

Protecting Intellectual Property

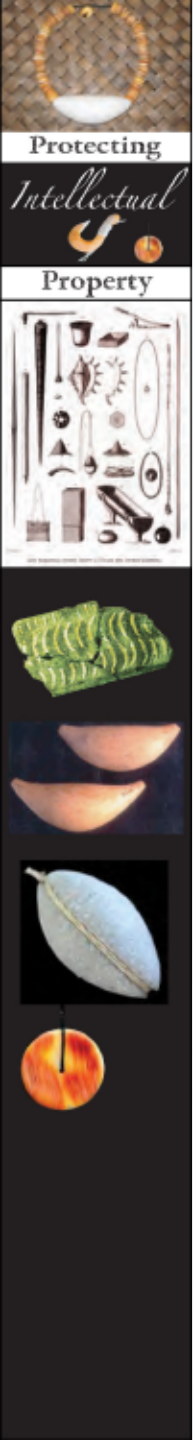
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Terlaje Professional Building, Hagåtña

Protecting Intellectual Property

A presentation by

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PROTECTING INTELLECTUAL PROPERTY

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WHAT IS INTELLECTUAL PROPERTY "IP"?

- IP is generally characterized as non-physical property that is the product of original thought - in other words **"ideas."**
- IP rights surround the **"control"** of physical manifestations or expressions of **"ideas"**.
- IP protects right to **ideas** by protecting the right to **produce and control** physical instantiations of those ideas.

TYPES OF IP

- Copyright ©
- Patent
- Trade Secret
- Trademark / Service mark TM ® **SM**

COPYRIGHTS (17 U.S.C. § 106)

- Form of protection provided to the authors of "**original works of authorship**" including literary, dramatic, musical, and certain other intellectual works.
- Protection is available for both published and unpublished works.
- Registered with the U.S. Copyright Office

COPYRIGHT PROTECTS

- Literary works
- Musical works, including accompanying words
- Dramatic works, including any accompanying words
- Pantomimes and choreographic works
- Pictorial, graphic, and sculptural work
- Motion pictures and other audiovisual works
- Sound recordings
- Architectural works

COPYRIGHTS

- Copyright Act gives the owner of copyright the "**exclusive**" right to do and to authorize others to do the following:
 - reproduce the work in copies or phonorecords
 - prepare derivative works based upon the work
 - distribute copies or phonorecords of the work to the public by sale or other transfer of ownership, or by rental, lease, or lending
 - perform the work publicly, in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audio visual works
 - display the work publicly, in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work
 - perform the work publicly (sound recordings) by means of digital audio transmission

COPYRIGHT **DOES NOT** PROTECT

- Works that have not been fixed in a tangible form
- Titles, names, short phrases, and slogans
- Familiar symbols or designs
- Variations of typographical ornamentation, lettering, or coloring
- Listing of ingredients

LIMITATIONS ON COPYRIGHT PROTECTION

- Fair Use **17 U.S.C. § 107**
- Reproduction by Libraries and Archives **17 U.S.C. § 108**
- Effect of Transfer of particular copy or phonorecord **17 U.S.C. § 109**
- Certain Performances & Displays **17 U.S.C. § 110**
- Secondary transmissions of broadcast programming by cable **17 U.S.C. § 111**
- Ephemeral recordings **17 U.S.C. § 112**

COPYRIGHT REGISTRATION

- Is a legal formality intended to make a public record of the basic facts of a particular copyright.
- NOT Required but advantages include:
 - Public Record of the Copyright
 - Before infringement suit may be filed in court, registration is necessary for works of U.S. origin
 - If made before or within 5 years of publication, prima facie evidence of the validity of the copyright
 - If made within 3 months after publication of the work or prior to infringement statutory damages and attorney's fees available
 - Allows the owner to record the registration with U.S. Customs for protection against importation of infringing copies.
- Copyrights may be registered at any time within the life of the copyright.

PATENT

- Provides protection of inventions and discovery of new and useful processes, machines, articles of manufacture, or compositions of matter.
- Strongest form of IP protection – 20 year exclusive monopoly is granted to the owner over any expression or implementation of the protected work. **35 U.S.C. §§ 101 & 154(a)(2)**
- Types of Patents
 - **Utility** – protects any new, useful, and nonobvious process, machine, article of manufacture, or composition of matter as well as any new and useful improvement thereof.
 - **Design** – protects any new, original, and ornamental design for an article of manufacture.
 - **Plant** – a new variety of plant.
- Registered with the U.S. Patent and Trademark Office

PATENT

- Patents require usefulness, novelty, and non-obviousness of the subject matter.
 - **Useful** requirement is met if the invention can accomplish at least one of its intended purposes.
 - Invention must be **new or novel**; this may be invalidated if the invention was publicly known before the patent applicant invented the subject matter.
 - Invention must be **non-obvious** to one ordinarily skilled in the relevant art at the time the invention was made.

PATENT

- Patent holder is granted the right to make, use, sell, and authorize others to sell the patented item.
- Precludes others from making, using, or selling the invention regardless of independent creation.
- Utility and Design patents lapse after 20 years
- Plant patents lapse after 14 years

COPYRIGHT VS. PATENT

Copyright

- Given for work of a creative or artistic nature which has been fixed in a medium.
- Extends well beyond the life of the creator so it can be bequeathed to someone else after the creator's death.
- Automatic protection (limitations exist).
- Doctrine of Fair Use
- Moves to public domain after expiration.
- Precludes others from making, using, or selling the invention regardless of independent creation.
- Utility and Design patents lapse after 20 years
- Plant patents lapse after 14 years

Patent

- Granted to inventions or discoveries which were not known before.
- Must be applied for and awarded before the inventor gains exclusive rights, and those rights exist only for a limited time. (May be willed if patent is in effect.)
- No protection until given.
- More time consuming and expensive.
- Invention cannot be used without permission from the holder without infringement.
- Moves to public domain after expiration.

TRADE SECRETS

- A trade secret is any information that can be used in the operation of a business or other enterprise and that is **sufficiently valuable** and **secret** to afford the actual or potential economic advantage over others.
- Must involve secrecy and competitive advantage.
- Owner of trade secrets have exclusive rights to make use of the secret only as long as the secret is maintained.
- Protection lapses when the secret becomes public.

TRADEMARKS/SERVICE MARKS

- A trademark is any word, name, symbol, or device, or any combination thereof, adopted by a manufacturer or merchant to identify her goods and distinguish them from goods produced by others. **15 U.S.C. § 1127**
- A service mark identifies and distinguishes the source of a service rather than goods.
- Protection is limited and may be waived in cases where the mark or symbol ceases to represent a company or interest or becomes entrenched as part of the common language or culture.
- Registered with the U.S. Patent and Trademark Office.

TRADEMARKS

- Selecting a mark must be done with great thought and care:
 - Not every mark is registrable
 - Not every mark is protectable (some marks are not capable of serving as the basis for a legal claim by the owner seeking to stop others from using a similar mark on related goods or services.

HIERARCHY OF MARKS

- Fanciful or arbitrary marks are registrable and more likely to get registered than descriptive marks.
- Suggestive marks “suggest” but do not describe qualities or a connection to the goods or services.
- Descriptive marks are words or designs that describe the goods and/or services.
- Generic are never registrable or enforceable against third parties.

Strongest
Protectable

Weak
May Not Be
Protectable

Weakest
Not
Protectable

TRADEMARK REGISTRATION

- Not Required
- Advantages to Registration
 - Legal presumption of ownership and exclusive right to use mark in the U.S. (Guam has its own registration statute – Chapter 20, Article 4 of 5 G.C.A.)
 - Public notice of claim to ownership
 - Listing on the USPTO online databases
 - Ability to record U.S. Registration with the U.S. Customs and Border Protection Service to prevent importation of infringing foreign goods
 - The right to use the ® symbol
 - Ability to bring action concerning the mark in federal court
 - Use of the U.S. Registration as a basis to obtain registration in foreign countries.

PROTECTING INTELLECTUAL PROPERTY

Questions

Thank You !!



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