

What Every Lawyer Should Know About Intellectual Property

December 10, 2020

Stephen Brookman
John Gray

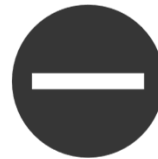
Why IP?



Protect innovation &
brand



Facilitate
business deals



Defense against
competitors



Increase growth and
valuation



Licensing revenue

Agenda (Types of Intellectual Property)


- Patent
- Trade Secret
- Trademark
- Copyright

Patents

Right to exclude others from making, using, offering to sell, or selling an invention

Utility Patent:

protection for 20 years from earliest filing date (with fees)

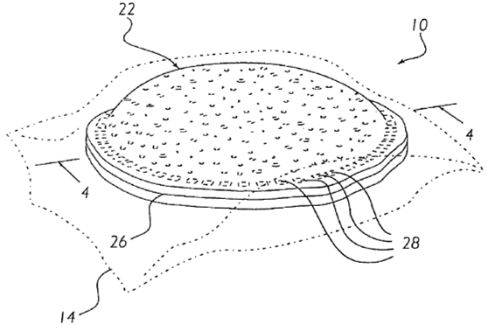


US006004596A

United States Patent [19] **Patent Number:** **6,004,596**
Kretchman et al. [45] **Date of Patent:** **Dec. 21, 1999**

[54] **SEALED CRUSTLESS SANDWICH** 5,853,778 12:1998 Mayfield 426:89
 [75] **Inventors:** Len C. Kretchman, Fergus Falls, Minn.; David Geske, Fargo, N. Dak. OTHER PUBLICATIONS
 "50 Great Sandwiches", Carole Handlip, pp. 81-84, 86, 95, 1994.
 [73] **Assignee:** Menusaver, Inc., Orville, Ohio Primary Examiner—Lien Tran
 Attorney, Agent, or Firm—Vickers, Daniels & Young
 [21] **Appl. No.:** 08/986,581 [57] **ABSTRACT**
 [22] **Filed:** Dec. 8, 1997
 [51] **Int. Cl.:** A21D 13/00
 [52] **U.S. Cl.:** 426:94, 426:274, 426:275, 426:297
 [58] **Field of Search** 426:94, 274, 275, 426:297, 138
 [56] **References Cited**
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 3,083,651 4/1963 Cooper 426:275
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10 Claims, 4 Drawing Sheets



Patents – What is patentable?

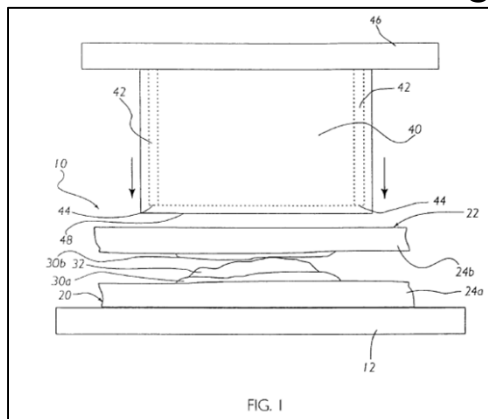
- process, machine, manufacture, composition of matter, or improvement thereof
- new to the public
- non-obvious
 - would “PHOSITA” have combined prior art?

(35 U.S.C. §§ 101-103)



Parts of a Patent

Drawings, Specification, Claims



DESCRIPTION OF THE PREFERRED EMBODIMENT

Turning now descriptively to the drawings, in which similar reference characters denote similar elements throughout the several views, FIGS. 1 through 5 illustrate a sealed crustless sandwich 10, which generally comprises lower bread portion 20, an upper bread portion 22, an upper filling 30b and a lower filling 30a between the lower bread portion 20 and upper bread portion 22, a center filling 32 sealed between the upper filling 30b and the lower filling 30a, and a crimped edge 26 along an outer perimeter of the bread portions 20, 22 for sealing the fillings 30a-b, 32 therebetween. The upper filling 30b and the lower filling 30a are preferably comprised of peanut butter but may consist of any other edible substance such as but not limited to meat, vegetable oil, jelly, cheese, honey, or fruit. The center filling 32 is preferably comprised of jelly but may consist of any other edible substance such as but not limited to meat, vegetable oil, jelly, cheese, honey, or fruit. The center filling 32 is prevented from leaking outwardly into and through the bread portions 20, 22 from the surrounding upper filling 30b and lower filling 30a. The sealed crustless sandwich is preferably packaged within a resilient packaging 14 to extend its useful life and for providing convenience for the user.

As shown in FIGS. 1, 2 and 5 of the drawings, a cutting cylinder 40 has a sleeve 42 positioned within. The sleeve 42 preferably is sidably positioned within a lumen of the cutting cylinder 40, but may be secured within the cutting cylinder 40. The bottom edge of the sleeve 42 has a notched end 44 with the notches spaced approximately every 1/8 inch. The plurality of extensions created from the plurality of notches forms a corresponding plurality of depressions 28 in the crimped edge 26 which represent the pressure points where extensions have projected into the bread portions 20, 22. A cutting edge 48 of the cutting cylinder 40 is utilized to penetrate through the bread portions 20, 22 as shown in FIG. 2 of the drawings. The cutting edge 48 may be formed into various shapes to form a unique design for the sealed crustless sandwich 10. The notched edge of the sleeve 42

We claim:

1. A sealed crustless sandwich, comprising:

- a first bread layer having a first perimeter surface coplanar to a contact surface;
- at least one filling of an edible food juxtaposed to said contact surface;
- a second bread layer juxtaposed to said at least one filling opposite of said first bread layer, wherein said second bread layer includes a second perimeter surface similar to said first perimeter surface;
- a crimped edge directly between said first perimeter surface and said second perimeter surface for sealing said at least one filling between said first bread layer and said second bread layer;
- wherein a crust portion of said first bread layer and said second bread layer has been removed.

35 U.S.C. § 112:

- must describe claimed subject matter
- must enable a skilled person to make and use the invention
- particularly point out and distinctly claim the invention

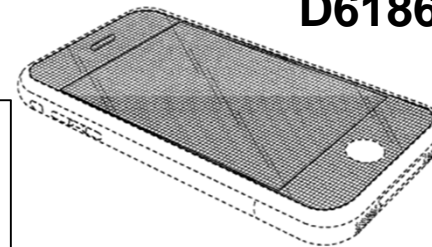
Design Patents

- ornamental design for a useful article, not function
- e.g., GUIs, product “looks”
- 15 years from issue date (no maintenance fees)



D604305

D618677



(57)

CLAIM

The ornamental design of an electronic device, as shown and described.

Patents – Right to Exclude, but not to Practice

Patent = right to **exclude**, but **not right to practice**.

Even if you are practicing your own patent, are you also practicing a technology protected by someone else's patent?

Consider:

- freedom-to-operate opinions
- licenses



Direct Patent Infringement

- making, using, offering to sell, selling a patented invention within the US, or importing patented invention into the US
- to infringe: widget must have every element in a claim, literally or under the Doctrine of Equivalents

A transportation device comprising:
a frame;
two wheels attached to the frame; and
a horn.

A transportation device comprising:
a frame;
two wheels attached to the frame; and
a seat.



(35 U.S.C. § 271)

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Indirect Patent Infringement

- induced infringement
 - ask or direct another to infringe (e.g., selling a product with instructions to cause an infringing use)
- contributory infringement
 - e.g., selling/importing a material component that does not have substantial non-infringing use

(35 U.S.C. § 271)

Patent Litigation

- District Court, appeal to Federal Circuit:
 - Claim construction: *Markman* process
 - Show infringement by preponderance of evidence
 - Show invalidity by clear and convincing evidence
 - e.g., anticipation, obviousness, indefiniteness, inequitable conduct



Patent Remedies

- Damages
 - patent owner's lost profits
 - reasonable royalties
 - *pre-suit* damages
 - *triple* damages for "willful" infringement



- Injunction



Other Patent Litigation Forums

- **International Trade Commission:** patent owner can sue to prevent import of infringing products
- **Patent Trial and Appeal Board (PTAB/USPTO):** anyone can challenge patentability of the claims
 - e.g.: *inter partes* review (“IPR”):
 - administrative patent judges
 - only novelty (§ 102) / obviousness (§ 103) based on patents or printed publications
 - preponderance of evidence standard
 - must file petition within 1 year of service of infringement complaint (if any)
 - 50-60% institution rate
 - 80% of Final Written Decisions render claims unpatentable

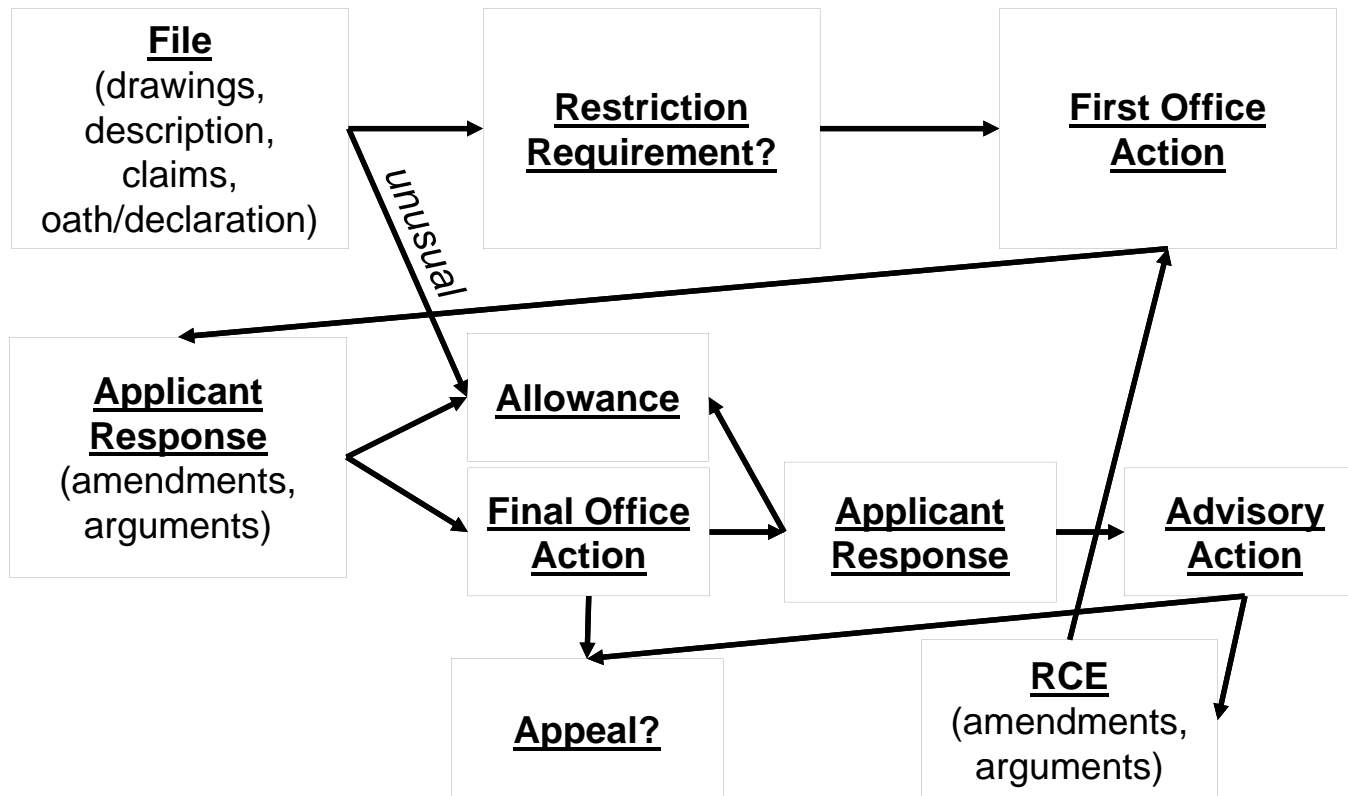


The Exchange – How to get a patent

The right to exclude is in exchange for public disclosure in the patent document (drawings, description).



Example U.S. Non-Provisional Examination Process(es)



Types of Patent Applications

- U.S. Non-Provisional (examined)
 - Continuations, Divisionals, Continuations-in-Part
- U.S. Provisional (not examined)
- Foreign / PCT?



Patents – Reminders and Practice Pointers

- inventor = person who conceived of the *claimed* invention
- employment contract: include *present* transfer of patent rights, not merely a *promise* to assign in the future
 - good to get specific assignments for each application
- Duty of Disclosure to USPTO (all material prior art)
 - includes **your own** prior public disclosure
 - e.g., sales, offers for sale, publications, trade shows...
 - U.S.: 1-year grace period for your own disclosure
 - Some jurisdictions (e.g., Europe) = “absolute novelty”
- First to file wins.

~~First to Invent~~

First to File

United States Patent [19]

Piro

[11] **Patent Number:** 4,608,967

[45] **Date of Patent:** Sep. 2, 1986

[54] **PAT ON THE BACK APPARATUS**

[76] **Inventor:** Ralph R. Piro, 676 Centre Ave.,
Lindenhurst, N.Y. 11757

[21] **Appl. No.:** 739,669

[22] **Filed:** May 31, 1985

[51] **Int. Cl.:** A61H 7/00

[52] **U.S. Cl.:** 128/61; 4/559;
15/143 R; 15/210 R; 224/265; 269/3; 272/1 R;
272/76; 446/26; 128/67

[58] **Field of Search:** 128/24.2, 24 R, 24 A,
128/25 B, 28, 32-40, 45, 46, 47, 50-53, 56, 57,
59, 61, 62, 65, 66, 67; 272/96, 8 N, 8 R, 76, 27
R, 27 N, 1 R; 15/28, 29, 310 R, 143 R, 144 R,
145; 4/559; 2/44, 45; 269/3; 224/265; 446/26,
28

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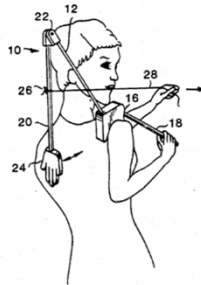
2527295 11/1977 Fed. Rep. of Germany 224/265
603405 1/1936 France 272/1 R
36643 10/1935 Netherlands 224/265
21411 5/1900 Switzerland 128/62 R

Primary Examiner—Clyde I. Coughenour
Attorney, Agent, or Firm—John J. Byrne; Bradford E.
Kile; Kevin M. O'Brien

[57] **ABSTRACT**

A self-congratulatory apparatus having a simulated human hand carried on a pivoting arm suspended from a shoulder supported member. The hand is manually swingable into and out of contact with the user's back to give an amusing or an important pat-on-the-back.

4 Claims, 2 Drawing Figures



What is a Trade Secret?

Trade Secret

All forms and types of information, if

- (1) reasonable measures have been taken to keep it secret;
and
- (2) it has independent economic value because it is not
generally known or readily ascertainable

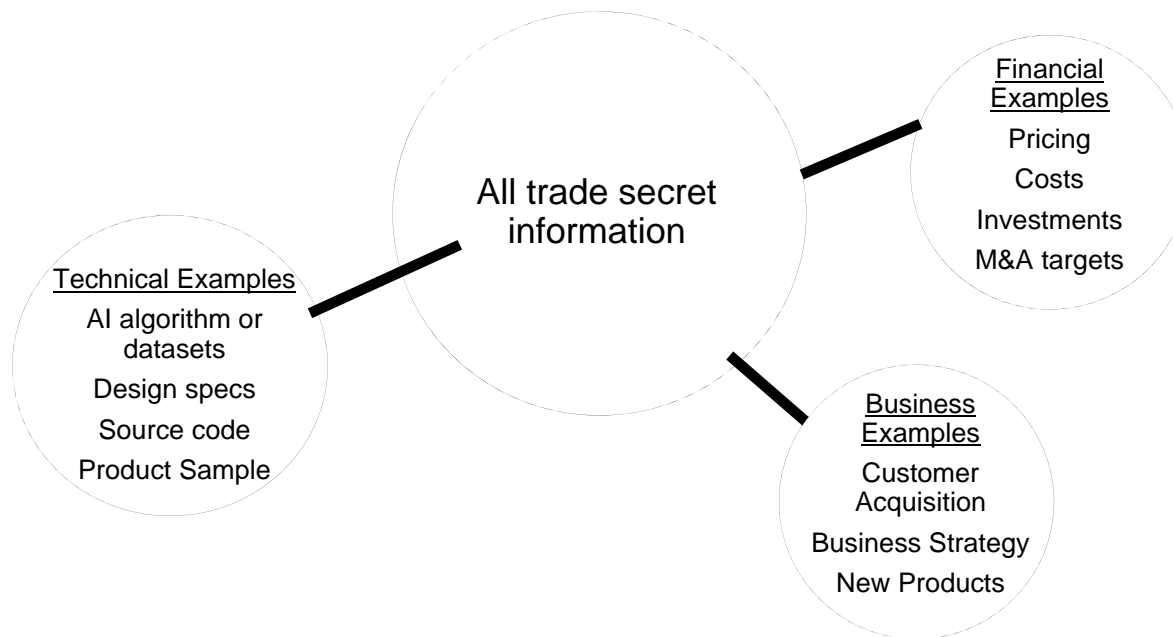
What is a Trade Secret?

Coca-Cola



Google

Scope of Trade Secrets



Why Not Trade Secrets (or not only trade secrets)

- Don't cover all angles of protection
- Business reason to disclose
- Information discernible by others?
- Requires ongoing efforts to protect and enforce
- Protection could be lost

How to protect AI trade secrets

Minimum: “Reasonable” Efforts To Protect

BUT remember:



Protecting Trade Secrets

- Physical barriers
- Technical barriers
- Limit dissemination
- Employee, customer, vendor, business partner protections
- NDAs
- Be proactive and reasonable

Misappropriation

- Misappropriation =**
Acquisition with knowledge, or
Disclosure or use
- If acquired improperly
 - If acquired innocently, but learned it was a trade secret before material change in circumstances



Case	Type	Damages/Settlement
<i>Epic v. Tata</i>	Business relationship	\$940M (reduced)
<i>DuPont v. Kolon</i>	Employee transition	\$919M (vacated)
<i>Lexar v. Toshiba</i>	Board member	\$465M (settled)
<i>Move v. Zillow</i>	Employee transition	\$130M (settlement)
<i>Waymo v. Uber</i>	Employee transition	\$245M (settlement)
<i>Title Source v. HouseCanary</i>	Business relationship	\$706M (verdict)

How Trade Secrets Move



Business Collaboration



Employees, Vendors, and Customers



Other Technological Means

Risk spectrum

Risk Level	People Overlap	Projects Similar	No Independent Development Efforts	Confidential Information Shared	Confidential Information Used
1					
2	√				
3	√	√			
4	√	√	√		
5	√	√	√	√	
6	√	√	√	√	√

You don't want to be a trade secret defendant

Company policies and procedures

General physical/technical restrictions

Employees & employee agreements

Vendor/customer agreements

NDA's

Terms of Use/Service

General
Practices



Compliance attestations

Limitations on use and access or
separate teams

Specific physical or technical barriers

Independent development

Clean room

Case
Specific



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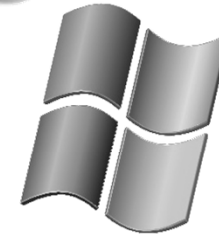
CLE Code Word: General

What is a Trademark?

Trademark

Any word, name, symbol, device, or any combination,
used or intended to be used
to identify and distinguish the goods/services of one seller
or provider from those of others,
and to indicate the source of the goods/services.

Sample marks



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Thinking about your marks

- Choosing a mark: What kind of mark(s) serves your business?
- Before you start using: Consider pre-clearing
- Do I have to register: No, but there are good reasons to
- Is it true that if you don't use it, you lose it: Possibly
- What if someone else uses it: Set up a program for enforcement and monitoring

I might be confused...

Likelihood of confusion varies by jurisdiction, but all similar

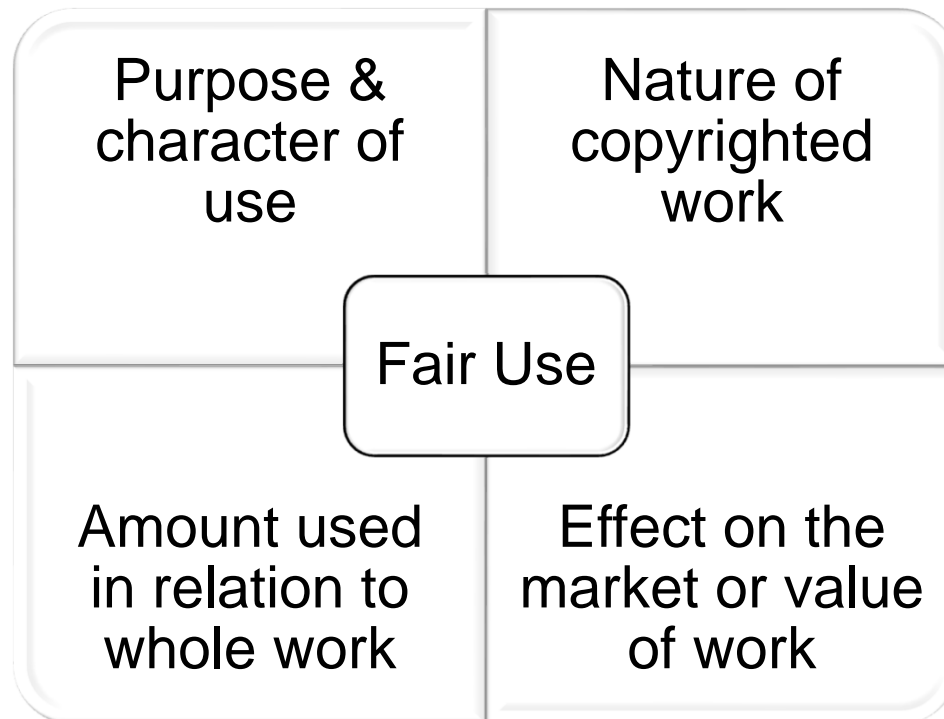
9th Circuit *Sleekcraft* factors:

- Mark strength
- Proximity of goods
- Similarity of marks
- Actual confusion
- Marketing channels
- Type of goods and degree of care of purchasers
- Defendant's intent
- Likelihood of expansion of product lines

Copyright

- Original work of authorship fixed in a tangible medium of expression (a creation in distributable form)
 - literary works
 - movies
 - computer software
 - architectural designs
 - paintings
- Expression, *not ideas or facts*
- lasts life of author plus 70 years or more
- Exclusive right to reproduce, prepare derivative works, distribute, publicly perform, publicly display, publicly perform by digital audio
- Work for hire
- Fair use

Fair Use



Fair Use



Patchwork (or tapestry) of protections

	Patent	Copyright	Trademark	Trade Secret
Protection	process, machine, manufacture, or composition of matter Design: ornamental appearance	Expression	Source of goods/services	Non-public information
Typical Duration	Utility Patent: 20 years from filing Design Patent: 15 years from issue	Life of author + 70 years	Indefinite	Indefinite
Original Owner	Inventor or Assignee	Author of the expression	Source of the goods/services	Owner of the information
Registration Required	Yes - Application	No, but registration → additional rights	No, but registration → additional rights	No



John Gray
602-351-8092
JHGray@perkinscoie.com



Stephen Brookman
602-351-8058
SBrookman@perkinscoie.com