



Intellectual Property: How Do You Protect Your Great Idea?

Patents, Trademarks, Copyrights, & Trade Secrets

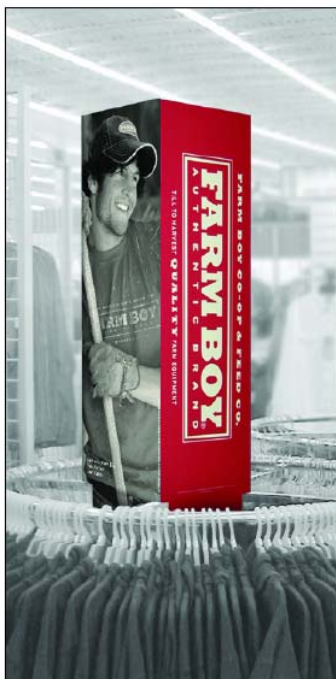
Dean R. Karau, Esq.

Carrie L. Rosenberry, Esq.



Different Types of Intellectual Property

A Cool Display?



FARM GIRL™ > BRAND FIXTURE TOWER

(Shown on Standard 4-Way Rack with Center Cross bars)

BRING ATTENTION TO FARM GIRL™ MERCHANDISE & INCREASE SALES WITH THIS UNIQUE CUSTOM DESIGNED IN-STORE 3D GRAPHIC.

LOOKS GREAT WITH FIXTURE PLACED ON CORNER OF INTERSECTING AISLES.

< FARM BOY® BRAND FIXTURE TOWER

(Shown on Standard Rounder Rack with Center Cross bars)

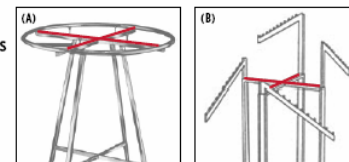
BRING ATTENTION TO FARM BOY® MERCHANDISE & INCREASE SALES WITH THIS UNIQUE CUSTOM DESIGNED IN-STORE 3D GRAPHIC.

LOOKS GREAT WITH FIXTURE PLACED ON CORNER OF INTERSECTING AISLES.



NO TOOL ASSEMBLY INSTRUCTIONS Farm Boy® & Farm Girl™ Brand Fixture Towers

The Farm Boy® & Farm Girl™ Brand Fixture Towers are designed to work with a standard Round Rack with center cross bars (A) and a standard 4-Way Rack with center cross bars (B). Either may be used depending on quantity of merchandise to be displayed. LOOKS GREAT ON A CORNER OF INTERSECTING AISLES!



1. Remove displays from shipping box and squeeze into square shape as shown.
2. Place square top into each tower so that it rests on inside foam squares.

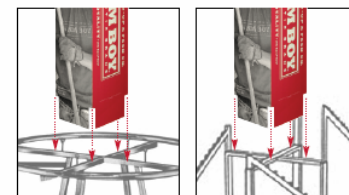


Farm Boy® Fixture Tower



Farm Girl™ Fixture Tower

3. Pick up Fixture Tower and place on your selected standard Round Rack or 4-Way Rack with center cross bars as shown. Making sure the cross bars are placed and resting into bottom of towers corner slots.



(A) Rounder Rack

(B) 4-Way Rack



THINK *PATENT*

- Inventions
 - Useful
 - Novel
 - Non-obvious

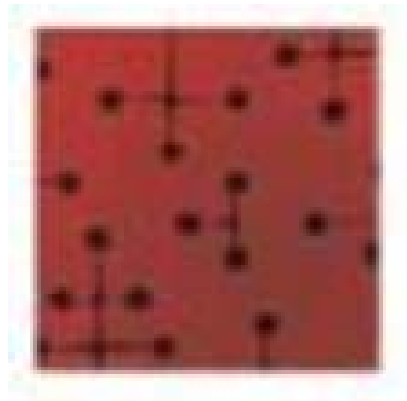


or **THINK *TRADE SECRET***
if it isn't apparent

- secret information
- with independent economic value
- derived from its secrecy



Elegant Fabric?





THINK *COPYRIGHT*

- original works of authorship
- Does not protect ideas
- Protects the tangible expression of ideas

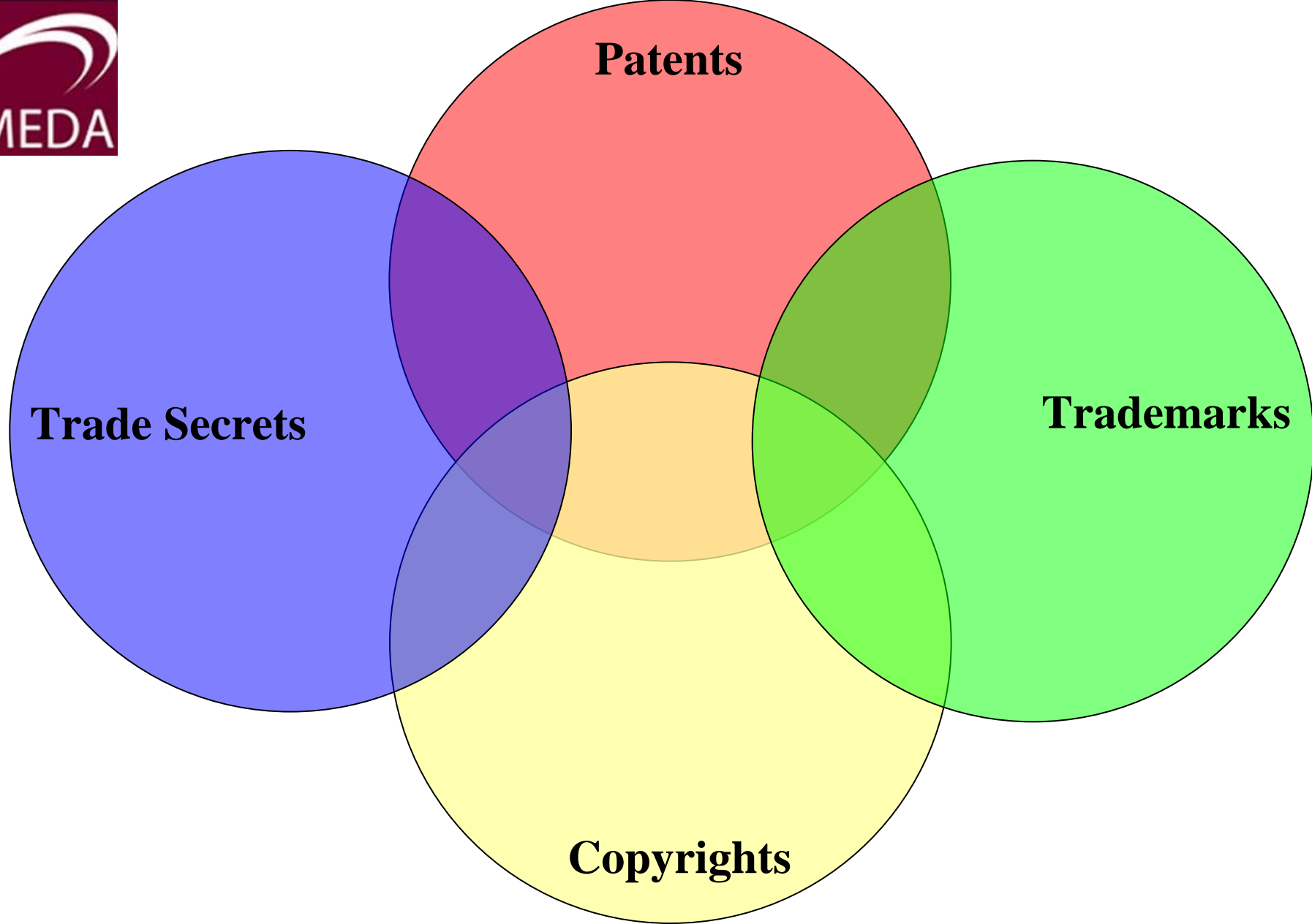


A Great Brand?



THINK *TRADEMARK*

- A unique symbol that distinguishes your product or services from those of competitors
- identifies source of products or services





What is a Trademark?

- Anything -- word, phrase, symbol, design, sound, smell, color, product configuration, group of letters or numbers, or combination of these
- Used by a company to identify products and
- Distinguish them from products of others

- Word marks:
 - KODAK[®] (registered)
 - SARAN WRAP[™] (unregistered)



The Key to Understanding Trademarks?

AVOID CONSUMER CONFUSION

- Trademark law looks through the eyes of the consumer and attempts to avoid confusion as to source of products
- Put yourself in shoes of consumer (or competitor) when selecting marks
- Choose distinctive marks to assist consumers in making choices between your products and products of others

Not All Marks Are Words



Not All Marks Are Words





Distinctiveness Spectrum

Non-Distinctive

"Bad"

Distinctive

"Good"

Generic

Descriptive

Suggestive

**Arbitrary,
Coined or
Fanciful**

Not protectable

Possibly protectable

Protectable immediately



Fanciful or Coined Marks

- Made-up words
 - only identify source of product
 - have no other meaning that conveys information about product itself
 - Examples:
 - KODAK[®] for cameras
 - EXXON[®] for petroleum products
- Most inherently distinctive and strongest marks
- Immediately protectable



Arbitrary Marks

- Actual, not made-up, words
 - Not related in any way to, or convey any information about, nature of product
 - Examples:
 - *APPLE*® for computers
 - *DELTA*® for airline services
- Inherently distinctive
- immediately protectable



Suggestive Marks

- Words that suggest attribute of or benefit derived from goods but do not describe goods themselves
 - Examples:
 - *COPPERTONE*[®] for suntan lotion
 - *APPLE-A-DAY*[®] for vitamins
- Inherently distinctive
- immediately protectable



Descriptive Marks

- Words that merely describe goods or characteristic, attribute or feature of goods
 - Example:
 - “delicious,” “red,” or “round” for apples
- Not immediately protectable
- May never be protectable
- unless they develop distinctiveness by acquiring “secondary meaning” through years of exclusive use
 - *BUFFERIN*® for buffered aspirin



Generic Words

- Describe type of product, such as “apple” for a red fruit that grows on trees
- Generic words only define product but not source
 - Examples:
 - aspirin brand aspirin?
 - apple brand apple?
- Generic words are NEVER protectable



Distinctiveness Spectrum

<i>Generic</i>	<i>Descriptive Geographic Surname</i>	<i>Suggestive</i>	<i>Arbitrary</i>	<i>Fanciful Coined</i>
Aspirin (aspirin)	BUFFERIN (buffered aspirin)	COPPERTONE (suntan lotion)	DELTA (airlines)	KODAK (film)
Apples (apples)	APPLEBAUM'S (restaurant)	APPLE-A-DAY (vitamins)	APPLE (computers)	SPAM (lunch meat)



How To Acquire Trademark Rights

- By use
 - Common law
 - Registration
- By license
- By transfer



Common Law Rights

- Rights arise *immediately* from use in commerce (whether registered or not)
- Some problem with unregistered rights:
 - Must prove rights in mark
 - Protection limited to geographic areas where mark used



U.S. Registration

- Although not required in U.S., owner may register trademark in USPTO and in all 50 states
- Can also register mark in most foreign countries



Advantages of Registration

- Constructive notice to public of ownership of mark
- Legal presumption of ownership of mark and exclusive right to use nationwide with goods/services listed in registration
- Right to bring lawsuit concerning mark in federal court
- Used as basis for registration in foreign countries
- Record with Customs Service to stop importation of infringing foreign goods
- Enhanced monetary relief, including treble damages and attorneys' fees



Two Issues in Selecting Trademarks

- Can you use your trademark?
 - Will use of trademark infringe someone else's superior trademark rights?
- Can you register your trademark rights?
 - Will USPTO find mark capable of functioning as trademark?
 - Will USPTO find mark confusingly similar to previously-filed trademark application or registration?
 - Will someone with superior rights oppose application to register mark?



Trademark Searching

- *ALWAYS DO A SEARCH*
- Determines whether likelihood of confusion exists
 - Identifies others who may have superior trademark rights and help avoid infringement
 - Identifies other applications and registrations that may block application
 - Assists in determining likelihood of overcoming descriptiveness refusal or other issues



File Application

- While rights begin to accrue the moment you begin using a trademark in geographic areas where you are using your mark,
- Filing application gives you presumptive nationwide rights as of the date of your application



Prosecuting Application

- Review by USPTO examiner within 3-4 months
 - Distinctive?
 - Confusingly similar to other marks for similar goods/services?
 - Other?
- Publication – others can “oppose” registration
- Proper commercial use required to obtain registration
- Total time to registration ~ 1 to 2 years



Post Registration

- Proper commercial use required to maintain registration
 - Renewal every 10 years
 - Affidavit of use at 5th-6th year gives full protection for 1st 10 years



How to Use a Trademark

- Trademarks should inform consumers of origin of products but not describe products themselves
- Use trademarks so that public recognizes them, not as identifiers of products alone, but as identifiers of your version of that product
- If use trademarks properly, rights in them will grow and last indefinitely



Improper Use = Lost Rights

- Becomes generic, descriptive term for product
- Could otherwise lose significance as trademark
- If you lose rights in trademark, anyone can use mark, consumers lose opportunity to identify



Rights Lost Because Registered Marks Became Generic Terms

ALLEN WRENCH

CELLULOID

DRY ICE

GRANOLA

LP

MIMEOGRAPH

POGO (stick)

TARMAC

ZEPPELIN

ASPIRIN

COLA

ESCALATOR

HEROIN

LINOLEUM

PHOTOSTAT

SHREDDED WHEAT

TOLLHOUSE COOKIE

ZIPPER

CELLOPHANE

COMPTOMETER

GRAMOPHONE

JUNGLE GYM

MERRY WIDOW

PIANOLA

SPANDEX

YO-YO



Rights Lost Because Registered Marks Became Generic Terms

ASPIRIN

HEROIN



BAYER

PHARMACEUTICAL PRODUCTS.

We are now sending to Physicians throughout the United States literature and samples of

ASPIRIN

The substitute for the Salicylates, agreeable of taste, free from unpleasant after-effects.

HEROIN

The Sedative for Coughs,

HEROIN HYDROCHLORIDE

Its water-soluble salt.

You will have call for them. Order a supply from your Jobber.

Write for literature to

FARBENFABRIKEN OF ELBERFELD CO.

40 Stone Street, New York,

SOLE U.S. AGENTS



Did You Know These Terms Are Registered Marks?

Aqua-Lung	Astroturf	Baggies	Bake-Off
Benadryl	Breathalyzer	Bubble Wrap	Chap Stick
Crock-Pot	Dictaphone	Dixie Cups	Drizabone
Dumpster	Elastoplast	Ethernet	Fiberglass
Frisbee	Formica	Glucometer	Gokart
Hula Hoop	Jaws of Life	Jet Ski	Jetway
Jumbotron	Kevlar	Laundromat	Magic Marker
Masonite	Pablum	PG	Phillips Screwdriver
Ping-Pong	Playbill	Plexiglas	Porta Potti
Popsicle	Quaalude	Quonset	Realtor
Rollerblade	Roquefort	Scotch Tape	Sharpie
SHEETROCK	Shop-Vac	Skivvies	Spackle
Stetson	Styrofoam	Superglue	Tabasco
Velcro	VHS	Windbreaker	Zamboni



Did You Know These Terms Are Registered Marks?

Formica



United States Patent Office 698,357
Registered May 31, 1960

PRINCIPAL REGISTER
Trademark

Ser. No. 78,278, filed July 23, 1959

FORMICA

Formica Corporation (Delaware corporation)
4614 Spring Grove Ave.
Cincinnati 32, Ohio

For: ADHESIVE FOR BONDING LAMINATED
PLASTICS TO OTHER SURFACES, SUCH AS WOOD,
in CLASS 5.

First use Feb. 26, 1953; in commerce Feb. 26, 1953.
Owner of Reg. Nos. 155,689 and 421,496.

Int. Cl.: 2

Prior U.S. Cls.: 6, 11, and 16

United States Patent and Trademark Office

Reg. No. 3,541,693

Registered Dec. 2, 2008

TRADEMARK
PRINCIPAL REGISTER



XIM PRODUCTS, INC. (OHIO CORPORATION)
1169 BASSETT ROAD
WESTLAKE, OH 44145

AND PROTECTIVE COATING SOLUTIONS FOR
USE ON METAL SURFACES, IN CLASS 2 (U.S.
CLS. 6, 11 AND 16).

FOR: COATINGS IN THE NATURE OF LIQUID
BONDING AND PROTECTIVE COATINGS FOR
USE ON SURFACES OF ALL KINDS, NAMELY,
PAINT PRIMERS, RUST INHIBITORS, STAIN INHI-
BITORS, PAINT SEALERS, HIGH BUILD PAINT
PRIMER AND PAINT SEALER; COATINGS IN THE
NATURE OF PROTECTIVE SURFACE COATING
PREPARATIONS FOR USE ON PORCELAIN, CER-
MIC TILE, GLAZED BLOCK, FORMICA, FIBER
GLASS, CEMENT, GROUT AND THE LIKE;
COATINGS IN THE NATURE OF RESTORATIVE

FIRST USE 9-1-2007; IN COMMERCE 9-1-2007.

THE MARK CONSISTS OF THE WORDS "THE
SECRET AGENT FOR PRIMING PERFECTION"
AND A CIRCLE WITH A THICK OUTLINE AND
THE SILHOUETTE OF A MAN HOLDING A PAINT
ROLLER WEARING A TUXEDO AND A HAT.

SN 77-976,119, FILED 6-28-2007.

NICHOLAS ALTREE, EXAMINING ATTORNEY

OF ALL KINDS, NAMELY,
ST INHIBITORS, STAIN INHI-
LERS, HIGH BUILD PAINT
SEALER; COATINGS IN THE
CTIVE SURFACE COATING
USE ON PORCELAIN, CER-
BLOCK, FORMICA, FIBER
GROUT AND THE LIKE
NATURE OF RESTORATIVE



Dos and Don'ts of Trademark Use

Do:

- *Do* use a trademark in distinct type.
MIDAS[®] not Midas
- *Do* use a mark as a proper adjective.
MEDTRONIC[®] pacemakers
- *Do* use a mark with notice of its status.



TM (trademark)

SM (service mark)

Don't

- *Don't* use a mark as a noun.
WRONG: LR[®] keeps costs under control.
- *Don't* use a mark as a verb.
- *Don't* change a mark's form.
WRONG: Buffalo-Wild-Wings[®] (no hyphens)
- *Don't* use a mark in a possessive form.
WRONG: Fizzies' qualities are outstanding.
- *Don't* use a mark to modify or describe any words other than the appropriate generic or descriptive name.
- *Don't* abbreviate a mark.
- *Don't* wrongly identify a mark as registered.



Trademark Infringement

Trademark owner must prove:

- priority of rights in
- a confusingly similar mark
 - similarity of marks
 - similarity of goods/services
 - similarity of consumers
 - similarity of channels of trade



CARIBBEAN KREME

AVAILABLE APRIL 8 - JUNE 2

CARIBBEAN KREME DOUGHNUT

Filled with a blend of exotic mango, pineapple and passion fruit, and topped with delicious white icing and shortcake crunch.

CARIBBEAN KREME CHILLER

Tasty blend of pineapple, mango and orange flavors. Can be ordered in a creamy blend or frozen fruity version.

Trademark Topics SM

Brand Battles: Say This Fast Five Times: Caribbean Crème Sues Krispy Kreme Over “Caribbean Kreme”
(http://www.fredlaw.com/areas/trademark/trade_0805_drk2.html)



Copyright Law: What Is Protected?

- Protects “original works of authorship fixed in any **tangible medium** of expression”
- Copyright law protects works of authorship:
 - Literary
 - dramatic works
 - audio/visual works
 - architectural plans and structures
 - computer programs



Copyright Law: Rights Protected

- Gives owner of a copyright the exclusive right to do and to authorize others to:
 - reproduce the works
 - prepare derivative works based on the work
 - distribute copies of the work
 - perform or display the work



When Copyright is Created

- When a work is fixed in a tangible medium
- Registration not needed for the author to have rights, but it affords “extra protection”



Who Owns the Copyright?

- the 'Author'
 - Work For Hire
 1. Work prepared by employee within the scope of employment; or
 2. A work commissioned for:
 - Collective work, audiovisual work, translation, supplementary work, compilation, instructional text, test, test answers or atlas
- Both require express written agreement



Copyright Registration

- Discretionary
- Why Register?
 - Must register to file law suit
 - Prima facie evidence of ownership
(if within 5 years of publication)
 - Statutory damages / legal fees
(If within 3 months after publication or before infringement)
 - Establish a public record



Copyright Registration

- Different forms for different types of works
- Copyright Office Website - valuable resource
 - www.copyright.gov
- Complete the form, submit a deposit copy, and pay the registration fee (\$35-45)
- Expedited Process
 - Litigation purpose
 - 3-4 weeks instead of 6-8 months
 - Around \$800



Copyright Notice

- Discretionary
- Should Include:
 - “Copyright”, “Copr.” or ©
 - Year Of First Distribution
 - Name Of Owner
- Previous notice requirements greatly effect pre-1989 works



Copyright Notice Example

- © [year of publication] name of copyright owner
- © 2004 Fredrikson & Byron, P.A.
- (P) 1993 A&M Records



Copyright Duration

- Life of the Author plus 70 years
- Anonymous works or works made for hire
 - 95 years from the date of publication OR
 - 120 years from creation



Copyright Infringement

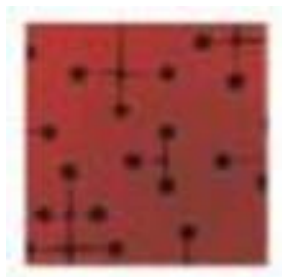
Copyright owner must prove:

- Ownership of protected work
- Unauthorized and unfair use of a work
- Infringement
 1. Direct evidence of copying
 2. Indirect evidence of copying
 1. Access
 2. Similarity



Protecting Yourself and Your Works

- Third Parties
 - Contractual warranties and indemnity provisions
 - Be careful disclosing work
 - Trade secret issues
 - Obtain a confidentiality agreement *before* disclosing work
- Employees
 - Confidentiality Agreement
 - Control access to work
 - Educate employees on issues
- Register before you publish



Trademark TopicsSM
Brand Battles: Pod's Use Of Dots
Puts It On The Spot In Spat

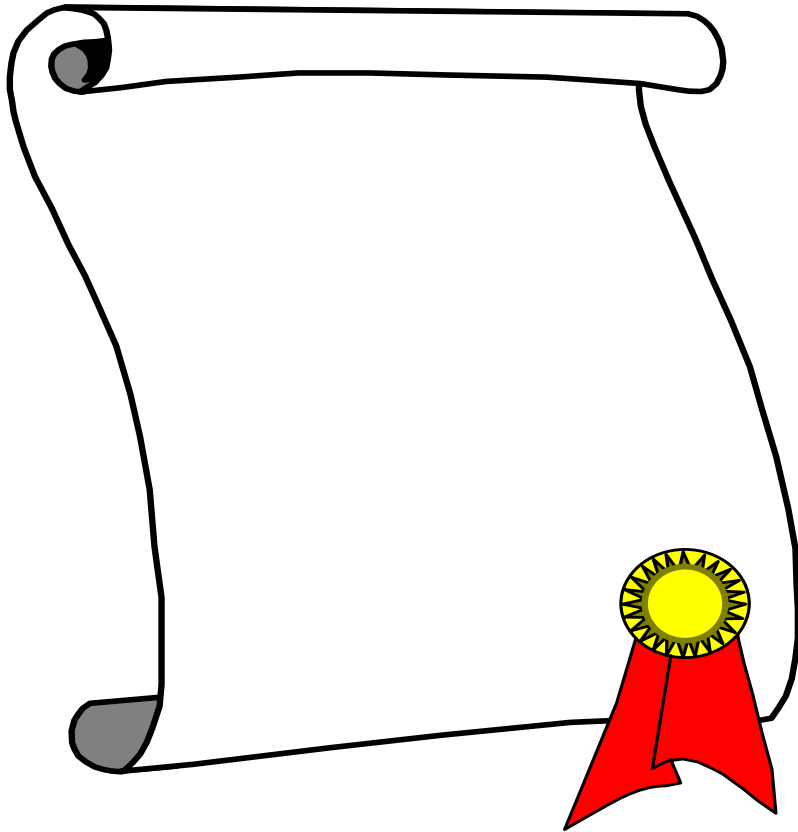
(http://www.fredlaw.com/areas/trademark/trade_0802_drk3.html)

Dean R. Karau
Carrie L. Rosenberry

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Fredrikson
& BYRON, P.A.

What is a Patent?



- A government granted right for new, nonobvious, and useful invention.
- Inventor gets a monopoly for placing the invention in the public domain.



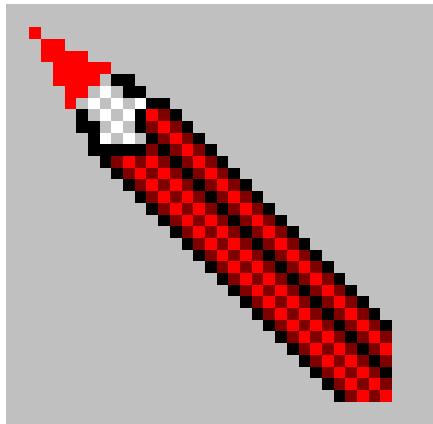
A Patent Confers the Right to:

- The right to exclude others from:
 - Making
 - Using
 - Selling
 - Importing into the United States

A Patent Does Not Give the Owner the Right to Make, Use, or Sell the Patented Invention

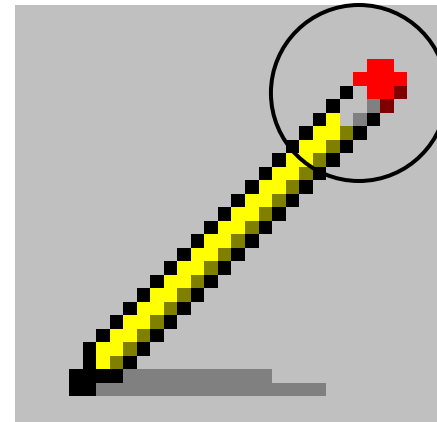
- You may have a patent and still be prevented from making, using, or selling the invention!

Competitor A



Patent: pencil

Competitor B



Patent: pencil with eraser

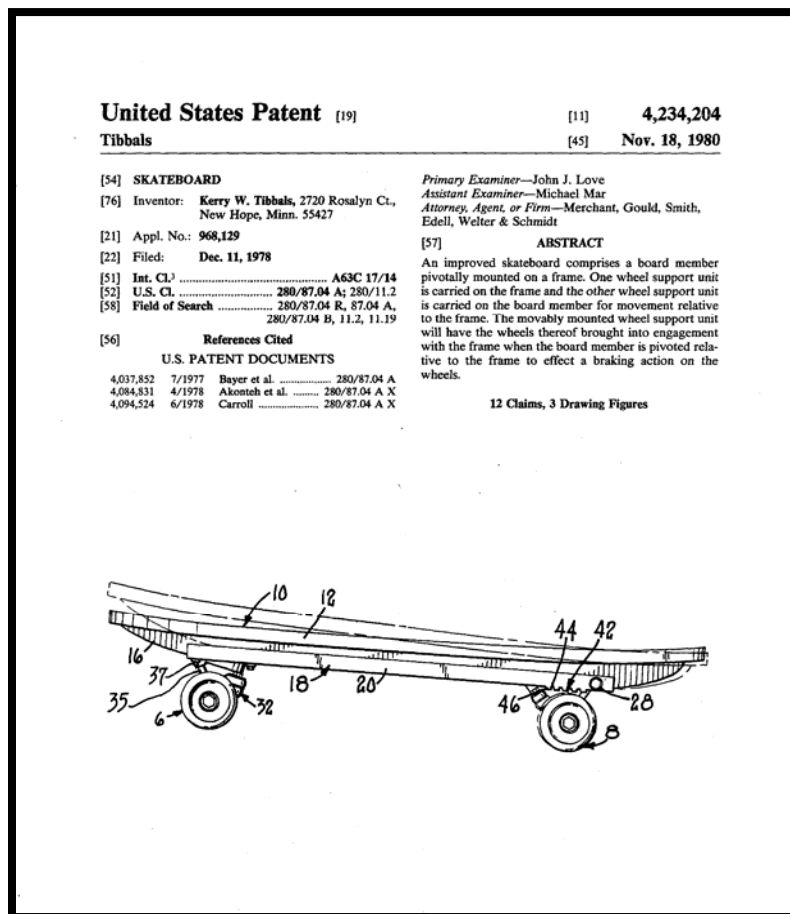


Types of Patents

A Utility Patent protects the functional or working aspects of a:

- Process
 - Machine
 - Composition of matter
 - Item of manufacture
- Term: 20 Years from date of filing

Utility Patent Example






Less Common Types of Patents

- A Design Patent protects the ornamental, aesthetic, or non-functional appearance of an article
 - Term: 14 years from date of Issue
- A Plant Patent is used to protect asexually reproduced plants
 - Term: 17 years from date of Issue

Design Patent Example



US000486639S

(12) **United States Design Patent** (10) Patent No.: **US D486,639 S**
Kranz (45) Date of Patent: **Feb. 17, 2004**

(54) **MONKEY SHAPED CAMERA BAG** D437,367 S * 2/2001 Wang D21,596
 D455,256 S * 4/2002 Tyler D3,219
 (75) Inventor: **Michelle R. Kranz, Boulder, CO (US)** D457,723 S * 5/2002 Tyler D3,267
 D472,387 S * 4/2003 Hassett D3,301

(73) Assignee: **Case Logic, Inc., Longmont, CO (US)** * cited by examiner

(**) Term: **14 Years** *Primary Examiner—Celia Murphy*
 (74) *Attorney, Agent, or Firm—Sheridan Ross P.C.*


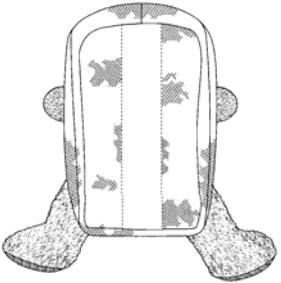
(21) Appl. No.: **29/170,158** (57) **CLAIM**
 (22) Filed: **Nov. 1, 2002**
 (51) **LOC (7) Cl.** **03-01**
 (52) **U.S. Cl.** **D3/267, D3/263, D3/270**
 (58) **Field of Search** D3/208, 215, 219,
 D3/225, 226, 243, 263, 267, 268, 270,
 273, 276, 283, 285, 287, 289, 290, 301;
 D6/632; D21/618, 654; 206/316.1, 316.2;
 224/583, 612, 908

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 D288,585 S * 3/1987 Shaffer et al. D21/618
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 D407,940 S * 4/1999 Bear D6/968
 D422,404 S * 4/2000 Hassas D3/216
 D436,443 S * 1/2001 Hillman D3/283

DESCRIPTION

FIG. 1 is a front perspective view of a monkey shaped camera bag, showing my new design;
 FIG. 2 is a front elevation view of the invention illustrated in FIG. 1;
 FIG. 3 is a rear elevation view of the invention illustrated in FIG. 1, the broken lines representing cavities and forming no part of the claimed design;
 FIG. 4 is a top plan view of the invention illustrated in FIG. 1;
 FIG. 5 is a bottom plan view of the invention illustrated in FIG. 1;
 FIG. 6 is a left elevation view of the invention illustrated in FIG. 1, and,
 FIG. 7 is a right elevation view of the invention illustrated in FIG. 1.

1 Claim, 7 Drawing Sheets



What Can Be Patented?

- “Anything under the sun that is made by man.” - U.S Supreme Court
- Requirements:
 - New (“novel”)
 - Useful
 - Nonobvious



Patentable Categories

- A process or method
 - Business method
 - Includes software
 - New use of a known item
- A machine
- An item of manufacture (including organisms)
- A composition of matter



What is not Patentable?

- Mathematical Formulas or Algorithms
- Laws of Nature ($e = mc^2$)
- Naturally Occurring Substances

Software computer instructions can be patented if associated with a useful result.



How Do I Get a Patent?

- File an application that discloses and describes a new, useful, and nonobvious invention
 - Provide a disclosure that **teaches** how to make or use the invention without “undue experimentation”
 - Disclose the best mode of using or making the invention
 - Claim each element of your invention
- It is not necessary to produce even a prototype before filing an application
- Unlike trademark and copyright, patent rights do not arise automatically



Patent Law Encourages Prompt Filing

- Absolute Time Bar to Patent Rights:
 - An application must be filed within one year of any public use, publication, or offer for sale
- Limited exception for public use of inventions if experimental
 - but always better to file early
- Limiting disclosure of your invention and filing early are important



In the U.S., You Must Be First to Invent

- Invention must not have been
 - known or used in this country or
 - patented or published by others anywhere
 - before patent applicant's invention date.
- In most other countries, priority is established by filing date.
- U.S. law may be moving toward “first to file.”



Initial Ownership is Determined by Inventorship

- All persons that contributed to the conception of the invention should be listed as inventors on the application
 - Failure to list all inventors may make patent invalid or cloud ownership rights
- Others should not be listed
 - People who merely apply their ordinary skill to assist the inventor(s) after conception considered inventors
- Invention is defined by law



Ownership of Patents

- Ensure that people doing work for you are obligated to assign inventions
- Determine ownership of inventions up front when establishing joint ventures, independent contractors (e.g., vendors)
 - Have other party sign proprietary information exchange agreement, joint research agreement, or other appropriate arrangement up front.



Patent Prosecution Timeline

- Patent Office examines application
- Respond with arguments supporting patentability and possibly amend claims
- Publication
- Prosecution averages 34 months (depends strongly on technology area)
- Appeals are available if normal prosecution is unsuccessful
- An Issue Fee and Maintenance Fees are required to receive and maintain patent right



How to Enforce Those Rights?

- Bring a patent infringement lawsuit in federal court
 - Obtain Money Damages
 - Enjoin (stop) Infringing Activity
 - Special Damages and Attorney Fees if “Willful”
- Patent rights are not self-enforcing



Proving Patent Infringement

- Elements of a patent infringement claim
 - Ownership of a valid patent
 - Proof that each element of the patented invention is found in the “infringing” product



Why Pursue Patents?

- Offensive Weapon
 - Protects valuable design improvements and innovations.
 - A patent gives you the right to exclude others from making, using, selling, or importing the invention into the U.S.
 - Licensing creates revenue streams.



Why Pursue Patents?

- Defensive Shield
 - Creates apprehension in other patent owners who avoid alleging infringement for fear of repercussions.
 - Provides valuable trade bait for use in defending or settling infringement disputes (Cross licensing).
 - However, not a defense to infringement.

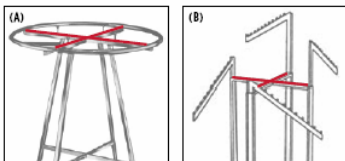


Why Pursue Patents?

- Fosters internal innovation
- Enhances credibility in the marketplace
- Discourages competition
- Exclusivity is valued by investors and customers in supply chain

NO TOOL ASSEMBLY INSTRUCTIONS
Farm Boy® & Farm Girl™ Brand Fixture Towers

The Farm Boy® & Farm Girl™ Brand Fixture Towers are designed to work with a standard Round Rack with center cross bars (A) and a standard 4-Way Rack with center cross bars (B). Either may be used depending on quantity of merchandise to be displayed. *LOOKS GREAT IN A CORNER OF INTERSECTING AISLES!*



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2. Place square top into each tower, so that it rests on inside foam squares.

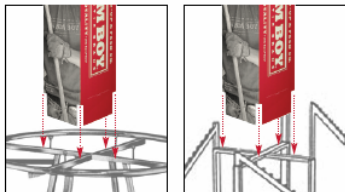


Farm Boy® Fixture Tower



Farm Girl™ Fixture Tower

3. Pick up Fixture Tower and place on your selected standard Round Rack or 4-Way Rack with center cross bars as shown. Making sure the cross bars are placed and resting into bottom of towers corner slots.



(A) Rounder Rack

(B) 4-Way Rack

- If our client had filed an application and obtained a patent, it could have prevented its supplier (and its competitors) from making, using, or selling similar brand towers



What is a Trade Secret

- Unlike a patent, trade secret protection depends on secrecy



Elements of a Trade Secret

- Any information
 - with independent economic value
 - not known to others
 - not readily ascertainable by proper means
 - maintained with reasonable efforts of secrecy



Trade Secrets

- No novelty requirement
- Relative, not absolute, secrecy
- Technical and business information covered
- Patentable or unpatentable information
- Unlimited life - as long as kept secret
- Can arise under tort law or contract law

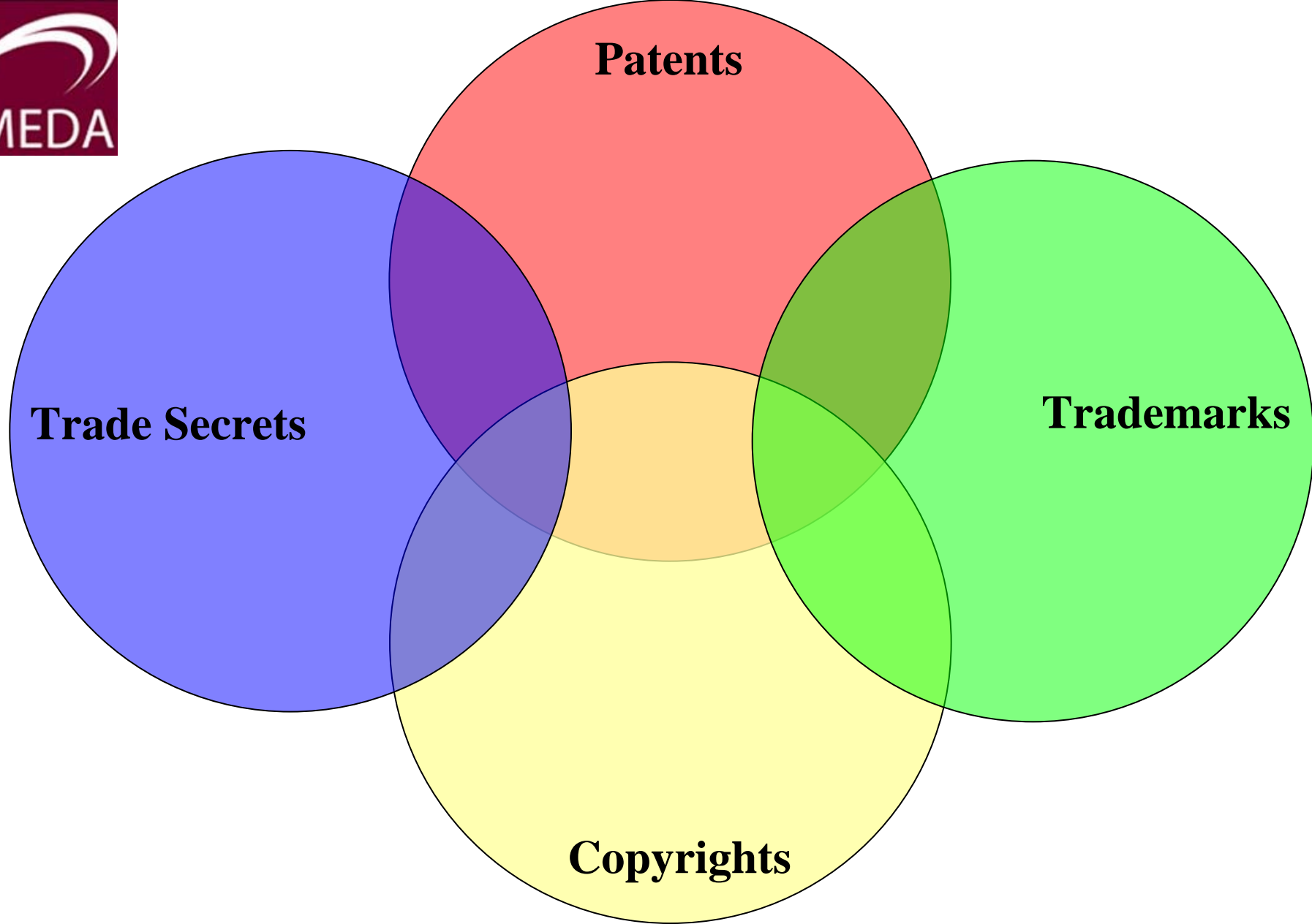


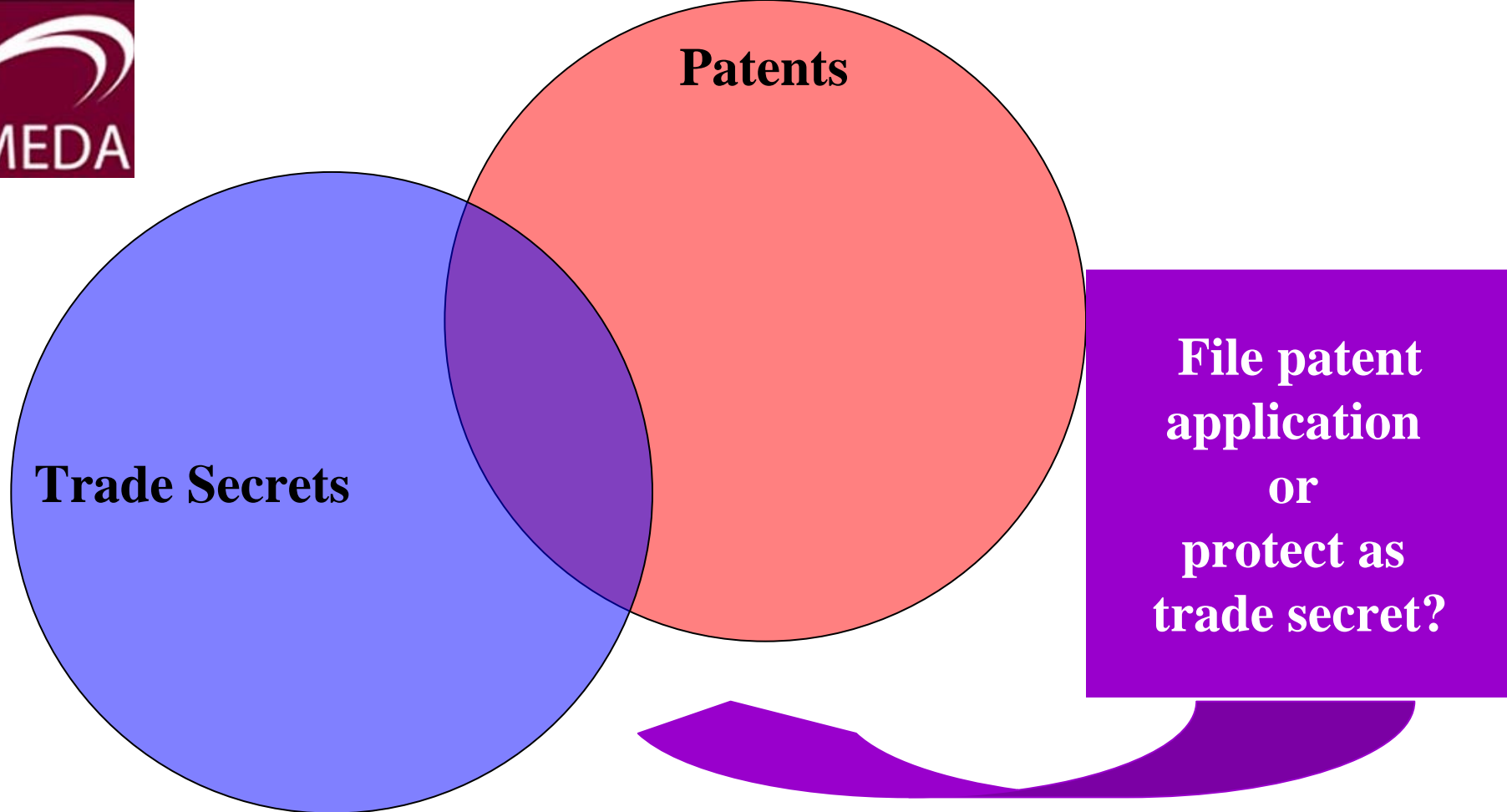
Enforcing Trade Secret Rights

- Owner of trade secret must prove:
 - has independent economic value
 - not known to others
 - not readily ascertainable by proper means
 - used reasonable efforts for secrecy
 - Trade secret obtained through improper means
 - Tort
 - Breach of contract



- former Coca-Cola secretary took confidential documents and samples of products that hadn't been launched with the aim of selling them to rival Pepsi
- Faced up to 10 years in prison if convicted of conspiracy





Patents

Trade Secrets

**File patent
application
or
protect as
trade secret?**



To Patent or Protect as Trade Secret

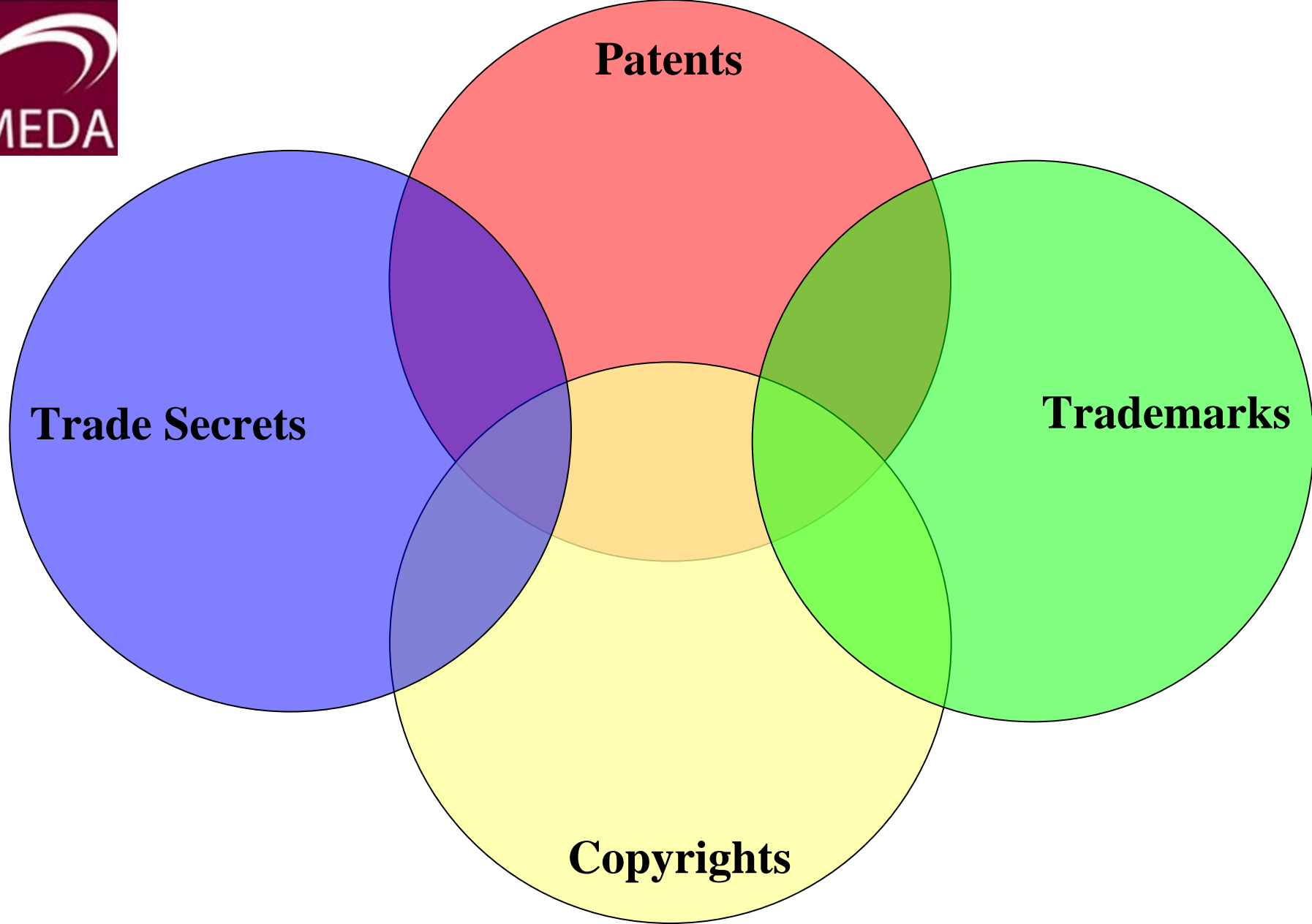
Factors to Consider

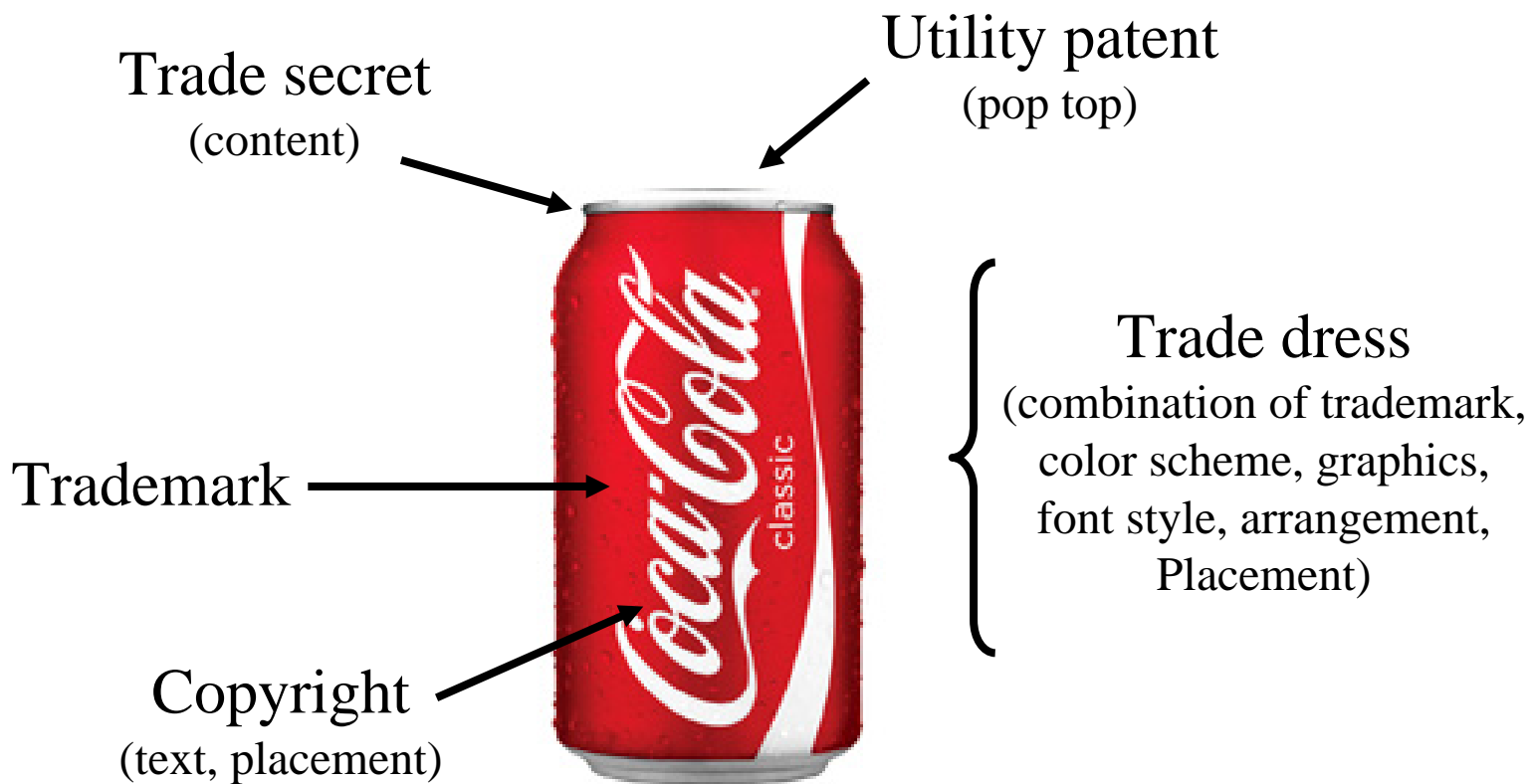
- Legal Issues:
 - Is it new and unobvious
- Number of similar patents
- Is there a dominating patent
- Consequences of public disclosure if patented
- Consequences if not patented and later reverse-engineered
- Cost



If You Decide To Keep Discoveries Secret

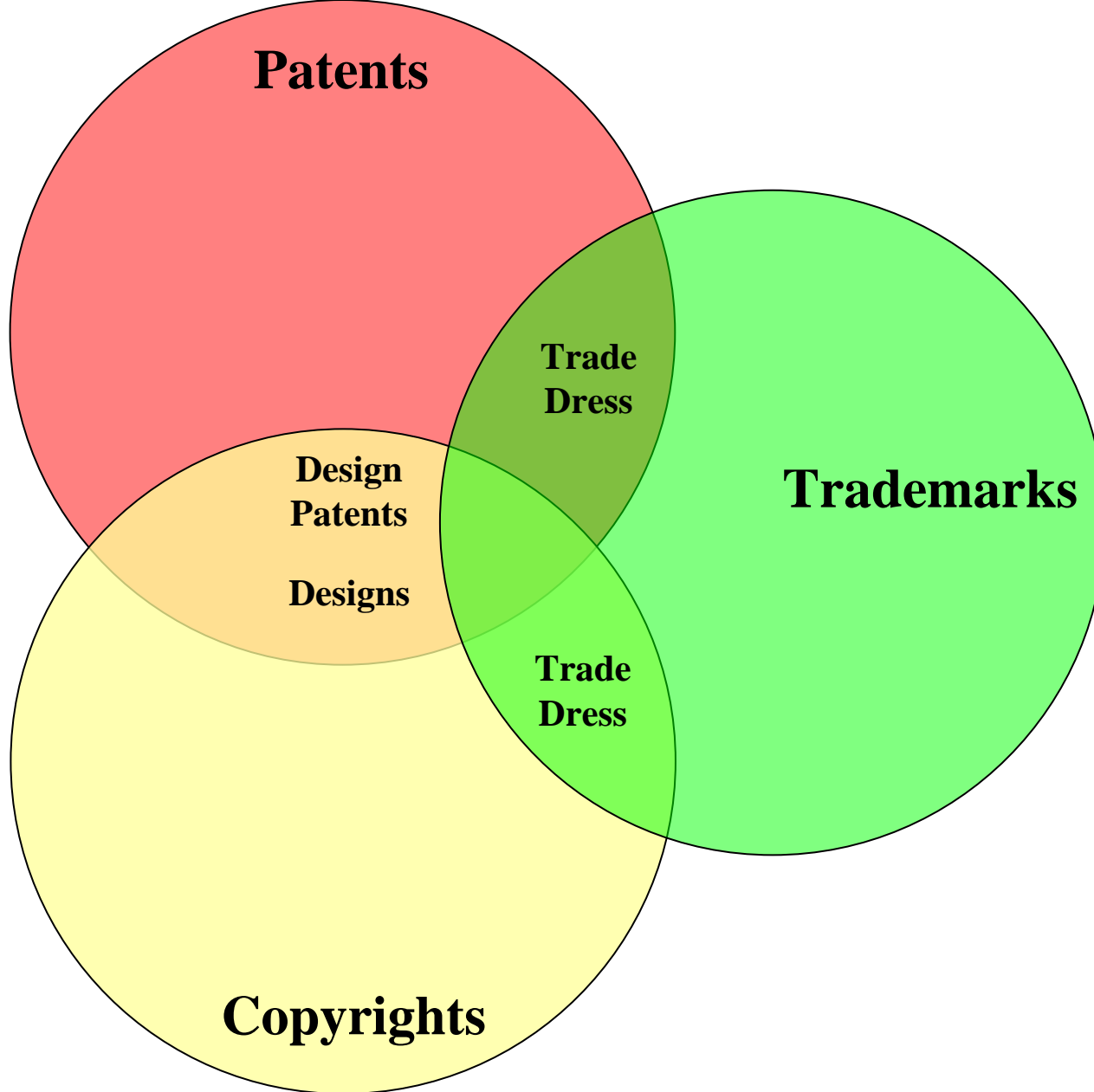
- Employee Nondisclosure Agreements
- Nondisclosure Agreements – third parties (subcontractors, suppliers and customers)
 - Definition of confidential info
 - Obligations
 - time period to keep secret
- Company Form Agreements







What About Designs?





Do Features of Design Make it Superior to Those of Your Competitors?

- You may have valuable intellectual property if the display's unique features are:
 - Source-Identifying, non-functional features
 - New ornamental features



If It Makes Customers Think of You, Protect It with Trade Dress

- Unique form of a trademark
- Trademarks can be design features—and anything else (*e.g.*, logos, colors, smells, sounds)—that help a consumer connect a product to its source
 - Remember the Coke bottle?





If It's New and Ornamental, Protect It with a Design Patent

- If your design includes *ornamental* features that look new and different compared with any known display, you may be able to protect these features with a design patent.
- Like trade dress, design patents cannot protect functional features.
- But unlike trade dress, design patent law has nothing to do with preventing consumer confusion.



If It is a Creative Design, Protect It Through Copyright Law

- “original works of authorship fixed in any tangible medium of expression”



Design Strategies

- Obtain a design patent to protect your display immediately upon launch
- Obtain a copyright registration at the same time
- Obtain a trade dress registration once consumers begin associating a display with your product
- The trade dress will continue to protect your design after the design patent and copyright protection expires



Conclusion

- Determine Type of Intellectual Property
- Determine Ownership
- Decide Best Way to Protect Your intellectual property



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