



What Business and Technology Professionals Need to Know About Intellectual Property

How and Why to Protect Intellectual Property

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About the Presenter



Roger Masson is an engineer and intellectual property (IP) lawyer who helps individuals and organizations maintain their competitive advantages by protecting their innovations.

IP-Protectable Competitive Advantages



- Reputation or brand
- Better products
- Lower costs
- Know how
- Barriers to entry

Agenda



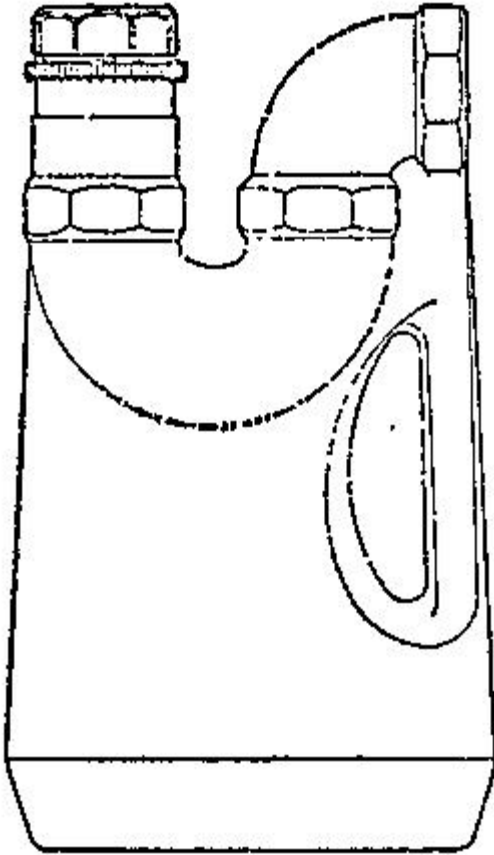
- **Trademarks – everyone has them!**
- Patents
- Copyright and
- Trade Secrets/Confidentiality
- Best time to capture your IP

Trademark — What Does It Protect?



- It protects *distinctive*
 - Names and logos (trademarks or service marks)
 - Packaging or decor (trade dress) and
 - Product appearance (trade dress)
- "Distinctive" = The trademark *signifies* the source of the product or service to consumers.
- The trademark prevents the use of confusingly similar marks on similar or related products.
- The trademark can even protect domain names.

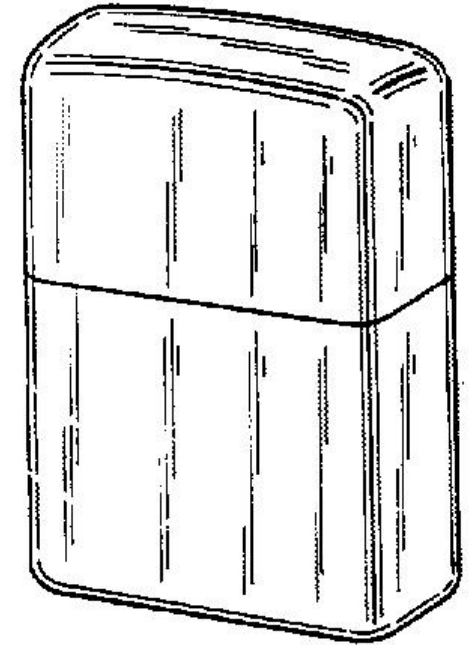
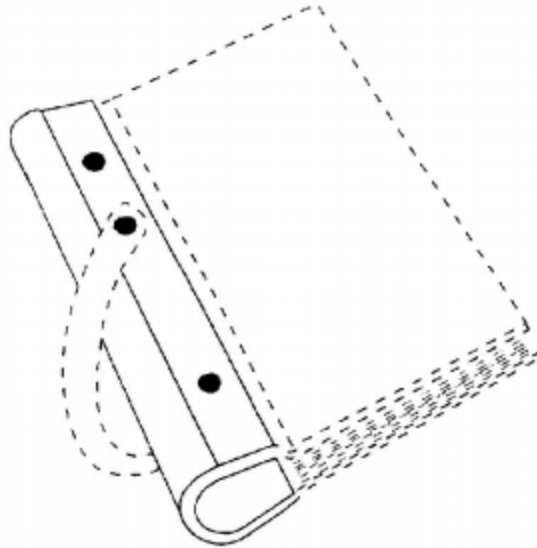
Trademark — Distinctive Packaging Examples



Trademark — Distinctive Packaging or Décor Examples



Trademark — Distinctive Product Examples



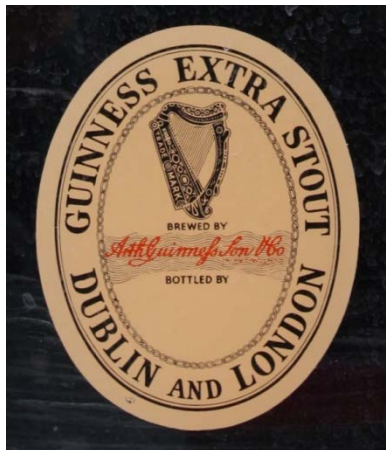
Strong Word and Logo Marks



- Suggestive, arbitrary and fanciful marks are strong



- Marks that started weak, but became strong



Weak Marks



- Descriptive marks are weak
 - Avoid selecting a descriptive mark.
 - But they can become protectable when people recognize the mark as a brand rather than a description.
- Generic marks are never protectable so avoid choosing one.
 - Aspirin
 - The Ale House

How to Protect Your Mark



- United States:
 - By use
 - By registration
- Foreign:
 - Often registration only
 - Notable exceptions Canada & United Kingdom
 - Good idea to file in advance of sales in country because others could file.

Registered Trademark Certificate



United States of America United States Patent and Trademark Office



Reg. No. 4,333,480

Registered May 14, 2013

Int. Cl.: 37

SERVICE MARK

PRINCIPAL REGISTER

SHARKEY'S AMAZING CAR WASH LLC (ILLINOIS LIMITED LIABILITY COMPANY),
DBA SHARKEY'S CAR WASH
5600 N. NEW WILKE ROAD
ROLLING MEADOWS, IL 60008

FOR: AUTOMOBILE CLEANING AND CAR WASHING; CAR WASHING, IN CLASS 37 (U.S. CLS. 100, 103 AND 106).

FIRST USE 12-1-2010; IN COMMERCE 12-1-2010.

THE MARK CONSISTS OF THE WORD "SHARKEY'S" ABOVE AND PARTLY BEHIND AN IMAGE OF A SHARK CAUSING A SPLASH OF WATER.

SER. NO. 85-226,735, FILED 1-26-2011.

MICHAEL WIENER, EXAMINING ATTORNEY



Benefits of Trademark Registration in the United States



- Establishes nationwide rights
- Can use ® to deter competitors
- Trademark Office will refuse to register competitor's confusingly similar mark.
- Is evidence of ownership and validity.
- After five years on the primary register, your TM can become "incontestable."
- Possibility of treble damages and attorney fees in a lawsuit.

What Can Happen If You Don't Register



- Without a registration, your TM rights are generally limited to the area where your product is distributed or your services are provided.
- You can be prevented from expanding use of your TM into new territories.
- You could be forced to change your brand and lose much good will.

Trademark Registration Requirements

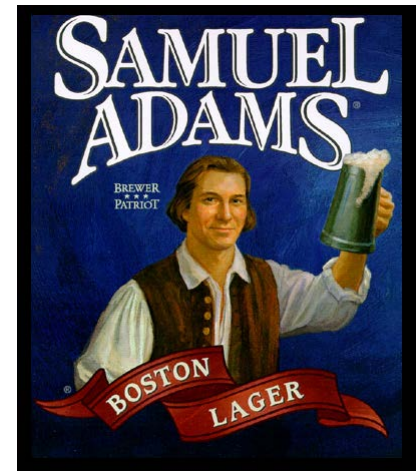


- Two kinds of applications typically:
 - "In use" application for marks that are already being used in interstate commerce
 - Intent to use application if there is a bona fide intention to use the mark in interstate commerce. A TM cannot issue until there has been use in commerce.
- Application cost: \$800-\$1,000 plus \$275 for additional classes
- Specimen showing use
- Entity should be formed in advance of filing generally.

Trademarks — Parting Comments



- Protection generally lasts until you stop selling products bearing the mark
- DON'T:
 - Use someone else's mark or a confusingly similar one in the same or related product/service area
 - Use a famous mark, e.g., McDonald's or IBM, even in an unrelated area
 - Use a famous person's name without their permission unless they are long dead.



Agenda



- Trademarks and Service Marks
- **Patents**
- Copyright
- Trade Secrets/Confidentiality
- Best time to capture your IP

Patents — Utility and Design Patent Commonalities



- No protection exists without obtaining a patent, which offers protection for a limited time
- Inventors are initial owners of patent rights.

Tip: Employment contracts should automatically assign inventions to employer.

- Foreign protection is available
- Gives a right to exclude others

Issued Patent



US008919610B2

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

(10) **Patent No.:** **US 8,919,610 B2**
(45) **Date of Patent:** **Dec. 30, 2014**

(54) **VACUUM BOTTLE STOPPER FOR WINE AND METHOD**

USPC 222/152, 563, 554, 566; 215/355, 296; 141/65, 8, 7
See application file for complete search history.

(71) Applicant: **Vinum Corporation**, Oak Brook, IL (US)

(56) **References Cited**

(72) Inventors: **Jean E. Haley**, Oak Brook, IL (US); **James D. Ryndak**, Barrington Hills, IL (US); **Roger M. Masson**, Oak Park, IL (US)

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(73) Assignee: **Vinum Corporation**, Oak Brook, IL (US)

FOREIGN PATENT DOCUMENTS

(*) Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 48 days.

FR 2717152 9/1995
OTHER PUBLICATIONS

(21) Appl. No.: **13/840,344**

International Searching Authority, International Search Report and Written Opinion, International Application No. PCT/US2014/029512, Aug. 5, 2014.

(22) Filed: **Mar. 15, 2013**

Primary Examiner — Lien Ngo

(65) **Prior Publication Data**
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(74) *Attorney, Agent, or Firm* — Hinshaw & Culbertson LLP

(51) **Int. Cl.**
B67D 1/08 (2006.01)
B65D 39/00 (2006.01)
B65B 31/04 (2006.01)

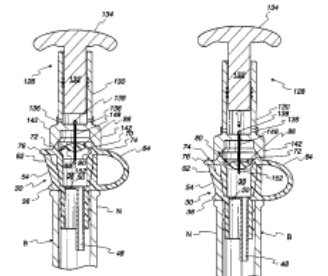
(57) **ABSTRACT**

A stopper for wine, a method of preserving wine, and a method of serving wine from a bottle stored in a vacuum are disclosed. The stopper has a vacuum valve in a vacuum indicator in a removable cap. The vacuum valve has a self-closing passageway due to the passageway traversing an elastomeric material. The vacuum indicator moves in response to vacuum and reveals a marking on a valve opener when a desired vacuum is achieved. The stopper may have a filter, which also aerates. The method of preserving wine includes installing the stopper in the neck of the bottle and withdrawing air from the bottle through the stopper. The method of serving wine includes releasing vacuum from the bottle by unseating the removable cap, removing the cap and pouring wine through the stopper. Pumps for the stopper are also disclosed.

(52) **U.S. Cl.**
CPC **B65D 39/0058** (2013.01); **B65B 31/047** (2013.01); **B65D 39/00** (2013.01)
USPC **222/152, 222/563; 215/355; 141/56**

(58) **Field of Classification Search**
CPC B65D 39/00; B65D 39/0017; B65D 39/0011; B65D 39/007; B65D 39/0076; B65D 39/0882; B65D 39/0088; B65D 39/0023; B65D 39/0052; B65B 31/047; B65B 31/08

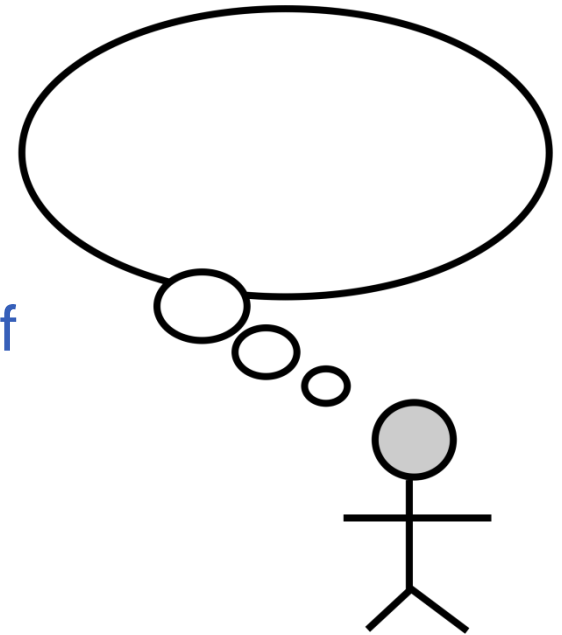
21 Claims, 9 Drawing Sheets



Utility Patents



- Protects an invention for 20 years from date of application generally
- Inventions can be "any useful process, machine, manufacture or composition of matter."
- Examples: Equipment, bacteria, medicines, software, production processes



Utility Patents (*cont'd*)

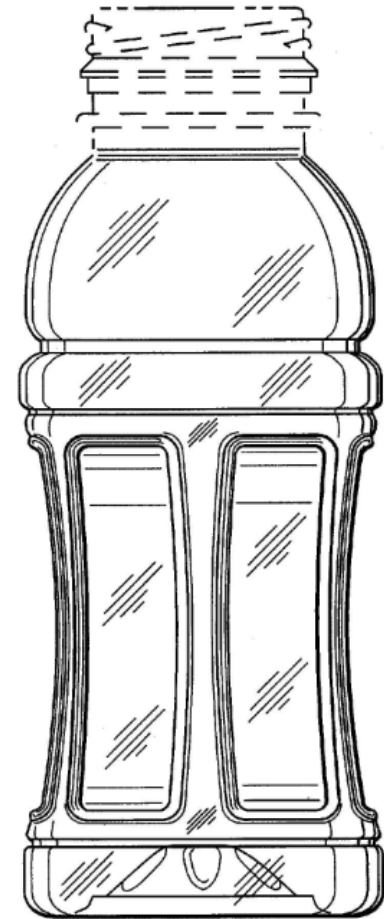


- Consider
 - if excluding others gives you enough of a competitive advantage.
 - invention is novel and non-obvious and
 - less than one year has passed since a public disclosure, using, selling or offering to sell the invention (if foreign countries are involved you likely don't have a year)
- Patentability searching is often a good idea and typically costs \$1,000–3,000.
- Typical application cost in the United States is \$ 6,000–12,000.

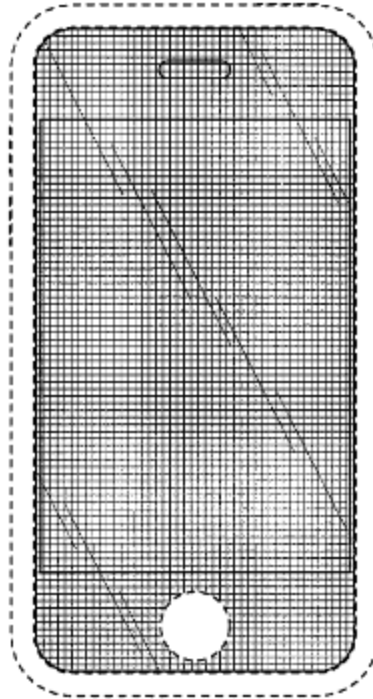
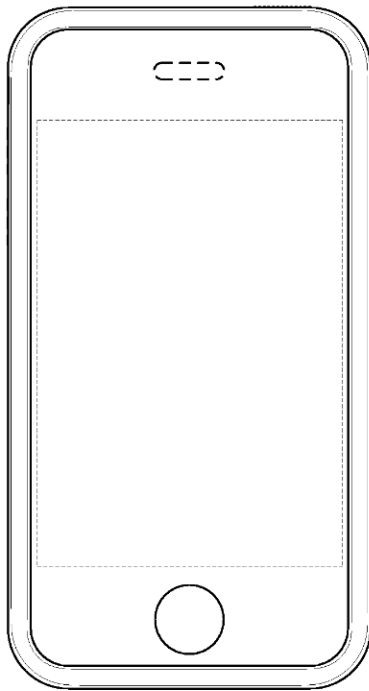
Design Patents



- Protects the *appearance* of an article of manufacture
- Consider filing if your article of manufacture is unique in the market place and you haven't "publicly disclosed" the article more than six months ago.
- Application consists primarily of figures
- 15-year life from date of grant
- Design patent has to be novel, non-obvious, enabled, and definite - low hurdles in practice
- Typical application cost \$2,500–5,000



Design Patents (*cont'd*)



Agenda



- Trademarks and Service Marks
- Design Patents and Trade Dress
- **Copyright**
- Trade Secrets/Confidentiality
- Best time to capture your IP

Copyright — Making Sure You Have The Rights You Need



- Who owns the art work/copyright in your
 - Logo
 - Label or
 - Website?
- If created by an employee within the employee's scope of employment then it is owned by the employer
- If created by a contractor and there is no contract addressing ownership then it is the contractor's.
- Has an IP lawyer reviewed your contracts?

Copyright Examples



- Traditional examples: music, paintings, sculptures & books.
- Modern examples: forms, websites, software, toys, cheerleader outfits, fabrics, architectural plans & instruction manuals.
- If you are in these industries, consider registering your copyrights.

Benefit of Copyright Registration



- Application for registration or registration is necessary for an infringement suit
- If registered within five years of publication, then it is evidence of validity of copyright and the facts stated therein
- Eliminates innocent infringement defense to damages
- Application is necessary for Customs and Border Protection to intercept infringing imports

What Is a Copyright? What Does It Protect?



- Definition: "[1] Original works of authorship [2] fixed in any tangible medium or expression ... from which they can be perceived, reproduced or otherwise communicated"
- Both [1] and [2] are low hurdles
- Protects expression, not ideas

Copyright Protection



- Protection is automatic upon "fixation"
- Protection typically lasts 95 years from publication
- Exclusive right to
 - Reproduce, distribute & perform copyrighted work
 - Prepare derivative works
- Prevents people with "access" to work from making something "substantially similar."
- Damages – statutory damages (up to \$150,000 per work) are helpful in small cases

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- Trademarks and Service Marks
- Design Patents and Trade Dress
- Copyright
- **Trade Secrets/Confidentiality**
- Best time to capture your IP



Trade Secrets — Definition

- Trade secret means information, including a formula, pattern, compilation, program, device, method, technique, or process, that:
 - derives independent economic value, actual or potential, from not being generally known to, and not being readily ascertainable by proper means by, other persons who can obtain economic value from its disclosure or use, and
 - is the subject of efforts that are reasonable under the circumstances to maintain its secrecy.
- Trade secrets can be protected *forever* if kept secret.
- Confidential information that is not a trade secret may still be protectable, primarily by contract.

Trade Secrets — Examples



- Know how
- Business/marketing plans
- Customer lists
- Supplier lists
- Raw material lists
- Manufacturing processes
- Recipes
- Typically does not cover devices sold to the public because the devices divulge the secrets, but can cover software

Trade Secrets — How to Protect



- Employment agreements
- Confidentiality/non-disclosure agreements
- Policies:
 - Password protection
 - Need to know – limiting access to those with need to know
 - Limiting tours / hiding details from view

Trade Secrets — What Is the Protection



- Trade Secret law protects against misappropriation by improper means
- Unlike patents:
 - Others may be allowed to have same secrets
 - Does not protect against independent invention
 - Does not protect against reverse engineering

Trade Secrets — Sources of Leaks



- Marketing
 - Tours
 - Product attributes/differentiation
 - Branding
- Culture of openness – disclosure to suppliers or partners
- Employee turnover

Plugging the Leaks with Confidentiality Agreements



- Suppliers/contractors
- Employees
 - Also have employees assign their inventions, whether patentable are not, to employer if made using employer's resources
- Owners
- Joint ventures/collaborations
 - Who owns any IP generated?

Non-Compete Agreements for Protection of Trade Secrets



- Sign up to attend the Rockford Seminar Series April 4 Presentation: "Drafting and Enforcing Post-Employment Restrictive Covenants on Competition"

Capturing Your IP



- Best times:
 - Starting a New Company/Business Plan
 - During Product Development/Improvement
 - Before a New Product or Service Launch
- Hopefully not too late
 - Now?
 - New Competition/New Competitor Products



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