

Protecting Your Intellectual Property

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Overview

- What is Intellectual Property?
- Patents
 - What is a patent?
 - How does one get a patent?
- Trademark
 - What is a trademark?
 - How does one get a trademark?
- Copyright
 - What is a copyright?
 - How does one get a copyright?
- Trade Secret
 - What is a trade secret?
 - How does one get a trade secret?

What is Intellectual Property?

Intangible products of the human mind; “intelligence goods” or “knowledge goods”

- Examples: inventions, ideas, writings, drawings, music, brand names, industrial secrets, customer lists, processes, configurations, formulas, identifying phrases, etc.

Group of legal rights which provide protection over things people create

What is Intellectual Property?

- Patent - inventions
- Trademark – designators of origin
- Copyright – artistic creation
- Trade Secret – anything deriving value from being secret

Why Do We Care About Intellectual Property?

- Business/personal asset
- Defensive protection for business
- Generate revenue (license/royalty)

Patents (US) - Overview

“The Congress shall have Power...To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.” U.S. Constitution, Art. I § 8, Cl. 8

Patents (US) - Overview

“Whoever invents or discovers any **new** and **useful** **process, machine, manufacture, or composition of matter**, or any new and useful **improvement thereof**, may obtain a patent therefore, subject to the conditions and requirements of this title.” 35 USC § 101

Patents (US) - Overview

- How does one get a patent?
 - File application
 - Pay money
 - Go through examination at U.S. Patent and Trademark Office (USPTO)
 - Examiners are divided into art units
 - Search patents, internet, publications, technical journals to find references to reject applications
 - Can find all aspects of your invention in a single reference (not new), or use a couple references in combination and argue an invention is obvious based on what was already known
 - Pay more money

Patents (US) - Overview

Types of applications

- Utility (provisional or non-provisional)
 - Protect how something is built, how something works, and otherwise functional aspects of an invention
 - Term of 20 years from earliest filing date
- Design
 - Protect the design or non-functional aspects of an invention
 - Term of 15 years from grant
- Plant
 - Protects...plants....
 - Term of 20 years from earliest filing

What Rights Does a Patent Give the Owner?

“Except as otherwise provided in this title, whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefor, infringes the patent.” 35 USC § 271

Patent (US) – Best Practices

- Potential New IP
 - Identify areas of innovations
 - Have company/employee policies
 - Keep track of when innovations happened
 - Keep track of when innovations are disclosed
- Existing Patents
 - Keep tabs on what your competitors are doing
 - Keep track of expiration maintenance fee/expiration dates
 - Monitor commercial usefulness

Trademark (US) - Overview

- 15 U.S. Code § 1127 – Trademark Definition
 - The term “trademark” includes any word, name, symbol, or device, or any combination thereof—
 - (1) used by a person, or
 - (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

Trademark (US) - Overview



Trademark (US) - Overview

What are the limitations? “No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration...unless it...”

- Is immoral, deceptive or scandalous in matter;
- Disparages or falsely suggests a connection with a person (without consent)
- Identifies a place other than the true place of origin (*think cheese and wines here*)
- Falsely suggests a connection with beliefs or national symbols or otherwise brings them into contempt or disrepute
- Consists of or comprises the flag or coat of arms or other insignia of the United States, any state or any foreign nation

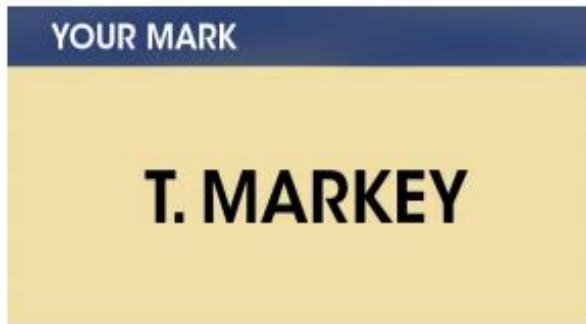
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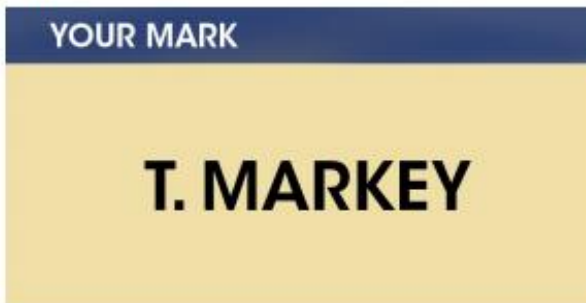
- Includes the name or portrait of a deceased U. S. president while the widow is still alive (without consent)
- Is confusingly similar with an existing mark (registered or not)
- Is functional
- Is merely descriptive or deceptively misdescriptive of the goods being sold under the mark, although a descriptive mark may gain distinction by use in commerce

Examples of Confusingly Similar

Sound

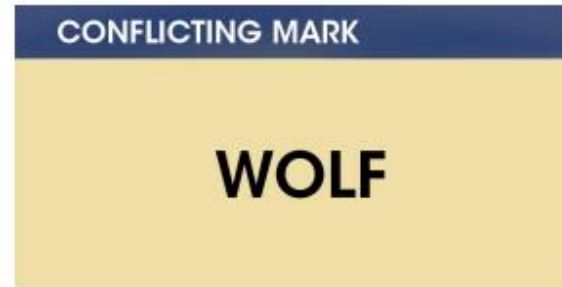
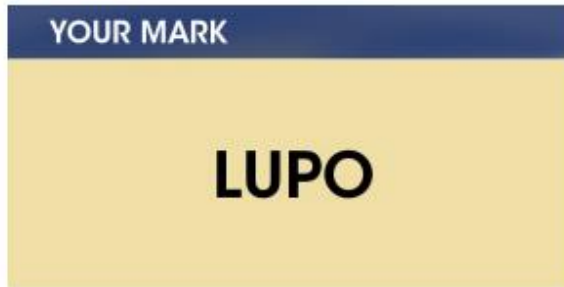


Appearance

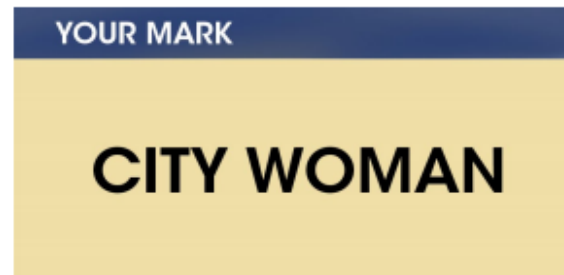
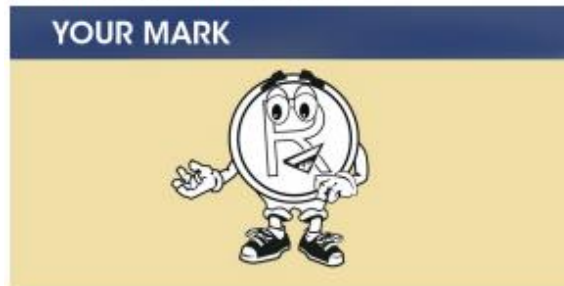


Examples of Confusingly Similar

Meaning



Commercial Impression



Examples of Confusingly Similar

Goods

YOUR GOODS

**T-shirts
and
pants**

RELATED GOODS

Hats

Services

YOUR SERVICES

**Banking
services**

RELATED SERVICES

**Mortgage
lending
services**

Goods and Services

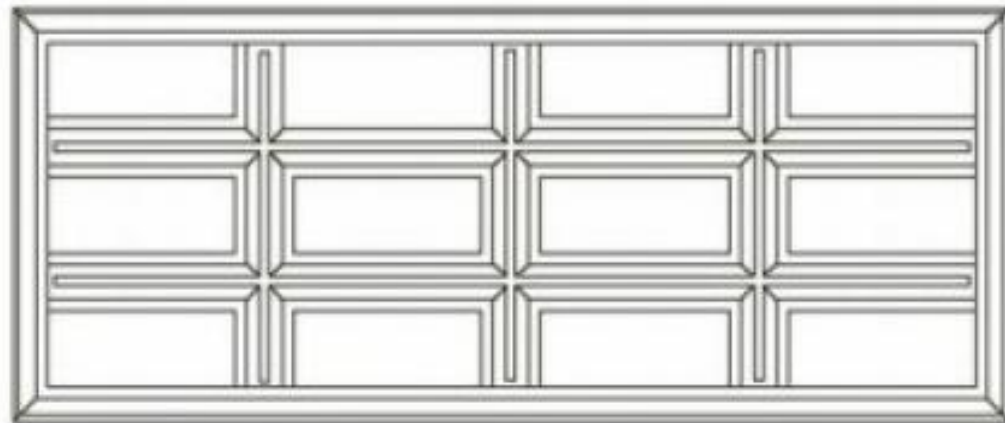
YOUR GOODS

**T-shirts
and
pants**

RELATED SERVICES

**Online retail
store services
featuring clothing**

Examples of Functional "Trademarks"



Examples of Descriptive



Trademarks are divided into five different categories, which are ranked by distinctiveness.

STRONG

Fanciful trademarks

Fanciful trademarks are made-up words which are invented to be used as a trademark name.

Kodak

EXXON

 **Polaroid**

Arbitrary trademarks

Arbitrary trademarks are words that have a real, common meaning but they are completely unrelated to the product or service.



Dove



Suggestive trademarks

Suggestive trademarks are named after a characteristic of the product or service.



JAGUAR

 Microsoft

NETFLIX

Descriptive trademarks

Descriptive trademarks are a description of the product or service.

SHARP

BRITISH AIRWAYS 



Generic trademarks

Generic trademarks cannot be protected as they are simply a generic description of the product or service.

BAND-AID
BRAND ADHESIVE BANDAGES

ASPIRIN

GENUINE
THERMOS

WEAK

Trademark (US) - Overview

- How does one get a trademark?
 - File application
 - Pay money
 - Go through examination
 - Use in commerce
 - Pay more money

BUT...

- Some protection is available upon use of the mark regardless of registration

Trademark (US) – Parts of a Trademark Application/Registration

Parts of a Trademark Application/Registration

- Mark
- Applicant/Owner
- Description of Mark if necessary
- Class
- List of Goods and Services
- First Use in Commerce

Term – as long as you're using it

What Rights Does a Trademark (registered) Give the Owner?

“Any person who shall, without the consent of the registrant – (a) **use in commerce** any reproduction, counterfeit, copy or colorable imitation of a registered mark **in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with** which such use is **likely to cause confusion, or to cause mistake, or to deceive**; or (b) **reproduce, counterfeit, copy, or colorably imitate** a registered mark and **apply such reproduction, counterfeit, copy or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements** intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use **is likely to cause confusion, or to cause mistake, or to deceive....**” will be liable... 15 USC § 1114

Trademark (US) – Best Practices

On the front end...

- Create strong marks
- Avoid descriptors
- Know what others in the industry are using

Once you decide on a mark....

- Consistent use
- Trademarks are adjectives
- Show you claim ownership of the mark
- Watch how others use your mark

Copyright (US) - Overview

“The Congress shall have Power...To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.” U.S. Constitution, Art. I § 8, Cl. 8

Copyright (US) - Overview

“Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:

- (1) literary works;
- (2) musical works, including any accompanying words;
- (3) dramatic works, including any accompanying music;
- (4) pantomimes and choreographed works;

Copyright (US) - Overview

- (5) pictorial, graphic, and sculptural works;
- (6) motion pictures and other audiovisual works;
- (7) sound recordings; and
- (8) architectural works.”

17 USC § 102

Copyright (US) - Overview

How does one get a copyright?

- File an application
- Pay money
- NO EXAMINATION – examined for formalities only

But ...

- Copyright protection comes into existence when a work is created and captured in tangible form.

Term - generally, life of the author plus 70 years

Copyright (US) – Parts of an Application

Parts of a Copyright Application

- Title of Work
- Author Information
- Publication/Creation Information
- Claimant Information
- Reference to Related Registrations
- Disclaimers
- Deposit Copy

Copyright (US) – Best Practices

- Mark creative works with © and the year, at a minimum
- Have a company/employee copyright policy
- Use ‘work made for hire’ agreements when applicable

Trade Secret (US)

- Traditionally governed by state law
- Recently the Defend Trade Secrets Act provides a federal cause of action for people who steal or misuse trade secrets

Trade Secret (US) - Overview

What is a trade secret?

A trade secret is a formula, pattern, physical device, idea, process, or complication of information which is not generally known or reasonably ascertainable, by which a business can obtain an economic advantage over competitors or its customers.

“Trade Secret” means information (e.g., formula, pattern, method, technique, etc.) that (i) derives independent economic value, actual or perceived, from not being generally known or readily ascertainable by proper means by other persons who can obtain economic value from its disclosure or use, and (ii) is the subject of reasonable efforts to maintain its secrecy.

Trade Secret (US) – Best Practices

- Identify subject matter
- Written company and employee trade secret policies
- Use non-disclosure agreements
- Restrict access
- Periodic risk assessment
- Periodic training
- **ENFORCE THE ABOVE**

Questions?

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