

Why is Intellectual Property Important?

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Disclaimer

- This presentation is for information purposes only and does not constitute legal advice.
- This presentation does not establish any form of attorney-client relationship.

What is Intellectual Property (IP)?

Intellectual Property (IP)

- Refers to a category of exclusive rights created by statute, including:
 - Copyrights
 - Trademarks
 - Trade Secrets
 - Utility Patents
 - Design Patents
- Others: Trade Dress, Mask Works, ...

Nature of the Exclusive Right

- Typically the right to exclude or prevent someone from doing something
- Usually req. gov't registration; Enforce it in court
- As business tools:
 - **Copyrights:** protect content; expression
 - **Trademarks:** enhance marketing strategies
 - **Trade Secrets:** keep proprietary info confidential
 - **Patents:** obtain exclusivity in your market niche
 - **Utility:** functionality; **Design:** appearance

Copyrights

Copyrights

- **Tools for protecting content**
- Provided to authors of “original works of authorship”
- Exclusive right to a work of expression, such as a written story, a photograph, or a computer program
- Not for things that are functional (that’s utility patents)
- Protection lasts for a very long time
 - 70 years after death; 95+ years for corporate author

Copyrights

- No registration necessary, it's automatic!
- Mark to provide notice:

© 2012 Company Name
All Rights Reserved

- Register with copyright office to sue

Trade Secrets

Trade Secrets

- Tools for keeping proprietary information confidential
- Just keeping it secret
 - NDAs, confidentiality agreements
- Make sure you can keep it secret!
 - Once the cat is out of the bag...

Patents

Patents

- **Tools that help you obtain exclusivity in your market niche**
- Right to exclude others from practicing your invention
 - Not a right to use, make, or sell
 - You may still infringe others' patents
- Two types:
 - **Utility Patent:** protect functionality (how it works)
 - **Design Patent:** protect ornamental appearance

Utility Patents

- Protection for functionality, how something works
- Invention must be **useful** and **novel** and **nonobvious** (e.g., not an obvious variation on something)
- Examined by USPTO
- Last for 20 years from date of priority (usually the filing date)
- Takes 3-5 years to issue typically, but...
 - Faster tracks available for a fee

Design Patents

- Protect ornamental appearance of an industrial article
- Must be **novel** and **nonobvious** (i.e., not an obvious variation on something)
- Examined by USPTO, but issue quickly
- Lasts 14 years (soon to be 15 years)
- Differ from copyrights
 - Different standards for grant and infringement (independent creation not an issue)
 - Presumption of validity

Side Note: Provisional Patent Applications

- An inexpensive, informal filing at USPTO
- Not examined
- Kept secret
- Turn into regular application within a year
- Gets you a priority date

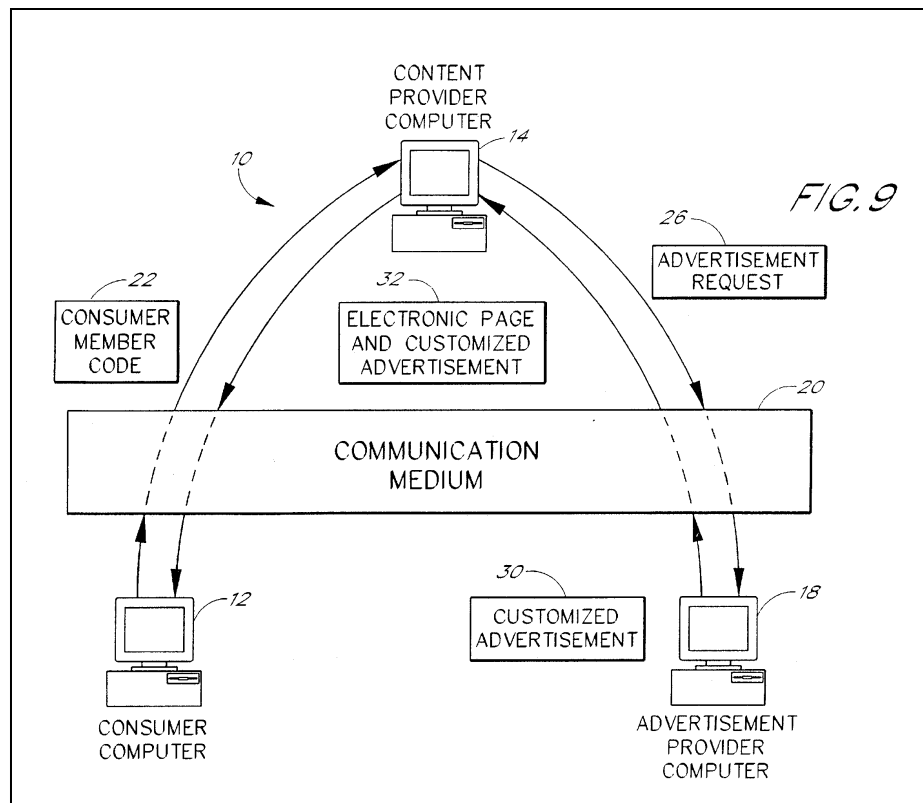
Why File for a Patent?

Why File for a Patent?


- **Attract Capital**
- **Licensing Revenue**
- **Enhance Company Value**
- **Reduce Likelihood/Impact of Employee Theft**
- **Stop Competition**
- **Protect Your Niche By Excluding Competition**
 - Stop others from making, using, selling, importing
- **Support Sales**
 - After filing = “Patent Pending”

Example: Attracting Capital

- Internet Advertising - U.S. Patent No. 5,933,811



Example: Licensing



US005602987A

United States Patent [19] [11] **Patent Number:** **5,602,987**
Harari et al. [45] **Date of Patent:** **Feb. 11, 1997**

[54] **FLASH EEPROM SYSTEM** 60178564 2/1986 Japan .
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 61054543 3/1989 Japan .
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[75] Inventors: Elyahou Harari, Los Gatos; Robert D. Norman, San Jose; Sanjay Mehrotra, Milpitas, all of Calif.
 [73] Assignee: SanDisk Corporation, Sunnyvale, Calif.

[21] Appl. No.: 174,768
 [22] Filed: Dec. 29, 1993

Related U.S. Application Data

[60] Continuation of Ser. No. 963,838, Oct. 20, 1992, Pat. No. 5,297,148, which is a division of Ser. No. 337,566, Apr. 13, 1989, abandoned.

[51] Int. Cl.⁵ G06F 11/00
 [52] U.S. Cl. 395/182.06; 365/200; 365/210; 395/427

[58] Field of Search 371/10.2, 10.3, 371/40.1; 365/200, 185.09, 201, 189.07; 395/375, 182.03, 182.04, 182.05, 182.06, 427, 430

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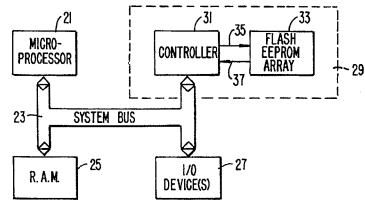
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 Hancock, "Architecting a CCD Replacement for the IBM 2305 Fixed Head Disk Drive," *Eighteenth IEEE Computer Society International Conference*, pp. 182-184, 1979.
 Wilson, "1-Mbit flash memories seek their role in system design," *Computer Design*, vol. 28, No. 5, pp. 30-32, (Mar. 1989).

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ABSTRACT
 [57] A system of Flash EEPROM memory chips with controlling circuits serves as non-volatile memory such as that provided by magnetic disk drives. Improvements include selective multiple sector erase, in which any combinations of Flash sectors may be erased together. Selective sectors among the selected combination may also be de-selected during the erase operation. Another improvement is the ability to remap and replace defective cells with substitute cells. The remapping is performed automatically as soon as a defective cell is detected. When the number of defects in a Flash sector becomes large, the whole sector is remapped. Yet another improvement is the use of a write cache to reduce the number of writes to the Flash EEPROM memory, thereby minimizing the stress to the device from undergoing too many write/erase cycling.

50 Claims, 5 Drawing Sheets



SmartMedia Card

Store Images, Text And More On A SanDisk® Removable SmartMedia Card!



Available Capacities

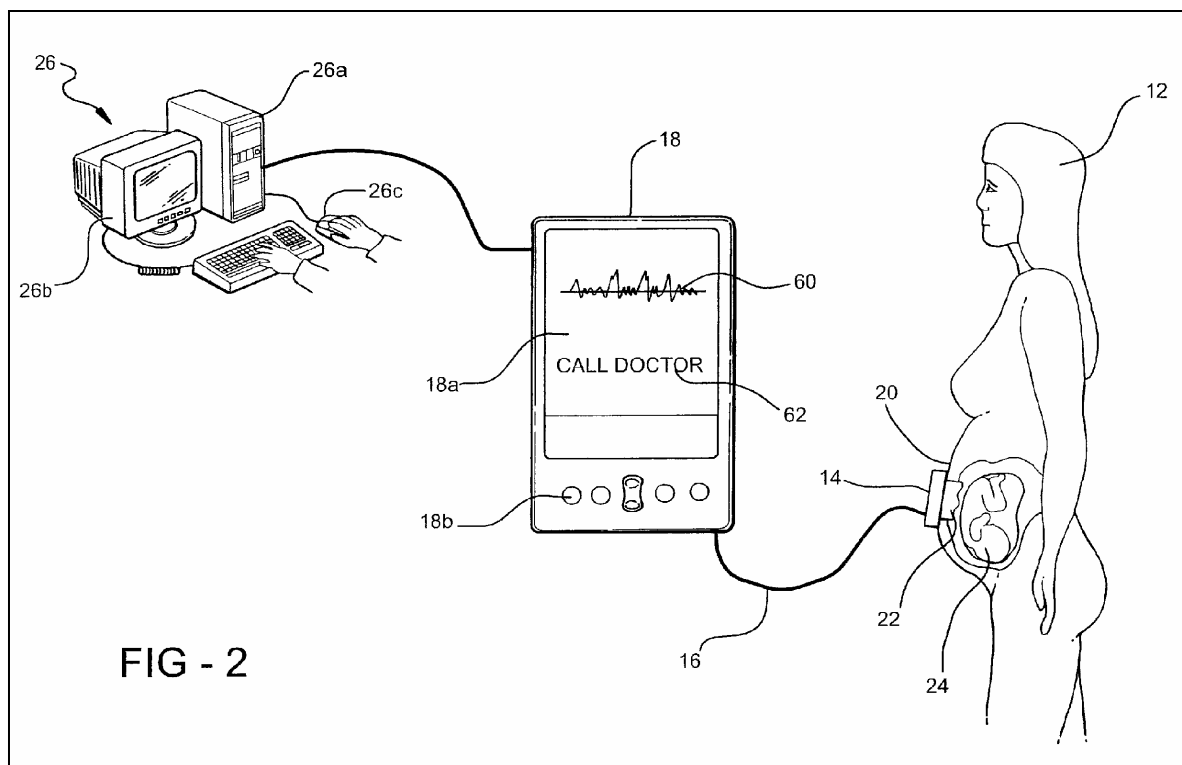


What is a SanDisk® SmartMedia Card?

The SanDisk® SmartMedia card is a removable flash memory card that can be used in several different types of digital devices; including digital cameras, digital music players and digital voice recorders.

Example: Stopping Competition

- Patient Monitoring System - U.S. Patent No. 5,558,638



Example: Protecting Market Niche



Can be used as a single parameter, stand-alone monitor



Can be used as a battery operated, handheld oximeter



SatShare enables installed base of conventional monitor to easily upgrade to Masimo oximeters

How Patent Rights Are Lost

- Premature disclosure
- Failure to recognize invention
- Problems with joint development agreement
- Employee disputes over IP

Trademarks

Trademarks Overview

- Tools that can greatly enhance marketing strategies
- Is any symbol capable of identifying and distinguishing its owner's products from those of others... It's a **Brand**



Trademarks Overview (cont.)

- Protects consumer from counterfeit goods
- Lasts as long as you continue using it
- Standard of infringement: “consumer confusion”
- How to get a trademark?
 - Start marking sold goodsTM – common law
 - For ® - register with USPTO

Search before you invest!

What Makes a Strong Brand?

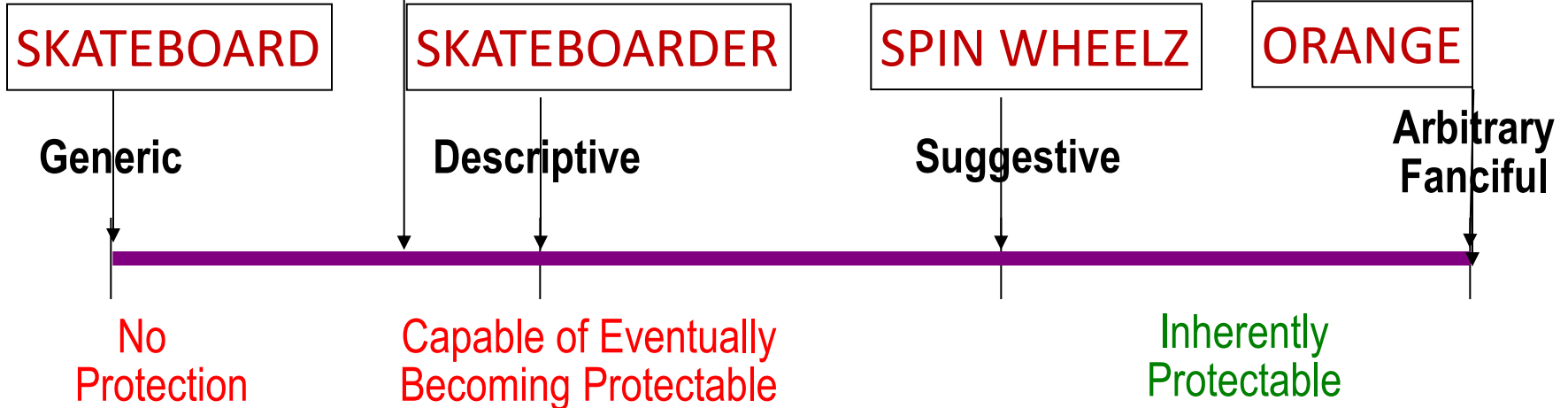
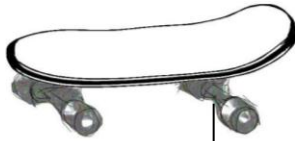
- Business and **LEGAL** Attributes of a Good Brand

- Appropriate
- Credible
- Appealing
- Relevant
- Memorable
- Enduring
- Easy to Pronounce

- ◆ **PROTECTABLE**
- ◆ **AVAILABLE**

Protectable Brands – Choosing Strong Brands

EXAMPLE: Choosing a brand to use in connection with the sale of SKATEBOARDS



Is the Brand **Available?**

- Conduct a **Trademark Search** on both the Name and the Logo BEFORE Investing \$\$\$
 - Make sure no one else is already using a confusingly similar name/logo
 - Make sure that the name/logo is protectable and registrable as a trademark
 - One resource: Trademark Electronic Search System (TESS)
- Once name/logo is cleared, seek a **Trademark Registration**

Trademark Availability

- A trademark is not available if:
 - The mark or a confusingly similar mark is already federally registered or is the subject of a pending federal registration (assuming that the application is ultimately accepted);
 - or
 - The mark or a confusingly similar mark is already being used in the same market in connection with similar goods or services.

Information for Conducting a Good Search

- **What** *goods or services* is the brand being used with?
Future expansion?
- **Where** is the intended *geographic reach* of the brand?
- **Type of Brand** – e.g., house mark, product level mark, feature mark (ties into ability to change mark in the future if conflict)
- **Intended shelf life** of the brand

Trademark Registration

- File trademark application
- Cost of filing an application varies depending on the number of Classes applied for and number of jurisdictions
 - Trademark Offices divides the universe of goods and services into 45 different Classes
 - ~\$275 or \$325 per class
 - Unfortunately no worldwide trademark registration!

Why Register?

- Prima facie evidence of ownership and validity
- Incontestable status after five years
- Right to record the registration with the U.S. Customs and other foreign Customs to prevent infringing goods from being imported into the U.S./foreign countries
- Significantly enhances ability to enforce brand
- Viewed as an asset in a corporate portfolio

Proper Trademark Use

- Ensure that all marketing materials properly display trademarks
 - Provide proper notice using TM or ®
- Use trademarks as an adjective, not a noun
 - “Hand me a Kleenex tissue” vs. “Hand me a Kleenex”
- Use the brand consistently with how it’s filed

Important Tips & Considerations

- Do not accidentally steal someone else's copyrighted work
- If using a designer, obtain copyright to your logo/icon
 - Even if includes license for designer promotion
- Control authorized usage via appropriate **licensing**

Domain Names

- Register as trademark
- “Defensive” domain names
- Watching services
- Monitor domain name renewal deadline
- Obtain Trademark as Name on Popular Social Media Sites (even if not going to use)
 - Facebook, Twitter, etc.

Final Thoughts on Trademarks

- Chose a **Strong Brand** (Word and Logo)
- Conduct a **Trademark Search** Before Investing in the Brand
- Seek **Trademark Registrations**
 - Think about long term product and geographic expansion
- Properly **Use the Brand**
- Ensure **Quality Control**
 - Distributors/licensees/certification programs
- Secure **Domain Names**

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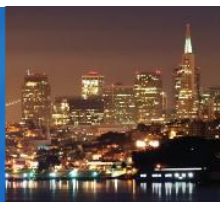
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Orange County



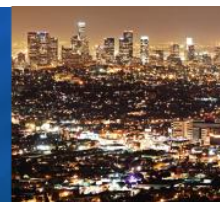
San Diego



San Francisco



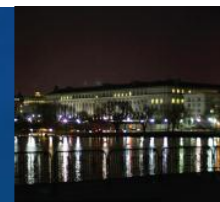
Silicon Valley



Los Angeles



Seattle



Washington DC