

PATENT LAW

- Any invention or discovery of any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.

PATENT LAW - ELEMENTS

- Must be patentable subject matter
- Must have utility
- Must be novel and not on sale or in commerce for a year or more
- Must not be obvious to one skilled in the art

PATENT LAW - RIGHTS

- A government granted monopoly to the inventor to **prevent others** from making, using, offering for sale, or selling the invention in the United States or importing the invention into the United States.

PATENT LAW - PROCESS

- Patents can only be prosecuted by the inventor, a licensed patent agent or licensed patent attorney
- Patentability search and assessment
- Drafting and filing an application
- Working to overcome the objections of the Patent and Trademark Office
- The process usually takes more than a year, and can take several years
- The rights are strong, the process of obtaining such rights is rigorous and time consuming.

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PATENT - RIGHTS DURATION

- Standard duration is 20 years from filing
- After the term, the invention is in the public domain

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PATENT LAW - INTERNATIONAL

- Many nations belong to the Patent Cooperation Treaty (PCT)
- Other agreements, GATT-TRIPPS, provide other avenues for international patent protection
- Talk to a patent attorney about obtaining patent protection for your inventions in countries important to your business.

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PATENTS - INFRINGEMENT

- Making, using, offering for sale, or selling" the invention in the United States or "importing" the invention into the United States any claim in an issued patent.
- Doing any of the above with the equivalent of any claim of an issued patent.
- No such thing as innocent infringement, independent invention is no defense.

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PATENTS - DAMAGES/RELIEF

- Injunctions
- Damages, reasonable royalties and lost profits
- Seizure of imported goods by U.S. Customs
- Destruction of infringing matter...

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PATENT - PRACTICE TIPS

- Perform an infringement search and analysis prior to implementing new technology or methods
- Upon development of a new technology or method perform a patentability search and analysis
 - Do not disclose such technology or methods without a non-disclosure agreement.
 - The one year on-sale bar is a killer
- If you think you have a patentable invention or method, then seek patent counsel promptly.

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PATENTS - DESIGN PATENTS

- Patents on ornamental designs
- The design must be ornamental, not useful
- The cost of prosecution is relatively low
- They offer some limited protection

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PATENTS - MYTHS VS. REALITY

- MYTH: Patents are solely for machines
- REALITY: There are 3 types of patents
 - Utility Patents - Useful Inventions
 - Plant Patents - asexually reproduced distinct new variety of plants
 - Design Patents - ornamental designs embodied in or applied to an article of manufacture

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PATENTS - MYTHS VS. REALITY

- MYTH: Everyone that invents something is entitled to patent protection for their inventions.
- REALITY: Patents only exist when the federal government issues letters of patent. Merely inventing does not necessarily provide any rights.

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PATENTS - MYTHS VS. REALITY

- MYTH: Patents stop others from making an invention identified in letters of patent.
- REALITY: Patents are not self enforcing. Patent owners must file infringement actions to prevent others from making, selling, offering for sale, or importing their protected inventions.

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PATENTS - MYTHS VS. REALITY

- MYTH: Patents give a right to make an invention.
- REALITY: Patents are a negative right to seek redress to prevent others from making, selling, offering for sale, or importing protected inventions.

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PATENTS - MYTHS VS. REALITY

- MYTH: Inventions must work to be patentable.
- REALITY: Not all patents work.



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PATENTS

- QUESTIONS

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COPYRIGHT

- Protects any creative expression in a tangible medium
- Protects the expression of ideas, works of art, but not ideas themselves
- Protects creative elements of a work, but not primarily functional or utilitarian elements
- Protects web page content, graphics, animations, sounds, source code...
- Protects system documentation

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COPYRIGHTS

- Rights vest the instant that an expression is reduced to a tangible medium
- Registration is not required to have copyrights in a work

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COPYRIGHT - OWNERSHIP

- Owned by the author, the one who puts the expression into the tangible medium
- In a true employment situation, the employer is deemed the author if the work was done within the scope of employment.
- Independent contractors retain copyright ownership in work created by them absent a written agreement to the contrary.

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COPYRIGHT - RIGHTS

- With respect to the work, copyright law provides an exclusive right to:
 - Reproduce, make copies
 - Create adaptations, enhancements, changes, new versions
 - Distribute publicly
 - Perform or display publicly

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COPYRIGHTS - MARKING

- Notice removes the innocent infringement defense to infringement.
- Form:
 - © 2020 Greg Gemignani
 - Copyright 2020 Greg Gemignani
 - Copr. 2020 Greg Gemignani
- Must be positioned to give reasonable notice to be effective
- Lack of proper notice may result in a disallowance of damages in a successful infringement suit

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COPYRIGHTS - REGISTRATION

- Registration is done through the Copyright Office of the Library of Congress
- Registration forms are available via the Library of Congress Web Site (www.copyright.gov)
- Registration must be filed prior to bringing suit
- Registration must be effective prior to filing an infringement law suit in order to be eligible for statutory damages and attorney's fees, unless registration is made within three months of initial publication

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COPYRIGHT - DAMAGES

- Lost profits
 - Proved and related to the infringement
- Disgorgement of profits
 - Proved and related
- Statutory damages of \$750 - \$150,000
 - At the court's discretion and depending on whether or not the infringement was willful.
- Attorney's Fees
 - In some circumstances
- Impoundment and/or destruction of infringing articles
- Injunctions

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COPYRIGHT - INFRINGEMENT

- Anyone that :
 - reproduces, make copies, creates adaptations, makes enhancements, makes changes, creates new versions, distributes publicly, performs publicly or displays publicly
 - any work that is subject to copyright ownership of another
 - and does so without the copyright owner's permission

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COPYRIGHT - DURATION

- For Works Authored By Natural Persons
 - Author's life plus 70 years
- Works For Hire
 - 95 years from first publication or 120 years from creation, whichever occurs first

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COPYRIGHT - PRACTICE TIPS

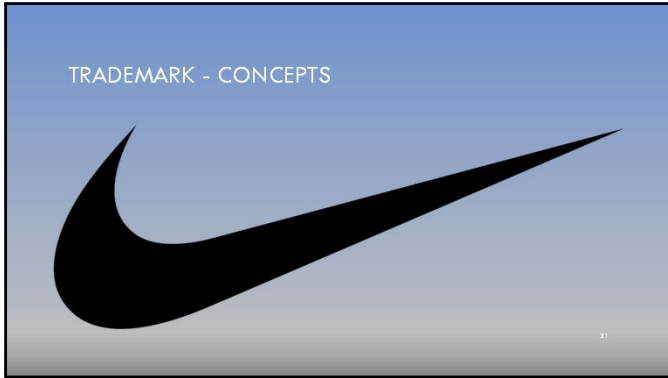
- Make sure you own what you think you own
 - Have agreements with independent contractors
 - Define the scope of employee activities
 - Have agreements with employees to assign rights
- Protect yourself from infringement
 - Agreements with independent contractors
 - Employee education
- Copyright is the most prevalent type of intellectual property on the web.
- For common infringement (i.e., non-competitive infringement), send a demand letter first or risk good will with the court.

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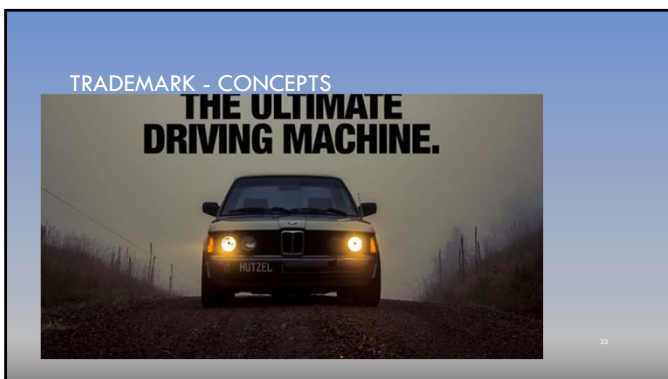
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- QUESTIONS

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TRADEMARK - CONCEPTS



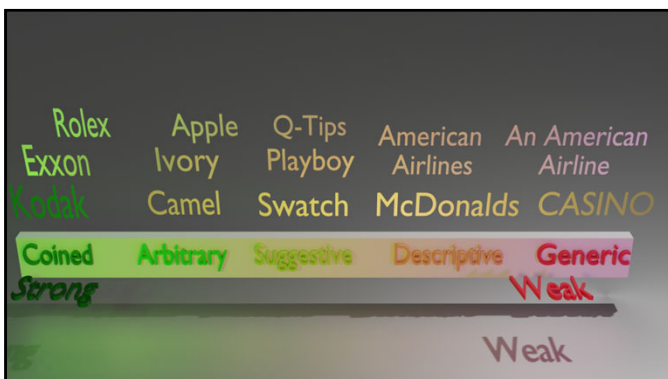
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TRADEMARKS - SUBJECT MATTER

- What is a trademark or service mark
- any word, name, symbol, or device or any combination thereof adopted and used by a manufacturer or merchant to identify and distinguish his 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. 15 U.S.C. § 1127.

Words/Phrases/Terms	XEROX
Designs	
Colors	 Pink for Fiberglass
Sounds	
Product Configuration	

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TRADEMARKS - STRENGTH



- Protection is available only for distinctive marks (distinguishes your goods/services from competitors)
- Generic terms are not distinctive
 - Casino for Gaming, Aspirin for Acetylsalicylic Acid, Car for Automobile
- Arbitrary use and coined words are inherently distinctive
 - Rolex, Xerox, Exxon, Oreo
- In-between being generic or arbitrary, distinctive use increases as the descriptive nature of the mark decreases

TRADEMARKS - OBTAINING RIGHTS

- USE is the key for obtaining trademark rights.
- Common law rights begin when the mark is used in commerce in a particular geographic area
- State Registration
 - In most states, use in the state and state registration provides a presumption that the registrant is entitled to exclusive use of the mark throughout the state
- Federal Registration
 - Can secure an initial date based on a bona-fide intention to use a mark
 - Federally registered mark rights only vest after interstate commercial use and the Patent and Trademark Office's issuance of a registration

TRADEMARKS - USE

- Type Of Use.
 - Use of the mark must be sufficiently public to identify or distinguish the goods or services in the public's mind as those goods or services of the owner of the mark
 - A trade name or corporate name used merely to identify a business entity is not protectable as a trademark
 - The use must also be a bona fide use in the ordinary course of trade. Token uses merely to establish trademark rights are not sufficient and, given the availability of the intent-to-use application, should not be necessary
- Common Law.
 - Use must be within the particular geographic territory within which protection is claimed
- State Registration
 - Usually requires actual use in commerce within the state
- Federal Registration.
 - The use must be in interstate commerce

TRADEMARKS - FED PROCESS

- Initial Search
 - Check the federal database for infringement
- Full Search
 - Check state, federal, common law and internic databases
- Prepare and File an Application
- Interact with the United States Patent & Trademark Office to prosecute registration

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TRADEMARKS -OBTAINING RIGHTS

- Presumption of an exclusive right to national use
- Availability of enhanced damages
- Presumed nationwide notice

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TRADEMARKS - MAINTENANCE

- Federal
 - File Affidavits of Continued Use
 - Between the 5th and 6th years and every 10 years thereafter
 - File Renewals
 - Every 10 Years
- State
 - File Periodic Renewals
- All
 - Police your mark to preserve the source indicating quality of the mark.

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TRADEMARKS - MARKING

- Federally REGISTERED marks
 - ®, "Registered in the U.S. Patent and Trademark Office" or "Reg. U.S. Pat. & Tm. Off."
 - Without notice monetary damages may be unavailable
- State Registered or Common Law Marks
 - TM or SM above and to the right of the mark.

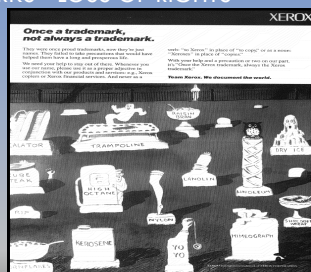
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TRADEMARKS - DURATION

- Perpetual
 - So long as source identifying quality is maintained
 - For registered marks, maintenance must be performed in order to retain registration benefits.

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TRADEMARKS - LOSS OF RIGHTS



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TRADEMARKS - LOSS OF RIGHTS

XEROX

**Not even
Xerox
can
Xerox.**

In fact, nobody can Xerox. Or have something Xeroxed. You can copy or have something copied, but you just can't Xerox.

That's because the Xerox trademark is not a verb. It's a proper adjective that should always be followed by a noun or phrase describing one of our products. As in Xerox copiers, Xerox electronic typewriters, Xerox laser printers, etc.

We're proud of our trademark. It's valuable to us. And to you. It's how you can be sure that when you ask for a Xerox product, you'll get a Xerox product. Not something else.

So, if you would make a copy of this advertisement and place it near your Xerox copier. Then everyone who copies will know that no one can Xerox.

Not even Xerox.

XEROX is a trademark of XEROX CORPORATION.

Advertisement used with permission from Xerox Corporation.

TRADEMARKS - INFRINGEMENT

- Likely to cause confusion in the minds of consumers as to the source, affiliation or endorsement of goods and services
- Common Factors
 - the strength of the plaintiff's mark and whether it is protectable;
 - the degree of similarity between the marks;
 - the similarity of the products and services offered by the parties;
 - evidence of actual confusion;
 - the similarity of the marketing channels of the parties;
 - the sophistication of the buyers in the relevant market and the degree of care likely to be exercised by the buyers;
 - the defendant's intent in adopting the mark; and
 - the likelihood of expansion of the product line or services

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TRADEMARKS - DAMAGES

- Monetary Relief
 - Lost profits
 - Infringer's profits
 - Statutory damages for domain name related infringement of up to \$150,000
 - Attorney's fees
- Injunctions
- Destruction of Infringing Articles

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TRADEMARKS - PRACTICE TIPS

- If your just starting, select a strong protectable mark.
- Tell consumers what your product or service is using a tag line.
- Don't use the mark of another on your site, in your domain name or in your URL path.
- Preserve the source indicating quality of your marks.
- If a domain name is available grab it, then do the search. For about \$20 it is cheaper to get it an not use it than negotiate the acquisition later.

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TRADEMARKS

- QUESTIONS

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TRADE SECRETS

- STATE LAW BASED INTELLECTUAL PROPERTY
- Information, (including a formula, pattern, compilation, program, device, method, technique, product, system, process, design, prototype, procedure, computer programming instruction or code) that (1) is economically valuable due to it not being generally publicly known and (2) is the subject of efforts that are reasonable under the circumstances to maintain its secrecy.

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TRADE SECRETS

- KEEP IT SECRET
 - Use reasonable efforts to prevent disclosure
 - Use non-disclosure agreements to protect the information prior to making a disclosure
 - Educate employees
 - Have written employment agreements
 - Perform employee exit interviews

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TRADE SECRETS

- Through Employees
 - Perform hiring interviews and identify any potential employees with prior agreements
 - Do not hire employees to perform jobs that will inevitably require them to rely on the trade secrets of another
 - Do not engage in questionable methods to obtain information

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TRADE SECRETS

- (Depends on the law of the state)
- Monetary damages
 - Lost profits, unjust enrichment
 - In Nevada, it may be double damages in some cases
- Reasonable royalty
- Attorney's fees

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TRADE SECRETS

- Treat valuable information as you would a valuable tangible asset
- Use agreements to protect secrecy
- Educate employees
- Don't place employees in situations that will likely cause the employee to use or disclose the trade secret of a prior employer

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DEMAND LETTERS - OLD STANDARD

- 1. State the rights you believe you have
- 2. Identify the use or potential infringement in question
- 3. Make your demand
 - Removal
 - Cessation of use
 - Destruction
 - Accounting
- 4. Reserve right to take further action if facts warrant
- 5. DO NOT THREATEN ACTION
 - Accusations of infringement or and threats of action may create a sufficient controversy to file a declaratory relief action in the recipients home jurisdiction.
 - Don't invite litigation your client may not want.

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DEMAND LETTERS - NEW STANDARD

- Be careful, nearly any communication asserting rights may provide a case in controversy.
- Consider filing, but not serving, prior to sending any demand letter.

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SUMMARY

- Summary
 - Copyrights protect particular expressions of ideas.
 - Copyrights are owned by authors
 - Trademarks protect the identity of source or affiliation of source with a given product or service
 - Trademark owners have a duty to preserve the source indicating qualities of their marks
 - Patents are monopolies granted to inventors that protect inventions
 - If you have a potentially patentable invention, composition of matter or method, then see a patent attorney
 - Trade Secrets are only valuable if kept secret
 - Don't hire people and place them where they will inevitably reveal the trade secret of another

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