

# The Nuts & Bolts of Intellectual Property



Presented By:  
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# The Nuts & Bolts of IP

## What is Intellectual Property (IP)?

- “Creations of the mind” – inventions; artistic works; designs, symbols & names used in commerce.
- 3 major pillars
  - Copyrights
  - Patents
  - Trademarks

# The Nuts & Bolts of IP

## Why IP is important:

- Sets you apart; makes you unique; lifts you out of the commodity business (little profit over inputs).
- The difference between “any knife” and “our knife”.
- Up to 2/3 of U.S. business assets are intangible.<sup>1</sup>
- More info: [http://www.wipo.int/sme/en/ip\\_business/](http://www.wipo.int/sme/en/ip_business/)

<sup>1</sup>[http://www.sonecon.com/docs/studies/0807\\_thevalueofip.pdf](http://www.sonecon.com/docs/studies/0807_thevalueofip.pdf)

# Copyrights

Protects “original works of authorship” fixed in a tangible medium.

- Copyright protection exists – © designation can be used – as soon as the “work” is “fixed”.
- No protection for ideas; must be “fixed”.

# Copyrights

No protection for “functional articles”.

- Divorce function from design.
- E.g. blade or handle designs – serve function or for ornamentation?

Registration & Search at [www.copyright.gov](http://www.copyright.gov) (copyrights controlled by Library of Congress).

Lifespan = Life (of author) + 70 years.

# Patents

Purpose: Promote innovation; grant limited monopoly as reward. But, remember, U.S. doesn't like monopolies.

Has its own, separate bar exam (like maritime)

Requires “hard” science degree (e.g. chemistry, engineering, physics).

Seek help . . . But, here's what you should know.

# Patents

## Two types

1. Utility – for a process or product that represents a useful improvement. The “traditional” patent.
2. Design – for a new, original & ornamental design of a product.

# Patents

## Utility Patent Registration Requirements

1. Novelty – New; no “prior art” . . . Anywhere
2. Non-obviousness – Not obvious to a person with ordinary skill in the industry; prevents monopoly over incremental improvements (tension between monopoly & innovation).



# Patents

Preliminary searching – [www.google.com/patents](http://www.google.com/patents).

Life span – 20 years.

Patent registrations (disclosure) vs. trade secret (maintain secrecy).

“Patent pending” – notice for retroactive damages.

<http://www.uspto.gov/patents-getting-started/general-information-concerning-patents>

# Trademarks

- A source identifier.
- Purpose = consumer protection.
- Can be a word, phrase, sign, symbol, design or “non-traditional” mark (e.g. color or sound).
- Includes “trade dress” – distinctive characteristics of a products’ appearance (e.g. design, packaging, etc.)

# Trademarks

How to acquire TM rights:

- Use (common law rights)
- Registration
  - States with Secretary of State
  - Federal with U.S. Patent & Trademark Office
    - [www.uspto.gov](http://www.uspto.gov)
- Lifespan – Perpetual; as long as in use.

# Trademarks

## Registrability Continuum (for “word marks”)

Highly registrable/protectable → Not registrable/protectable

Fanciful > Arbitrary > Suggestive > Descriptive > Generic

Xerox > Apple (computers) > Netscape > Sharp (TVs) > Xerox

Xerox shows danger of “genericisation”

# Trademarks

## Trademarks for logos & product designs.

Logos – Registrability determined by USPTO review for “confusingly similar” marks (also standard for infringement).

Product designs (aka trade dress)

- Non-functional (like design patent).
- Secondary meaning/acquired distinctiveness (not like design patent).

# Good Offense & Good Defense

## Good Defense:

- ▶ Why
  - ▶ Avoiding infringement claims & the associated costs & inconvenience.
  - ▶ Plus, being a good corporate citizen and a fair competitor.
- ▶ How
  - ▶ Have a working knowledge of IP – what is likely claimed by others in the market.
  - ▶ Pay attention to designations in the market place – ©, ®, TM, “patent pending”; etc.
  - ▶ Searches – USPTO.com; Copyright.gov; Google.com/patents.
  - ▶ Ask an expert. Seek advice.

# Good Offense & Good Defense

## Good Offense:

- ▶ Why
  - ▶ See slide 3 – Why IP is Important.
  - ▶ Build and secure the value of your business.
  - ▶ Help other businesses & competitors avoid infringement.
- ▶ How
  - ▶ Have a working knowledge of IP – what IP you are creating and own.
  - ▶ Use appropriate designations– ©, ®, TM, “patent pending”; etc.
  - ▶ Constant vigilance, investigations, enforcement actions.
  - ▶ Ask an expert. Seek advice.

# PILLARS OF BRAND PROTECTION

- ~ *Identify, Acknowledge & Register Intellectual Property*
- ~ *Constant Vigilance*
- ~ *Investigations*
- ~ *Enforcement*





# Identify, Register and Reinforce Intellectual Property

<b>WHAT</b>	<b>WHY</b>	<b>HOW</b>
<p>➤ Determine and Claim IP</p> <p>Knowing IP basics helpful here.</p>	<p>➤ Allows Protection</p> <p>Registrations always make protection easier even if not “essential” (e.g. unregistered copyright or common law TMs).</p>	<p>➤ State, Federal &amp; International Registrations</p> <p>➤ Marketing, Promotion &amp; Ads</p>

# CONSTANT VIGILANCE

<b>WHAT</b>	<b>WHY</b>	<b>HOW</b>
<ul style="list-style-type: none"><li>➤ Keeping you eyes open</li><li>➤ Keeping your ear to the ground</li></ul>	<ul style="list-style-type: none"><li>➤ Keeps you in the know</li><li>➤ Allows you to attack problems earlier</li></ul>	<ul style="list-style-type: none"><li>➤ Tradeshows</li><li>➤ Flea Markets/Festivals</li><li>➤ Auction Sites</li><li>➤ E-Commerce Website</li><li>➤ B2B Sites</li><li>➤ Web-based Searches</li><li>➤ Web Crawlers</li></ul>



# INVESTIGATIONS

<b>WHAT</b>	<b>WHY</b>	<b>HOW</b>
<ul style="list-style-type: none"><li>➤ Developing actionable intelligence</li></ul>	<ul style="list-style-type: none"><li>➤ Identify full threat, related parties, and information about future plans</li><li>➤ Guard down</li><li>➤ Assists law enforcement</li></ul>	<ul style="list-style-type: none"><li>➤ Standard &amp; Advanced Investigations</li><li>➤ Trademark Use</li><li>➤ Trademark Clearance</li><li>➤ Trap Purchase</li></ul>

**Case Study: Roger Cleveland Golf Company Inc v. Prince et al**



# ENFORCEMENT

WHAT	WHY	HOW
<ul style="list-style-type: none"><li>➤ Civil</li><li>➤ Criminal</li><li>➤ Administrative</li></ul>	<ul style="list-style-type: none"><li>➤ Obvious, BUT the trick is being effective</li></ul>	<ul style="list-style-type: none"><li>➤ Cease &amp; Desist Letters</li><li>➤ Web Shutdowns</li><li>➤ Policing Online Auctions</li><li>➤ UDRPs, DMCA take down</li><li>➤ Customs seizures</li><li>➤ Criminal prosecutions</li></ul>



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