

Intellectual Property 101: Patents, Copyrights, Trademarks, and Trade Secrets – A Primer



James Pistorino // October 2023

Overview

What Is each one?

How do you get it?

What does it protect?

How long does it last?

Where are the lawsuits filed?



Fundamental Concepts

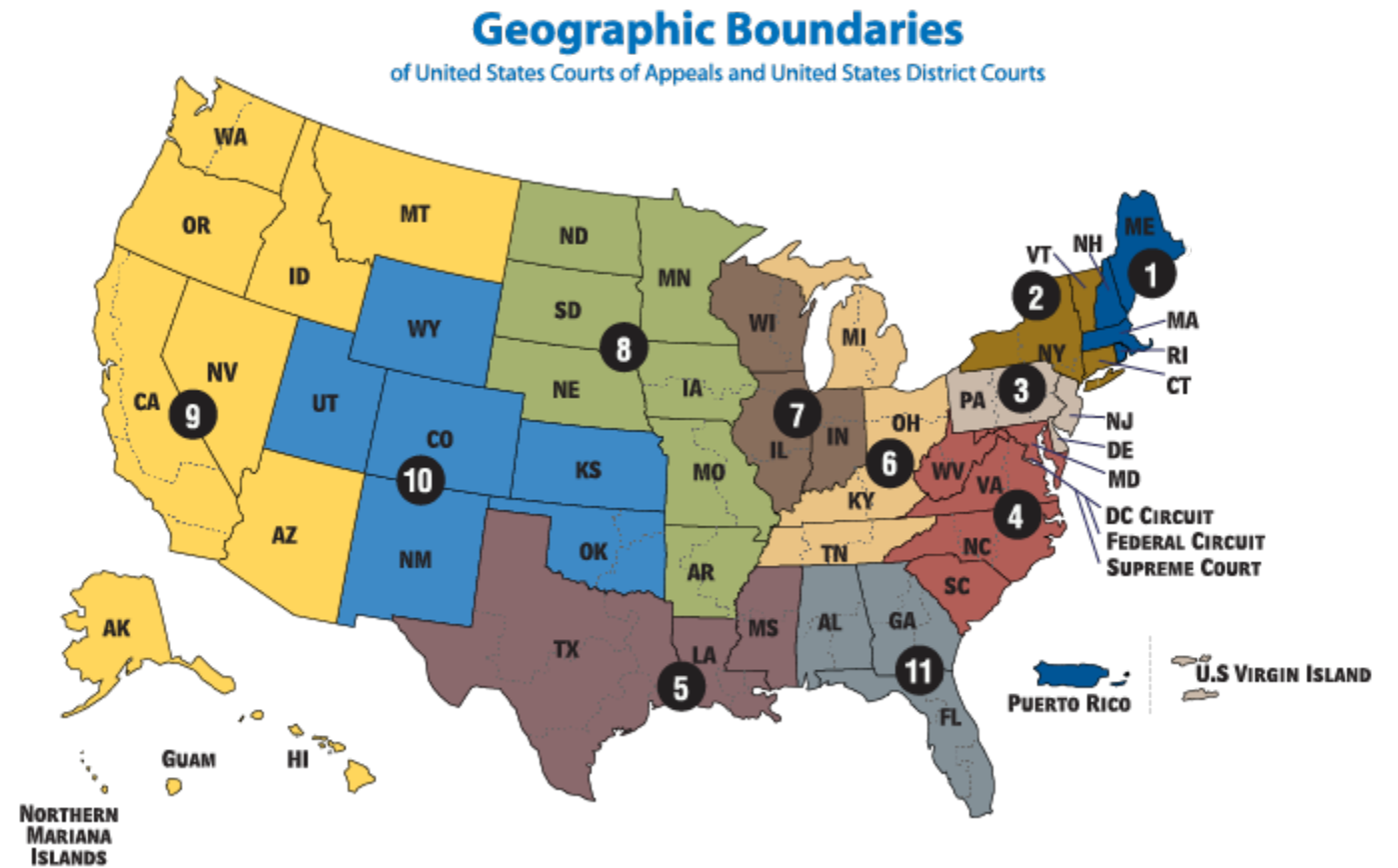


Dual Sovereigns

- In the United States, laws relating to intellectual property can be made by:
 - States
 - The federal government
- Knowing which controls dictates:
 - Whether there is one law or up to 50
 - Which courts/where, a lawsuit would be filed (generally)



Dual Sovereigns



Trade Secrets



Trade Secrets

The Coca-Cola logo, featuring the brand name in its iconic red script font.

Trade Secrets

- Arise under State law
- Anything you keep secret/confidential
 - Customer lists, pricing, manufacturing processes
 - Other people can use/have the same secret as long as they did not improperly get it from you
- Last indefinitely and you do not have to apply for or register trade secrets
- Must make efforts to keep secret/confidential
- Employment agreements



Trademarks

(also Servicemarks)



Trademarks

- Arise under BOTH State and Federal law
- Any distinctive mark that indicates origin/source of goods/services in a particular field of commerce
 - Can be a word, a made up term/phrase, a figure, a color, a sound

XEROX®



Trademarks

- Arise under BOTH State and Federal law
- Any distinctive mark that indicates origin/source of goods/services in a particular field of commerce
 - Can be a word, a made up term/phrase, a figure, a color, a sound
- Lasts indefinitely and you do not have to apply for or register a trademark, unless you want more protection



Trademarks



Trademarks

- Why register?
 - More protection against new people using the mark
 - Damages, ability to file lawsuits
- Why choose State registration vs. federal?
 - State registration is typically cheaper and faster but only protects in your State
 - Federal registration is nationwide, but costs more, takes longer, and has more hoops



Trademarks



Trademarks

- If someone uses a mark in a manner that is likely to cause confusion among the interested public, that is called “infringement.”
- Infringers can be sued.
- If likelihood of confusion is found, under federal law, infringers have to prove that profits were *not* the result of the infringement
- In the case of willful infringement, damages can be trebled.



Trademarks

- Must police the mark
 - If you know/reasonably should know of infringers, you must take steps to stop the infringement or risk losing you mark



Trademarks



DRY ICE



zipper

TRAMPOLINE



Copyrights



Copyrights



U.S. Constitution, Art. I, § 8: The Congress shall have power:
“To promote the progress of science and the useful arts, by
securing for limited times to authors and inventors the
exclusive rights to their respective writings and discoveries.”



Copyrights

- Arise under federal law (mostly)
- An original work of authorship, fixed in a tangible medium of expression
 - An article, book, manual, painting, picture, movie, song, map, etc.
- As soon as you record it, you have a copyright
 - No need to register or write “copyright”
 - Indicating copyright helps for damages
 - Registration is a pre-requisite for suit



Copyrights

- Protects not only the work but derivatives (e.g., sequels).
- The “author” of a work is the presumptive copyright owner.
- The “author” of a work can be an individual or a company he works for.
 - If creating works is within the scope of employment, then the “author” is the company and it automatically owns the copyright
- Copyright owner has exclusive right to make copies, prepare derivatives, public performances, etc.



Copyrights



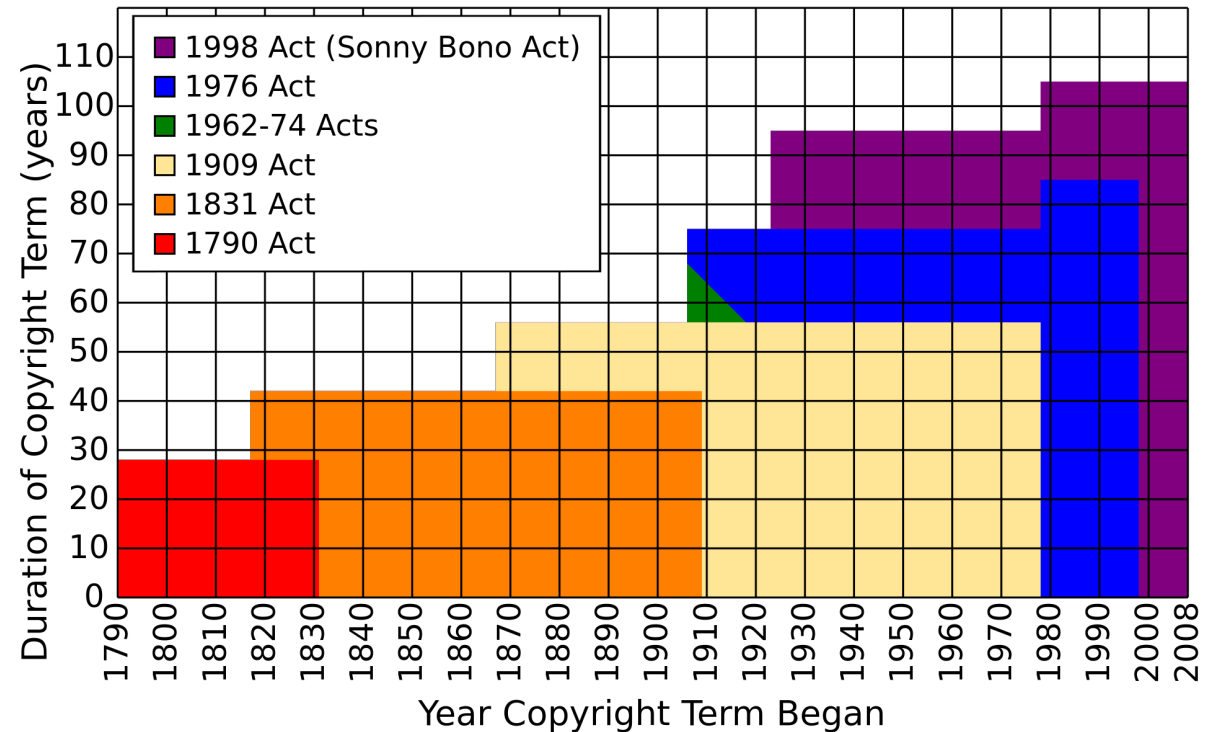
Copyrights

- If you hire someone to create a work/an employee creates works outside the scope of his employment, he is the “author” and owns the copyright.
 - You only get a license to use
- “work made for hire”
 - An agreement, in writing, transferring the copyright to whoever hired the creator.
- Employment agreements

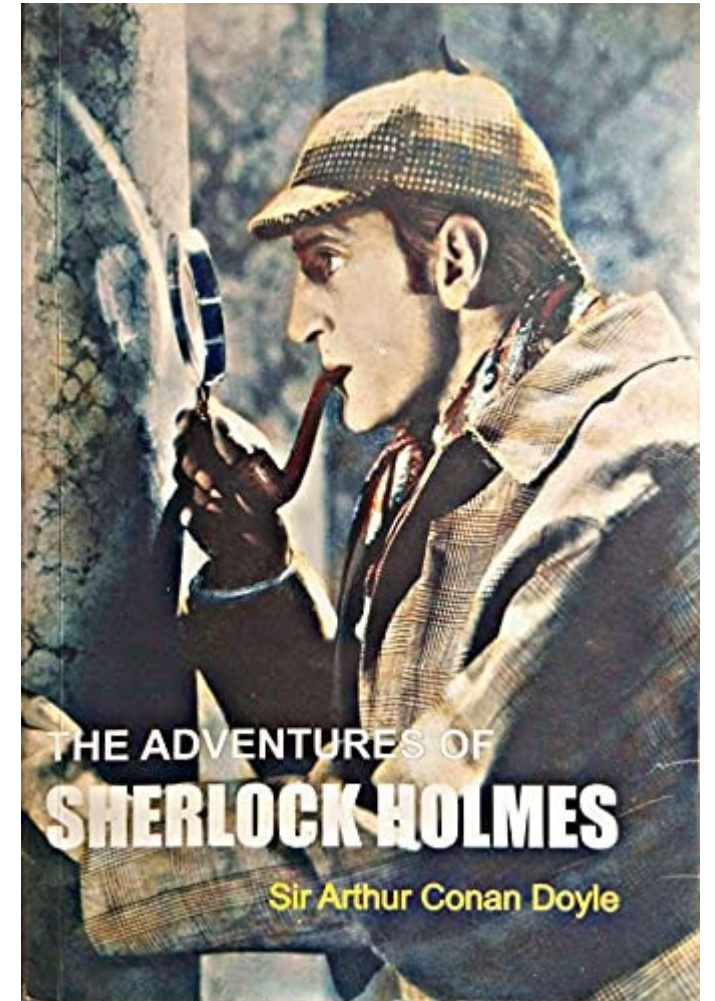
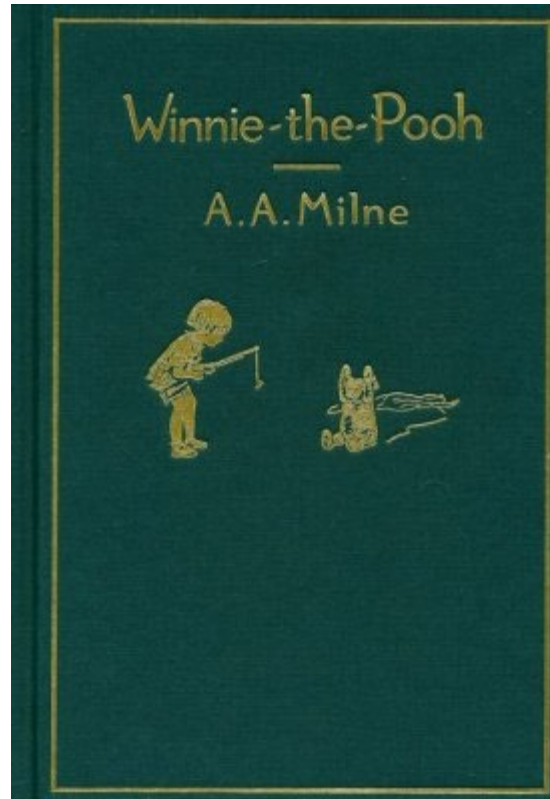
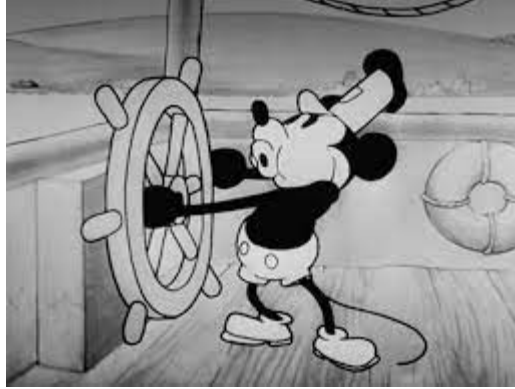


Copyrights

- Copyrights last for different amounts of time:
 - Basic rule, life of the author plus 95 years OR 120 years from the date of creation, whichever expires first
 - Many changes over time



Copyrights



Copyrights

- Lawsuits filed in federal court
- Registration is a pre-requisite to filing suit



Copyrights

- Defenses – “fair use”
 - Use a limited amount of a work for commentary, criticism, news reporting, scholarly reports – including parody
 - Not a defense that you did not make money
- Damages –
 - Actual damages
 - Statutory damages - \$200-\$150K



Patents – A Big Topic



Patents



U.S. Constitution, Art. I, § 8: The Congress shall have power:
“To promote the progress of science and the useful arts, by
securing for limited times to authors and inventors the
exclusive rights to their respective writings and discoveries.”



Patents

- Arise exclusively under federal law
- Three types of patents (utility, design, plant)
- “Anything under the sun that is made by man.”
- “New, useful, and non-obvious”
- Basically, a contract:
 - If you tell us your idea, we will give you a monopoly on it for a limited time.
 - Patent applications are published.
- Lasts for 20 years from date you file application.



Patents

- Why get a patent?
 - Marketing
 - Exclude competitors
 - Licensing



Patents

- Patent Prosecution
- Patent Litigation



Patent Prosecution



Patent Prosecution



Patent Prosecution

- Do not evaluate whether the idea is a good idea or a bad idea
- Only evaluate whether the claims are new, useful, and non-obvious
- “One of the most difficult legal instruments to draft”



Patent Prosecution

- Patent Agent
 - Person with a technical background
 - Passed a special test – the Patent Bar
 - Licensed *only* to prepare and prosecute patent applications
- Patent Attorney/Lawyer
 - Same as Patent Agent but also went to law school and is admitted as a lawyer
 - In addition to preparing patent applications, can also do everything a lawyer can do
 - Draft contracts
 - Litigate

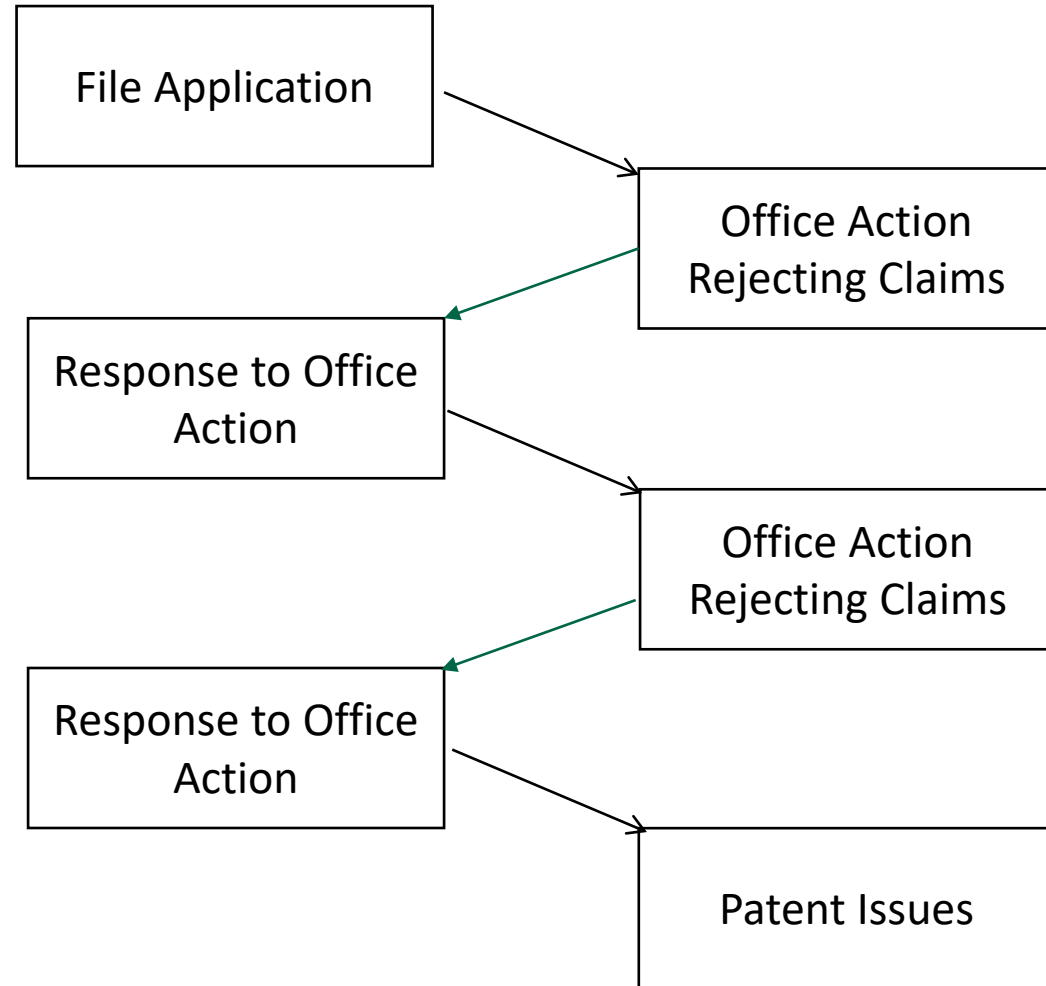


Patent Prosecution

- Basically, a negotiation where your agent/lawyer tries to get you claims that are:
 - As broad as possible to cover/exclude the most activity
 - Not so broad that they cover what other people did before or are obvious in light thereof
- The broader the claims in a patent without being invalid, the more a patent may be worth



Patent Prosecution



Patent Litigation

- “The Sport of Kings”
 - Compared to most litigation, VERY expensive
- Plaintiff tries to prove that the Defendant did what is covered by the claims
- Defendant tries to prove that he did not do what is covered by the claims OR that the claims are invalid
- If the Plaintiff wins, they can get damages AND an Order barring the Plaintiff from infringing



Questions



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