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## What's Your Intellectual Property? A Meeting With In House counsel

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## VAR – Our current product

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## Launching a new product, what do we do now?

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## What is a patent?

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- A patent is a business tool.
  - Quid Pro Quo
  - “Exclusive” Legal Right
  - Reduces Investment Risk
  - A “Medium” for Commercializing Discoveries in the Lab
  - ... other



## What is (and isn't) patentable?

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- Patentable (???) –  
“Anything under the  
sun made by man”



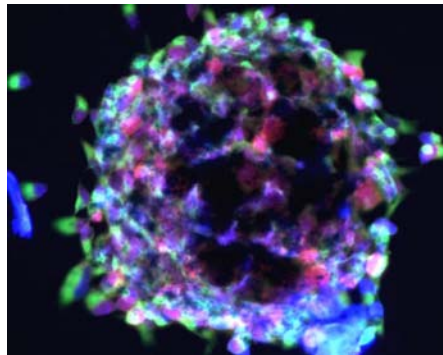
- Not patentable –  
Algorithms, Laws of  
Nature, Abstract  
Ideas
  - “Alice”



## Requirements to Get a Patent

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Useful  
Novel  
Non-obvious  
Written  
description  
Best mode



# A Variety of Patentable Inventions

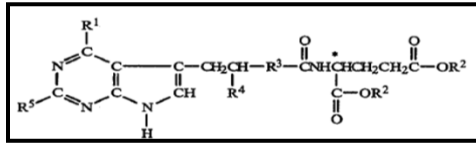
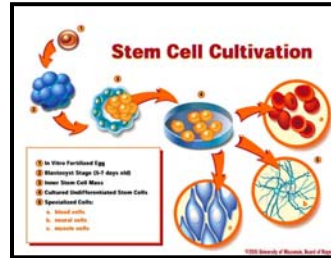
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Machines & Devices

Processes

Articles of manufacture

Compositions of matter



# Our Client's Product

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## FINNISH MYTHOLOGY

The Gods of Finland & Lapland...

### #

INTRO

Finnish mythology > Finnish Gods list

AKKA

■ Finnish Earth Goddess

Also known as MAAN-EMO, MAA-EMOINEN, RAUNI, RAVDNA, RDOONIKKA

**Finnish Earth Mother Goddess**

The consort of **UKKO**, she is an empowering female deity who provides feminine fertility, strength and sexuality. She is also the Goddess to call upon for earth magic and channeling.

### ↻

EXPLORE

### ⚡

FINNISH GODS

# Functions of a Trademark

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- Indicates the **source or origin** of goods or services
  - Do you need to know the source?
  
- Assures consumers of the **quality** of goods bearing the mark
  - Does the level of quality matter?
  
- Creates business **goodwill** and brand awareness
  - What is goodwill?

# Choosing and protecting a mark

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- Word marks
- Slogans
- Product configurations
- Product design
- Color
- Smells



# What isn't a trademark

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- Merely descriptive terms
- Functional shapes
- Generic Words
- Instructional expressions
- You can lose trademark rights if you allow your mark to become generic!

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# TM Clearance & Opinion

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## Why conduct a search?

- To find out if the proposed mark is identical or similar to another mark already in use.
- To determine whether it can be registered
  - Is it a strong or weak mark?
  - Has the Trademark Office registered similar marks?
- To determine whether it fits the terms of the USPTO requirements (Section 2 of the Lanham Act, 15 U.S.C. 1052) (e.g., descriptiveness, surnames).

# Clearances

Check on third party marks that may be considered confusingly similar

- In the USPTO
- At common-law
- On the internet
- As a business name

Degree of search is often dependent on a company's threshold for risk

Searching your mark

Pick a few options

Look at databases for identical marks

Look for "confusingly similar marks"

Common law use

Brand extensions

United States Patent and Trademark Office  
Home Site Index Search FAQ Glossary Guides Contacts eBusiness eLitig alerts News Help

Trademarks > Trademark Electronic Search System (TESS)

TESS was last updated on Mon Oct 17 03:21:57 EDT 2016

TESS Home New Lists Structure Fees Forms Renewals SEARCH GO Print List Next List IMAGE LIST Bottom HELP  
Logout Please logout when you are done to release system resources allocated for you.

Start List At:  OR Jump to record:  10 Record(s) found (This page: )

Refine Search [akka] [COMB]

Current Search: S1: [akka] [COMB] docs: 10 occ: 27

Serial Number	Reg. Number	Word Mark	Check Status	Live/Dead
1	06419707	AKKA'S	TSDR	LIVE
2	05816102	AKKA	TSDR	LIVE
3	05816117	AKKA	TSDR	LIVE
4	05593988	AKKA SOCCER	TSDR	LIVE
5	05593970	AKKA SOCCER	TSDR	LIVE
6	79122678	AKKA	TSDR	LIVE
7	77211005	AKKA	TSDR	LIVE
8	77324343	AKKA	TSDR	LIVE
9	76514223	AKKA	TSDR	DEAD
10	73798318	AKKA	TSDR	DEAD

TESS Home New Lists Structure Fees Forms Renewals SEARCH GO Print List Next List IMAGE LIST Top HELP



## Advantages of Federal Trademark Registration

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- Presumption of ownership and rights against third parties
- Ability to use the ® symbol on the goods or services
- Constructive notice to third parties of rights
- National protection
- Can file without use based on bona fide intent to use
- Record with U.S. Customs to prevent infringing goods from entering the U.S.
- Enforcement against counterfeits
- Basis for foreign trademark applications

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## What do you want to protect

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- Trademark?
- Package?
- Bottle Design?
- Logo – on bottle?
- Slogan?
- Advertising materials?
- Brand extensions?



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## United States Trademark Application

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- Basis
  - Intent to use (ITU)
  - Use
  - Foreign filing
- Ownership
- Goods/services
  - Classified according to type of goods under the Nice Convention
- Specimen of use
  - Used on or in connection with the sale of goods or service
  - Not required for ITU

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## What is use?

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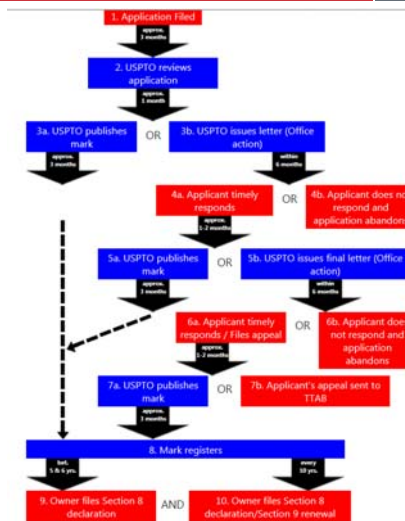
- Interstate commerce
- In connection with the sale of a product
  - On the product
  - In a catalog where the product is offered for sale
  - On a website where the product is available for purchase, with the shopping cart
  - For a service – a website or promotional literature, provided that the service is currently offered

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## How Long Does It Take To Get A Federal Trademark Registration

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Usually from  
9-15 months



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## Rolling out protection Internationally

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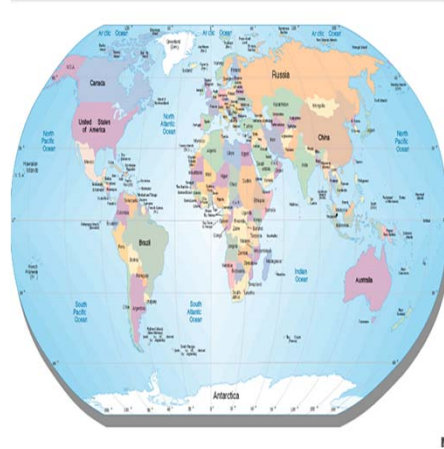
- Can file in individual countries
- May file in the EU under a single application
- May file under the Madrid Protocol to extend protection to designated countries
  
- What to look for:
  - Place of sale
  - Place of intended sale
  - Place of manufacture
  - Noted places for counterfeiting
  - Places for competition in the marketplace

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# International Registration

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- Rights are territorial
- Laws are different
- Use may not be required at time of filing or initial registration
- Consider meaning of terms and pronunciation
- May require additional country clearance searching



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# Enforcement

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- In the U.S., action may be brought in Federal or State Courts or Administrative agencies (ITC)
- Infringement of registered or common law rights
- May be based on a claim of false advertising or false association
- Actions strictly on registrability are brought before the Trademark Trial and Appeal Board of the USPTO
- ITC proceedings to exclude the product from entering the country
- In foreign countries, check with foreign counsel on procedures

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# COPYRIGHT LAW

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## Protection for:

- **Original** works of expression
- Contained in **tangible** form
- From the date of creation in **fixed** form

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# Examples

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books



catalogs



musical compositions



recordings

paintings



sculpture



software



photo



Film



choreography



architectural designs



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## A Bundle of Rights



Reproduction



Derivative Works



Transmission



Distribution



Performance



Public Display

## Think about

- Artwork on packaging
- Advertising – print and media
- Design of logo



## Who Owns the Copyright

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Copyright typically vests in the “author” of the work  
- one who created the work

Note: Possession is not the same as ownership

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## Who owns the copyright

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- Copyright typically vests in the “author” of the work. The person who creates the work.
  - Exceptions: work for hire in the scope of employment
  - Works assigned to the company by third parties

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## Fair use: 17 U.S.C. § 107

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“...[T]he fair use of a copyrighted work, including such use by reproduction in copies or phonorecords . . . , for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright.”

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## Copyright Clearance

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- Not typical to search
- The factors for infringement are access to the work and substantial similarity
- Take care with “inspirations”

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# Copyright Registration

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No need to register a copyright

Advantages to registration

- Must register to sue for infringement (*Fourth Estate*)
- Registration before violation provides alternate basis for statutory (as opposed to actual) damages

Copyright notices should be applied in all cases:

©; Copr; or "Copyright" with year of publication

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# Protection against infringement and counterfeiting

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- Protect against infringements and counterfeits by:
  - Record registered trademarks and registered copyrights with U.S. Customs
  - File for trademarks in foreign countries and record registrations in foreign countries
  - Register your copyright in the U.S., and internationally, where possible.
  - Mark your products with the appropriate trademark symbol and copyright symbols
  - Enter into agreements with vendors, distributors and manufacturers that detail ownership of rights and prohibitions against trafficking in unauthorized products

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# Licenses and Assignments

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- Licenses to third parties who want to use your marks and copyrighted materials
- Assignments to and from third parties who:
  - Are transferring rights in IP – for example trademarks
  - Are transferring rights in IP – for example artistic works that the company wishes to use

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# Loss of Rights

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- Failure to Police
- Improper licensing
- Improper assignment
- Failure to maintain registration
- Non-use

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