

Upcoming Meetings

Wednesday, October 6, 2010

Speaker: Anthony T. Verwey, Esquire
Topic: Ethics for Young Lawyers -- CLE

Wednesday, November 3, 2010

Speaker: TBD
Topic: TBD

Wednesday, December 1, 2010

Secretary Elections

Upcoming Events

September 16, 2010

Event: Country Lawyer
Sponsor: CCBA
Location: CCBA Lower Level
Time: 5-7

September 24, 2010

Event: Naturalization Ceremony
Location: ~~Annapolis, MD~~
Time: 11:30-1

October 10, 2010

Event: Rotary Chili Cook Off
Sponsor: CCBF
Location: West Chester
Time: 8 am
Description: <http://www.westchesterchilicookoff.com/>

October 14-16, 2010

Event: Fall Bench Bar
Sponsor: CCBA
Location: Bedford Springs, PA
Description: http://www.chescobar.org/events/fall_bench_bar.html

Chester County Bar Association
 THE FUNDAMENTALS OF INTELLECTUAL PROPERTY
 Andrew Koopman
 Zachary Fansler
 September 1, 2010

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THE FUNDAMENTALS OF INTELLECTUAL PROPERTY

- I. Patents
- II. Trademarks
- III. Copyrights
- IV. Trade Secrets
- V. Common IP Issues

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I. PATENTS

~~I Can't Infringe, I Have My Own Patent!~~

↑ WRONG! ↑

- Inventor is given...
 - the exclusive right to prevent others from
 - making, using, and selling a patented invention
 - for 20 yrs
- Inventor gives...
 - the details of the invention to the public

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I. PATENTS

Patentable Inventions Must Be:

- Novel

When is it too late to file?

- Disclosure
- Sale or Offer to Sell (e.g., "commercial exploitation")
 - YOU HAVE A 1 YEAR GRACE PERIOD TO FILE
- But...
 - THERE IS AN EXPERIMENTAL USE EXCEPTION

How can I meet the deadline?

- File a Provisional Application
- File a Non-Provisional Application

I. PATENTS

What is Patentable?

- Patentable: New, Useful and Non-obvious...
 - Process, Machine, Method of Manufacture, Composition of Matter
- Not-patentable:
 - Laws of Nature, Natural Phenomena, Abstract Ideas

Bilski claims:

- (1) initiating a series of sales or options transactions between a broker and purchaser-users by which the purchaser-users buy the commodity at a first fixed rate based on historical price levels;
- (2) identifying producer-sellers of the commodity; and
- (3) initiating a series of sales or options transactions between the broker and producer-sellers, at a second fixed rate, such that the purchasers' and sellers' respective risk positions balance out.

I. PATENTS

Is computer software patentable?

Yes, but...

- "Machine or Transformation Test"
- In re Bilski* (Fed. Cir. 2008)
 - A claimed process may be patent-eligible if:
 - (1) It is tied to a particular machine or apparatus, or
 - (2) It transforms a particular article into a different state or thing
- This is the starting point.
- Patentability of programs and software is yet to be fully determined; patents issued in the last 10 years may still be asserted

II. TRADEMARKS

What Can you Trademark?

- Anything that is:
 - Not generic,
 - Not confusingly similar to another mark, or
 - Not functional
- Use it or lose it
- Protects consumer

II. TRADEMARKS

How Strong is the Trademark?

- Generic – Not a TM
- Descriptive –
 - Only with Secondary Meaning
- Suggestive
- Arbitrary and Fanciful



II. TRADEMARKS

Benefits of a Trademark

- Identify the source of goods;
- Build your reputation;
- Establish branding; and
- Provide the ability to expand your business if you chose to license your trademark.

II. TRADEMARKS

Trademark Registrations

- www.uspto.gov
- Results from a USPTO search is a preliminary step and should not be used as the only step when registering or researching a trademark. The results of this search requires a legal analysis

III. COPYRIGHTS

Why get a Copyright?

- Protect literary, dramatic, musical, artistic, and computer works:
- **What you must show:**
 - Original work of authorship (Idea/Expression dichotomy)
 - Fixed in a tangible medium of expression
- **What you get:**
 - **Exclusive rights to (or authorize others to)**
 - Reproduce a work
 - Prepare a derivative work
 - Distribute copies
 - Publicly perform or display a work
- Prevent others from displaying, reproducing, adapting, performing, or publishing copyrighted works

III. COPYRIGHTS

Registration Steps:

- Fill out a form.
 - <http://www.copyright.gov/eco/>
- Pay a fee (\$35 - \$45)
- Deposit a copy of the work with the Copyright Office
- What if my work also contains a trade secret?

expiration = your life + 70 yrs.

III. COPYRIGHTS

How Strong is Copyright Protection?

- To Prove Infringement:
 - Must be copied from the copyrighted source, not from an independent source
 - Must be substantially similar to the copyrighted work
 - Must have had access to the copyrighted work
- Fair Use Exceptions to Copyright Protection:
 - Educational uses
 - Parody
 - Literary criticism
 - Satire
 - Scenes a faire
 - Other uses protected by the First Amendment

IV. TRADE SECRETS

What is a trade secret?

- information used in a trade or business;
- if disclosed to a competitor, it would cause real (or significant) harm to the owner of the secret; and
- owner must limit the sharing of the information and/or prevent widespread publication

Examples

- Formulas, patterns, compilations, programs, devices, methods, techniques, or processes

IV. TRADE SECRETS

Pros/Cons of Trade Secret

- Pros:
 - Avoid need to disclose idea (patent)
 - May be less costly
 - Exclusivity can last >20 yrs, as long as it remains secret
- Cons:
 - Exclusivity lasts only as long as it remains secret
 - Strict security requirements (NDAs, physical security)
 - Someone else can discover & file for patent
 - Business Method Exception
 - Someone can legally discover your trade secret
 - Independent invention
 - Reverse engineering
 - Obtaining a license
 - Public observation

V. COMMON IP ISSUES

Domain Names & Disputes

- ICANN - The Internet Corporation for Assigned Names and Numbers
 - An internationally organized, non-profit corporation that has responsibility for Internet Protocol (IP) address space allocation
 - ICANN implemented a Uniform Domain Name Dispute Resolution Policy (UDRP)
- <http://www.icann.org/udrp/udrp-policy-24oct99.htm>



V. COMMON IP ISSUES

Where Can I Be Sued?

- Questions to ask:
 - How interactive is your website?
 - Do you offer services on your website?
- What does this mean?
 - Open yourself up to a lawsuit in the various places

V. COMMON IP ISSUES

FAIR USE

- Fair Use of a Copyright and Trademark on your website
- Linking websites
 - Do Not Defame
 - Give Appropriate Credit
 - Do Not Give Improper Appearances

V. COMMON IP ISSUES

IP Issues in Particular Agreements

- Non-Disclosure Agreements
- License/Sales/Distribution Agreements
- Contractor Agreements
- Employment Agreements
- Corporate Transactions
- Joint Development Agreements
- Trademark Licensing
- Beta Licensing

V. COMMON IP ISSUES

Contractor Agreements

- Ownership Of IP (Software Copyright Issue)
- Obligation Of Confidentiality
- Indemnification/Warranty Of Origin
- Restrict Working With Competitors
- Example of Consequences


V. COMMON IP ISSUES

Employment Agreements

- Assign IP Rights To Company
- Obligation Of Confidentiality
- Pre-Employment Development
- Non-Compete
 - Enforceability Varies by State
- Consideration - new employee vs. existing employee

THE FUNDAMENTALS
OF INTELLECTUAL PROPERTY

QUESTIONS?

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THE QUALITY OF THE LAW OF INTELLECTUAL PROPERTY

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