

Intellectual Property Strategy

Deborah Kang - UC Berkeley School of Law
Mike Saunders – Saunders Law, PLLC

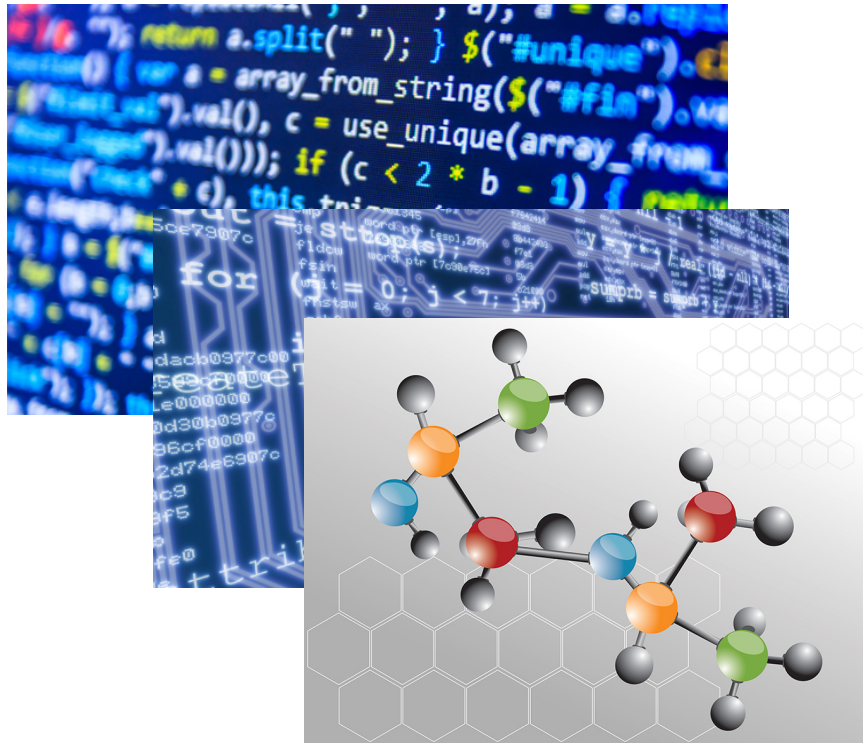
Welcome and Introduction

- About this class
 - Goal: to provide an overview of the basic laws and issues surrounding intellectual property at the formation of a startup
- About us

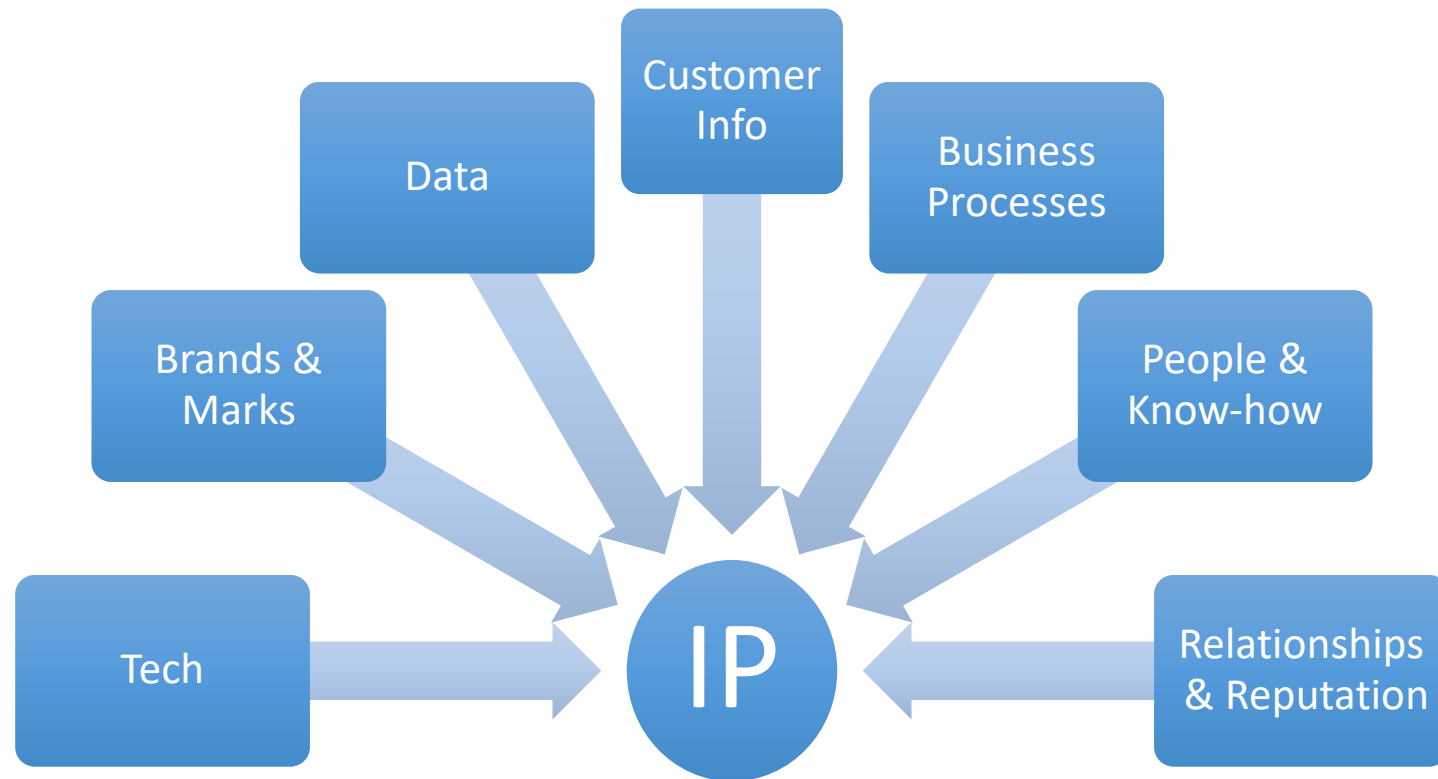
Intellectual Property Strategy

- **Types of Intellectual Property**
- Methods of Protecting Intellectual Property
 - Trademarks
 - Patents
- Creating a Strategy
- Ownership Issues
- Open Source
- Business Restrictions
- Other Common Pitfalls

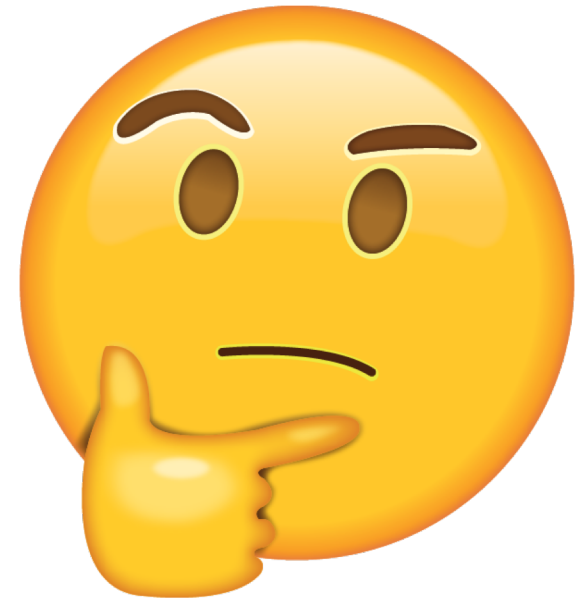
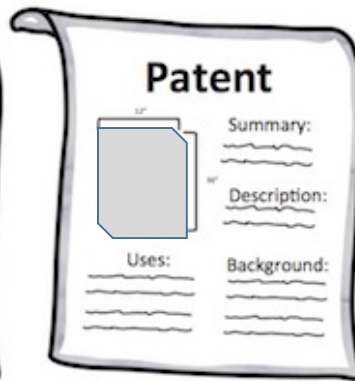
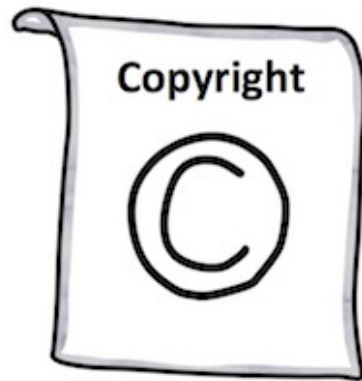
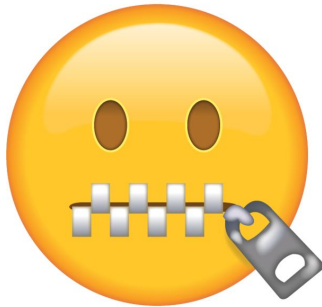
What is IP?



What is IP?



How can you protect IP?



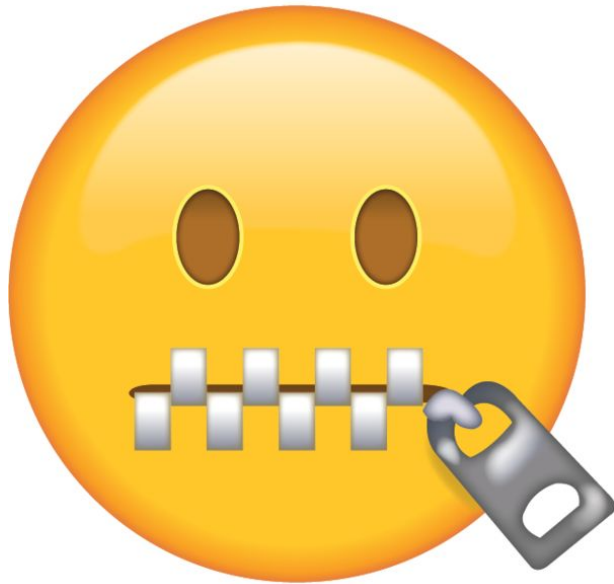
Intellectual Property Strategy

- Types of Intellectual Property
- **Methods of Protecting Intellectual Property**
 - Trademarks
 - Patents
- Creating a Strategy
- Ownership Issues
- Open Source
- Business Restrictions
- Other Common Pitfalls

How can you protect IP?

Type of IP	What is Protectable	Examples
trade secrets	secrets with economic value	non-public technology product roadmap
contract IP	as defined in the contract	technology business information
copyright	creative, authored works	software content
patent	inventions	new technology
trademark	branding	marks and logos slogans
domain names	presence	newco.com

Trade Secret

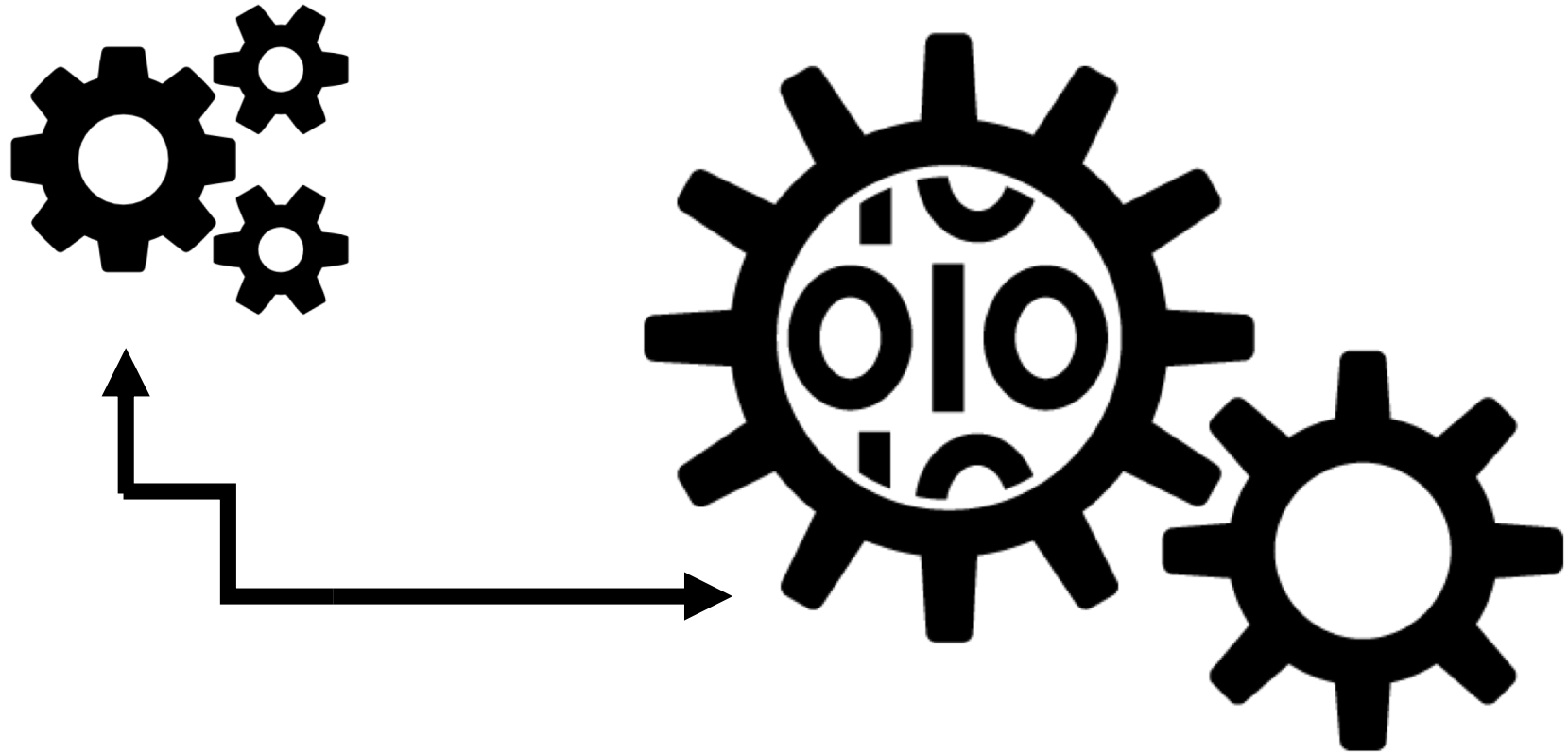


- Protects info & ideas
- No registration process
- Prevents stealing secrets and using stolen secrets
- Lasts as long as the secret is a secret

Trade Secret



Trade Secret



Contract NDA



- Protects confidential info
- No registration process
- Definitions rule
 - Disclosure
 - Use
 - Duration

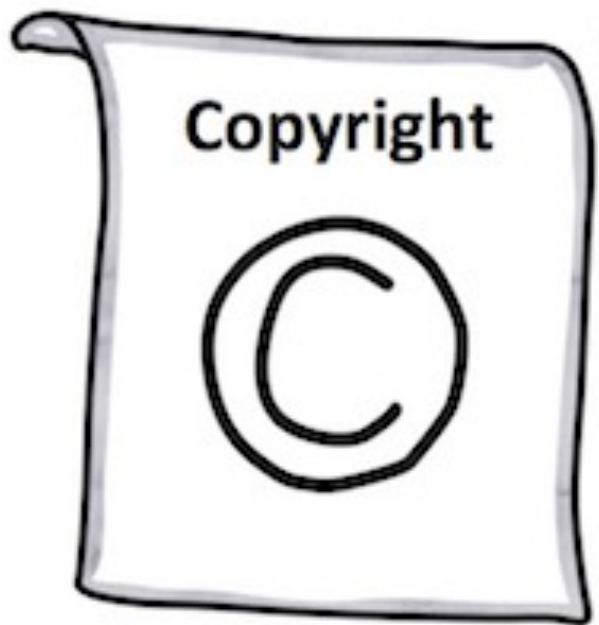
Contract NDA

- Beware of certain clauses:
 - **Feedback.** During the Term, each party shall provide the other party with Feedback regarding the other party's products and services. "Feedback" means any requirements, expectations, suggestions, test results, error data, bug reports or other information and materials provided by one party to the other party regarding such other party's products or services. The party providing such Feedback irrevocably assigns to the other party all of the providing party's right, title, and interest in and to the Feedback, including all patent rights, copyright rights, trade secret rights, and other intellectual property rights therein.

Contract NDA

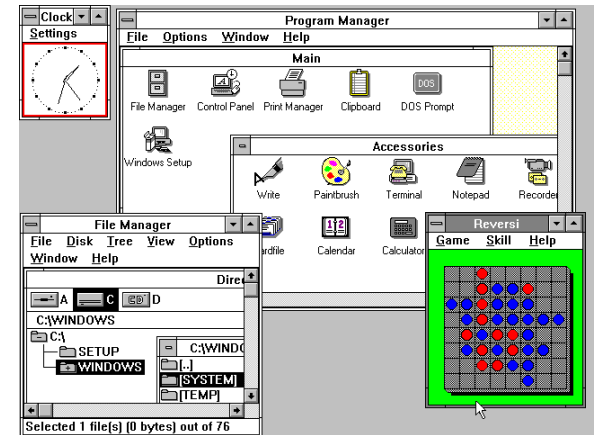
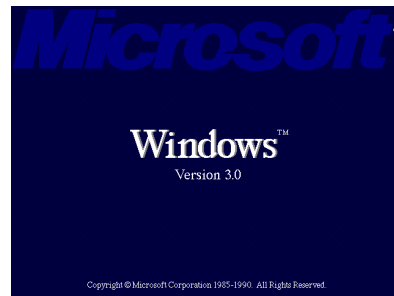
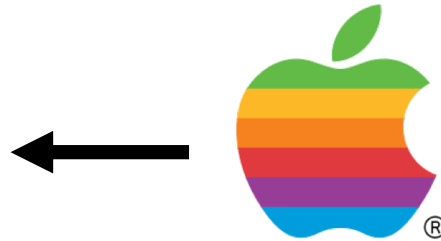
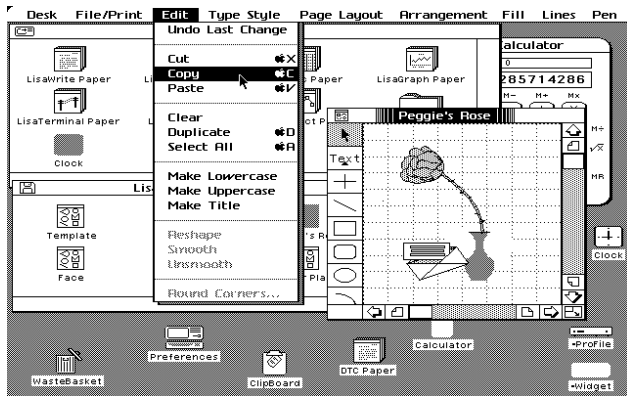
- Beware of certain clauses:
 - **Residuals.** Each party has the right to use for any purpose the Residuals resulting from access to or work with the other party's Confidential Information. The term "Residuals" means information in non-tangible form that is retained in the memories of persons who have had access to the other party's Confidential Information, including any generalized ideas, concepts, know-how or techniques contained therein. Nothing in this section or otherwise will be deemed to grant to either party a license under any of the other party's patents or copyrights. Neither party shall have any obligation to limit or restrict the assignment of such persons or to pay royalties for any work resulting from the use of Residuals.

Copyright



- Protects works of authorship
- Registration process
- Lasts practically forever

Copyright



Trademark

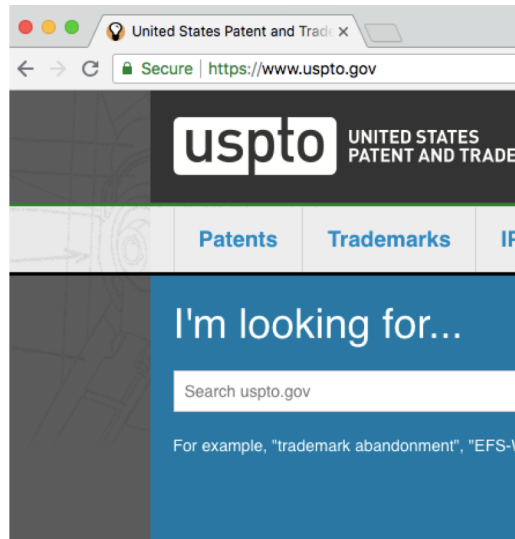


- Protects branding and marks
- Registration process
- Lasts as long as in use*

Trademark



Trademark



Learn about the process

Patents

- [General information concerning patents](#)
Find out if a utility, design, or plant patent is right for you

- [Patent process overview](#)
An overview of a patent application and

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Updates and announcements

Fees and Payment

Pay maintenance fees and learn more about filing fees and other payments

Systems status

Current and planned system outages

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Patents

Trademarks

Trademarks > Trademark Electronic Search System (TESS)

Welcome to the **Trademark Electronic Search System (TESS)**. This search engine allows you to search the USPTO's database of registered trademarks and prior pending applications to find marks that may prevent registration due to a **likelihood of confusion** refusal.

WARNING: Before conducting your search, you must understand the following: (1) what the database includes; (2) how to construct a complete search; and (3) how to interpret the search results. Click [TESS TIPS](#) for detailed information on these and other important search topics. If mark images do not appear when viewing search results, clear the cache in the Internet browser. If you need detailed instructions for clearing the cache, contact tes@uspto.gov. Thank you.

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▶ **Word and/or Design Mark Search (Free Form)**

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Guides and manuals

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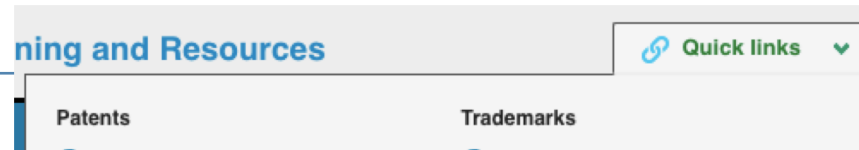
Pay maintenance fees and learn more about filing fees and other payments

Systems status

Current and planned system outages

Trademark

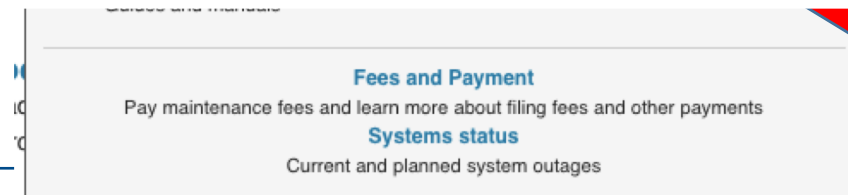
Trademark ID Manual



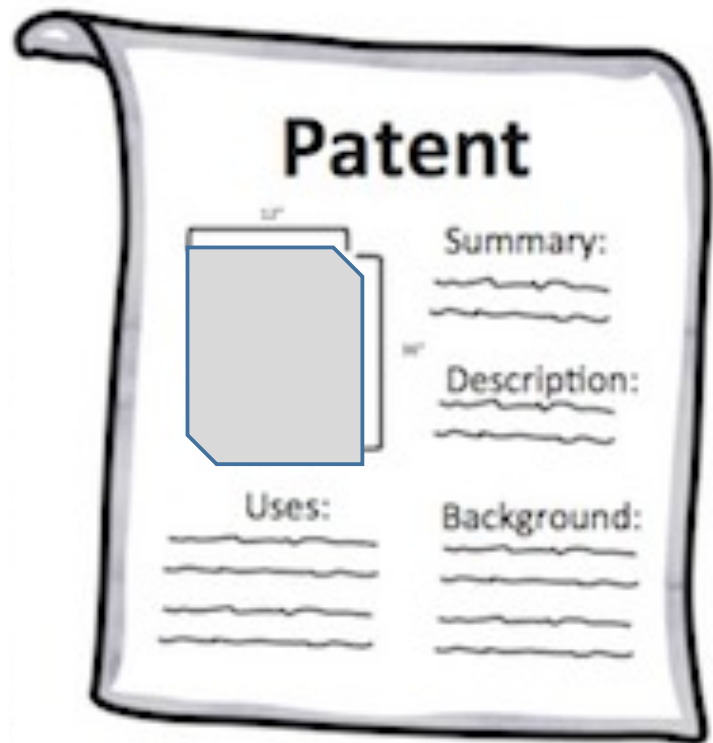
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ID Master List



Patent



- Protects inventions
- Registration process
- Lasts for 15-20 years

Basics of Patent Protection

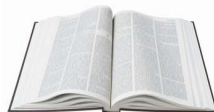
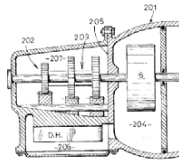
Michael Saunders
Saunders Law, PLLC

Outline

- What is a Patent?
- Why get a Patent?
- Who can file for a Patent?
- Types of Patents
- Requirements for Patentability
- How is a Patent granted?
- How long does it take to get a Patent in the United States?
- Patenting Considerations
- Trade Secret vs. Patent

Overview of Intellectual Property

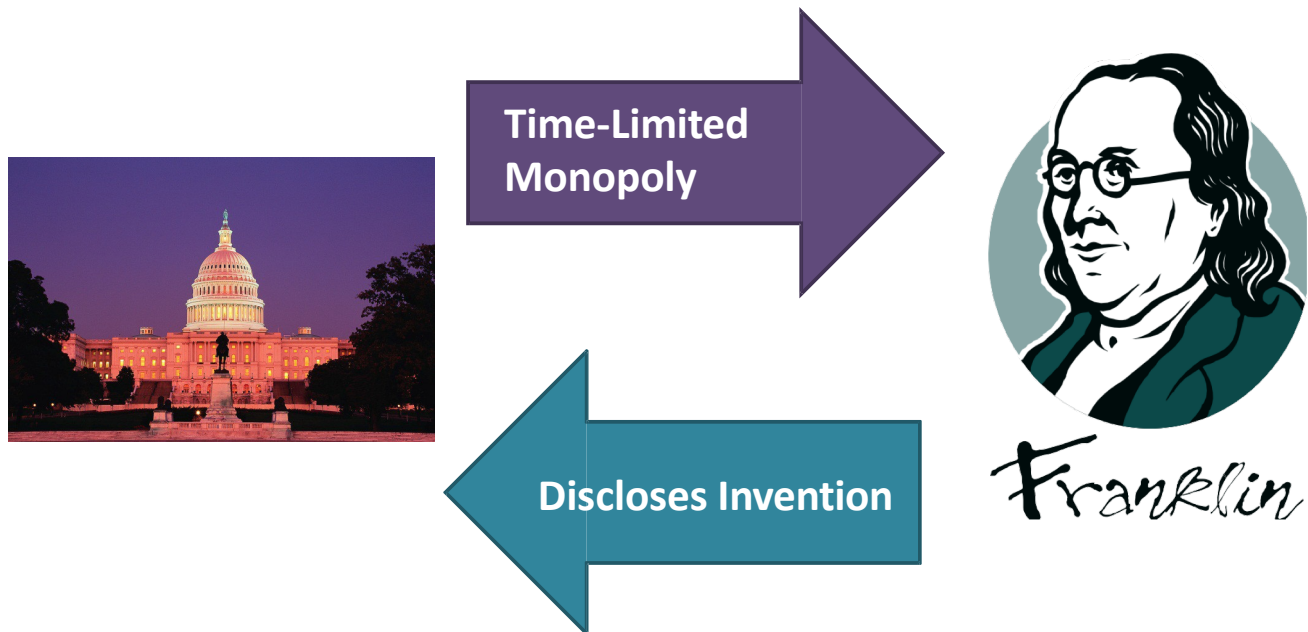
	What's Protected?	Examples	Protection Lasts for:
Utility Patent	Inventions	iPod, chemical fertilizer, process of manipulating genetic traits in mice	20 years from the date of filing regular patent application
Design Patent	Ornamental (non functional) designs	Unique shape of electric guitar, design for a lamp	14 years
Copyright	Books, photos, music, fine art, graphic images, videos, films, architecture, computer programs	Michael Jackson's Thriller (music, artwork and video), Windows operating system	The life of the author plus 70 years (or for some works, 95 years from first publication)
Trade Secret	Formulas, methods, devices or compilations of information which is confidential and gives a business an advantage	Coca-Cola formula, survey methods used by a pollster, new invention for which patent application has not been filed	As long as information remains confidential and functions as a trade secret
Trademark	Words, symbols, logos, designs, or slogans that identify and distinguish products or services	Coca-Cola name and distinctive logo, Pillsbury doughboy character	As long as business continuously uses trademark in connection with goods or services



What is a Patent?

- A Property Right
 - Right to **exclude others** from making, using, selling, offering for sale or importing the claimed invention
 - Limited term
 - Territorial: protection only in territory that granted patent; NO world-wide patent

Quid Pro Quo



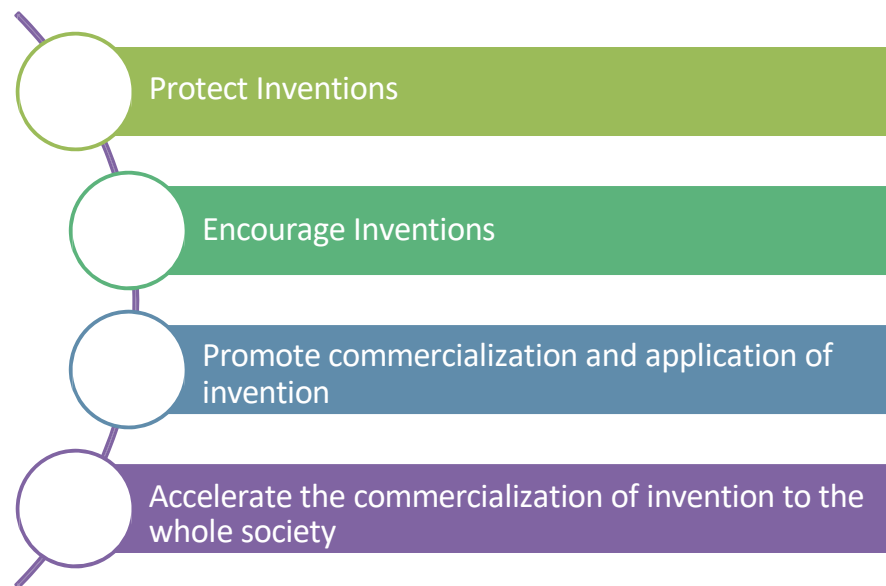
Basis for Protection of US Patents and Copyright

US Constitution, Article 1, Section 8, Clause 8

“Congress shall have the power ... 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.”



Role of the Patent System



Why Get a Patent?

- A patent can be
 - Used to gain entry to a market
 - Used to exclude others from a market
 - Used as a marketing tool to promote unique aspects of a product
 - Sold or licensed, like other property

Who Can File for a Patent?

- Anyone...from anywhere may apply, with only one exception:
 - Officers and employees of the USPTO

35 U.S.C. §4 - Restrictions on officers and employees as to interest in patents
Officers and employees of the Patent and Trademark Office shall be incapable, during the period of their appointments and for one year thereafter, of applying for a patent and of acquiring, directly or indirectly, except by inheritance or bequest, any patent or any right or interest in any patent, issued or to be issued by the Office...
- An assignee, a person to whom the inventor is under an obligation to assign, or a person who otherwise shows sufficient proprietary interest

Types of U.S. Patents

- Utility – How an invention works
 - Inventions
 - Functionality
 - 20 year term from filing date
- Design – How it looks
 - ornamental design described & shown
 - 14 year term from grant date
- Plant – new variety of asexually reproduced plant.
 - 20 year term from filing date

Plant Patent PP20,900



US00PP20900P2



United States Plant Patent
Kelly et al.

(10) **Patent No.:** **US PP20,900 P2**
(45) **Date of Patent:** **Mar. 30, 2010**

(54) **PIN OAK TREE NAMED 'PWJR08'**

(50) Latin Name: *Quercus palustris*
Varietal Denomination: **PWJR08**

(76) Inventors: **Joseph C. Kelly**, 6511 NE. 41st St.,
Redmond, OR (US) 97756; **Peter J.**
Brentano, 5009 Davidson Rd. NE., St.
Paul, OR (US) 97137

(*) Notice: Subject to any disclaimer, the term of this
patent is extended or adjusted under 35
U.S.C. 154(b) by 0 days.

(21) Appl. No.: **12/315,680**

(22) Filed: **Dec. 4, 2008**

(51) **Int. Cl.**
A01H 5/00 (2006.01)

(52) **U.S. Cl.** **Plt./225**

(58) **Field of Classification Search** **Plt./225**
See application file for complete search history.

Primary Examiner—Susan B McCormick Ewoldt
(74) *Attorney, Agent, or Firm*—Klarquist Sparkman, LLP

(57) **ABSTRACT**

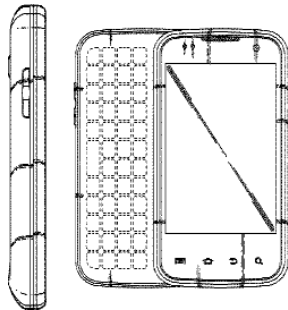
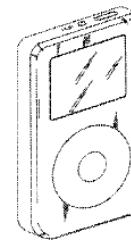
A new variety of *Quercus palustris* Pin Oak tree substantially
as herein shown and described, characterized particularly by
a combination of glossy foliage, new growth leaves that are
pubescent, upright growth habit and orange-red Fall color.

8 Drawing Sheets

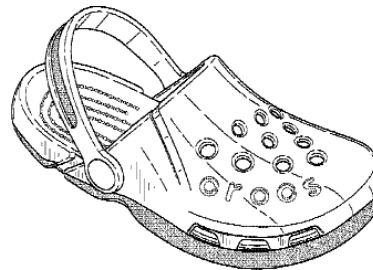


Design Patent

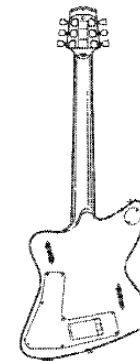
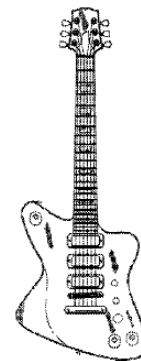
- Protects the way an article looks, including
 - its shape and configuration, as well as
 - surface ornamentation applied to the article



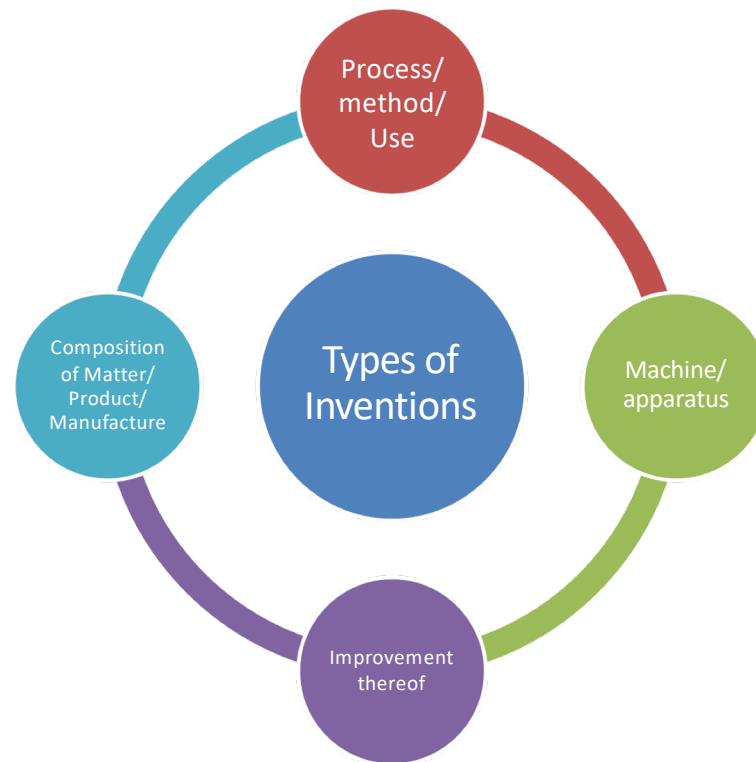
Christian Dior
Couture



Crocs



Utility Patents



Requirements for Patentability

35 USC §101 – Utility, Statutory Subject Matter

35 USC §112 (a) – Enablement, written description, and best mode

35 USC §112 (b) – Definiteness

35 USC §102 – Anticipation

35 USC §103 – Obviousness

It's all about the claims!

- Protection is limited to what is claimed
- During prosecution, claims are searched, may be rejected, amended, and allowed
- Specification may include numerous embodiments and elements
 - but only subject matter claimed is afforded protection
- Examiner works with the Applicant to focus the claims on novel aspects of the invention
- Broadest reasonable interpretation during examination
 - Search of invention may extend to unrelated areas

Patent Examination

- Patent Examiner reviews contents of the application for compliance with all U.S. legal requirements
- **Burden is on the examiner: An applicant is entitled to a patent unless...**
 - Requirements of U.S. Law are not met

35 U.S.C. 101

- Patent eligible subject matter:
 - Process
 - Machine
 - Manufacture, or
 - Composition of matter
- Judicial exceptions:
 - Abstract ideas
 - Products of nature
 - Natural phenomena

35 U.S.C. 112 (a)

- The specification shall contain
 - a **written description** of the invention, and of
 - the manner and process of making and using it,
 - in such full, clear, concise, and exact terms as to **enable** any person skilled in the art
 - to which it pertains, or with which it is most nearly connected,
 - to make and use the same,
 - and shall set forth the **best mode**
 - contemplated by the inventor of carrying out his invention

35 U.S.C. 112 (b)

- The specification shall conclude with
 - one or more **claims**
 - particularly pointing out and
 - **distinctly claiming**
 - the subject matter which the applicant regards as his invention

35 U.S.C. 102

- 35 U.S.C. 102 - an invention must be new
 - An invention lacks novelty (i.e., is “anticipated”) only if
 - each and every element as set forth in the claim is found,
 - either expressly or inherently,
 - in a single prior art reference
 - Reference must teach every aspect of the claimed invention either explicitly or impliedly
 - Any feature not directly taught must be inherently present

35 U.S.C. 103

- 35 U.S.C. 103 - an invention must be non-obvious
 - More than a mere obvious modification of the prior art
 - Reference teachings must somehow be modified to meet the claims
 - Modification must be one which would have been obvious to one of ordinary skill in the art at the time the invention was made
 - The teachings of multiple references may be combined under § 103

Prior Art - 35 U.S.C. 102 & 35 U.S.C. 103

- Prior Art
 - Any information available for consideration when determining whether an invention is patentable
 - Public information
 - Patents, publications, articles, products, information on the internet, etc.
 - Printed publications – U.S. or foreign
 - Information available/dated before the filing date of application being examined

Examiners search the prior art

EAST Browser - L3: (173) (2/77) CCLS [US 6237152] Tag: 5 [Doc: 9/173 (FILTERED)] "Full" 1/6 (Total images 8) | Front Page

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US Full Image

US-PAT-NO: 6237152
DOCUMENT-IDENTIFIER: US 6237152 B1
TITLE: Pocketed waterproof garment and a method for providing same

Current US Cross Reference Classification - CCXR (5):
247

(54) POCKETED WATERPROOF GARMENT AND A METHOD FOR PROVIDING SAME
(75) Inventor: Kevin Gootrad, Draught Studios, #150, 47 W. Park St., Chicago, IL (US) 60605
(*) Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(c) by 0 days.

(11) Appl. No.: 09318413
(22) Filed: May 25, 1999
(51) Int. Cl.: A41D 3/04
(52) U.S. Cl.: 2/87, 2/77, 2/92, 2/64, 2/56, 2/55, 2/50
(53) Field of Search: 2/49, 2/45, 4/1, 2/108, 94, 100, 67, 115, 2/16, 2/17, 95, 247, 2/5, 77, 70, 82, 125, 250, 87, 50839
(55) Reference Cited
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(10) Patent No.: US 6,237,152 B1
(45) Date of Patent: May 29, 2001

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4,773,566 • 12/1/82 Van 15:46
5,213,592 • 10/1/89 Hestlow 1:36
5,490,205 • 3/1/99 Lee 40:59
5,562,897 • 1/1/97 Wang 1:36
5,598,286 • 2/1/97 Mangione 2:57
5,638,514 • 3/1/97 Auland 2:57
5,876,441 • 3/1/99 Baker et al. 2:57
6,048,813 • 4/20/00 Horigan, Jr. 2:57

* cited by examiner
Primary Examiner—John J. Calvert
Assistant Examiner—Katherine Mena
(74) Attorney, Agent, or Firm—Patton + TMS

(57) ABSTRACT
A garment is provided having at least one pocket that is attached to the garment and accessible via a zipper or other fastener that provides access to an interior compartment formed by the pocket as well as a method for providing a garment with a waterproof zipper that is constructed via a process requiring the pocket and the zipper to be attached by stitching and/or braiding the same. As a result, a completely waterproof and waterproof pocket is formed allowing the use of the garment to carry items that typically may not be exposed to water.

22 Claims, 3 Drawing Sheets

Details Text Image HTML KWIC

FLT	U	S	Document ID	Publicati	Inventor	Page
9			US 6237152	20010529	Gootrad, Kevin	8
10			US 5924133	19990720	Zapiti, Mike	6
11			US 5919539	19990706	Bisbis, Benyoussef	7
12			US 5720044	19980224	Y. et al. Robinson, James	6
13			US 5689829	19971125	Rose, Walter T.	7
14			US 5628064	19970513	Chung, Chin-Fu	12
15			US 5492753	19960220	Levy, Ruth L. et	30

Other Types of Prior Art in the U.S.

- Prior sales or public use in the United States
 - If the U.S./foreign patent/publication or public use/sale in the U.S. is more than one year before the effective filing date
 - Applicant is barred from obtaining a patent
- AIA Changes to Prior Art (March 16, 2013)
 - Prior public use or sale anywhere in the world qualifies as prior art

Grace Periods

- Time prior to filing during which public disclosure by an inventor will not be considered prior art
- Differs in different jurisdictions.
 - U.S.: 1 year grace period (35 U.S.C. 102(b))
 - EU: No grace period.
 - JPO: 6-month grace period, under certain circumstances

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ABST	Abstract	ICN	Inventor Country
ACLM	Claim(s)	LREP	Attorney or Agent
SPEC	Description/Specification	AN	Assignee Name
CCL	Current US Classification	AC	Assignee City
ICL	International Classification	AS	Assignee State
APN	Application Serial Number	ACN	Assignee Country
APD	Application Date	EXP	Primary Examiner
PARN	Parent Case Information	EXA	Assistant Examiner
RLAP	Related US App. Data	REF	Referenced By
REIS	Reissue Data	FREF	Foreign References
PRIR	Foreign Priority	OREF	Other References
PCT	PCT Information	GOVT	Government Interest

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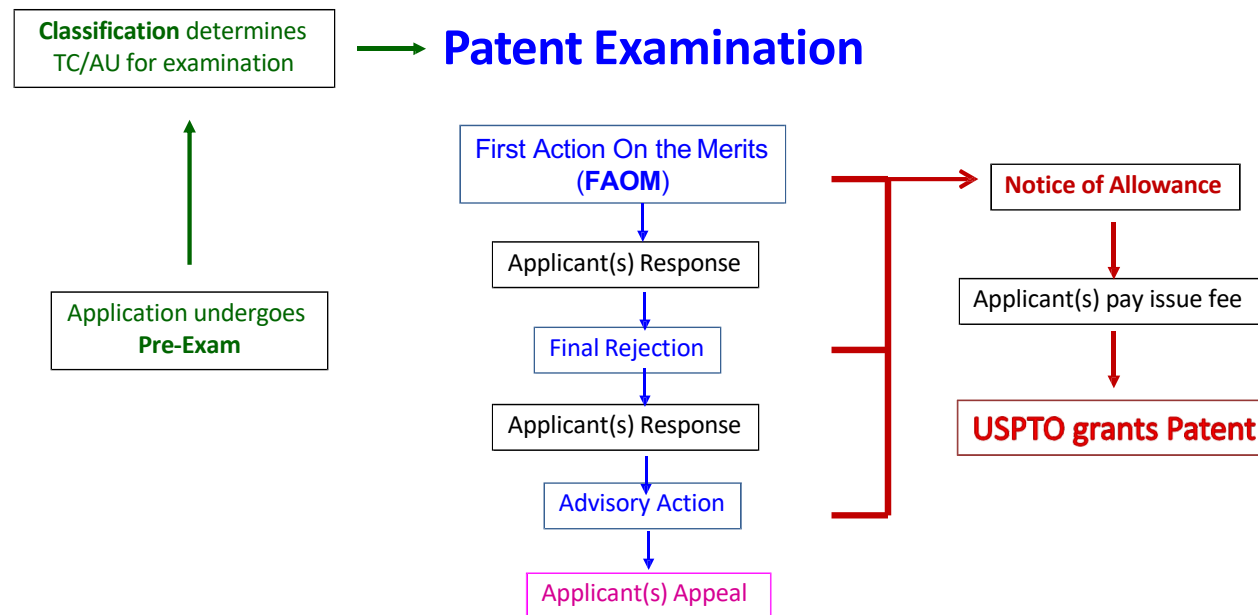
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04-06-2011	ISSUENF	Issue Notification	PROSECUTION	1	<input type="checkbox"/>
03-22-2011	IFEE	Issue Fee Payment (PTO-85B)	PROSECUTION	1	<input type="checkbox"/>
03-22-2011	WFEE	Fee Worksheet (SB06)	PROSECUTION	2	<input type="checkbox"/>
03-22-2011	N417	FIS Acknowledgment Receipt	PROSECUTION	2	<input type="checkbox"/>
01-12-2011	NOA	Notice of Allowance and Fees Due (PTOL-85)	PROSECUTION	4	<input type="checkbox"/>
01-12-2011	SRNT	Examiner's search strategy and results	PROSECUTION	1	<input type="checkbox"/>
01-12-2011	FWCLM	Index of Claims	PROSECUTION	1	<input type="checkbox"/>
01-12-2011	IIFW	Issue Information including classification, examiner, name, claim, renumbering, etc.	PROSECUTION	1	<input type="checkbox"/>
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12-17-2010	A...	Amendment/Req. Reconsideration-After Non-Final Reject	PROSECUTION	1	<input type="checkbox"/>
12-17-2010	CLM	Claims	PROSECUTION	3	<input type="checkbox"/>
12-17-2010	REM	Applicant Arguments/Remarks Made in an Amendment	PROSECUTION	2	<input type="checkbox"/>
12-17-2010	DRW	Drawings-only black and white line drawings	PROSECUTION	1	<input type="checkbox"/>
12-17-2010	WFEE	Fee Worksheet (SB06)	PROSECUTION	2	<input type="checkbox"/>
12-17-2010	N417	FIS Acknowledgment Receipt	PROSECUTION	3	<input type="checkbox"/>
12-17-2010	WFEE	Fee Worksheet (SB06)	PROSECUTION	1	<input type="checkbox"/>
08-20-2010	CTNF	Non-Final Rejection	PROSECUTION	5	<input type="checkbox"/>
08-20-2010	892	List of references cited by examiner	PRIOR ART	1	<input type="checkbox"/>
08-20-2010	BIB	Bibliographic Data Sheet	PROSECUTION	1	<input type="checkbox"/>
08-20-2010	FWCLM	Index of Claims	PROSECUTION	1	<input type="checkbox"/>

37 CFR 1.77(a): Elements of an Application

1. Utility application transmittal form.
2. Fee transmittal form.
3. Application data sheet – bibliographic information.
4. Specification.
 - Abstract, title, cross-references to related applications, background of invention, summary of invention, brief description of drawings, detailed description, claims, etc.
5. Drawings (if necessary).
6. Executed oath or declaration.

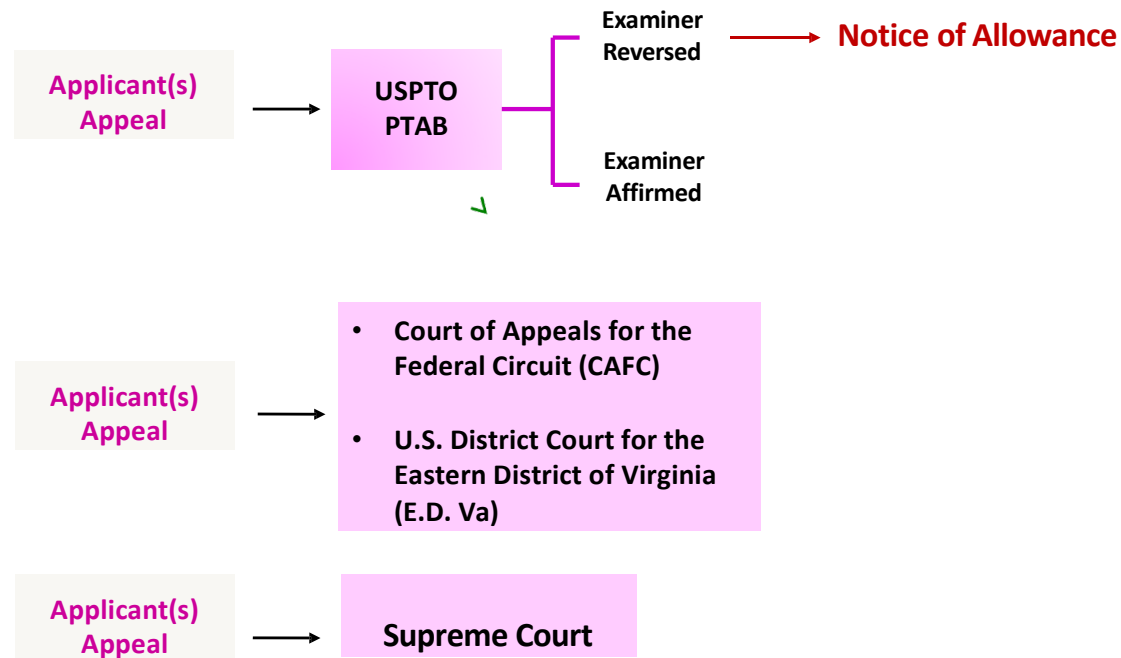
Flowchart of Patent Examination and Appeal System

(I) Patent Examination



Flowchart of Patent Examination and Appeal System, cont.

(II) Appeal Process



How long does the process take?

- Utility Patents
 - 15.5 months avg. for a first office action
 - 24 months avg. for total pendency
- Design Patents
 - 13 months avg. for total pendency
- Time can vary depending on the technology and amount of prosecution
 - ~530,000 application backlog
- ~8000 Patent Examiners

Where to Patent?


- Patent protection can be an important part of overall business strategy in global marketplace
- Patent rights are territorial
 - Protection against infringing activities
 - Only within the country or region in which patent was granted
- NO world-wide patent
 - Must apply for and be granted a patent in each country or region of interest

International Patent Protection

- The Patent Cooperation Treaty (PCT) helps patent offices with their patent granting decisions. By filing one international patent application under the PCT, applicants can simultaneously seek protection in 150 countries.
- **Filing:** you file an international PCT application in one language, and you pay one set of fees.
- **International Search:** an “International Searching Authority” (ISA) identifies the relevant prior art and writes an opinion on your invention’s potential patentability.
- **International Publication:** after 18 months the content of your international application is disclosed to the world.
- **National Phase:** after the end of the PCT procedure, usually after 30 months, you pursue your patents directly before the national (or regional) patent Offices where you want to obtain them.

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- 80+ countries
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→ What are the admissible entries for a date range search?

Related links +

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Select the database in which you wish to search: i
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2. Search terms
Enter keywords in English - ctrl-enter expands the field you are in

Keyword(s) in title: i plastic and bicycle
Keyword(s) in title or abstract: i hair
Publication number: i WO2008014520
Application number: i DE19971031696
Priority number: i WO1995US15925
Publication date: i yyyyymmdd
Applicant(s): i Institut Pasteur
Inventor(s): i Smith

Patenting Considerations

- Conduct cost/benefit analysis
 - Consider the shelf life of a product, e.g., changes in technology, style
 - Consider how the patent will be used, e.g. licensing, to exclude competitors
 - Consider whether the product can be used outside your market
- Determine patentability
 - Searching yourself vs. engaging a professional searcher
- Choose right patent attorney/agent
- Preparation of a thorough and accurate application
- Are there workarounds for the invention?
- Costs – Patents can be expensive.
 - Background work can help to keep attorney fees lower
 - Annuity & Maintenance fees

How much does it cost?

Fees

- USPTO Utility application
 - Filing fee
 - Search fee
 - Examination fee
 - Discount for small entities
 - Issue Fee
 - Maintenance Fees
due at 3 ½ , 7 ½ & 11 ½
years

- Attorney fees

- Hourly fees
- Flat Rates

- Design Patents

- No maintenance fees
- ~2,000-\$3,000

Cost varies based on amount of prosecution.

~\$5,000-\$25,000

Provisional Patent Application

- A low-cost way to establish an early effective filing date (priority date) in a non-provisional patent application with fewer formalities
 - Specification & Drawings
 - No claims required
- 12 month window to file a corresponding utility patent application in order to benefit from the priority date of the provisional application
 - Caution – will lose priority date for any new matter filed in the utility application
- Provisional application is abandoned automatically at 12 months and is not examined

Patent Infringement in the U.S.

Occurs when –

Without authorization of patent owner:

- Making or using the invention
- Offer to sell or sells within the U.S.
- Import the invention into the U.S.
- Actively induce infringement by another

Enforcement Considerations

- Enforceability of patents
 - Effectiveness of enforcement laws and procedures in the country/region of interest
 - Some countries allow recordation of patent with customs
- Enforcement requires patent owner action
- Competitor products should be monitored
 - In stores
 - At trade shows
- Licensing may be beneficial
 - Limit as to time, geographical area, or field of use

Trade Secret Law

- Protects a commercially valuable proprietary information
- Valuable business information that gives a competitive advantage
- Trade Secrets are not generally known and must be subject to reasonable efforts to preserve confidentiality
- Examples
 - Formulas (e.g. Coca-Cola®)
 - Manufacturing processes
 - Business strategies
 - Business management information
 - Customer lists
 - Design concepts

Trade Secret vs. Patent

Trade Secret

- Indefinite
- Not registered or disclosed
- Can be separately discovered
- Remedy only if the secret is illegally appropriated

Patent

- 20 year term
- Public disclosure
- Right to exclude others
- Remedy for infringement

Common Ways to Lose a Trade Secret

- Owner or owner-authorized disclosure
- Reverse engineering
- Independent development
- Failure to take adequate steps to prevent disclosure

Resources

- <http://www.uspto.gov/inventors/index.jsp>
 - Inventors Resources on PTO Internet site
- <http://patft.uspto.gov/>
 - Searching US patents
- http://www.uspto.gov/patents/init_events/pct/index.jsp
 - PCT Legal Web site
- <http://www.StopFakes.gov>
 - Protecting Intellectual Property Rights
- <http://www.ustr.gov/trade-topics/intellectual-property>
 - Office of US Trade Representative
- <http://www.wipo.int>
 - World Intellectual Property Organization
- <http://www.espacenet.com/access/index.en.html>
 - European patent database
- http://www.ipdl.ncipi.go.jp/homepg_e.ipdl
 - Japanese patent database

THANK YOU

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