Understanding the Essentials of Intellectual Property

Trademarks, Patents, Copyright, Trade Secrets

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West Virginia University Libraries
“A category of intangible rights protecting commercially valuable products of the human intellect.” “A commercially valuable product of the human intellect, in a concrete or abstract form...”—Black’s Law Dictionary
Types of Intellectual Property

1. Patents
2. Trade Secrets
3. Trademarks
4. Copyright
Patent and Three Types

◆Patent—

- a property right granted by the Government of the United States of America to an inventor “to exclude others from making, using, offering for sale, or selling the invention throughout the United States or importing the invention into the United States” for a limited time in exchange for public disclosure of the invention when the patent is granted.
Three Types of Patents

**Utility**—any new, useful, and nonobvious process, machine, article of manufacture, or composition of matter, or any new and useful improvement thereof.

**Design**—a new, original, and ornamental design for an article of manufacture

**Plant**—an asexually reproduced distinct and new variety of plant.
The terms of utility and plant patents are twenty years from application date.
The term of design patents is fourteen-years from date of issue.
7 Step Strategy

1. Find keywords to use with the Index to US Patent Classification.
   - What does the invention do?
   - What is the end result?
   - What is it made of?
   - What is it used for?

2. Check the Manual of Classification.

3. Read Class and Subclass definitions.

4. Retrieve and Browse Patent Titles and Abstracts

5. Retrieve and review all patent documents within relevant classifications.


7. Check References and previously published documents.
2009 Trademark Expo Set for May 8-9
Apply to Exhibit Here

The United States Patent and Trademark Office will hold its annual Trademark Expo next May 8-9 at the agency’s headquarters in Alexandria, Virginia. The 2008 Expo attracted 7,000 people and received wide media coverage. Next year’s two day event will focus again on educating the public about the value and important role trademarks play in our society and the global marketplace. It will feature themed displays, company booths, costumed characters interactive exhibits and trademark related seminars for attendees. An intensified effort will be made this year to attract school children to the event.

All individuals, companies, non-profit organizations and educational institutions that own a valid registered United States trademark are invited to apply to exhibit. The deadline for applications is January 9, 2009. Applications will be evaluated on the following criteria: Brand recognition, educational value of the proposed exhibit and category diversity. Space is limited so apply today. Those selected to exhibit will be notified by February 1, 2009.

To view photos of the 2008 Expo go here

Answers to frequently asked questions about the Expo are available here.
How Much Will it Cost?

(Small Entities – Utility Patent)

- **Filing fee:** $75 (electronic), $155 (paper)
- **Search Fee:** $255
- **Examination Fee:** $105
- **Issue Fee:** $720
- **Maintenance Fees:**
  - 3.5 years: $465
  - 7.5 years: $1180
  - 11.5 years: $1955
- **Total:** $4755, $4835 (at minimum)
Other Important Patent Resources

Trade Secret

“a device or technique used in a particular trade or (transf.) occupation and giving an advantage because not generally known.” -- Oxford English Dictionary

“something (as a formula) which has economic value to a business because it is not generally known or easily discoverable by observation and for which efforts have been made to maintain secrecy”—Merriam Webster Dictionary
Advantages to Trade Secrets

- An inventor is not required to obtain a patent. They may choose that the benefits of keeping the invention secret outweigh the benefits of a patent.
- Property of its owner as long as it remains secret; patents have a limited term (the oldest known trade secret has been kept since 1623)
- Can be exploited on a global basis, patents are only valid in the country in which they were obtained
Disadvantages of Trade Secret

- once they become public, the owner has limited legal remedies to prevent others from making, selling, or using the invention.

- Owner takes on the responsibility of protecting it and preventing its disclosure, which may cost a lot of money.
A word, name, symbol, or device that is used in trade with goods to indicate the source of goods and to distinguish them from the goods of others.

A service mark is the same as the trademark except that it identifies and distinguishes the source of service rather than a product.
Administered on federal level by USPTO.
- http://www.uspto.gov

Can be granted on the state level.
- West Virginia Secretary of State
  http://www.sos.wv.gov/business-licensing/trademarkservicemarks/

International applications handled through the USPTO as well.
Examples

- Trademarks
  - “mac” (Apple Computer)
  - “intel inside”

- Service Marks
  - FedEx (package delivery service)
  - Blockbuster (video rental service)
Prevents others from using a confusingly similar mark.

Does NOT prevent others from selling the same goods and services under a clearly different mark.
“Rights in a federally-registered trademark can last indefinitely if the owner continues to use the mark on or in connection with the goods and/or services in the registration, and files all necessary documentation in the USPTO at the appropriate times.”

Trademarks last as long as you continue to pay the fees.
Strong Marks

◆ For a discussion of what makes a strong mark see *Trademark.Legal Care for your Business & Product Name*, pp. 9/2-9/18.

◆ Important terms
  - Distinctive Marks
  - Nondistinctive Marks
  - Generic Labels
  - Composite Terms and Slogans
Reasons for Trademark Registration Refusal

Not all words, names, symbols or devices function as trademarks. For example, matter which is merely the generic name of the goods on which it is used cannot be registered.

The grounds for refusal under Section 2 of the Trademark Act (15 U.S.C. §1052) may be summarized as:

1. the proposed mark consists of or comprises immoral, deceptive, or scandalous matter;
2. the proposed mark may disparage or falsely suggest a connection with persons (living or dead), institutions, beliefs, or national symbols, or bring them into contempt or disrepute;
3. the proposed mark consists of or comprises the flag or coat of arms, or other insignia of the United States, or of any State or municipality, or of any foreign nation;
Reasons for Trademark Registration Refusal (cont.)

4. the proposed mark consists of or comprises a name, portrait or signature identifying a particular living individual, except by that individual's written consent; or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow;

5. the proposed mark so resembles a mark already registered in the Patent and Trademark Office (PTO) that use of the mark on applicant's goods or services are likely to cause confusion, mistake, or deception;

6. the proposed mark is merely descriptive or deceptively misdescriptive of applicant's goods or services;

7. the proposed mark is primarily geographically descriptive or deceptively geographically misdescriptive of applicant's goods or services;

8. the proposed mark is primarily merely a surname; and

9. matter that, as a whole, is functional.
Trademarks do not have to be exactly alike to be infringing. Are they similar in Sound, Appearance, or Meaning?

However....

- Exactly the same marks can co-exist if their goods or services are not similar.
Some Steps in Filing Trademark

- Search for use in commerce
- Use in commerce
- Register at USPTO
- Published for Opposition
- Pay renewal fees
Accessing Trademarks Online

www.uspto.gov

- Trademarks main page
- 3. Search Trademarks
- 18. Fees
Components of a Trademark

- Type of Good or Service sold under the proposed Trademark
- Symbol, or word or phrase used
Design Elements have a three level numerical designations:

Example: Clown Design

Category: 02 (humans)
Division: 01 (men)
Section: 17 (clowns)

02.01.17
Registering Trademark

◆ Paper
  ■ Commissioner for Trademarks
  P.O. Box 1451
  Alexandria, VA 22313-1451
  ■ 1-800-786-9199

◆ Register online using the Trademark Electronic Application System (TEAS)

Strongly Recommended

◆ http://www.uspto.gov/teas/index.html
Trademark Fees

◆ Application for registration per international class
  ▪ Paper $375
  ▪ Electronic filing, TEAS application $325
  ▪ Electronic filing, TEAS Plus application $275

◆ Renewal
  ▪ $400 per class
“A form of protection provided to authors of ‘original works of authorship’ including literary...and certain other intellectual works, both published and unpublished.”

Exclusive right to reproduce the copyrighted work, prepare derivative works, and to distribute copies (among other things).

Currently a work does not have to be register to be protected. But you cannot bring suit unless the work is registered.
Copyright protects form of expression rather than the subject matter of the writing.

For example, a description of a machine could be copyrighted, but this would only prevent others from copying the description; it would not prevent others from writing a description of their own or from making and using the machine.
Copyrights are administered by the Library of Congress.

www.copyright.gov

Term of copyright longer than patent.

- For Works Originally Created on or after January 1, 1978:
  - life plus an additional 70 years after the author's death.
  - For works made for hire, 95 years from publication or 120 years from creation, whichever is shorter.

Public Domain

- “Therefore, the U. S. copyright in any work published or copyrighted prior to January 1, 1923, has expired by operation of law, and the work has permanently fallen into the public domain in the United States.”
Copyright (cont.)

1. Literary works (books, magazines, web pages)
2. Musical works (songs, musical plays)
3. Dramatic works (plays, dramatic readings)
4. Pantomimes and choreographic works
5. Pictorial, graphic, and sculptural works
   (paintings, photographs, cartoon characters, maps, technical drawings, boat hull designs)
6. Motion pictures and other audiovisual works
   (films, videos, slides)
7. Sound recordings (discs, tapes, records)
8. Architectural works (building design, blueprints)
Basic Registration Fees

- Each registration must include a properly completed application form, a nonrefundable filing fee, and a nonreturnable deposit.
  - $35 Electronic registration through eCO (available on the website)
  - $50 Registration on Fill-In Form CO (available on the website)
  - $65 Registration on Form TX, Form VA, Form PA, Form SE, and Form SR (available by regular mail only)
Publications  http://www.copyright.gov/pubs.html

Information Circulars and Factsheets
- http://www.copyright.gov/circs/
- provide basic information about registration, fees, compulsory licenses
- Including current fees

Forms
- http://www.copyright.gov/forms/
- Electronic Filing Strongly Recommended
Copyright Law of the United States
- [http://www.copyright.gov/title17/](http://www.copyright.gov/title17/)

Fair Use
- [http://www.copyright.gov/fls/fl102.html](http://www.copyright.gov/fls/fl102.html)

Mandatory Deposit
- [http://www.copyright.gov/circs/circo7d.pdf](http://www.copyright.gov/circs/circo7d.pdf)
  - All works under copyright protection that are published in the United States are subject to the mandatory deposit provision of the copyright law.
  - Two copies of the best edition must be sent to the Copyright Office within three months of publication.
  - Mandatory deposit applies to foreign works distributed in the United States.
Searching Copyrighted Works

Copyrighted Works

Search copyright information
Works registered and documents recorded by the U.S. Copyright Office since January 1, 1978.

Prior to 1978 records only at the Copyright Office

Public Catalog
Copyright Catalog (1978 to present)

Basic Search

Other Search Options

Search for:

Search by:

Title (omit initial article A, An, The, El, La, Los etc.)

Name (Crichton Michael, Walt Disney Company)

Keyword

Registration Number (for VAu 598-575 type vau000598575)

Document Number (for V2606 P87 type v2606p087)

Command Keyword
Questions?

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