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IP TUTORIAL FOR CONSULTANTS

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AGENDA

- Introductory Comments
- Patents
- Trade Secrets
- Trademark
- Copyright
- Consultant Rights
- Questions

INTELLECTUAL PROPERTY

PATENT

TRADE SECRET

TRADEMARK

COPYRIGHT

OTHER

PATENTS

- **What legal rights does an issued U.S. patent provide its owner?**

- **Patent grants the right to exclude others from making, using, selling, or offering for sale articles (or methods) covered by one or more claims of the patent.**
- **It does not grant the right to make, use, sell, or offer to sell articles covered by the claims of the patent.**

PATENTS

- **How does owning a Patent differ from Freedom to Operate so that one can make, use, …, without being sued for violating someone else's patent?**
- **Making, using, selling, or offering for sale your or your company's patented good or service my violate someone else's patent**
- **Having your own patent does <u>not</u> eliminate the possibility that your patented product will infringe another's**
- **Need to investigate Freedom to Operate (usually in the form of a legal opinion) to keep out of trouble.**
- **May want to "design around" a potentially problematic patent**
- **May need to consider obtaining a license to one or more other patents**

PATENTS

- SOME REASONS TO PATENT
  - Competitive Advantage
    - Better Technology
    - Lower Price (no royalties such as competitors may need to pay)
  - Protect investment in Technology R&D
  - Derive licensing revenues for company
  - Cross licensing possible instead of paying $'s if accused of infringement of other patents
  - Defense against later patent by others
  - Notoriety for Inventor
  - Enhance reputation for Company or Consultant

PATENTS

- SOME REASONS NOT TO FILE FOR PATENT
- **Technical solution is narrow and many other ways to solve the problem (value of patent < cost to obtain patent)**
- **Invention is novel but probably obvious in light of prior art and cannot be successful in obtaining a patent**
- **Keep as "Trade Secret" : Invention would be very difficult to discover, will have value for >20 year patent life, can be kept secret (?) long enough to present value.**
- **Some legal or statutory "bar" to patentability exist**

PATENTS

- What subject matter can be patented in USA?
  - Machine (System, Apparatus, Device, etc.)
  - Process/Method (Algorithm)
  - Article of Manufacture
  - Composition of Matter
  - Computer Program (Software/Algorithm)
  - Business Model/Method

PATENTS

- **Non-patentable subject matter:**
  - **Ideas or concepts**
  - **Laws of Nature**
  - **Scientific Truths or Principles (e.g., $e=mc^2$)**
  - **Mental Steps (pure algorithms)**
  - **Printed Matter**
  - **(Internationally there are other restrictions)**

PATENTS

- **Requirements for being granted a patent?**
- **Provide an "enabling" written description and describe "best-mode".**
- **Provide description and drawings that show the invention and distinguish over prior art in that field**
- **Provide at least one "claim" that defines the invention and which is:**
  - **Useful (some countries require "industrial applicability")**
  - **Novel (same thing not done before in all history)**
  - **Non-Obvious (not an obvious extension or minor difference compared to closest combination of "prior art"** (sometimes referred to as "inventive step")

PATENTS

- Provide an "enabling" written description and "best mode".

  The specification shall contain *a written description of the invention and the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor in carrying out his invention*. (35 U.S.C. 112(1))

- Duty to disclose any prior art the inventor or others involved may know of that may be relevant to determining patentability of the invention (no duty to perform a search).

PATENTS

- **CLAIMS**
- Claims define the invention (but the specification and drawings affects interpretation of the claims)
- Must be read carefully - every word is significant, and "comprising" means "includes"
- Desirable to eliminate any unnecessary qualifying/limiting terms
- If not described and covered by a claim as granted – its not patented
- Claims are only basis for an infringement lawsuit by patent owner
- Hierarchical claim structure – broad independent claim for each class and increasingly detailed and narrower dependent claims
- Interpret claims in light of at least: (1) Claim language, (2) specification and drawings, (3) the prior art, and (4) history of argument/amendment with the patent office

PATENTS

- **TYPICAL CLAIM TYPES** **(examples)**

- **DEVICE** (circuits, chips, semiconductor structure, cables, cards, boards, mechanical, etc.)

- **APPARATUS** (see device – no real difference but often use alternative term to distinguish one part of an invention from another)

- **SYSTEM** (usually a combination of interoperating devices such as in a computer, distributed computing network, controller, etc.)

- **METHOD/PROCESS** (Method for making an automobile tire, Computer Programs, Software, Business Methods & Models, method for constructing a Data Structure, etc.)

- **COMPUTER PROGRAM** ("computer readable medium encoded with a computer program…" . May permit direct action against manufacturer when method claim does not.)

- **ARTICLE OF MANUFACTURE** (Something produced by a manufacturing method, such as a particular semiconductor wafer structure, etc.)

- **SIGNAL CLAIMS** (modulation scheme, encoding, etc.)

PATENTS

- **What is "Prior Art" (at least in the USA- international more stringent)**
  - **The existing body of technological (business/economic) information including:**
    - **Prior knowledge or use** (not only what has been patented)
    - **Prior printed publications** (including technical papers & patent applications)
    - **Prior Patents** (count for what they "describe" as well as for what they "claim" – but only the claims count for patent infringement)
    - **Attempt to Commercialize > 1 year before filing**
    - **Advertising > 1 year before filing**
    - **Sale or Offer to sell > 1 year before filing**
    - **Public Use > 1 year before filing (even if use is hidden)**
    - **… other ...**

PATENTS

- **BARS TO PATENTABILITY IN THE UNITED STATES:**
  - **PUBLICATION**
    - **Non-Confidential or Unrestricted communications**
    - **Papers or Journals**
    - **Internet Web Pages/Sites (Do not market or announce product before patent filing)**
    - **Reports to/from Customers**
    - **News Reports or Press Releases**
    - **Lectures and/or remarks to colleagues at conferences**
    - **Poster Sessions at Technical Conferences**
    - **Other …**

(* Even with these, there may be a 1-year grace period for filing, but only in the USA)

PATENTS

- **BARS TO PATENTABILITY IN THE UNITED STATES** (continued):
  - **PUBLIC USE** (EVEN IF HIDDEN OR SECRET) (> 1 year before filing date)
  - **DISCLOSURE NOT UNDER NDA** (> 1 year before filing date)
  - **DISCLOSURE TO EVERYONE IN THE INDUSTRY EVEN UNDER NDA** (> 1 year before filing date)
  - **DISCLOSURE UNDER NDA TO LARGE SEGMENT OF MARKET** (> 1 year before filing date)
  - **SALE or OFFER FOR SALE** (> 1 year before filing date)
  - **ATTEMPTED COMMERCIAL EXPLOITATION** (> 1 year before filing)
  - The one year period is often referred to as the 1-year grace period in the US

PATENTS

- **INTERNATIONAL AND FOREIGN PATENTS**
- **BARS TO PATENTABILITY** (GENERALLY) **- No 1-year grace period**
  - **ANY PUBLIC USE PRIOR TO FILING** (even if hidden use)
  - **ANY SALE OR OFFER TO SELL PRIOR TO FILING**
  - **ANY PUBLICATION PRIOR TO FILING**
    (PRINTED, INTERNET, CONFERENCE, S/W RELEASE, ETC.)
  - **ANY COMMERCIAL EXPLOITATION PRIOR TO FILING**
  - BUT, MAY FILE IN USA PRIOR TO THESE EVENTS AND THEN MAY HAVE ONE-YEAR PERIOD IN MANY BUT NOT ALL COUNTRIES TO FILE FOREIGN APPLICATIONS (NOT TAIWAN, MAYLASIA, AND OTHER COUNTRIES)
  - SOME COUNTRIES HAVE EXCEPTIONS FOR APPROVED CONFERENCES OR BAD ACTS BUT THESE ARE VERY LIMITED AND NEED TO BE LOOKED AT ON A CASE-BY-CASE BASIS.

PATENTS

- **INVENTOR AND COMPANY R&D RECORDS**
- **Maintain R&D Notebook (traditional) or Database (Dated and witnessed documents are best evidence)**
- **Enter all ideas, concepts, designs, tests, calculations, graphs, results, conclusions (including failed tests and bad data if any)**
- **Page number and date each entry (traditional - best to use sewn-in style notebook with pre-numbered sheets,)**
- **Have each page periodically witnessed by company co-worker who understands the technology.**
- **Company / Inventor can establish electronic database or record of R&D and inventions**
- **Should consider need to maintain evidence of invention for duration of patent lifetime and beyond**

PATENTS

- **INVENTION DISCLOSURE - GUIDELINES**

- **A particular minimum set of information needs to be identified to a Company Patent Committee or to a Patent Attorney, or by an independent inventor or consultant for each invention.**

- **A company usually wants to encourage invention and not restrict it with overly burdensome paperwork**

- **Various Forms may be provided for inventor use.**

PATENTS

INVENTION DESCRIPTION GUIDELINES

1. Descriptive title for the invention (a guide to what the invention is about)

2. Names of inventors

3. Product or project into which the invention may be incorporated (important for tracking and timing purposes)

4. Earliest date on which product incorporating the invention may be released outside the company

PATENTS

5. Overview diagram (Figure 1) showing the environment or context in which the "invention" operates, and a short description pointing out how the invention differs from the traditional approach.

6. List of the problems in the traditional system or approach that are solved by the invention.

PATENTS

7. Diagram (Figure 2) showing the closest traditional approach (system, device, algorithm) for solving the problems addressed by the invention that were known before this invention.

8. Diagram (Figure 3) showing the inventive approach (system, device, computer program, algorithm) for solving the problem in a manner that the differences from the traditional approach are clear from the traditional approach diagram. Ideally, this is the same diagram as in 7 but has added, deleted, or modified certain features and left the others unchanged.

PATENTS

9. List (or description) of all of the known advantages of the inventive approach and the problems it solves

10. Text description (usually at least 1-2 pages) of the invention with reference to the diagrams (Figures 1-3). Additional figures and description may usually be requested later when working with in-house or outside patent attorneys

(May attach any relevant materials from manuals, design documents, specifications & standards, as well as any prior art descriptions or documents.)

PATENTS

- U.S. PATENT APPLICATION PROCEDURE (typical)
- 0. May file "Provisional" patent application
- 1. File Utility Patent Application
- 2. Provide Inventor Oath/Declaration (at filing or <=+2 months later)
- 3. Submit Information Disclosure Statement (at filing or <=+3 mo.)
- 4. Preliminary Amendment (<=+3 mo or before 1st O.A. examination)
- [FILE INTERNATIONAL AND FOREIGN APPLICTIONS WITHIN 12 MONTHS]
- 5. 1st Office Action / Exam on Merits (+12 to +36 mo.)
- 6. 1st response to 1st O.A. (w/ 3-6 mo of 1st O.A)
- 7. 2nd O.A./Exam (w/ 3-6 mo of 1st response)
- 8. 2nd response (w/ 3-6 mo of 2nd O.A.)
- 9. If Final rejection - Appeal or refile for further consideration
- 10. If Allowed - pay issue fee - Patent issues +3 mo later (elapsed ~3 yr)

PATENTS

- **PATENT INFORMATION RESOURCES**
- **www.uspto.gov** (PATENT BUTTON)
  - **www.uspto.gov/main/patents.htm**

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Commerce Under Secretary and Orlando Congressman Highlight Orlando's Innovation and Employment

Focus on importance of intellectual property protection to Orlando's economy

Under Secretary of Commerce for Intellectual Property and Director of the U.S. Patent and Trademark Office (USPTO) Jon Dudas, joined by U.S. Representative Tom Feeney (R-FL), on Friday told reporters on a conference call that protecting intellectual property against piracy and counterfeiting is a key part of economic growth, particularly in Orlando. Dudas and Feeney emphasized that intellectual property theft costs U.S. businesses approximately $250 billion annually and hundreds of thousands of jobs.

"Orlando is a leader in innovation and high-technology. Today's job numbers show that the U.S. has continued to add new jobs. Innovation in Florida is leading the way," noted Under Secretary Dudas.

>> Read full story.

Bush Administration Releases Report On Intellectual Property Enforcement And Protection

On September 28 the Bush Administration released the 2006 Report to the President and Congress on Coordination of Intellectual Property Enforcement and Protection. The report sets forth the actions and initiatives that the U.S. government has taken over the past year to combat the rising tide of global counterfeiting and piracy, and notes the importance of these efforts because of the critical role intellectual property (IP) plays in the country's economic strength and the health and safety of consumers.

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	PAT. NO.	Title
1	D529,920	Graphical user interface for a display screen of a communications terminal
2	D529,037	Graphical user interface for a display screen of a communications terminal
3	D529,036	Graphical user interface for a display screen of a communications terminal
4	7,113,409	Mounting structures for electronics components
5	D528,553	Graphical user interface for a display screen of a communications terminal
6	D528,552	Graphical user interface for a display screen of a communications terminal
7	7,107,419	Systems and methods for performing record append operations
8	7,096,214	System and method for supporting editorial opinion in the ranking of search results
9	7,089,490	Identifying navigation bars and objectionable navigation bars
10	7,089,237	Interface and system for providing persistent contextual relevance for commerce activities in a networked environment
11	7,068,192	System and method for encoding and decoding variable-length data
12	7,065,618	Leasing scheme for data-modifying operations
13	7,031,961	System and method for searching and recommending objects from a categorically organized information repository
14	7,031,954	Document retrieval system with access control
15	7,028,029	Adaptive computation of ranking
16	7,027,987	Voice interface for a search engine
17	6,982,945	Baseband direct sequence spread spectrum transceiver
18	6,941,293	Methods and apparatus for determining equivalent descriptions for an information need
19	6,934,634	Address geocoding
20	6,906,920	Drive cooling baffle

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United States Patent **7,107,419**
Ghemawat , et al. **September 12, 2006**

Systems and methods for performing record append operations

Abstract

A system facilitates the performance of a record append operation. The system may include a primary replica and one or more secondary replicas that store copies of data. The primary and secondary replicas may receive a record to be appended to the data and a record append request that identifies the record to be appended to the data. The primary and secondary replicas may append the record to the data, possibly at the same offset. If multiple record append requests are concurrently received, the requests may be serialized to establish an order for the requests.

Inventors: **Ghemawat**; **Sanjay** (Mountain View, CA), **Gobioff**; **Howard** (San Francisco, CA), **Leung**; **Shun-Tak** (Mountain View, CA), **desJardins**; **David L.** (Mountain View, CA)
Assignee: ***Google* Inc.** (Mountain View, CA)
Appl. No.: **10/608,140**
Filed: **June 30, 2003**

Current U.S. Class: **711/162** ; 707/204; 711/112; 711/114; 711/154; 711/163
Current International Class: G06F 12/00 (20060101)
Field of Search: 711/162,112,114,154,163 707/204

References Cited [Referenced By]

U.S. Patent Documents

5440727	August 1995	Bhide et al.
5794254	August 1998	McClain
5978813	November 1999	Foltz et al.
6189017	February 2001	Ronstrom et al.
2002/0107877	August 2002	Whiting et al.

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CONSULTANTS' RIGHTS

- **PATENT**
  - **Consultant obligated to assign patent rights**
    - **Must be directly related to problem solved (or "hired to invent")**
    - **Can change scope of assignment by agreement**
    - **Judges read assignment agreements restrictively**
  - **Assigning back after termination: Fact-based analysis**
    - **State law controls**
  - **Invention "made" after invention "conceived"**

CONSULTANTS' RIGHTS

- **PATENT (Continued)**
  - **Non-Compete: May have to sell or license patent rights**
    - **State law controls**
  - **Consultant may grant an implied license to a previously owned patent if the patented invention is used to solve the problem**
  - **Shop Rights**
    - **Employee uses employer's resources**
    - **Invention need not be related to business of employer**
    - **Employer gets non-exclusive rights to use inventions of employee**

TRADE SECRET

- **Working Definition of Trade Secret:**
  - **Business or technical information**
  - **that is the subject of reasonable efforts to preserve confidentiality**
  - **because it is not generally known in the trade.**

TRADE SECRET

- **TRADE SECRET INFRINGMENT**
  - **Allegation of infringement involves two main issues:**
    - **(1) Whether there is valuable and secret business/technical information?**
    - **(2) Whether the information was obtained using improper means?**
  - **These issues suggest certain protective steps**
    - **Label, Store Securely, Control Distribution, Establish Handling Procedures, Use NDA**

CONSULTANTS' RIGHTS

- **TRADE SECRET**
  - **Consultant retains "personal equipment"**
    - **State law controls**
  - **Must be sensitive to trade secrets when applying for patent**
  - **Consultant's trade secrets**

TRADEMARKS

- **What is a Trademark? (Service Mark?)**
  - **A means for identifying and distinguishing goods (services).**

- **Two purposes of Trademark:**
  - **Identification - To identify one seller's goods (services) and distinguish them from goods (services) sold by another.**
  - **Source - To signify that all goods (services) bearing the trademark (service mark) come from or are controlled by a single source.**

TRADEMARKS

- **Application & Examination of Trademark**
  - **File "Intent-to-Use" or "Use" Application**
  - **Cannot have likelihood of confusion with another mark**
  - **Cannot be generic**
  - **If merely descriptive, secondary register only**
  - **If suggestive, arbitrary, or fanciful, primary register**

TRADEMARKS

- TRADEMARK INFORMATION RESOURCES
- www.uspto.gov (TRADEMARK BUTTON)
  - www.uspto.gov/main/trademarks.htm

CONSULTANTS' RIGHTS

- **TRADEMARK**
  - **Can a consultant have trademark rights?**
  - **See Copyright**

COPYRIGHT

- Works of Authorship can be copyrighted.
- Authorship relates to "expression" not fact or idea.
  - Literary Works including Computer Software
    - Compilations
  - Motion pictures and audiovisual works
  - Sound recordings
  - …

COPYRIGHT

- **CRITERIA FOR COPYRIGHTABILITY**
  - Original
  - Fixed in any tangible medium of expression
  - Can be perceived directly or with the aid of a machine

COPYRIGHT

- **RIGHTS OF A COPYRIGHT OWNER**
  - To reproduce the copyrighted work in copies
    - Including to copy the work into the memory of a computer
  - To prepare derivative works
  - To distribute copies for sale, rental, or lease
  - To perform or display the copyrighted work publicly

COPYRIGHT

- **DURATION OF COPYRIGHT PROTECTION**
  - **FOR NATURAL PERSONS**
    - One Author: Life of Author + 70 years
    - Joint Authors: Life of last surviving author + 70 years
  - **EMPLOYER AS COPYRIGHT AUTHOR**
    - Longer of: 95 Years from the date of publication, or
      120 Years from the date of creation

COPYRIGHT

- **REGISTRATION OF A COPYRIGHT**
  - **RIGHTS GAINED UPON REGISTRATION**
    - Right to sue & recover statutory damages
  - **REGISTRATION OF A COMPUTER PROGRAM**
  - **FILE FORM "TX" for literary work**
  - **Pay Official Fee to U.S. Copyright Office**
  - **Submit "deposit" of Work with the Form**
    - Discuss Computer Program deposit with Attorney

COPYRIGHT

- **COPYRIGHT NOTICE**
  - “copyright”, “Copr.”, or ©
  - First year of publication of the work
  - Name of copyright owner

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COPYRIGHT

- **COPYRIGHT RESOURCES**
  - INCLUDING FORMS FOR REGISTRATION
    - **www.copyright.gov**

CONSULTANTS' RIGHTS

- **COPYRIGHT**
  - **"Works Made for Hire"**
    - **Work prepared by an employee within the scope of employment or**
    - **Work specially ordered or commissioned for use as a contribution to a collective work, part of an audiovisual work, as a translation, as a supplementary work, as a compilation, as an instructional text, as a test, as answer material for a test, as an atlas, or parties agree the work is a "work made for hire"**
    - **May change by express agreement**

CONSULTANTS' RIGHTS

- **COPYRIGHT**
  - **If Consultant provides software solution without copyright agreement**
    - **Employer owns the software**
    - **Consultant owns the copyright**
  - **What can consultants do with a copyright?**
    - **Anything a copyright owner can do, but notably this includes version control (if the client wants to sell the new version)**

INTELLECTUAL PROPERTY

QUESTIONS?

INTELLECTUAL PROPERTY

THANK YOU!

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