

IP 101

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Introduction

What is Intellectual Property (IP)?

Why should you care?

Why is IP Important

- Your Business Likely Depends Upon it
 - Competitive Advantage?
- Exclusive Rights
 - Value in the Marketplace?

Common Mistakes

- Not having a basic understanding of IP
- Not Identifying important IP
- Not protecting important IP
- Not recognizing and realizing the value of IP

What We' ll Discuss

- Copyright
- Patent
- Trademark
- Trade Secret

Copyright

- Creative Expression
- Pictures
- Movies
- Written Materials
- Art - Jewelry

Patent

- Ideas Expressed in Inventions
- Machines
- Apparatuses
- Combination of Matter
- Improvements
- Methods

Trademarks

- Word, Phrase, Design
- Brand Identity

Trade Secret

- Information that Brings Value Because it is not Generally Known

Copyright

- Protects creative expression of authors
- Does not protect facts or ideas
- Rights attach when expression becomes “fixed in a tangible medium of expression.”
- Generally, term is life of author plus 70 years

Exclusive Rights

- Reproduction
- Distribution
- Modification
- Public Display/Performance

Who Owns Copyright Rights

- Author
- Employer
- Independent Contractor
 - Implications
 - Written Assignment of rights required

Transfers

- Grants Subject to Revocation
 - 5 year window beginning 35 years after xfer
- Not for Works Made for Hire
- Work Made for Hire \neq Grant of Ownership

Separate from Underlying Work

- The “Copyright” is Separate from the “Work”
- First Sale Rule

Joint Authors

- Indivisible Part of Unitary Whole
- Intent that the work be “Joint”
- Both Authors Make a Copyrightable Contribution

Perfecting Copyright Rights

- Federal Registration
 - Within 90 days of first publication for maximum rights
 - Allows for Statutory Damages
 - \$750 - \$30,000 per violation
 - Up to \$150,000 per willful violation
- Registration not required – but . . .

Copyright Infringement

- Fair Use
 - Criticism, comment, news reporting, teaching, scholarship or research
 - Rules of Thumb

Fair Use Factors

- Nature and Character of Use
- Character of Work Copied
- Amount Taken
- Effect on Market

Patents

- Protect ideas expressed in inventions
- Provide the right to exclude others from making, using, or selling the patented invention

Patents

- Provide a monopoly with regard to the subject matter of the patent (for a limited time)
- Require complete disclosure
- “Contract” with the government

Types of Patents

- Utility
- Design
- Plant

Term of Protection

- Utility – 20 years from filing date
- Design – 14 years from issuance
- Plant – 20 years from filing date

Patent Ownership

- Inventor Is Owner
- Patent Must be Filed in Name of Inventor
- Patent Rights may be Sold, Leased, Licensed

Employer Rights

- Shop Rights
- Assignment in Employment Agreement

Patent

- Novel
- Useful
- Non-Obvious

Patent

- First to Invent
- Invention Requires:
 - Conception
 - Reduction to Practice

Statutory Bars

- Offer to Sell
- Sale
- Public Disclosure
- Starts Clock on One-Year Grace Period

Provisional Patent Application

- Not a “real” patent
- Can never become enforceable
- Stops the clock on prior art
- Establishes a filing date
- One year period to test the market

Patent Infringement

- Accused device includes every element contained in a claim

Patent Claims

- Claim 1: A bucket comprising
 - A. a vessel for holding water;
 - B. a handle attached to said vessel; and
 - C. a spout formed into a rim of said vessel.

Patent Claims

- Claim 1: A bucket comprising
 - A. a vessel for holding water, wherein said vessel has a volume of between $\frac{1}{2}$ gallon and 2 gallons, said vessel is symmetrical about a vertical axis, said vessel has a top rim with a diameter and a bottom rim with a diameter, wherein said top rim diameter is greater than said bottom rim diameter ;
 - B. a handle attached to said vessel; and
 - C. a spout formed into a rim of said vessel

Patent Claims

- Claim 1: A bucket comprising
 - B. a handle attached to said vessel, said handle attached to said top rim and extending in an arc from a side of side top rim to an opposite side of said top rim, said handle constructed of A36 grade steel; and
 - C. a spout formed into a rim of said vessel

Patent Claims

- Broad vs. Narrow
- Value Obtained
- Narrow to overcome prior art

Trademarks

- Word, phrase, symbol, or design, or combination thereof, which identifies and distinguishes the **source** of the goods of one party from those of another
- Mark must be arbitrary or suggestive – not descriptive or generic

Trademarks

- Federal registration – “use in commerce”
- State registration
- Common Law rights

Service Marks

- Same as Trademarks – applied to services rather than goods

Trademark Rights

- Federal Registration:
 - Presumptive exclusive right to use the mark
 - Right to exclude importation
 - Unlimited duration – requires continuous use and renewal every 10 years

Trademark Rights

- State Registration
- Common law rights – based on use

Trademark

- Clearance Search
 - Prior to use
 - Avoid business disruption
 - Avoid unnecessary expense

Trademark Infringement

- Same or similar mark
- Same or similar goods/services
- Likelihood of consumer confusion

Trademark

- Administrative Proceedings
- Trademark Trial and Appeal Board (TTAB)

TTAB Proceedings

- Opposition
- Cancellation