

TCBA 1st Annual Intellectual Property Symposium
February 20, 2009 -- Texas Wesleyan Law School

The symposium will focus on leveraging Intellectual Property for business success. The speakers will discuss procedures and practices that encourage the development of Intellectual Property; the modes by which value can be obtained; strategies for leveraging Intellectual Property assets for business success; and practices to protect Intellectual Property. Invitations will go out to the business and intellectual property legal community, as well as to the local business community.

Chair: Kathleen Knight, Whitaker Chalk Swindle & Sawyer, LLP
Moderator: J. Andrew Lowes, Partner, Haynes & Boone, LLP
Panelists: Gregg Brown, Vice President and Chief IP Counsel, Alcon Inc.
Russ Holloway, Associate General Counsel-IP, Bell Helicopter, Textron
John McGowan, Associate General Counsel for IP, Lockheed Martin Aeronautics

Company

Jon McGough, Associate General Counsel, UNT System Office of General Counsel
Jim Walton, Law Offices of James E. Walton, PLLC
Mack Ed Swindle, Partner, Whitaker Chalk Swindle & Sawyer, LLP
Stephen Mosher, Whitaker Chalk Swindle & Sawyer, LLP

Schedule

12:30 pm Registration
1:00 pm Introduction – Kathleen Knight
1:15 pm Brief Overview of Patents, Trademarks, Trade Secrets and Copyrights

Panels

1:45 pm IP Issues for the Early Stage Company and Research Institutions – Evaluation, Funding, Ownership & Strategies
2:15 pm Strategies to Build and Protect IP within your Business – Designing and Implementing an Intellectual Property Management Program (what to protect; incentives for invention; and coordinating filings)
3:00 pm Question and Answer Session
3:15 pm Break
3:30 pm Monetizing Intellectual Property Part I – Acquisitions, Sales and Spin Offs, Joint R&D
4:00 pm Monetizing Intellectual Property, Part II – Getting value out of owned IP through licensing, product pricing, and litigation
4:45 pm Question and Answer Session
5:00 pm Reception

INTELLECTUAL PROPERTY SYMPOSIUM REGISTRATION FORM
February 20, 2009 -- Texas Wesleyan Law School

Fee for TCBA Intellectual Property Section Members: \$40

Fee for all others: \$50

Name _____ Address _____

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Mail to: TCBA, 1315 Calhoun Street, Fort Worth, Texas 76102

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The IP Family of Protection Mechanisms

Some Definitions, Procedures, and
Resources

Stephen Mosher
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Presented Feb. 20, 2009

Members of the family

- Copyright
- Patent
- Trademark
- Trade Secret
- Contract

An example

- A **beverage container** may embody all forms of Intellectual Property
- **Copyright:** graphics and text
- **Patent:** container shape or method of manufacture; opening device or cap
- **Trademark:** brand name, logo
- **Trade Secret:** recipe of the contents
- **Contract:** proprietary information not otherwise protected

Copyright

17 U. S. C. Chapters 1, 3, and 4

- A copyright is embodied in an “original work of authorship fixed in any tangible medium of expression.”
17 U.S.C. § 102
- Original: created for the first time
- Work: writing, graphic, design, sculpture, music, dance, architecture...
- Fixed: in a visible or audible form

Procedure and Notice

- Copyright is **automatic** upon creation, whether or not it is published -

Berne Convention, since March 1, 1989

Notice (optional but recommended):

© 2009 Author's Name

Registration: By application to U. S. Copyright Office

Registration of Copyright

- Select and fill out application form. Most often used forms are:
 - TX (textual);
 - VA (visual arts);
 - PA (performing arts);
 - SR (sound recordings).
- Submit with fee and sample to the U. S. Copyright Office.
- Await examination and issue of Registration Certificate.

Benefits of Registration

- Right to file suit in Federal Court to enforce;
- Option of claiming statutory damages and recovery of attorney fees in an action for enforcement;
- Gives rise to a presumption that the copyright is valid.

Copyright vs. Ideas

- Protects **expression** of ideas, not the idea itself
 - A fixed, visible image, graphic, writing
 - A recorded sound or sound sequence
 - A 3-dimensional sculpture or structure
- Ideas may be protected by contract
 - Non-disclosure agreement
 - Confidentiality agreement

Term of Copyright

- 95 years from year of first publication; or
- 120 years from year of creation,
whichever expires first; or
- 70 years from death of author.

These rules apply for works created after
January 1, 1978.

Copyright vs. Patent

- Ideas that have utility may be protected by a grant of patent.
- Purely functional or utilitarian features of an article not usually copyrightable.

Patent

35 U. S. C. §§ 101, 102, 103

- Grant of an exclusive right for limited time
- To exclude others from making, using, offering for sale, or selling or importing the patented invention
- An invention
 - Machine, product, composition of matter, article of manufacture, process, business method, ornamental design
 - New, useful, not obvious

New, Useful, Not Obvious

- New:
 - Not known or used by others in the USA before the date of invention;
- or
- Not patented or published or available to the public anywhere more than one year before an application for patent in the USA

Useful

- The invention must have a specific and substantial utility.
- This means:
 - Must be operable for its intended purpose;
 - It cannot be a perpetual motion machine.
- Exception: Design Patent
 - Ornamental design only;
 - Independent of function of the article

Not Obvious

An invention:

- cannot be obvious to a person of ordinary skill in the field of the invention; or
- may be obvious because it is easily suggested by considering two or more inventions together.

Application for Patent

35 U. S. C. §§ 111, 112, 113

- **Specification:**
 - Written description:
 - Fully discloses the invention;
 - Enables others to practice the invention; and
 - Describes the best mode of the invention
 - Claims:
 - Particularly and distinctly setting forth the invention
 - Drawing:
 - Where necessary (nearly always)
- **Oath:**
 - Applicant is the inventor
- **Fee**

Examination of Application

- Examiner's search for prior art
- Office Action written by Examiner
- Applicant's written response
- Repeated Office Action and response, which is usually a Final Office Action
- Notice of Allowability & Issue Fees due
- Grant of Patent, Issue of printed patent

Grant of Patent

- Printed patent sent to Applicant
- Marking of patented product or article made by patented process: U. S. Patent No. 7,XXX,XXX
- Term of Patent: up to 20 years from filing date of the application if maintenance fees paid at four year intervals

Underlying Basis

- Copyrights and Patents arise from the U. S. Constitution, Article I, Section 8, clause 8:
 “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.”
- Patents & copyrights, and registration of Trademarks are subject of Federal Laws and Rules.
- Trademarks and Trade Secrets are subjects of State Law and The Common Law.

Enforcement

Benefits under Federal Law include Federal Court jurisdiction

- Patents: Presumption of validity
- Copyright: Registration enables remedies for unauthorized use
- Trademark: Registration enables constructive notice, incontestability after five years of use, a presumption of validity and other benefits.

Term of a Patent

- 20 years from date application for patent was filed; or
- 17 years from date patent was granted or 20 years from date application was filed, whichever is longer, if the application was filed before June 8, 1995.

Trademark

Lanham Act (1946)

Trademark Law Revision Act (1988)

- Distinctive mark or indicia associated with an entity, product, or service.
- Generally denotes authenticity.

Examples include:

- Words or symbols or combinations thereof;
- Designs, images, colors;
- Sounds or smells;
- 3-dimensional configurations.

Distinctiveness

- A spectrum of properties of marks, from most to least distinctive:
 - **Fanciful**: made-up word or combination of symbols, but without intrinsic meaning;
(Kodak, Xerox)
 - **Arbitrary**: has meaning but unrelated to user's products or service;
(Purple Dairy)
 - **Suggestive**: of some aspect of user's products or services;
(Slumber Inn)

Distinctiveness (continued)

- **Descriptive:** of intended purpose, function or other aspects of user's goods or services, including shape, origin, or user's surname, as long as the mark has secondary meaning as a brand;
(Stone's Masonry)
- **Generic:** the common name for goods or services;
(hardware, grocer).
Generic marks cannot be registered.

Registration of a Trademark

- Application
- Examination and Search
- Examiner's Office Action
- Applicant's Response
- Notice of Allowance
- Period of Opposition
- Issue of Registration Certificate

Marks for Trademarks

- Registered marks bear the ® symbol after last character.
- Unregistered marks may use ™ or SM after last character to indicate owner's claim to use of the mark.
- TM = trademark.
- SM = service mark.

Trade Secret

- Arises from two bodies of law: The *Uniform Trade Secrets Act (UTSA)*, and, in several states, including Texas, the *Restatement (First) of Torts (Restatement)* and the common law.
- **Restatement definition:** “any formula, pattern, device or compilation of information which is used in one’s business, and which gives him an opportunity to obtain an advantage over competitors who do not know or use it.”
- The **UTSA definition** is similar and also includes the attribute that a trade secret “[is] the subject of efforts that are reasonable under the circumstances to maintain its secrecy.”

Trade Secret

- Protection only lasts as long as the information is secret.
- Examples:
 - Kentucky Fried Chicken
 - Secret blend of herbs & spices locked behind three doors within a vault.
 - Coca Cola®
 - One person knows only part of recipe.

IP Protection by Contract

- To protect ideas, proprietary or confidential information during disclosure from owner to recipient:
 - Non-disclosure Agreement (NDA)
 - Confidentiality Agreement
 - Provided for in an Agreement of greater scope

The Example, Revisited

- A **beverage container** may embody all forms of Intellectual Property
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Resources

- www.copyright.gov for copyright information;
 - See also: Title 17, United States Code
- www.uspto.gov for patent and trademark information;
 - See also: Title 35, United states Code
- *The Intellectual Property Handbook*, Edited by William A. Finkelstein and James R. Sims,
 - © 2005, American Bar Association
- Stephen Mosher at smosher@whitakerchalk.com