A. Overview of Intellectual Property

Intellectual property: intangible assets such as musical, literary, and artistic works; discoveries and inventions; and words, phrases, symbols, and designs. Common types of intellectual property rights include copyright, trademark, patents, trade dress, and in some jurisdictions trade secrets.

Objectives of intellectual property law: first, to "promote progress." Additionally, financial incentive (briefly licensed monopolies), economic growth, and morality.

Top ten list of IP protection:
1. Do not publicly disclose your invention to anyone uninvolved in its development until a patent has been filed. Use non-disclosure agreements.
2. Perform infringement searches before bringing your patented idea to market.
3. Advise your patent attorney of prior art.
4. Carefully read and understand the language regarding ownership of inventions when you begin new employment.
5. Confirm your logo/name are dissimilar from those of related businesses.
6. Require vendors to agree to no IP claim in projects related to your business.
7. Understand theft requirements.
8. Document all development progress to protect yourself in future disputes.
9. Don’t copy someone else’s expression of a concept.

B. Patents

Patent purpose: 35 U.S.C. §101 allows patents "for any new and useful process, machine, manufacture, or composition of matter." Not patentable: laws of nature, physical phenomena, and abstract ideas. (e.g. a newly discovered but naturally occurring mineral, Einstein’s E = mc², and Newton’s law of gravity.)

Novelty: 35 U.S.C. §102 invalidates patents if they have been: (1) previously patented, (2) described in print (published), (3) in public use, (4) on sale, (5) otherwise available to the public (A1). These activities must occur prior to the effective filing date of the claimed invention (the first patent of a particular idea becomes prior art to other inventions). (A2). The inventor/joint inventor are protected from patent invalidation if the disclosure was made 1 year before or less effective filing date of the patent (B1).

Obviousness: 35 U.S.C. §103 is judged from the perspective of "a person having ordinary skill in the art to which [the subject matter of the patent] pertains" (35 U.S.C. 103(a)). This means that a patent may not be obtained if the inventions are obvious to a person who has neither a genius/leading expert in the field of subject matter to which the patent applies nor an amateur/layperson. When a genius/leading expert in the field of subject matter to which the invention pertains is needed by the court system, which the patent applies nor an amateur/layperson. When a genius/leading expert in the field of subject matter to which the invention pertains is needed by the court system, which the patent applies.

Patent history: The English legal system became the foundation for modern IP in common with other law heritage, including the United States. The first Patent Act of the U.S. Congress was passed in 1790: "An Act to promote the progress of useful Arts."

Patent limitations: A patent does not give a right to make or use or sell an invention. Rather, a patent provides, from a legal standpoint, a right to exclude others from making, using, selling, offering for sale, or importing the patented invention for the term of the patent, which is usually 20 years from the filing date subject to the payment of maintenance fees. A given patent is only useful for protecting an invention in the country in which that patent is granted. Additionally, there are international treaty procedures that centralize some portion of the filing and examination procedure (Patent Cooperation Treaty provides a unified procedure for filing patent applications to protect inventions in each of its states).

Patent priority: Patents, even with added elements (X+Y, etc.), have a 1 year deadline after their first filing (X) for priority. Priority periods: 6 months after the deadline and individual foreign PCT applications must be filed within 30 months of the original provisional filing (18 months after PCT filing/deadline).

Provisional patent applications: 12 month patents (2 month extension petitions available). Provisional patents must include the names of all the inventors and a written description of the invention complying with 35 U.S.C. §112. Prop. patents also require a filing fee and a cover sheet.

Non-provisional patent applications must be filed with a specification (and at least one claim for a design patent) for it to be accorded a filing date. The applicant has 3 years from the filing date of the application within which to file a patent. To file a provisional application, you must file the search fee, and examination fee, and pay the surcharge required by §1.16(f) to avoid abandonment.

Design patents are forms of legal protection granted to the ornamental design of a functional item 35 U.S.C. §173 states that the U.S. design patent term is 15 years (after May 2015). The Ordinary Design test is used to identify whether a particular product infringes a design patent. These protect appearance where utility patents protect use.

C. Trade Secrets

Trade secret means any part of any "scientific or technical information, design, process, procedure, formula, improvement, confidential business or financial information, listing of names, addresses, or telephone numbers, or other information relating to any business or profession which is secret and of value." A trade secret remains protected so long as it is kept secret per the qualifications for protection (potentially indefinite). If an action for misappropriation of a trade secret is desired, it must be brought to attention within three years of the discovery of the misappropriation. A company can protect itself through the non-compete and non-disclosure contracts with its employees (within the constraints of employment law, including only restraint that is reasonable in geographic and time scope). To qualify for protection as a trade secret, the information must be a secret, the information must have commercial value as a secret, and the owner must take a reasonable effort to maintain the secret.

Trade secrets by state: Although patents are protected under federal statutes, trade secret laws are determined by states and lack a unifying federal protection. In an effort to harmonize the specifics of copyrights generated during their employment ("work for hire" agreements have implicit copyright ownership assigned to the employer because the work was done for hire).

E. Trademarks

Trademark: word, phrase, symbol or design or a combination thereof that identifies and distinguishes the source of the goods of one party from those of others. The essential function of a trademark is to exclusively identify one's business or origin of products or services, so a trademark, properly called, indicates source or serves as a badge of origin. One can establish rights in a mark based on use of the mark in commerce, without a registration, but owning a federal trademark on the Principal Register provides benefits (easier foreign registration, recognition in federal court, use of federal registration symbol). For goods, "interstate commerce" generally involves sending the goods across state lines with the mark displayed on the good or the packaging for the goods. With services, "interstate commerce" generally involves offering a service to customers in another state or rendering a service that affects interstate commerce (restaurants, gas stations, and hotels). If you claim rights to use a mark, you may use the "TM" (trademark) or "SM" (service mark) designation to alert the public to your claim of a "common-law" mark. No registration is necessary to use a TM or SM symbol. Those symbols put people on notice that you claim rights in the mark, although common law doesn't give you all the rights and benefits of federal registration. You may only use the federal registration symbol if the legal ownership specifics of copyrights generated during their employment ("work for hire" agreements have implicit copyright ownership assigned to the employer because the work was done for hire).
AbbVie v. Janssen (written description requirement): AbbVie attempted to patent an entire genus without a truly representative set of species in their claims. Janssen used a different structure (varied heavy and light chains on an antibody) compared to AbbVie and didn’t infringe in doing so. 35 U.S.C. §112.

Alcon v. Barr (enablement, best mode): Barr didn’t infringe on Alcon because their PECO-containing prostaglandin formulation was too dissimilar compositionally. Alcon’s patents were unaffected by the lawsuit despite Barr’s claims of undue experimentation, as sufficient exemplary formulations were included in their written description. 35 U.S.C. §112.

Phillips v. AWH (claim construction): Phillips’ patent protecting his structures containing baffles for modular prison construction was clear to a POSITA that the baffles were not restricted to 90° angles. As such, AWH had infringed on Phillips’ intellectual property for several years by using their 90° baffles.

Festo (Doctrine of Equivalents; DOE): SMC started selling one-two way sealing rings and nonmagnetic sleeves, which seemed to infringe on Festo’s IP. By prosecution history estoppel, one cannot use the DOE for subject matter ceded by amendments (Federal Circuit set a complete bar in 2000 and the Supreme Court altered it in 2002 to a presumptive bar). With the presumptive bar, a patentee using DOE only has to show that the equivalent was impossible to forsee, that their amendment didn’t surrender the at-issue equivalent, or some other reason the patentee couldn’t recite the equivalent in their claims. 535 U.S. 722.

University of Pittsburgh v. Hedrick (inventorship): Doctors Katz and Llull at Pitt conceived of adipose-derived stem cells. They briefly collaborated with Hedrick, who started his own group at UCLA that went on to transdifferentiate these cells. Hedrick and his group didn’t conceive of the idea so they were eventually removed from the patent. 35 U.S.C. §116, 256.

Stanford v. Roche (assignments): The original inventor of a patent can ultimately assign the patent at their discretion. In Roche v. U.S. Vitro patent by Stanford’s Professor Holodniy, even though he had signed an agreement that Stanford would be assigned his inventions, 35 U.S.C. §261.

Intelect Wireless v. HTC (duty of disclosure): The Federal Circuit determined that Intellect Wireless engaged in a pattern of conceiving to correct false statements, showing materiality and intent to deceive the USPTO. Their invention had been fictitiously reduced to practice via a brochure and “commercialization.” IW lost their patents and HTC was free to continue using their call ID service. 37 C.F.R. 1.56.

Anascape v. Nintendo (subject of priority): Anascape’s claims weren’t valid in terms of filing date because they were trying to get a continuation in part (CIP) priority for a patent on one-joystick controllers. The original patent was exclusive in its language so Nintendo received prior art status and Anascape was denied their CIP claim. 35 U.S.C. §120, 121.

G. Non-presentation cases

Diamond v. Chakrabarty (patentability): Chakrabarty invented a new type of bacterium that contained some specific DNA (that he had placed in the organism) that allowed it to break down crude oil. (Bacteria that could eat oil, essentially.) The USPTO (Diamond was commissioner) allowed Chakrabarty’s process claim to the procedure for the bacteria and the manufacture claim for an inoculum (floating carrier material) that served as a delivery system for the bacteria. (2 claims.) The Supreme Court asserted that their task was to determine whether Chakrabarty’s bacterium should be legally considered a “manufacture” or a “composition of matter” within the meaning of the original statute (if the organism fell into either category, it would be patentable; if not, then it would fall into the open category of the previous court). Chakrabarty’s bacterium deemed a “product of human ingenuity.” Any concerns about the hazards of genetic engineering should’ve been addressed to the Administration or Legislature.

Myriad (patentability) patented “…human (breast and ovarian) (ca)ncer predisposing gene” or “(breast and ovarian) cancer predisposing gene” in isolated DNA and cDNA forms (no introns). The Association for Molecular Pathology, as the petitioner, requested the review. They were unhappy with the Federal Circuit Court’s ruling that both isolated DNA and cDNA were patent eligible, so they filed a certiorari. Claim 1 applied to naturally occurring DNA where the only description related to the material commerce. The Supreme Court found the claim to the isolated BRCA1 DNA coding sequence was invalid. Claim 2 applied to modified DNA (cDNA) that did not include introns, an important piece of naturally occurring DNA. As such, the claim to the non-naturally occurring cDNA was upheld.

Pfaff v. Wells (novelty, on-sale bar): Pfaff makes sock ears and fills purchase order for TI more than a year before, or April 19, 1981. 1980: Pfaff commenced practice via a brochure and “commercialization.” IW lost their patents and HTC was free to continue using their call ID service. 37 C.F.R. 1.56.

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A prior art reference (in any language) anticipates a claim if it discloses each and every limitation of the claim within its four corners. 35 U.S.C. §102(a). The meaning of the reference can be narrowed or broadened to the specific manner in which the invention was reduced to practice, however as long as the search party can identify a clear statement of materiality and intent to deceive the USPTO. Their invention had been fictitiously reduced to practice via a brochure and “commercialization.” IW lost their patents and HTC was free to continue using their call ID service. 37 C.F.R. 1.56.

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