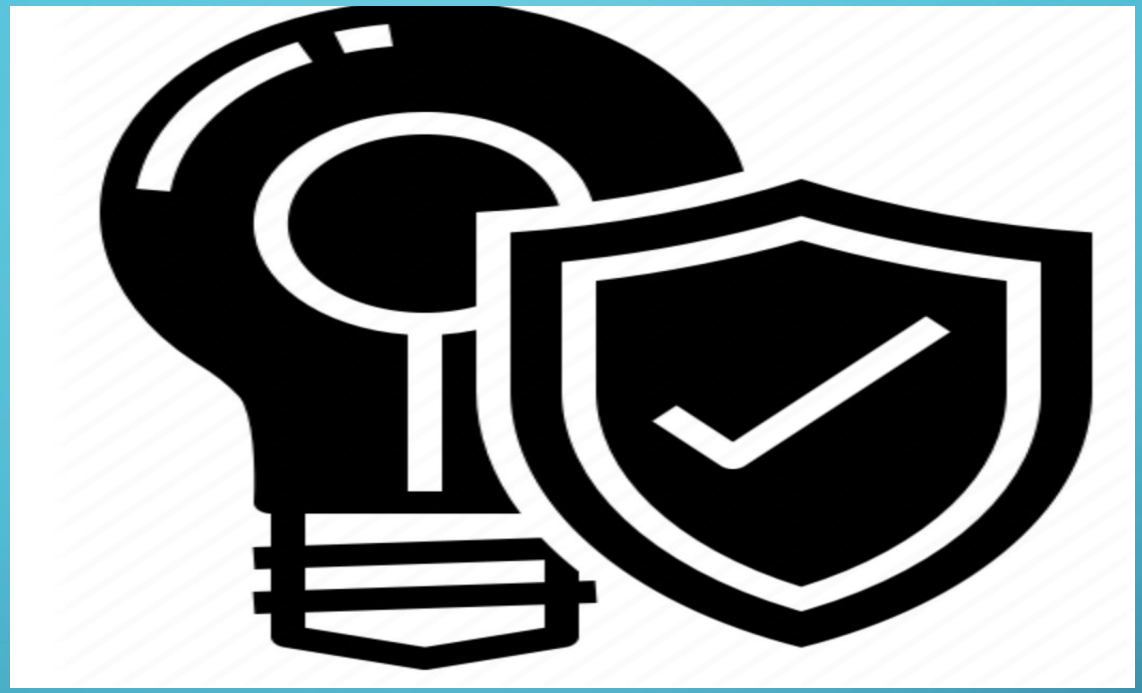


IP Issue Spotting for the Non-IP Attorney

Kirby Drake, Kirby Drake Law PLLC

WHAT IS A TRADEMARK?

- Symbol used in commerce to indicate source of good or service
- Takes form of word, logos, shapes, colors, smells, and even combinations
- Can last forever if mark continues to be used





WHY REGISTER A TRADEMARK?

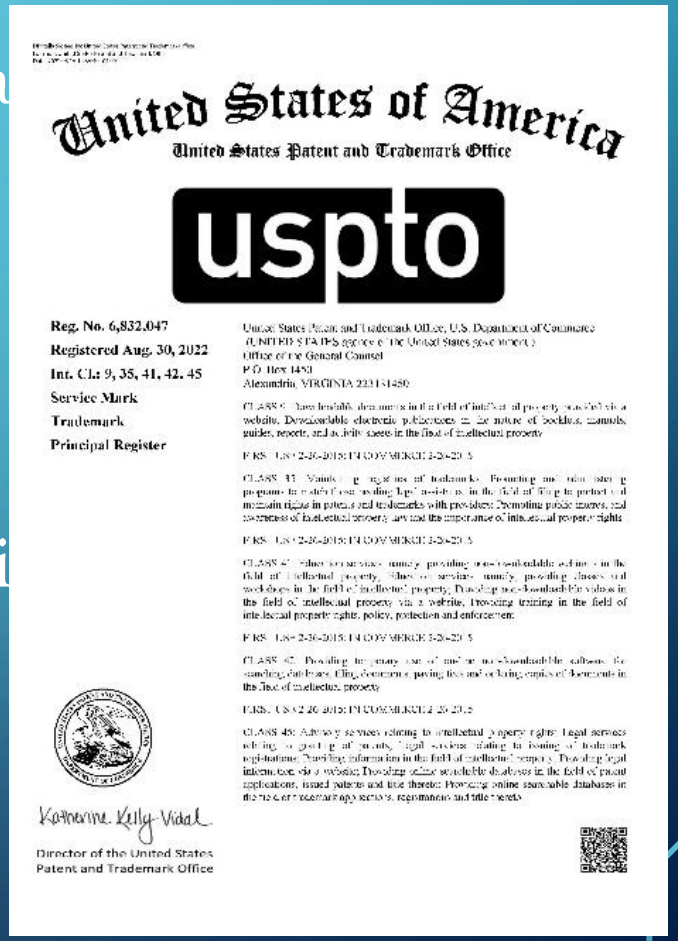
- Nationwide protection
- Constructive notice of right to use
- Refusal of later-filed applications that are "confusingly similar"
- Ability to use ® symbol
- Can obtain registration in a foreign country
- Statutory damages and attorneys' fees available in federal litigation relating to infringement

WHAT MAKES A "GOOD" TRADEMARK?



TRADEMARK – POSSIBLE PITFALLS

- Failure to adequate select enforceable tradema
- Failure to meet USPTO requirements
- Failure to adhere to “less is more” principle
- Failure to maintain or even complete registrati



United States of America
United States Patent and Trademark Office

uspto

Reg. No. 6,832,047
Registered Aug. 30, 2022
Int. Cl.: 9, 35, 41, 42, 45
Service Mark
Trademark
Principal Register

Director of the United States
Patent and Trademark Office

WHAT IS A COPYRIGHT?

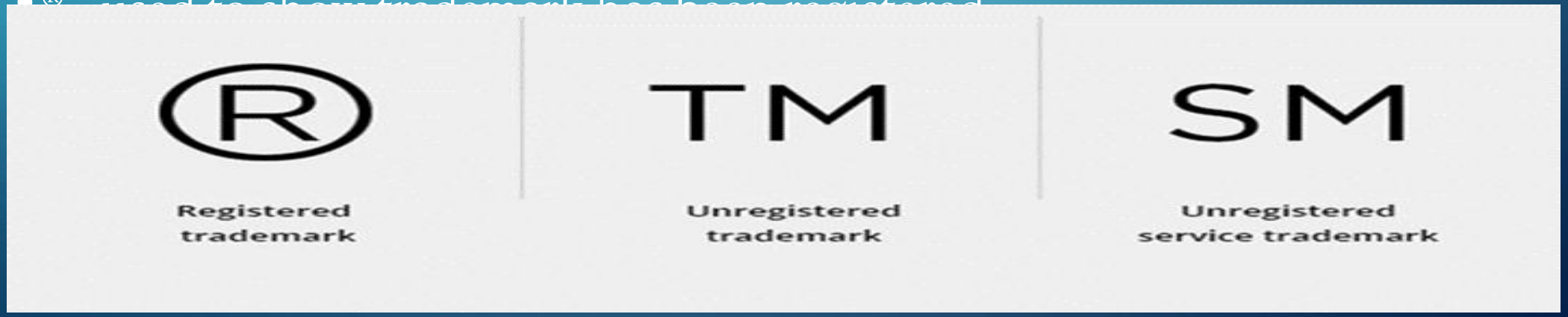
- Protect original works of authorship fixed in a tangible medium of expression
- Can include literary works, musical works, dramatic works, graphic and sculptural works, sound recordings, motion pictures, architectural works
- Exclusive rights to reproduce, distribute copies, perform publicly, display publicly, transmit sound recordings digitally, prepare derivative works
- Owned by creator but can be owned by employer if created by employee or commissioned by employer
- Must register with US Copyright Office to sue for infringement



WHAT IS THE DIFFERENCE BETWEEN ©, ™, AND ®?

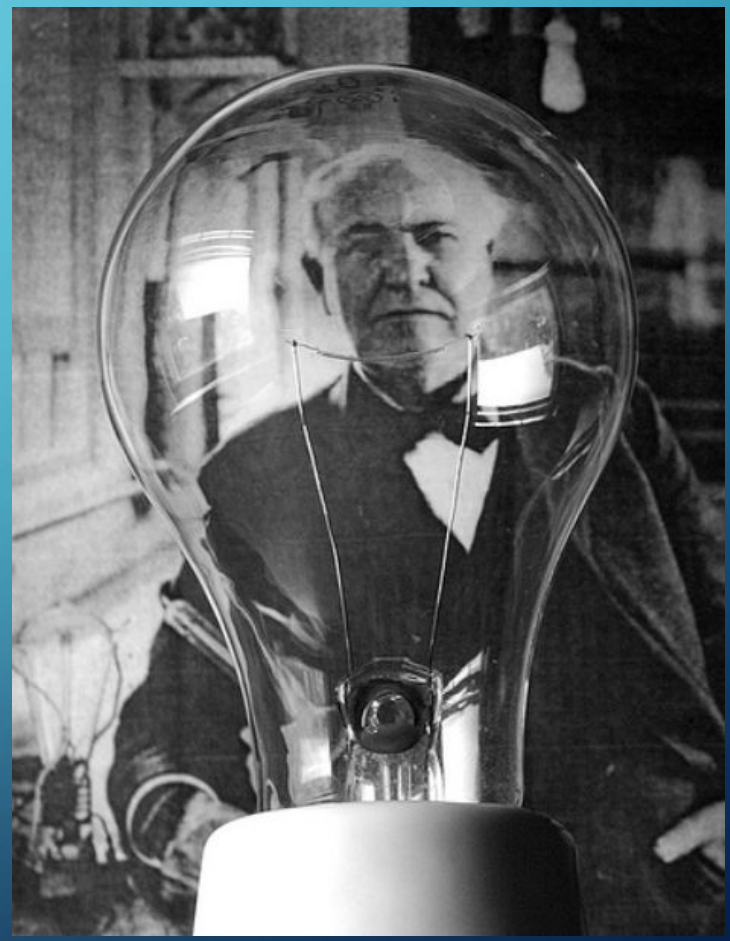


- Copyright - ©
- Trademark
  - ™ - used to show that you are claiming rights to mark; not registered
  - ® - used to show trademark has been registered



WHAT IS A PATENT?

- Grants right to exclude others from making, using, offering for sale, selling, or importing invention
- Can protect processes, machines, articles of manufacture, new and useful improvements thereof, as well as new, original, and ornamental designs
- Can file provisional or non-provisional applications for utility inventions but provisional applications do not issue directly into patents



PATENTS: MISCONCEPTIONS ABOUT PROVISIONAL PATENT APPLICATIONS

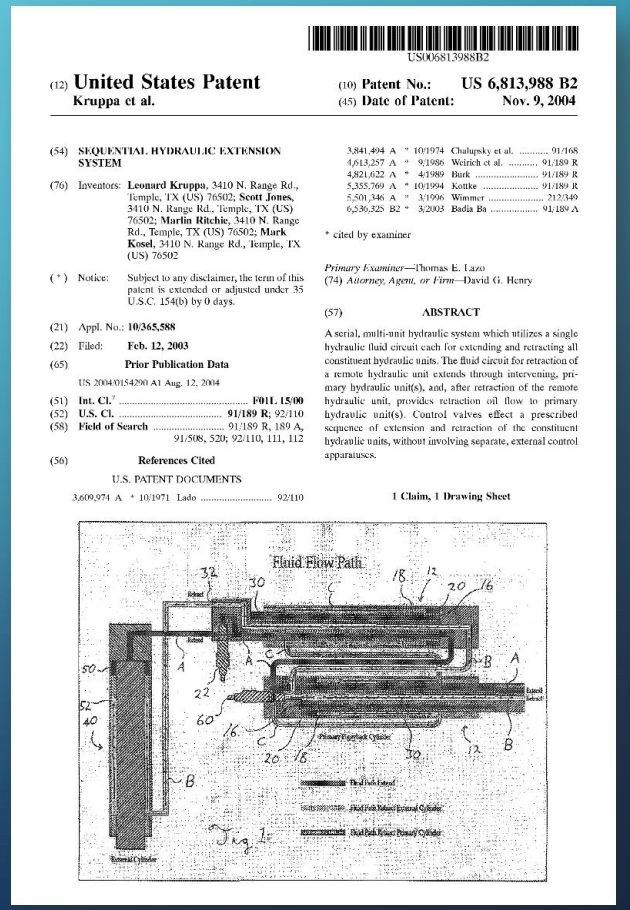
- Erroneous belief that a provisional patent application is a patent
- Failure to appreciate need to convert provisional application within 1 year to get benefit of provisional filing date





PATENTS: IMPROPERLY WRITTEN APPLICATION ALMOST AS BAD AS NO APPLICATION AT ALL

- Failure to describe invention in sufficient detail
- Failure to claim invention properly
- Over-describing prior art



US006813988B2

(12) **United States Patent**
Kruppa et al.

(10) **Patent No.: US 6,813,988 B2**
(45) **Date of Patent: Nov. 9, 2004**

(54) **SEQUENTIAL HYDRAULIC EXTENSION SYSTEM**

(76) Inventors: **Leonard Kruppa**, 3410 N. Range Rd., Temple, TX (US) 76502; **Scott Jones**, 3410 N. Range Rd., Temple, TX (US) 76502; **Marlin Ritchie**, 3410 N. Range Rd., Temple, TX (US) 76502; **Mark Kosel**, 3410 N. Range Rd., Temple, TX (US) 76502

(*) Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 0 days.

(21) Appl. No.: **10/365,588**

(22) Filed: **Feb. 12, 2003**

(65) **Prior Publication Data**

US 2004/0154290 A1 Aug. 12, 2004

(51) **Int. Cl.**[7] **F01L 15/00**
(52) **U.S. Cl.** ..... **91/189 R**; 92/110
(58) **Field of Search** ..... 91/189 R, 189 A, 91/508, 520; 92/110, 111, 112

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* cited by examiner

Primary Examiner—Thomas E. Lazo
(74) *Attorney, Agent, or Firm*—David G. Henry

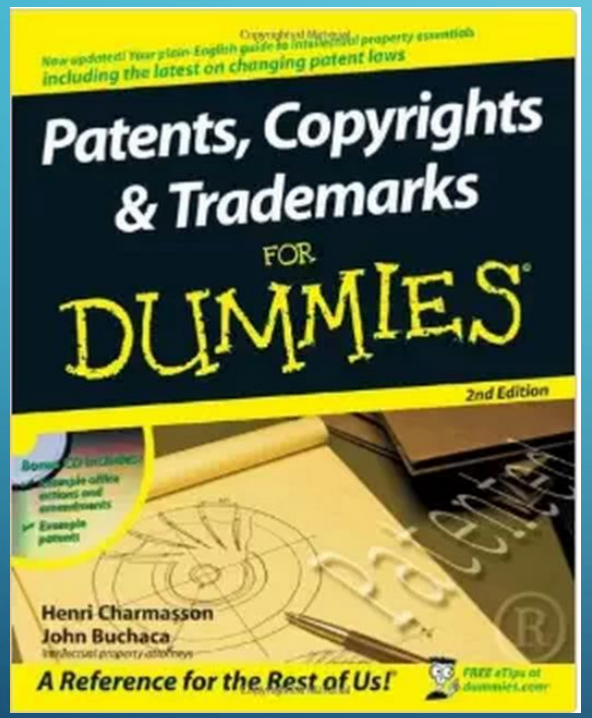
(57) **ABSTRACT**

A serial, multi-unit hydraulic system which utilizes a single hydraulic fluid circuit each for extending and retracting all constituent hydraulic units. The fluid circuit for retraction of a remote hydraulic unit extends through intervening, primary hydraulic unit(s), and, after retraction of the remote hydraulic unit, provides retraction oil flow to primary hydraulic unit(s). Control valves effect a prescribed sequence of extension and retraction of the constituent hydraulic units, without involving separate, external control apparatuses.

1 Claim, 1 Drawing Sheet



legalzoom



LegalForce
Trademarkia

WORLD PATENT MARKETING

WHAT IS A TRADE SECRET?

- Protect confidential information that gives company competitive edge
- No formal registration requirement
- Reasonableness for maintenance
- Trade secrets usually endure as long as the information is kept secret





WHAT IS PROTECTABLE AS TRADE SECRET?

- Manufacturing processes
- Ideas
- Manufacturing drawings
- Software
- Chemical formulae and processes





TRADE SECRET CONSIDERATIONS

Commercial Life of Product	Reverse Engineering
Independent Development	Tipping Off Competitors
Type of Subject Matter/Industry	Ease of Keeping Secret
Time Needed to Obtain Patent	Economic Effects

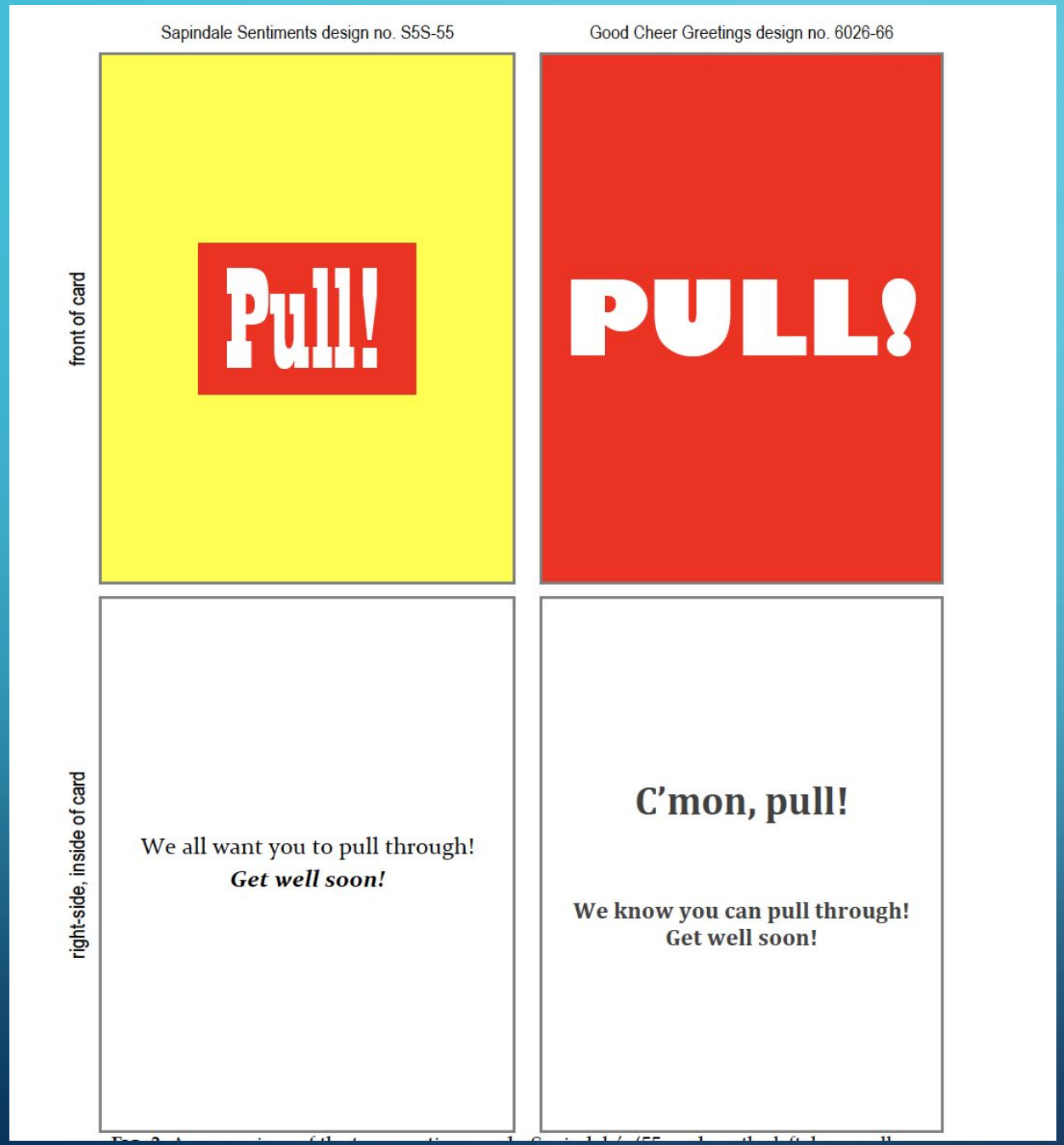
TRADE SECRETS – REASONABLE MEASURES

- Limit digital and physical access to confidential information to employees who need it
- Have written company policy restricting disclosure of confidential information
- Conduct exit interviews with departing employees to remind them about their confidentiality obligations
- If feasible, non-disclosure agreements with customers and vendors who receive confidential information



ISSUE SPOTTING #1

- Good Cheer scientist developed new kind of polymer that darkens in color when it is pulled or stretched. Darkening reverses when polymer relaxes.
- Good Cheer wants to use new polymer in greeting card. Develops new greeting card – when recipient "pulls," text appears on inside of card.
- Turned into a gag where recipient is prompted to pull more than once to reveal text ((1) C'mon, Pull; (2) We Know You Can Pull Through).
- Now accused of plagiarism (copyright infringement) – demand to cease and desist manufacture and sale of greeting card; also accused of trademark infringement for card design to be unveiled next month



1. Is there anything patentable?
2. Is anything protectable by copyright? Can there be infringement?
3. Can the card be protected by trademark?

ISSUE SPOTTING #2

- Good Cheer executive goes to competitor's hometown to recruit key creative and marketing personnel – get know-how to reverse market losses
- Executive given flash drive with label ("confidential financial data, greeting card designs, distribution negotiation spreadsheets, audio chip designs")
- Copied data to new flash drive and used data to win back market penetration

1. Is there possible copyright infringement for copying the data from the flash drive?
2. What are the trade secret issues and is there actionable misappropriation?

QUESTIONS?

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