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Introduction to US Patent and Trade Secret Law

Grand Junction Business Incubator
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DISCLAIMER!

- This may be boring
- You may not learn anything
- If you learn something, it'll probably be enough to make you dangerous
- This is **NOT** legal advice

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IDEAS AND CONCEPTS

- Are *not protectable* in and of themselves
- Legal protection extends to the *tangible expression* of ideas and concepts
- This tangible expression is known as *Intellectual Property* ("IP")

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INTELLECTUAL PROPERTY

- **What?**
 - *Tangible Expression* of creative human endeavor
 - *Protected* by
 - *Patents*
 - *Trademarks*
 - *Copyrights*
 - *Trade Secrets*


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Can I Patent a Trademark For a Copyright?

NO, because:
Terms *patent*, *trademark* and *copyright* are not synonyms, but distinct intellectual property rights

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Intellectual Property...

- Transportation Analogy
 - Cars drive on land 
 - Ships sail on water 
 - Planes fly in air 
 - Hydroplanes travel on water and in air 

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Intellectual Property...

- **Patents** → Inventions or Discoveries
- **Trademarks** → Indicators of Source
- **Copyrights** → Original Works
- **Trade Secrets** → Confidential Information

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Intellectual Property...

- **Rights?**
 - **Limited term exclusive property right** in exchange for promotion of the useful arts and sciences (per US Constitution for patents and copyrights)

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Intellectual Property...

- **How Long?**
 - Until becomes **Public Domain**
 - Available for all to use
 - **Caveat:**
 - Public Availability ≠ Public Domain

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PATENTS

- **What?**
 - **Inventions or Discoveries**
 - Three Types
 - **Utility**
 - **Design**
 - **Plant**

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Utility Patent

Any **new, useful** and **nonobvious**

- **Process** (making an aluminum can)
- **Machine** (aluminum can making machine)
- **Manufacture** (aluminum can)
- **Composition of Matter** (alloy - steel)
- **Improvement thereof** (pop-top can)

protecting the technological and creative arts

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United States Patent
6,293,874 B1
Sep. 26, 2001

1976 UNITED STATES PATENT AND TRADEMARK OFFICE

1974 Inventor: John W. Nurnberger, III, Eugene O. ...
1973 Attorney: ...
1972 Appl. No. 08/121,212
1971 Filed: 08/12/1994

ABSTRACT
A method of forming a beverage can with a pop-top lid. The method includes providing a blank aluminum can body with a top flange. The top flange is formed by a top flange forming machine. The top flange forming machine includes a top flange forming die and a top flange forming punch. The top flange forming die is used to form the top flange of the can body. The top flange forming punch is used to punch the top flange of the can body. The top flange forming machine is used to form the top flange of the can body. The top flange forming machine is used to form the top flange of the can body.

FIG. 1
A perspective view of a beverage can with a pop-top lid. The can includes a top flange and a pop-top lid. The top flange is formed by a top flange forming machine. The pop-top lid is formed by a pop-top lid forming machine. The top flange forming machine is used to form the top flange of the can body. The pop-top lid forming machine is used to form the pop-top lid of the can body.

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Patents...

- **How Long?**
 - **Utility:** 20 years from filing date
 - **Design:** 14 years from grant date
 - **Plant:** 20 years from filing date

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Patents...

- **Public Domain?**
 - **Expiration** of grant

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Patents...

- **Marking?**
 - U.S. Patent No. 6,565,059 (*utility*)
 - U.S. Patent No. D253,194 (*design*)
 - U.S. Patent No. PP13,360 (*plant*)
 - U.S. Pat. Pend. (*pending application*)

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Patents...

- **Who is an Inventor?**
 - Contributor to an element in a *Claim*
- **Who is an Owner?**
 - Inventor, or
 - Assignee
- **Who is an Applicant?**
 - Inventor, or
 - Assignee

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Patents...

- **Acquisition of Rights?**
 - Upon *grant*
 - US Patent & Trademark Office
 - *Registration required*

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Patents...

- **US Application Process?**
 - Patent right belongs to **Inventor**
 - Prior Art Bar Period
 - 12 months to file after **public disclosure**, or
 - **Deemed dedicated to public**
 - **Prior Art Search**

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Patents...

- Applications?
 - Foreign Filing Considerations:
 - Disclosure can be **Absolute Bar**
 - Filing Date = **Priority Date**

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Patents...

- US Application Parts
 - Specification
 - Abstract
 - Drawings
 - Claims
 - Ancillary Documentation
 - Declaration of **Inventor**
 - Assignment to **Owner/Applicant**

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Patents...

- Applications?
 - Types:
 - **Provisional** (*only utility*)
 - **Non-provisional**
 - **Patent Cooperation Treaty**

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Patents...

- Applications?
 - **Provisional**
 - Minimal disclosure - no claim
 - **12 months** duration
 - No examination
 - **No grant**
 - **Priority date placeholder**

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Patents...

- Applications?
 - **Non-provisional**
 - Complete disclosure with claims
 - Examination
 - May mature into a **Grant**

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Patents...

- Applications?
 - **Patent Cooperation Treaty**
 - Foundation for **foreign filings**
 - Disclosure/Examination/Grant
 - Initial filing, or
 - Based upon **US filing**

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Patents...

- **Applications?**
 - Pendency
 - First-come, first-served
 - **First action** average = 18 months
 - **Biotech** = 3-5 *years*
 - **Examination** average = 3 years

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Patents...

- **Applications?**
 - **CO\$\$T\$**
 - **Legal Fees** - *prepare application*
 - **Filing Fees** - *file application*
 - **Issuance Fees** - *grant patent*
 - **Maintenance Fees** - *keep patent*

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Patents...

- **Intangible property right**
 - Exploit for self (own)
 - Permit another to exploit (license)
 - Sell to another (dispose)

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Patents...

- **Licensing?**
 - **Permission** to use per terms
 - Any or all rights to *make, use and sell*
 - *Time*
 - *Territory*
 - *Payment*
 - *Quantity*
 - *Etc.*

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Patents...

- **Infringement?**
 - **ALL Elements of Claim are met**
 - *Literal*
 - *Doctrine of Equivalents*
- **What is okay?**
 - **Express permission**
 - **Public domain**

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Patents...Practice Pointers

- **Disclosure** can be **fatal**
 - **Prior Art Bar** (1 year look-back period)
 - **First to File** per America Invents Act (16 March 2013)
- **Provisional Patent**
 - **Priority date placeholder**
 - **No rights**
- **DIY** can be dangerous

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TRADE SECRETS

- **What?**
 - *Business information* that has
 - *Commercial value*
 - Provides an actual or potential *economic advantage* over others
 - Is *maintained in confidence*

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Trade Secrets...

- **Rights?**
 - *Exclusive* right to *use*

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Trade Secrets...

- **Where?**
 - *State by State*
 - Other areas of legal recognition
 - Federal

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Trade Secrets...

- **How Long?**
 - As long as maintained in *confidence*



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Trade Secrets...

- **Public Domain?**
 - *Disclosure*
 - By *anyone*
 - With or without fault

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Trade Secrets...

- **Marking?**



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Trade Secrets...

- Acquisition of Rights?
 - Upon *creation*
 - Not Registered
 - Contractual Right

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Trade Secrets... Practice Pointers


- Contracts
 - Employees
 - Independent Contractors
 - Third Parties
 - Duration of Duty
- Control Access
- Inventory

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QUESTIONS

- ANSWERS
 - The Answer to Life, the Universe and Everything is "42"
 - Douglas Adams, *Life, the Universe and Everything*
(*Hitchhiker's Guide to the Galaxy* Trilogy)
 - "It Depends"
 - Universal legal answer



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