

INTELLECTUAL PROPERTY LAW FOR THE TECH INDUSTRY

Presented by

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IP Overview

Trademark:

(a) covers words, phrases, symbols, slogans used to identify the source of goods or services;

(b) automatic common law rights with use, but trademark registration has advantages;

(c) trademarks last as long as the trademark is used in commerce and the public views it as the source of goods or services.

IP Overview

Patent:

- (a) covers new, useful ideas, "inventions";
- (b) must apply to USPTO to get patent coverage—technical and expensive;
- (c) lasts generally 20 years.

IP Overview

Copyright:

(a) covers "works of authorship" like poetry, novels, movies, songs, etc., but also computer software, architectural designs, website content;

(b) automatic common law coverage, but must apply to copyright office to get advantages of copyright registration;

(c) copyright lasts for the life of the author + 70 years, 95 years from publication, or 120 years from creation (depending on authorship).

IP Overview

Trade secret:

- (a) confidential business information that gives you a competitive edge, like secret formula, manufacturing method, customer list, marketing strategy;
- (b) no registration because it's secret, but ownership requires "reasonable efforts" to maintain secrecy;
- (c) lasts as long as it's kept secret.

What is a Trademark?

- Word, name, symbol, design, or combination
- Used in commerce
- Distinguishes source of the goods/services
- A “brand”
- Trade Name v. Trademark
(business name v. source identifier)



What Does Trademark Law Protect?

- Protects “brands” as designations of source
- Rights arise from first use
- Registration confers additional benefits
 - “TM” v. “®”
- Trademarks promote:
 - Product recognition
 - Goodwill
 - Consumer protection

Systems of trademark protection

- Common Law Rights (geographic limitation)
- State Registration
- Federal Registration (®)
- International Registration (if using mark in other countries)

Strength of Trademarks

STRONG

weak

Fanciful Arbitrary Suggestive Descriptive Generic



International Business
Machines Corporation

COMPUTERS.COM

Trademark Infringement

- Unauthorized use of a mark in connection with goods or services in a manner that is likely to cause confusion about the source of goods or services.
- Courts will consider:
 - Similarity of marks
 - Similarity of goods or services
 - Also: where goods/services are advertised and sold; prospective purchasers; actual confusion; defendant's intent; and strength of plaintiff's mark



Mc Donalds Registered Trademark



Copycat



Protecting Trademarks

- Choose a strong mark
- Clear it (make sure you got there first)
- Use it
- Police it
- Enforce your rights
- Registration is not required but affords significant benefits

Patents

- A legal right to keep other parties from making, using, or selling the thing claimed in the patent for a limited period of time.
- Does not confer a legal right for you to make, use, or sell the thing claimed in the patent.

Patents

Myths:

1. “My patent gives me the right to make, use and sell the invention.”
2. “Merely having a patent will stop others from copying my patented product.”
3. “We don’t copy anyone’s product, so we don’t infringe anyone’s patents.”
4. “I’ve never seen this product on the market, so it must be patentable.”

Patents

- Two types that are most relevant: (Apple v. Samsung)

Design patents – cover ornamentality Utility patents – cover functionality

(12) **United States Design Patent** (10) Patent No.: **US D593,087 S**
 Andre et al. (45) Date of Patent: **** May 26, 2009**

(54) ELECTRONIC DEVICE

(56)

References Cited

(12) **United States Patent** (10) Patent No.: **US 7,469,381 B2**
 Ording (45) Date of Patent: **Dec. 23, 2008**

(54) **LIST SCROLLING AND DOCUMENT TRANSLATION, SCALING, AND ROTATION ON A TOUCH-SCREEN DISPLAY** 6,489,951 B1 12/2002 Wong et al. 345/173
 6,567,102 B2 5/2003 Kung 345/660

1. A computer-implemented method, comprising:

at a device with a touch screen display:

displaying a first portion of an electronic document;

detecting a movement of an object on or near the touch screen display;

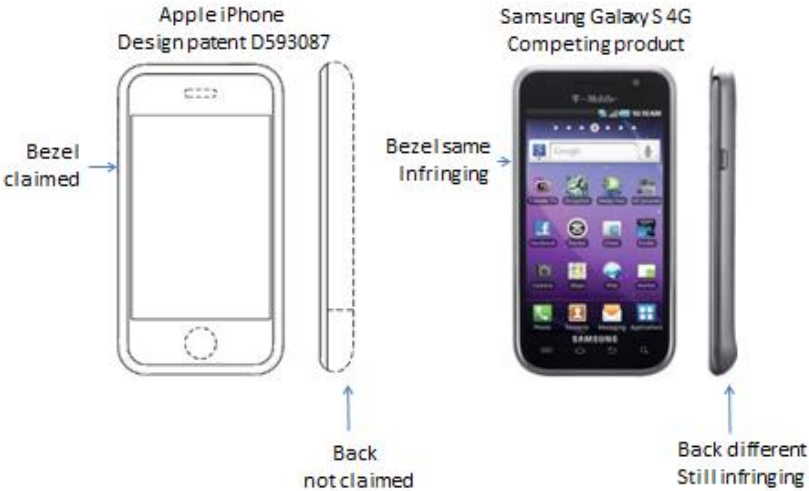
in response to detecting the movement, translating the electronic document displayed on the touch screen display in a first direction to display a second portion of the electronic document, wherein the second portion is different from the first portion;

in response to an edge of the electronic document being reached while translating the electronic document in the first direction while the object is still detected on or near the touch screen display:

displaying an area beyond the edge of the document, and

displaying a third portion of the electronic document, wherein the third portion is smaller than the first portion; and

in response to detecting that the object is no longer on or near the touch screen display, translating the electronic document in a second direction until the area beyond the edge of the electronic document is no longer displayed to display a fourth portion of the electronic document, wherein the fourth portion is different from the first portion.



Patents

- What is patentable?
 - Must be novel and non-obvious to one of ordinary skill in the art
 - Statutory Subject Matter
 - processes, machines, manufactures, compositions of matter
 - NOT laws of nature, natural phenomena, abstract ideas, scientific principles, mental processes, physical phenomena

Patents

- **What About Software Patentability?**
 - Software patent claims can be rejected as directed towards patent ineligible “abstract ideas.”
 - How to avoid or overcome the “abstract idea” rejection:
 - Focus claims to be directed to an improvement in computer functionality.
 - Provide a technical solution to a technical problem.
 - Solve a problem particular to the internet, 3D animation, etc.
 - Not patentable:
 - Use of generic computer components that operate in well-understood, routine, conventional ways.
 - Transformation of a process traditionally carried out by humans into an automated process executed on computers.

Patents

- US Only: One year on-sale/public disclosure bar:
 - No patent if the invention was "on sale or otherwise available to the public" anywhere in the world one year or less before the filing date of the patent.
- Most other countries: lose ability to file as soon as disclosed

Patents

- Inventorship/Ownership
 - There can be more than one inventor on a patent.
 - In the US, the inventor is presumed to be the initial owner of a patent or patent application. Make sure there are one or more of the following in place:
 - Employee Agreements (Automatic Assignment)
 - Obligation to Assign
 - Explicit Assignments

Copyright

- Protects the rights of individuals and groups in:
 - Original works of authorship
 - Fixed in tangible medium of expression

Copyright

- Copyright Protects...
 - literary (written) works
 - musical works
 - dramatic works
 - graphic, sculptural works (photos, art)
 - motion pictures, TV, DVD
 - sound recordings
 - software (code and GUI)
 - websites

Copyright

Copyright Does Not Protect

- ideas (but may be protectable as trade secrets or patent)
- facts (but selection of unprotected facts is protected if original)
- titles, slogans and other short phrases (but trademark law may provide protection)

Copyright

1. Reproduce
2. Derivative works
3. Distribute (“first publication”)
4. Perform publicly
5. Display publicly
6. Digital performance of musical work
7. Authorize (license) any of the above

Copyright

Copyright does NOT depend on registration.

Original work of authorship is copyrighted as soon as it is fixed in a tangible medium.

BUT, registration has significant advantages.

Copyright

- Advantages of Registration
 - Inexpensive
 - Presumption of exclusive rights
 - Prima facie evidence of validity, ownership, originality
 - Ability to bring infringement action
 - Election of statutory damages + award of costs and fees

Copyright Ownership

- Ownership
 - general rule is that person who creates the work is the author
- “work for hire” exception
 - Work prepared by an employee within scope of employment, OR
 - Work prepared by independent contractor only if:
 - prior to creation of work, company commissions work and contractor expressly agrees in a written signed document that work is “work made for hire,” and
 - work falls into one of nine specific categories (including translations, contributions to a movie or collective work, atlas, compilation, instructional text, test or answer to test).
- *Note: Lots of critical things, including advertising photography or copy and software code are NOT “work for hire” if created by a contractor.*
- Copyright assignments must be in writing, signed by the contractor/assignor.

Open Source

- Protected by copyright
- Provided under a license
 - Copyleft/Reciprocal – derivatives must be distributed under same terms
 - Permissive – few restrictions on redistribution

Using open source to develop
proprietary and/or commercial
software products?

PROCEED WITH CAUTION

Copyright Infringement & Enforcement

Infringement (using copyrighted work without permission)

- Get permission
- Fair use?

Enforcement

- Registration required to file lawsuit
- DMCA

Trade Secrets

- Three related requirements for information to be considered a trade secret:
 - Secrecy (not told to anyone outside company and not readily ascertainable);
 - Commercial value because it's a secret; and
 - Reasonable steps to keep it secret.

Trade Secrets

- Examples:
 - Formulas, such as Coca Cola, WD40;
 - Recipes;
 - Marketing and business strategies;
 - Customer lists
 - Manufacturing processes and techniques;
 - Computer algorithms;
 - A new invention for which a patent application has not been filed

Trade Secrets

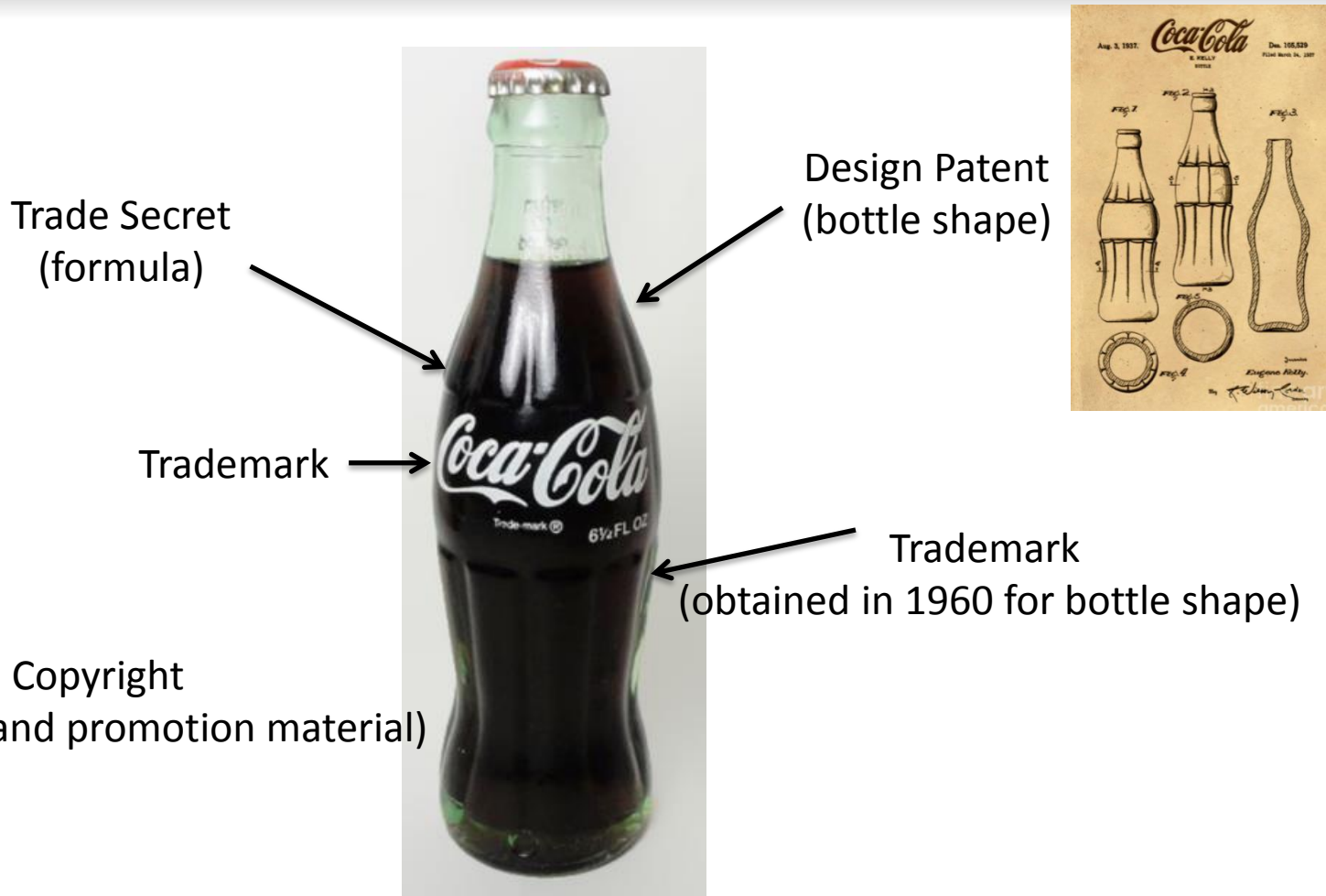
- Limit access by reasonable efforts:
 - Restrict access to the information (e.g., encryption and password protection);
 - Limit the number of people who know the information;
 - Have employees, consultants, and contractors sign non-disclosure agreements;
 - Maintain and mark all documents relating to the trade secret confidential.

Trade Secrets

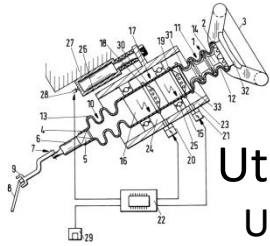
■ Ownership

- Generally, without any agreements in place, whoever knows the information may be considered an owner of the trade secret.
- Employers should enter into written agreements regarding ownership of discoveries, ideas and inventions in general, including trade secrets.
 - New federal trade secret act (DTSA) requires immunity notice if trade secret is disclosed to government official for the purpose of reporting suspected violation or disclosed under seal, in a court filing. Otherwise forfeit double damages and attorney fees.

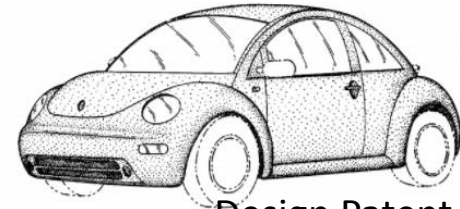
IP basics: How they all work together



IP basics: How they all work together



Utility Patent
US6189919



Design Patent
USD385220

Copyright
Emissions Control
Software

Trademark



Questions?

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