

Intellectual Property Protection in a nutshell



Letao Qin, JD, PhD
Coats and Bennett, PLLC

What is in the headline?

- Apple v. Samsung
 - a total of 12 patents, 6 patents infringed,
 - Jury verdict: \$1 billion damage
- Nortel Patent portfolio auction
 - Liquidation during bankruptcy,
 - 6000 patents sold for \$4.5 billion
- iPad trademark dispute in China
 - iPad2 sales disrupted because of the TM dispute.

What is intellectual property (IP)?

Work resulted from ideas, creative endeavors, and innovative thinking.

- Books, films, videos, songs, articles, poems, choreography, photographs, paintings.
- Product designs, trademarks, trade dresses
- New machines, new manufacturing processes, new material.
- Isolated genes? Business methods?

Types of IP protected under US law

- Trade secret
- Copyright
- Patent
- Trademark/Trade dress

Trade Secret

- Definition:
 - Valuable & secret information:
not in public domain, not readily accessible
 - Reasonable precautions
- Protection lasts as long as it remains secret.

Trade Secret

- Remedy: available
 - only if improper means or in breach of confidential relationship;
 - Not if reverse engineering or independent discovery

Copyright

- Definition

“original work” fixed in a “tangible medium of expression”

Copyright

- Threshold of protection

A piece of original work must exhibit a modicum of originality and be fixed in a “tangible medium of expression.”

Donald Trump’s “You’re fired”
Copyrightable? (CM #1)

Copyright

- Rights of:
 - performance,
 - display,
 - reproduction of the copyrighted work, and
 - making derivative works from the copyrighted work.

Copyright

- Duration
 - the life of the author plus 70 years,
 - if entity author,
 - 95 years from first publication, or
 - 120 years from the year of creation, whichever occurs first.

Copyright

- Formalities
 - No required formalities (notice & publication) but registration of a copyright is required if US authors before instituting a lawsuit.
 - Registration with USPTO and deposition of copies of the work.

Patent

- Definition

- A grant of certain rights to the patentee who owns the patent.
- Rights to exclude or authorize others to make, use, offer to sell, sell, and import into the US the patented invention
“negative rights” (CM #2)

Patent

- Types of patents
 - Utility patents
 - Design patents
- Duration
 - 20 years from filing for utility patents.
 - Extension up to 5 years for drugs, medical devices and additives.
 - 14 years for design patents.
 - Plus Patent Term Adjustment.

Patent

- Requirements
 - statutory subject matter,
 - novelty,
 - non-obviousness,
 - utility
- Loss of right if disclosed publically
 - Grace period

Patent

- How to get a patent
 - Drafting
 - Filing
 - Prosecuting in front of the USPTO
 - No right to exclude before issuance
(CM #3)

Patent

- How to write a patent application
 - Parts of a patent application
 - Requirements of written descriptions
 - Claims (CM#4)

Patent

- Costs
 - Fees paid to the USPTO
 - Attorney fees
 - Maintenance fees after the patent has been issued.

Trademark/dress

- Trademark and trade dress
 - Definition
 - Registration with the USPTO
 - Not necessary but many benefits
 - Likelihood of confusion
 - Duration: until it is abandoned



IP is important!

- Revenue generating assets
 - licensing fees, royalty, selling
- Important tools in a competitive marketplace:
 - sword and shields
- Leverage for a start-up company
 - attract VC investments
 - prevent copycats

