

Protect Your Work!

What is intellectual property? How are IP rights created? How do you protect it? What is IP enforcement?

Prairie Ridge Incubator Class—10Apr19



Genna S. Hibbs and Hibbs Law, LLC



- ▶ Intellectual Property Boutique firm. Founded 1Jan2013.
- ▶ Small business and individual needs: Patents, Trademarks, Copyrights, Unfair Competition, Trade Secrets, Infringement enforcement and litigation, licensing, entity formation, and business transactions.
- ▶ Background in Biotechnology and Genetics, small business and government.
- ▶ Substantial dedication (20-30% target) to *pro bono* legal services: low-income health center, consolidated school district prevention program, low-income inventors, public education, for example.
- ▶ Personal activities: committee work, gardening, and bicycling.

Where to start?



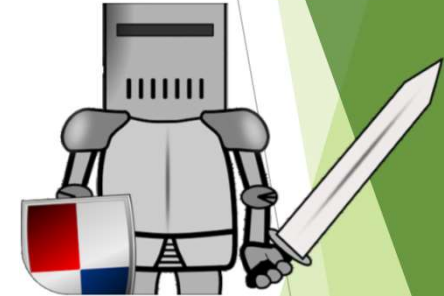
What is IP?



How are IP rights created?



How do you protect it?



What is IP enforcement?

1. What is Intellectual Property?



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- = the *Intangible Property Rights* in things created by human ingenuity and creativity;
- Categories: P, C, TM, & sometime TS and RoP
- Property rights provide the ability to control how something is used, controlled, transferred, created, and destroyed.



PATENT PENDING

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TOP SECRET

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What is a Patent?

- Prized and limited monopoly for inventions (20yrs) and ornamental designs (15yrs).
- Granted by the Federal Gov't (USPTO and Int'l PO's) only.



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§101 INVENTIONS:

- ▶ new and useful:
- ▶ Process/Methods –an act or series of acts/steps
- ▶ Machine—concrete thing, consisting of parts or devices/combination of devices
- ▶ Manufacture—article (hand or machine) produced from raw or prepared materials, new form, quality, property, or combination
- ▶ Composition of Matter—all compositions of two or more substances and all composite articles whether chemical union, mechanical mixture, gases, fluids, powders, or solids.
- ▶ Subject matter exception: abstract ideas, laws of nature, and physical phenomena.

What is a Trademark?

- ▶ Trademark rights: common law origins and statutory policy basis in CONSUMER PROTECTION
 - ▶ Brand loyalty
 - ▶ Expected quality
- ▶ Trademark is the goodwill identifier that the public associates with YOU as the source of origin of your product/service.
 - ▶ Rights are based on USE, IN COMMERCE
- ▶ Balance trademark rights with 1st Amendment Free Speech (FAIR USE: Nominative and Descriptive) and Functionality.
- ▶ USPTO and States register.
- ▶ No expiration with use and maintenance fees.

Words

Literal letters, stylized fonts, logos, slogans, products, overall brand, collections, non-functional packaging content.

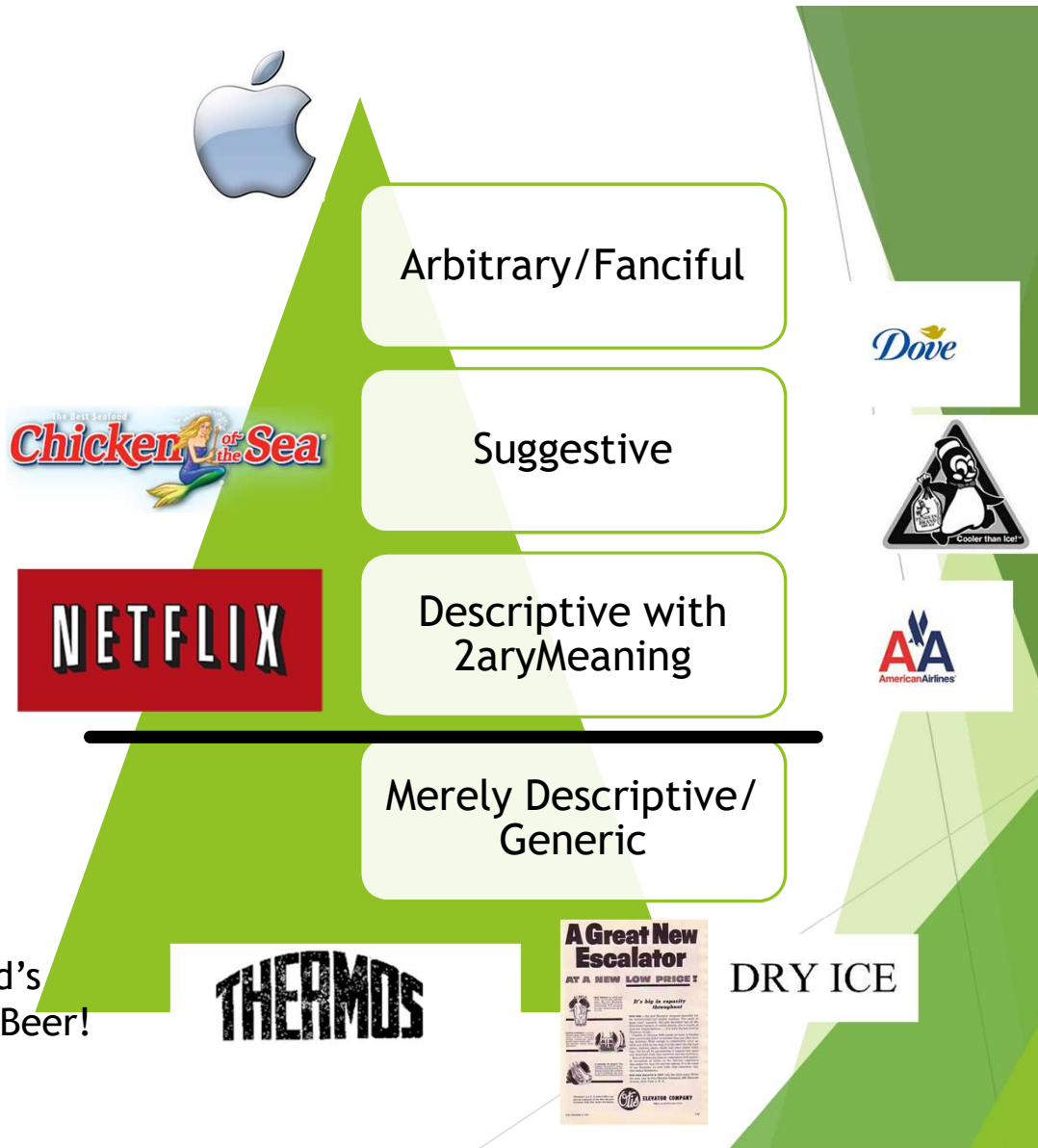
Other

Colors, sounds, shapes, smells, décor, packaging

A Trademark's strength is based on time, market, and **DISTINCTIVENESS**

Important for choosing your brand/trademark.

Secondary Meaning: primary source in public's mind; time and market strength factors can bolster a descriptive mark into protectability; presumed after 5yrs (incontestability)



World's Best Beer!

THERMOS



DRY ICE

What Is a Copyright?

- Constitutional Power and Statutory rights
- Copyright Office
- Copyrighted Work Created → original works “fixed in a tangible medium of expression”



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Trade-secrets for
'valuable' commercial
privacy.



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Right of Publicity,
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2. How are IP rights created?



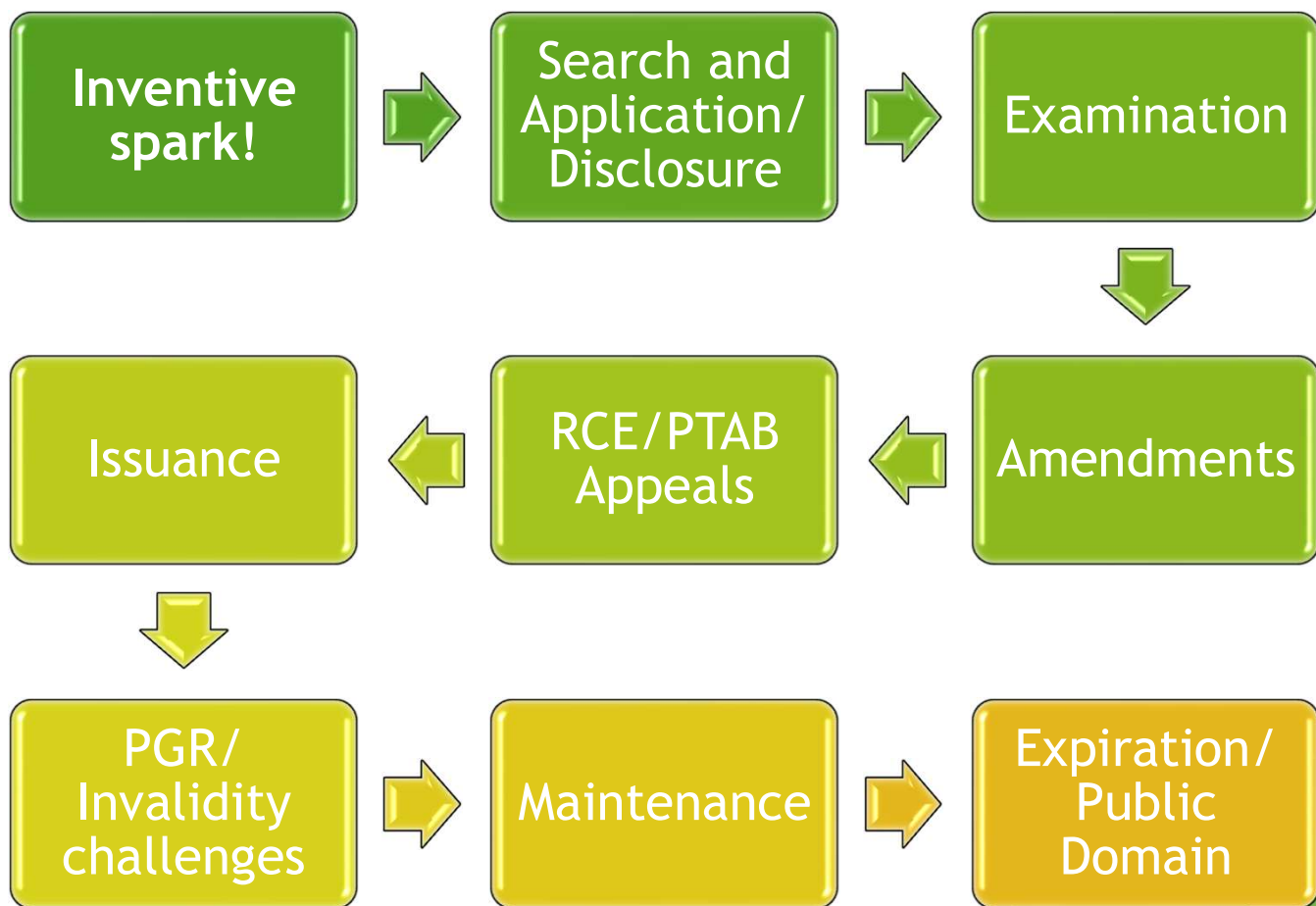
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Public Policy for consumer protection and to protect HUMAN CREATIVITY!

Societal/ethical underpinnings = created by Humans.

Common Law or Statutory?

Patent Rights: USPTO Basic Application Process



Trademark Rights: Two Layers (plus State).

Common Law, §43(a)

- ▶ Starts when you begin to use your mark, aka are identifying the source of origin of your goods/services with the particular TM.
- ▶ Limited to your geographic area and reasonable expansion (gets fuzzy with internet).
- ▶ Use TM to identify common law TMs.

Federal registration, USPTO

- ▶ Once registered, provides nationwide protection from the filing date against all junior users.
- ▶ Use ® to identify registered TMs.
- ▶ USPTO registration can be extended internationally (1yr priority deadline for filing date).
- ▶ States also offer registration (little value).

USPTO TM Registration, general overview

Before

- Self Knock-out search
- Decide on what to protect
- Clearance Search
- Gather information for application

USPTO
1st

- File application
- Examiner's review/search
- Amendments/ Office Actions

USPTO
2nd

- 6mo Publication period
- Challenger?
- Registration

After

- Enforcement Searches
- Reviewing use as business evolves
- Maintenance of USPTO registration

Copyrights

- Registration generally a formality, but needed for damages.
- Rights created with the original work!
- Notice © it up!
- Term is your life + 70yrs OR Anonymous = 95yrs from first publication, or 120 years from creation, whichever is shorter



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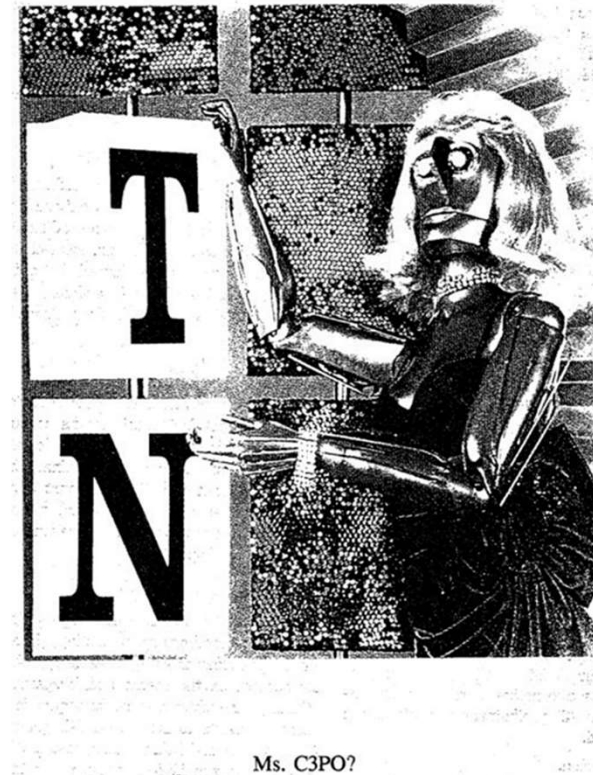
Trade-Secrets



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Keep it secret, keep it safe!

Right of Publicity



Use it or lose it!

3. How do you protect it?



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- You've acquired rights for a specific space of IP.
- Learn the parameters/ strengths/ weaknesses of your IP rights.
- Understand what Infringement is for your particular type of IP.

What is Infringement?

- ▶ **PATENT:** unauthorized use of the invention (make, use, sell, offer to sell, or import) based on every element of the claims (some structural equivalents allowed, and some insubstantial limitations ignored).
 - ▶ Priority in time is vital!
 - ▶ Doctrine of Equivalents and Inherent Characteristics balanced against prosecution history estoppel.

- **ABCDE**
- **ABC**
- **BCDE**

Patented
Invention



- **ABCEF**
- **ABCDE**
- **ABCD**

New
User



- = No Infringement.
- = Infringement!
- = No infringement.

RESULT

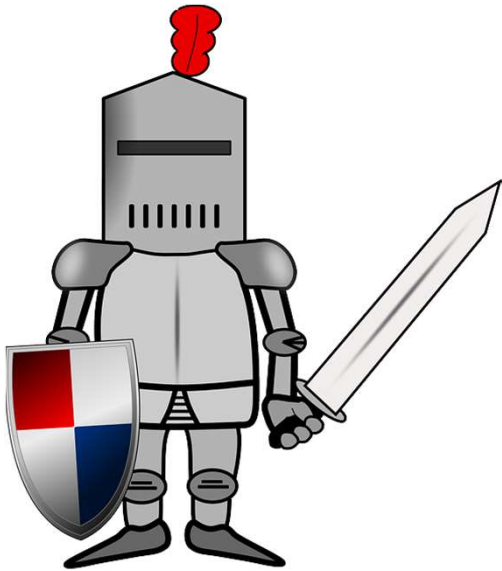


What is Infringement?

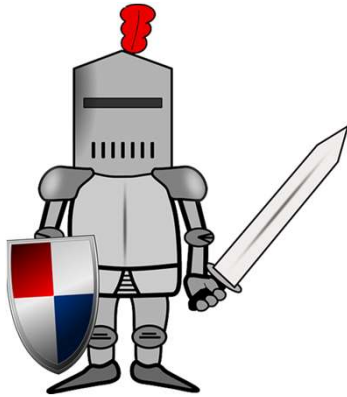
- ▶ **COPYRIGHT:** Unauthorized use (reproduce, distribute, display, perform, or derivative works) of the expression. If not direct copying, is there a 'substantial similarity' and is it commercial/misappropriation? Can be direct, indirect, contributory, or inducing infringement.
 - ▶ Knowledge/access is key

- ▶ **TRADEMARK:** Likelihood of Confusion is the legal test for trademark infringement → is there a likelihood that a potential consumer would be confused as to the source of origin? Is the junior user attempting to capitalize and steal the senior user's goodwill?
 - ▶ LoC Factors Analysis: similarity of marks; similarity of goods/services; sophistication of consumers; strength of mark; length and market of use; willfulness to infringe by junior user; and actual confusion.

4. What is IP enforcement?



- The Process for becoming aware of other users.
- First determine whether or not they are infringing.
- Then weigh your legal position and business interests with the available options.
- = Take actions to defend your rights!



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The Enforcement Process: Rights Holder v. Defense

Rights Holder Become aware of other user

Research (RH)

Cease & Desist Letter

Offer terms

Other actions (walk away or rebrand)

Cease & Desist Letter Response

Research (D)

Refutation &/or
Negotiations for
settlement

Other actions
(preemptive changes)

Formal process

ADR

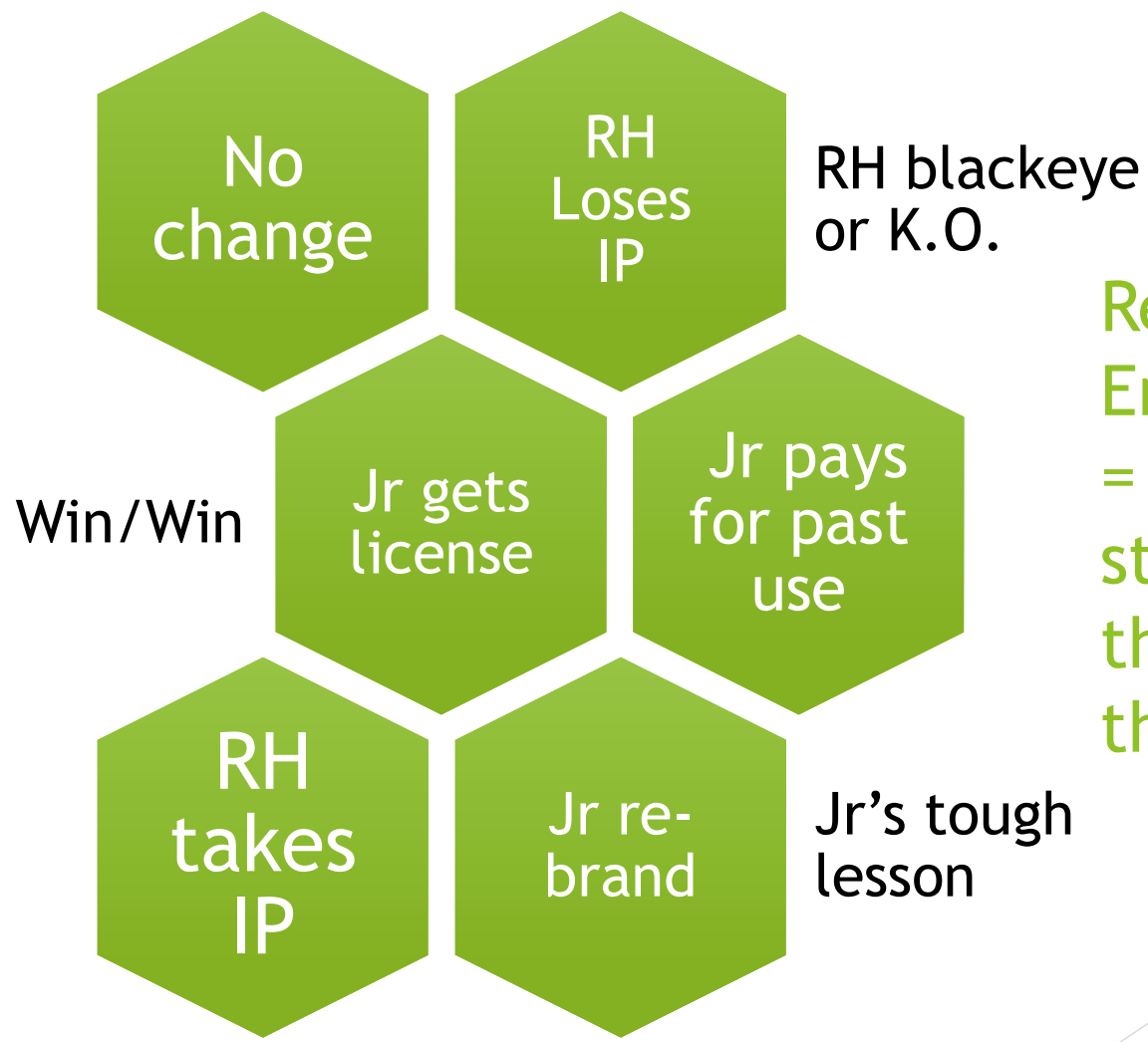
USTPO PTAB/TTAB

Court (classic)

ICANN (domains)

USITC (imports)

...what results are possible?



Results of Enforcement = a lot at stake, including the cost to get there.

QUESTIONS?

