A Guide to Intellectual Property

RatnerPrestia's attorneys and patent agents have hundreds of years of combined experience in intellectual property law.

From procuring IP rights to litigating disputes involving these rights, we are familiar with the intricacies of the various forms of IP law because we work with it every day.

Assessing the scope and validity of a patent, for example, cannot be accomplished competently by an occasional visitor to this increasingly important area of the law. When a client is accused of patent infringement or needs to know the legal protection its own patents provide, there is no substitute for day-to-day experience in reviewing patent prosecution histories and comparing prior art.

Treble damages and attorney's fees are routinely awarded if an accused infringer is not acting in good faith. Reliance on the advice of a non-patent attorney may be considered an indication of absence of good faith. *Underwater Devices, Inc. v. Morrison-Knudsen Co.,* 717 F2d 1380, 1390 (Fed. Cir 1983).

This Guide provides an overview, but is not a substitute for legal competence when clients have complex questions and need advice and experience they can rely on.

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INTELLECTUAL PROPERTY OVERVIEW

	PATENTS	TRADEMARKS	COPYRIGHTS	TRADE SECRETS
Subject Matter	Any new, non-obvious, and useful process, machine, manufacture, or composition of matter, or improvement thereof; new variety of plant; new, non-obvious, and ornamental design for an article of manufacture.	Mark by which the goods or services (for a service mark) of one person may be distinguished from other goods or services. Marks should be used as adjectives, not as nouns or verbs. (Certification and collective marks also exist.)	Original works of authorship fixed in a tangible medium of expression. Works may be literary, musical, dramatic, pantomime, choreographic, pictorial, graphic, sculptural, audio-visual, audio, architectural, software.	Any formula, pattern, device, program, method, process, technique, or compilation of information used in a business which gives the business an advantage over competitors who do not know or use the information.
Degree of Federal Preemption	Total federal preemption. *See* Sears v. Stiffel, 376 U.S. 225 (1964); Compco v. Day-Brite, 376 U.S. 234 (1964); and Bonito Boats v. Thundercraft, 489 U.S. 141 (1989).	No federal preemption. States may register marks for intrastate use. Federal registration applies to all states and precludes later-acquired common law and state rights.	Total federal preemption for works that fall within the scope of the copyright statute. *See* 17 U.S.C. § 301.	No federal preemption. Each state has its own provisions to prevent misappropriation of trade secrets (*see* 18 P.S. § 3930). Federal Economic Espionage Act of 1996, 18 U.S.C. §§ 1831-39, also may apply.
How Protection Obtained	By application submitted to and approved by the U.S. Patent and Trademark Office (PTO). Provisional application may be filed to reserve, but not confer, protection.	Common law protection obtained through use of the mark. Federal registration requires application to and approval by U.S. Patent and Trademark Office (PTO); application may be based on use or on bona fide intention to use mark in commerce, but use is required before registration is granted.	Copyright protection exists as soon as the work is "fixed in a tangible medium." The additional protection of federal registration may be obtained upon application to the U.S. Copyright Office.	Information can be protected if used continually in a business ("trade") and if the owner obtains an advantage over competitors who do not know the information ("secret") and takes reasonable steps to prevent disclosure of the information.
Scope of Protection & Features Subject to Protection	New, useful, and non-obvious subject matter, as defined by the patent claims, can be protected along with a varying range of equivalents. Owner is granted the right to exclude others from making, using, offering to sell, selling, or importing the patented invention. The patent owner may or may not have the right to use the invention; a patent does not confer that right.	Protection against other designations which are likely to cause confusion, cause mistake, or deceive or which dilute the distinctive quality of a famous mark. Protection depends upon similarity between mark and designation, similarity between respective goods or services, strength of mark, and other factors. Generic terms cannot be protected; descriptive marks must acquire distinctiveness (i.e.,"secondary meaning").	Expression and form of the work can be protected. Ideas, content of the work, and intrinsic utilitarian functions of the work cannot be protected. Expression may not be protected if it is the only way to express an idea. Owner has exclusive right to: reproduce, prepare derivatives of, distribute copies of, publicly perform, and display the work.	Protection is afforded against misappropriation by wrongful means and use of the subject matter by another. No protection exists against independent development or reverse engineering.
Infringement	Anyone who makes, uses, offers to sell, sells, or imports the patented invention-including the product of a patented process-without authorization of an owner of the patent. Anyone who contributes to or induces infringement by another.	Use of a designation with goods or services in a manner likely to cause confusion, cause mistake, or deceive or to dilute the distinctive quality of a famous mark.	Anyone who reproduces, prepares derivatives of, distributes copies of, publicly performs, or displays the work without the permission of the copyright owner. Limitations on rights permit, among other exceptions, "fair use."	Misappropriation occurs through acquisition, disclosure, or use of a trade secret obtained by improper means. "Inevitable" disclosure may be enjoined.
Original Ownership	The inventor or inventors (jointly).	First user of the mark who creates association of mark with goods or services.	Author, who may be an employer or a fictitious party.	Developer of the trade secret, who may be an employer.
Duration	Term of utility and plant patents, for applications filed before 6/8/95, is the greater of 17 years from issue or 20 years from effective filing date; for applications filed on or after 6/8/95, 20 years from effective filing date (utility patent terms can be extended for certain delays during prosecution or in obtaining FDA approval). Term of design patent is 14 years. No renewals; utility patents require maintenance fees.	Term lasts for as long as qualified use continues. Federal registration granted for 10 years with potentially infinite 10-year renewals available.	Works created after 1/1/78: life of author plus 70 years. Where author is a corporation or unknown: shorter of 95 years from first publication or 120 years from creation. Copyrighted pre-1978 works: 95 years (with renewal). Non-registered, non-published, pre-1978 works: life of the author plus 70 years.	Potentially unlimited duration provided proper precautions against disclosure are maintained. Public disclosure destroys the trade secret.
Transfer of Rights	Rights can be assigned by an instrument in writing; recordation with the PTO within 3 months protects against later purchasers and mortgagees. *See* 35 U.S.C. § 261. Rights can also be licensed. The duty to assign may be in employment contract or implied from employment relationship.	Rights can be assigned by an instrument in writing; recordation with the PTO protects against later purchasers and mortgagees. Assignment must include goodwill associated with the mark. Rights can be licensed if the owner exercises control over the quality of the goods or services provided under the mark.	Copyright or any of the exclusive associated rights can be assigned by an instrument in writing. Ownership of a copyright is distinguished from ownership of the work itself. Copyright or any portion of the copyright may also be licensed. Licensor or Assignor may terminate license or assignment under certain conditions.	Rights can be licensed or sold as business know-how. Licensor must limit disclosure to a third party.
Marking	"Patent Pending" or "Patent Applied For" means an application for patent has been filed in the PTO. "Patent No." (e.g., 6,000,000) means the article, a portion of the article, or the process for making the article is covered by the identified patent. Mismarking is subject to sanctions.	"TM" or "SM" gives notice to others that the mark is being used as a trademark or service mark; mark need not be registered. "®" or "Reg. U.S. Pat. & Tm. Off." or "Registered in U.S. Patent and Trademark Office" means mark is federally registered. Mismarking is subject to sanctions.	Marking is not necessary but is recommended. "© 2000 ABC Co." means the work was published in 2000 and ABC Co. claims copyright in the work. No registration is needed to use this marking.	Use of "confidential" stamps or other similar markings is recommended, although not required.

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