

Intellectual Property Law

❖ INTRODUCTION AND PATENTS

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What is intellectual property (IP)?

- ❖ **Knowledge. Assets.** The kind of property that results from the fruits of mental labor. Can it be converted into property? Knowledge is abstract. If someone gains knowledge it does not reduce that available to others.
- ❖ Two ways of turning knowledge into property.
 - ❖ Intellectual property law: copyright, patent, registered industrial design and trademark legislation and conventions.
 - ❖ Secrecy: shared by all cultures i.e. hiding it.

Why is IP important?

If you are an inventor, designer, writer programmer, you need to understand the language of intellectual property law to intelligently deal with such issues as:

- ❖ who owns creative works or commercially valuable information
- ❖ how these owners can protect and enforce their ownership rights
- ❖ how disputes between intellectual property owners can best be resolved
- ❖ how ownership rights can best be transferred to others

What is a patent?

- ❖ Grant of property right by Government to inventor "to exclude others from making, using or selling the invention"
- ❖ Must file an application
- ❖ Must disclose invention ("novel" and "unobvious") with enough particularity to enable one of ordinary skill to make and use it.



Three types of patents

- ❖ Utility Patents
 - New and useful process, machine, manufacture or compositions of matter, or any new and useful improvement
- ❖ Design Patents
 - New, original and ornamental design for an article of manufacture
- ❖ Plant Patents
 - Invented, discovered and asexually reproduced any distinct and new variety of plant



What is a copyright? ©

- ❖ An intangible right granted by statute to the author or originator of certain literary or artistic production
- ❖ To give copyright notice:
© followed by the date and owner's name deter potential infringers
Example: ©2000 Kate Zhou
- ❖ Computer programs specifically classified as literary works and given full copyright protection

Scope of copyright protection for software

Three prerequisites for copyright protection

- ❖ Fixation: fixed in a tangible medium of expression.
- ❖ Originality Independent creation
- ❖ Minimal creativity over the originality is necessary for copyright protection.



Copyright Protection for Computer Software

- ❖ Copyright protects expressions *not ideas*, program documentation, program code, program structure, sequence and organization, user interfaces supporting materials like users manuals, video games
- ❖ The scope of copyright protection is proportional to the range of expression available to articulate the underlying ideas communicated by the program. i.e. the Karate game example



Copyright Protection for Computer Software

- ❖ Computer Software Copyright Act (1980). Amended 1976 Copyright Act by including computer programs in the list of creative works protected by federal copyright law. Computer program "set of statements or instructions to be used directly or indirectly in a computer in order to bring about a certain result."
- ❖ 1983 Apple Computer, Inc. v. Franklin Computer Corp.



Copyright infringement

- ❖ Form or expression of an idea copied
- ❖ Section 107 of the Copyright Act ("Fair use doctrine")

"The fair use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means specified by [Section 106 of the Copyright Act] for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship or research, is not an infringement of copyright"

- ❖ Sony Corp v Universal City Studios
- ❖ Basic Books, Inc. v. Kinko's Graphics Corp



Copyrights never protect the following works:

- ❖ Purely functional items
- ❖ Words, names, titles, slogans, and other short phrases (i.e. get info or trash)
- ❖ Blanks forms designed solely to record information
- ❖ Typeface designs
- ❖ Works for which copyright has expired
- ❖ Works dedicated to the public domain

Copyright Registration Process

- ❖ Select the appropriate registration form
 - ❖ Form TX for software
 - ❖ Form PA for pictorial or graphic authorship.
- ❖ To obtain forms:
 - <http://lcweb.loc.gov/copyright/>
- ❖ Fill out the registration form correctly i.e. see the forms



Copyright Registration Process

- ❖ Satisfy the Copyright Office's deposit requirements:
 - A deposit shows the Copyright Office that your work is eligible for copyright protection
 - ❖ the entire program source code if the source is no more than 50 pages
 - ❖ if longer than 50 pages, send it only the first and last 25 pages.



Copyright filing fees

Basic registrations:

- ❖ **Form TX or Short Form TX** \$30
- ❖ **Form VA or Short Form VA** \$30
- ❖ **Form PA or Short Form PA** \$30
- ❖ **Form SE or Short Form SE** \$30
- ❖ **Form SR** \$30
- ❖ **Form GATT** \$30



Copyright filing fees

Renewal registrations: (before January 1, 1978):

- ❖ **Form RE** \$ 45
- ❖ **Addendum to Form RE** \$ 15

Special handling for registration of qualified copyright claims

- ❖ **Special handling fee (per claim)** \$500
- ❖ **Additional fee (non-special handling)** \$ 50



What is a Trademark?

- ❖ Words, phrases, slogans, logos, sounds 3D symbols, designs or even scents used to identify and distinguish the origin of goods sold
- ❖ Service mark – identifies the source of a service
- ❖ Rights arise from the actual or intent to use the mark.



"All trademarks, service marks and trade names of NIKE used herein (including but not limited to the NIKE name, the Swoosh Design, the NIKE AIR Design, the Basketball Player Silhouette ("Jumpman") Design and The NIKE Alpha Project) are trademarks or registered trademarks of NIKE, Inc."

- www.nike.com



Trademarks

- ❖ Trademarks should be used as adjectives, not as nouns or verbs:
- ❖ "Kleenex tissues" NOT "a Kleenex"
 -
- ❖ "Apple computers" NOT "an Apple"
 -
- ❖ "A Xerox copy" NOT "Xerox this document"
 -
- ❖ Others: escalator, jacuzzi, zipper, nylon, pampers, rollerblades

Why are trademarks important ?

- ❖ Marks are symbols of quality
- ❖ Those who create and/or provide goods and services can reap the benefits of their ingenuity and industry
- ❖ Consumers can identify the things they want and offer protection against consumer fraud.

Trademark advantages on the net

- ❖ The Web strengthens trademark rights and public recognition
- ❖ Web consumers link products and services offered in connection with trademarks
- ❖ Consumers can make more educated choices among competing products

Trademark registration process

- ❖ Consult Legal Advice and Assistance
- ❖ Perform use search (U.S. and International)
www.trademarksonline.com or
www.tmweb.com
- ❖ Register online or mail
www.uspto.gov/treas/e-TEAS/
- ❖ Pay fees
- ❖ Use it!
doesn't expire
longer used, higher the value

Basic fees for trademarks (12/99)

Trademark Processing Fees

- ❖ Application for registration, per class \$325
- ❖ Filing an Amendment to allege Use \$100
- ❖ Filing a State of Use \$100
- ❖ Application for renewal \$400
- ❖ Petition for cancellation \$300
- ❖ Notice of opposition \$300
- ❖ Dividing an application (file wrapper) \$100

Basic fees for trademarks (12/99)

Trademark Service Fees

- ❖ Printed copy of each reg. Mark (USPS) \$ 3
- ❖ Printed copy, next bus day delivery \$ 6
- ❖ Certified copy reg. service \$15
- ❖ Certified copy expedited service \$30
- ❖ Certified copy trademark application \$15
- ❖ Certified copy trade. app. Expedited \$30
- ❖ Certified copy file wrapper and contents \$50

Guidelines for trademark use

- ❖ Register mark
- ❖ Use proper trademark symbol
 - ❖ ® for trademarks or service marks registered by the U.S. Patent and Trademark Office
 - ❖ ™ for unregistered trademark
 - ❖ ℠ for unregistered service marks
- ❖ Trademarks in text should be emphasized
- ❖ Use notices:
"Trademarks Online is a service mark of Trademarks Online, Inc."

Trademark in domain names

- ❖ Domain names assigned by Internet Network Information Center (InterNIC)
- ❖ First com, first-served basis
- ❖ No investigation on name
- ❖ InterNIC registration does not create rights other than the right to use a particular domain name
- ❖ Trademark identical to a domain name
- ❖ Cybersquatting

What are Trade Secrets?

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.

-- The Economic Espionage Act of 1996,
Sec. 1832

The Premise of Violation

- ❖ The owner action -- reasonable measures to keep such information secret
- ❖ Law violation -- derives independent economic value, actual or potential, from not being generally known to, and not being readily ascertainable through proper means by the public.

What is Governing Law for Trade Secrets?

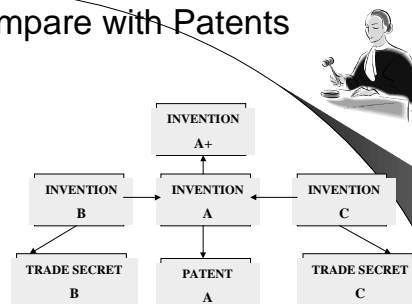
- ❖ In the U.S., trade secret protection comes in part from contract law and in part from state law.
- ❖ In 1979, the National Conference of Commissioners on Uniform State Law promulgated the Uniform Trade Secrets Act ("UTSA") which has now been adopted in a Majority of states.

The Theft of Trade Secrets is Now A Federal Crime

- ❖ On October 11, 1996, President Clinton signed "The Economic Espionage Act of 1996" into law.
- ❖ A violation of Section 1832 can result in stiff criminal penalties.



Compare with Patents



Compare with copyrights



- ❖ Programmer's dilemma
- ❖ The 1978 Copyright Act

Case Study_DoubleClick



- ❖ Defendants -- Dickey and Henderson, Top Executive of DoubleClick
- ❖ Plaintiff -- Kevin Ryan, President of DoubleClick
- ❖ Trade Secrets -- revenue projections, plans for future projections, pricing and project strategies, and database containing information collected by DoubleClick

Conclusion

- ❖ Intellectual Property an important asset to your business
- ❖ Need to protect it
- ❖ "Due diligence"
- ❖ May need to hire a lawyer

CheckList : IP Triggers

- ❖ Buying, selling or starting up a business
- ❖ Selecting a name or logo for a product, service or company
- ❖ Developing a new product or service
- ❖ Improving an existing product
- ❖ Bringing on a key employee or contractor for design, research or developmental work
- ❖ Providing business or technical information to suppliers or investors

CheckList : IP Triggers

- ❖ Launching a major sales effort
- ❖ Preparing new advertising or marketing literature
- ❖ Maintaining or expanding a customer list
- ❖ Creating original arts, crafts or designs
- ❖ Writing software
- ❖ Searching for advantages in a competitive market

Comparison and Overview

| | Utility Patents | Copyrights | Trademarks | Trade Secrets |
|----------------------------|--|--|--|---|
| Protectable subject matter | Useful processes, machines, articles of manufacture and compositions of matter | Works of authorship, including writings, music, works of art and the like, reduced to a tangible medium of expression | Words, names, symbols, or other devices used serve to distinguish goods or services. | Information not generally known in trade which gives a business an advantage over competitors. |
| Sources of Protection | Issuance of patent by the U.S. Patent Office | Federal protects when fixed in a tangible medium of expression | Common law protection, so long as proper use continues | Protected by common law, state statutes, principle of express or implied contract law and law of unfair competition |
| Terms of Protection | From issuance of patent to 20 years from filing of patent application | Life of author, plus 50 years for works created after 1/1/78. 75 years from first publication for works made for hire and anonymous and pseudonymous works | 10 years from issuance of Federal Registration renewable for additional 10 year terms, as long as properly used and not abandoned. | As long as information remains a secret |

Useful Web Sites

Patents and Trademark Office

<http://www.uspto.gov/>



Copyrights Office

<http://lcweb.loc.gov/copyright/>



Trade Secrets Resources

www.patents.com/secrets.sht

www.execpc.com/~mhalign/web.html

www.execpc.com/~mhalign/crime.html

Useful Web Sites

General Information on Intellectual Property Law

<http://miso.wva.com/~psecrest/subject.html>

<http://www.cfht.hawaii.edu/Reference/Library/Whatsnew.htm>

http://www.nolo.com/encyclopedia/pct_ency.html

<http://www.ipwatchdog.com/econsulting.html>

<http://www.findlaw.com/01topics/23intellectprop/index.html>

The End

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