

Protecting Your Law Firm's Hidden Treasures:

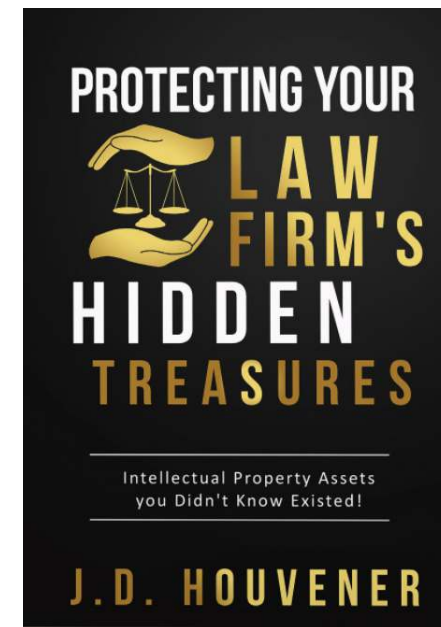
Intellectual Property Assets you didn't know existed



J.D. HOUVENER,

PATENT ATTORNEY AND FOUNDER OF
BOLD IP, PLLC

MAY 24, 2017



First, Some Myths...



“Law Firms are known only by their Surnames, and those can’t be registered trademarks...”

“There is no sense in registering a copyright for things you write for the firm, it puts you at a serious risk for breaching ethical rules”

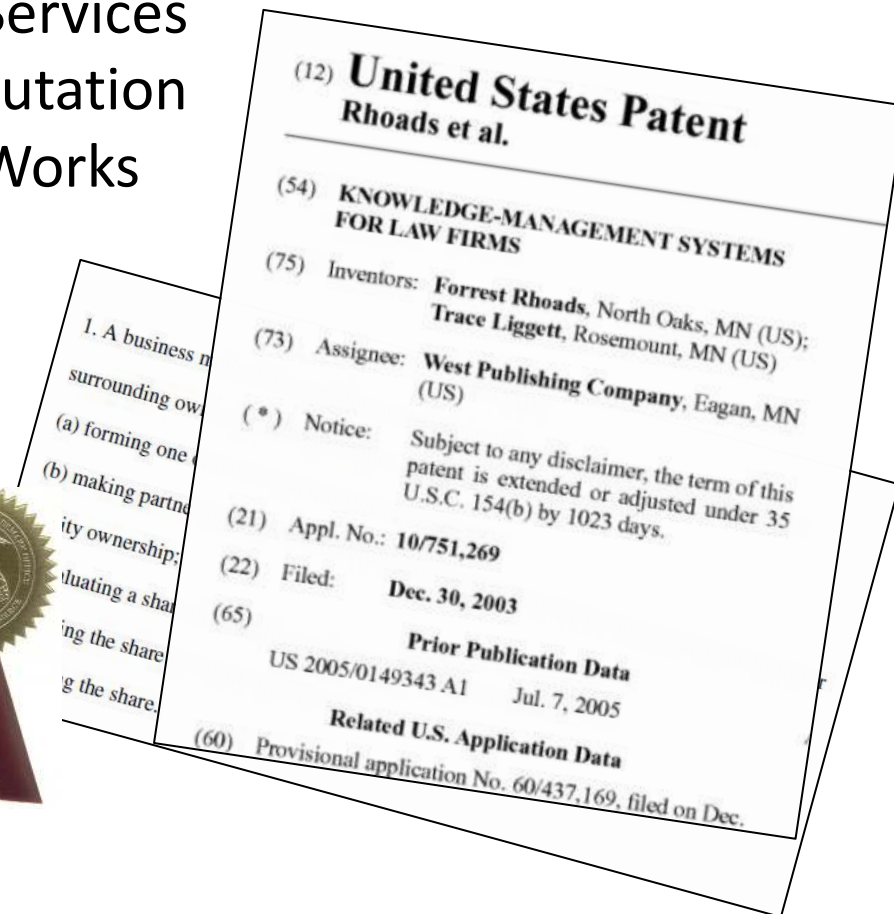
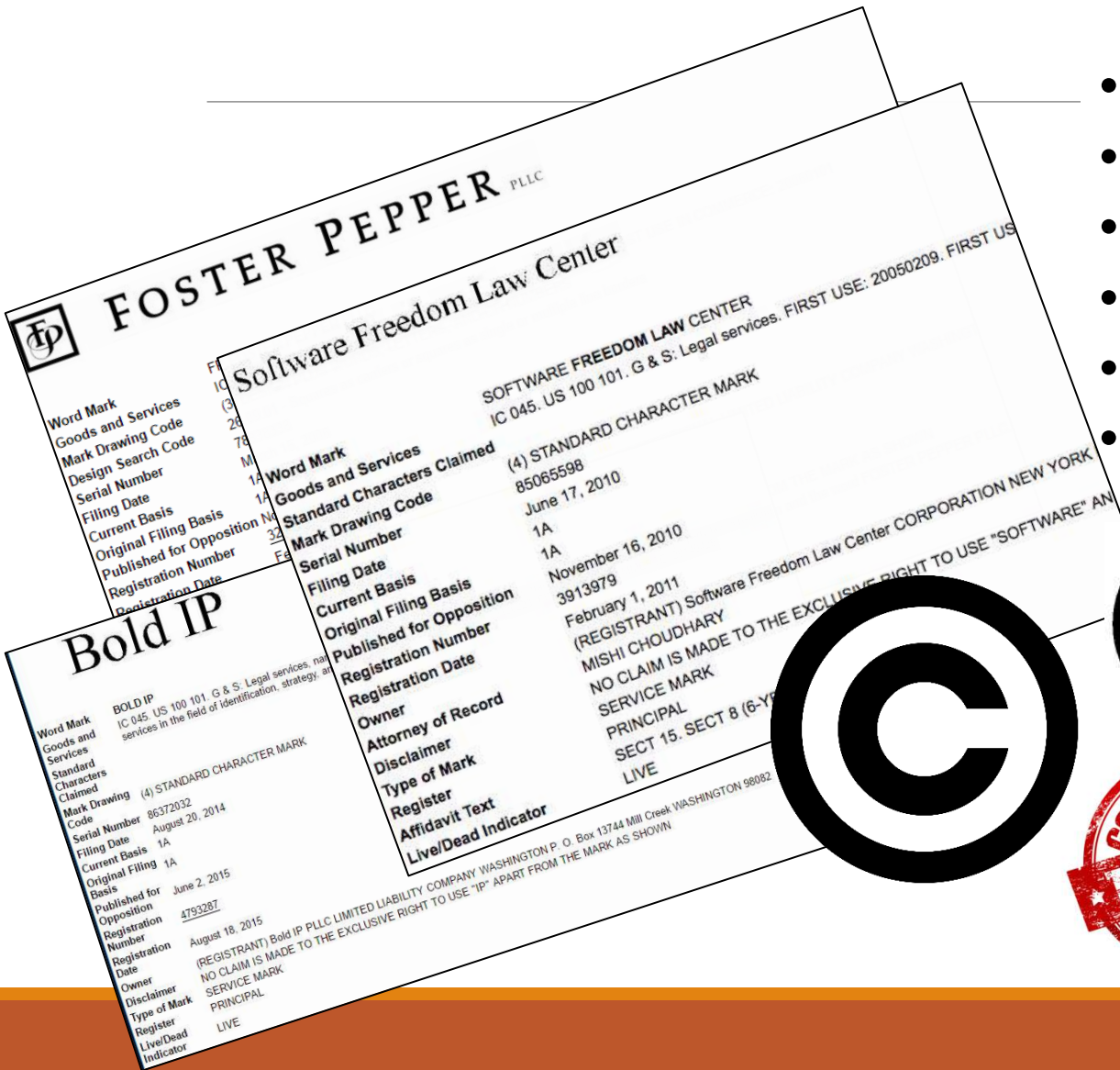
“...Attorneys do not need to worry about IP because its only important for businesses who develop/sell real products and need to protect their brands.”

“Law Firms and their attorneys can’t patent anything, they wouldn’t qualify...”

“There is no special sauce here at the law firm, we simply serve our clients the best we can with the resources we are given”

Some Truths...

- Law firm is like any other business
- Selling Legal Services
- Goodwill/Reputation
- Copyrighted Works
- Patents
- Trade Secrets



Types of Intellectual Property

- Trademark
- Copyright
- Trade Secret
 - Patent

What is a trademark?

15 U.S. Code § 1127

- A trademark is a word, symbol, or phrase that accomplishes two things:
 - 1. distinguish an individual's (or company's) goods/services from the goods/services of others
 - 2. indicate the source of goods/services
- An applicant for a trademark registration must have a bona fide intention to use the trademark in commerce (or already be using the mark in commerce)



What is “use in commerce” as applied to law firms (service marks)?

15 U.S. Code § 1127

- **A service mark is “used in commerce” when:**
 - (1) the mark is used or displayed in the sale or advertising of services, and
 - (2) the services are rendered in commerce

(a service mark is considered a sub-set of trademark)



How do you acquire rights in a trademark?

- Assuming a trademark qualifies for protection, rights to the trademark can be acquired in one of two ways:
 - (1) by being the first to use the mark in commerce; or
 - (2) by being the first to register the mark with the USPTO



What is trademark infringement?

15 U.S. Code § 1114

A trademark is infringed when:

- (1) someone who is not the owner of the trademark uses (or intends to use), without permission or authorization from the owner, a reproduction/copy/colorable imitation of a registered trademark in connection with the sale/ distribution/advertising of any goods/services, and
- (2) that unauthorized use (or intent to use) is likely to cause confusion for consumers



What is the standard courts use for determining trademark infringement?

- Consumer Confusion / Likelihood of Confusion Standard
- Courts typically look at 7 factors
 - (1) the **strength** of the mark;
 - (2) the **proximity** of the goods;
 - (3) the **similarity** of the marks;
 - (4) evidence of **actual confusion**;
 - (5) the similarity of **marketing channels** used;
 - (6) the **degree of caution** exercised by the typical purchaser;
 - (7) the **defendant's intent**.





How do trademarks apply to law firms?

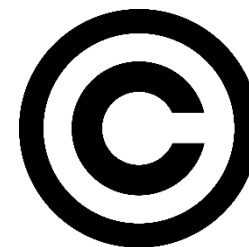
- Law firms provide legal services!
- No law firm should be the same as another, show off your distinctiveness!
- Protect Different Service Offerings:
 - Example: Bold Patents, Bold Ventures, and Bold Innovations are both pending applications
- Protect Goods Offerings:
 - Example: “Law Firm In a Box”, proprietary software or practice management suite



What is a copyright?

17 U.S. Code

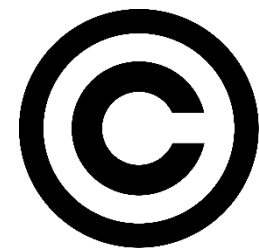
A Copyright is the right of an author/creator to control the use and distribution of his/her work for a limited period of time.



What can be copyrighted?

17 U.S. Code § 102

- Only an original work of authorship which is fixed in a tangible medium of expression can receive a copyright.
- You cannot copyright an idea. However, once an idea is written down, recorded, or otherwise transferred into physical form, that resulting “work of authorship” is “fixed” and therefor eligible for copyright protection.

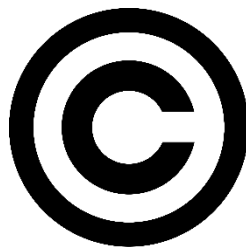


What does the owner of a copyright have the exclusive right to do?



17 U.S. Code § 106

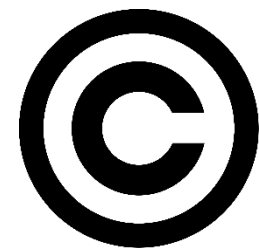
- The owner of a copyright has the exclusive right to
 - reproduce
 - perform
 - display (publicly) and/or
 - prepare derivative works based on his/her original work of authorship (or authorize others to do so)



When does copyright protection begin and how long does it last?

17 U.S. Code § 302

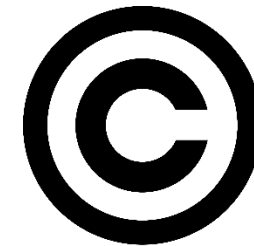
- Copyright protection begins when the original work of authorship is created and fixed in a tangible form
- Copyright protection lasts until 70 years after the author's death (if author is named), 95 years from the year of the works' creation (if work is anonymous), and 120 years from the work's creation (if the work is done for hire)





How do copyrights apply to law firms?

- Many of the documents that attorneys prepare in the course of their legal practice can be considered “original works of authorship” which are absolutely eligible for copyright protection
- Some examples of copyrightable materials often used by law firms or prepared by a firm’s attorneys are:
 - (1) the written code for discovery software developed in-house, and
 - (2) legal documents which are unique to the firm (i.e. not industry standard or comprised of boiler plate language)



What is a Trade Secret?

18 U.S. Code § 1839

- A trade secret is any confidential business information, not generally known by the public, which has economic value to the business or entity, and which the business or entity has taken reasonable steps to keep secret



When is another's use of an entity's trade secret actionable?

UTSA § 1

- If a court determines that the information qualifies as a trade secret, the court can prohibit another party from using the trade secret if:
 - Obtained the information through improper means, or
 - Obtained the information through misappropriation





How do trade secrets apply to law firms?

- A law firm is a business. Just like many other businesses, law firms often possess information that is not publicly or widely known and from which the firm derives economic benefit.
- Some examples of the types of information law firms may possess which can be considered trade secrets are:
 - (1) advertising strategies/processes to attract/retain clients,
 - (2) lists of current clients,
 - (3) in-house developed discovery software for which no patent has yet been filed



What is a patent?

- A patent is a contract between an inventor and the U.S. government granting (for a limited time) the inventor the sole right to exclude others from making, using, or selling the invention in exchange for public disclosure of the invention



What is patentable?

35 U.S. Code § 102

- An invention is patentable if it is different from all previous inventions that were public knowledge prior to the filing date (it is novel)

35 U.S. Code § 103

- An invention is patentable if, when the invention is compared to all previous inventions, a determination is made that a person having ordinary skill in the art would not have thought to create the invention (it is non-obvious)
- To be patentable the invention must also be patentable subject matter, and be useful, but both of these requirements are easier to satisfy than novelty and non-obviousness



What must be included in a patent application?

35 U.S. Code § 111

■ A patent must include:

- (1) a written description of the invention, and of the manner and process of making using it, and conclude with claims which identify the subject matter which the inventor regards as the invention,
- (2) drawings of the invention, and
- (3) the name of the inventor(s)





How do patents apply to law firms?

- Law firms utilize technology and various business processes when providing legal advice to clients.
- Some examples of things that law firms could potentially obtain patents for are:
 - (1) discovery software
 - (2) methods or processes of conducting client intake or discovery (or any other necessary elements of a legal practice)



Microsoft Word 97
- 2004 Document

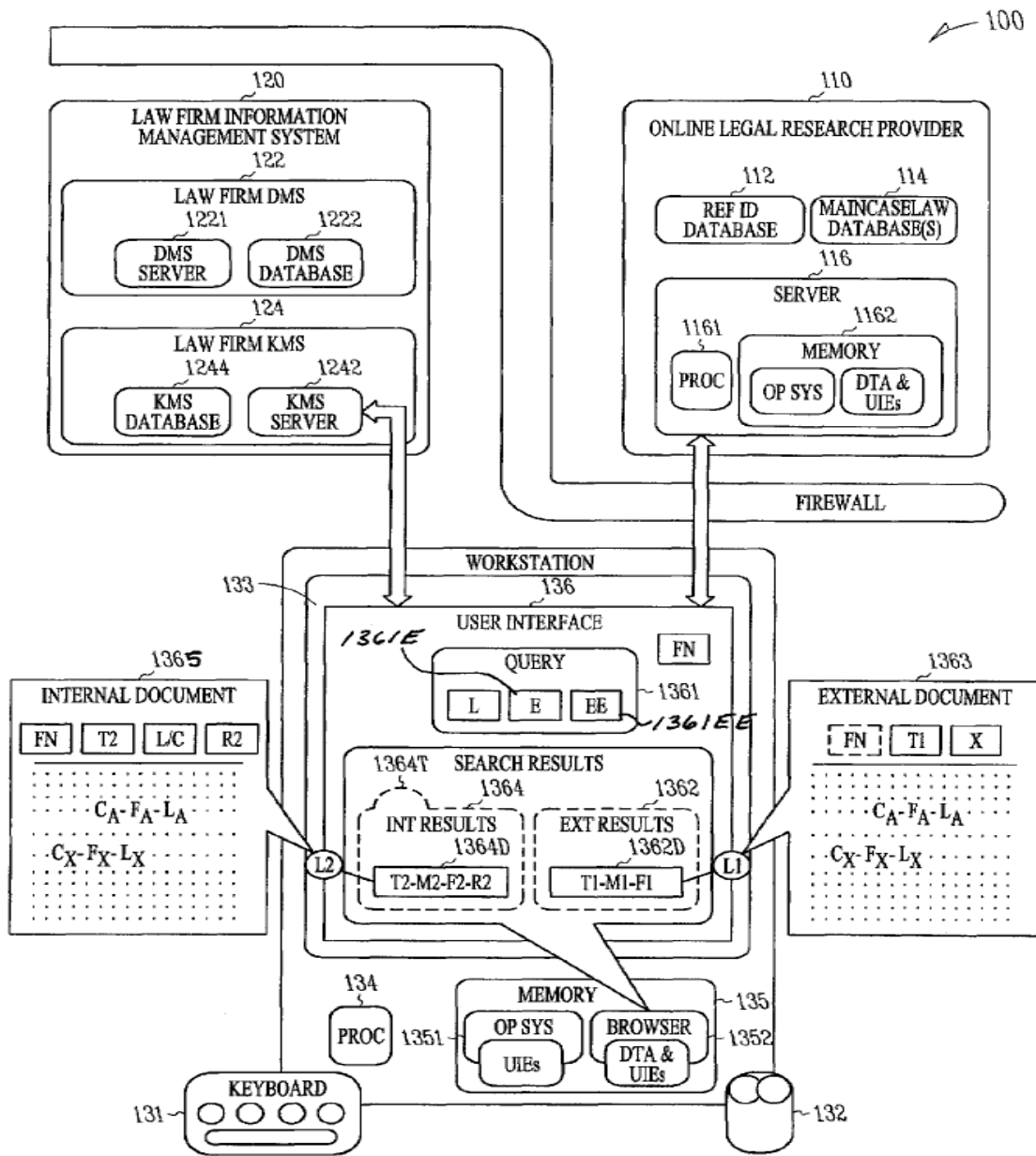


FIG. 1

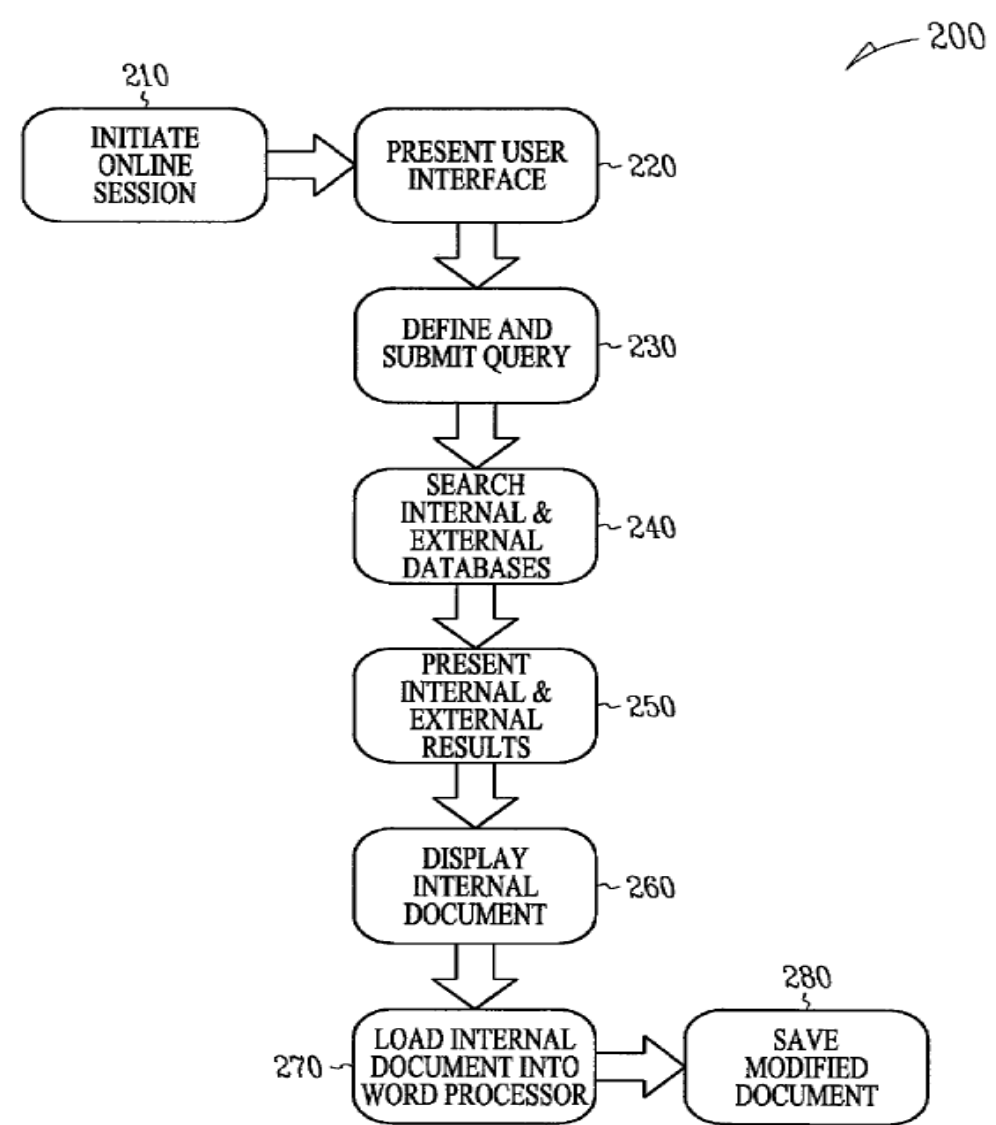


FIG. 2

Thank you!

Speaker's Information:

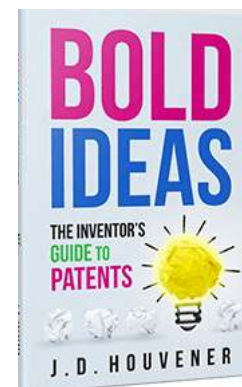


J.D. Houvener, MBA, PE, Esq.

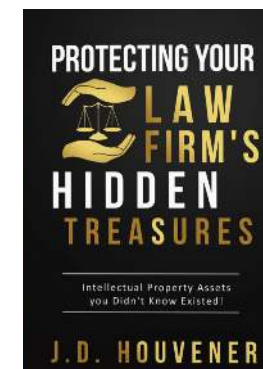
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Questions?

Q & A

Q: Why are trademarks important for law firms?

Q: What prerequisites must a mark satisfy to serve as a trademark?

Q & A

Q: Does an original work of authorship need to be registered to receive copyright protection?

Q: What is a “derivative work?”

Q & A

Q: What is a “work made for hire?”

Q: What constitutes “improper means” for obtaining a trade secret?

Q & A

Q: What constitutes “misappropriation” for obtaining a trade secret?

Q & A

Q: What steps (at a minimum) must a law firm take to protect trade secrets?

Q: What is patentable subject matter?

Q & A

Q: When is an invention considered “useful” for purposes of determining patentability?

Q: How long are patents valid (i.e. how long does patent protection last)?

Q: When is an invention considered “public knowledge?”