

What Innovators in Technology Should Know About Intellectual Property

On a first visit, the world of Intellectual Property is mysterious and dangerous. Missteps can result in the loss of rights in inventions, can find a business having to sacrifice time and money spent in building a brand, and can leave an artist without many options to stop a blatant copier. Following is a brief list of what are, in my opinion, some of the most helpful tips for those who are often involved in innovation in technology, and business in general. Following these tips should help innovators avoid the more common pitfalls.

TIP 1: Identify Your Intellectual Property (IP)

Inventions:

An invention is almost anything that has a particular function or design and that resulted from innovation, such as a product, system, assembly, method, design, etc. Those that are **new** (*i.e.*, never been seen in exactly the same way before), **nonobvious** (*i.e.*, not obvious changes from what has been done before), and **useful** may be patentable.

Trademarks and Trade Dress:

Practically **ANYTHING** that indicates the source, origin, or sponsorship of a good or service constitutes a trademark or trade dress. This includes logos, product names, business names, product design, packaging design, and even sounds, colors, and smells. Those that are not likely to cause confusion with other registered trademarks or trade dress may be registerable themselves.

Copyrights:

Most **Original Works of Authorship**, such as books, music, photographs, website designs, logo designs, software source code, instruction manuals, product packaging, and other artistic, literary, musical, and dramatic work, are subject to copyright, and the copyright may be registerable.

TIP 2: Keep Records of Your Innovation from Its Initiation

Inventions:

Use an **Inventor's Notebook** to record how, when, and why you **conceived** of your invention and to track how you **reduced it to practice**.

Trademarks and Trade Dress:

Keep records of how you chose your mark, when you first used it anywhere, when you first used it in offering or selling goods or service, where you used it, how you used it, for what goods or services you used it, etc. Keep samples of how you use it, *e.g.*, copies of the labels, packaging, etc., showing your mark.

Copyrights:

Keep your drafts. Make a note of when you completed the work. Make a note of when you published the work. Keep a copy of the work itself.

TIP 3: Investigate Your IP Yourself (Before Calling an IP Attorney)

You can save *a lot* of money if you investigate the patentability of your invention or the registerability of your trademark before you spend money on legal opinions or applications.

Inventions:

Search for inventions with similar key features using:

- Google Patents (www.google.com/patents);
- the US Patent Office's website for issued patents (<http://patft.uspto.gov/netahtml/PTO/search-bool.html>) and published patent applications (<http://appft1.uspto.gov/netahtml/PTO/search-bool.html>);
- the World Intellectual Property Organization (<http://www.wipo.int/pctdb/en/>); and
- the Internet (using Google, Yahoo, Bing, or other Internet Search engines)

Keep notes on **everything significant you find!**

Trademarks:

Look for product names, business names, logos, etc., that are similar in appearance or sound, particularly those used with similar goods or services:

- Search for your exact mark and similar-sounding marks using the Trademark Electronic Search System (TESS) at the US Trademark Office (<http://tess2.uspto.gov/>);
- Search the Internet (using Google, Yahoo, Bing, or other Internet Search engines)
- Visit [yourtrademark] .com, .net, .org and similar-sounding names .com, .net, .org, etc.

Keep notes on **everything significant you find!**

TIP 4: Understand Why Formal Protection is Important

Inventions:

Acquiring a patent on an invention allows the patent owner to stop someone else from making, using, selling, and importing a copy. A patent is limited to the geographic area of the issuing entity. In other words, to stop infringement in the U.S., you need a U.S.-issued patent. To stop an infringer in Japan, you need a Japanese patent. Generally speaking, **if a product is not patented, it is free for the copying.**

Trademarks:

Trademark rights can arise even without registering a trademark, but these “common law” trademark rights will be awfully limited and can be hard to prove. Registration of a trademark can greatly broaden the protection of the trademark and makes it easier to stop someone who later uses a confusingly-similar trademark. Federal registration gives you **nation-wide** coverage. Plus, it is probably the best way to alert others that you are using your trademark.

Copyright:

Copyright rights are usually established as soon as the work is created, but **registration is required before you can sue a copyright infringer**. By law, certain published works must be registered.

TIP 5: Protect Your IP Before It's Too Late

Inventions and Patents:

Keep Your Invention Secret Until You File a Patent Application: Generally, the instant you make a public disclosure of your invention (including selling your invention or offering to sell your invention), you lose many foreign patent rights, and you start a **one**-year countdown clock running on your opportunity to seek a patent in the United States.

Trademarks and Trade Dress:

File a Trademark Application Early: Filing a trademark application early, even before you begin to use your mark, is your best chance at acquiring the broadest possible protection and the best chance that someone else will not beat you to the registration with a confusingly-similar mark.

Copyright:

Register Within 90 Days of Publication: This is the best chance at being able to acquire money damages from a copyright infringer. Having money damages available makes it easier to convince an infringer to stop the copying.

TIP 6: Know Who Owns the IP

Inventions:

An invention is, at least initially, owned by the individuals who actually contributed to the conception and development of the invention (as claimed in the patent application). The inventors must be correctly listed on the patent application or the resulting patent could be invalid and unenforceable. (HINT: If your boss didn't help invent the invention, he/she should not be listed on the patent application.)

Transfer of ownership from inventors should be accomplished through a written assignment, and it should be recorded at the Patent Office if there is a patent application involved.

Trademarks:

A trademark is owned by the individual or entity to which the trademark indicates source, origin, or sponsorship. (HINT: It is *not* owned by the person who designed the logo, but by the business that actually uses the logo on its products.)

Transfers of ownership in a trademark must be accompanied by a transfer of the associated “good will” and should be recorded. (HINT: If you have a logo you use for potatoes, you can’t sell your trademark rights to another business who is going to use it for tires. That other company would be, essentially, starting over with the trademark.)

Copyrights:

Usually, the copyright is owned by the person or people who actually created the work. (HINT: The copyright in a painting of a potato is owned by the artist who actually painted the potato, not the person who requested that the potato painting be painted.)

Work-Related Exceptions:

When a work is prepared by **an employee** within the scope of his or her employment, the **employer** owns the copyright.

When a work is prepared by **an independent contractor**, there is a written agreement that the work is to be a “work made for hire,” and the work is for use as a contribution to a collective work, a part of a motion picture or other audiovisual work, a translation, a supplementary work, a compilation, an instructional text, a test, answer material for a test, or an atlas, then the **contractor** owns the copyright.

Joint Authorship:

When two or more people contribute to a work and intend that their contributions will be intermingled, they are joint authors. Each is free to fully utilize the work, but with an accounting to the other authors.

Transfers of ownership should be in writing, and should be recorded (if the copyright was recorded).

TIP 7: Correctly Use IP Markings:

Inventions:

“**Patent Pending**” or “**Pat. Pend.**” – Use only for those inventions for which a patent application has already been filed

“**Pat. ____**” or “**Patent ____**” – Use only after a patent actually issues

Trademarks:

® – Use only with **registered** trademarks.

TM – Can be used with unregistered trademarks.

Copyrights:

Copyright notice on the copyright work is not required, but recommended. It should look like this: © [Year of first publication] [Name of copyright owner]

TIP 8: Avoid Unintentional Infringement of Others' Rights

Even if you have no interest in protecting your own intellectual property, remember that you are operating in an environment crowded with the intellectual property of others. Before you invest substantial time, money, and energy into new products, you would be wise to check and make sure you are not infringing upon someone else's intellectual property rights.

Inventions:

Does your new product infringe on someone else's patent? – Before you go through the entire product development stage and introduce your product on the market, check for any patents on similar inventions. (See TIP 3 above.) Keep in mind that what matters is whether there is an enforceable, non-expired patent, not whether there is a product covered by that patent on the market. If you find patents for similar devices, processes, systems, methods, designs, etc., contact a patent attorney for a legal opinion as to infringement/non-infringement before you move forward.

Trademarks:

Is your mark similar to another's mark for similar goods or services? – Perhaps the most frequent problem I see innovators in business encounter is the unknowing trademark dispute situation in which the innovator adopted a trademark, invested a lot of time, money, and energy in building up the trademark only to get a cease and desist letter from another business that has an older and somewhat-similar (or sometimes identical) mark. So, before you pick a new trademark and before you register a new domain name, check for any similar trademarks for similar goods or services. (See TIP 3 above.). If you find something somewhat similar, ask yourself: Do I want to risk being sued by the owner of this mark? (HINT: Avoid trademarks that are even somewhat similar to famous mark. Thus, no "A Tea & Tea Shops" please!) Consider getting a legal opinion as to infringement/non-infringement from an attorney.

Copyrights:

Don't copy someone else's work without permission (or a sure-fire fair use excuse) – Even if a work is not marked as being subject to copyright, the chances are very good that it is. Even if you cannot find a record of a copyright registration in the Copyright Office's records, the work is still probably subject to copyright.

Modifying the work when you copy it doesn't mean you haven't committed copyright infringement – Copyright holders have the right to stop others from making copies and derivative works, *i.e.*, works derived from the original. So, don't make even a modifying copy.

Get permission if you really want a copy – Many copyright owners are very willing to grant permission for others to make copies, make derivative works, publicly display, and even sell their work. It could be as easy as asking and getting a simple license prepared. This can save a lot of time, money, and stress down the road.

TIP 9: Engage an IP Attorney:

You are not required to be represented by an attorney to protect, enforce, or defend your intellectual property rights (unless you are a business seeking to enforce or defend your rights in a lawsuit). However, many choose to have an IP attorney help them with the process. There is a reason for this. Attorneys know the system and greatly improve your chances of getting through it successfully.

This tip is, of course, coming from a patent attorney with an obviously-biased perspective. Still, I have seen, too many times, innovators who tried to go it alone and, due to unfamiliarity with the IP registration systems, made mistakes that resulted in the loss of valuable IP rights. So, don't be afraid to hire an IP attorney to help you with the process.

Importantly, because the world of intellectual property is very different than the other areas of law, if you seek counsel, **seek an attorney who is experienced in Intellectual Property law**.

This tip applies to all stages of Intellectual Property dealings, including:

- **Pre-registration/application/use Stage:** To get a legal opinion about patentability, non-infringement, trademark registerability, trademark non-infringement, etc.
- **Registration/Application Stage:** To prepare and prosecute the patent application, trademark application, or (in complex situations) copyright registration application
- **Licensing/Ownership Transfer Stage:** To prepare the license, assignment, etc. (There are specific requirements, limitations, and implications on transfer of intellectual property ownership and licensing of rights. I have often encountered IP owners who have unwittingly lost rights in their IP through licenses/assignments that were not prepared by IP attorneys.)
- **Enforcement/Defense Stage:** If you learn that someone may be infringing your patent, trademark, or copyright rights, and if you are serious about stopping the infringement, engage an IP attorney. More importantly, if someone accuses YOU of infringing on their IP rights, engage an IP attorney right away!

Inventions:

Inventors are not required to engage a patent attorney or patent agent in the quest to get a patent on an invention. However, it is highly recommended because it is awfully difficult to maneuver through the complexity of the Patent Office's numerous rules, regulations, statutes, and procedures. Mistakes can lead to **complete loss of patent rights**. Even the first steps in the process are tricky, and mistakes at the early stages can have devastating results later on. Patent Attorneys and Patent Agents know the ropes, so call one!

Trademarks:

The trademark registration process, on the federal level, is not quite as complex as the patent prosecution process, but it is far from simple. The United States Patent and Trademark Office has Trademark Examining Attorneys handling trademark registration applications and there are still numerous rules, regulations, statutes, and procedures to be followed. Unless you are quite familiar with the ins and outs of the process, contacting an attorney with trademark prosecution experience may be a good idea.

Copyrights:

Copyright registration is usually rather straight forward, so many copyright owners will see to registering their copyrights without an attorney's help. However, if you have a complex situation, such as one in which it isn't clear who the authors of the work are or one in which the work to be registered is derived from a line of other work, etc., then contacting an attorney who is experienced in copyright law may be a good idea.

TIP 10: Prepare for the Process Before you Call an IP Attorney:

As with any significant step in life, do your homework and be prepared before you jump in with both feet. The following can make the process smoother:

- **Save Up!** – Particularly with patents and, to a lesser-degree, trademarks, the process is likely to be expensive. We're lucky to be in Idaho where patent services are available at relatively-low cost, but even here, the costs are nothing to scoff at. Ask for cost estimates early on, and start saving for the long haul. Failure to pay certain fees to the Patent and Trademark Office along the way can result in abandonment of your application. Also recognize that you are not guaranteed to get a patent, and even if you get a patent, it does not mean that you will make money off of the invention.
- **Realize That You'll Need to be Patient** – The patenting process often takes years to go from the initial filing to an issued patent. (I recently saw an estimate from the Patent Office indicating we should expect to wait more than 3 ½ years before they would even take a *first* examining look at a recently-filed patent application.)
- **Have the Facts on Your IP Ready for Your Attorney** – When you do call an attorney, it is often helpful if you supply him or her with all the information you have such as:

For Inventions:

- When did you invent it?
- Who was involved in inventing it?
- Have you disclosed your invention to anyone (including showing it to others, describing it to others, selling it, offering to sell it, etc.)?
- What similar inventions, products, methods, etc., are known to you? (Tell your attorney about **everything** known to you!)
- How is your invention different and better than the similar inventions, products, methods, etc.?
- Pictures or drawings of your invention.
- Notes from your search (from TIP 3) (Tell your attorney about **everything** you found!)
- What are your goals and priorities? E.g.,:
 - Do you want a patent in the U.S. only or in other countries as well?
 - Do you want to get patent pending as quickly and cheaply as possible?
 - Do you want to stay "patent pending" for as long as possible regardless of whether a patent ever issues?
 - Do you want to keep your invention completely secret unless and until you have a patent in hand?

For Trademarks:

- Have you used your mark yet?
- If so, when, where, and how have you used it?
- On what or with what goods and services have you used your mark?
- Do you plan to expand to other goods and services?
- Samples of how you have used your mark.
- Notes from your search (from TIP 3)
- Do you want trademark protection in any other country?

For Copyrights:

- A copy of the work to be registered
- Who are the authors, and what are their addresses, years of birth, and citizenships?
- What did each author contribute to the work?
- When was the work completed?
- When was the work first published?
- Are there any earlier-copyright works related to this one?

These Tips Brought to Girls in Tech Boise

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by

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