

**INTELLECTUAL
PROPERTY
FOR ENTREPRENEURS**

**CRASH
COURSE**

April 14, 2015

Jason Haislmaier

jason.haislmaier@bryancave.com



This presentation is intended for general informational purposes only and should not be construed as legal advice or legal opinion on any specific facts or circumstances, nor is it intended to address specific legal compliance issues that may arise in particular circumstances. Please consult counsel concerning your own situation and any specific legal questions you may have.

The thoughts and opinions expressed in this presentation are those of the individual presenters and do not necessarily reflect the official or unofficial thoughts or opinions of their employers.

For further information regarding this presentation, please contact the presenter(s) listed in the presentation.

Unless otherwise noted, all original content in this presentation is licensed under the Creative Commons Attribution-Share Alike 3.0 United States License available at: <http://creativecommons.org/licenses/by-sa/3.0/us>.



Intellectual Property
Not “everything”
Just some important things

Intellectual Property
It's everywhere

Intellectual Property

What is it?

Patents

Trade Secrets

Copyrights

Trademarks

© Randy Glasbergen
glasbergen.com



“I invented fire, but now everyone is using it for free. In hindsight, maybe my first invention should have been intellectual property law.”

Intellectual Property

What does it mean to you?

to customers?

to competitors?

to investors?

to acquirers?

Intellectual Property

Ownership

Protection

Value

Sharing

Opportunity

Intellectual Property
The problem?



Intellectual Property
What can I do about it?

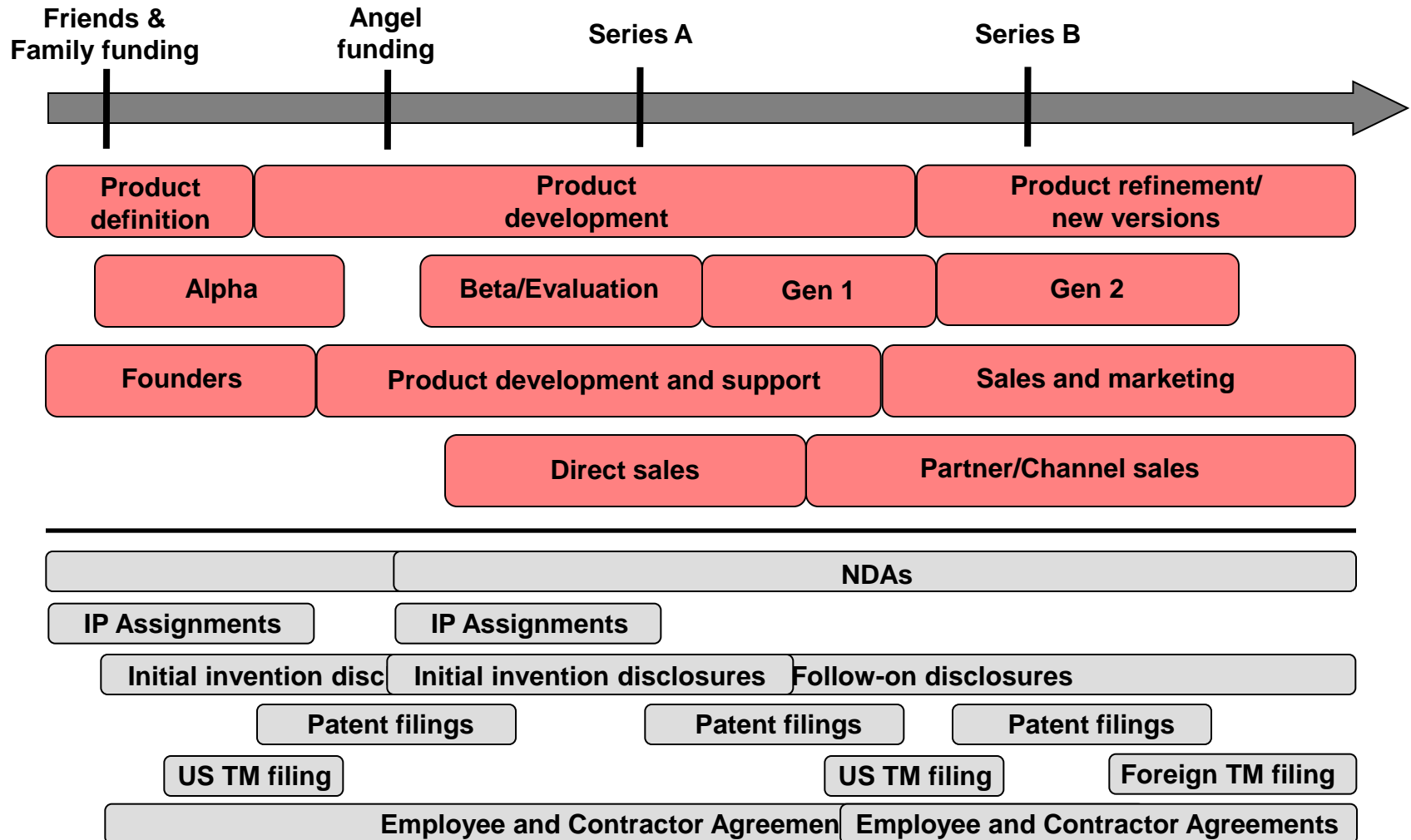
Develop an **IP strategy**
Make **conscious choices about IP**
In support your **business objectives**

IP Strategy

What is an IP Strategy?

***A roadmap for how IP will support
your business objectives***

IP Strategy



IP Strategy

Business objectives
Existing IP
Future goals
Risks of not protecting
Available budget
Simplicity
Continuous process
Conscious choices

IP Strategy

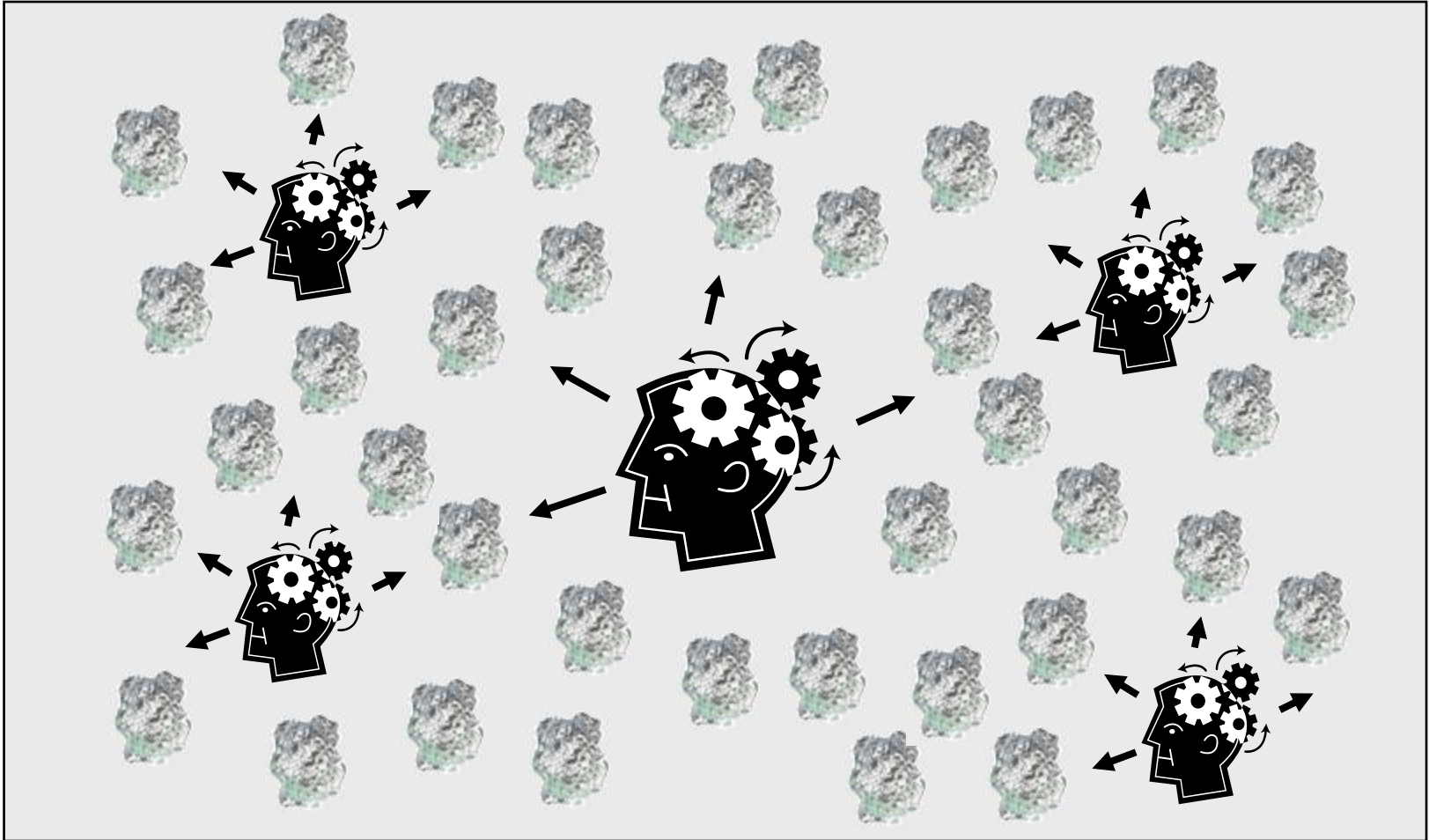
***Don't let the passage of time
make your IP choices for you.***

Ownership
Ownership is important
Centralize ownership
Capture value

Ownership



Ownership



Ownership



Not Always Easy!

Ownership

**If I pay for it,
do I own it?**

Not Necessarily!

Ownership

**If they don't pay for it,
do I own it?**

Not Necessarily!

Ownership

Ownership?
Contracts
IP Assignments
Contractor Agreements
Employee IP Agreements

No Substitute
Know the tools
Know how to use them



Patents

Ideas and
Inventions

Trademarks

Brand
Identity

Copyrights

Creative
Expressions

Trade Secrets

“Know-How”

Trade Secrets

“Know-How”

Trade Secrets

General Information

- Attributes
 - Not generally known or readily available
 - Independent economic value
 - Reasonable efforts to maintain secrecy
- Virtually any type of data or information
- Type or form of information is irrelevant
- Not registered, but still a form of property (like any other form of IP)
 - Licensable
 - Assignable
 - Able to be abandoned
- Created and enforced largely through contracts
 - Nondisclosure agreements (NDAs)
 - Employee and contractor agreements

Trade Secrets

Easily obtained

Easily lost

Trade Secrets

*Once the **secrecy** is gone
The **trade secret** is gone*

Trade Secrets

NDA's

Quite *common*

Often *overlooked*

Not all *equal*

Do not take them for granted

Trade Secrets



Trade Secrets

NDA's

Do you **need one?**

What if the other side **won't sign one?**

Trade Secrets

Trade Secret Misappropriation

- Acquisition, disclosure, or use in breach of a duty to maintain secrecy
 - Improper means to acquire
 - Knew or had reason to know acquired
 - Through improper means
 - Under duty to maintain secrecy or limit use
 - From someone else who had a duty to maintain secrecy
- Knew or had reason to know acquired through accident or mistake
- Independent development and reverse engineering

Patents

Ideas and
Inventions

Patents

Legal “monopoly”
Exclude from *making, using & selling*
In exchange for *full disclosure*

Patents

Novel
Useful
Non-Obvious

Patents

Are **patents** evil?
No, but **patent holders** can be

Patents



Patents

Patent Applications

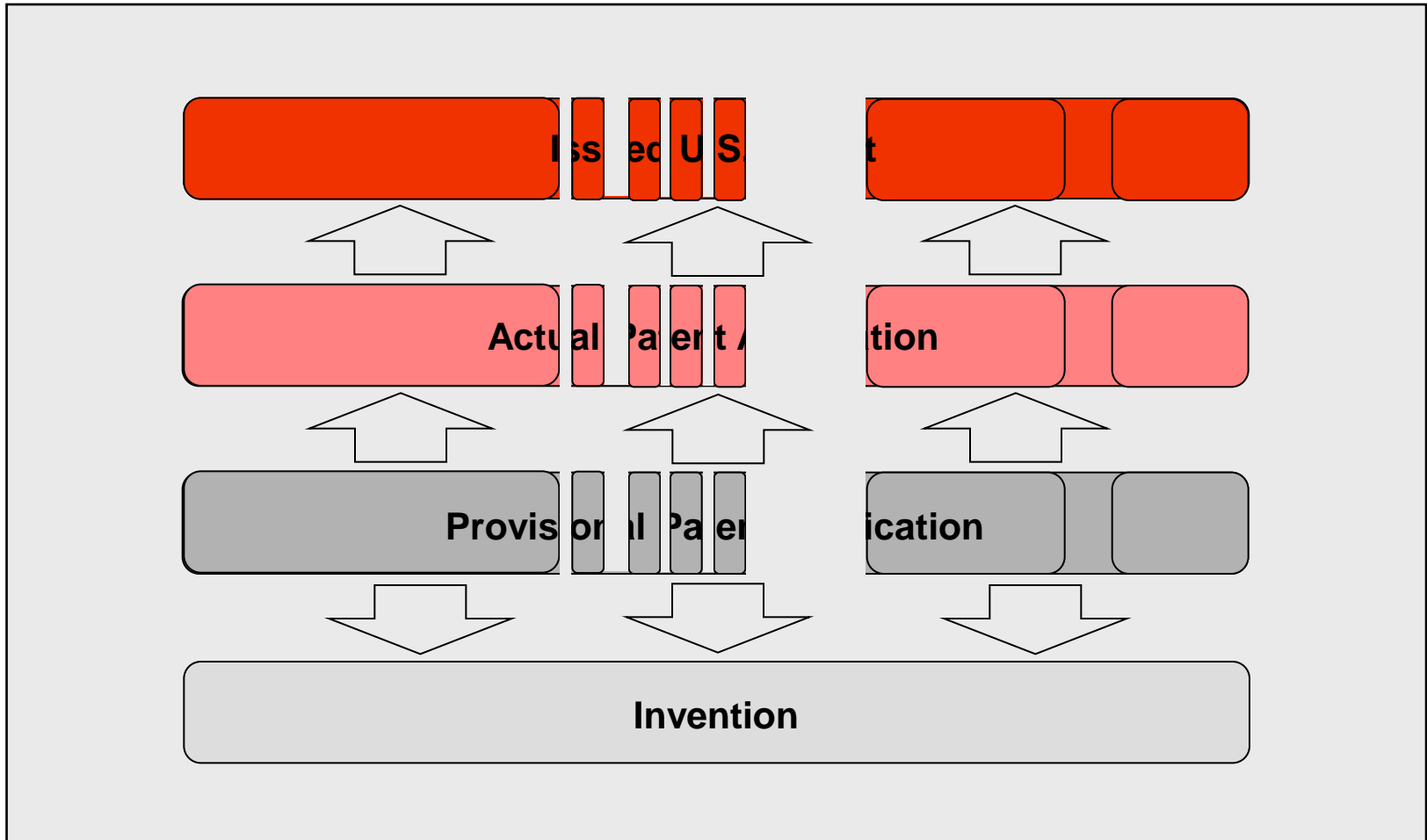
- Patents exist only in registered form
- Must file a patent application with the USPTO
 - Provisional Patent Application
 - Utility Patent Application
- Patent applications are *not enforceable* until the patent issues
- Once issued, provides 20 years of protection from the date of filing of the initial application

Patents

Provisional Patent Applications

- Many early stage companies rely on “provisional” applications
 - One-year grace period before filing regular application
 - Quicker?
 - Less expensive?
- Risks exist
 - Regular application limited to what is captured in the provisional
 - Limitations in the provisional
 - The “Power Point” provisional
 - New matter developed after the provisional is filed
 - Must file the regular application within the year
 - A good patent attorney can only help so much. . .

Patents



Patents

America Invents Act (AIA)

Patents

America Invents Act

- Signed into law September 16, 2011
- Fully effective March, 2013
- Called the most sweeping change to US patent law since the adoption of the U.S. Patent Act of 1952
- Goals:
 - Harmonization
 - Simplification
- Phased implementation (now fully implemented)
- Still plenty of uncertainty

Patents

America Invents Act

- Filing reforms
 - First to file
 - Dilution of “best mode” requirement
- Examination reforms
 - Definition of prior art (“ . . . or otherwise available to the public”)
 - Inventor grace period
- Third party reforms
 - Expanded prior user rights
 - Expanded inter partes review
 - New post grant opposition system and third party submissions policy
- Additional reforms
 - Fee reductions (“microentity fees”)
 - Priority examination

Patents

First to File

U.S. patent system was “first-to-invent”

U.S. patent system is now “first-to-file”

Patents

U.S. Patent Filing “Bar date”

One-year grace period

Following first publication by the inventor

Patents

Non-U.S. Patent Filing “Bar date”
No grace period
***Following first publication or
commercialization***

Patents

Prior art

***On sale, used in public, published,
or patented***

Also “or otherwise available to the public”

Patents

Why Patent?

Defensive

Offensive

Licensing

Resale

Optics

Ego

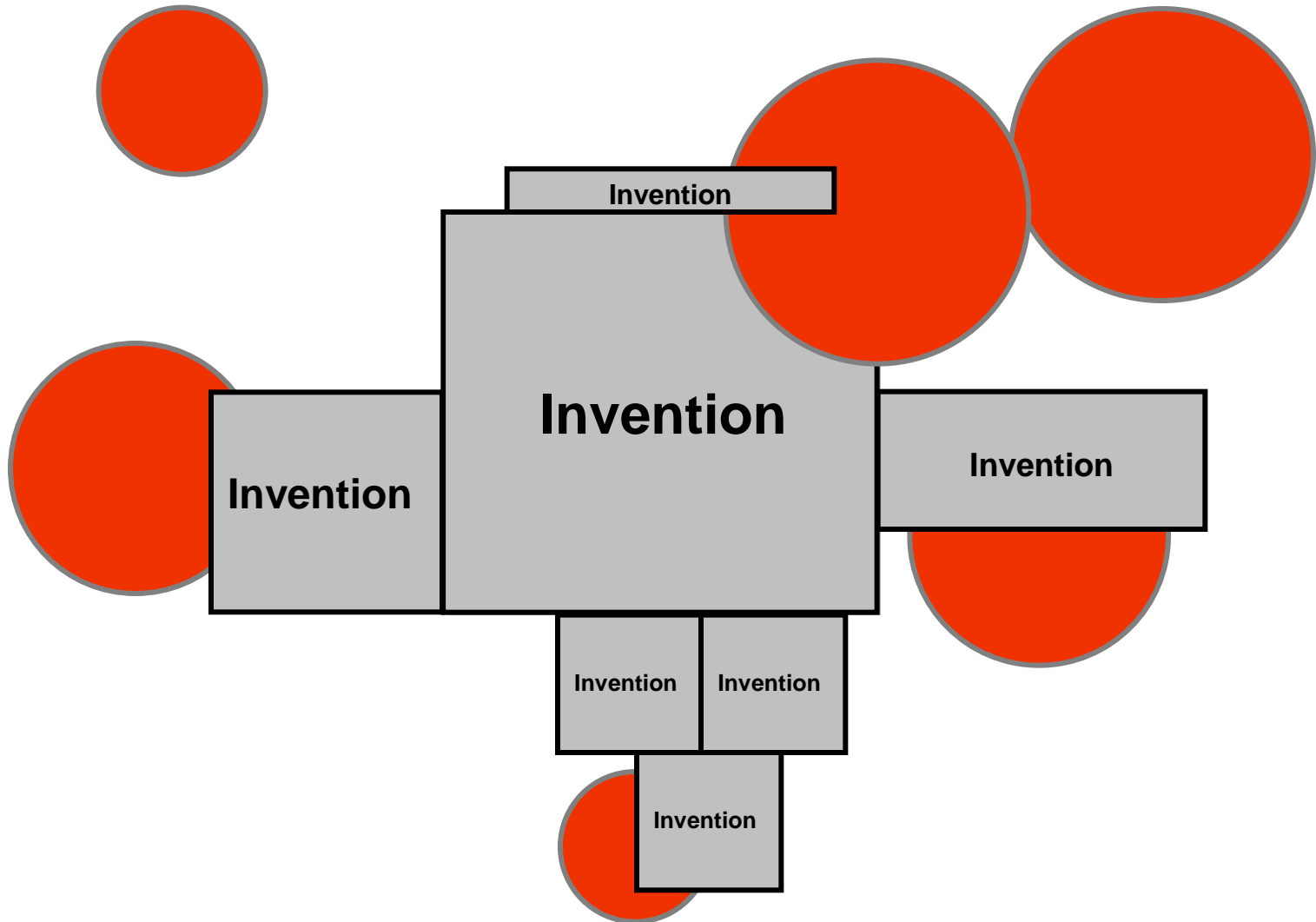
Patents

It is patentable?

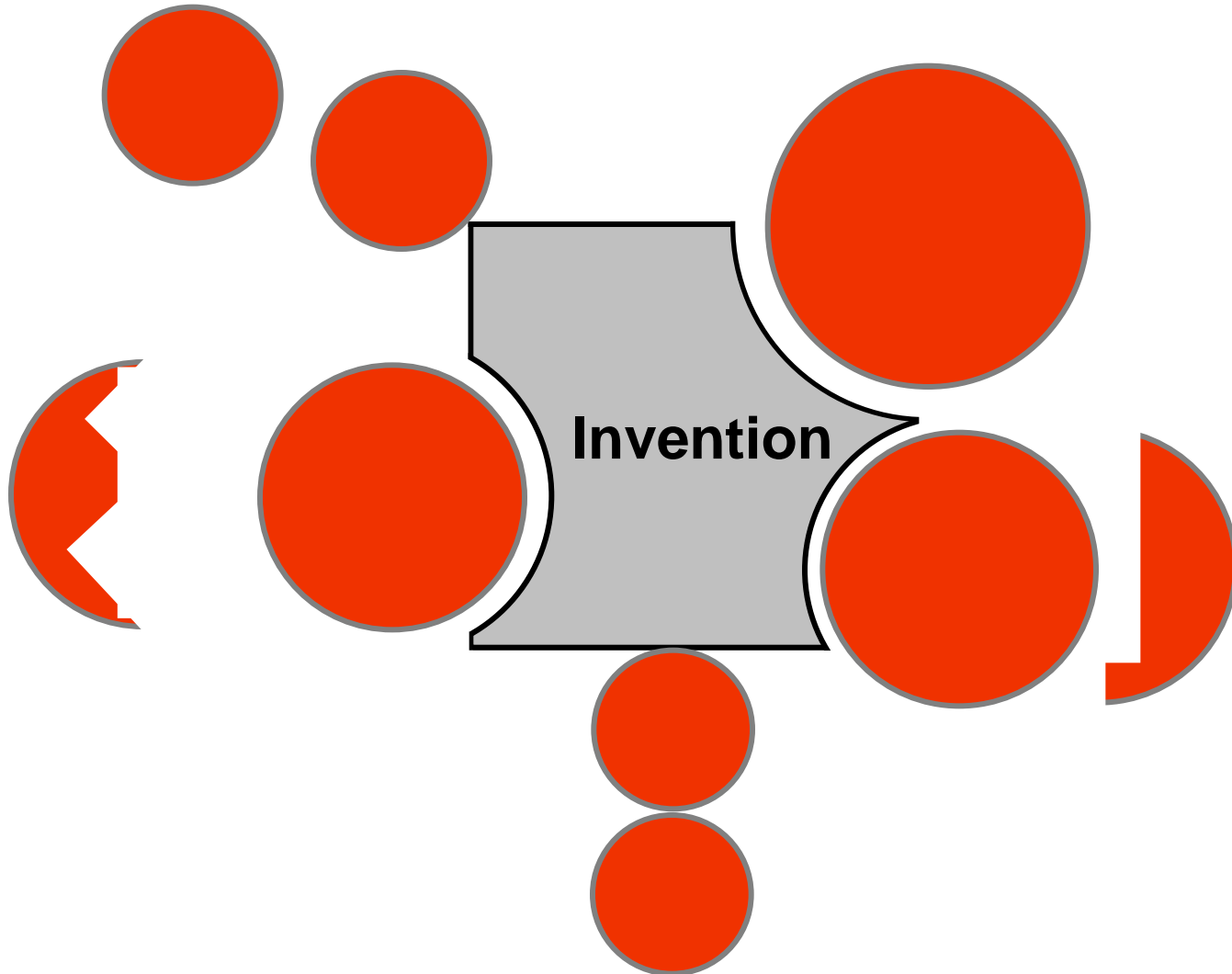
“Anything under the sun made by man”

Often not “if” but how strong

Patents



Patents



Patents



Patents

Ownership and Transfer

- Owner
 - Patents issued to the named inventors
 - Inventors can assign rights to employer or other third party
- Joint ownership
 - Joint owners owe no obligations to other owners
 - Contrast with copyright
- Assignments
 - Entire patent or an undivided interest
 - Must be in writing
- Licenses
 - Any owner may grant a nonexclusive license
 - Exclusive licenses only by agreement of all owners

Patents

Patent Infringement

- Infringement requires making, using, or selling in the U.S.
- Two types of Infringement
 - Literal infringement
 - Infringement of each and every element of a patent claim
 - Doctrine of equivalents
 - Using substantially the same means
 - In substantially the same way
 - To obtain substantially the same result as the patented device or process
- No defense of independent development
- No defense of lack of knowledge

Patents

Lack of knowledge
No defense

Copyrights

Creative
Expressions

Copyrights

Creative Expressions
Not Ideas

Copyrights

Original work
Fixed in a tangible medium
From which the work can be perceived

Copyrights

*Virtually **anything***
*But must have **some creativity***

Copyrights

Reproduce and copy
Create derivative works
Distribute
Display
Perform

Copyrights

Creation and Protection

- Either registered or unregistered
- Unregistered = Immediate Existence
 - Copyright comes into being as soon as original work fixed in tangible medium
- Registration is generally not burdensome
- Benefits of registration
 - Statutory damages and attorneys' fees
 - *Prima facie* evidence of copyrightability
 - Shifts burden of proof
 - Federal court
- No notice required
 - Since March 1, 1989, notice (©) is no longer required (although it is desirable)

Copyrights

Infringement

- Two types of infringement
 - Actual copying (verbatim copies)
 - Access plus substantial similarity
- Any or all of the five exclusive rights can be infringed
- Independent creation
- Lack of access

Copyrights

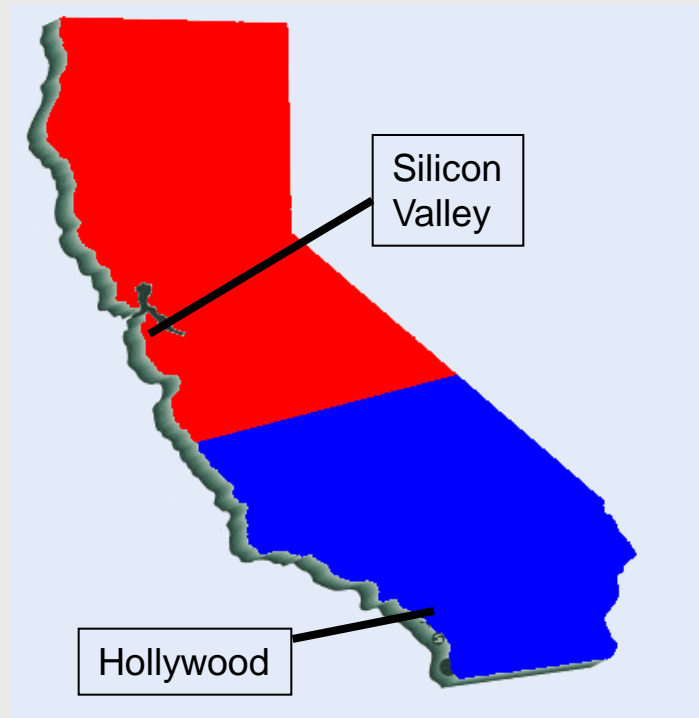
DMCA **Digital Millennium Copyright Act**

Copyrights

DMCA

- Enacted largely in response to fears of the content industry
 - Digital format made copying easy and cheap
 - Existing copyright law provided ineffective protections against piracy of copyrighted works
- Creates several primary areas of focus
 - Legal protection against circumvention of technological protection measures
 - Safe harbors from copyright infringement for “online service providers”
 - Other areas (less prominent, but equally important)
- Highly controversial

Copyrights



Reverse-engineering Hacking

Copyrights

DMCA – Anti-Circumvention and Trafficking

- Focus on circumvention of technological measures used by a copyright owner to control access to their work
- Targets both the act circumventing access controls *and* trafficking in circumvention tools
- Neither requires that an infringing copy of the work have been made
- Technology-neutral
- Some limited exceptions (e.g., some forms of reverse engineering)

Copyrights

UGC

User-Generated Content

Copyrights

DMCA – Safe Harbor

- Provides safe harbors for Online Service Providers (OSPs) against direct and contributory liability for copyright infringement
- Primary safe harbor relates to user-posted materials
- Minimal requirements (and who says *nothing* is free. . .)
 - Designation of an agent for service under the DMCA
 - Compliance with the specific “notice and takedown” procedures in the DMCA

Copyrights



Public Domain

True “Public Domain” is Very Limited

- Copyright attaches automatically
- Very few works not covered by copyright
- Pledging a work to the “public domain” is not sufficient
- Licensing options can get close
 - Open source
 - Creative Commons
- What should you do?

Trademarks

Brand
Identity

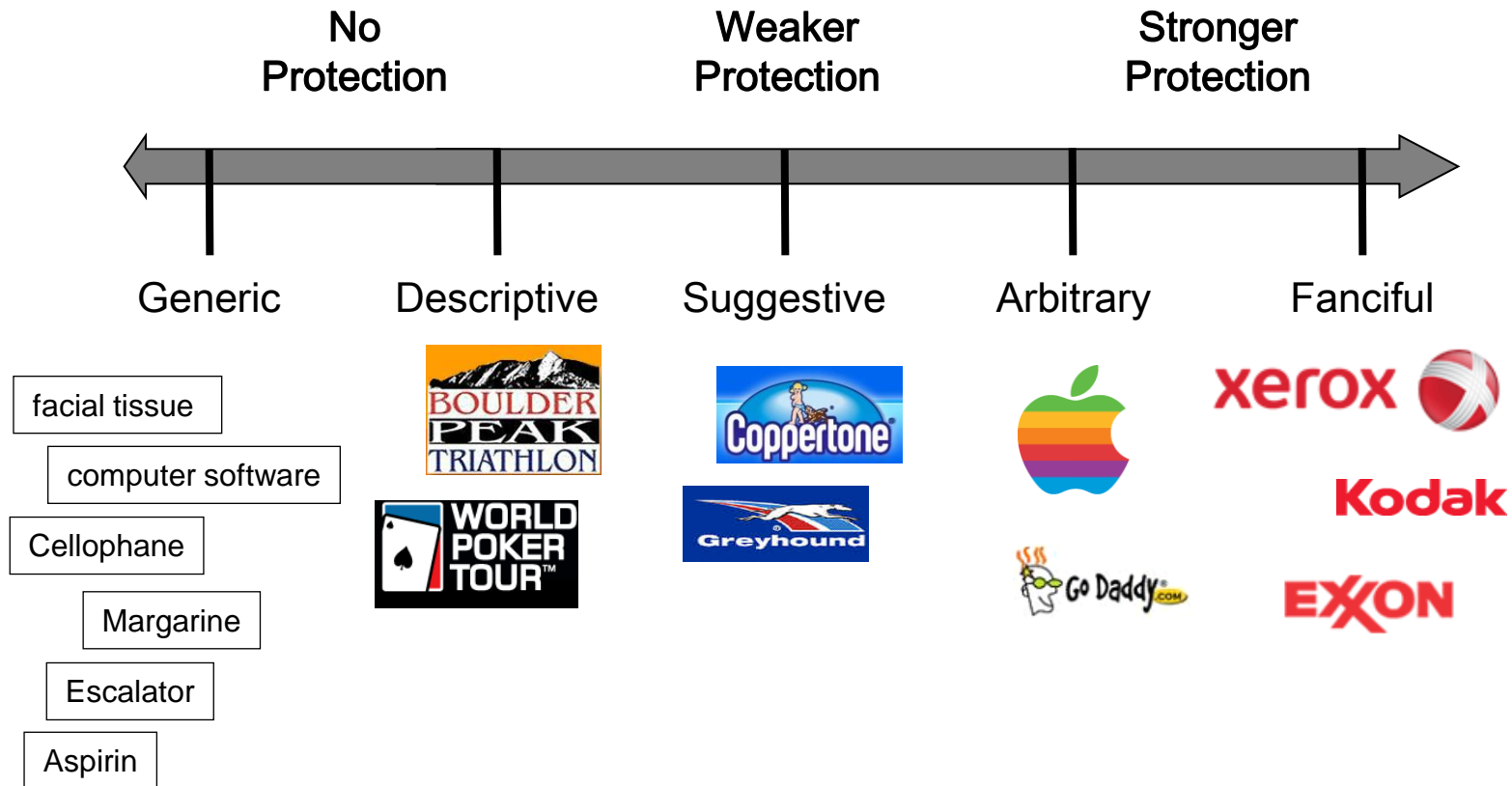
Trademarks

General Information

- Identify the source of origin of goods/services
- Either registered or unregistered form
- Unregistered = Use
- Registration requires filing
- Types of registrations
 - Trademarks – goods
 - Service marks – services
 - Collective marks
 - Certification marks
- Territorial protection
- First to use (U.S.) v. first to file
- Intent to Use (with later showing of actual use)
- Likelihood of confusion, not actual confusion

Trademarks

All Marks Are *Not* Created Equal



Recap...

IP is everywhere

Not if you have IP
But how valuable IP is to your business

Centralize *IP ownership*

*Develop an
IP strategy
for your business*

***Make each choice about IP
an informed and conscious choice***

Thank You.

Jason Haislmaier

jason.haislmaier@bryancave.com

[@haislmaier](#)

<http://www.linkedin.com/in/haislmaier>



This presentation is intended for general informational purposes only and should not be construed as legal advice or legal opinion on any specific facts or circumstances, nor is it intended to address specific legal compliance issues that may arise in particular circumstances. Please consult counsel concerning your own situation and any specific legal questions you may have.

The thoughts and opinions expressed in this presentation are those of the individual presenters and do not necessarily reflect the official or unofficial thoughts or opinions of their employers.

For further information regarding this presentation, please contact the presenter(s) listed in the presentation.

Unless otherwise noted, all original content in this presentation is licensed under the Creative Commons Attribution-Share Alike 3.0 United States License available at: <http://creativecommons.org/licenses/by-sa/3.0/us>.

