

# **Intellectual Property Basics: Trademark, Patent and Copyright**

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**What's the difference and  
why should I care?**



# Presenters -

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### **Education**

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- JD San Joaquin College of Law, Clovis, CA 2005

### **Fields of Practice**

- Patent Law
- Trademark Law
- Copyright Law
- Trade Secret Law
- IP Litigation
- Contract Law
- Construction Defect Litigation



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**Education**

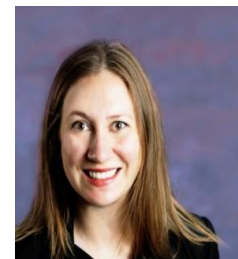
- University of Oklahoma College of Law, J.D., with honors, 1997
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**Fields of Practice**

- All areas of Intellectual Property
- Practice emphasis on managing IP portfolios; negotiating complex intellectual property transactions and agreements; drafting and prosecuting patent applications

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**Fields of Practice**

- All areas of Intellectual Property
- Practice emphasis on drafting and prosecuting patent applications, trademark applications, and copyright applications;



# Intellectual Property Rights



- ❑ Creations of the mind
- ❑ Both artistic and commercial



# Intellectual Property Rights, cont.

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- ❑ Exclusive rights
- ❑ Intangible assets
  - musical, literary, and artistic works,
  - ideas, discoveries, and inventions, and
  - words, phrases, symbols, and designs.



# Intellectual Property Rights, cont.

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- ❑ industrial design rights,
- ❑ **patent,**
- ❑ **trademark,**
- ❑ **copyright,**
- ❑ trade dress, and
- ❑ trade secret.



# Intellectual Property Rights, cont.

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## □ Constitutional right in the USA (Art. 1, Sec. 8)

*“The Congress shall have 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...”*



# Patent Law

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Patents protect inventions that are useful AND novel AND non-obvious

Three types of patents:

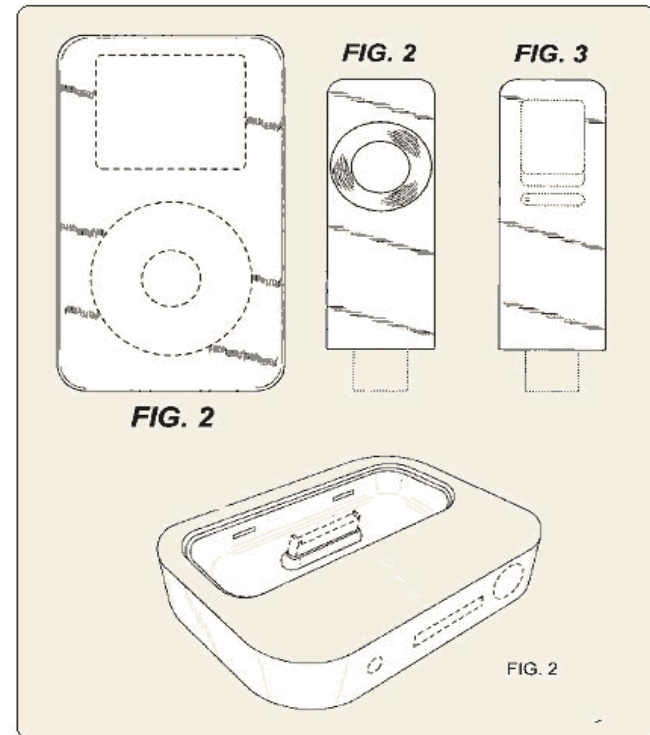
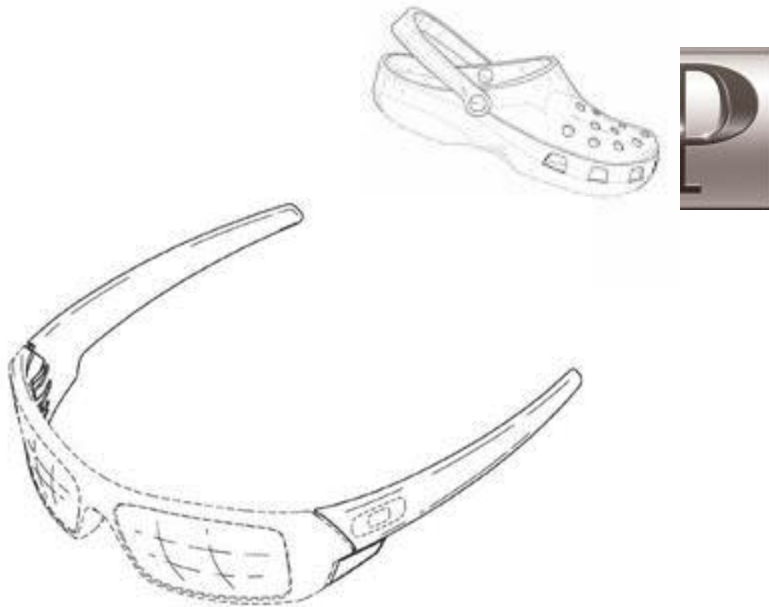
1. design patents
2. plant patents
3. utility patents





# Design Patent (35 U.S.C. § 171)

- ❑ visual design of objects
- ❑ not purely utilitarian.
- ❑ new, original, and ornamental design



# Design Patent: International View

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In many jurisdictions (e.g. Europe) industrial designs are not protected as patents, but are separate rights:

- ❑ Registered Design Rights (e.g. Community Registered Designs, National Registered Designs)
  - design of a product
  - novelty
  - individual character
  - not solely dictated by a product's technical functions
- ❑ Unregistered designs
  - Community Unregistered Design Right (UDR): 1-year grace period between publication of the design and application for a registered design
  - British Unregistered Design Right: No subsequent DR needed
  - Copyright



# Plant Patent (35 U.S.C. § 161)

- ❑ invent or discover
- ❑ asexually reproduce
- ❑ distinct and new



**Fig. 1**



# *Diamond v. Chakrabarty*, US Sup. Ct. (1980)

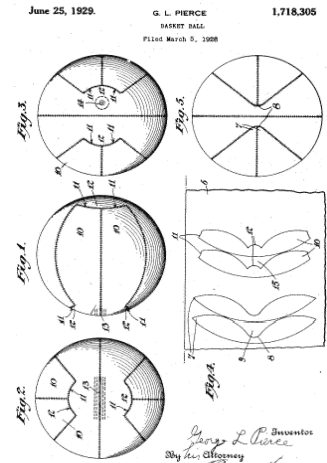
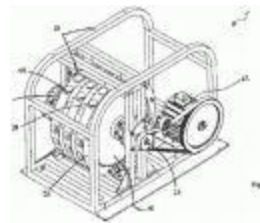
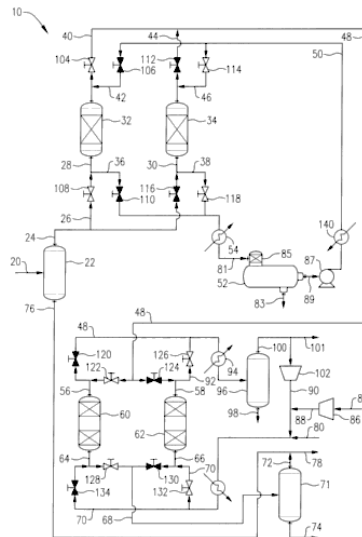
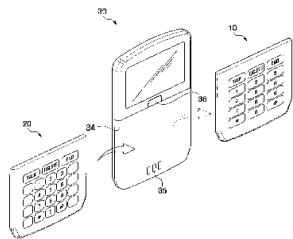


“...anything under the sun that is made by man”



# Utility Patent (35 U.S.C. § 101)

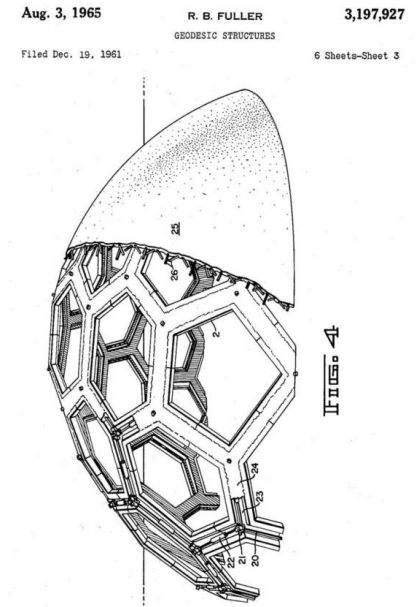
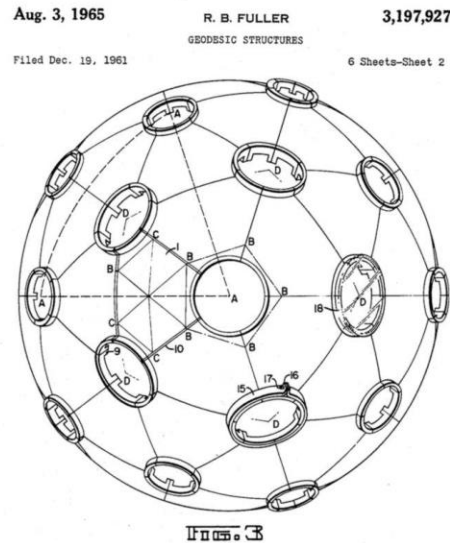
- ❑ process
- ❑ machine
- ❑ article of manufacture
- ❑ composition of matter



# Utility Patents

To obtain a patent, the invention must be:

- useful,
- novel, and
- non-obvious



# Utility Patents

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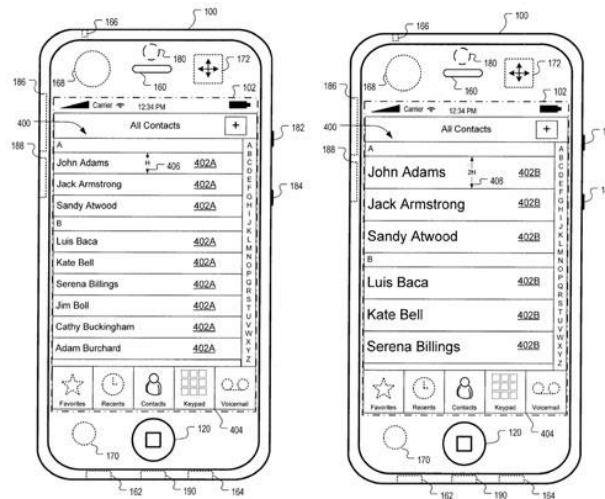
- ❑ Prior to March 16, 2013, the U.S. was a “first-to-invent” system
- ❑ With passage of the America Invents Act, the US joined all other countries in adopting a “first-to-file” system



# Utility Patents

In general, a patent cannot be obtained if the invention was previously:

- ❑ described in a printed publication anywhere in the world, or
- ❑ known or used by others





# Utility Patents

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- ❑ Patentee has the right to exclude others from making, using, offering for sale, or selling the invention
- ❑ These are “negative” rights, that is, the right to prevent others from acting
- ❑ Patentee must enforce these rights or lose them



# Patents – International

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Two groups of international treaties relating to patents:

- ❑ Treaties containing regulations regarding the obtainment of patents
  - Patent Cooperation Treaty (PCT):
    - ❑ Makes it possible to seek patent protection for an invention simultaneously in each of a large number of countries (148) by filing an "international" patent application.
    - ❑ The PCT system examines PCT applications, but does not provide a “worldwide” patent
    - ❑ The PCT system is a gateway to filing in the member countries.
    - ❑ Provides a 30 or 31 month delay to determine in which countries to file
  - Regional Patent Conventions
    - ❑ Regularly provide a legal framework for the granting of regional patents, via a single procedure
    - ❑ Do mostly not result in a unitary right, but a group of essentially independent nationally-enforceable, nationally-revocable patents



# Patents – International, cont.

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- Examples:

- European Patent Convention (EPC)
- Eurasian Patent Convention (EAPO)
- African Intellectual Property Organization (OAPI)
- African Regional Intellectual Property Organization (ARIPO)

- Treaties containing material regulations regarding patent protection

- Paris Treaty:

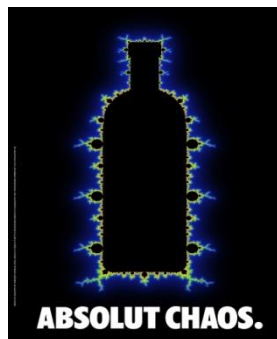
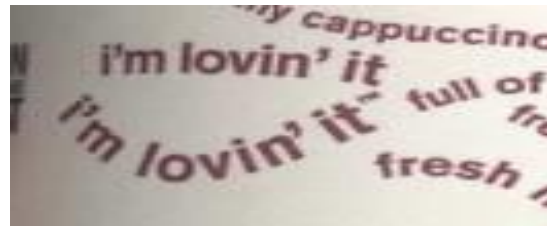
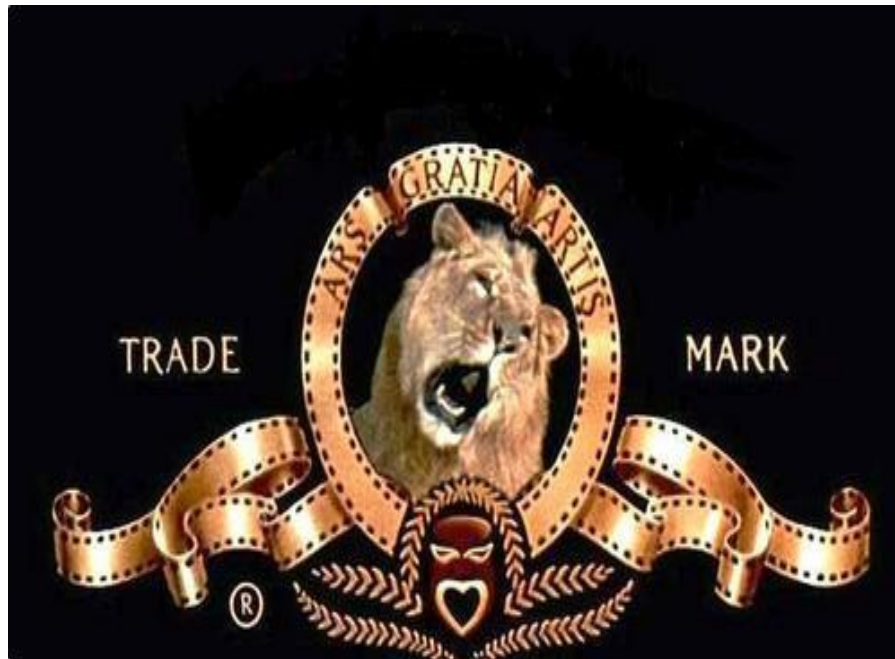
- Third country patent applications can claim benefit to the filing date of first application if filed within one year

- TRIPS (Agreement of Trade Related Aspects of IPR)

- Sets down minimum standards for many forms of IP regulation and applies to nationals of other WTO Members



# Trademarks



# Trademark Notice and Attribution

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# What is a Trademark?

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- ❑ Any word, image, smell, logo, shape, color, or sound that serves to identify the source of a product
- ❑ A service mark identifies the source of a service





# Trademark Law

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- ❑ Designed to prevent consumer confusion



- ❑ Protects business and symbolizes goodwill
- ❑ Advertising investment
- ❑ Inferior product could damage reputation
- ❑ Protection available at federal and state level



# Trademark Term

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- ❑ The term of a registered trademark can be indefinite
  - ❑ As long as the mark continues to be used properly; and
  - ❑ The registration is renewed (after the first 5 years and between every 9<sup>th</sup> and 10<sup>th</sup> years)



*first used as a mark in the 1600's*





# Classification of Trademarks

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- ❑ Not everything can be trademarked
- ❑ “Generic” words can never be registered (e.g. shoes, car)
- ❑ “Descriptive” words can be in specific circumstances

- “Soaker” for a water gun



- “Break and Bake” for scored cookie dough



- “Georgia” for peaches



# Secondary Meaning

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- ❑ Acquired distinctiveness for a mark - consumers recognize that a product comes from a single source
- ❑ While “Mrs. Fields’ Cookies” is descriptive, it has acquired secondary meaning.



# Classification of Trademarks, cont.

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- ❑ Suggestive Words are acceptable for registration



- “Nutrasweet” for artificial sweetener



- “Gung-Ho” for Marine Action Figure Toy



- “Surf-vivor” for beach related goods



# Classification of Trademarks, cont.

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## ❑ Arbitrary and Fanciful words are best

- arbitrary
  - known words are used as a trademark
  - words are unrelated to the goods or services
- fanciful
  - made up words
- typically easy to register
- strong marks



# Examples of Arbitrary Marks

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☐ “Blue Diamond” for nuts



☐ “Amazon” for online book sales



☐ “Apple” for computers



# Examples of Fanciful Marks

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The word "Kodak" is written in a bold, red, sans-serif font. The letters are slightly irregular and have a hand-drawn feel, with the 'K' and 'O' being particularly prominent.

☐ “Kodak” for film

The word "EXXON" is written in a bold, red, sans-serif font. The 'X' is stylized with a diagonal slash through it. Below the text is a solid blue rectangular bar.

☐ “Exxon” for fuel



☐ “Clorox” for bleach



# To maintain & keep a trademark registration

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- ❑ The owner must take affirmative steps to protect the mark from:
  - unauthorized use, and/or
  - infringement, among other things
  
- ❑ To avoid dilution and possible loss of the mark, the owner must:
  - Challenge trademark applications for similar marks
  - Police publications, etc. ... to discover and stop unauthorized uses of the mark or use of confusingly similar marks



# Enforcing Trademark Rights

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- ❑ 1. Control ALL uses of the mark (internal and external)
  - use form of mark registered
  - control use by 3rd parties - notify of infringement
  - third party trademark licensing agreement
  - infringement action





# Enforcing Trademark Rights, cont.

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## 2. Provide proper notice and attribution (i.e., ® or ™)

- ❑ Owner of trademark must provide proper notice and attribution



- ❑ International: Outside the US, most trademark systems do not require notice and/or attribution



# How Do You Obtain a U.S. Trademark?

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- ❑ Use in interstate commerce
- ❑ U.S. application
  - ❑ 45 international classes
- ❑ Intent to use application
  - ❑ statement of use
  - ❑ extensions available (up to 3 years)
- ❑ First-to-use vs. first-to-file



# US Trademark Application Timeline

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- ❑ In the US 4-6 months before Trademark Office responds
- ❑ Generally 1+ year(s) before registration is granted
- ❑ Critical dates are date of filing and date of first use





# How Do You Obtain a Foreign Trademark?

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## ❑ Direct file

- ❑ In a foreign country
- ❑ for a regional TM which grants protection for various countries (e.g. CTM)

## ❑ Madrid system

- Makes it possible to seek protection for a TM simultaneously in each of a large number of countries by filing an "international" application.
- System is a gateway to filing in the member countries. TM protection is on a national level.
- Requires a “home” application in a country which has joined the Madrid protocol (6 month priority)
- “Central attack” of home application for 5 years



# Copyright

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- ❑ “original works of authorship”
- ❑ literary, dramatic, musical, artistic, and certain other intellectual works



# What is Copyright?

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It is the right:

1. to reproduce the work;
2. to prepare derivative works;
3. to distribute copies (sale, rental, lease, transfer ownership);
4. to perform the work publicly; and
5. to display the work publicly.



# Obtaining Copyright

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- ❑ Work must be an original work; and,
- ❑ Work must be in a tangible form.



# How is a Copyright Established?

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- ❑ No publication or registration is required in the US
- ❑ Copyright laws provide several inducements to encourage registration, registration is required to litigate copyright





# Copyright Registration

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- ❑ Register within three months, or before infringement
- ❑ Statutory damages
- ❑ Attorney's fees
- ❑ Otherwise, actual damages



# Copyright Registration, cont.

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- ❑ Register within 5 years of publication
- ❑ *Prima facie* evidence of validity



# Copyright Ownership

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- ❑ Property of author who created the work
- ❑ The author may have entered into a “work made for hire” contract and/or have an employment relationship that effectively assigns the ownership to the employer



# How long is a copyright effective?

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- ❑ For works created after 01/01/1978 the term is either:
  - (1) for the author's life plus an additional 70 years after the author's death, or
  - (2) for an anonymous work, a pseudonymous work, or a work made for hire, the copyright endures for a term of 95 years from the year of its first publication or a term of 120 years from the year of its creation, whichever expires first
- ❑ For works created before 01/01/1978 the term will vary depending on several factors



# International Copyright

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- ❑ Depends on the national laws of each country
- ❑ Various international treaties in order to harmonize the differences between national laws:
  - TRIPS
  - Berne Convention
  - WIPO Copyright Treaty / WIPO Performance and Phonograms Treaty
  - Universal Copyright Convention (UCC)

# International Copyright

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- ❑ No registered right

- In most countries, copyrights need no registrations and may not be registered

- European approach:

- ❑ Protection of personal and economic interests of the author. The creator of a work is thus the owner of the respective copyrights.
- ❑ Moral rights of the author to protect its personality expressed through the work: Paternity and Integrity. Moral rights may not be transferred. Economic rights may be transferred.
- ❑ Distinction between author rights and neighboring rights, i.e. rights for activities related to works (e.g. sound recordings, broadcasts, performances, etc.)
- ❑ No attribution required, may however be useful
- ❑ Collecting Societies

# Thank you!

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