

UNIT 6

Patents and Intellectual Property

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Types of Intellectual Property

Intellectual Property

Utility Patent

Design Patent

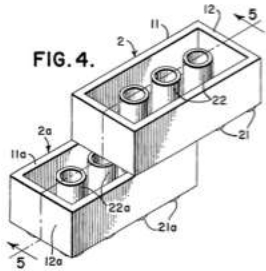
Plant Patent

Trademark

Copyright

Trade Secret

Geographical Indication



1. novel
2. useful
3. non-obvious

ornamental design only

new composition of matter

word or symbol

original expression of work

proprietary and useful

unique regional qualities

requires formal application

may be registered

not registered

registered

Trademark

- Valuable for building and protecting a brand
- A “mark” under which you sell goods and services

– House trademark 

– Trade dress 

– Product trademark 

– Service mark 

– Federal registration available in US (TM or SM → ®)

- Strength of trademark depends on distinction

– Generic 

– Descriptive 

– Suggestive 

– Arbitrary

iPad

– Fanciful



↓
generally
stronger

- Check availability at US trademark Database www.uspto.gov and at WIPO Global Brands Database www.wipo.int

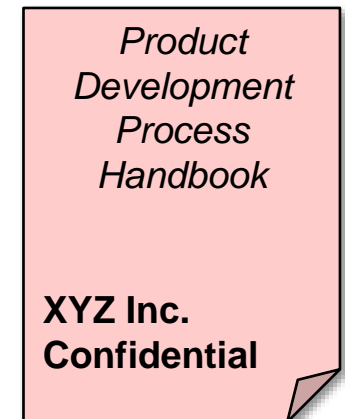
Copyright

- **The right to make copies**
 - Arises from simply creating a work
 - Protects the *expression* – not the idea
 - great for music, poor for software
- **Default copyright ownership**
 - Owned by author unless otherwise agreed (e.g. by employee or contractor agreement)
- **Open source**
 - For sharing and building
- Federal registration is a plus
- **© notice format is flexible**
 - Copyright © 2018, MyBiz, Inc., All Rights Reserved
 - © 2018 MyBiz
 - Copyright MyBiz



Trade Secret

- **Confidential information that is used for competitive advantage**
- Prevents, but does not block, others from developing similar knowledge
- **Protection varies by state and country**
- **Lasts as long as you can keep it secret**
- **Must actively work to protect trade secrets**
 - **Nondisclosure agreements**
 - Confidential markings
 - **Employee education**



Patent

- A **limited-time monopoly**, granted by government, in exchange for publicly sharing new, useful knowledge
 - 20 years from filing date in US, Europe, and many other countries
 - **Periodic maintenance fees** (on utility patents, **not plant or design**)
- Gives owner the **right to exclude others** from practicing their invention
 - Owner's right to practice may be limited by others' prior patent rights (e.g. when extending a patent with more specific claims)
- **Real estate analogy:**
 - Right to prevent trespassers
 - **Ownership ≠ right to use – limited by access rights, zoning, etc.**
 - **Claims of patent ≈ fence around property**
- Patent search:
 - US www.uspto.gov
 - US www.google.com/patents
 - Global www.wipo.int



Requirements to Obtain a Patent

- Patentable subject matter
- Not previously sold or publicly described
- **First to file**
- **Novel**
 - beyond what is already patented or known
 - **prior art must be cited**
- **Useful**
 - for some demonstrable need or value
 - initial **commercial success may demonstrate**
- **Not obvious**
 - **“to one of ordinary skill in the art”**
 - prior art **“teaches against”**
 - inventive, rather than simple modification

Patent Application

Patent application includes text and diagrams:


- **Field of the invention**
 - Describe the problem addressed
- **Background of the invention**
 - Describe the prior art
 - List advantages over existing methods
- **Detailed description**
 - Best mode: the best way to implement the invention
 - **Examples of use and modes** of implementation
- **Claims**
 - What exactly is the invention

Provisional patent application (optional)

- **Establishes date of filing before examination begins**
 - 1 year to file full regular application
 - Public disclosure allowed after provisional is filed

Chapter Example: David W. Coffin, Sr. US Pat.# 5,205,473 Coffee cup sleeve





US005205473A

United States Patent [19] [11] **Patent Number:** **5,205,473**

Coffin, Sr. [45] **Date of Patent:** **Apr. 27, 1993**

[54] **RECYCLABLE CORRUGATED BEVERAGE CONTAINER AND HOLDER**

[75] **Inventor:** David W. Coffin, Sr., Fayetteville, N.Y.

[73] **Assignee:** Design By Us Company, Philadelphia, Pa.

[21] **Appl. No.:** 854,425

[22] **Filed:** Mar. 19, 1992

[51] **Int. Cl.:** B65D 3/28

[52] **U.S. Cl.:** 229/1.5 B; 206/813; 220/441; 220/DIG. 30; 229/1.5 H; 229/DIG. 2; 493/296; 493/907

[58] **Field of Search:** 229/1.5 B, 1.5 H, 4.5, 229/DIG. 2; 220/441, 671, 737-739, DIG. 30; 493/287, 296, 907, 908; 209/8, 47, 215; 206/813

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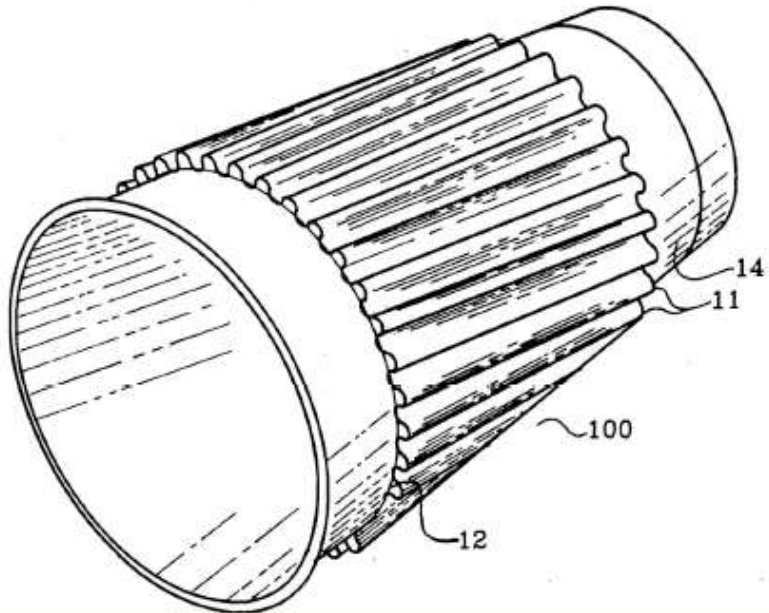
"The Wiley Encyclopedia of Packaging Technology", John Wiley & Sons, pp. 66-69, 1986.

Primary Examiner—Gary E. Elkins
Attorney, Agent, or Firm—Synnestvedt & Lechner

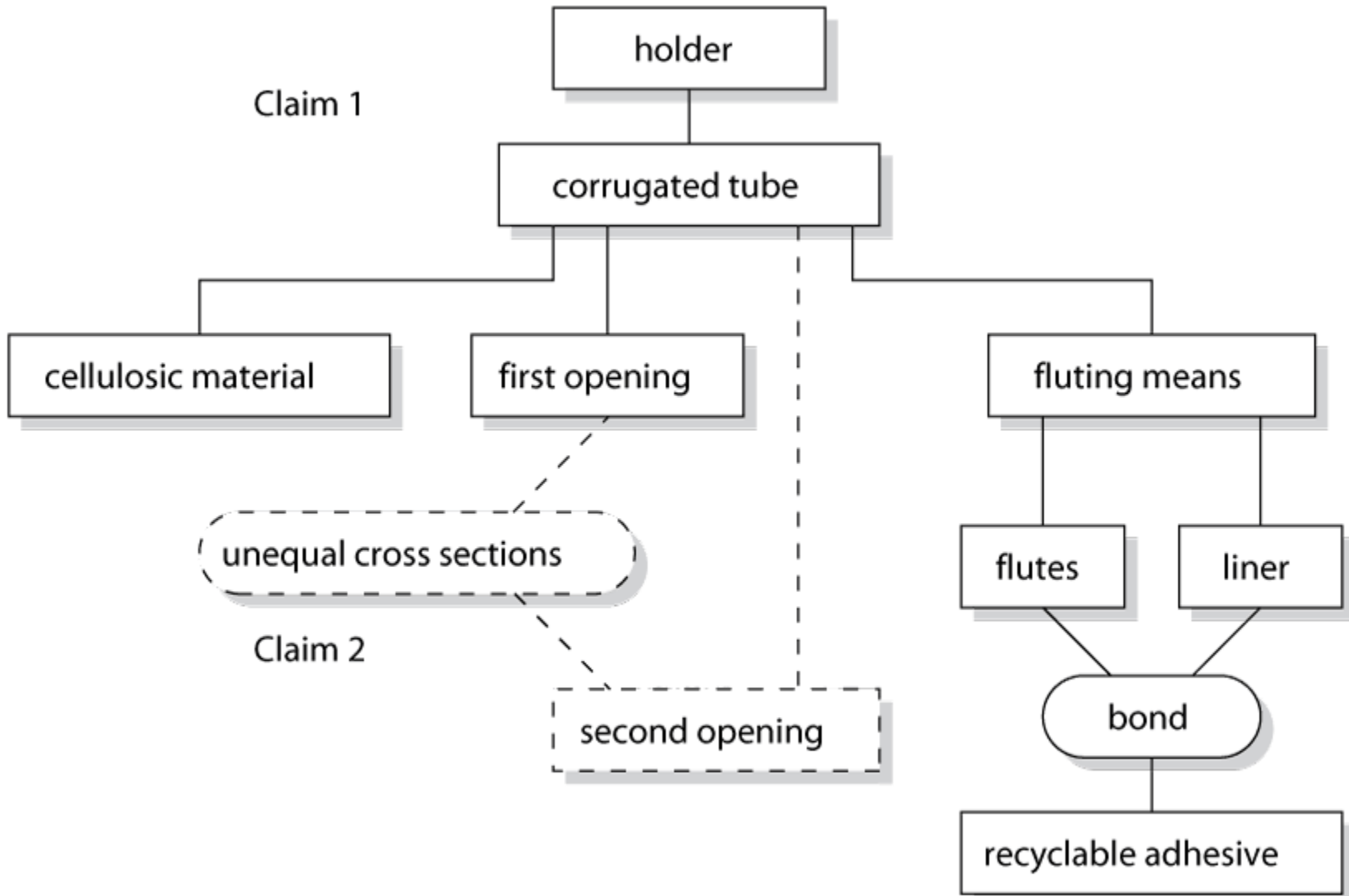
[57] **ABSTRACT**

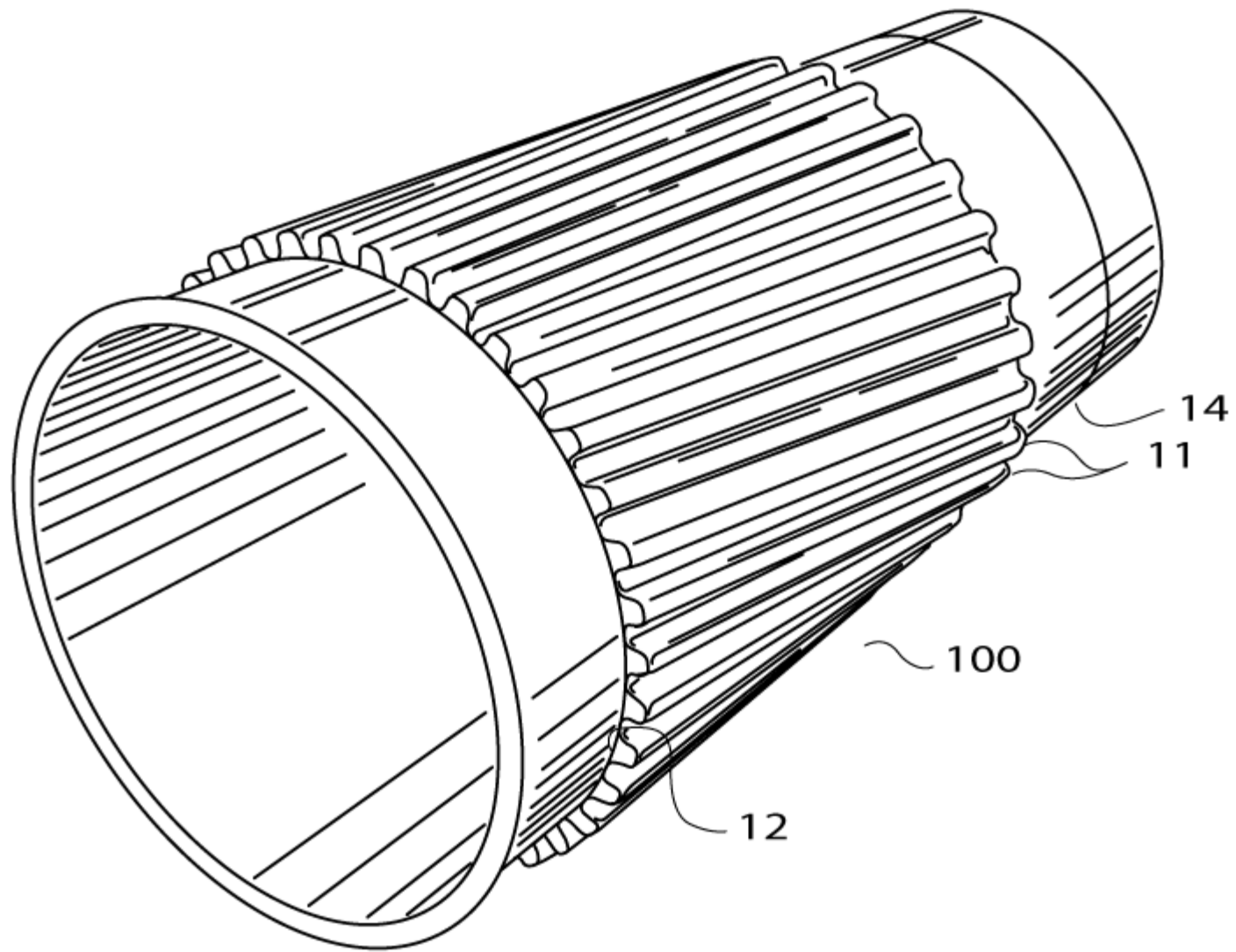
Corrugated beverage containers and holders are which employ recyclable materials, but provide fluting structures for containing insulating air. These products are easy to hold and have a lesser impact on the environment than polystyrene containers.

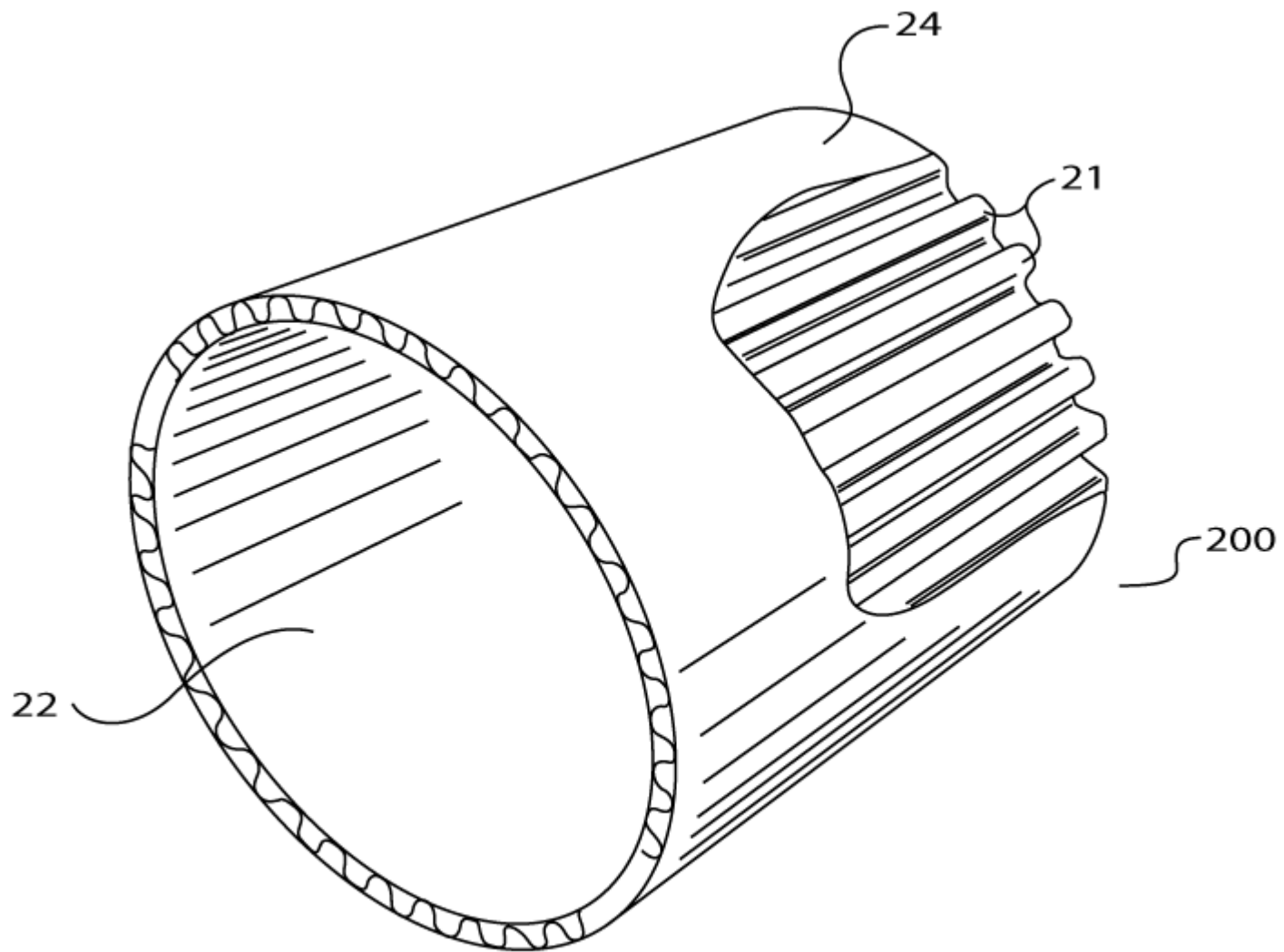
18 Claims, 8 Drawing Sheets



D.W. Coffin Sr., US Pat.# 5,205,473: Claims 1 and 2







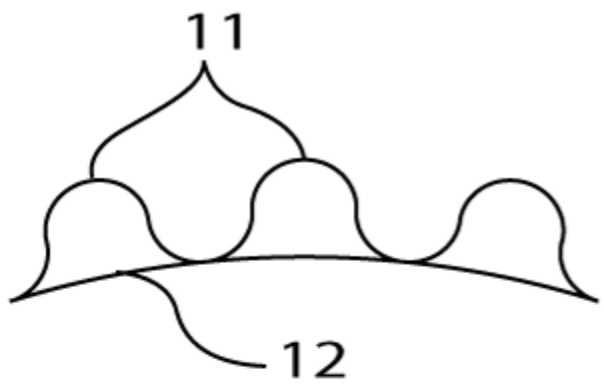


Fig. 6a

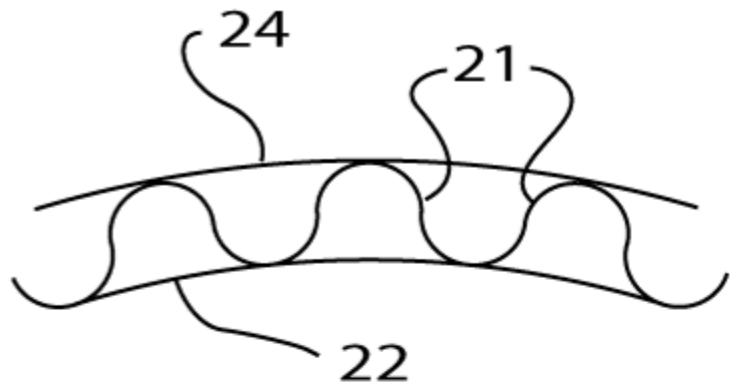


Fig. 6b

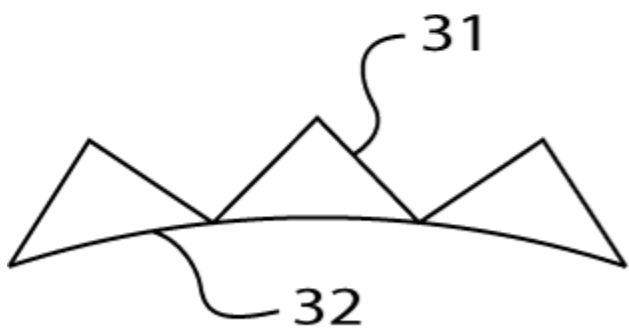


Fig. 7a

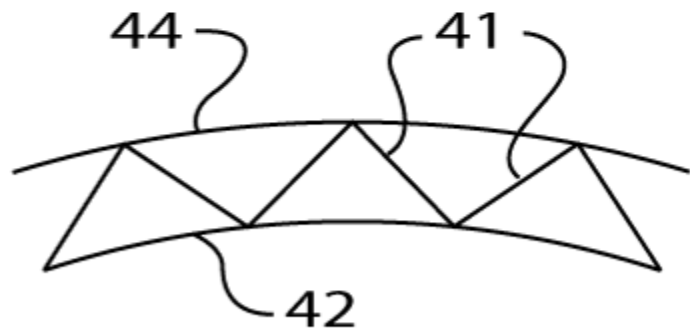
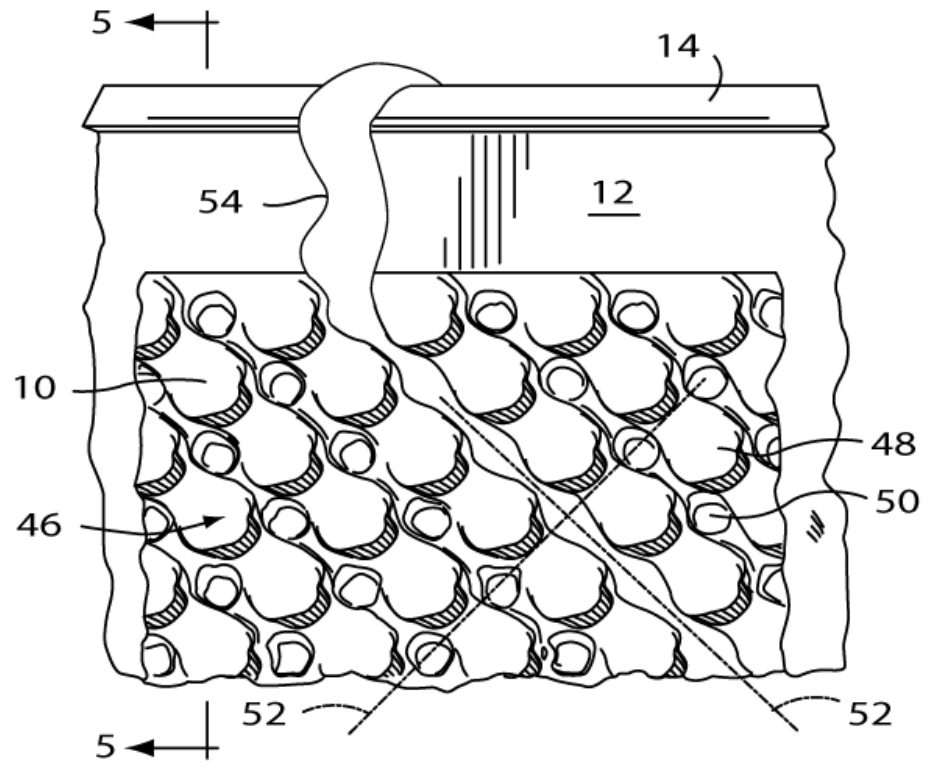
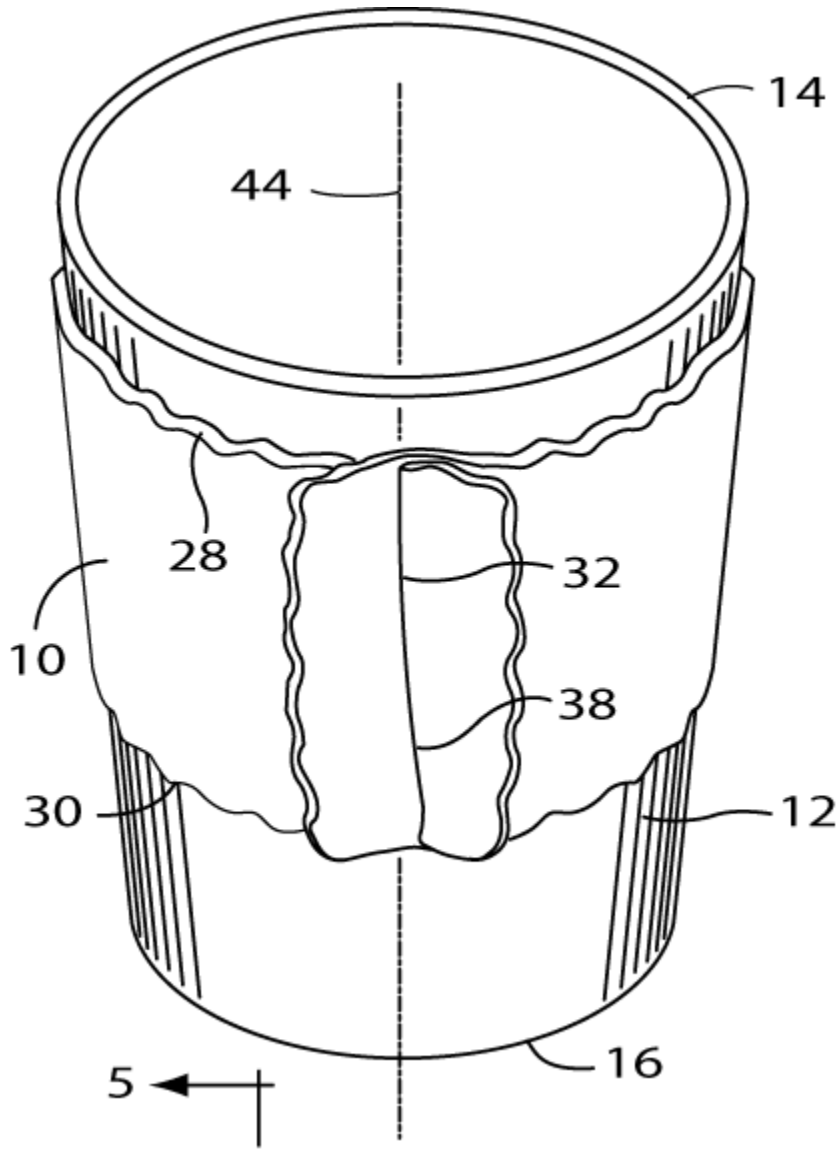


Fig. 7b

Jay Sorenson,
US Pat. # 5,425,497





Smucker's Uncrustables

- 1998 – Product launch
- 1999 – US Patent #6,004,596 issued, claiming a crustless, crimped, filled sandwich
- 2007 – Patent challenged, re-examined, and finally cancelled due to prior art (crimped meat pies, ravioli)
- Now – over \$120M/year sales (unpatented) for Smucker's, plus generic competitors



Strategic Tools for IP

- Publication
 - Cheapest way to prevent a competitor from patenting
- Patent
 - Gives limited right to exclude others
- License
 - Gives limited right to use patented invention under specified terms
- Non-Disclosure Agreement (NDA)
 - Prohibits disclosure or use of confidential information
 - Helps to protect patentability and trade secrecy
- Non-Compete Agreement (NCA)
 - Prevents employee from working for competitor (typically 3-36 months)
 - Not legally enforceable everywhere
- Employee Assignment (Invention) Agreement
 - Agreement to assign ownership of inventions while employed
- Material Transfer Agreement (MTA)
 - Controls how proprietary materials can be used
 - May provide for joint ownership of derived inventions
- Joint Invention Agreement
 - Specifies how to share costs, revenues, and IP responsibilities



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Thank you