



FUNDAMENTALS OF INTELLECTUAL PROPERTY

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WHY PATENTS?

- Society benefits from the development of new ideas
- The commercialization of these ideas must have an economic reward for risk takers



MY GOAL

- Introduce group to patent concepts and ideas
- Cannot evaluate individual ideas in discussion, but will provide concepts and terms for consideration in the development of a patent strategy
- **Patents are a reward from the marketplace for continuous research and development**
- Products which cannot be patented can be sold as a 'sales and marketing opportunity' or protected as a 'trade secret'

YOUR GOAL

- Create defensible IP which can be used for licensing, funding, sale, or other financial opportunities
- Patents are awarded and defended
- The award of a patent gives you the right to defend the patent
- It does not protect you from counter claims or lawsuits

THREE IMPORTANT THINGS

- 1. **You need a lawyer.** This material is complicated and you must carefully plan each step



THREE IMPORTANT THINGS

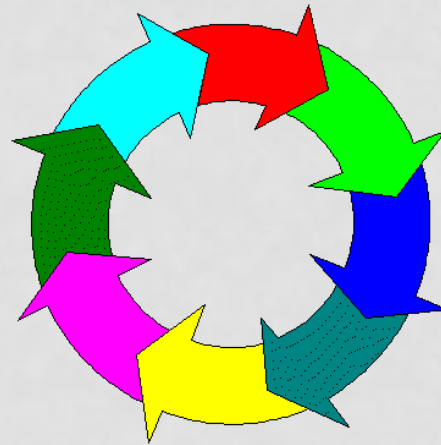
- 2. **Most countries track patents by Filing Date.** The date you file your initial paperwork is critical when compared to similar claims. The United States is transitioning from a 'first to invent' to a 'first to file' system.

THREE IMPORTANT THINGS

- 3. **The definition of your idea in the initial filing is critical.** Countries limit your ability to modify your paperwork after filing. The definition must be limited enough to be unique and broad enough to include similar modifications of your idea.

THE BASICS

- Everything is about Process



AGENDA

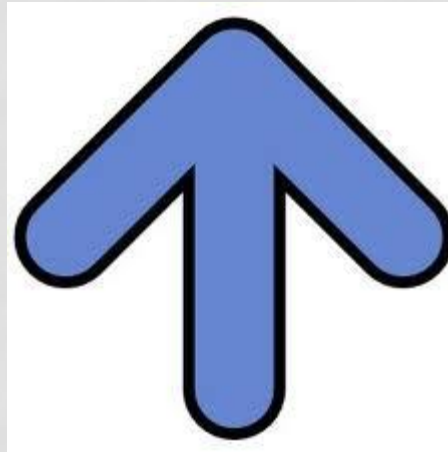
- **IP Strategy**
- **Patents**
- **International IP Standards**
- Trade Secrets
- Copyrights
- Trademarks
- Industrial Design
- Conclusion

IP STRATEGY

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STRATEGY

- IP strategy ties closely with business strategy



STRATEGY

- Your goal is to seek initial protection for your innovation and use the provisional, PCT, or regional filings as a basis for licensing and partnerships discussions
- The cost of expanding IP protection will become part of the business model

STRATEGY

- The simplest step might be to patent in your home country and file for a provisional patent in the largest market – the United States
- This will give you one year with the provisional patent for you to decide how to proceed
- Adding additional patent options can be covered as you develop the business needs and finances to execute

LEVERAGING ASSETS

- Global patent strategy is expensive
- In seeking partners for your business strategy, look for organizations with experience in filing IP claims in your space



PLANNING

- In this presentation, you should understand terms and concepts and use these to develop your business model
- **Although filing is expensive, releasing information prevents others from using your ideas**
- Public information cannot be patented

PATENTS

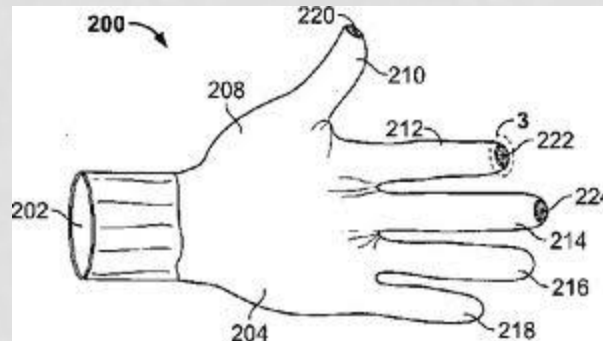
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WHAT IS A PATENT?

- A patent is a type of intellectual property
- The ownership of a patent is legally enforceable in gives you exclusive right to limit others in using your idea
- Patents, as an asset, can be sold, licensed, or used as a basis for loans or capitalization

WHAT IS A PATENT?

- **Utility patents** are awarded for devices with a use
- **Design patents** are awarded for the appearance of a device or object



WHAT IS A PATENT?

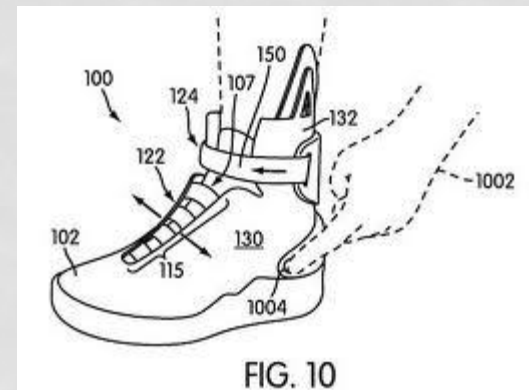
- **Plant patents** are awarded for the appearance and color of a plants, such as flowers. This is critical to organizations who develop seeds and plants to grow in different environments
- **Cells and living animals** are being awarded patent protections. This is important for medical research where certain types of mice have been developed for cancer studies.

WHAT IS A PATENT?

- With a patent award, the inventor has exclusive rights to idea for a defined time period
- In the marketplace, it rewards the inventor and allows them to recover development costs and profit from risk
- The patent is a legally enforceable monopoly for the innovation

WHAT IS A PATENT?

- Patent is enforceable against competitors in both civil and criminal courts internationally
- **Reverse engineering cannot be used to override a patent**
- Independent research cannot be used as justification to override a patent



WHAT IS A PATENT?

- In this process, you will apply for the patent and the government will review your application, which will take several years
- Until the patent is awarded, the government will not provide protection from infringement
- It is possible for an idea to be obsolete by the time the government awards the patent

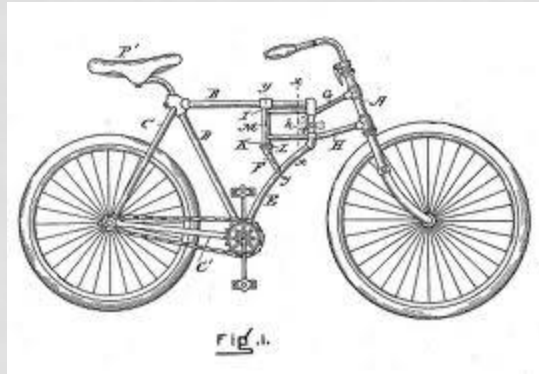
PATENT REQUIREMENTS

A Patent must have three characteristics:

- **Useful** – have commercial or utilitarian value
- **Novel** – unique, not patented or published elsewhere. Publishing limits include the patent applicant.
- **Non-Obvious** – to “one having ordinary skill in the art to which said subject matter pertains”

PATENT REQUIREMENTS

- A patent is not a law of nature or a scientific formula
- A patent is not an idea, but the execution of an idea



PATENT SPECIFICATION

- Patent Specification is the description of invention
 - List of requirements to develop or utilize invention
 - Optimal use of innovation as viewed by the inventor
 - Features which differentiate the product from other products or 'prior art'
 - Key part of process – most governments will limit your ability to modify the specifications after the initial application

PATENT ASSIGNMENTS

- Employees and consultants are usually required to transfer all rights for products developed to the organization
- Key aspect of the relationship between owners and employees or consultants

PATENT INFRINGEMENT

- Infringement is when some uses the patent
- Legal limits on their access to the patent
- Economic damages from their revenues from patent infringement
- Definition of the patent in the initial filing is critical to infringement claims
- Challenge against the validity of the patent and the infringement of the patent

INTERNATIONAL IP STANDARDS

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INTERNATIONAL PATENTS

- The enforcement of regional patents lies within the jurisdiction of each member State.

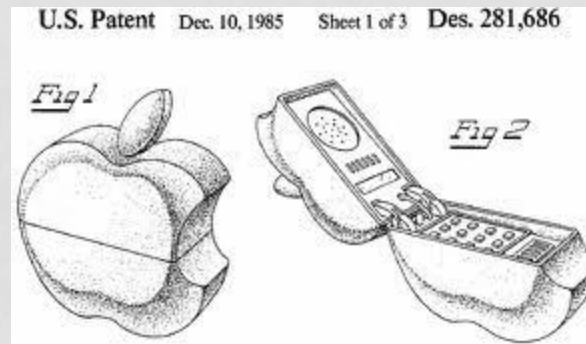


PATENT DISCLOSURE

- Patents are disclosed as part of the approval process.
- For multi-country applications, you will need to coordinate the best strategy for application and disclosure

IT'S GETTING EXPENSIVE

- Yes, it is. Individual filing fees, lawyers, and so forth.



INTERNATIONAL PATENTS

- A patent is, in general, granted by a national patent office. The effects of such a grant are, however, limited to the country concerned.
- Patents may also be granted by a regional office that does the work for a number of countries, such as the European Patent Office (EPO) and the African Regional Industrial Property Organization (ARIPO).

INTERNATIONAL PATENTS

- Under such regional systems, **regional patent office accepts regional patent applications**, or grants regional patents, which have the same effect as applications filed, or patents granted, in the member states of that region.

PCT

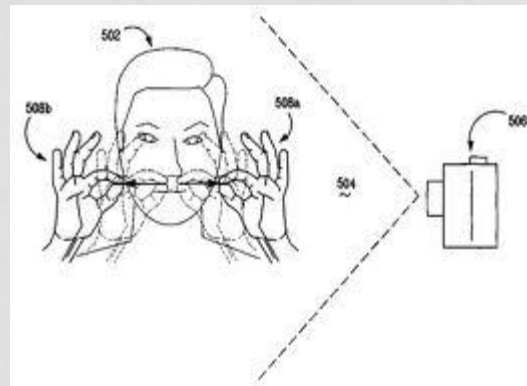
- PCT is a registration process and can be used as the basis for pursuing patents in multiple countries
- PCT is not a patent application for multiple countries
- Upon PCT approval, you still need to pursue patent applications in individual countries
- Your successful PCT documentation can be used for your application in other countries

INTERNATIONAL PATENTS

- The WIPO-administered Patent Cooperation Treaty (PCT) is an agreement for international cooperation in the field of patents. It is largely a treaty for rationalization and cooperation with regard to the filing, searching and examination of patent applications and the dissemination of the technical information contained therein.

INTERNATIONAL PATENTS

- The PCT does not provide for the grant of “international patents”: The task and responsibility for granting patents remains exclusively in the hands of the offices mentioned in the paragraph above.



INTERNATIONAL PATENTS

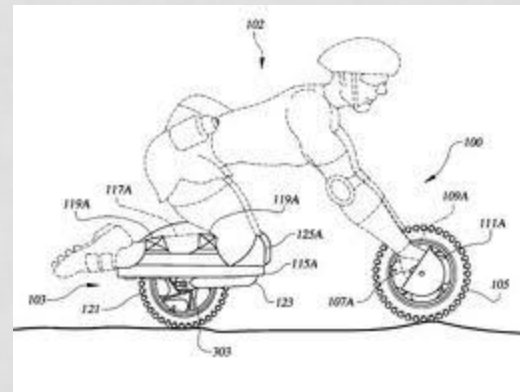
- At present, no "world patents" or "international patents" exist.
- In general, an application for a patent must be filed, and a patent shall be granted and enforced, in each country in which you seek patent protection for your invention, in accordance with the law of that country.

INTERNATIONAL PATENTS

- Further, any resident or national of a Contracting State of the Patent Cooperation Treaty (PCT) may file an international application under the PCT. A single international patent application has the same effect as national applications filed in each designated Contracting State of the PCT.

INTERNATIONAL PATENTS

- However, under the PCT system, in order to obtain patent protection in the designated States, a patent shall be granted by each designated State to the claimed invention contained in the international application.



INTERNATIONAL PATENTS

- Procedural and substantive requirements for the grant of patents as well as the amount of fees required are different from one country/region to the other.
- **It is therefore recommend that you consult a practicing lawyer** who is specialized in intellectual property or the intellectual property offices of those countries in which you are interested to get protection.

PROCESS

- Determine which countries you wish to target for development or sales
- If this number is large, the PCT process will be advantageous
- If the number is smaller (5-6 in the same region), you should look to regional patent treaties
- If the number is less than 5, you should consider filing in the individual countries

TRADE SECRETS

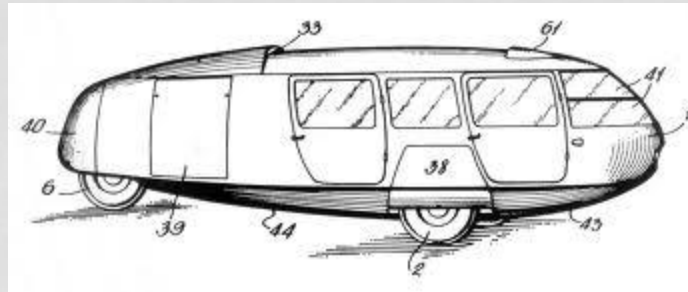
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TRADE SECRETS

- Trade secrets are information which cannot be patented
- The claimed secret must be secret in fact, have economic value, and you must take reasonable steps to keep the information secret
- Examples of trade secrets include research data, client lists, formulations, and other information not subject to patent law

TRADE SECRETS

- Protection of trade secrets must be a reasonable effort and organizations should not be held to an extreme standard.
- Examples would be use of confidentiality agreements, passwords for system access, limit data access



TRADE SECRETS

- Trade secrets exist for as long as the information is secret and valuable
- Trade secrets are protected by the courts
- Trade secrets are not the basis for investment or loans

TRADE SECRETS

- Government agencies and public universities may have limited ability to generate trade secrets
- The concept would be whoever pays for the development of the information should have access to the information

COPYRIGHTS

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COPYRIGHT

- Copyright is a method of giving protection to authors of works for their creative efforts. The legal definition of for them to copyright their 'works'.

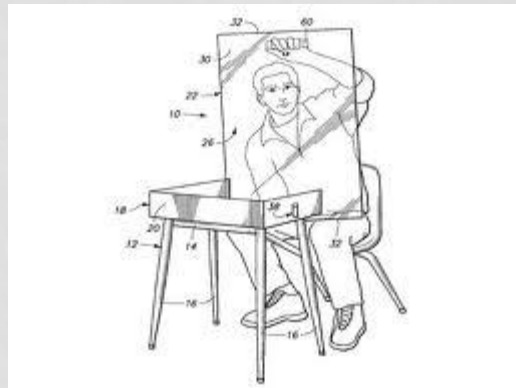
COPYRIGHT

- Copyright is extended to the expression of thoughts, but not to the ideas. You cannot copyright the idea of 'religious freedom'. You can copyright your writings on the subject.
- **Copyright protection is automatically extended to works as they are created**, without the need to register or claim protection with a government agency.

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Frankivsk and
Dnepropetrovsk ©
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COPYRIGHT

- Copyright owners have **economic rights**, which allow them to have financial reward for their works and moral rights, which link the author to the work.
- **Moral rights** allow you to control the presentation and editing of your ideas by others



NEIGHBORING RIGHTS

- **Neighboring rights are associated with the public performance of a work.** Although the works of Prokofiev are not copyrighted, the public performance, recording, and broadcast of 'Peter and the Wolf' featuring the Philadelphia Orchestra and Narrated by David Bowie would be copyrighted.



NEIGHBORING RIGHTS

- Much of the work in copyrighting performances came about after a recording of a Crosby, Stills, Nash, and Young concert was recorded and sold in the 1970s.
- Other bands, such as The Grateful Dead, have permitted the recording and sharing of their concerts for anyone who does not achieve economic gain.

COPYRIGHT

- Copyright law protects published and unpublished works. **Works are protected regardless of the perceived scientific, literary, or artistic value.**
- Copyright law protects authors, regardless of the manner of expression. This will allow people to copyright their performances, writing, paintings, or other forms of expression.

TRADEMARKS

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TRADEMARKS

- A trademark is a sign or logo to distinguish a company or idea from others. The letter 'M' is not a trademark, the letter 'M' in the McDonald's logo is a trademark.

TRADEMARKS

- Key issue for this class is to avoid duplication or confusion between your name or logo and others



TRADEMARKS

- Apple and Proview are suing over iPad name
- The punk band 'Thorazine' was given a cease and desist order by GSK. Legally, the band was probably in the right, however, GSK was willing to spend more to defend the name
- Value of intellectual property is often the amount of money you want to spend defending it

INDUSTRIAL DESIGN

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INDUSTRIAL DESIGN

- An industrial design is the ornamental aspect of an article
- No claims are made to the patentability of the article, merely the desire to protect the uniqueness of the design
- Key issue for jewelry, housewares, instruments, and other products which do not have patent protection.

IN CONCLUSION ...

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NO IP?

- Your product may be a sales / marketing opportunity

TO START

- Define your idea in terms of its unique aspects
- Search Ukrainian and global databases for similar applications
- **Redefine your idea in terms of its unique aspects**
- Parts of the product/idea will be unique, other parts may not. The unique parts of the product/idea would be awarded patent protection.

DATABASES FOR SEARCHING

- Global - <http://www.wipo.int/patentscope/search/en/structuredSearch.jsf>
- Ukraine - <http://www.ukrpatent.org/en>
- Each local country has patent databases

WEBSITES FOR INFORMATION

- <http://investukraine.com/investors-guide/intellectual-property-rights-in-ukraine>
- <http://www.wipo.int/about-wipo/en/gib.htm>
- <http://www.wipo.int/treaties/en/ip/index.html>
- <http://www.ukrpatent.org/en>

MORE ABOUT PATENTS

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IPHONE SCREENS



Patent Search

Google™ Custom Search

Search x

We provide for your convenience easy access to the WIPO search engine that allows you to search for patents free of charge, using English terms.

Search example: **dog collar.**

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Publications



About

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Patent Search

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About 266 results (0.24 seconds)

[WO/2011/156923 MULTITUBE](#)

Dec 22, 2011 ... Disclosed herein is a valveless multitube pulse **detonation engine** ... In the disclosed engine, an air and fuel mixture is detonated in the ...
www.wipo.int/patentscope/search/en/detail.jsf?...

[WO/2003/064841 PULSE](#)

Aug 7, 2003 ... The invention relates to a pulse **detonation engine** and a method for ... The pulse **detonation engine** (1) comprises a combustion chamber (2), ...
www.wipo.int/patentscope/search/en/WO2



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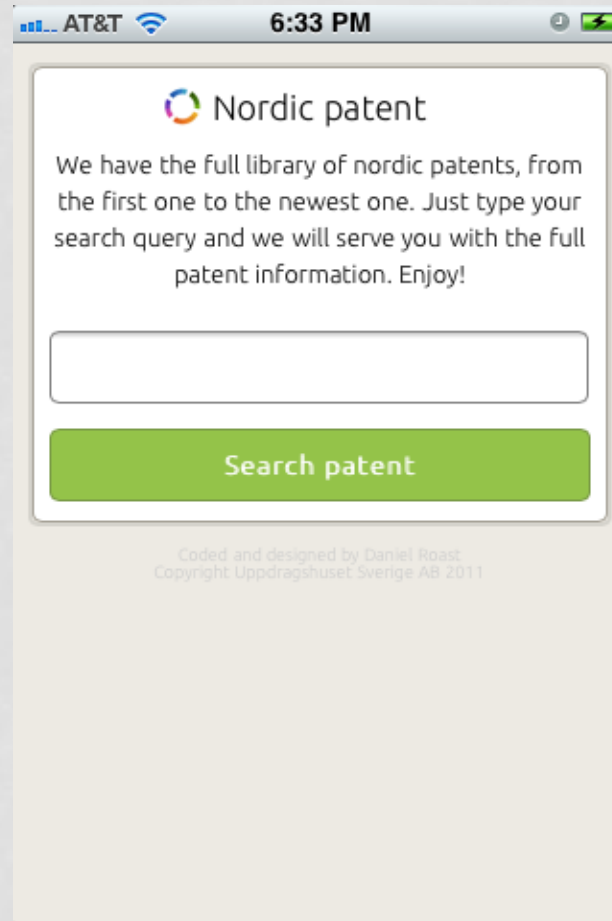


Publications

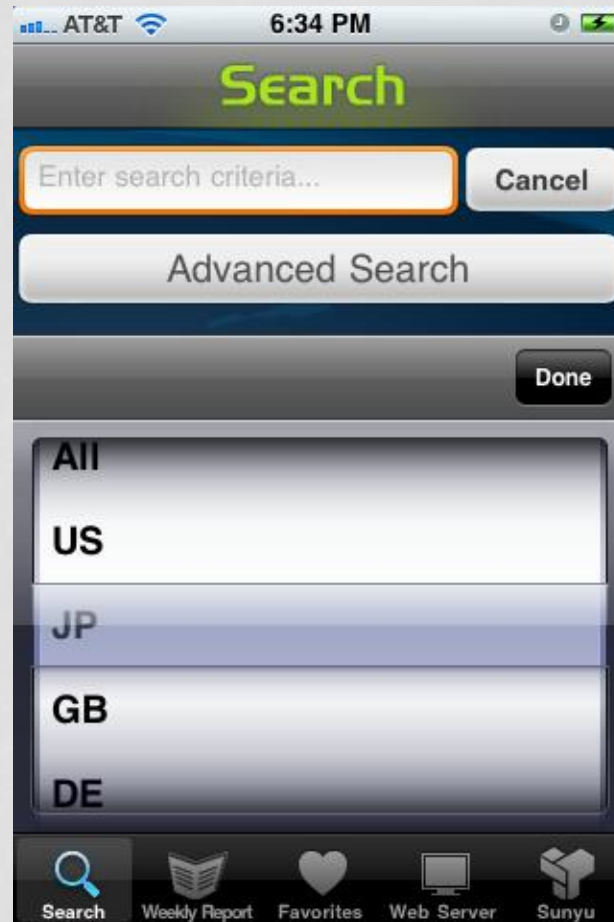


About

IPHONE SCREENS



IPHONE SCREENS



ITUNES RESOURCES

The screenshot shows the iTunes application interface. The top menu bar includes File, Edit, View, Controls, Store, Advanced, and Help. The main window title is "iTunes". The navigation bar at the top of the content area includes Music, Movies, TV Shows, App Store, Books, Podcasts, iTunes U, and Ping. The user's email address, chager@austin.rr.com, is visible in the top right corner.

The left sidebar contains the following sections:

- LIBRARY**: Music (36), Movies, TV Shows, Podcasts (48), iTunes U, Books, Apps (19), Tones, Radio.
- STORE**: iTunes Store, iTunes Match, Ping, Purchased.
- DEVICES**: Earle Hager (3x1).
- GENIUS**: Genius.
- PLAYLISTS**: iTunes DJ, 90's Music, Classical Music, Music Videos, My Top Rated, Recently Added, Recently Played, Top 25 Most Played, (1994) Oasis - Defi..., 00-bruce_springst..., 00-Miles Davis - Ti..., 00-mitt the hoop...

The main content area displays the "iTunes U > University of Pennsylvania" page for the course "Patent Law (Fall 2011) - Professor Polk Wagner - Fall 2011 Class Sessions (Slides + Audio)". The instructor is R. Polk Wagner, Professor of Law at the University of Pennsylvania Law School. A description states: "In our modern technologically-based economy, the creation and enforcement of patent rights can make or break a business. With record numbers of patents being issued every year, the stakes for inventors (and, indeed, their lawyers) continue to increase, even as the patent law and its administration faces growing criticism. This course seeks to equip students with a detailed overview of the law and policy of the United States patent system." Below the description are buttons for "Subscribe Free" and "Get All".

Below the course information is a table of class sessions:

Name	Time	Released	Description	Popularity	Price
1 Class 01 - Introduction to Patent Law	1:18:04	9/12/11	--	■■■■■■■■■■	FREE
2 Class 02 - History and Theory of Patents	1:16:55	9/15/11	--	■■■■■■■■■■	FREE
3 Class 03 - Patent Document 1	1:17:30	9/22/11	--	■■■■■■■■■■	FREE
4 Class 04 - Patent Document 2	1:11:59	10/2/11	--	■■■■■■■■■■	FREE
5 Class 05 - Novelty 1	1:15:38	10/2/11	--	■■■■■■■■■■	FREE
6 Class 06 - Novelty 2	1:09:35	10/7/11	--	■■■■■■■■■■	FREE
7 Class 07 - Nonobviousness 1	1:20:53	10/7/11	--	■■■■■■■■■■	FREE
8 Class 08 - Nonobviousness 2	1:19:06	10/11/11	--	■■■■■■■■■■	FREE
9 Class 10 - Claim Construction 1	1:18:50	10/17/11	--	■■■■■■■■■■	FREE
10 Class 11 - Claim Construction 2	1:04:28	10/19/11	--	■■■■■■■■■■	FREE
11 Class 13 - Doctrine of Equivalents 1	1:19:10	11/7/11	--	■■■■■■■■■■	FREE
12 Class 14 - Doctrine of Equivalents 2	1:15:08	11/7/11	--	■■■■■■■■■■	FREE
13 Class 15 - Doctrine of Equivalents 3	1:05:42	11/7/11	--	■■■■■■■■■■	FREE
14 Class 17 - Infringement and the Scope of the Patent Right	1:20:12	11/11/11	--	■■■■■■■■■■	FREE
15 Class 18 - Defenses to Infringement	42:58	11/14/11	--	■■■■■■■■■■	FREE

Total: 21 Items

The bottom of the window shows the Mac OS X dock with various application icons and the system tray with the date and time: 6:43 PM, 3/4/2012.

ITUNES RESOURCES

The screenshot shows the iTunes application interface. The top menu bar includes File, Edit, View, Controls, Store, Advanced, and Help. The main window title is "iTunes" with an Apple logo. A search bar in the top right contains "Search Store" and the user's email "ehager@austin.rr.com".

The left sidebar shows the "LIBRARY" section with categories: Music, Movies, TV Shows, Podcasts (36), iTunes U (48), Books, Apps (19), Tones, and Radio. The "STORE" section includes iTunes Store, iTunes Match, Ping, and Purchased. The "DEVICES" section shows Earle Hager. The "GENIUS" section shows a Genius playlist. The "PLAYLISTS" section shows various playlists including "iTunes DJ", "90's Music", "Classical Music", "Music Videos", "My Top Rated", "Recently Added", "Recently Played", "Top 25 Most Played", and several "00-" playlists.

The main content area displays the "iTunes U > Suffolk University" page for the "Intellectual Property Law Podcast Series - Bibliography Information". The page includes a "Subscribe Free" button and a "Get All" button. Below these are "Links" for "Professor Beckerman-Rodau's W..." and "Suffolk Law's Intellectual Property...".

A table lists the podcast episodes:

Name	Time	Released	Description	Popularity	Price
1 Ganzl - Patent Quality - Bibliography	--	5/17/10	--	██████████	FREE
2 LawAdmin_IP_UDRP	--	1/7/11	--	██████████	FREE
3 WIPO Domain Name Dispute: Case No.D2009-1007	--	1/7/11	--	██████████	FREE
4 untitled	--	1/21/11	--	██████████	FREE
5 LawAdmin_Biblio_Note on Website Interactivity and Analysis of Personal Jurisdic...	--	1/21/11	--	██████████	FREE
6 Looks Matter: Protect Your Product Designs with Intellectual Property Rights Whil...	--	2/11/11	--	██████████	FREE

Total: 6 Items

Below the table, a section titled "Customers also subscribed to" features several recommended resources with thumbnails and titles:

- Intellectual Property and Access to... Hosted by DePaul Uni...
- Property Law (Spring 2009) ... R. Polk Wagner - Prof...
- 2009 - 2010 School of Law Lecture Serie... Case Western Reser...
- Law & Religion: The Next 25 Years - ... Center for the Study ...
- Statute Law: Making Legislation Oxford University
- IP/Technology and the Law - Tracks New York Law School
- Introduction to Intellectual Proper... Mindy Fleisher
- PLAI Liber

The bottom of the screen shows the Windows taskbar with various application icons and the system tray displaying the time "6:42 PM" and date "3/4/2012".

ITUNES RESOURCES

The screenshot displays the iTunes application window. The top menu bar includes File, Edit, View, Controls, Store, Advanced, and Help. The main navigation bar shows Music, Movies, TV Shows, App Store, Books, Podcasts, iTunes U, and Ping. The left sidebar contains sections for LIBRARY (Music, Movies, TV Shows, Podcasts, iTunes U, Books, Apps, Tones, Radio), STORE (iTunes Store, iTunes Match, Ping, Purchased), DEVICES (Earle Hager), GENIUS (Genius), and PLAYLISTS (iTunes DJ, 90's Music, Classical Music, Music Videos, My Top Rated, Recently Added, Recently Played, Top 25 Most Played, 00-Miles Davis - Defi..., 00-bruce_springst..., 00-Miles Davis - Ti..., 00-mott_the_hoop...). The main content area is titled 'iTunes U > Vanderbilt University' and features a video player for 'Vanderbilt Law School - WIPO Conference Video'. Below the video player are buttons for 'Subscribe Free' and 'Get All'. A 'Category: Law' and 'Language: English' section is visible. A table lists 8 items with columns for Name, Time, Released, Description, Popularity, and Price. The bottom of the window shows a dock with various application icons and a system tray with the date 3/4/2012 and time 6:40 PM.

Vanderbilt Law School - WIPO Conference Video
Vanderbilt University
Description
For more than 125 years, Vanderbilt Law School has trained excellent lawyers for careers throughout the United States and around the world. Located on the Vanderbilt University campus in Nashville, Tennessee, the law school combines the advantages of a stimulating university community, a top-tier faculty, a small, carefully selected student body, and a vibrant, livable city. Known for offering a rigorous academic program in a collegial, supportive atmosphere, Vanderbilt Law School attracts law...
...More

Name	Time	Released	Description	Popularity	Price
1 World Intellectual Property Organization Organization (WIPO) Conference 2...	24:04	10/26/07	--	■■■■■■■■■■	FREE
2 WIPO Panel 1. The Application of International Treaties in Relation to Colle...	1:43:14	10/25/07	--	■■■■■■■■■■	FREE
3 WIPO Panel 2. Emerging New Services: Their Impact on Collective Manag...	1:40:19	10/25/07	--	■■■■■■■■■■	FREE
4 WIPO Panel 3. Licensing, Documentation and Distribution Issues in the M...	1:36:28	10/25/07	--	■■■■■■■■■■	FREE
5 WIPO Panel 4. Collective Managemeth of Copyright and Related Rights - D...	1:27:36	10/26/07	--	■■■■■■■■■■	FREE
6 WIPO Panel 5. Collective Management of Mechanical Rights	1:50:12	10/26/07	--	■■■■■■■■■■	FREE
7 WIPO Panel 6. The Protection and Enforcement of Copyright and Related ...	1:41:25	10/25/07	--	■■■■■■■■■■	FREE
8 WIPO Panel 7. The Entertainment Industry in Today's Market Economy and...	1:45:26	12/2/08	--	■■■■■■■■■■	FREE

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- Property Law (Spring 2009) - R. Polk Wagner - Prof... - Penn Law
- Statute Law: Making Legislation - Oxford University
- Law School Lectures (audio) - The University of Chicago
- Law Scho

THANK YOU

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QUESTIONS?

