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What is IP? And How to Protect It.

October 27, 2016

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I will focus on “What is IP?”

- Four “primary” types of intellectual property:
 - Patents (cover the “idea/thing”)
 - Copyrights (cover the “expression”)
 - Trademarks (identify the “source”)
 - Trade Secrets (cover “confidential information”)
- Many others are recognized (e.g., right of publicity, fragrances/smells, etc.), which often blur the lines of the primary types of IP

Patents - Utility Patents

What are Utility Patents?

- Patents are provided for under the Constitution (Art. I, § 8, cl. 8) “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.”
- **Patents are essentially a limited duration monopoly for new inventions**
- Monopolies and Capitalism are like Oil and Water
- “Quid Pro Quo” of Patents
 - Inventors get a monopoly of limited duration
 - The public gets innovation and an *enabling* disclosure of patented inventions

United States Patent [19] **Patent Number: 5,036,164**
Schrader et al. [45] **Date of Patent: Jul. 30, 1991**

[54] **MULTIPLE TAP GROUND CONNECTOR**
 [75] **Inventors:** Gary E. Schrader, Manchester; H. Thomas Nelson, Bedford, both of N.H.
 [73] **Assignee:** Burody Corporation, Norwalk, Conn.
 [21] **Appl. No.:** 558,005
 [22] **Filed:** Jul. 25, 1990
 [51] **Int. Cl.:** H01R 4/18; H01R 4/66
 [52] **U.S. Cl.:** 174/94 R; 174/7; 403/285; 403/391; D13/149
 [56] **Field of Search:** 174/6, 7, 71 R, 84 C, 174/90, 94 R; 24/315 A, 129 W; 29/873, 514; 403/278, 281, 285, 385, 391; 439/92, 890; D13/149
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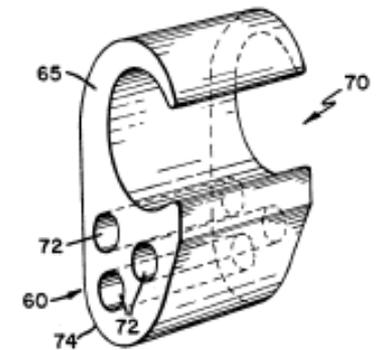
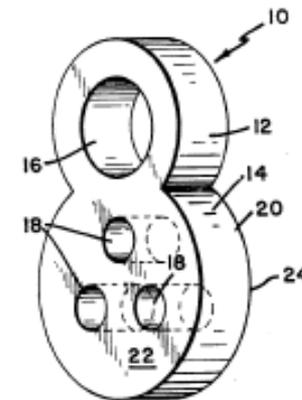
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Primary Examiner—Laraine E. Askin
Attorney, Agent or Firm—Barnett J. Keenan; Patrick J. Walsh

[57] **ABSTRACT**
 Several configurations of compression ground connectors to allow for one, two, three or more taps from a single ground connector to an installation requiring grounding. The installation is completed using a single crimping stroke.

6 Claims, 2 Drawing Sheets



Patents

How do I get a Patent?

- The Patent Act provides that a patent shall be granted if a person (applicant/inventor) meets certain criteria (to the satisfaction of the Patent Examiner):
- Hurdle One – The patent claims must cover “**patentable subject matter**” defined in Section 101 (“any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof”)
- Hurdle Two – The patent claims cover subject matter that is **novel** (not known or previously published by others, with exceptions) in Section 102
- Hurdle Three – The patent claims cover subject matter that is **not obvious** over what was previously known in the field in Section 103
- Hurdle Four – The patent claims cover subject matter that is **described** in the Specification and **sufficiently enables** a person in the field to make and use the invention in Section 112

Patents

What rights do I get with my patent monopoly?

- Does a patent grant the patentee a right to make and sell his or her invention?

NO!!

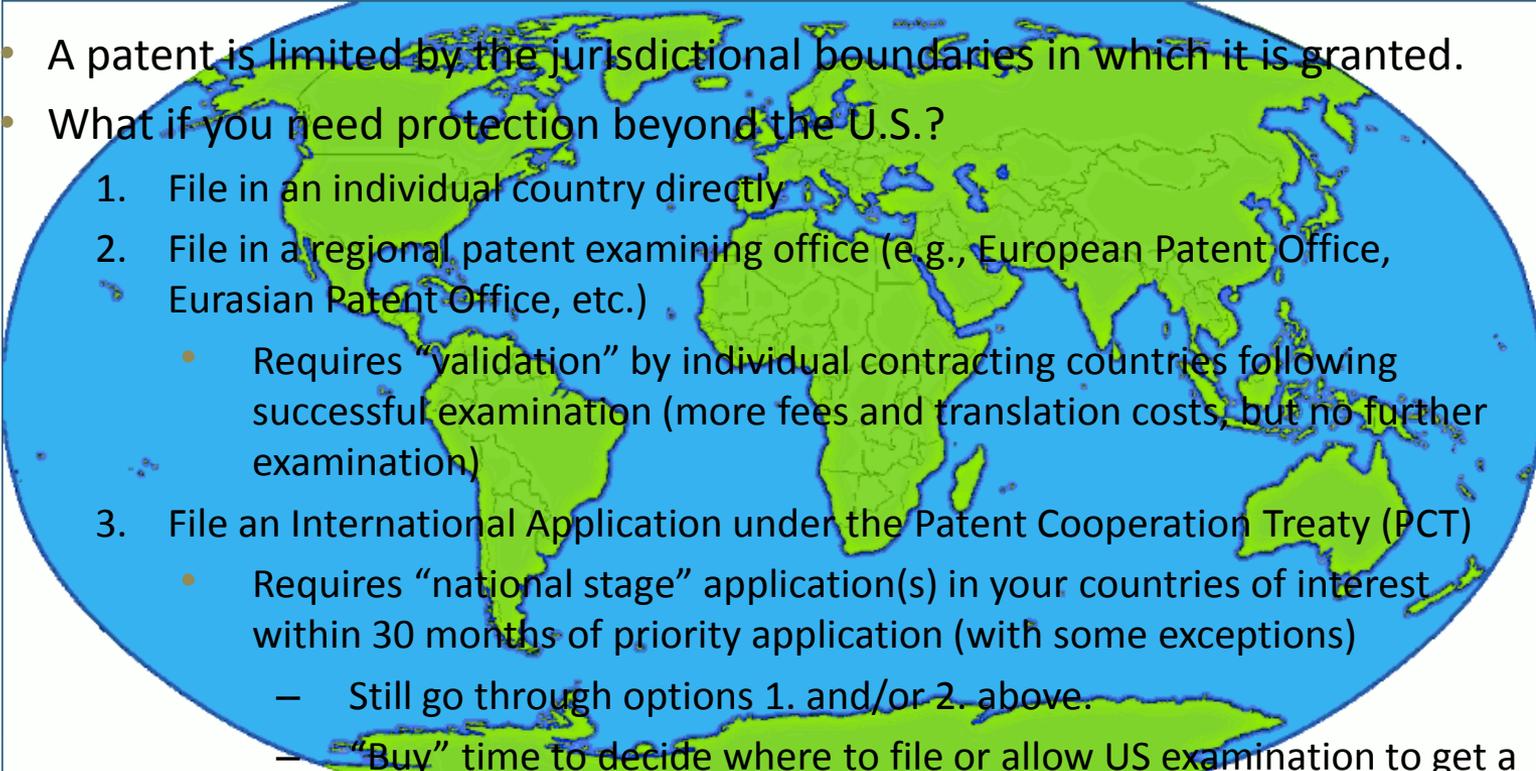
Patents

What rights do I get with my patent monopoly?

- Patents bestow a bundle of exclusionary rights on the patentee.
- The rights to exclude someone without authority from:
 - Making (in the USA)
 - Using (in the USA)
 - Selling (in the USA)
 - Offering for Sale (in the USA)
 - Importing (into the USA)
- Duration is 20 years from the original application filing date (with some exceptions, e.g., patent term adjustment)
- These rights are limited by the jurisdictional boundaries of the USA (with some exceptions, e.g., method patents)

Patents

Geographical Limitations

- 
- A patent is limited by the jurisdictional boundaries in which it is granted.
 - What if you need protection beyond the U.S.?
 1. File in an individual country directly
 2. File in a regional patent examining office (e.g., European Patent Office, Eurasian Patent Office, etc.)
 - Requires “validation” by individual contracting countries following successful examination (more fees and translation costs, but no further examination)
 3. File an International Application under the Patent Cooperation Treaty (PCT)
 - Requires “national stage” application(s) in your countries of interest within 30 months of priority application (with some exceptions)
 - Still go through options 1. and/or 2. above.
 - “Buy” time to decide where to file or allow US examination to get a head start
 - 47 countries are not members of the PCT – most notable are Argentina and the Bahamas (requires option 1. above)

Patents

What rights do you get with your patent monopoly?

Example (assume we live in the 1800s):

- In 1817, Karl invents a two-wheeled vehicle with a steerable front wheel. A patent is granted in 1818 that will expire in 1838 with the following claim:
 - An ambulatory vehicle comprising a pair of wheels arranged in tandem on a rigid frame and a steering mechanism for the front wheel.
- In 1818, Denis improves upon the two-wheeled vehicle by introducing a seat for the user. A patent is granted in 1822 that will expire in 1842 with the following claim:
 - An ambulatory vehicle consisting of [comprising] a pair of wheels arranged in tandem on a rigid frame, a steering mechanism for the front wheel, and a seat disposed between the center of the two wheels.
- In 1839, Gavin improves upon the two-wheeled vehicle by introducing a set of pedals attached to a rotary crank that the user turns to power the vehicle. A patent is granted in 1839 that will expire in 1859 with the following claim:
 - A human-powered vehicle comprising a pair of wheels arranged in tandem on a rigid frame, a steering mechanism for the front wheel, a seat disposed between the center of the two wheels, and a pair of pedals attached to a rotary crank on the front wheel.

Patents – Provisional Patents

Testing the Water



- Regular or “Non-Provisional” **patent applications are expensive** to draft and expensive to prosecute (move through examination to achieve allowance and issuance)
- A less expensive option is available: the Provisional Patent Application
 - Provisionals cost a fraction of the filing fees (\$65 vs. ~\$800)
 - **Provisionals are not examined and cannot issue**
 - Provisionals can be drafted quickly and inexpensively in some circumstances
 - Provisionals do not need claims (for U.S. priority)
 - Provisionals can be a simple manuscript, white paper, presentation slide deck, or even less
 - **Provisionals expire in 12 months from their filing date**
 - A Non-Provisional and/or PCT application can be filed within the 12 month pendency that claims “priority” back to the Provisional filing date
 - Provisionals do not count against the 20 year U.S. patent term
 - If no interest at expiration, Provisionals can die a quiet death

Patents – Design Patents

- Design Patents protect the “ornamental” appearance of a manufactured article
- Design Patents do not cover the “utility” of a design or its function
- Sometimes overlooked, Design Patents have proved to be very valuable
 - Crocs® footwear have been successfully protected with Design Patents
 - Apple’s iPhone screen shape was found to be infringed by Samsung with damages of over \$500 Billion (right)
- Design Patents are typically much less expensive to draft and to prosecute
- Design Patents have a duration of 15 years (filed on or after May 13, 2015)

(12) **United States Design Patent** (10) Patent No.: **US D618,677 S**
 Andre et al. (45) Date of Patent: **** *Jun. 29, 2010**

(54) **ELECTRONIC DEVICE**
 (75) Inventors: **Bartley K. Andre**, Menlo Park, CA (US); **Daniel J. Coster**, San Francisco, CA (US); **Daniele De Iulius**, San Francisco, CA (US); **Richard P. Howarth**, San Francisco, CA (US); **Jonathan P. Ive**, San Francisco, CA (US); **Steve Jobs**, Palo Alto, CA (US); **Duncan Robert Kerr**, San Francisco, CA (US); **Shin Nishibori**, Portola Valley, CA (US); **Matthew Dean Rohrbach**, San Francisco, CA (US); **Douglas B. Satzger**, Menlo Park, CA (US); **Calvin Q. Seid**, Palo Alto, CA (US); **Christopher J. Stringer**, Woodside, CA (US); **Eugene Antony Whang**, San Francisco, CA (US); **Rico Zerkendorfer**, San Francisco, CA (US)

(73) Assignee: **Apple Inc.**, Cupertino, CA (US)
 (*) Notice: This patent is subject to a terminal disclaimer.
 (**) Term: **14 Years**
 (21) Appl. No.: **29/328,018**
 (22) Filed: **Nov. 18, 2008**

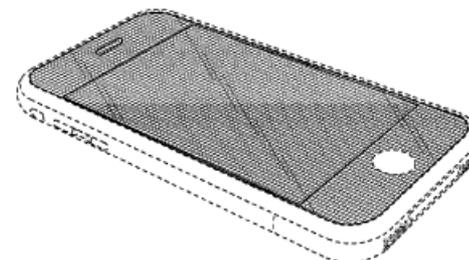
Related U.S. Application Data
 (60) Division of application No. 29/282,834, filed on Jul. 30, 2007, now Pat. No. Des. 581,922, which is a continuation of application No. 29/270,888, filed on Jan. 5, 2007, now Pat. No. Des. 558,758.

(51) **LOC (9) CL** **14-02**
 (52) **U.S. CL** **D14/341; D14/248; D14/203.7**
 (58) **Field of Classification Search** **D14/341; D14/342, 343, 344, 345, 346, 347, 420, 426, D14/427, 432, 439, 440, 441, 448, 496, 125, D14/137, 129, 130, 138, 250, 389, 147, 218, D14/247, 248, 156; D10/65, 104; D13/168; D18/6, 7; D21/329, 686; 455/90.3, 556.1, 455/556.2, 575.1, 575.3, 575.4; 379/433.01, 379/433.04, 433.06, 433.07; 361/814; 341/22; 345/169, 173; D6/596, 601, 605**
 See application file for complete search history.

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 Primary Examiner—Cathron C Brooks
 Assistant Examiner—Angela J Lee
 (74) Attorney, Agent, or Firm—Stern, Kessler, Goldstein & Fox PLLC
 (57) **CLAIM**
 The ornamental design of an electronic device, as shown and described.

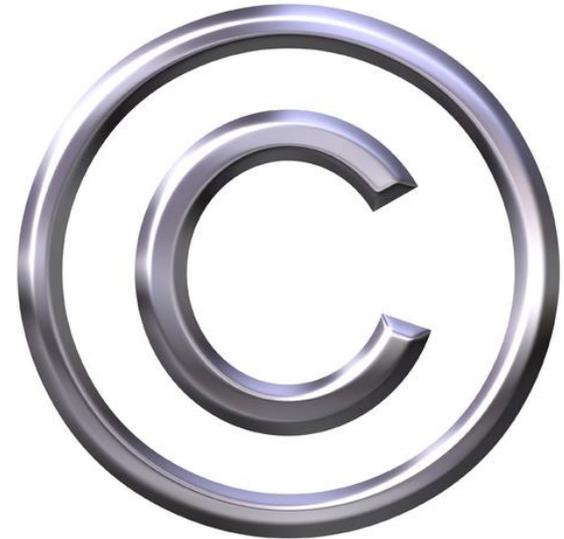
DESCRIPTION
 FIG. 1 is a front perspective view of an electronic device in accordance with the present invention;
 FIG. 2 is a rear perspective view thereof;
 FIG. 3 is a front view thereof;
 FIG. 4 is a rear view thereof;
 FIG. 5 is a top view thereof;
 FIG. 6 is bottom view thereof;
 FIG. 7 is a left side view thereof; and,
 FIG. 8 is a right side view thereof.
 The claimed surface of the electronic device is illustrated with the color designation for the color black.
 The electronic device is not limited to the scale shown herein. As indicated in the title, the article of manufacture to which the ornamental design has been applied is an electronic device, media player (e.g., music, video and/or game player), media storage device, a personal digital assistant, a communication device (e.g., cellular phone), a novelty item or toy.

1 Claim, 2 Drawing Sheets



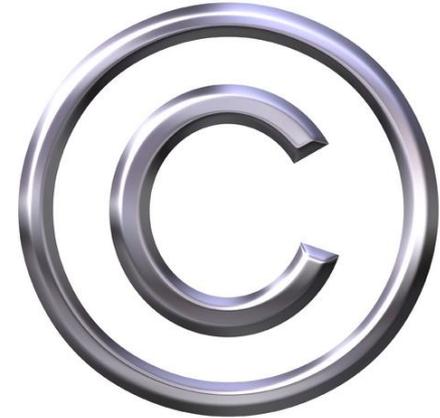
Copyrights

- Copyrights are provided for under the Constitution (Art. I, § 8, cl. 8) “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.”
- **Encouraging innovation in exchange of limited monopoly**
- Federal Law applies
 - Technically, common law copyright exists, but Federal Copyright Act expressly preempts almost all kinds of state (and common law) copyright law



Copyrights

What is a Copyright?



- Copyrights cover the “expression” of an idea in “original works” composed in a “tangible medium”
 - The “idea/thing” that is the subject of the expression **IS NOT** protected
 - Common law copyright automatically attaches once the definition is met
 - Most protections, however, comes after Federal Registration
- Works covered include:
 - literary, musical/sound, dramatic, artistic, and other works
 - Importantly, software and algorithms can be copyrighted
 - Company/product logos and slogans can be copyrighted

Copyrights

What protections do I get?



- Protections Provided through Registration:
 - Exclusive right to reproduce the work
 - Exclusive right to distribute reproductions of the work
 - Exclusive right to publicly perform/display the work or reproductions (depends on the form of the work)
 - Exclusive right to make derivative works
 - Exclusive right to digitally transmit sound recording works
 - Access to federal courts and Customs seizures
- How Long?
 - Duration for a **known author** = life time + 70 years
 - Duration for a **joint author** = life time of longest surviving + 70 years
 - Duration for **unknown author or organization** = 95 years from publication OR 120 years, whichever is shorter

Copyrights

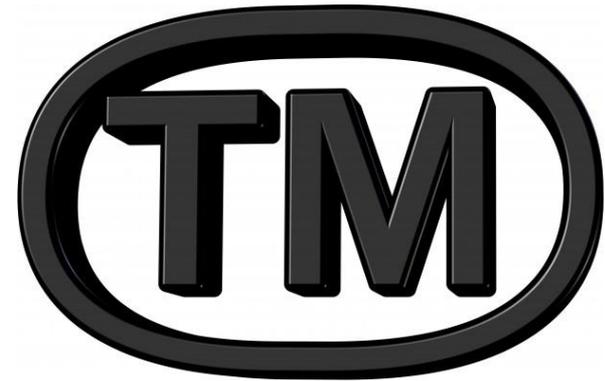
How do I obtain them?

- Federal Copyright **Registration is a threshold requirement** for enforcement of the protections provided in the Copyright Act
 - Including Statutory Damages and Attorney Fees
- Federal Registration is handled through the Copyright Office
- Registration Procedure is relatively simple compared to Patent Prosecution and Trademark Registration (can be done electronically for most works - <http://copyright.gov/eco/>)
 - \$45 per work to be registered
 - Application document describing the author(s) or organizational owner(s) and the work(s) to be registered
 - A copy of the work(s) to be registered must be deposited with the Copyright Office
 - Registration Certificate typically follows 9 Months later

Trademarks

What is a Trademark?

- Trademark Law protects the **source identification** of a product or service
- A Trademark is usually a word, name, or logo
- Federal and State Law apply
 - Federal Law requires interstate or foreign commerce
 - State Law is limited by geographical bounds of the state



Trademarks

What protections do I get?

- Unregistered Marks “TM” must rely on state statutory and common law protections
- Federal Trademark Registration “[®]”, like Copyright law, provides enhanced protections and access to federal courts and Customs seizures
- The protection is for a **source identifier** for goods and services, so the actual product/service with this Trademark label **IS NOT** protected
 - The actual product/service may change over time or be altered for regional preferences – all with the same Trademark

Trademarks

How do I obtain them?

- Simply using a source identifying name or mark attaches common law protections, but those protections are limited
- Federal Registration is handled by the U.S. Patent & Trademark Office
 - The Application process is not difficult, but significant “clearance” research should be conducted prior to filing a registration application
 - Also, Brand Management should also be considered when registering a Trademark

Trademarks vs. Brands

- A “Brand” may overlap with a Trademark, but it generally is the name chosen to identify a product/service or a line of products/services or of the business, itself
- Thus, the Brand name may also be Trademarked
- A company may have multiple Brands that target different sectors of the market, even if the features are similar (e.g., GM – GMC, Chevrolet, Buick, Cadillac, etc.)

The GMC logo is rendered in a bold, red, three-dimensional font with a metallic sheen and a slight shadow, set against a white background.The GM logo consists of the letters "GM" in a white, bold, sans-serif font, centered on a solid blue square background.

Trade Secrets

- Federal and State Law apply
 - Until this year, Trade Secret law was purely a matter of state law
- Most states have (generally) harmonized Trade Secret laws over the past three decades
 - Many state-specific differences remain, which was an argument for passing federal Trade Secret protection
- Federal Defend Trade Secret Act (DTSA) signed into law in 2016
 - Will not preempt state Trade Secret law
 - Provides another layer of protection by creating a federal cause of action for misappropriation of a Trade Secret
 - Importantly, misappropriating goods can be seized by federal Customs agents

Trade Secrets – What is a Trade Secret?

- **Federal Law** has a very expansive definition
- DTSA definition of Trade Secret
 - **all forms and types of** financial, business, scientific, technical, economic, or engineering **information**, including patterns, plans, compilations, program devices, formulas, designs, prototypes, methods, techniques, processes, procedures, programs, or codes, whether tangible or intangible, and whether or how stored, compiled, or memorialized physically, electronically, graphically, photographically, or in writing **if—**
 - (A) the owner thereof has taken **reasonable measures to keep such information secret**; and
 - (B) the information **derives independent economic value, actual or potential, from not being generally known** to, and **not being readily ascertainable through proper means** by, the another person who can obtain economic value from the disclosure or use of the information
- **In other words:** Information that (1) has been reasonably guarded and (2) is valuable because it is secret or not generally known or readily ascertainable by those who could profit from such knowledge

Trade Secrets – What is a Trade Secret?

- Tennessee definition at Tenn. Code Ann. § 47-25-1702(4)
 - **information, without regard to form, including, but not limited to, technical, nontechnical or financial data, a formula, pattern, compilation, program, device, method, technique, process, or plan that:**
 - (A) **Derives independent economic value, actual or potential, from not being generally known to, and *not being readily ascertainable by proper means* by other persons who can obtain economic value from its disclosure or use; and**
 - (B) **Is the subject of efforts that are reasonable under the circumstances to maintain its secrecy.**
 - TN defines “**improper means**” as including “theft, bribery, misrepresentation, breach or inducement of a breach of a duty to maintain secrecy or limit use, or espionage through electronic or other means”
 - CA law allows “**readily ascertainable**” information to be a Trade Secret, so long as it has not been ascertained by others in the industry in question
 - NC law allows for a Trade Secret to be **independently developed** by more than one person, but specifically allows for reverse engineering as a proper means to “readily ascertain” such information as a defense
 - Nevada law snuffs out **anything known by any other person**

General Rule

ADDED
(broadens)

Varies by State

Trade Secrets vs. Patents

When do I choose one over the other?

- Can Information used in or to make my product or service be readily ascertained by those in my field/industry by inspection or reverse engineering?
 - Yes: Trade Secret will probably provide limited protection
 - No: Trade Secret is more viable, but remember that you must take reasonable measures to keep that information **secret**
- SUCCESSFUL AND FAMOUS TRADE SECRETS
- Coca Cola formula
 - Even chemical analysis cannot discern all details of the formula and how it is prepared
 - True value is in brand (Trademark) management, but that brand is built around the Trade Secret of the formula
- KFC's 1939 recipe of "11 Herbs and Spices"
 - KFC filed a lawsuit in 2001 seeking an injunction against a couple (and former friends of Col. Sanders) from selling a recipe list of "11 Herbs and Spices" contained in an old book found in a house they purchased from Col. Sanders

Assignments and Licensing

- Intellectual Property is “property”, and it can be bought, sold, leased, and borrowed just like tangible property
- Assignments amount to a sale of the IP with transfer of substantially all rights to a new owner(s)
- Licenses are any transfer of rights that amount to less than an Assignment

- Exclusive License
- Nonexclusive License
- Royalties
 - One time payment

- Payments made over time, usually based on products/services produced, imported, and/or sold



Summary

- **Patents** – Cover the ideas/things that are new and non-obvious
 - Expensive to obtain and maintain
 - Provide exclusionary rights for ~20 years
 - Must provide an enabling disclosure (teach the public how to infringe)
- **Copyrights** – Cover the expression of the idea/thing in a tangible medium
 - Free to create AND Inexpensive to register
 - Provide rights to publish, perform, duplicate, and to create derivative works, as well as exclude others from these activities for ~100 years
 - Registration provides greater protections and access to federal courts
- **Trademarks** – Cover the source identity of a thing or service
 - Relatively inexpensive to obtain BUT Maintenance costs add up over time
 - Provide the right to keep others from using confusingly similar marks for products/services in the same category as your product/service
 - Must be renewed every five (5) years, but theoretically can have infinite duration
- **Trade Secrets** – Cover confidential information of ideas/things
 - Free to create BUT May be expensive to maintain
 - Provides rights to keep others from improperly taking your confidential information
 - Theoretically can have indefinite duration, but reasonable steps must be taken to maintain secrecy

THANK YOU