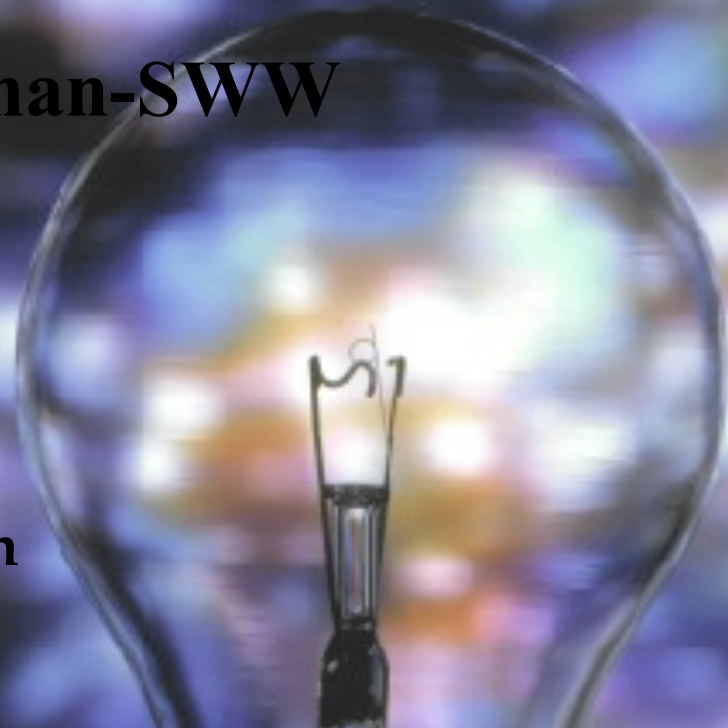


Intellectual Property for the Non-IP Practitioner

John Mansfield-MansfieldLaw

Devon Zastrow Newman-SWW

**Multnomah Bar Association
World Trade Center
March 3, 2011**

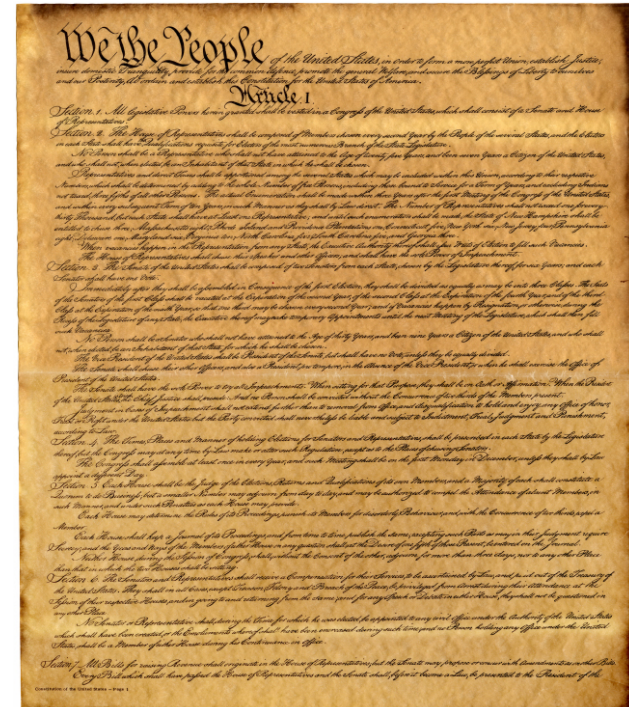


Program overview

- Introduction
- Trademarks and Copyrights
 - John Mansfield
- Patents and Trade Secrets
 - Devon Zastrow Newman

Intellectual property

“To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries”



The three big IP questions

- 1 - What rights are protected?
- 2 - How do you get them?
- 3 - How do you protect them?

Types of intellectual property

Trademarks



Copyrights



Patents



Trade Secrets



TRADEMARKS

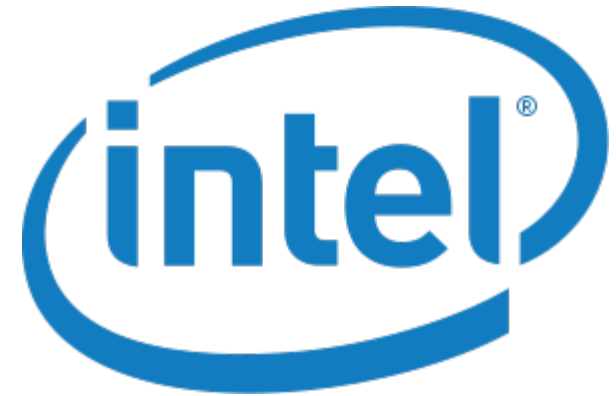


John Mansfield

® What is protected

Name, logo or trade dress used by business to uniquely identify the source of products and/or services, and to distinguish its products or services from those of other entities....

I.e., a BRAND



Trade dress

- Distinctive look and feel of a product



- Also protectable and can be owned by a business

® How to get them

- **Use** them to identify & differentiate your business/products/services
- Register with U.S.P.T.O. or other body (optional)
- Intent to use application (optional)

® How to take care of them

- Use continuously
- License carefully
- Monitor and enforce
- Mark with ® or ™

COPYRIGHTS



John Mansfield

© What is protected

- Original works of authorship
- **Fixed** in tangible medium of expression
- Ideas are *not* protected

Bundle of copyrights

- Copy or reproduce the work
- Prepare derivative works
- Distribute copies
- Perform the work publicly
- Display the work publicly

How to get them

- Create work in a fixed form
- Register with U.S. Copyright Office (optional)

© How to take care of them

- Register with U.S. Copyright Office (optional)
- Mark with © (optional)

Copyright use: The basic rule



If you didn't create it, you can't use it,
unless...

- Not protected under ©
- License/assignment
 - Fair use
- Public domain

Fair use

[T]he fair use of a copyrighted work...for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright. 17 U.S.C. § 107

What use is fair?

- The purpose and character of the use, including whether such use is of commercial nature or is for nonprofit educational purposes
- The nature of the copyrighted work
- The amount and substantiality of the portion used in relation to the copyrighted work as a whole
- The effect of the use upon the potential market for, or value of, the copyrighted work

Fair use mythology

- There was no ©
- I used fewer than 10/100/1000/10⁴⁷ words
- I changed it
- Public domain/it is everywhere on the net/ everyone else does it
- It wasn't original
- You can't copyright a
- I'm doing it for educational purposes
- Credit = permission

Public domain



<http://copyright.cornell.edu/resources/publicdomain>

PATENTS



Devon Newman



What is protected

- New, useful and non-obvious processes, machines, articles of manufacture, or compositions of matter
- A legal right to exclude others from making, using, offering to sell, selling and/or importing a claimed invention, for a limited time

U.S. Patent types

- Utility patents
- Design patents
- Provisional patents
- Plant patents

Patents

Design

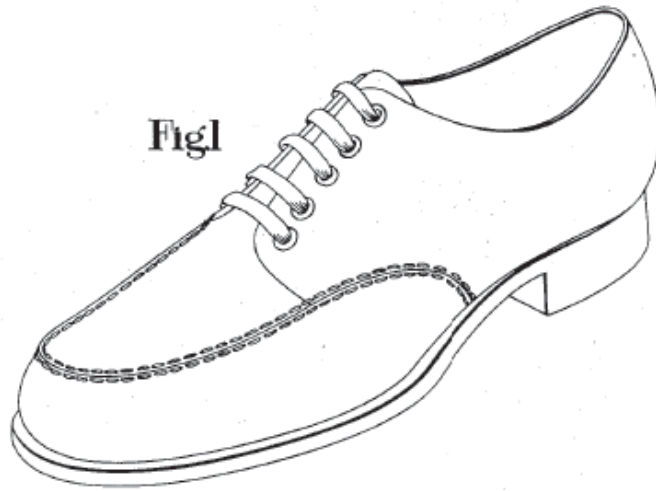
Feb. 11, 1941.

F. R. MERRITT
SHOE

Des. 125,090

Filed Aug. 23, 1940

Fig 1



Utility

I claim:

1. A paint mixture, comprising a latex • base, 5% toluene...



How to get them

- File application in U.S.P.T.O.
- File provisional application (optional)
- File foreign application (optional)



How to take care of them

- File within 1 year of public use/sale (U.S.)
- Properly name all inventors
- Don't commit inequitable conduct
- Don't misuse
- Mark products as appropriate
- Pay maintenance fees

Patent Enforcement

- Monitor for Infringement
- Cease and Desist Letter
- Licensing Discussions
- Litigation



Patent strategy

- Know your client's business
- Be aware of the landscape
- U.S. v. foreign protection
- Offensive or defensive use of patents

TRADE SECRETS



Devon Newman



What is protected

- Information that is:
 - Valuable because not generally known to others
 - Has been maintained as secret under the circumstances

How Is A Trade Secret Different From Other IP?

- Unlike a patent:
 - Doesn't have to be new
- Unlike a trademark:
 - Not about avoidance of confusion
- Unlike a copyright:
 - Doesn't protect the form of expression





How to get them

- Create the information (no need to fix form) and
- **Keep it secret**



How to take care of them

- Take all reasonable steps to keep secret
 - Non-disclosure agreement
 - Employee agreement
 - Employer policies
- Don't file for a patent

Misappropriation

- Acquiring a trade secret by someone who knows/should know that the trade secret was obtained improperly
- Disclosure/use of a trade secret
- Penalties:
 - Injunction
 - Damages
 - Criminal law



Non-misappropriation

- Information is publicly disclosed other than by misappropriation
- Independent discovery
- Reverse engineering



John Mansfield

john@mansfieldlaw.net

971 271-8615

Devon Zastrow Newman

dnewman@schwabe.com

503 796-2944