National Border
 - International Reciprocity

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Copyrights...

- How Long?
 - Individual Work: Life of author plus 70 years
 - Joint Work: Life of last-surviving author plus 70 years
 - Anonymous Work, Pseudonymous Work, Work for Hire: Earlier of
 - 95 years from publication
 - 120 years from creation

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Copyrights...

- **Public Domain?**
 - *Expiration* of term

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Copyrights...

- **Marking?**
 - *Copyright*
 - Symbol (©)
 - Word (Copyright)
 - Abbreviation (Copr.)
 - *Year* of Creation or Publication
 - *Author* Name

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Copyrights...

- **Marking...**
 - *Visually Perceptible Copies*
 - © 2019 Author Name
 - Copyright 2098 Author Name
 - Copr. 2019 Author Name

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Copyrights...

- **Marking...**
 - *Sound Recordings*
 - © 2019 Author Name

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Copyrights...

- **Acquisition of Rights?**
 - Upon *creation*
 - US *Copyright Office*

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Copyrights...

- **Acquisition of Rights...**
 - *Registration not required, but* provides
 - Proof of *ownership*
 - *Public record*
 - Required to bring *suit*
 - File within 3 months of *Publication*
 - Damages
 - Attorneys Fees

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Copyright...

- **Infringement?**
 - Access to original work, and
 - Substantial similarity to original work

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Copyrights...Practice Pointers

- **Creator = Owner**
- **Work for Hire**
 - Employment
 - Order or Commission
- **Contracts (assignment)**
 - Independent Contractors
 - Third Parties
- **Commercially Viable? Register!**

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TRADE SECRETS

- **What?**
 - *Business information* that has
 - *Commercial value*
 - Provides an actual or potential *economic advantage* over others
 - Is *maintained in confidence*

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Trade Secrets...

- **Rights?**
 - *Exclusive* right to *use*

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Trade Secrets...

- **Where?**
 - *State by State*
 - Other areas of legal recognition

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Trade Secrets...

- **How Long?**
 - As long as maintained in *confidence*



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Trade Secrets...

- **Public Domain?**
 - *Disclosure*
 - By *anyone*
 - With or without fault

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Trade Secrets...

- **Marking?**

CONFIDENTIAL

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Trade Secrets...

- **Acquisition of Rights?**
 - Upon *creation*
 - Not Registered
 - **Contractual** Right

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Trade Secrets...

- **Infringement?**
 - *Improper Access*
 - *Use or Disclosure*

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Trade Secrets... Practice Pointers

- **Contracts**
 - Employees
 - Independent Contractors
 - Third Parties
 - Duration of Duty
- **Control Access**
- **Inventory**

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