Intellectual Property Protection in a nutshell

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What is in the headline?

• Apple v. Samsung
  – a total of 12 patents, 6 patents infringed,
  – Jury verdict: $1 billion damage

• Nortel Patent portfolio auction
  – Liquidation during bankruptcy,
  – 6000 patents sold for $4.5 billion

• iPad trademark dispute in China
  iPad2 sales disrupted because of the TM dispute.
What is intellectual property (IP)?

Work resulted from ideas, creative endeavors, and innovative thinking.

– Books, films, videos, songs, articles, poems, choreography, photographs, paintings.
– Product designs, trademarks, trade dresses
– New machines, new manufacturing processes, new material.
– Isolated genes? Business methods?
Types of IP protected under US law

• Trade secret
• Copyright
• Patent
• Trademark/Trade dress
Trade Secret

- Definition:
  - Valuable & secret information: not in public domain, not readily accessible
  - Reasonable precautions
- Protection lasts as long as it remains secret.
Trade Secret

- Remedy: available
  - only if improper means or in breach of confidential relationship;
  - Not if reverse engineering or independent discovery
• Definition

“original work” fixed in a “tangible medium of expression”
Copyright

• Threshold of protection

A piece of original work must exhibit a modicum of originality and be fixed in a “tangible medium of expression.”

Donald Trump’s “You’re fired” Copyrightable? (CM #1)
Copyright

• Rights of:
  – performance,
  – display,
  – reproduction of the copyrighted work, and
  – making derivative works from the copyrighted work.
Copyright

- Duration
  - the life of the author plus 70 years,
  - if entity author,
    - 95 years from first publication, or
    - 120 years from the year of creation, whichever occurs first.
Copyright

• Formalities
  – No required formalities (notice & publication) but registration of a copyright is required if US authors before instituting a lawsuit.
  – Registration with USPTO and deposition of copies of the work.
Patent

• Definition
  – A grant of certain rights to the patentee who owns the patent.
  – Rights to exclude or authorize others to make, use, offer to sell, sell, and import into the US the patented invention “negative rights” (CM #2)
Types of patents
- Utility patents
- Design patents

Duration
- 20 years from filing for utility patents.
- Extension up to 5 years for drugs, medical devices and additives.
- 14 years for design patents.
- Plus Patent Term Adjustment.
Patent

• Requirements
  – statutory subject matter,
  – novelty,
  – non-obviousness,
  – utility

• Loss of right if disclosed publically

  Grace period
Patent

• How to get a patent
  • Drafting
  • Filing
  • Prosecuting in front of the USPTO
    No right to exclude before issuance
    (CM #3)
• How to write a patent application
  – Parts of a patent application
  – Requirements of written descriptions
  – Claims (CM#4)
Patent

• Costs
  – Fees paid to the USPTO
  – Attorney fees
  – Maintenance fees after the patent has been issued.
Trademark/dress

• Trademark and trade dress
  – Definition
  – Registration with the USPTO
    • Not necessary but many benefits
  – Likelihood of confusion
  – Duration: until it is abandoned
IP is important!

• Revenue generating assets licensing fees, royalty, selling
• Important tools in a competitive marketplace: sword and shields
• Leverage for a start-up company attract VC investments prevent copycats