SOUTHERN METHODIST UNIVERSITY

INTELLECTUAL PROPERTY AND INFORMATION TECHNOLOGY

Course Number 7192

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Course Outline

1. Instructors
2. Course Requirements
3. Expectations

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Technological Developments

1. Prehistory: Stone, Fire
2. Agriculture, animal domestication
3. Cities: craftsmen
4. Birth of Science: Egypt
5. Greeks
6. Romans
7. Dark and Middle Ages

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Recent History

1. Renaissance
2. Industrial Revolution
3. 19th Century
4. 20th Century
5. Information Age
6. Biotechnology Age

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Overview of Law

1. History
2. Legal Disciplines
3. Intellectual Property
   - Patent
   - Copyright
   - Trademark
   - Trade secret
   - Antitrust

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Patent Law Overview

1. Government Grant
2. Limited Monopoly to Exclude – Idea
3. Philosophy
4. History
5. U.S. Constitution

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Copyright Law Overview

1. Government Grant
2. Limited Monopoly to Exclude – Expression
3. Philosophy
4. History
5. U.S. Constitution

Trademark Law Overview

1. Government Grant
2. Limited Monopoly to Exclude – Mark
3. Philosophy
4. History

Trade Secret Overview

1. Private Right
2. No Monopoly
3. Philosophy

Patent Law

1. Types: Utility, Design, Plant and Animal
2. Basic Requirements:
   - 35 U.S.C. §101
   - 35 U.S.C. §102
   - 35 U.S.C. §103
   - 35 U.S.C. §112
3. Philosophy
4. What is not Patentable
5. Legal History

Novelty 35 U.S.C. §102

1. Not anticipated
2. §102(a) Known/Used by Others
3. §102(b) Printed Publication
4. §102(c) Abandonment
5. §102(d) Patented Elsewhere
6. §102(e) Another's Patent
7. §102(f) Not Inventor
8. §102(g) Interference

Nonobviousness 35 U.S.C. §103

1. An advance in the art
2. Complicated Analysis

Patent Process

1. Invention Disclosure
2. Patent Application
3. File: U.S./PCT
4. Prosecution
   - Office Action
   - Rejection
   - Allowance
5. Issuance
6. Enforcement

Patent Infringement

- Complaint
- Injunction
- Damages
  - Reasonable Royalties
  - Lost Profits
- Appeal

What is a copyright?

- Long history
- Authors of "original works of authorship"
- Exclusive rights, 17 U.S.C. § 106
- Limitations, 17 U.S.C. §§ 107-121

What is a copyright?

- Original or independent authorship and
- Some minimal level of creativity
- Feist Publications, Inc. v. Rural Telephone Service Co., 499 U.S. 340 (1991)

Who can claim copyright?

- Created at time the work is fixed
- Right only in author or derived therefrom or
- Work for hire

What is a work for hire?

1) Created by an employee within the scope of their employment
   - no written agreement necessary
2) Independent contractor for particular types of work
   - written agreement necessary

Works subject to work for hire

1) Contribution to a collective work
2) Part of a motion picture or other audiovisual work
3) Translation
4) Supplementary work
5) Compilation
6) Instructional text
7) Test
8) Answer materials for a test
9) Atlas

Employee vs. Independent Contactor

- CCNV v. Reid, 490 U.S. 730 (1989)
- Agency principles
- Various factors to consider

Employee vs. Independent Contractor

1) Hiring party's right to control "manner and means" by which the work is done
2) Skill of hired party
3) Source of tools used in creating the work
4) Location of the work performed by hired party

Employee vs. Independent Contractor

5) Duration of relationship
6) Hiring party's right, if any, to assign further projects to hired party
7) Extent of hiring party's discretion or control over when and how long hired party works
8) Method of payment

Employee vs. Independent Contractor

9) Hired party's role in hiring and paying assistants
10) Whether hiring party is in business and whether work is part of that business
11) Whether hired party receives employment benefits
12) Whether hired party is treated as employee for tax purposes

What exclusive rights are given authors?

- Enumerated in 17 U.S.C. § 106
- Limited by various compulsory licenses and exemptions in 17 U.S.C. §§ 107-121

What exclusive rights are given authors?

1) To reproduce the work in copies or phonorecords
2) To prepare derivative works based upon the work

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What exclusive rights are given authors?

3) To distribute copies or phonorecords of the work to the public
   - sale
   - other transfer of ownership
   - rental
   - leasing
   - lending

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What exclusive rights are given authors?

4) To perform the work publicly
   - literary
   - musical
   - dramatic
   - choreographic
   - pantomime
   - motion pictures
   - other audiovisual works

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What exclusive rights are given authors?

5) To display the copyrighted work publicly
   - literary
   - musical
   - dramatic
   - choreographic
   - pantomime
   - pictorial
   - graphic
   - sculptural
   - motion pictures (including individual images)
   - other audiovisual works

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What exclusive rights are given authors?

6) In the case of sound recordings, to perform the work publicly by means of a digital audio transmission
7) Additional protection accorded some visual art in attribution and integrity

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Fair Use Limitation

- 17 U.S.C. § 107
- Use does not infringe if for purposes of
  - criticism
  - comment
  - news reporting
  - teaching
  - scholarship
  - research

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Fair Use Factors

1) Purpose and character of the use
   - commercial
   - nonprofit educational purposes
2) Nature of copyrighted work
3) Amount and substantiality of portion used
   - in relation to work as a whole
4) Effect of the use
   - potential market
   - value of the copyrighted work

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What types of works are protected?

1) Literary works
   - computer programs
2) Musical works
   - along with any accompanying words
3) Dramatic works
   - along with any accompanying music
4) Pantomimes and choreographic works

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What types of works are protected?

5) Pictorial, graphic and sculptural works
6) Motion pictures and other audiovisual works
7) Sound recordings
8) Architectural works

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What works are not protected?

- Works not fixed in tangible form
  - choreographic works not recorded or notated
  - improvisational speeches or performances not written or recorded
- Titles, names, short phrases and slogans
- Familiar symbols or designs
- Mere listing of ingredients or contents
  - recipe

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What works are not protected?

- Ideas
- Procedures
- Methods
- Systems
- Processes
- Concepts
- Principles
- Discoveries
- Works having information entirely common property no original authorship
  - standard calendar, height/weight charts, rulers, tables

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Copyright formalities

- Created automatically upon fixation
- Publication no longer key
  - prior to 1978 required
  - important for anonymous works

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Notice not required, but recommended

- Required under 1976 Copyright Act
- Requirement eliminated per Berne Convention in 1989
- Informs public of copyright protection
- Identifies copyright owner
- Shows first year of publication
  - 2001 © Raymond Van Dyke
- Negates innocent infringement defense

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How long do copyrights last?

- Depends upon creation date
- Sonny Bono Copyright Amendment adds 20 years
- Created after January 1, 1978
  - automatic protection upon creation
  - author's life plus 70 years
  - if joint, last surviving plus 70 years
  - anonymous works, the shorter of
    - 95 years from publication
    - 120 from creation

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How long do copyrights last?

Created and published before January 1, 1978

- 28 years from publication or registration
- renewable during 28th year for another 28 years
  - but under 1976 Act and Bono Amendment 67 year extension

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Transfers of copyright interests

- Any or all of exclusive rights or subdivision of those rights
- In writing and signed
- Nonexclusive transfer not require written agreement
- Personal property right

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Registration of a copyright

- Not required, but advantageous
- Establish public record
- Necessary prior to filing infringement suit
- If registered within 5 years of publication, prima facie evidence of validity
- If registered within 3 months of publication, statutory damages and attorney's fees available; otherwise, actual damages and profits

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Registration of a copyright

- Three elements required to register
  1) application form for type of work
  2) filing fee ($30)
  3) generally 2 copies of work
- Author, owner, authorized agent

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Damages for infringement

- Injunction
- Actual damages and infringer profits or
- Statutory damages
  - one work
  - $500 to $20,000
  - up to $100,000 if willful infringement
- Full costs may be awarded to either party
- Attorney's fees may be awarded to prevailing party

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What are Trademarks and Service Marks?

- Trademark is any word, phrase, symbol or combination thereof which is used by a manufacturer or merchant to identify its goods and distinguish them from those manufactured and sold by others.
- Service Mark is any word, name, symbol or combination thereof which is used in the sale or advertising of services to identify the services and distinguish them from those of others.

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How to Acquire Trademark & Service Mark Rights

Trademark & Service Mark rights are acquired by actual use of a mark, in conjunction with the marking of the goods or services, which are introduced into commerce.

- For a Trademark, the mark must be placed in association with the good it represents by being placed on the goods directly, on a label, attached to the goods, or on the packaging containing the goods.
- For a Service Mark, the mark is used if it is applied to materials which promote, offer for sale or otherwise describe the services. Advertising is a common method of establishing service mark use.

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What is Use In Commerce?

Use In Commerce is the bona fide use of a mark in the ordinary course of trade in intrastate, interstate, or foreign commerce, and not merely to reserve a right in a mark.

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Advantages of Promoting Marks

- Attracts attention
- Symbolizes quality and promotes goodwill for the owner
- Conditions consumers response to automatically recognize owner

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Presentation of Marks

- DO use marks as adjectives
- DO distinguish marks from goods or services themselves; and
- DO use a trademark or service mark notice such as ™ SM or ®
- DON'T use marks as nouns, verbs, plurals or possessives; and
- DON'T use marks next to one another

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Degrees of Distinctiveness

The scope of protection afforded a particular mark varies with the distinctiveness of the mark. In general, the more distinctive the mark, the greater the scope of protection.

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Trademarks

Selection

Arbitrary/Fanciful	Suggestive
Clorox	Coppertone
Descriptive	Generic
Yellow Pages	Potato Chips

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Registration Advantages

A Common Misperception

- "Trademarks must be registered to be protected."
  - Registration Advantages
- Improved Ability to recover damages for infringement
- Presumed ownership of mark
- Nationwide notice of rights
- Right to sue in Federal Court
- Presumption of uncontestability after 5 years
- Basis for foreign registrations
- Protection against registration of similar marks

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Trademarks - Strategies

1. Pre-clearance and evaluation
2. Seek Registration
   - Use based
   - Intent to use
3. Use Proper Notice
4. Maintain Registrations
   - Affidavit of Use and Incontestability
   - Renewal

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Trademarks - Strategies

5. Consistent Use
   - Guidelines
6. Monitor the trade for infringement
7. Use licenses where appropriate
8. The Dilution Act and Famous Marks

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