Intellectual Property Overview

A Presentation by Michael J. Feigin, Esq.
Patents, Trademarks, General Practice
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About Your Presenter

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  - Education: Rutgers College, Seton Hall Law
  - Prior Technical Experience in IT
  - Prosecuted applications for AT&T, Vodaphone, Rus-Engineering, NEC, etc.
  - Presently work mainly with startup companies
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What is “Intellectual Property”?  

- A “property right” created by law for an intangible concept.
- The rights can be created, transferred, licensed, copied, etc.
- Typically, grants rights to exclude others from your Intellectual Property

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Source of the Right

“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”

- Article I, Section I, Clause 8 of the U.S. Constitution
Protectable Intellectual Property

- **Patents** cover compounds, machines and processes
  - Give the right to exclude others from making, using, offering for sale, selling, importing

- **Copyrights** cover works of authorship reduced to a tangible means of expression
  - Give exclusive rights to copy, distribute, perform, display, make derivative works

- **Trademarks** indicate source of goods and services
  - Others may not use mark to indicate a different source

- **Trade Secrets** are legally protected secrets
  - Cannot misappropriate, but can reverse engineer
The Value of IP

- Exclusive use of your “property” in the United States
- A deterrent to others to enter the market or compete
- Venture capital / gov. grants want to see IP
- Can license your “property” to other players
- Can stop infringing goods at the border
- Only way to survive in the market – learn from Vonage mistake

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Confidentiality: Pre-Patent Filing

- Before you file a Patent, you conceive of an invention, develop it, test it, use it, etc.
- Invention should be kept CONFIDENTIAL – this may be a trade secret
- The U.S. will give you a 1 yr grace period to file after making public, but not a good idea to rely on –
  - Rest of the world gives no grace period
  - May create more issues in litigation (cost $$$)
  - U.S. law may change

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Maintaining Confidentiality

- Essential for a trade secret (forever) or an invention before filing a Patent (will last 20 yrs)

- Ways to maintain confidentiality
  - Formal Confidentiality Agreement
  - Attorney-Client: Privilege & Confidentiality

- Keep records to determine misappropriation, date of conception, due diligence.

- Difficult to do when lots of people know, lots of time passes, people leave company, etc…

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Patents

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What Is Patentable?

- **Process**: “Method of routing calls to an IP phone . . .”
- **Machine**: “Device for receiving phone calls connected to an IP network . . .”
- **Manufacture**: “A black box having punched out holes for at least one phone and one network port . . .”
- **Composition of Matter**: “A mixture of 95% synthetic fiber and 5% steel wool forming . . .”
- **Combinations of the Above**
How it Works...

- Inventor gives invention to public:
  - How to make
  - How to use
  - Best mode

- Inventor gets ~20 yrs from filing to exclude:
  - Making
  - Selling
  - Using
  - Importing

Everyone Wins: Inventor gets limited duration protection for advancing society.

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Types of Patents

- **Design**
  - Protects ‘Ornamental Design for Article of Manufacture’
  - Term of 14 years

- **Utility**
  - Almost anything ‘new and unobvious under the sun made by man’ – Supreme Court
  - Cannot be law of nature, abstract, or natural phenomena
  - Term of 20 years

- **Plants**

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When Is an Invention Patentable?

- **Useful:** Any sludge is useful
  - “A new method of killing the weeds”
  - “A new method of helping the weeds grow”

- **Novel:**
  - “No one has killed weeds with a broken copy machine before!”

- **Non-Obvious:**
  - “… and it isn’t obvious to use a copy machine to kill weeds!”

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Provisional Application

- When pressed for time to disclose invention
- Have 1 year to convert to Utility Application
- Must be “enabling”
- May create more litigation issues later, will pay Practitioner and Patent Office fees twice

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Novelty Search

- Inventor disclosure to Patent Practitioner (form available)
- Search ensures your invention is new and unobvious
- Search at U.S. Patent Office and other databases

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Why Do a Search?

- To determine scope of patentability
- Familiarizes both the practitioner and the client with existing Patents and the technology
- Know what your competition is doing and what to protect

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Filing at the U.S. Patent Office

- Submit complete application and fee ($435)
- Submit Declaration signed by Inventors
- Submit Information Disclosure Statement (IDS)
- Submit Assignment Documents

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Typical Timeline

- **Search** – about two weeks
- **Drafting & Filing** – about two months
- **Information Disclosure** – within 4 months
- **Foreign Filing** – within 1 yr of U.S. filing
- **Office Actions** – 6-36 months after U.S. filing
- **Patent Issued** – 3 to 5 yrs from U.S. filing

Ex:

- 1/2013
- 3/2013
- 5/2013
- 1/2014
- 4/2014
- 9/2016

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Eventually...

About 3 to 5 years and $10k – 25k later...
To review . . .
Trademarks
What is Trademarkable?

- A trademark is a word, name, slogan, symbol, sound, smell, color, or anything else that is used to indicate the unique source of the goods.

- A service mark is the same as a trademark except that it identifies a service rather than a good.
What is Trademarkable?

- Must be No "Likelihood of Confusion"
- Cannot be "Merely descriptive" of Goods
- Must be Unique Name for Goods … or acquire "secondary meaning"
- **Primary Register**: Already have secondary meaning (i.e. LIMELOCK)
- **Supplemental Register**: May gain it (i.e. REMOTE LANDLORD)

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Trademark Clearance

- “Preliminary Search” – typically, look through U.S. Trademark Office records, use search engines for exact name.

- “Full Clearance” – search databases, periodicals, conduct Soundex searches, find everything.

- Why? Much less expensive to find right name first than change it later.

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U.S. Federal Registration

- Good throughout country
- Trumps state registrations
- Takes about 6 months to 1.5 yrs to register
- Further disclosures at years 5, 9 and every 10 yrs
- Can extend indefinitely – but must always refer to same source.

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What is a Copyright?

- Protection on any “original works of human authorship” fixed in a tangible medium and of sufficient length
- Not for: short phrase (that’s a trademark), slogan, software
- Is for: books, plays, music, movies, sculpture, source code, and certain databases
- Protection instant from time of creation of first draft
- No need to file to protect (in U.S. need to file before suit)

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Copyright Rights

- Filing eliminates some defenses of infringers (i.e., when also have copyright notice)
- Six basic protections: copying, distribution / transmitting, derivative works, public display, public performance
- “Fair Use” defense
- Protects both published and unpublished works
- Cannot protect ideas, forms, and common scenes
- Since 1978, most works are protected for 95 years from publication (or 120 years from creation or 70 years from a human author’s death)

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Real World Example
Most Famous Trade Secret?

- The key flavor mixture is "Merchandise 7X"?
- Formula kept in a bank vault in Atlanta, Georgia?
- Only 2 executives know the formula: some say each only knows half of it, and they are not allowed to travel together?
- Some say factory workers are rotated out frequently during the mixing process?
- Until 1991 you could not buy it in India because old Indian law required that trade-secret information be disclosed?
- The secret has been kept since 1886?

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Secret Formula for Coca-Cola (1886)

Ingredients

- Citrate Caffein, 1 oz.
- Ext. Vanilla, 1 oz.
- Flavoring, 2.5 oz.
- F.E. Coco, 4 oz.
- Citric Acid, 3 oz.
- Lime Juice, 1 Qt.
- Sugar, 30 lbs.
- Water, 2.5 Gal.
- Caramel sufficient

Flavoring

- Oil Orange, 80
- Oil Lemon, 120
- Oil Nutmeg, 40
- Oil Cinnamon, 40
- Oil Coriander, 40
- Oil Neroli, 40
- Alcohol, 1 Qt.

let stand 24 hours.
… but Coca-Cola Will Be Fine

- **Trademark** – The name ‘Coca-Cola’ estimated to be worth hundreds of millions of dollars

- **Copyrights** – Protects artistic works – their commercials, characters, merchandise, etc.

- **Patents** – Protects their bottle designs, methods of manufacture, etc.

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Thank You

Thank you for attending this Seminar.

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