

# JCOTS Nanotechnology Advisory Committee

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## OVERVIEW OF US INTELLECTUAL PROPERTY LAW

# Buchanan Ingersoll PC

ATTORNEYS

Including attorneys from **Burns Doane Swecker & Mathis**

# ENFORCEABLE IP IN THE US

- ❖ Patents
- ❖ Trademarks
- ❖ Copyrights
- ❖ Trade Secrets

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# LAY DEFINITION OF “PROPERTY”

**To the world:**

**KEEP OFF, unless you  
have my permission  
otherwise.**

**Signed: Private Citizen**

**Endorsed: The State**

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# IP EXAMPLES

- ❖ Embodiments of Ideas
- ❖ Processes
- ❖ Products
- ❖ Compositions
- ❖ Software
- ❖ Books
- ❖ Pictures
- ❖ Artwork/Music
- ❖ Marks
- ❖ Configuration of goods
- ❖ Artistic layouts



Patents or  
Trade Secrets

Copyrights

Trademarks

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# PATENTS

- **Societal Contract Theory of Patents**
- **Benefits of Patents**
  - stimulate further research, encourage innovation and investment, prompt commercialization of inventions.
  - Foster exchange of information, help avoid duplicative research, and increase the general pool of public knowledge.
- **A patent gives a negative right – not the right to use the invention**
- **Patents are territorially limited and enforced through civil court**
- **Availing oneself of a patented invention without permission infringes that patent, whether knowingly or not**
- **Remedies: injunctions, destruction of infringing articles, and monetary damages**
- **Patents can be challenged**

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# WHAT CAN BE PATENTED?

“anything under the Sun made by man”

- ❖ **Process, machine, manufacture or compositions of matter, or any improvements thereof**
  - That are:
    - Novel
    - Useful
    - Non-obvious
  - But not abstract ideas, pure algorithms or laws of nature

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# “MARKS”

- **Trademarks and service marks –**
  - primarily intended to
    - indicate the source of goods and services
    - distinguish the trademarked goods and services from others
    - symbolize the quality of the goods or services with which they are used.
- **Mostly words, but they can be almost anything that distinguishes one product or service from another**
- **Registration desirable and renewable indefinitely as long as the marks are used**
- **Owner may preclude others from using a similar mark if such use is likely to cause confusion in the minds of purchasers**
  - a multi-factor analysis

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# TRADEMARKS

- **In “first-to-use” countries like the U.S. (as opposed to first-to-file countries), registering the mark is optional**
  - Registration nevertheless desirable - presumptive evidence of the validity and ownership, and notice
- **A mark's strength based on its distinctiveness measured from weakest to strongest as generic, descriptive, suggestive, arbitrary, and fanciful.**

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# COPYRIGHTS

- **An exclusive right to reproduce and prepare derivative works**
  - an original work of authorship
  - fixed in any tangible medium of expression
- **Copyright protection does not overlap patent protection**
- **Rather, copyright protection is limited to an author's particular expression of an idea, process, concept, and the like in a tangible medium.**
- **Copyright protection automatically created in all works of authorship from the moment of creation.**
- **Term of protection: 70 years from author's death, or, if the work is made for hire, 120 years from creation or 95 years from first publication, whichever is shorter.**
- **Fair use doctrine**

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# TRADE SECRETS

- **Information that is secret or not generally known in the relevant industry and that gives its owner an advantage over competitors**
- **Trade secret protection exists as long as the information is kept secret or confidential by its owner and is not lawfully and independently obtained by others**
- **Trade secrets are not registered like other forms of intellectual property and are not creatures of statutes.**
- **Secrecy the most important factor**

- If the information is available through any legitimate means and is obtained in this way, then the information is no longer secret and may become ineligible for protection.

- However, protection may still be granted if the owner has taken reasonable steps to protect the information

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# The End

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