

Intellectual Property – Patents, Copyright, Trade Secrets, and Trademarks

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**KINNEY
& LANGE®**
INTELLECTUAL PROPERTY
ATTORNEYS

How is this relevant to me, an Engineer?

- Reading competitor's patents
 - Want to “design around” your competitor's patent
 - Want to gauge what your competitors are working on
- Filing information disclosure forms
 - How to communicate what is novel about what you have invented
- Meetings with patent attorney's/ in-house counsel
 - Want to understand the “legalese” of the patent attorney's or the in-house counsel
 - Want to communicate what is novel about what you have invented

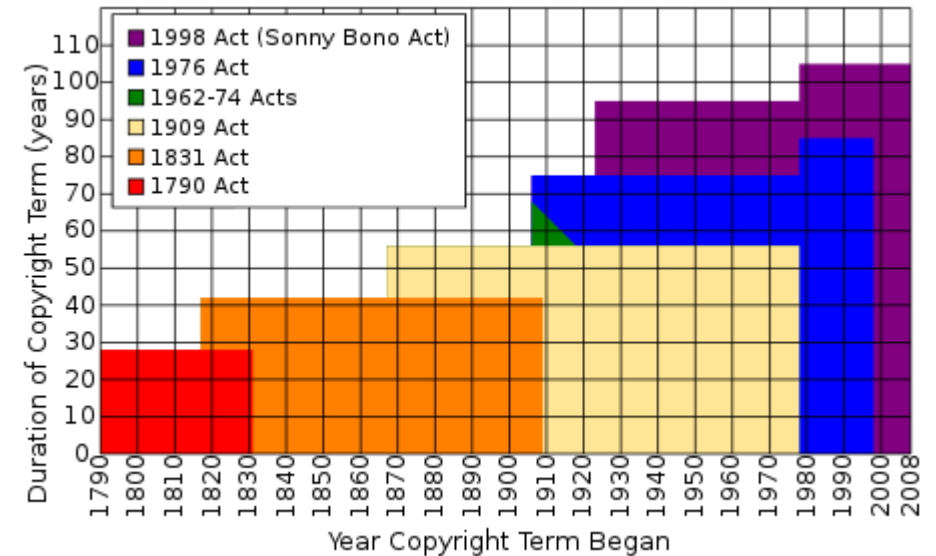
Copyright

- Based on power given to Congress in U.S. Constitution, Article 1, § 8, Cl.8
- Can be applied to literary works, musical works, dramatic works, pictorial works, architectural works, and more
 - Excludes facts, history, blank forms, recipes, titles, and typeface designs
- Copyrights don't grant exclusive right to the idea, only the expression of the idea



Copyright Cont.

- Copyrights are granted for the life of the author plus 70 years
 - This is continually being extended
- Copyright is enforced by filing a lawsuit in federal court to enforce your rights
 - This is not enforced for you by the government
- Relatively easy to register a work
 - Attorneys often not needed
 - File an application
 - Appropriate fees (\$45)



Trade Secrets

- To be considered a trade secret something must:
 - Be commercially valuable because it is secret
 - Be known to a limited group of persons
 - Be subjected to reasonable steps to keep it secret
- Unauthorized acquisition, use, or disclosure contrary to honest commercial practices is regarded as unfair practice and violation of trade secret protection

The Coca-Cola logo is displayed in its iconic red script font. The letters are fluid and connected, with a classic, elegant design. The logo is positioned in the lower right quadrant of the slide, set against a white background. Below the logo, there is a solid orange horizontal bar that spans the width of the slide.

Trade Secrets Contd.

- Trade secrets do not protect against independent discovery
- Backed up by two different federal laws
 - Economic Espionage Act of 1996 which makes the theft or misappropriation of a trade secret a crime
 - Defend Trade Secrets Act of 2016 which created a federal cause of action for misappropriating trade secrets

Trademarks

- Indicates the source or origin of the goods
 - Trademarks are there to protect the consumer
- Can take the form of word, slogan, name, letters, numbers, and more
- Trademarks can be broken down into Trademarks, Service Marks, Certification Marks, and Collective Marks.
- Moderately costly
 - Typical costs for registration and prosecution will run ~\$1k

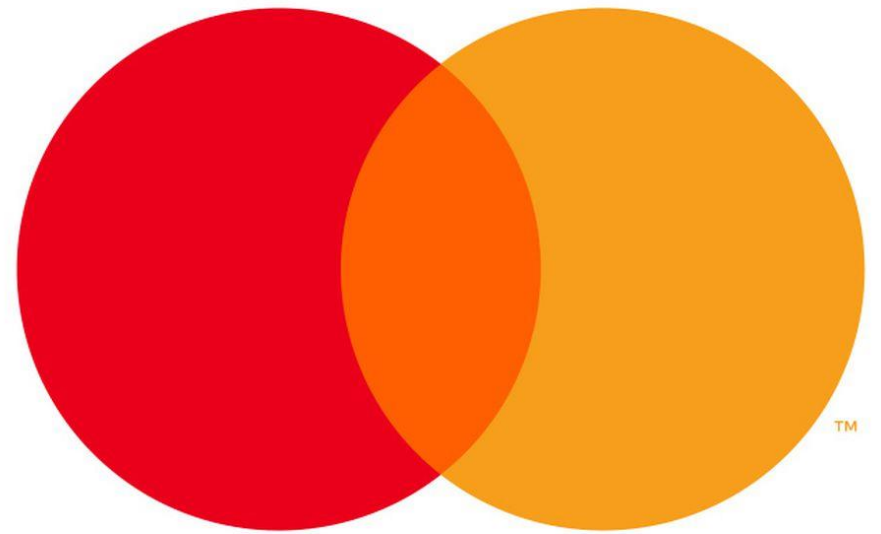
Trademark

- Identify and distinguish the goods of one company from those of another



Service Mark

- Identify a service provider



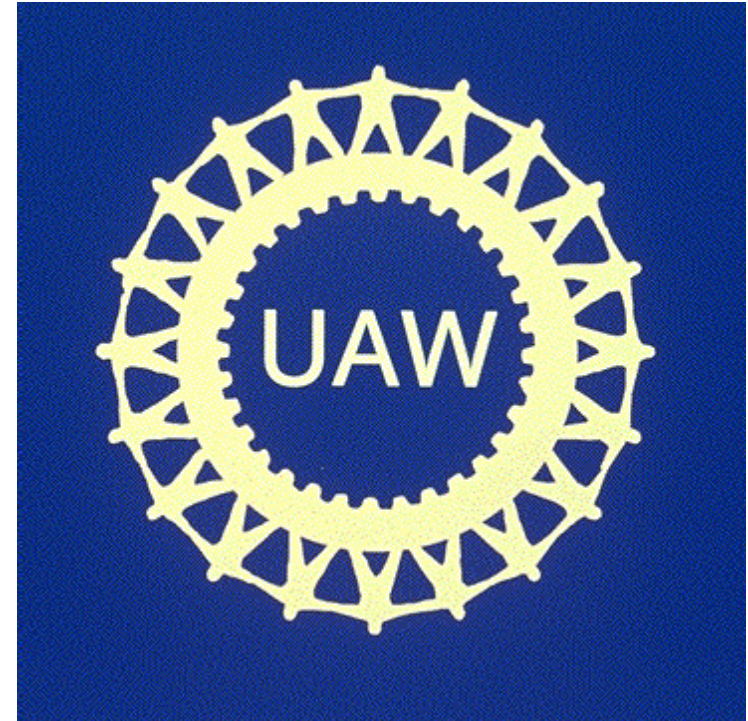
Certification Mark

- Identify a product that meets a standard or regulation



Collective Mark

- Identify members of a union, cooperative, or other collective organization



Categories of Trademarks

- Fanciful
- Arbitrary
- Suggestive
- Descriptive
- Generic

Fanciful Trademarks

- Made up words which are invented to be used as a trademark name

The Exxon logo is displayed in a bold, red, sans-serif font. The word "Exxon" is written in a stylized manner, with the two 'X's overlapping. The 'E' is a simple block letter, the 'x' is formed by two overlapping diagonal strokes, the 'o' is a solid circle, and the 'n' is a simple block letter. The entire logo is rendered in a vibrant red color.

Arbitrary Trademarks

- Words that have a real, common meaning but they are completely unrelated to the product or service



Suggestive Trademarks

- Named after a characteristic of the product/ service.



Descriptive Trademarks

- Description of the product or service



Generic Trademarks

- Generic description of the product or service
 - Dry Ice, Escalator, Linoleum, Band-Aid

How to obtain/lose a Trademark

- Must register the Mark with the USPTO and then use the Mark.
 - Registering the Mark helps thwart counterfeiting and establishes date of First Use
- Some Marks may not be Registerable
 - Marks can be contested by third parties if the third party believes it conflicts with their mark
- Marks are lost through abandonment
 - No use (3 years), failure to protect, licensing without quality control, or changing the Mark

Abandonment of a Trademark

- Trademarks not actively used, will be lost
 - The Trademark for Standard oil is owned by Chevron who maintains one standard oil gas station in each of the 16 states in which it operates



Patents

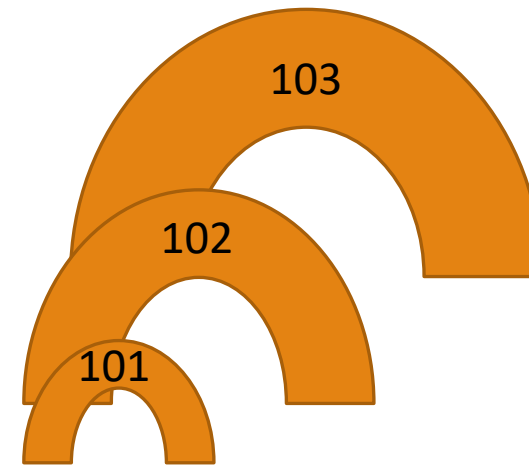
- Based on power given to Congress in the U.S. Constitution
- Patent process was revised in 2011 with the Leahy-Smith America Invents Act
 - This harmonized the U.S. process with international standards
 - Switched to a first to file system
 - Eliminated interference proceedings

Patents contd.

- Patents allow the patent owner to exclude others from making, using, selling offering for sale, or importing the protected article for 20 years from earliest filing date
 - In return, you must disclose how the device works and what the best way to use it is for everyone to see
 - As with copyrights, the government will not enforce a patent for you
 - Patents provide the strongest protection as they do not require intentional copying or misappropriation to be infringed
- Quite costly
 - Typically, \$10,000+ per invention to prepare, file, prosecute, and issue a patent
 - Similar costs for each international filing

Requirements for a patent

- The invention must satisfy the following requirements
 - 35 U.S.C. § 101 - Invention must be useful
 - 35 U.S.C. § 102 - Invention must be new/novel
 - 35 U.S.C. § 103 - Invention must be non-obvious



35 U.S.C. § 101

- “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 therefor, subject to the conditions and requirements of this title.”
- Thus, industrial machines, industrial processes, computer software, methods of doing business, medical devices, and more can all be claimed
 - Described in case law as “anything under the sun invented by man”
- This part of the statute excludes
 - Inventions which are impossible such as perpetual motion machines
 - Laws of nature, natural phenomena, and abstract ideas

35 U.S.C. § 102

- “102(a) Novelty; Prior Art.—A person shall be entitled to a patent unless:
 - 102(a)(1) the claimed invention was patented, described in a **printed publication, or in public use, on sale, or otherwise available to the public** before **the effective filing date** of the claimed invention”
- 102 covers situations where nearly the same disclosure has been patented before by someone else before you

35 U.S.C. § 103

- “A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102, if **the differences** between the claimed invention and the prior art are such that the claimed invention as a whole **would have been obvious** before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains.”
- 103 covers situations where your disclosure has been patented before by a combination of others before you and it would have been obvious to one of skill in the art to combine them

Types

- Utility patent
 - Provisional
 - Non-provisional
- Design
- Plant

Provisional Patent

- Quite inexpensive
 - \$70-\$280 (micro entities – large entities)
- Establishes a priority date
 - Priority dates are the first date that you can swear back to in order to overcome prior art
- Not examined by the patent office

Non-Provisional Patent

- Can claim to provisional if within one year
- Non-Provisionals will proceed through prosecution at the USPTO and can lead to a utility patent
 - Prosecution is where a patent attorney/agent or an inventor will argue with the patent office about why their invention is novel
- Non-Provisionals in the US must include description, preferred embodiments, drawings, and claims
 - One of the preferred embodiments must be the “best-mode”
 - The description and drawings must be “enabling” in that someone skilled in the art could perform the patent as described

Design Patent

- Legal protection on the ornamental appearance of an article of manufacture including the shape/ configuration or surface ornamentation.
- There are a few differences when compared to utility patents
 - Design patents last 15 years from date of grant
 - No maintenance fees
 - Only a single claim is allowed

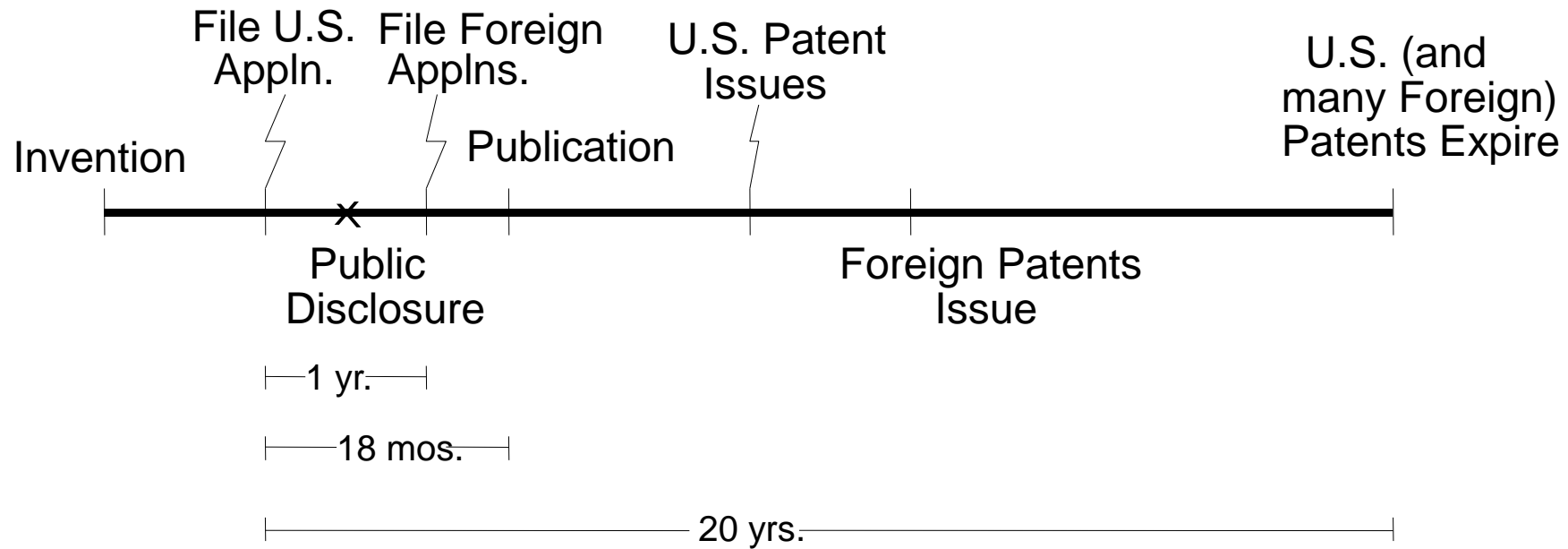
Plant Patent

- Patent given on plants that are invented and asexually reproduced
 - No plant patents on potatoes!
- Algae and macro-fungi are considered plants, but bacteria are not

Timing

- In the U.S. you have 1 year after a disclosure or offer for sale
- In foreign countries there is an absolute novelty bar
 - This means that any disclosure would bar patentability

Timing



Summary

- Four main types of intellectual property protection
 - Copyright
 - Weak, easy to obtain protection
 - Trade Secrets
 - Best for difficult to reverse engineer products
 - Trademarks
 - To protect the consumer from confusing similar products
 - Patents
 - Difficult, strong protection but must disclose everything

Questions?

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