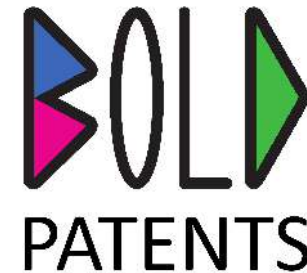


IP 101: Patent, Trademark, Copyright and Trade Secret Law

J.D. Houvener, ESQ, MBA, PE
founder of Bold IP, PLLC

February 2, 2018



Intellectual Property Series: 101,201, and 301

February 2, 2018

March 2, 2018

April 6, 2018



IP 101:
Learning the Law of
Patents, Trademarks,
Copyrights and Trade
Secrets and how they
apply to your
business/startup

IP 201:
Creating a plan for
Patents, Trademarks,
Copyrights and Trade
Secrets into your
business/startup

IP 301:
Implementing Patents,
Trademarks, Copyrights
and Trade Secrets into
your business/startup

Agenda:

8:00-8:05: Gather, Coffee, and Get Seated

8:05-8:15: Around-the-Room Introductions

8:15-8:45: Patent Law Introduction

8:45-9:00: Patent Workshop & Sharing

9:00-9:15: 15-Minute Break

9:15-9:45: Trademark Law Introduction

9:45-10:00: Trademark Workshop & Sharing

10:00-10:15 – 15-Minute Break

10:15-10:45 – Copyright Law Introduction

10:45-11:00: Copyright Workshop & Sharing

11:00-11:15: 15-Minute Break

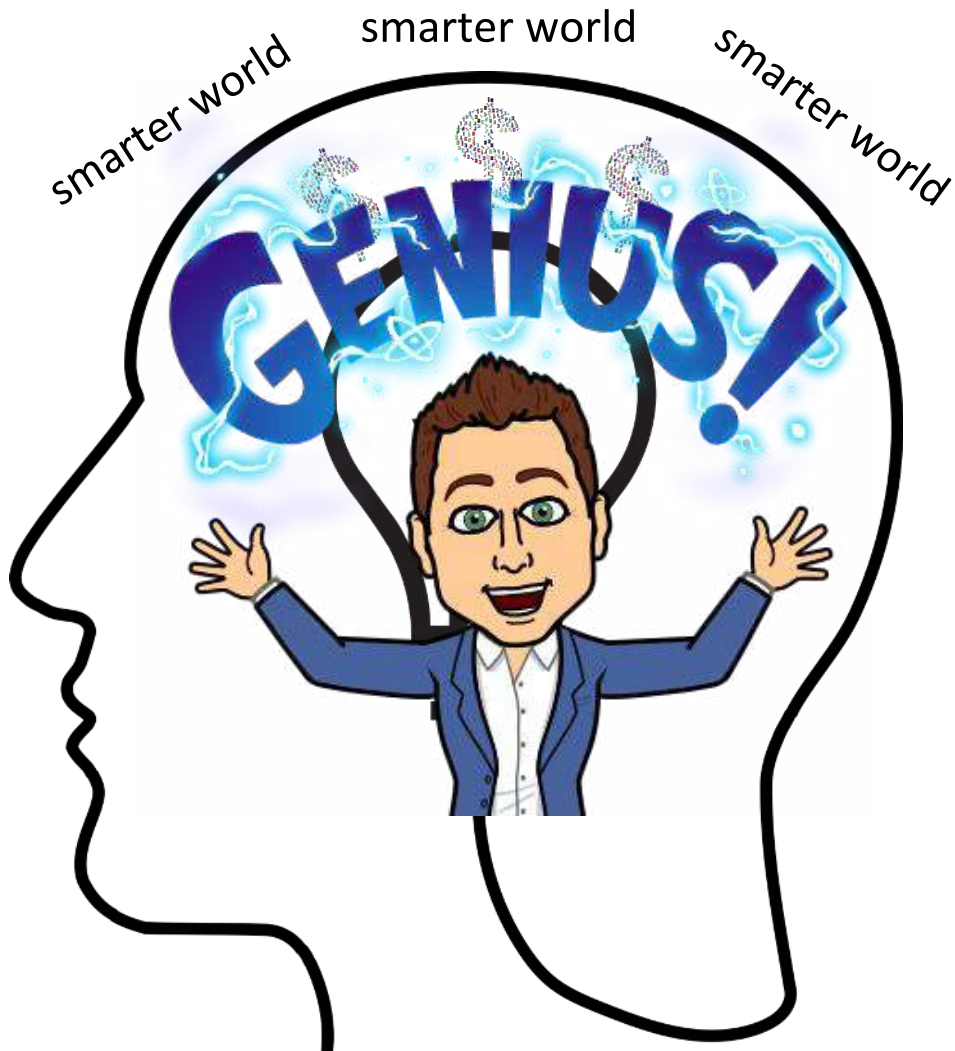
11:15-11:45: Trade Secret Law Introduction

11:45-12:00: Trade Secret Workshop & Sharing

The 4 Pillars of IP

- Patents
- Trademarks
- Copyrights
- Trade Secrets





Intellectual Property

Q: What is *intellectual property*?

A: Intellectual property is a product of the mind and human intellect.

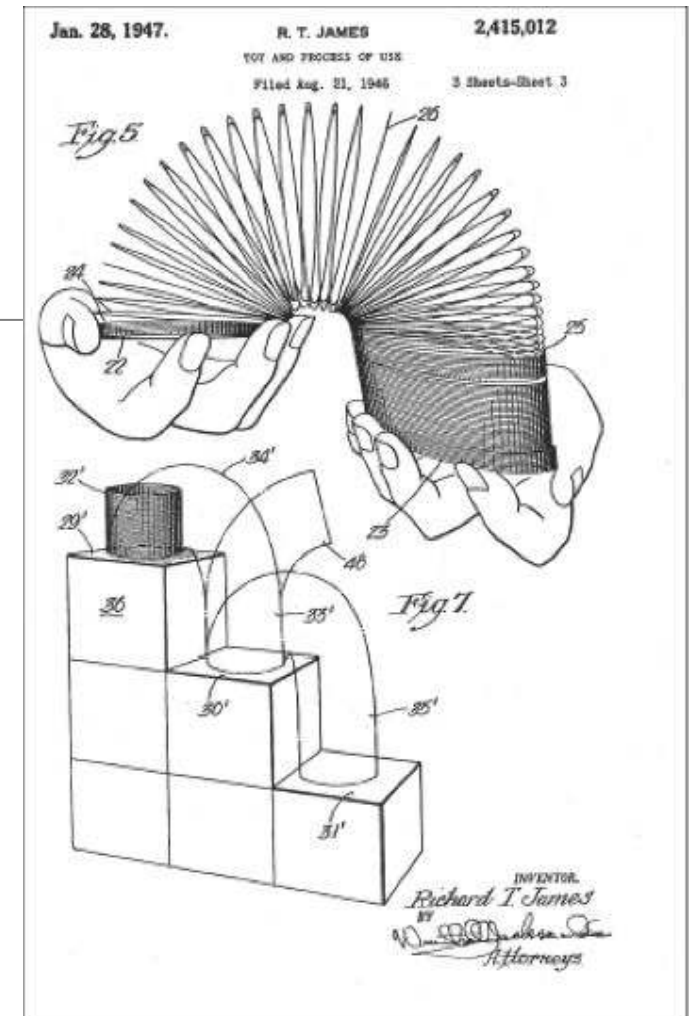
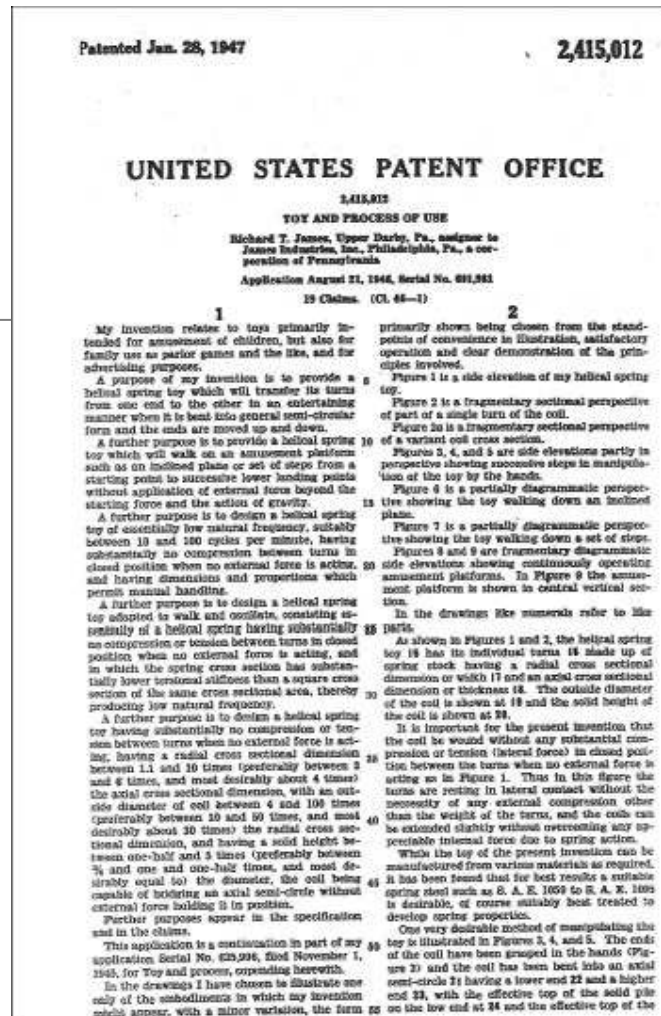
Q: Why is intellectual property important?

A: These products, “ideas” “inventions” and “creations” have commercial value - \$\$\$ and help make the world a better place

Patents: Protect

A PATENT gives an inventor the right to exclusive use of their invention for a limited period of time. (20 years)

- Three requirements
 - Novelty
 - Nonobviousness
 - Utility
- Types of Patents
 - Plant Patents
 - Design Patents
 - Utility Patents
 - Device, Manufacture, Composition of Matter or Process/Method



U.S. Constitution gives the power to Congress

"[t]o promote the progress of science and useful arts, by securing for limited time to authors and inventors the exclusive rights to their respective writings and discoveries."

Key Federal Statute:

United States Code, Title 35

Patents: Eligibility (Utility)

- Machine (e.g. Apparatus)
- Manufacture (e.g. Assembly)
- Composition of Matter (e.g. Chemical)
- Process (e.g. Method)

Requirements for Application

1. Declaration
2. Power of Attorney
3. Assignment
4. Drawings
5. Specification
6. Claims
7. Information Disclosure Statement
8. Application Transmittal Form
9. Fee Determination Form
10. Filing by Mail/Postcard
11. Certificate of Mailing/Fax
12. Application Data Sheet

All that is needed to get a filing date is the submission of a complete spec (with claims) and drawings, as needed.

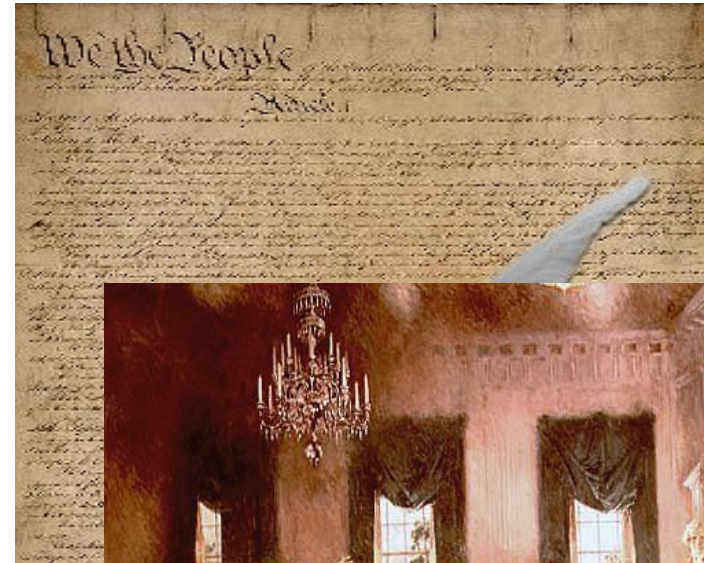
The Specification and Drawings must meet the **enablement** requirement:

“Sufficiency of disclosure or **enablement** is a **patent law requirement** according to which a **patent** application must disclose a claimed invention in sufficient detail for the notional person skilled in the art to carry out that claimed invention.” (MPEP 2164)

Constitutional Basis

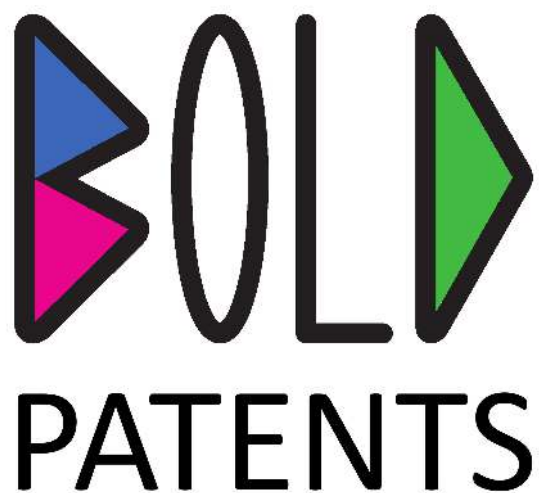
Article I, Section [8] of the U.S. Constitution gives the power to the Congress

“To promote the progress of science and useful arts, by securing for limited time to authors and inventors the exclusive rights to their respective writings and discoveries.”



Patents: Protect

- American Invents Act
 - First to File vs. First to Invent
 - Worldwide Prior Art
 - PTAB
- Timing is Critical
 - Best to FILE before public disclosure
 - Use NDA if you must disclose
 - Statutory Bars for Selling or Publicly Disclosing
 - 1-Year Grace Period for US



Simplified

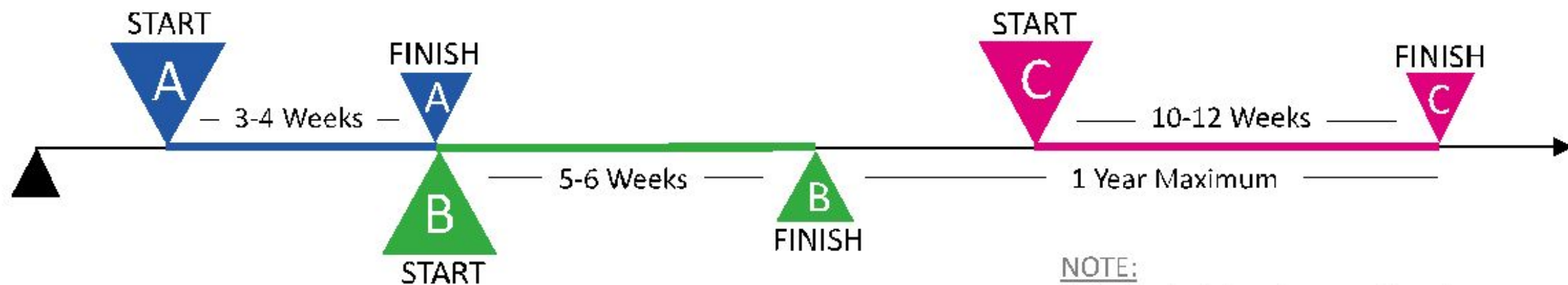
A-B-C Patent Application Process Flow

Patentability Search:

- Takes 3-4 Weeks
- Answer on Patentability/Scope
- Recommended Path Forward

Nonprovisional Patent Application:

- Takes 10-12 Weeks
- Update Specification/Drawings
- Draft Claim Language



Initial Consultation:

- Eligibility Issues
- Inventorship/Ownership
- Long-Term Business Goals

Provisional Patent Application:

- Takes 5-6 Weeks
- "Patent Pending" status
- Develop *Enabling* Disclosure

NOTE:

Submittal of the Nonprovisional Patent Application "C" must be done within 1 year of submittal of the Provisional Patent Application "B" date.

Patents: Enforce

- USPTO is not Police!
- 15-20 Year Limited Monopoly to Prevent Others From
 - Making
 - Using
 - Selling
 - Importing
- Federal Court
- Patent Trial & Appeal Board (PTAB)

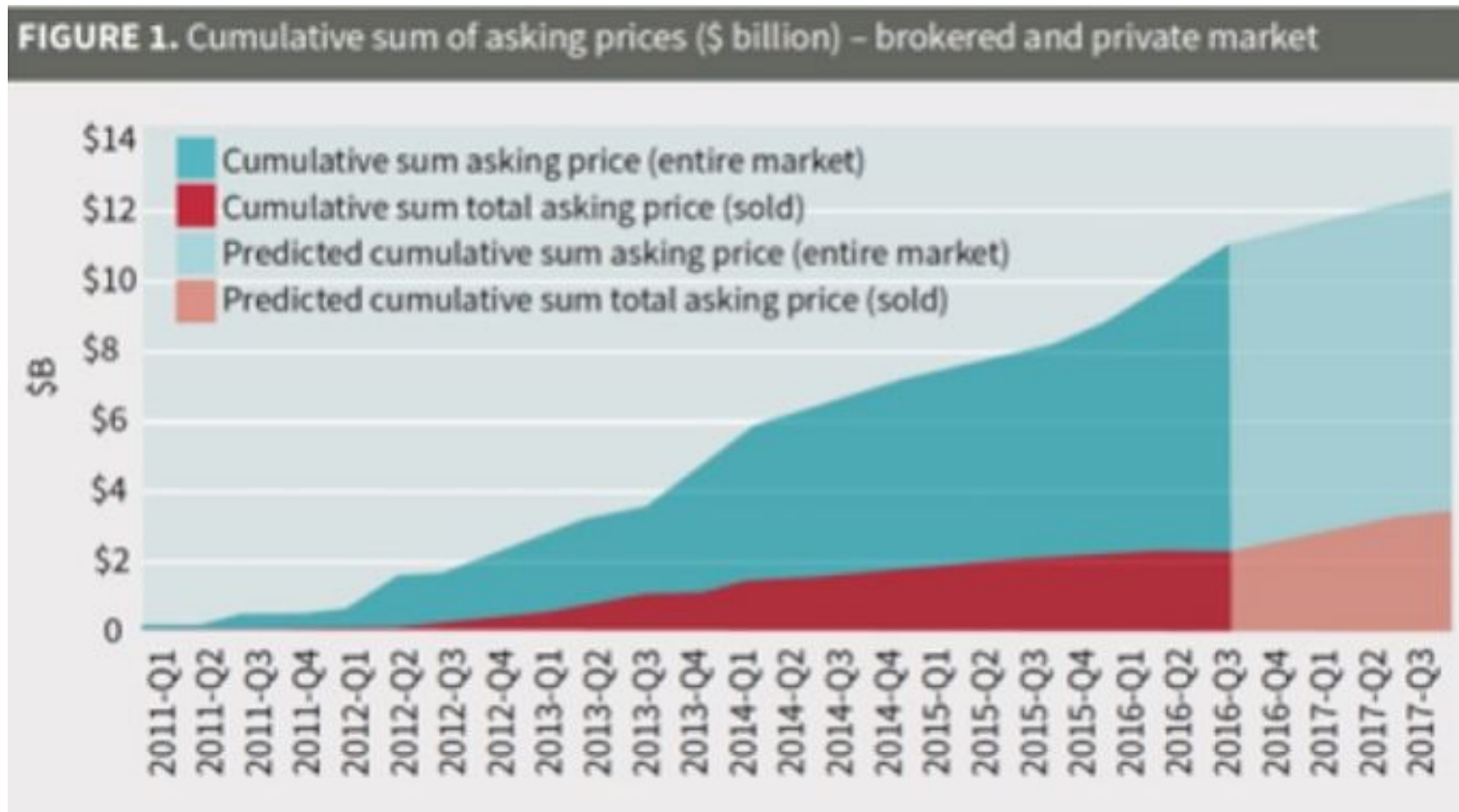
Patents: Enforce

1. Monitor Technology/Market
2. Validity Opinion
3. Infringement Opinion
4. Cease & Desist
5. Settlement
6. Arbitrator
7. Trial

Patents: Monetize

- Patent Rights are fully Licensable, Transferrable, Descendible, and Assignable
- Enforcement Proceedings usually result in Settlement (Licensing, Sale, or Combination)
- Competitive Advantage
- Improvements

Patents: Monetize



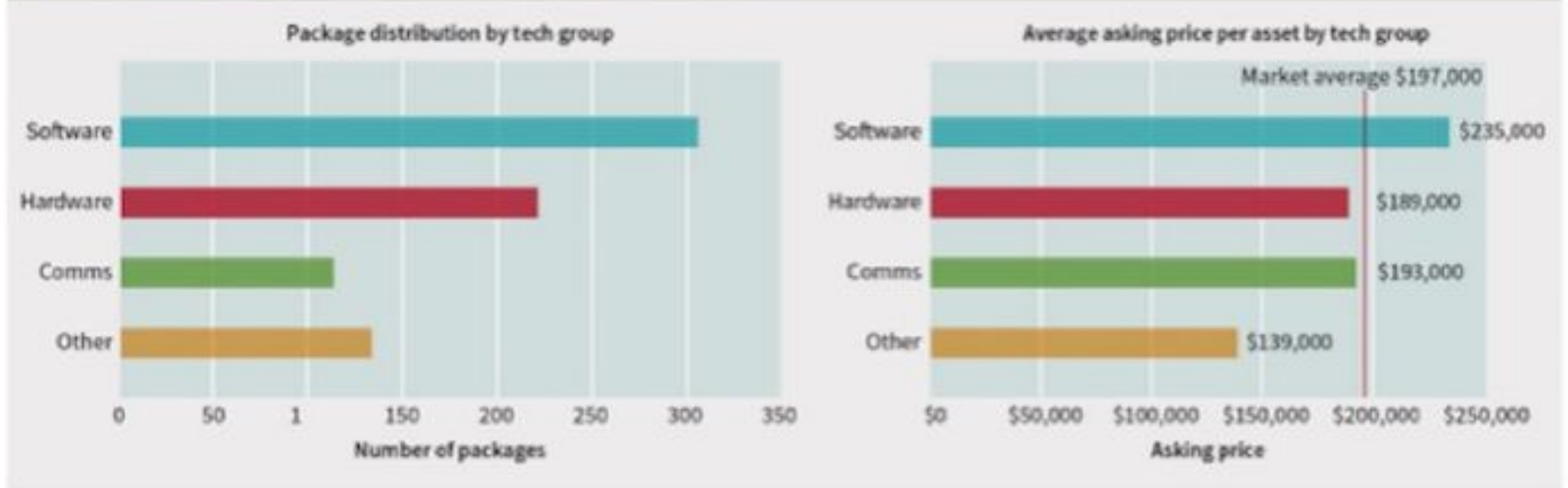
Source: <http://www.ipwatchdog.com/2017/04/10/2016-patent-market-report-overview/id=81689/>

Patents: Monetize

TABLE 2. Brokered patent market contents

	2016 market year	2015 market year	% change
Packages	772	578	34%
US-issued	6,966	6,203	12%
Assets	11,478	8,870	29%

FIGURE 4. Package distribution and asking price per asset by technology group



Source: <http://www.ipwatchdog.com/2017/04/10/2016-patent-market-report-overview/id=81689/>

Patents: Monetize

FIGURE 6. Frequency of package sizes (total assets)

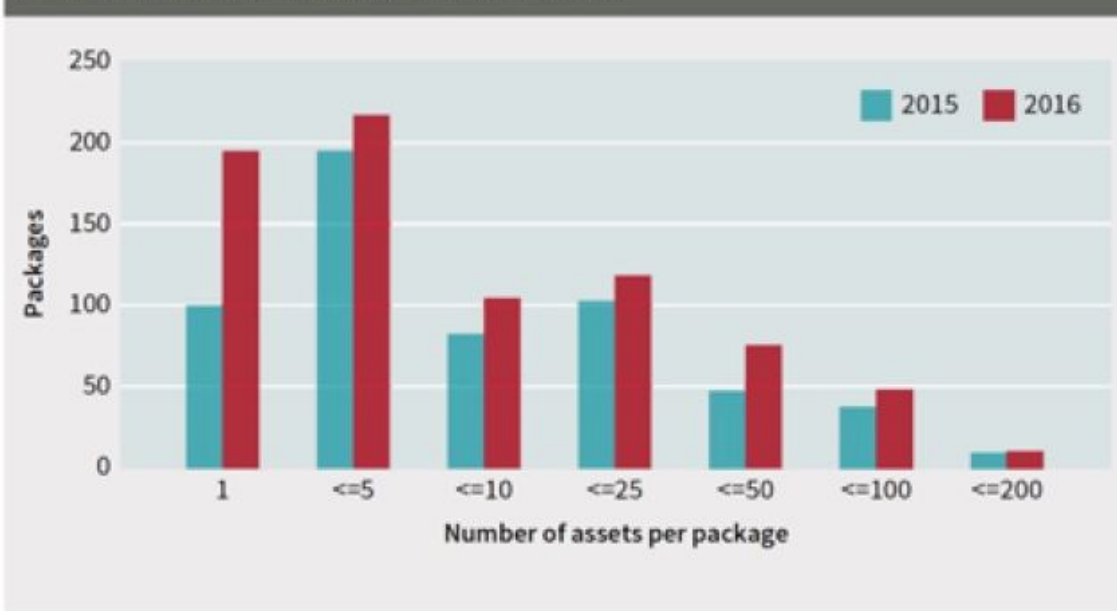


FIGURE 13. Cumulative sales by years from package listing date



Patents: Workshop

- Write down 3 ways that your business is impacted by Patent Law
- For each way, list 1-2 ways in which you can leverage these impacts in the market
- Share just one Patent law Impact with the class and one leverage point

Think about what kinds of technology are involved to get from A-B? Do you, a vendor, supplier, customer have patentable subject matter (devices, manufactures, compositions of matter, processes) that are novel, nonobviousness, and utility that could set you apart from Competition?

Trademarks: Protect

- Legal Basis: *Lanham Act 15 USC Section 1051*
- Begins at the Moment of Sale
- The Customer's Perspective
- State vs. Federal
- Perpetual Duration
- Classifications

Typed Drawing

Word Mark	SLINKY
Goods and Services	IC 028. US 022 023 038 050. G & S: TOYS OF METAL AND PLASTIC, namely, SPRING TOYS, [TOY RINGS,] BATHTUB TOYS, PULL TOYS, PIN WHEELS, [TOY EYE GLASSES, TILEGAMES, PICK-UP-STICKS,] HAND-GUIDED SPINNING WHEEL TOY, AND INTERLOCKABLE TOY CONSTRUCTION AND BUILDING BLOCKS AND PIECES. FIRST USE: 19450000. FIRST USE IN COMMERCE: 19450000
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	73629147
Filing Date	November 7, 1986
Current Basis	1A
Original Filing Basis	1A
Published for Opposition	June 9, 1987
Registration Number	1455493
Registration Date	September 1, 1987
Owner	(REGISTRANT) JAMES INDUSTRIES, INC. CORPORATION PENNSYLVANIA P.O. BOX 407 BEAVER STREET HOLLIDAYSBURG PENNSYLVANIA 16648 (LAST LISTED OWNER) POOF-SLINKY, LLC LIMITED LIABILITY COMPANY MICHIGAN 4280 S. Haggerty Road Canton MICHIGAN 48188
Assignment Recorded	ASSIGNMENT RECORDED
Attorney of Record	STANLEY B. KITA
Prior Registrations	0427951;1137993;1180355;1276398
Type of Mark	TRADEMARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20170919.
Renewal	2ND RENEWAL 20170919
Live/Dead Indicator	LIVE

Trademarks: Protect

TRADEMARKS protect the unique name, design, logo, symbols or colors used by a business to identify their products or services.

- Begins at the Moment of Sale
- The Customer's Perspective
- State vs. Federal
- Perpetual Duration
- Requirements
 - Source Identifying
 - Not Merely Descriptive
 - Not Confusingly Similar
- Types of Trademarks
 - Word Mark
 - Design Mark
 - Trade Dress

Google

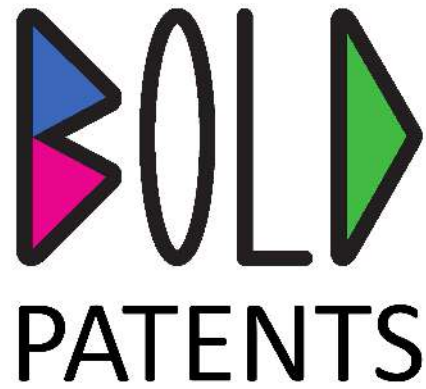
Word Mark	GOOGLE
Goods and Services	IC 035. US 100 101 102. G & S: Dissemination of advertising for others via the Internet. FIRST USE: 20001000. FIRST USE IN COMMERCE: 20001000
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Serial Number	78433507
Filing Date	June 10, 2004
Current Basis	1A
Original Filing Basis	1A
Published for Opposition	January 24, 2012
Registration Number	4123471
International Registration Number	0859851
Registration Date	April 10, 2012
Owner	(REGISTRANT) Google Inc. CORPORATION DELAWARE 1600 Amphitheatre Parkway Mountain View CALIFORNIA 94043 (LAST LISTED OWNER) GOOGLE LLC LIMITED LIABILITY COMPANY DELAWARE 1600 AMPHITHEATRE PARKWAY MOUNTAIN VIEW CALIFORNIA 94043
Assignment Recorded	ASSIGNMENT RECORDED
Prior Registrations	2806075;2884502
Type of Mark	SERVICE MARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR).
Live/Dead Indicator	LIVE

Key Federal Statute:

United States Code, Title 15
Chapter 22

Also called the "Lanham Act"





Simplified

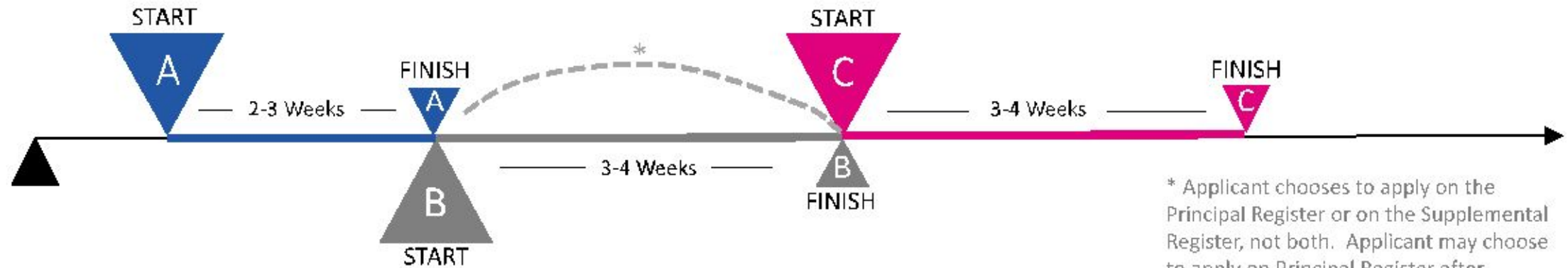
A-B-C Trademark Application Process Flow

Trademark Search:

- Takes 2-3 Weeks
- Answer on Trademark Availability
- Recommended Path Forward

Principal Register Trademark Application:

- Takes 3-4 Weeks
- Detailed list of goods/services **
- Description of the mark
- Grants trademark national recognition and protects from infringement throughout US



Initial Consultation:

- Eligibility Issues
- Ownership
- Areas of Commerce
- Goals of Business

Supplemental Register Trademark Application:

- Takes 3-4 Weeks
- Detailed list of goods/services
- Description of the mark
- Grants trademark recognition in specific state and protects from infringement in that state

* Applicant chooses to apply on the Principal Register or on the Supplemental Register, not both. Applicant may choose to apply on Principal Register after trademark is registered on Supplemental Register, but usually not vice versa.

**When applying for a trademark on the Principal Register, can apply for a mark already in use or can apply on an intent to use basis.

Trademarks: Enforce

- USPTO is not Police!
- Prevent another from using your mark or confusingly similar mark
- Famous Marks
- Federal Court
- Trademark Trial and Appeal Board (TTAB)

Trademarks: Enforce

1. Monitor Market/Competition
2. Validity Opinion
3. Infringement Opinion
4. Cease & Desist
5. Settlement
6. Arbitrator
7. Trial

Primary goal of TRADEMARK law is to reduce customer confusion



Trademarks: Monetize

- Brands can be sold/licensed
- Settlements from Federal Court or TTAB
- Differentiate from competition

Trademarks: Monetize



SIR GUY®

SOLD

Specnaz®

Make offer

**Penguin's
Paradise®**

\$5,000 or Best Offer

**Sweat Is
Intoxicating®**

\$125000 OBO

SEARCHUS®

25,000 USD



[Company](#)

[Our Services](#)

[Available IP](#)

[Wanted IP](#)

Trademarks

[Patents For Sale](#)

[Trademarks For Sale](#)

Trademarks: Workshop

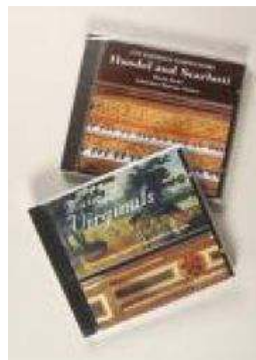
- Write down 3 ways that your business is impacted by Trademark Law
- For each way, list 1-2 ways in which you can leverage these impacts in the market
- Share just one Trademark law Impact with the class and one leverage point

Think about what kinds of goods and services you sell. What might you be selling in 3-5 years? You want to try to get the broadest protection possible. Ever done a search to see if anyone else is using the same name in the same industry?

Copyrights: Protect


COPYRIGHT protects creative and artistic expressions for example, books, drawings, paintings, computer programs and music.

- Common law copyright
- Requirements
 - Independent Creation
 - Artistic Expression
 - Fixed in Tangible Means
- Types of Copyright Works
 - Written
 - Visual
 - Sculptural
 - Musical
 - Performing



Certificate of Registration

This Certificate issued under the seal of the Copyright Office in accordance with title 17, United States Code, attests that registration has been made for the work identified below. The information on this certificate has been made a part of the Copyright Office records.

 *Marybeth Peters*
Register of Copyrights, United States of America

Registration Number: VAu 965-360

Effective date of registration: November 28, 2007

Title _____
Title of Work: Tire Tread Design
Nature of Work: Technical Drawing

Completion/ Publication _____
Year of Completion: 2007

Author _____
Author: Brandon Lagarde
Author Created: Technical drawing
Work made for hire: Yes
Citizen of: United States
Year Born: 1968
Anonymous: No Pseudonymous: No

Copyright claimant _____
Copyright Claimant: Sudden Impact Racing, LLC
P.O. Box 11168, Jefferson, LA, 70181
Transfer Statement: Assignment

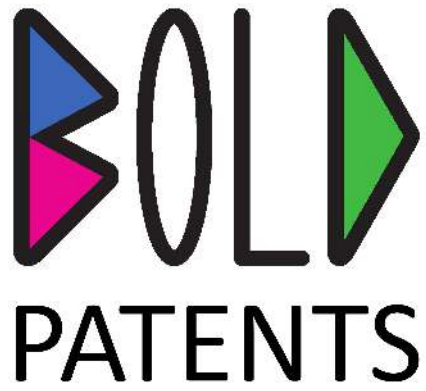
Limitation of copyright claim _____
Previously registered: No

Certification _____
Name: Neil J. Coig, authorized agent of Sudden Impact Racing, LLC
Date: November 21, 2007

Key Federal Statute:

United States Code, Title 17

Original Art, Fixed in a tangible means



Simplified

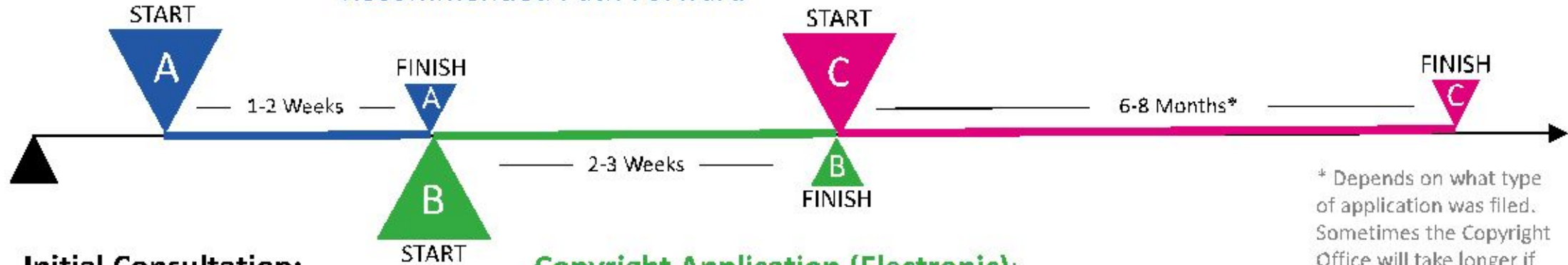
A-B-C Copyright Application Process Flow

Authorship/Creation Information:

- Takes 1-2 Weeks
- Collect Information about Creation
- Recommended Path Forward

Registration:

- Takes 6-8 Months*
- Confirm Registration Information



Initial Consultation:

- Eligibility Issues
- Ownership/Authorship
- Goals of Individual/Business
- eCO (Electronic Registration)

Copyright Application (Electronic):

- Takes 2-3 Weeks
- Title, Publication Description, Author, Claimants, Limitations, Rights, Correspondent, Mail Certificate, Handling, Certification
- Payment of Fee

* Depends on what type of application was filed. Sometimes the Copyright Office will take longer if physical specimens are submitted. Electronic Submissions take typically 6-8 months and paper submissions take around 8-10 months

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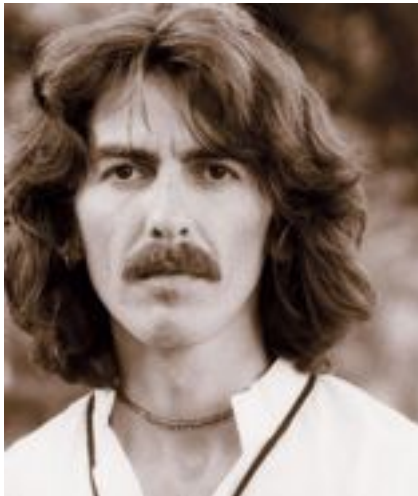
Copyrights: Enforce

- Library of Congress are not Police!
- Give Proper Notice
- Monitoring
- 3rd Party Enforcement (e.g. ASCAP)
- Federal Court

Copyrights: Enforce

1. Monitor Market/Air
2. Validity Opinion
3. Infringement Opinion
4. Cease & Desist
5. Settlement
6. Arbiter
7. Trial

The primary goal of COPYRIGHT law is the prevention of theft of another's unique expression



George Harrison (1970's)

My Sweet Lord (November, 1970)

Together!



The Chiffon's (1960's)

He's So Fine (December 1962)

Copyrights: Monetize

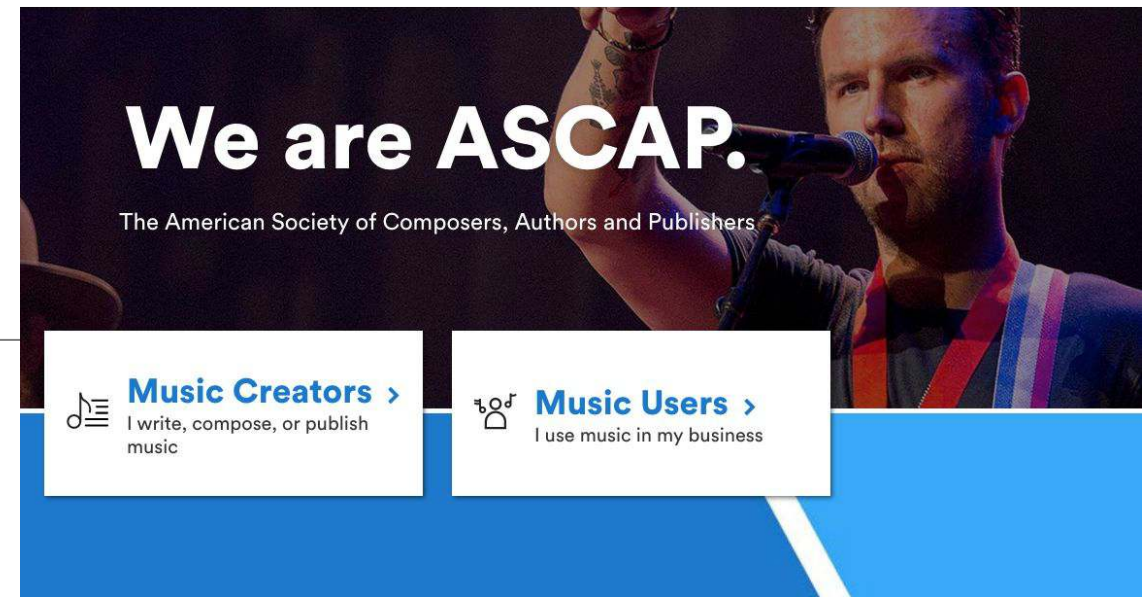
- Settlements
- Direct Licensing/Sale
- 3rd Party Licensing
- Creating Derivative Works

Copyrights: Monetize

HOME > DIGITAL > NEWS

APRIL 28, 2016 11:30AM PT

YouTube Will Let Copyright-Disputed Videos Keep Earning Ad Revenue While Claims Are Pending



SONGWRITERS+PUBLISHERS
YOUR MUSIC. YOUR RIGHTS. YOUR MONEY.
LET SESAC REPRESENT YOU.

GO

LICENSEES
LICENSING THE WORLD'S FASTEST GROWING
MUSICAL REPERTORY IS EASIER THAN EVER.

GO

YOUR SESAC ACCOUNT

Choose Your Login

GO

RUMBLEFISH/HFA
LEARN ABOUT OUR SUITE OF SERVICES.

GO

Copyrights: Workshop

- Write down 3 ways that your business is impacted by Copyright Law
- For each way, list 1-2 ways in which you can leverage these impacts in the marketz
- Share just one Copyright law Impact with the class and one leverage point

Think about what kinds of creations you make (either on purpose or accidentally) during the course of serving customers? How might your use of other's creations be an infringement?

Trade Secrets: Protect

- State-Specific: 19.108 RCW (WA)
- Requirements
 - Make effort to keep secret
 - Economic value
 - Not easily ascertainable
- Employment Agreements
- Nondisclosure Agreements
- Computing Security



Key Federal Statute:

United States Code, Title 18,
Section 1839

NEW: Defend Trade Secrets Act
of 2016

Trade Secrets: Enforce

- Called Misappropriation
- Federal Mechanism to bring Suit
 - *18 USC Section 1836*
- Exit Agreements/Severance Packages
- Licensing/Technology Transfer

Trade Secrets: Enforce

1. Employee Monitoring
2. Validity Opinion
3. Misappropriation Opinion
4. State or Federal Statute
5. Settlement
6. Arbiter
7. Trial

Trade Secrets: Monetize

- Technology Transfer
- License Technology
- Employee Contracts— Non-Compete Clauses
- Competitive Advantage in Marketplace

Trade Secrets: Workshop

- Write down 3 ways that your business is impacted by Trade Secret Law
- For each way, list 1-2 ways in which you can leverage these impacts in the market
- Share just one Trade Secret law Impact with the class and one leverage point

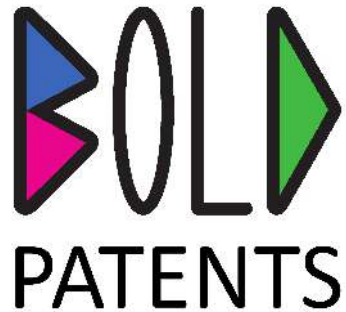
Think about what “secret sauce” your company has? What information, if it got out, would your competitor be licking their chops to get? Know any former employees that might look to misappropriate information?



Genius is 1 % inspiration and 99 % perspiration.

Thomas Edison

Thank you! Questions?



J.D. Houvener

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www.boldip.com

let's
DISCUSS



Top 10 IP Tips for Businesses

1) Limit Disclosure

2) Notices

3) Ownership

4) Goals

5) Advisors

6) R&D Analysis

7) Security

8) Goods & Services

9) Creative Assessment

10) Valuation

Choosing, Protecting & Enforcing Your Brand

Choosing

- Begins with the heart of the business – answering the big Why?
- What do you want your customers to think/say about you?

Protecting

- What areas of commerce are you in?
- Who will you be selling to?
- Have you done a professional search? Ready to register?

Enforcing

- Are you actively monitoring the market & registry?
- Did you catch someone infringing?