Intellectual Property
Patents, Trademarks, Copyrights and Matters of Unfair Competition

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Where do Intellectual Property Rights Come From?

Article 1, Section 8, Clause 8 of the US Constitution authorizes that:

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

COPYRIGHTS

Title 17 of the US Code

Protect the creative materials, not the ideas

Copyright protection is available for original works of authorship that are fixed in a tangible form, whether published or unpublished Arises when it is in fixed medium

Copyright law only covers the particular form or manner in which information or ideas have been manifested, known as the "form of material expression." The law does not cover the actual ideas, concepts, facts, or techniques contained in the copyright work

The scope of copyright law is set forth in the Copyright Act of 1976. The law lists 8 categories of works that are appropriate for copyright. These include

Literary works; speeches
Musical Works and their words;
Dramatic works and their music theatre performances
Pantomimes and choreographic works;
Pictorial, graphic and sculptural works;
paintings sculptures photographs
Motion pictures and other audiovisual works;
Sound recordings; and
Architectural works
Computer programs

A Copyright Owner's Rights

As exclusive rights, including the right to:

- Reproduce the work
- Prepare "derivative works" (other works based on the original work)
- Distribute copies of the work by sale, lease, or other transfer of ownership
- Perform the work publicly
  - MORAL RIGHTS
- Display the work publicly
- Authorize others to use the rights- can be exclusive transfer of less than the full license

Term of Copyright

Current term of copyright for an individual life of author plus 70 years

Work made for hire" and anonymous and pseudonymous works have protection for 95 years from the publication date or 120 years from creation, whichever expires first

MICKEY MOUSE 1928 to 2003 would have expired
Changed from 75 to 95 years

Copyright Infringement

17 usc 501 provide that anyone who violates any of the exclusive rights of a copyright owner as provided in sections 106 through 122, or the author as provided by 106(a), or who imports copies or phono records … is an infringer of the copyright or right of the author.

17 USC 502 provides for injunctions against infringement;

17 USC 503 provides for impounding and disposition of infringing articles;

17 USC 504 provides for damages and profits:

(a)an infringer of copyright is liable for either

- (1) the copyright owner's actual damages and any additional profits of the infringer, as provided by subsection (b); or
- (2) statutory damages, as provided by subsection (c).

FAIR USE

- Criticism;
- Comment;
- News reporting;
- Teaching, includes making copies for use in the classroom;
- Scholarship and research;
- Parody
  - Small quote
  - Effect on Market value
  - Religious
  - Educational

The Fair Use Four-Factor Test

Courts consider four factors when evaluating whether an unauthorized use of copyrighted material is fair:

- **The purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes:** Is the use transformative? Did the new expression change the original work, or did the use create new information or lead to new ideas? The more transformative a new work, the more likely a court will consider it fair use.

- **The nature of the copyrighted work:** Courts look at whether the copyrighted work is creative or factual and whether it is published or unpublished. Creative works, such as fiction, creative nonfiction, pictures, and graphic works, typically receive more protection; factual works, such as history accounts and scientific works, receive less protection because of the benefit to society from the exchange of ideas.

- **The amount and substantiality of the portion used in relation to the copyrighted work as a whole:** Courts consider how much material was copied and whether the copied material a central part of the original work. For parody, however, it is acceptable to borrow a large portion and to use the central part of the original work.

- **The effect of the use upon the potential market for or value of the copyrighted work:** A court will look closely at a use that deprives a copyright holder of income, regardless of whether the new material is competing in the same market. Important factors include the current market and the potential market.

Courts may use additional factors to determine whether the unauthorized use of copyrighted material is fair.

Registering Your Copyright

Registration with the U.S. Copyright Office is not necessary to secure copyright protection in a work; however, it does have its advantages:

Registering your copyright provides a public record of the copyright claim.

Copyright registration is also necessary (for works of U.S. origin) before a copyright owner can file an infringement lawsuit in court.

If you register your copyright within 3 months of publishing the work or before an infringement occurs, you may realize attorney's fees and statutory damages in lawsuit.

Copyright Notice
© Author or transferee and date

Although previously a requirement under United States law, a copyright notice is no longer required in accordance with the Berne Convention (for any work created after March 1989). Please keep in mind, however, that a notice of copyright can still benefit the copyright owner.

First of all, it gives notice to the public that the work is under copyright protection. It also notifies the public who the copyright belongs to and the year in which the work was first published. It's also easy to add the copyright notice because it doesn't require the copyright holder to seek any kind of permission to include the notice or to register with the Copyright Office. The final reason a copyright notice is a good idea is because it prevents a defendant from claiming an innocent infringement defense (a claim that it was an "accidental" infringement) in a copyright infringement case.

Digital Millennium Copyright Act

The DMCA makes it a criminal act to produce and disseminate devices, services, or technology that evades measures that control access to copyrighted works

The law also makes the act of circumventing an access control a crime, even if there was no actual copyright infringement, and increases the penalties for any copyright infringement that is done on the Internet

The DMCA also addresses the role of online service providers in copyright infringement. The law does not hold Internet service providers directly or indirectly liable for any copyright infringement that occurs through the use of their services, provided they adhere to certain guidelines. One action required of online service providers is to block access to or remove infringing material when they receive notice of an infringement claim from a copyright owner

WEBSITES

Make sure you own and not website designer Have a “work for hire” agreement;

TOP level Domain names

Multiple domains should be purchased

WHOIS

Make sure you get copyright and source code material to web site design

Make sure you have rights to material from your IT people and web site designer.

Permissions

Clearinghouses and collectives are organizations that license works and grant permission for their members. They are good sources for permission information.

It is wise to familiarize yourself with these organizations' websites, so that you can turn to them when obtaining permission to use protected material.

Not only are **Clearinghouses and collectives** sources that can grant you permission for use, but they can be used to find contact information for songwriters, artists, authors, and photographers.

Organizations such as National Music Publishers' Association, Corbis, and the Cartoonbank can assist you

Trademarks

Title 15 of the US code regulates commerce and trade, where chapter 22 regulates TMs (§§ 1051-1141n)

A trademark includes any word, name, symbol, or device, or any combination, used, or intended to be used, in commerce to identify and distinguish the goods of one manufacturer or seller from goods manufactured or sold by others, and to indicate the source of the goods. In short, a trademark is a brand name;

Trademarks are not limited to a name, tagline or logo, but also embody patterns, symbols, expressions, catchphrases, and even jingles.

Olympic runner Mo Farah registered his "Mobot" as a trademark.

Author of "Tarzan of the Apes" Edgar Rice Burroughs registered a trademark for the Tarzan yell. "The mark is a yell consisting of a series of approximately ten sounds, alternating between the chest and falsetto registers of the voice."

What is a service mark?

A service mark is any word, name, symbol, device, or any combination, used, or intended to be used, in commerce, to identify and distinguish the services of one provider from services provided by others, and to indicate the source of the services.

There are 34 goods classes (IC 001-034) and

11 services class (IC035-045)

https://www.uspto.gov/trademark/trademark-updates-and-announcements/nice-agreement-current-edition-version-general-remarks

Acquiring Trademark Rights

Trademark rights are **acquired** by being the first to use the mark in commerce. The first user of the mark on goods in commerce creates an association with consumers, and **trademark laws** are intended to protect the consumer by avoiding confusion and enabling companies to compete fairly.

A **common law trademark** is a type of infringement **protection** for intellectual property wherein the property is used in commerce before it's federally registered. The U.S. **common law trademark** starts when you use the mark in commerce for the first time within a geographic area.

Do I have to register my trademark?

No, but federal registration has several advantages, including notice to the public of the registrant's claim of ownership of the mark, a legal presumption of ownership nationwide, and the exclusive right to use the mark on or in connection with the goods or services set forth in the registration.

What are the benefits of federal trademark registration?

Constructive notice nationwide of the trademark owner's claim.

Evidence of ownership of the trademark.

Jurisdiction of federal courts may be invoked.

Registration can be used as a basis for obtaining registration in foreign countries.

Registration may be filed with U.S. Customs Service to prevent importation of infringing foreign goods.

How do I find out whether a mark is already registered?

You may conduct a search free of charge on the USPTO website using the Trademark Electronic Search System (TESS).

https://www.uspto.gov/trademarks-application-process/search-trademark-database

Click on “Search our trademark database (TESS)

Click on “basic Word Mark Search (New User)

Type of TMs/SMs

TMs/SMs can be described as one of four types:

- Generic (e.g., “cellophane tape”)
- Descriptive (e.g., “buns and burgers” for a burger grill)
- Suggestive (e.g., “Burger King” for a burger grill)
- Coined (“MacDonald's” for a burger grill)

Please note, however, that surnames and geographic names cannot be registered;

Coined marks and suggestive marks can be registered, but descriptive and generic cannot; However, marks that are deemed descriptive under section 2(e)(1) of the trademark act may be shown to have secondary meaning after 5 years of continuous use

How to identify a TM or SM

With a US registration, a mark is identified with the encircled, superscripted R: ®

Under the common law, a mark that is identified with a superscripted TM or SM indicates to the world that the use is in a proprietary trademark/ service mark sense

TMs and SMs only exist by use in association with goods or services, i.e., stamped on trade dress or the goods themselves, or using some kind of media positioned close to the goods, or in association with the services

What is the cost for registering a TM or SM

For both “intent to use” applications (filed under section 1(b) of the trademark act), and “in use” applications (filed under section 1(a) of the trademark act), the cost for filing is $275/class using the TEAS reduced fee form;

If one files under an “intent to use” application under section 1(b) of the trademark act, the mark must be used in commerce at some point, post-filing for a registration to issue. At that point (i.e., use in commerce), a statement of use (SOU) must be filed, at a cost of $100/class. A “specimen,” evidencing how the mark is used in commerce with the respective goods or services, must be uploaded with the SOU;

One requirement for registration is that there is no likelihood of confusion

Is it likely that a customer will buy a product, believing he or she is buying somebody else's product?

Are the products the same kind of item?

Is it likely that a customer will believe that a particular entity has sponsored or approved the item bearing the mark?

Are the two entities using the mark competing with each other for business?

Do the two entities sell their product in the same sorts of stores?

Do the two entities sell their product to the same kind of customers?

How much do the two products cost? (This is a good way to determine whether a product is a knock-off as well.)

More on Likelihood of Confusion

How do the two entities advertise and inform customers about their products? Are they doing similar marketing?

Does one entity use the same mark on several different kinds of products?

Are the two products closely related? This question might arise in a situation like the following example: one entity using the mark sells cosmetics and the other entity sells hair do-dads. Both products are be found in the "Health and Beauty" department of a drug store or discount store, sometimes in the same aisle. Even if the products are different, they are closely related. But if one entity uses the mark on cosmetics and the other uses the mark on trailer hitches, a good argument could be made that the products are not closely related, not marketed in the same way, and not purchased by the same kind of customer.

How much are the marks alike?

When spoken out loud, do they sound the same?

'Trade Dress' Protection for Web Pages

Web pages fall more readily under the concept of "trade dress." This concept refers more broadly to a product's physical appearance, including its size, shape, texture, color(s), graphics, and other characteristics..

Trade dress must **be distinctive**, either because it **is inherently distinctive, or because it has acquired distinctiveness over time through public recognition.** Second, the trade dress must be nonfunctional. Third, and finally, the trade dress of the defendant (person being sued) must be likely to cause confusion as to the source of the product or service.

More Trade Dress Protection for Web Pages

Whether a website is inherently **distinctiv**e is subjective. Website designers typically seek a unique look, yet, that can make it easier, or harder, for any one site to stand out. For popular websites this will be of less concern, for they may acquire distinctiveness, that is, recognition by the public, through their popularity. Many of us, for example, might recognize immediately the Yahoo or E-bay home pages.

The requirement that trade **dress must not be functional** looks at its impact on the competition. Trademark law helps to prevent unfair competition by stopping manufacturers from stealing customers by using their competitors' marks. But the competitors still have a right to compete in the marketplace. So, if companies could secure exclusive rights in functional aspects of products, it would close others out of the market, which is anticompetitive.

Patents

Title 35 of the US code regulate Patents. Title 35 is implemented by Congress stemming from the authority granted in then by Article 1, Section 8, Clause 8 of the Constitution.

35 USC 101 provides that 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.

The invention must be novel (35 usc 102) and non-obvious (35 usc 103) to a person of ordinary skill in the art to which the subject matter pertains in order for a patent to be granted.

This type of patent is utility patent and is usually granted for 20 years from your initial filing date.

The most important part of a patent is what it claims—patent claims define the metes and bounds of the invention;

Patents can generate royalties if licensed;

Patents prevent others from making, selling or using an invention;

Patents do not give the patentee a right to practice his/her patented invention:

For example, if inventor Mr. Smith gets patent claims for an apparatus comprising 5 elements, a, b, c, d and e , and Mr. Jones already has a patent claiming a, b, c and d, Mr. Smith cannot practice his patent w/o a license from Mr. Jones;

Types of Patents

Provisional Patent Applications

Non-Provisional Patent Applications

Design Patent Applications

Plant Patent Applications

International Patent Applications (PCT)

Provisional Patent Applications

Provisional patent application is a type of US patent application that expires after 12 months;

Since June 8, 1995, applicants have an option to file a provisional application in lieu of a non-provisional utility application;

Applicants may claim the benefit of the provisional application;

Basic filing fee $280/$140/$70;

Can file a non-provisional application claiming priority under 35 USC §119(e), within one year of the provisional application filing date;

Provisional (35 USC §119(e))

Corresponding non-provisional application benefits in that

- Patentability evaluated as if filed on earlier provisional filing date;
- Resulting publication or patent issuing is treated as a reference under 35 USC §102(e) as of the provisional application filing date;
- But twenty year term measured from the non-provisional application filing date, not that of the provisional;

MUST comply with 35 USC §112;

Provisional (35 USC §112)

Written description and any drawings must adequately support the subject matter claimed in the later filed non-provisional application to benefit from the earlier filed 35 USC §119(e) filing date;

The later filed non-provisional application need not be identical to the provisional application, but is only entitled to the benefit of common subject matter filed in the non-provisional not later than 12 months from the filing date;

The specification must disclose the manner of making and using the invention in such full, clear, concise and exact terms as to enable any person skilled in the art to which the invention pertains to make and use the invention (w/o undue experimentation);

Non-Provisional (Utility) Application

A non-provisional utility patent application must be filed in English (or with a translation) and a fee under 37 CFR 1.17(i);

MUST include a Specification (under 35 USC §112), including a claim or claims, drawings, where necessary, an oath or declaration and the prescribed filing, search and examination fees;

Basic filing fee:

Microentity:	$400
Small entity	$785
Large Entity	$1,570

Specification (MPEP 608.01(a))

The Specification is a written description of the invention and of the manner of making and using same; for example, in Word 81/2 by 11 format, 12-point font;

MUST be in full, clear, concise and exact terms to enable one skilled in the art or science to which the invention pertains to make and use same;

The Specification should include section headings

- Title of the Invention
- Cross-Reference to Related Applications, for example, reference to a provisional application upon which priority is claimed under 35 USC §119(e);

Specification

Section Headings (continued)

- Background of the Invention-Description of prior art including any shortcomings (MPEP 608.01(c))
- Summary of the Invention- Functional description of the Invention including advantages and a restatement of independent claims (MPEP 608.01(d))
- Brief Description of the Drawing Figures (MPEP 608.01(f); MPEP 608.02; 35 USC §113; 37 CFR 1.81)
- Detailed Description of the Invention (MPEP 608.01(g))
- Claims (608.01(i))
- Abstract of the Disclosure (MPEP 608.10(b))

Patent Claims

In establishing a disclosure, an applicant may rely not only on the description and drawing as filed but also on the original claims where content justifies;

Claims must commence on a separate sheet after the detailed description;

Each claims begins with a capital and ends with a period (.);

Different elements should be separated with line indentations;

Form of claim required in 37 CFR 1,75(e) is adapted for description of improvement type inventions;

Design Patent Applications

A design consists of the visual ornamental characteristics embodied in or applied to an article of manufacture (as distinguished from a copyright);

Because a design is about appearance, the subject matter of a design patent application may relate to the configuration or shape of an article, or the combination of configuration and surface orientation;

MPEP 1500;

The term is 15 years from the date of grant (35 USC §173);

Basic Filing Fee:

Microentity	$240
Small entity	$480
Large entity	$960

Plant Patent Applications

A Plant Patent is granted to an applicant or his/her heirs and assigns who has invented or discovered and asexually reproduced a distinct and new variety of plant (other than a tuber);

20 years from the date of filing;

35 USC §161;

MPEP 1600;

Basic Filing Fee

Small entity	$570
Large entity	$1140

International Patent Applications (PCT)

The Patent Cooperation Treaty enables a US applicant to file one application (an international application) in a standardized format in English;

The PCT application is filed in the US Receiving Office (USPTO);

The PCT application as filed is recognized as a regular national patent application in the Contracting States designated by applicant;

Up-to-date list of PCT member countries found at www.wipo.int/pct/en/index.html;

MPEP §1800;

Search

- It is often recommended that one who wishes to apply for a patent conduct a patentability search for novelty and non-obviousness before proceeding. No patent search can ever be completely exhaustive, due to, among other reasons, the filing system in the Patent Office where a relevant patent can be off the shelf and therefore unavailable, and differing interpretations as to relevant, related patents.
- There is also a possibility that someone has filed a patent application for substantially the same invention which is still pending. As patent applications are confidential, there is no way to determine if there are other related patent applications pending unless it is published, which generally occurs approximately eighteen (18) months after it is filed.

More on **Searching**

Patent Searching

- Uspto.gov
- Click on Patents
- Search patents
- Carry out quick or advanced search in issued patent database (PatFT) or published application database (AppFT)
- A patentability opinion includes a search and an analysis of the search results; the cost for a search/patentability opinion varies between $1400 and $1800, depending on the technology

Trademark Searching

- Click on search TM database (TESS)
- Select new user search form

Intellectual Property Resources

US Code, Title 35, Patents

- Code of Federal Regulations, Title 37, sections 1.1-1.997
- MPEP

US Code, Title 15, Chapter 22, Trademarks

- Code of Federal Regulations, Title 37, sections 2.1-2.209;
- TMEP

US code, Title 17, Copyrights

Non-Disclosure Agreements

Non-Disclosure Agreement is a contract between a disclosing party (you) and a receiving party (potential investor or licensee);

In consideration for the value (potential) the receiving party will realize by having an opportunity to view the confidential material, the are bound by a promise to keep confidential;

The consideration is like “$1 and other valuable consideration;”

Goes back to English common law of contract;