



Intellectual Property Seminar 1: IP Basics

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



Gary Con XIV – 24 March 2022

Hibbs Law, LLC

Genna Hibbs & Emily Mosnick



- ▲ Intellectual Property boutique firm **founded in 2013**
- ▲ **Bar Admissions:** Illinois, US Northern District IL, US Patents & Trade Office
- ▲ **Focus Areas:** Patents, Trademarks, Copyrights, Unfair Competition, Trade Secrets, Infringement Enforcement/Litigation, Licensing, Entity Formation, Regulatory Compliance, and Business Transactions.
- ▲ **Clientele:** Small business, medium corporations, individuals
- ▲ **Expertise**
 - ▲ **Genna:** Biotechnology, Genetics, Small Business, Government,
 - ▲ **Emily:** Regulatory, International Law, Trademark, Copyright, Privacy
- ▲ **Gaming Experience:**
 - ▲ **Genna:** TTRPG, MTG, WH40K, FPS
 - ▲ **Emily:** Browser-based RPG games
- ▲ Substantial dedication to **pro bono** legal services (20-30% of time)



Legal Disclaimer



- ▲ **Nothing** in this presentation is meant to imply or suggest that an attorney-client relationship is created through this presentation or related communications.
- ▲ After a private initial client meeting, a signed **letter of engagement** would be the official step to create that relationship with Hibbs Law, LLC
- ▲ Legal analysis is largely fact-based and involves a full examination of all details and factors. **General rules** presented, or questions asked and answered, are posed as hypotheticals, and should not be relied on as legal advice. The most common answer to a ‘simple’ legal question is: “It depends.”



Road Map



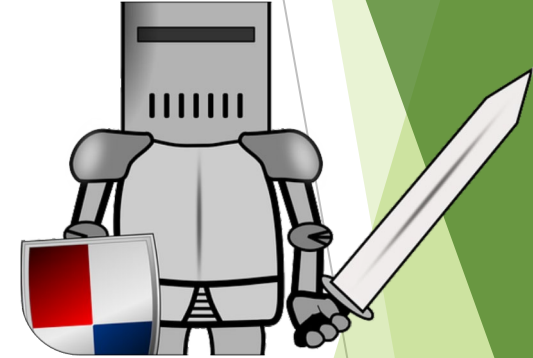
What is IP?



How are IP
rights
created?



How do you
protect it?



What is IP
enforcement?

What is Intellectual Property?



- **Categories:** Patent, Copyright, Trademark, & Trade Secrets
- *Intangible* property rights in things created by human ingenuity and creativity
- Property rights provide the ability to control how something is used, controlled, transferred, created, and destroyed



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PATENT PENDING



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TOP SECRET

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What is a Patent?



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- Prized and limited monopoly for inventions (20 years) and ornamental designs (15 years)
- Granted by the Federal Government only through the United States Patent and Trademark Office (USPTO)

What Can Be Patented?

Inventions Defined by §101:

- ▶ 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.
- ▶ Excludes: abstract ideas, laws of nature, and physical phenomena.



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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.
- ▶ No expiration with use and maintenance fees.



What Can be Trademarked?

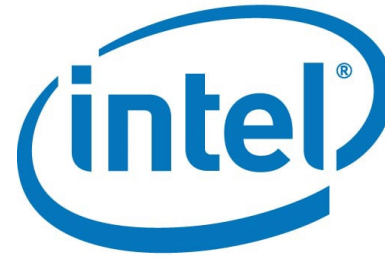


Words

- Literal letters
- Stylized fonts
- Logos
- Slogans
- Products
- Overall brand
- Collections

Others

- Colors
- Sounds
- Shapes
- Smells
- Décor
- Product packaging



JUST DO IT.



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 5 years (incontestability)



Arbitrary/Fanciful

Suggestive

Descriptive with Secondary Meaning

Merely Descriptive/
Generic



DRY ICE



What Is a Copyright?

- Work of Authorship: original works “fixed in a tangible medium of expression”
- Basis in the Constitution and statutory rights
- Registration granted by Copyright Office



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Trade Secrets

Provides protection for 'valuable' commercial property

Recent federal law (Defend Trade Secrets Act) passed in 2016, but basis in state law protections under the Uniform Trade Secrets Act

Often applies to things like recipes, competition information, or R&D



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Right of Publicity

Control commercial use in your likeness, name, or “recognizable aspects of one’s persona”

Right to license those elements for commercial purposes

Limited protection based in state common law or under Unfair Competition law

Federal protection under Trademark law if element qualifies as a trademark



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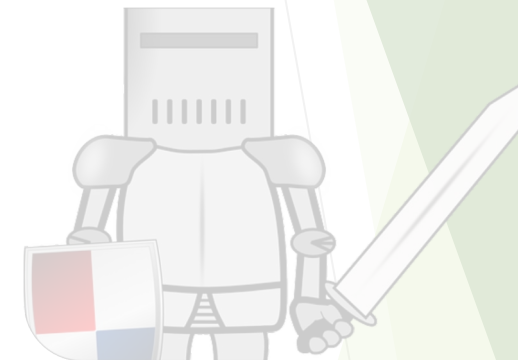
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How are IP Rights Created?

Public Policy for consumer protection and to protect HUMAN CREATIVITY!

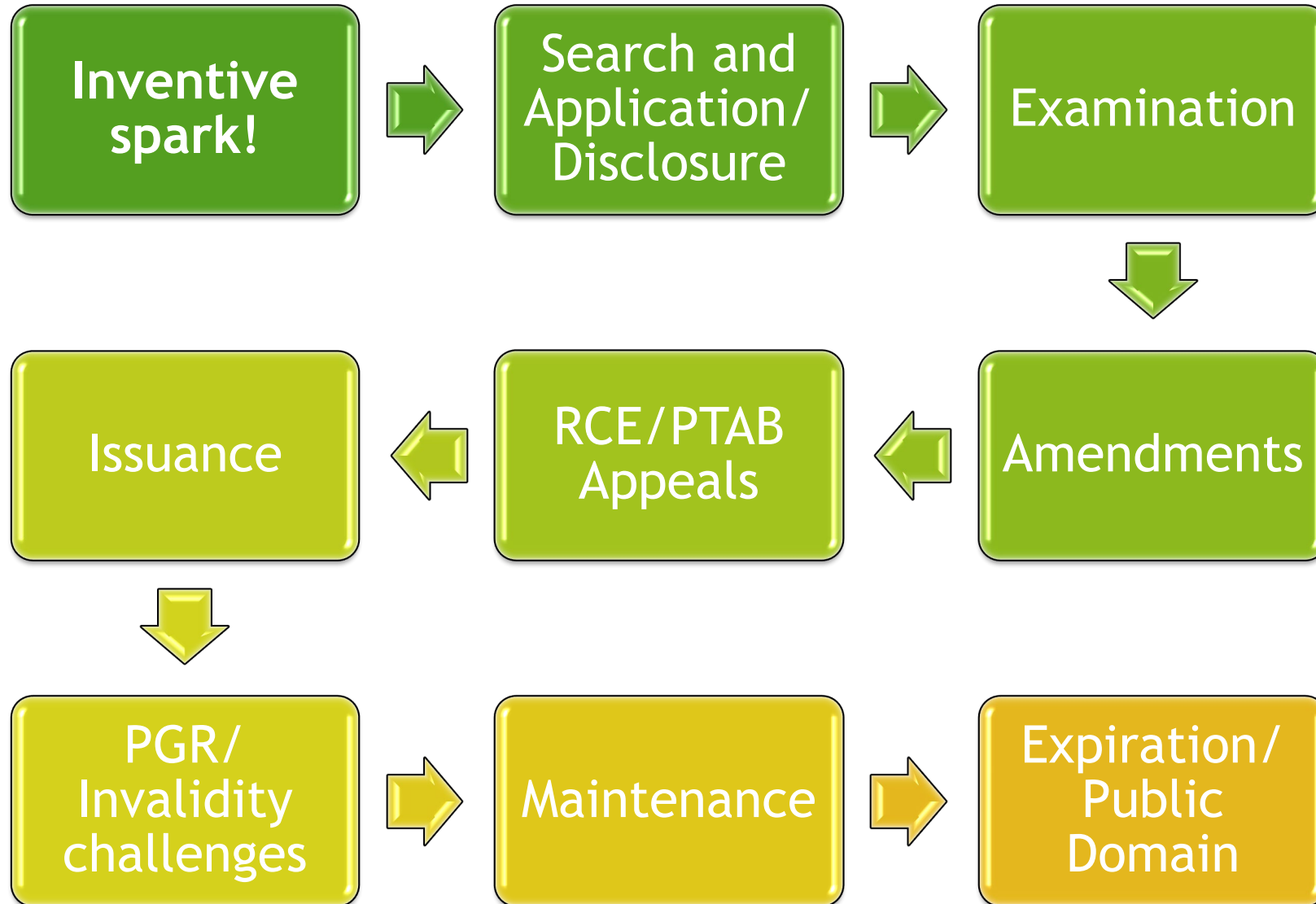
Societal/ethical underpinnings created by Humans

Common Law or Statutory?



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Patent Registration: The Lifecycle!



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 mark
- ▶ Limited to your geographic area and reasonable expansion (gets fuzzy with internet)
- ▶ Use™ to identify common law trademarks or those still in application status

Federal registration, USPTO

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

Trademark Registration: The Lifecycle!



Before

Copyrights



- Registration generally a formality, but necessary for certain damages
- Rights exist from the instant the work is “fixed”
- Notice: © it up!
- Term
 - Your life + 70 years
 - Anonymous author: 95 years from first publication or 120 years from creation, whichever is shorter



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Patent



Trade Secrets



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If you “lose” it, then you lose it!

Right of Publicity



Use it or lose it!

Road Map



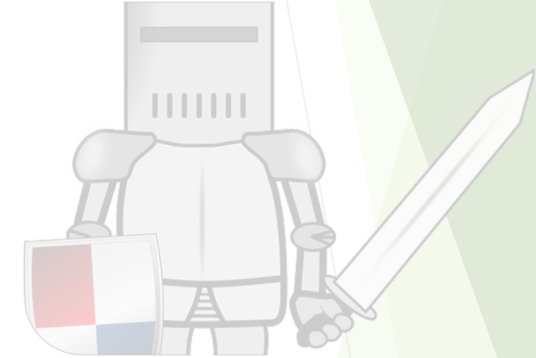
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How Do You Protect It?



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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

Patent Infringement?

- ▶ 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**

Copyright Infringement



- ▶ 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 and access is key



Trademark Infringement



- ▶ Likelihood of Confusion is the legal test for trademark infringement
- ▶ Key Question: 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?
- ▶ Factors Analysis (7th Circuit):
 1. Similarity of marks
 2. Similarity of goods/services
 3. Sophistication of consumers
 4. Strength of mark
 5. Length and market of use
 6. Willfulness to infringe by junior user
 7. Actual confusion



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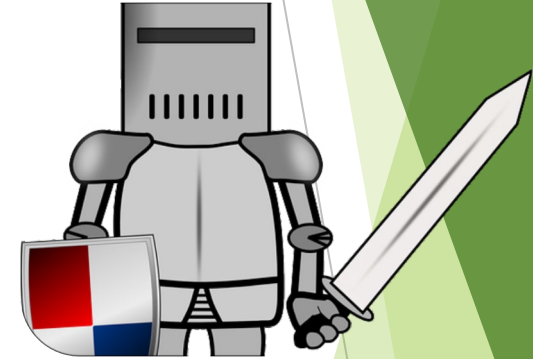
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How to “Hold the Door” on Your IP



- First, become aware of other users
- Second, determine if they are infringing
- Third, weigh your legal position and business interests with the available options
- Fourth, take actions to defend your rights!



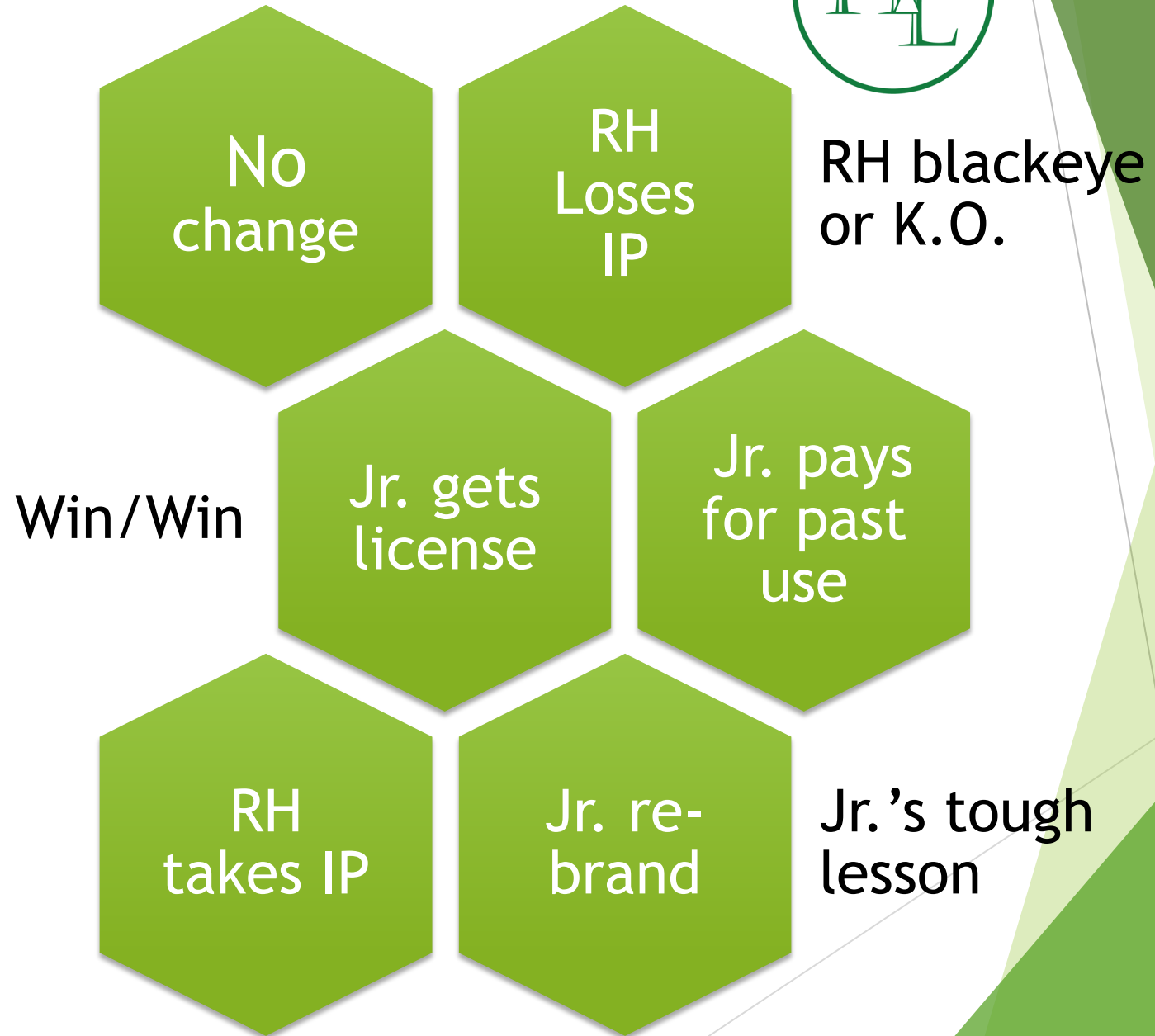
The Enforcement Process: Rights Holder v. Defense

Rights Holder Become Aware of Other User



End Results

There is a lot at stake, including the cost to get there (financial and emotional)



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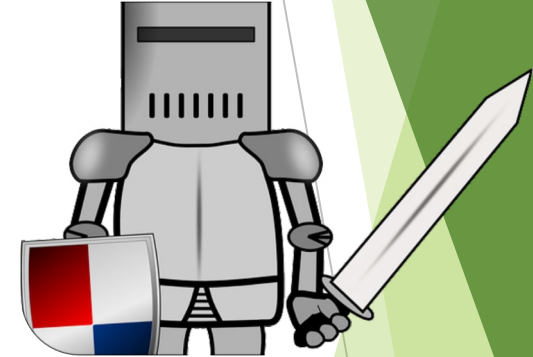
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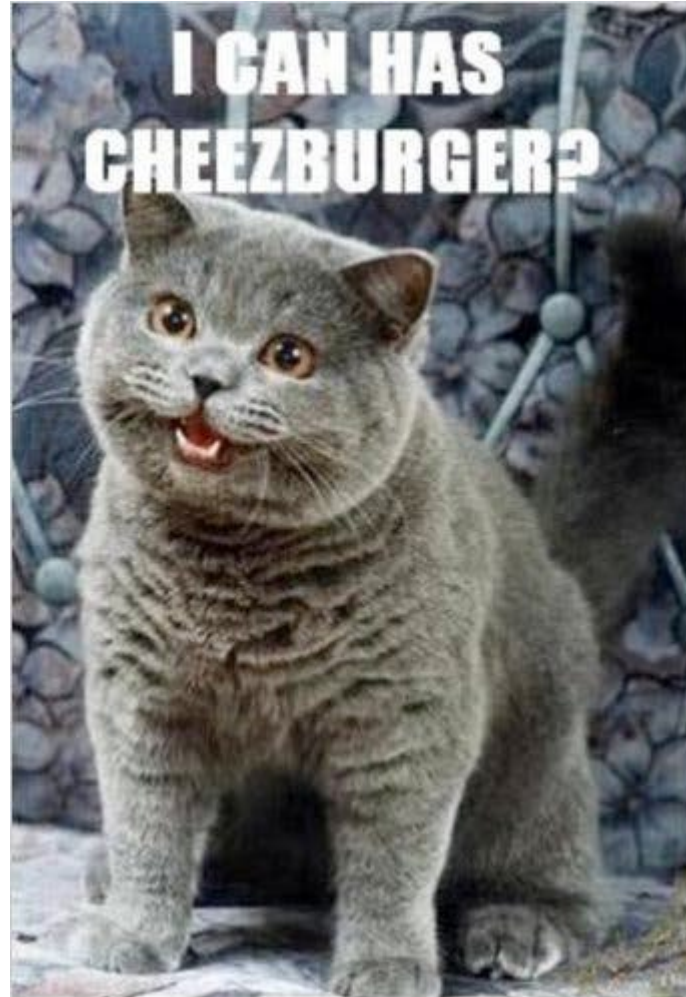


How do you
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What is IP
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QUESTIONS?



QUESTIONS?



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