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# Types of Intellectual Property

- Trademarks - Protect goodwill (source identifiers)
- Copyrights - Protect expression (writings)
- Patents - Protect inventions
- Trade Secrets - Protect confidential information

# Trademarks

- A word, symbol or logo that distinguishes the source of goods/services
- Consumer perception: who made or sponsored this product?
- U.S. trademark rights based on use<sup>TM</sup> – not required to register<sup>®</sup>
  - Can file based on intent to use
- Trade names may be trademarks



# Strength of Marks/Scope of Protection

- Fanciful
  - Kodak, Exxon, Google (no other meaning)
- Arbitrary
  - Apple (for computers)
- Suggestive
  - Vise-Grip, Blu-ray, Eveready, Outback Steakhouse
- Descriptive (including geographically)
  - Tasty Foods, American Airlines, Central Florida Medical Center, Dell (surname)
- Generic (not a trademark)
  - Aspirin, Escalator, Zipper, Xerox?, Kleenex? Google?



**WISE-GRIP®**

**Google**

# Why Register in the U.S.?

- Additional advantages:
  - Sue for infringement in federal courts
  - Presumption of ownership and use
  - Profits, damages, costs, attorney fees
  - “Incontestable” after five years
  - Use the ® symbol
  - Mark is placed on Trademark Register (provides notice and may “freeze” competitor)
  - Register with Customs
- Foreign jurisdictions require registration or may not be protected
- Trademark Clearance

# Proper Use of Trademarks



- Use consistently
  - Not nouns or verbs
  - Not plural, possessive, -ing

- Trademark notices ® ™

Rollerbade® Inline Skates



# TM Infringement & Defenses

- Infringement means using a trademark in a manner likely to confuse consumers
  - If viewer likely to assume affiliation with the trademark owner



- Defenses
  - No likelihood of confusion
  - Nominative/Fair use (non-trademark use)
  - Started using trademark first



# Patents

- Patents protect new, useful and non-obvious (original) inventions
- Patent grants the owner the right to exclude others from practicing the patent (making or selling the invention)
- Patent protection requires filing with government

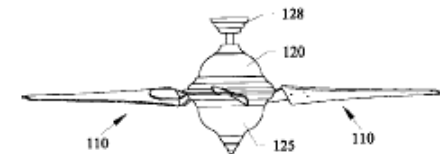


Fig. 2

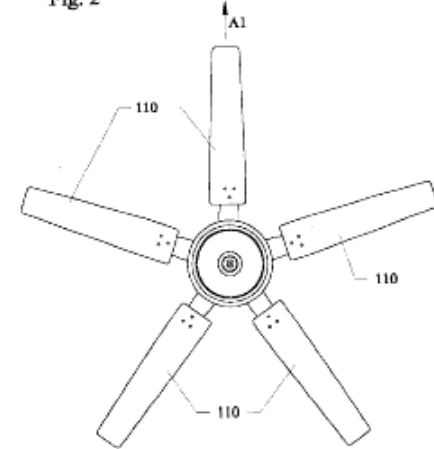


Fig. 3



# Utility Patents

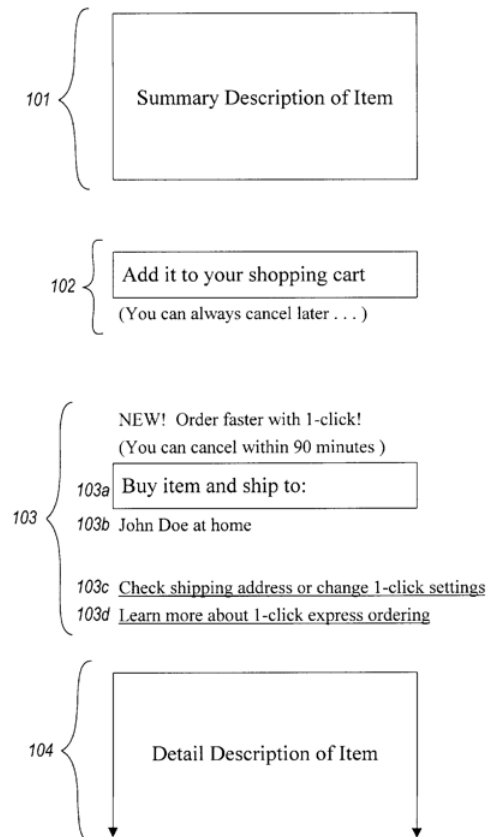
## METHOD AND SYSTEM FOR PLACING A PURCHASE ORDER VIA A COMMUNICATIONS NETWORK

U.S. Patent

Sep. 28, 1999

Sheet 1 of 11

5,960,411



- Protects functional inventions and discoveries
  - Devices, processes, chemical compositions
  - Business/software methods
- Term is 20 years from date of filing
- Scope is defined by written description of invention
- Non-patentable – laws of nature, algorithms, abstract ideas

# Design Patents

U.S. Patent

Sep. 16, 2014

Sheet 1 of 7

US D713,587 S

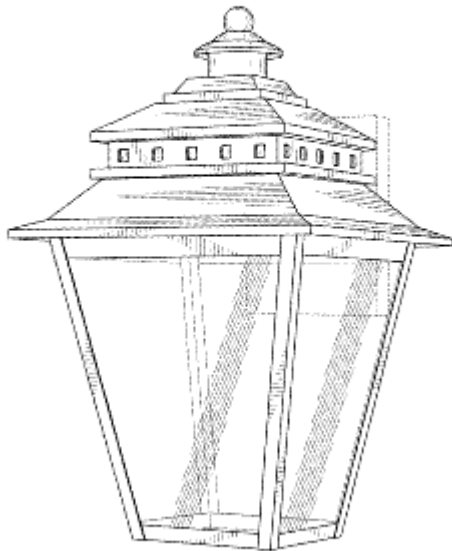


FIG. 1

- Protects ornamentation (surface decoration or shape of article)
- Manufactured items only
- Non-functional aspects only
- Term is 15 years from date of issue
- Scope is defined by patent drawings

# Inventorship/Ownership of Patent Rights

- First to file – “prior art” prevents patenting
- Each inventor owns an undivided interest
- Patent rights may be sold (assigned) or leased (licensed)
- Employees are typically required to assign their patent rights to the company-employer
  - Invention Assignment Agreement (“hereby assigns”)
  - If no agreement then employer only has a shop right – a non-exclusive, implied license – to use the invention

# Patent Infringement

- Design patents receive narrow protection – material changes can avoid liability
  - Ordinary observer of design in entirety – differences increase in importance if crowded field
- Everyone possessing or using infringing item is potentially liable
  - Get indemnity from suppliers
- Cannot violate patent by discussing or depicting invention in photo



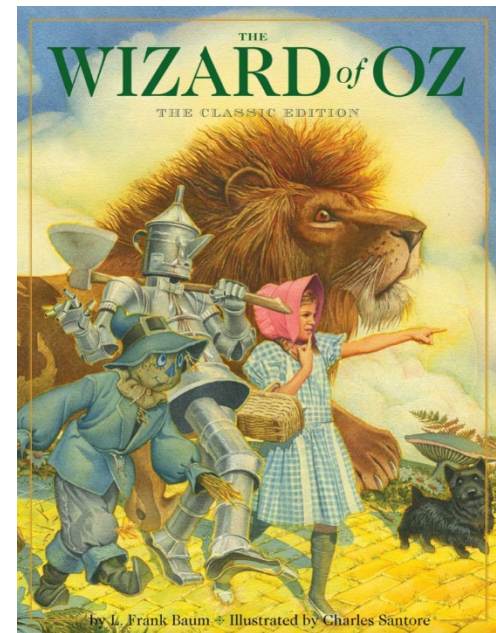
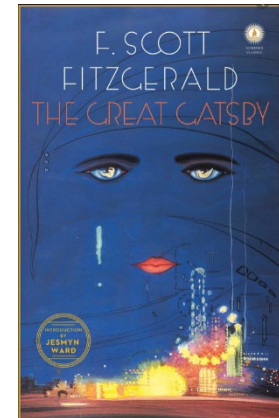
# Copyrights

- Works of Authorship

- Books, pictures, sculpture, music, videos
- Fabric designs, carpet patterns, ads, photos, literary characters

- Not covered by copyright

- Ideas (only expression of ideas)
- Facts
- Phrases and slogans
- Names
- Functional items or useful articles



# Copyright Protection



- Author is initial owner
- Term
  - Life of author plus 70 years
  - Works for hire are 95 years from publication
  - Older copyrights have different terms
- Protection automatic - registration is not required
- Berne Convention gives foreign protection



# Copyright Infringement

- Prevent copying, modifying, distributing, publicly displaying
- Intent doesn't really matter
- Test is substantial similarity – no 20% rule
- Defenses
  - Licensed
  - Independent creation
  - Public domain
  - Fair Use
    - Criticism, comment, scholarship, teaching



# Photographs

- Photographer owns copyright in photo
- Others can own copyright in items in photo
  - Sculpture and artwork (moral rights)
  - Fabric and carpet patterns
- People in photo have a right of publicity
- Trademark owners have rights in logos and trademarks depicted in or on items



# Internet Content

- COPYing content from the internet is likely copyright infringement
  - Interim copies count
  - Lack of copyright notice does not matter
  - Use of content in violation of website Terms of Use can also be breach of contract
- Linking to content is probably not infringement

# Works Made for Hire

- Works made by an employee in the scope of her duties
- Most works developed by third parties will not be works for hire
  - Need contracts explicitly assigning/licensing rights in developed materials and ideas (“hereby assigns”)
  - If no agreement then hiring party only has non-exclusive, implied license – factually specific question about scope of that license

# Trade Secrets

- Protects confidential information
  - Creative ideas
  - Customer and supplier lists
  - Pricing and financial information
  - Software
  - Business plans & strategies
  
- Not protected
  - Publicly available information
  - Information that can be reverse-engineered



# Trade Secret Protection

- Uniform Trade Secrets Act / Defend Trade Secrets Act
- Must implement reasonable secrecy measures
- Potentially unlimited duration as long as maintain secrecy
- Misappropriation claim
- Inevitable disclosure doctrine



# Non-Disclosure Agreements

- Purpose
  - Demonstrate taking reasonable secrecy measures for trade secrets
  - Provide a breach of contract claim even if not a trade secret (know-how)
  - Deterrence effect (can't put cat back in the bag)
- Important to have in place before disclosing confidential concepts or ideas
- Venture capital usually will not sign

# Confidentiality Legends

- Mark proprietary written materials with a legend to preserve trade secret protection
- Puts viewer on notice of confidential relationship

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