

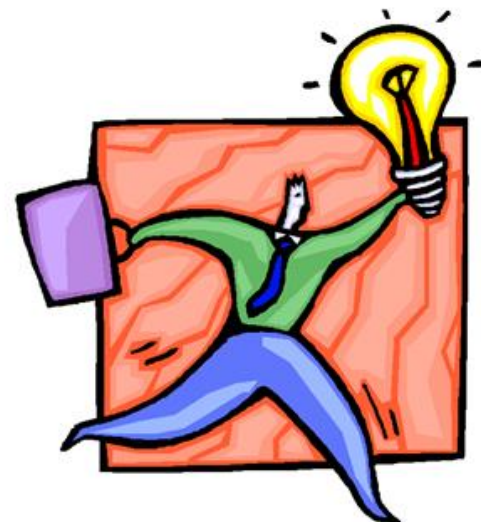
IP 101: The Basics

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IP BASICS

The Big 3:

- Copyright
- Trademark
- Patent

and Trade Secrets



Trade Secrets



Information that...

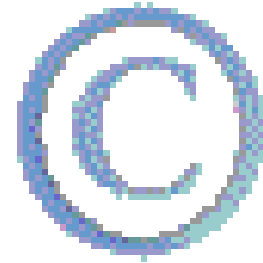
- is secret
- has economic value
- is not readily ascertainable by proper means
- is subject to reasonable efforts to protect

Trade Secrets



- no filings
- no expiration date
- have to control access
- risk of independent discovery (reverse engineering)

Copyrights



What is a copyright?

- A bundle of rights protecting an original work of authorship fixed in any tangible medium of expression

U.S. Constitution, Art. 1, Sec. 8, Cl. 8
17 U.S.C. § 101 *et seq.*

Copyrights

- To be protected by copyright, a work must contain at least a certain minimum amount of authorship in the form of original literary, musical, pictorial, or graphic expression.



Copyrights

What is copyrightable?

- Literary works
- Musical works
- Dramatic works
- Sound recordings
- Architectural works
- Computer software
- Pantomimes and choreographic works
- Pictorial, graphics and sculptural works
- Motion pictures and audiovisual works



Copyrights

Computer Program

- Set of statements or instructions to be used directly or indirectly in a computer in order to bring about a certain result

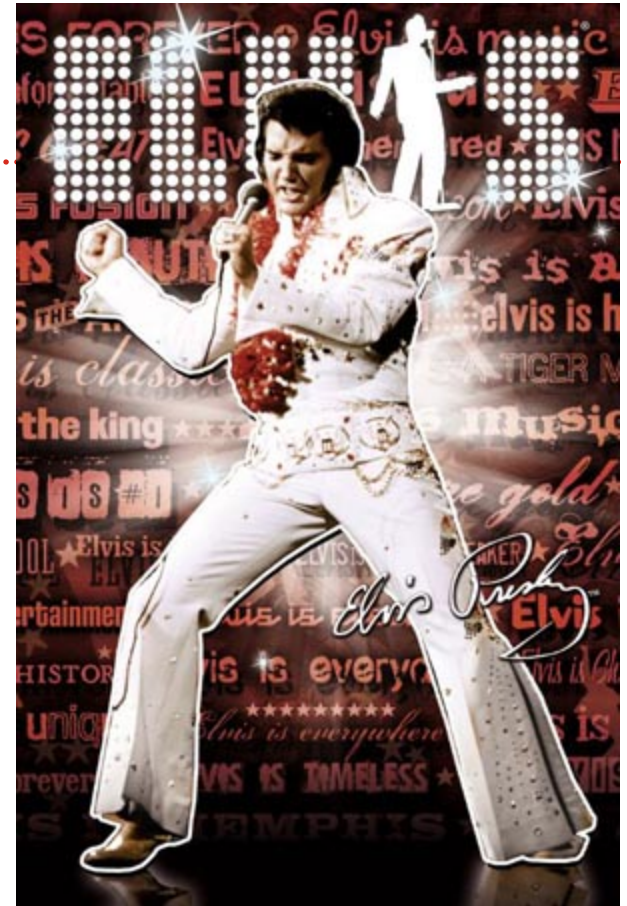
Protects that *particular expression* of the set of statements or instructions, *not what the program does*



Copyrights

What is NOT copyrightable?

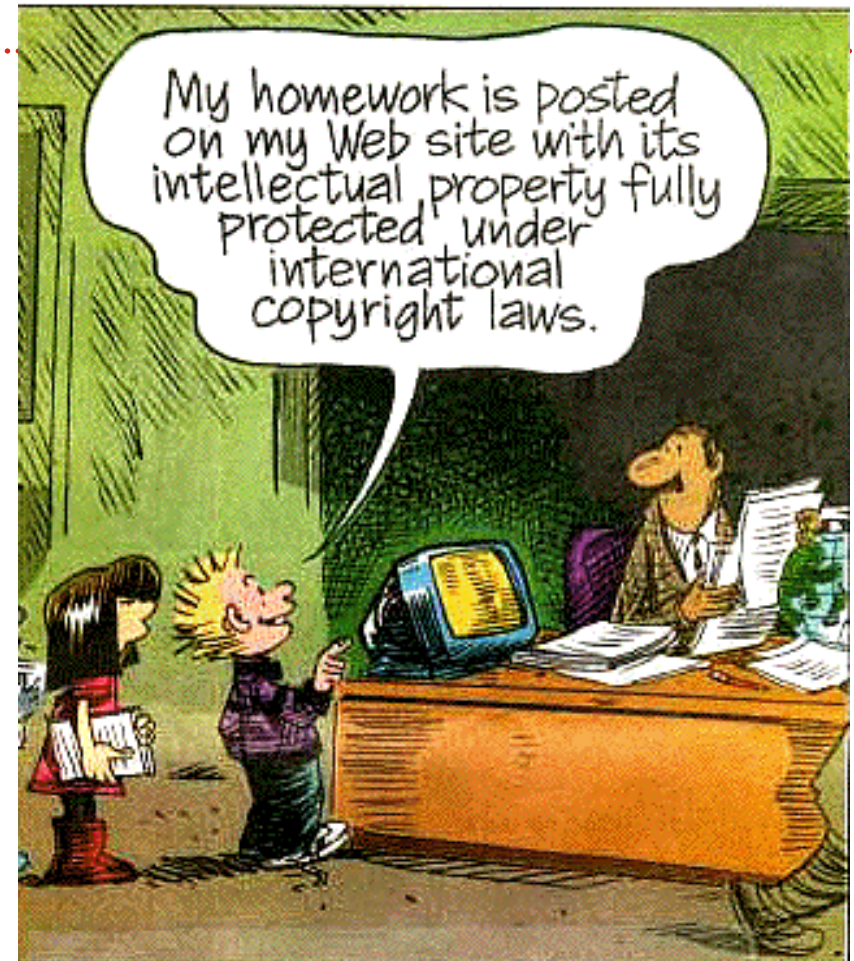
- Names
- Titles
- Slogans, short phrases
- Domain names
- Facts, ideas, systems, methods
- Recipes (mere listing of ingredients)
- Clothing designs
- Sightings of Elvis



Copyrights

Creation

- Copyright automatically exists as soon as work is created in “fixed form”
- Registration with U.S. Copyright Office is not required, but brings benefits:
 - Ability to bring infringement action
 - Timely registration allows recovery of statutory damages and attorneys fees
 - Prima facie evidence of validity of copyright



Copyrights



WORK IN PROGRESS

Work For Hire

- Work prepared by an *employee* within scope of employment
- Work specially ordered or commissioned, *expressly agreed in written instrument*, for one of following:
 - Contribution to collective work
 - Part of motion picture or other AV work
 - Translation, Supplementary work
 - Compilation, Instructional text
 - Test, Answer material for a text, Atlas

***Get a written assignment, or
you may not own it!!***

Trademark

TM



What is a trademark or service mark?

- Any word, name, symbol, device, or combination thereof either used or intended to be used by a person to identify and distinguish goods or services from those of others and to indicate their source of origin

15 U.S.C. § 1051 *et seq.*

Trademark

Levels of Distinctiveness

- Fanciful or Coined
- Arbitrary
- Suggestive
- Descriptive
- Generic



Trademark

Fanciful or Coined

- Letters that form a word without meaning, has no relation to the product
- “Short, Vigorous, Easily Spelled and Meaningless”
- Strongest type of mark
- E.g., KODAK, EXXON

Problem: Can become generic (“genericide”)



Trademark

Arbitrary

- One or more words whose common meaning has nothing to do with the goods or services being labeled
- Strong mark
- E.g., APPLE, used for computers



Apple Computer

Trademark

Suggestive

- One or more words that hint at or suggest the nature of a product without actually describing it (“allusive”)
- Requires a mental step before association between mark and product is understood
- E.g., CITIBANK financial services; GREYHOUND bus lines



Trademark

Descriptive

- Words that merely describe the product or its components or ingredients, or its geographic origin
- Very weak; protectable as trademark only if can establish that term has acquired “secondary meaning” (expect at least 5 years and a big advertising budget)
- E.g., **HOMEMAKER** home care services; **APPLE PIE** potpourri



Trademark

Generic

- Words that designate the “genus” of the product or what the product is
- Cannot trademark
- E.g., THERMOS, ASPIRIN, CELLOPHANE, ESCALATOR, ZIPPER



Trademarks

Creation

- Trademark rights conferred by use in commerce
- Registration with U.S. Patent and Trademark Office is not required, but brings benefits:
 - Nationwide notice
 - Can achieve incontestable status



JCW Investments v. Novelty, Inc.
482 F.3d 910 (9th Cir. 2007)

Copyright and Trademark Infringement

“Pull My Finger Fred”

Pull My Finger Fred

Plush doll

White, middle-aged, overweight man with black hair, receding hairline, sitting in an armchair with white tank top and blue pants



Pull My Finger Fred

- “Did somebody step on a duck?”
- “Silent but deadly”
- “Mmmmmm.....fruity!”



Pull My Finger Fred

- Copyright registration (Feb. 5, 2001)
- Trademark registration (Reg. 2532263)
 - “Pull My Finger”
 - “Plush Toy with electronic action”

“Pull My Finger”

- Other trademark registrations
 - Compact Discs featuring the sounds of intestinal gas expelling from the body
 - Bowl, Soup Bowls, Sugar Bowls
 - Beans, peas
 - Entertainment services, motion picture film
 - Beer
 - Cosmetics, skin and hair care products

Pull My Finger Family

“Pull My Finger Frankie”



Pull My Finger Family

“Pull My Finger Gascar Driver”

“Ooooh...a backfire!”

“Aaaaah...I blew a tire!”



Pull My Finger Family

“Pull My Finger Fat Bastard”

“Get In My Belly!”



Pull My Finger Family

“Pull My Finger President”

*“Hey Sadaam...here’s a
weapon of mass
destruction!”*



Not in the Pull My Finger Family

“Fartman”

“...could be Fred’s twin. Fartman, also a plush doll, is a white, middle-aged, overweight man with black hair and a receding hairline, sitting in an armchair wearing a white tank top and blue pants.”



JCW Investment v. Novelty, Inc......

- JCW sues for copyright and trademark infringement
- Wins summary judgment on liability
- Jury awards damages

JCW Investment v. Novelty, Inc.

- \$116K for copyright infringement
- \$125K for trademark infringement
- \$50K in punitive damages
- \$575K in attorneys fees



Patents



What Is A Patent?

- *Set of exclusive rights granted to an inventor for a fixed period of time in exchange for the regulated, public disclosure of the invention*

U.S. Const. Article I, Section 8, Cl. 8

35 U.S.C. § 1 *et seq.*

Exclusive Rights

- Right to *exclude* others from making, using, selling, offering to sell the invention within the U.S., or importing into the U.S.
- Does not give inventor the right to make, use, sell, offer to sell



What Can I Patent?

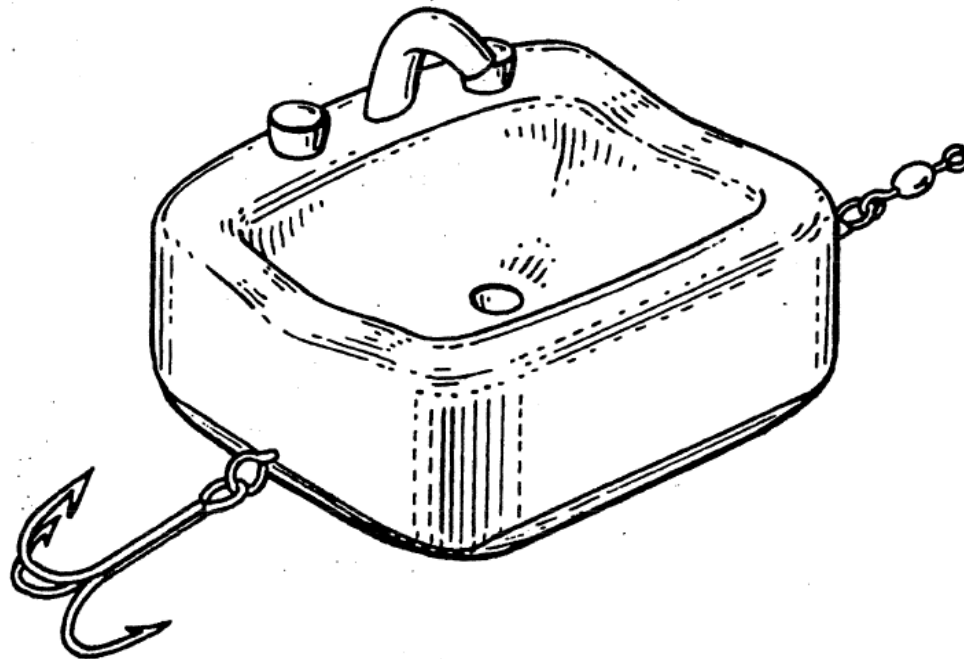
- **Plant** – protects certain types of plants
- **Design** – protects the ornamental (non-functional) appearance of an article; the way it looks
- **Utility** – protects a useful article; the way it works or is used



Design Patents

FISHING LURE

US D274,350 (1984)

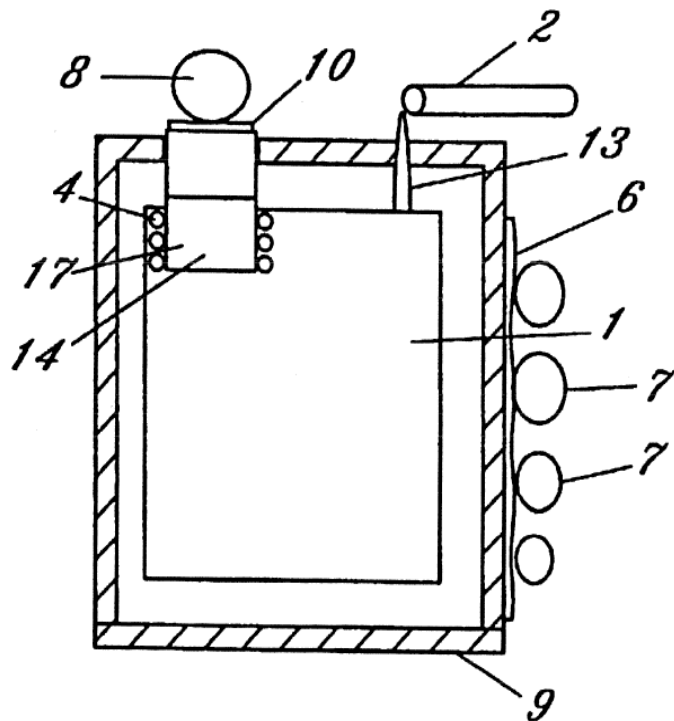


The ornamental design for a fishing lure, as shown.

Utility Patents

SMOKING CESSATION LIGHTER AND METHOD

US 5,871,518 (Feb. 16, 1999)



It delivers a shock to the user's hand when the lighter is extinguished....The anticipation of the shock will negate the anticipation of the relief the drugs in the smoke provide. In yet another embodiment...a pin pricks the user at the time of activation of the lighter.

Utility – *Requirements*

- Patentable Subject Matter
- Utility (i.e., useful)
- Novelty (i.e., new)
- Not obvious



Utility-Subject Matter



- Machine
- Manufacture (Article of Manufacture)
- Composition of Matter
- Process (Method)

Patentable Subject Matter

- **CANNOT patent:**
 - *scientific truths, laws of nature*
 - *mathematical expressions*
 - *algorithms*
 - *abstract ideas*
 - *physical phenomena*



Novelty

- **Inventor Can Destroy Novelty**
 - public use or disclosure of invention
 - prior sales or offers for sale

U.S. – 1 year prior to filing

Foreign – absolute novelty bar

Unlike copyrights and trademarks, you must timely file with the U.S. PTO in order to have patent rights!

Starting the Time Bomb

- Journal article
- Newspaper article
- Emails
- Submission of proposal
- Report to research sponsor
- Poster presentation
- Oral presentation with handouts or slides
- Thesis catalogued and placed on shelf



Ownership

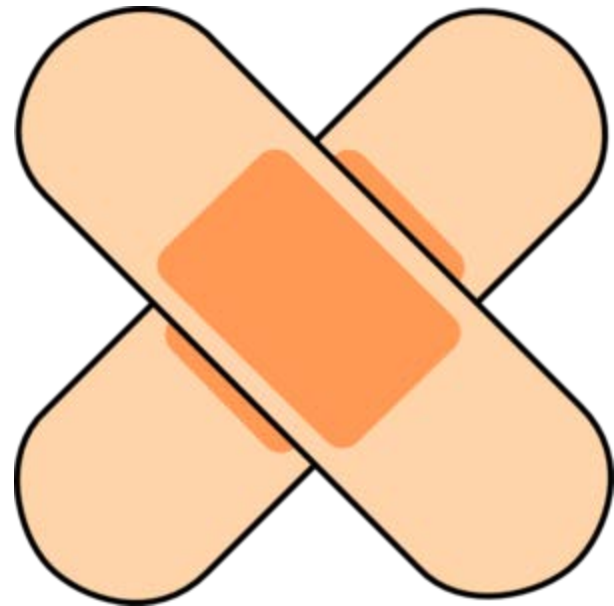
- In U.S., only individuals can be inventors (not corporations, entities)
- Inventors can assign the patent to any entity
- Each inventor owns full rights to invention without an obligation to the other inventors
- No “work-for-hire” doctrine



Get assignment or obligation to assign IP rights in agreement!

Patent Reform

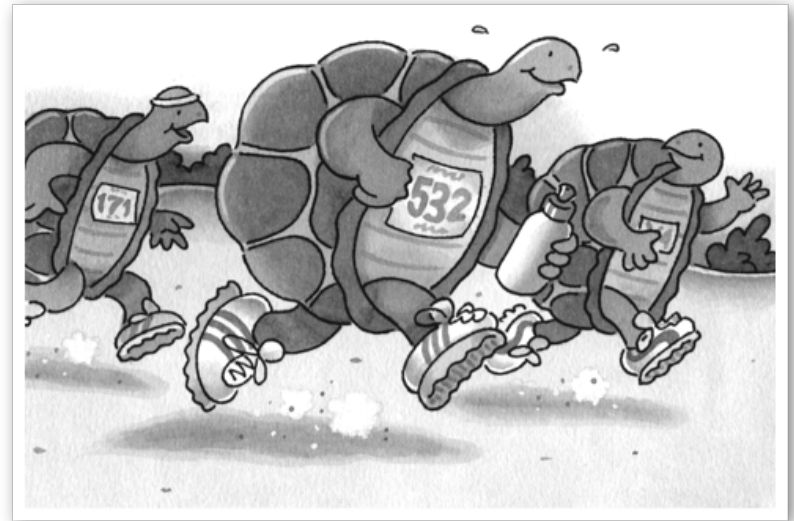
- Signed by President Obama on Sept. 16, 2011
- Melange of changes (major and minor)



Patent Reform

It's Not Really “First-to-File”

- “First-to-Publish” can beat “First-to-File”



File Early, File Often!

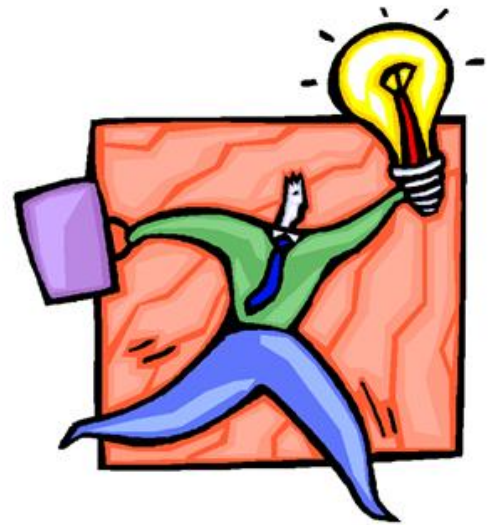
Provisional Patent Application

- Lower cost, quick alternative
- No claims required
- No particular format
- Provides earlier effective filing date, permits use of “patent pending” status
- Not examined, does not issue into a patent
- Must file full utility application within one year



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They Patented That??

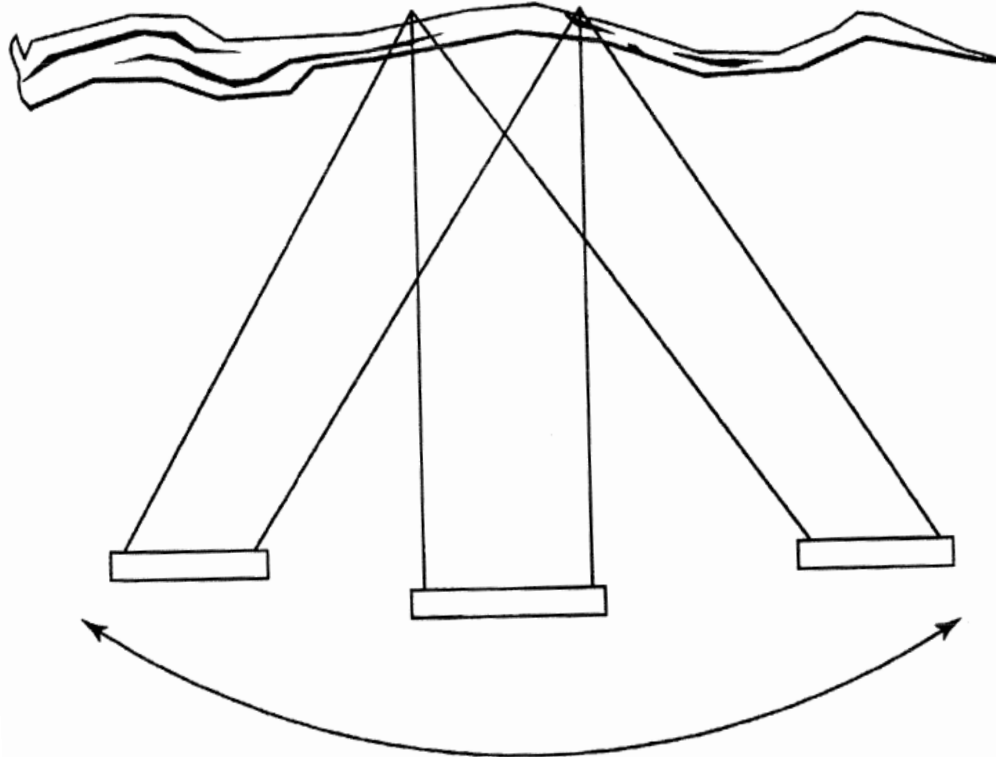


BAKER DONELSON

EXPAND YOUR EXPECTATIONS™

METHOD OF SWINGING ON A SWING

Olson, US 6,368,227 (Apr. 9, 2002)

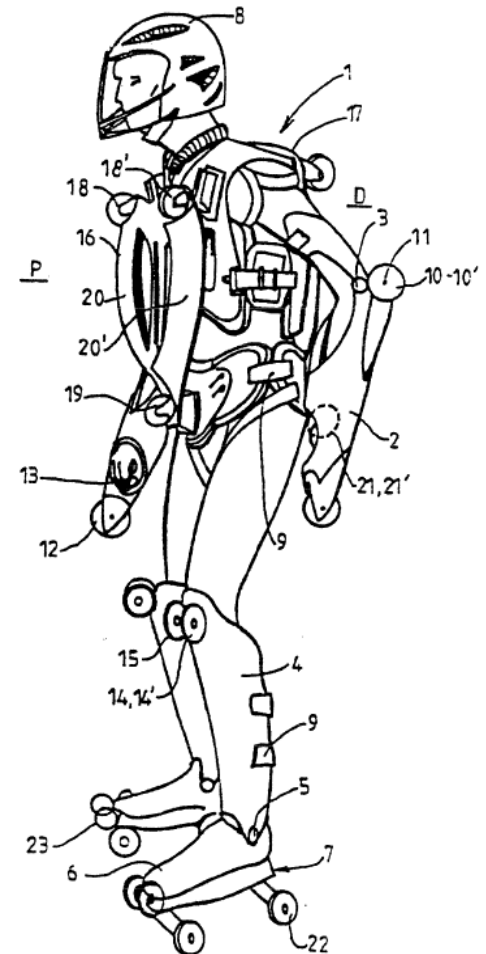


A method of swing[ing] on a swing is disclosed, in which a user positioned on a standard swing suspended by two chains from a substantially horizontal tree branch induces side to side motion by pulling alternately on one chain and then the other.

ARMOR WITH ROLLERS

Blondeau, US 5,926,857 (Jul. 27, 1999)

An armor with rollers is provided that enables a user to move in all positions by rolling on a hard and smooth surface while constantly varying his bearing points on the ground.



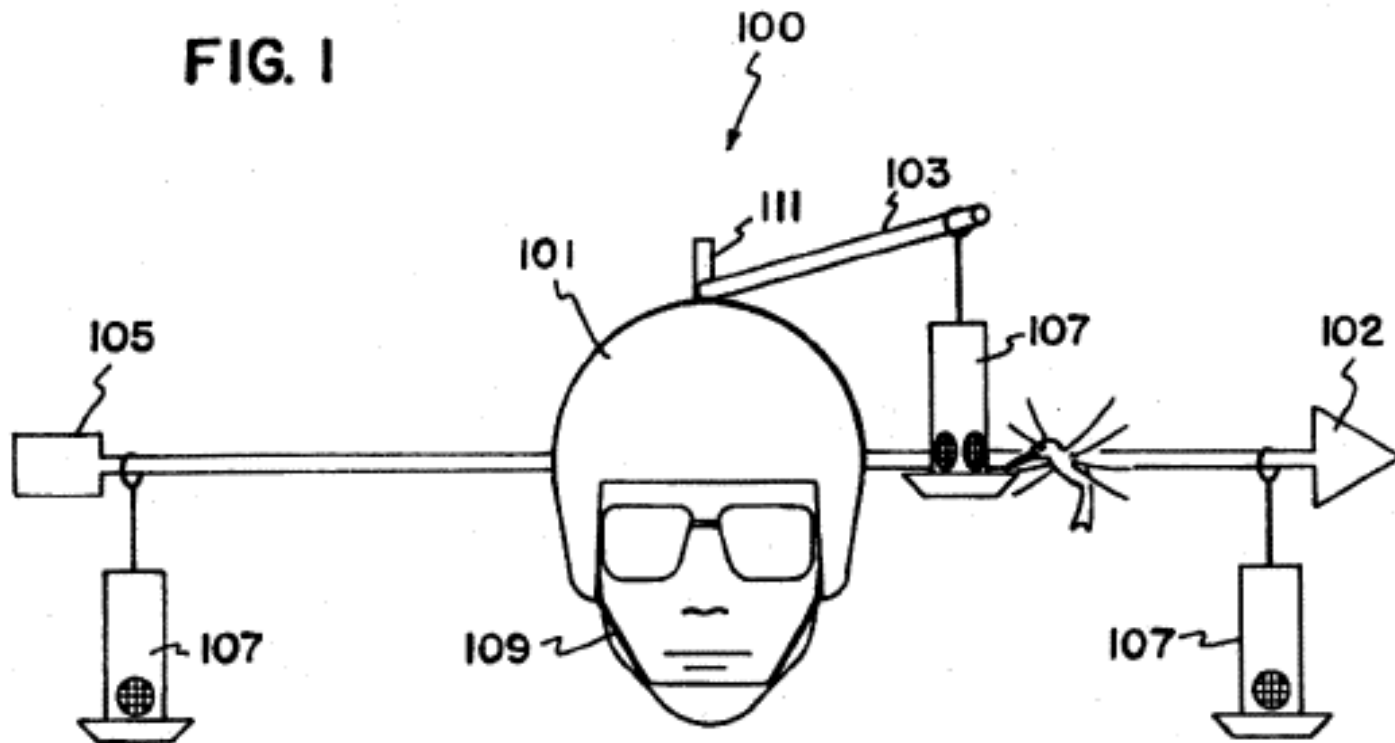
WEARABLE DEVICE FOR FEEDING AND OBSERVING BIRDS AND OTHER FLYING ANIMALS

Leslie, US 5,996,127 (Dec. 7, 1999)

The device may comprise a helmet with three poles mounted on it and extending outward from the helmet, and a feeder hanging from each of the poles.

US 5,996,127

FIG. I

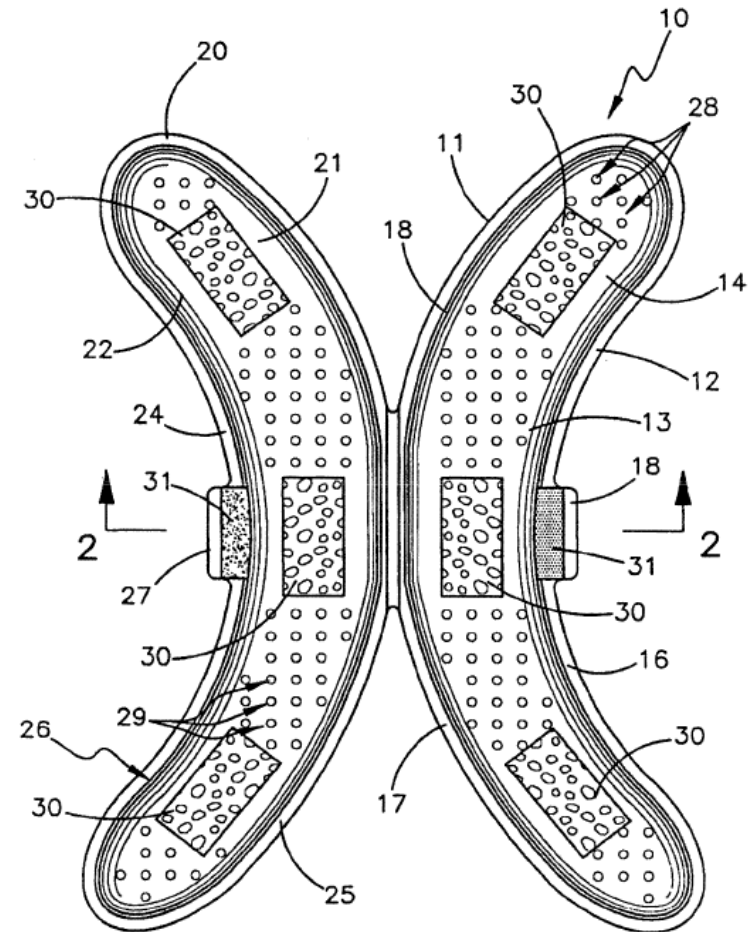


Optionally, a pole may enter the helmet from one side and exit on the other side, whereby a single pole will extend in two directions from the hat.

BANANA PROTECTIVE DEVICE

Agulnik, US 6,612,440 (Sept. 2, 2003)

The use of a banana guard is known in the prior art. More specifically, a banana guard heretofore devised and utilized are known to consist basically of familiar, expected and obvious structural configurations, notwithstanding the myriad of designs encompassed by the crowded prior art which have been developed for the fulfillment of countless objects and requirements.



USER-OPERATED AMUSEMENT APPARATUS FOR KICKING THE USER'S BUTTOCKS

Armstrong, US 6,293,874 (Sep. 25, 2001)

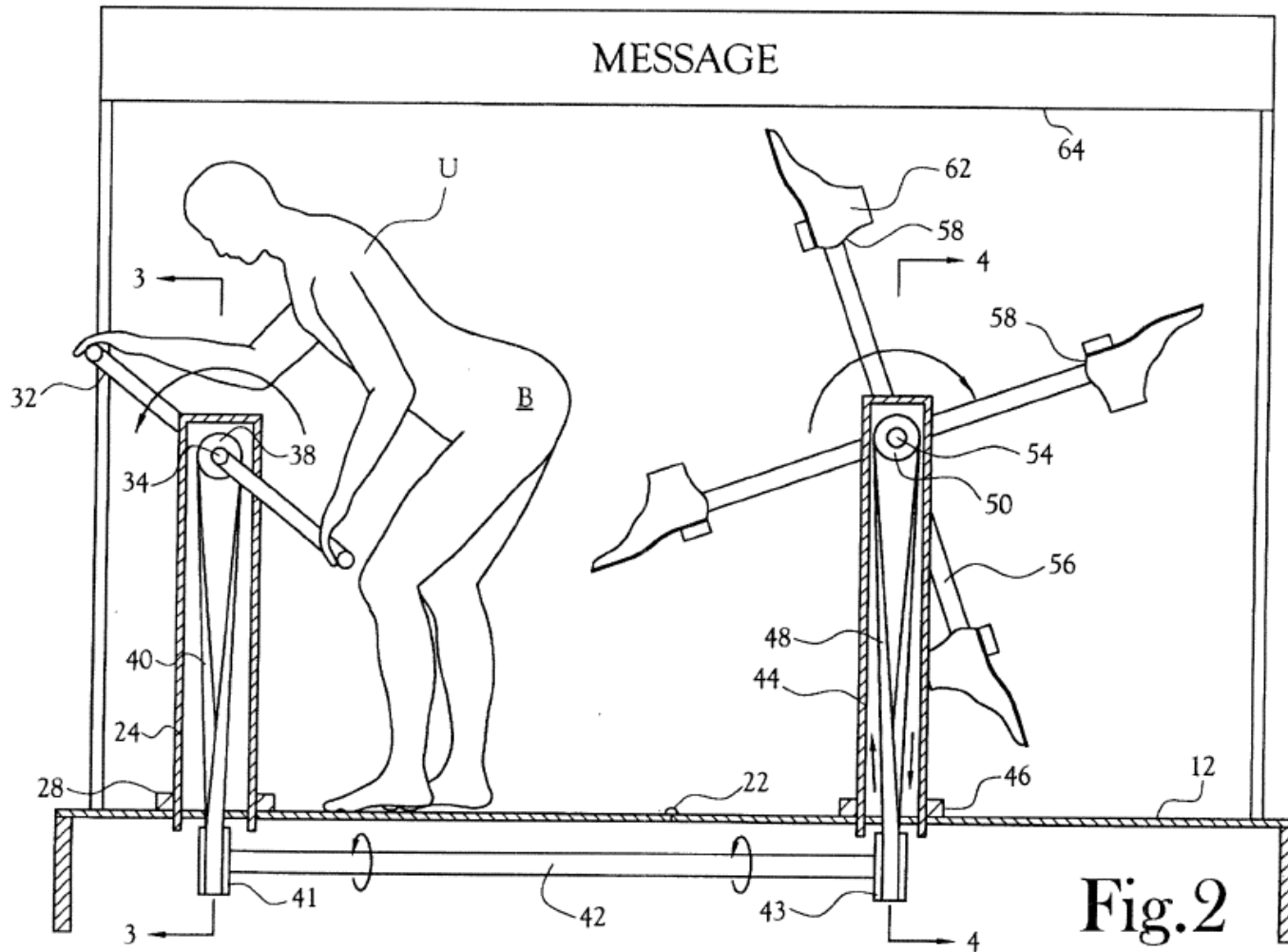


Fig. 2

Contact Us

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