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IP Primer

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HOW TO USE IP PRIMER

Intellectual property (sometimes called “IP”) is the broad name given to various intangible assets which can provide value to a company or individual. The purpose of intellectual property is to foster creativity by giving creators exclusive rights to their innovation for a limited time.

Intellectual property includes the subject matter of patents, trademarks, copyrights, trade dress, trade secrets, domain names, and know-how. Each form of intellectual property is designed to protect different subject matter and has its own unique rules for developing and maintaining rights. By carefully developing its intellectual property, a company can obtain a significant economic advantage over its competitors. Failure to develop and protect intellectual property can leave a company at a significant competitive disadvantage.

IP Primer was created by BATEMAN IP to aid our clients in keeping necessary records regarding their intellectual property. By completing and maintaining the IP Worksheets (see our website at www.batemanip.com) with your other necessary business records, you will be able to organize information about your intellectual property in one place and be able to better coordinate your protection strategies.

The IP Worksheets made available through our website can serve as part of your safety net should a situation arise in which you need to document your claim to an intellectual property right, whether it be a lawsuit, due diligence or proving the date of invention, use or disclosure. Lawsuits can be raised several years after the creation of an invention, use of a trademark or trade dress or development of a trade secret. Therefore, it is important to maintain records for the life of your company, or at least for the life of the intellectual property at issue.

At BATEMAN IP we strive to provide our clients with excellent, zealous representation before, during, and after litigation. Better yet, we hope to help our clients avoid litigation where possible. We offer IP Worksheets in order to provide our clients with a potential safety net to reduce the risk of litigation and to place the client in a better position in the event that litigation

Disclaimer:

This Intellectual Property handbook is meant to provide general information about intellectual property matters. It is not intended to serve as legal advice. Laws frequently change and you should consult counsel prior to reliance on any statement made herein.

becomes necessary. We encourage you to keep complete and accurate records of your intellectual property.

As our client or prospective client, you are hereby given permission to copy any part of these worksheets for use within your company. Please feel free to document inventions, trademark usage and other intellectual property rights with the included forms. Additional copies of any forms may be downloaded from our website, www.batemanip.com. If you would like to discuss more detailed record keeping strategies for inventions, trademarks, copyrights, trade secrets and the like, please contact us.

PATENTS

A patent does not provide the affirmative right to practice an invention and there is no requirement to obtain a patent prior to marketing a product or service. Rather, a patent provides the negative right to *exclude* others from making, using, selling, or offering to sell a product, process or design that is protected by a patent. A company with patent protection realizes an economic advantage by selling products at a higher price than might be achieved if there were a number of competitors selling the same product. Additionally, a company may be able to obtain sales by offering features which its competitors cannot offer. Revenue can also be generated by licensing the right to use the patented technology, either to competitors or to companies in other industries.

A patent owner has various types of protection should the patent be infringed. A court can award damages for any harm to the patent owner. The damages are required to be no less than a reasonable royalty for use of the invention. Where infringement is willful, the court can triple the damages award and award the patent owner their attorney's fees. Patent owners may also be able to obtain injunctions to stop infringing activities.

Types of IP

- Patent
- Trademark
- Copyright
- Trade Secret
- Know-How

Types of Patents

When most people think of obtaining a patent, they generally mean a utility patent. However, there are several types of patents that are used to protect intellectual property.

A *design patent* provides protection for the ornamental features of a design, as opposed to the utility of a product or process. Design patents last for 14 years from the

Types of Patents

- Utility
- Design
- Plant

date of issuance. Unlike utility patents, there are currently no maintenance fees that need to be paid to keep the patent in force throughout its life. An example of a design patent may be a chair that has a new look. It would be very difficult to protect a chair lacking some novel structure or function with a utility patent. Rather, the patentable subject matter could be the aesthetic look of the chair.

A *plant patent* is awarded to a person who has discovered and asexually reproduced a distinct and new variety of plant, other than a tuber propagated plant or a plant found in an uncultivated state. Plant patents follow the same scheme as utility patents. The patent will expire 20 years from the filing date of the application. While much less common than utility patents, plant patents can be valuable in agriculture and related businesses.

A *utility patent* is designed to protect a product, an apparatus, a composition of matter, or a method for performing a process. Thus, the focus of a utility patent is ultimately on protecting the function of the patented product, process, etc.

Traditionally, utility patents were valid for 17 years from the date of issuance. However, in 1995 the law was changed to have a patent expire 20 years after the earliest effective filing date for the patent application. A patent owner whose patent application predates June 8, 1995 is able to select from the longer of 20 years from the date of filing or 17 years from the date of issue. Patents based on applications filed on or after June 8, 1995 expire 20 years from the earliest effective filing date. Thus, for example, if a patent was filed on January 1, 2000 and issued on June 30, 2001, the patent owner would receive a patent life of 18 ½ years. However, if the patent did not issue until January 1, 2005, the length of patent protection would only be 15 years. Like-

Design Patents

- 14 years from issue
- Ornamental Protection

Plant Patents

- 20 years from filing
- New Variety of Manmade Plant

Utility Patents

- 20 year term from filing
- Product, Apparatus, Composition or Method
- Functional Protection

wise, if a continuation application is filed on January 1, 2010, but claims priority to a parent application filed on January 1, 2005, the resulting patent will expire on January 1, 2025.

The length of a patent term may change in certain circumstances. For example, where the applicant has a previous application which claims very similar subject matter, occasionally, an examiner will enter a rejection suggesting that an application is obvious in light of another commonly owned patent. When this is done, the application may still issue. However, the term must expire as of the date of the earlier filed application. Thus, there are times when the patent will last less than the statutory term of 20 years from the earliest effective filing date.

The Patent and Trademark Office also realizes that there are times when it delays the issuance of applications. Where the Patent and Trademark Office fails to accomplish certain steps regarding the patent in a designated amount of time, the patentee may be given a patent term adjustment which can add months or even years to the term of the patent.

Computer Software Patents.

In the past, computer software was often considered non-patentable subject matter because it was an abstract idea, composed of algorithms and formulas. However, computer software can often be patented when it is connected to a process or data transformation. The law concerning computer software has undergone significant revisions in the last couple of years, so it is advisable to consult your attorney for an up to date view of software patentability.

Business Method Patents.

The Supreme Court recently upheld the validity of business method patents, as long as they are directed to processes and not abstract ideas. One important test, though not the exclusive test, is the “machine-or-transformation” test, or whether the process is directly connected to a machine or transforms an article to a different state.

Biotech Patents

Patents can be granted for inventions relating to genes, novel nucleotide and amino acid sequences, and other biotechnologies. While this improves the profitability of biotech firms, it can also cause problems for researchers who need to seek several licenses to properly conduct their studies. Currently, there is some dispute as to the extent to which human genes can be patented. This will likely be resolved by the Supreme Court in the near future.

Provisional vs. Non-Provisional Patent Applications

Non-provisional patent applications are traditional applications that are fully examined by the Patent Office and can lead to patent rights. Unlike non-provisional patent applications, provisional patent applications are not examined by the Patent Office. Provisional patent applications work to secure an early filing date, which can be preserved as long as a non-provisional application is filed within one year of the provisional application's filing. Provisional applications secure patent rights and can be filed more quickly and inexpensively than non-provisional applications; this allows further time for development, marketing, and raising capital for a technology whose value is not yet fully known, while preserving an early filing date for the original technology.

Provisional patent applications may also be used to extend the patent term of the patent by one year at the end of a patent's life, since the 20 year patent term is calculated from the date that the regular non-provisional application is filed, not the filing date of the provisional application.

The Patent Application Process

Patent Search. Usually, a patent applicant first wants to be sure that no one else has already obtained a patent for their invention. This is usually accomplished by conducting a patent search. Patent searches can vary from a simple computer

search of the Patent and Trademark Office database, to detailed professional searches that spend considerable time investigating the closest relevant prior art patents to determine the likelihood of an invention being patentable. It is usually desirable to conduct at least some form of patent search as the results of the patent search can help the inventor focus on the truly novel aspects of the invention, in contrast to those portions that are likely to be found obvious in light of the prior art.

Patent Search Types

- Personal Knowledge
- Database Search
- Professional Search

Preparation of the Application. A patent application has several parts. Usually the application includes a background section which places the invention in context of the prior art (the state of the industry) or in context of the problem being solved. The application also includes a summary of the invention and a description of the drawings contained in the application. Additionally, the application contains a detailed description of the invention that should enable a person of ordinary skill in the art to make and use the invention. The application should also include the "best mode" of practicing the invention. The patent application must contain at least one claim which defines the legal scope of protection sought by the applicant. Finally, the application has a short abstract describing the subject matter of the invention and drawings used to explain the invention.

Application Parts

- Background
- Summary
- Drawing Description
- Detailed Description
- Claim(s)
- Abstract

Prosecution of the Application. After an application has been filed, it will typically take one to two years to obtain a first office action. In the office action the examiner will review the application and note any failure to comply with the requirements as to clarity of the invention and structuring of the claims. The examiner will also cite the best references that he or she finds and will typically reject one or more of the claims in light of the cited "prior art" (most commonly prior patents and other references relevant to the invention).

The patent attorney then prepares a response either explaining why the prior art cited by the examiner does not meet the claim limitations, or amending the claims to distinguish the invention from the prior art. It is not uncommon for two or three such exchanges to occur between the examiner and the patent attorney prior to issuance of a patent. Recent statistics show that about fifty percent of applications will ultimately be granted as a patent, although this percentage varies significantly over time.

Prosecution

- Publication at 18 months
- 1-2 Years before first Office Action
- 2-3 Responses Common
- Term ends 20 years from filing date
- Fees at 3½, 7½, 11½ yrs from date of Patent Grant

Patent Grant. Once a patent application has been granted it will issue upon the payment of an issue fee to the Patent and Trademark Office. The patent is then issued and will be valid from the date of issuance until 20 years from the earliest effective filing date of the application, provided that the patent owner pays the appropriate maintenance fees. Maintenance fees are currently due 3 ½, 7 ½, and 11 ½ years after the issue date of the patent. Failure to pay the maintenance fees will result in the patent being abandoned.

Common Pitfalls Regarding Patents

The One Year “On Sale” Bar and Early Disclosure. In the United States, a patent application must be filed within one year of the first offer for sale or the first public disclosure of the invention. The offer for sale can occur even before the product has been built (this is common with custom software). Thus, it is important to document any sales activity and to ensure that patent applications are filed within the one-year time frame. Placing the invention in the public

One Year Bar – U.S. Rule

Must file within 1 year of:

- Offer for Sale
- Public Disclosure
- NDA can make disclosure non-public, but may leave “on sale” issue

domain through other means can also invalidate your patent rights. Things such as your own publications, presentations at conferences, and displays at tradeshows all place the invention in the public domain. Thus, it is crucial to file a patent application within one year of any public disclosure or offer for sale to secure your rights. For a variety of reasons, it is preferable to file prior to any public disclosure. For example, foreign countries require that the patent application be filed before any public disclosure (there is no one-year grace period).

As is explained below in more detail, on March 16, 2013 the United States transitioned to a first inventor to file patent application system. This may have a significant impact on companies who chose to rely on the one-year grace period provided under U.S. law to file a patent application.

Proper Inventorship. In the United States, patent applications were filed in the name of the inventors until September of 2012. While applications can now be filed in the name of the owner, it remains important to properly name the inventors. If the Patent Office determines that the inventorship was deliberately misrepresented, the patent can be invalidated or held unenforceable. Therefore, it is important to determine the actual inventors of the claimed subject matter. Just because you own the company or supervised the work does not mean you should be listed as an inventor on the patent.

Inventorship

- Must be Actual Person
- Must be involved--Not Just Company Owner
- Inventor of Content in Claims--Not content in disclosure

First to File Traditionally the U.S. has awarded patents to the first to invent rather than the first to file. On March 16, 2013 the United States transitioned to a “first inventor to file” system. Rather than relying on the date of invention, the new law relies primarily on the date which a party filed its patent application. Thus, it is possible for someone to have made an invention only to see the patent awarded to someone who made the same invention much later but filed earlier. Therefore, it is important to file at least a provisional application, if not a non-provisional application, as soon as reasonably possible to avoid the loss of patent rights.

Additionally, despite the change in the law, it still is important to maintain documentation as to the date of invention and any disclosures of the invention, including public offerings for sale. Under the new law a patent or patent application may be challenged if it can be shown that the person who filed the application derived the invention from a prior inventor. This is not an uncommon situation where there has been a disclosure to other entities. Additionally, one's sales activity may be beneficial in invalidating the patent of another party, if it can be shown that the public disclosure of the invention (i.e. sale of product) was made prior to the other party's filing date.

Non-Obviousness and Novelty Requirement. U.S. patent law requires an invention to be new (or "novel") in order to receive a patent. Not only must an invention be novel, it must also not be obvious in light of material already in the public domain. For example, a simple and obvious combination of two prior devices into a single new device would not be patentable subject matter. Obviousness is determined on a case-by-case basis, and the Patent Office uses the standard of whether a person having ordinary skill in the art would have considered the invention obvious at the time of invention.

Medical Procedures. In many countries medical procedures or any methods for treating the human body are not patentable subject matter. In the United States, a patent may be obtained for a medical procedure; however, doctors are not liable for infringement when performing the medical procedure. This does not mean, however, that a patent on a medical procedure is completely without value.

Often a medical products company may be a contributory infringer if they provide materials that facilitate infringement of the patent's claims.

Medical Procedures

- Procedure or Method
- Some Foreign Not Granted
- Doctors not Liable
- Medical Products Company

Foreign Patent Rights. If an invention is going to be marketed and sold abroad, foreign patent rights may be desirable for further protection. Most commercially relevant foreign countries are part of the Patent Cooperation Treaty (PCT). The PCT streamlines foreign filings through its unified procedure, and allows protection in each of its contracting states through a single filing of an international application. While the PCT is not a single "international patent," it does simplify the process of applying in several countries at once.

One important consideration for patent rights in foreign countries is the requirement of "absolute novelty." Unlike the U.S., most countries do not give a grace period to file a patent application following a sale or public disclosure. The application must be filed prior to public disclosure. Thus, if you are considering filing in foreign countries, it is crucial to file your patent application describing the complete invention in detail prior to publicly disclosing the invention.

Novelty - Foreign

- No Public Disclosure
- No Scholarly Publication
- No Articles
- No Marketing

INVENTION DISCLOSURE INFORMATION

1. What is the title of the invention/name of the project?
2. Who are the inventors? (Include Name, City and State of Residence, and Nationality.)
3. On what date was the invention conceived (thought of)?
On what date was the invention reduced to practice (actually made or practiced)?
4. Do you have notebooks, etc. documenting the invention?
(Provide Copies If Available)
5. Is there anybody who can corroborate the process of developing your invention?
6. Was the invention made as a joint effort with another person or company?
7. Has a working prototype, etc., been made?
8. Please give a brief description of the invention, including the uses for your invention:
9. What is the best form of or best method of using your invention?
10. Does your invention solve any particular problems?
11. Identify anything that you are aware of which is similar to your invention:
12. How is your invention different from similar items already available?
13. Has the invention been disclosed to anybody? If so, when and under what circumstances. Was the disclosure subject to a confidentiality agreement? (Please provide accurate dates as this can impact both U.S. and foreign patent rights)

14. Has the invention been sold, or offered for sale? If so, when: (Please provide accurate dates as this can impact both U.S. and foreign patent rights.)
15. Have you published or advertised anything about your invention? If so, describe the publication:
16. Have you presented your invention at a conference or tradeshow? If yes, describe the presentation and relevant dates:
17. Did you have any funding from the U.S. Government relating to the invention?
18. Are you a single inventor, small business (less than 500 employees), micro-entity, or nonprofit organization?*
19. How many patent applications have you filed prior to this?*
20. Are you under any obligation to license or assign the invention to another entity? If so, please explain:*
21. Are you interested in protecting your invention in any foreign countries?

Signatures and Date of persons making this disclosure:

*Note: Depending on how you answered questions 18-20, you may be entitled to a fee reduction with the U.S. Patent and Trademark Office. It is your obligation to verify your qualification for such a fee reduction as a small entity or micro-entity and to notify us of any change in your qualification for such a fee reduction. Failure to notify the USPTO of any change in qualification for fee reductions will require the retroactive payment of additional fees, and could jeopardize any resulting patent.

Printable/Fillable Forms Available at www.batemanip.com.

TRADEMARKS

Trademarks and service marks (collectively “marks”) are used to identify the source of a product or a service so that consumers can easily determine expected quality. If a mark is associated with good quality, the owner of the mark is more likely to sell its product or service and may sell it for a higher price. The mark must not merely describe the goods, and must be distinctive or have acquired good will in conjunction with the goods.

Trademarks

- Identify the Source
- Consumer Protection Goal

While marks typically are owned by the company or individual producing the product or service, a major component of trademark law is preventing consumers from being confused and preventing others from passing off their products as those of the trademark owner. Thus, the value of a mark is often referred to as the “goodwill” of the trademark owner in the mark.

Trademarks and service marks are similar in numerous ways and are often collectively referred to as simply trademarks or marks. However, each has its own unique issues of which the owner of the marks should be aware.

Trademark and Service Mark Rights Arise From Use

Unlike a patent, trademark rights do not arise from a government grant. Rather, trademark rights spring from use of the mark, commonly called “common law rights”. The extent of these common law rights is determined by the geographical area of use and the goods and services related to the mark. In order

Filing

- Filing Can Secure Priority
- Promptly Register Marks
- Conduct Clearing Searches

to preserve one’s position, however, the Patent and Trademark Office allows individuals to file an “intent to use application.” An intent to use application advises the public that the applicant intends to use the mark for a particular good or service. The advantage of an intent to use trademark application is that it provides constructive use of the mark so long as the applicant

uses the mark within three years of the application’s allowance, submits a statement of use, and otherwise complies with the formalities of the registration process. In other words, if Company A files an intent-to-use application and obtains a registration, it will have priority over Company B who uses the mark after the intent to use filing date but prior to the date Company A actually begins use. Thus, it is important to seek registration of marks promptly and to conduct appropriate clearing searches.

Benefits of Registration

Even though trademark and service mark rights arise from use, registering marks promptly provides several significant advantages. While marks which are not registered can be enforced, it is often more difficult to do so. To enforce a non-registered mark, a party must prove ownership and that the mark has developed secondary meaning (i.e., that the trademark or service mark owner has goodwill in the mark among consumers).

Advantages

- Presumed Your Mark
- Protect Market Expansion
- In 5 Years w/o Dispute Becomes Incontestable

The Legal Presumption. A federal registration usually provides a legal presumption that the owner of the registration is the legal owner of the trademark and has the right to exclude others from the use of any confusingly similar marks. Infringement of a federally registered mark gives rise to a cause of action in federal court. Owners of federally registered marks may also be able to stop importation of goods that include the infringing mark. The owner of a federal registration ordinarily does not need to show that the mark has developed secondary meaning. The registration also serves as nationwide constructive notice of the owner’s right to exclusive use of the mark for the registered goods or services.

Limiting Encroachment. Registration of the mark prevents others from obtaining trademark registrations which can later interfere with protecting trademarks and expanding product lines. If a party adopts a confusingly similar mark and gets

a registration, the owner of the original, unregistered mark must prove the likelihood of confusion and seek to cancel the other registration. In contrast, if the senior user already has a registration for the mark, the U.S. Patent and Trademark Office will usually prevent the junior user from registering the mark.

Obtaining “Incontestability.” Once a mark has been registered on the principal register for five years without being disputed, the trademark registration can become incontestable, as does the trademark owner’s right to use the mark. This can result in a junior user having a trademark registration which precludes the unregistered senior user from obtaining one. Thus, it is desirable to obtain an incontestable registration as soon as possible, to ensure one’s right to use the mark, and to prevent junior users from doing so.

The Registration Process

Registering a trademark can be relatively simple. The user need only identify the mark, identify the proper classification based on the goods or services with which the mark is used, and provide a specimen, if the mark is already in use. There are, however, several potential missteps an applicant can make, and you should always consult with an experienced intellectual property law attorney before filing for a trademark.

Steps in Registration

- Search for Other Conflicts
- Decide Who Owns the Mark
- Select Accurate Goods and Services
- Trademark Examiner Reviews Application
- Respond to Any Negative Result of Examination
- 30 Day Wait for Opposition after Publication
- Give Proof of Use if Intent to Use Application
- Use ® once Registered

Conduct a Clearing Search. Conducting a clearing search prior to filing a registration is highly advisable. Searches can range from a quick search on the U.S. Patent and Trademark Office database to ensure that there is no direct conflict, to professionally conducted searches that look at marks which may

have similar phonetic or design elements that might be confusing. One substantial advantage of the search is that it allows the potential owner of a mark to determine the most appropriate course of action. Has a junior user already registered the mark? If so, a cancellation proceeding would be required. Is there a mark and identification of goods which might sound similar to a trademark examiner if care is not taken in describing the goods or services? A clearing search helps to avoid small problems now from becoming big problems later. It also helps to protect significant investments of time and money in marketing efforts by ensuring that trademarks used now will not conflict with third party prior users.

Select Proper Ownership. It is important to understand and identify who the actual owner of the mark is. Occasionally, an entity with subsidiaries will not properly determine ownership of related marks, which may interfere with registration because related marks owned by different entities may delay or prevent registration of a mark. It is important to determine who actually owns the mark, and if it is being used by another entity, to properly license use of the mark.

Select the Goods or Services. The U.S. Patent and Trademark Office provides a list of goods and services which it deems acceptable. If the owner of a mark can appropriately select one of the accepted goods or services, it will facilitate registration of the application.

There are times, however, when the U.S. Patent and Trademark Office’s list does not properly fit the goods or services with which the mark is used. Likewise, if there is a potentially conflicting mark which has already been filed, carefully constructing the identification of goods or services can avoid a likelihood of confusion rejection by the trademark examiner. Care should be taken in determining the appropriate identification of the goods or services.

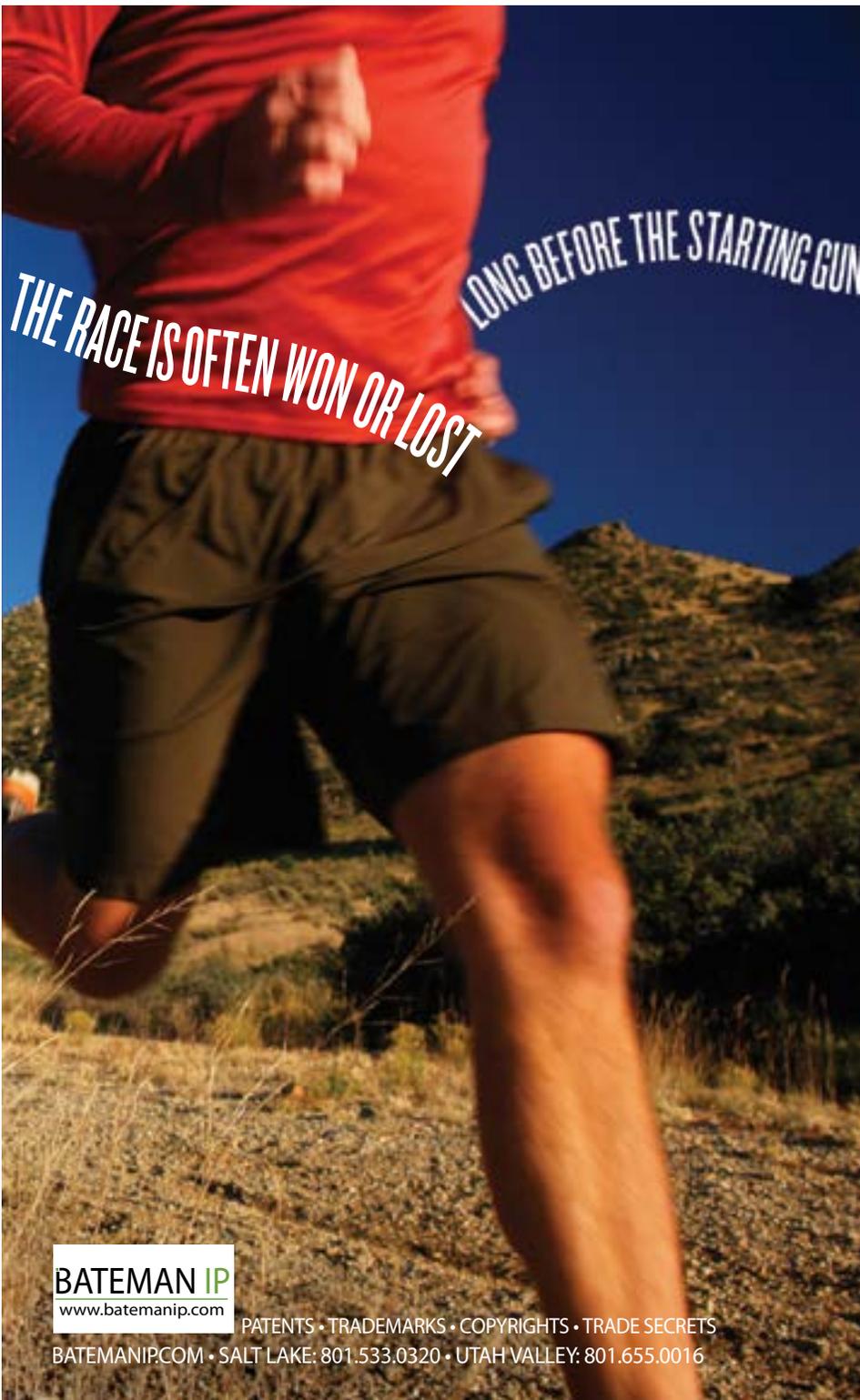
The Examination Process. Once a trademark or service mark application has been filed, it will typically be examined in 3–6 months. The examining attorney will look at the mark and make sure that it meets the requirements of the U.S. Patent

and Trademark Office. The examining attorney will also ensure that the description of goods or services is proper and that it matches any specimen that may be filed. Finally, the examining attorney will refuse the application if it appears that there will be a likelihood of confusion with a mark that has already been registered, and may suspend the application if there is a prior filed application which raises a concern about confusion.

The Response. It is common for a trademark application to be refused on first examination. The attorney prosecuting the trademark application will typically amend the identification of goods or services to resolve any of the examiner's concerns, submit new specimens if required, or explain why there would not be a likelihood of confusion between the pending application and the registered mark of another.

Publication. Once the examining attorney has found the application to be in condition for allowance, the mark is published in the Official Gazette of the U.S. Patent and Trademark Office. Any party objecting to registration of the mark may file an opposition for 30 days from the publication date, or may obtain an additional time period to file the opposition. Opposing a mark before it is registered prevents the mark from being registered until the issue is resolved. If the Trademark Trial and Appeal Board agrees with the opposer, the mark will be refused registration.

The Notice of Allowance. If the application was filed as an intent-to-use application and no evidence of use was filed prior to publication, the U.S. Patent and Trademark Office will issue a Notice of Allowance. The Notice of Allowance gives the applicant six months in which to file a Statement of Use and evidence that the mark has been used in commerce. If the owner submits the Statement of Use, the mark will be registered (typically about 3-4 months after filing of the Statement of Use). If the applicant is not yet using the mark, it can seek extensions (6 months at a time) for up to three years from the mailing date of the Notice of Allowance. If the mark is not in use within three years of the mailing date of the Notice of Allowance, the application is abandoned.



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Registration. After publication of a mark which was in use in commerce, or after the filing of a Statement of Use in an intent-to-use application, the mark is registered with the U.S. Patent and Trademark Office. At this point, the owner of the registration has a legal presumption that it is the owner of the mark, and is allowed to use the ® symbol. (Prior to registration, TM should be used).

If the examining attorney found that the mark was merely descriptive, the mark is registered on the Supplemental Register. This allows the owner to use the ® symbol, but lacks the legal presumption that the mark has goodwill or secondary meaning. In other words, to enforce the mark the owner must prove that the public has come to associate use of the mark with a single source.

Maintaining the Mark

After a mark has been registered, it must be maintained in order to remain registered. If the registrant fails to take the necessary steps, the registration will be canceled.

Declaration of Use. Between five and six years after a mark has been registered, the owner of the mark must file a declaration showing that the mark is still used in commerce. Failure to file the declaration will result in the registration being canceled. (The Patent and Trademark Office is currently considering reducing this time period).

Declaration of Incontestability. Along with the Declaration of Use, the owner of a mark may file a Declaration of Incontestability if the mark has been in use continuously and substantially exclusively since the date of registration, and there is no dispute as to the owner's right to the registration. Once the declaration

Steps in Maintenance

- Between 5th-6th Year – Must File Statement of Use
- May Also File Declaration of Incontestability if no Dispute
- Every 10 years must be renewed
- Mark Must Still be Used in Commerce

has been accepted, it significantly limits the ability of others to challenge both the registration and the right of the owner of the registration to use the mark.

Renewal. A mark must be renewed every ten years after registration. Renewal includes the requirement that the mark still be used in commerce.

Trademark Traps

Misrepresentations in the Application. False statements in an application may be grounds for canceling the registration. The most common misstatements are incorrectly identifying the date of first use and identifying goods or services which extend beyond those on which the mark is actually used. An application identifies that a mark was used “at least as early as” a particular date. One can later claim a date of first use that was earlier than the date identified in the application. However, if one identifies a date which is before the mark was actually used, the registration may be canceled when the misstatement is discovered. Thus, it is important to carefully check the information in each application for accuracy.

Common Pitfalls

- Too Early Date of First Use
- Trademark Must be Placed on Goods or on/in Packaging
- Service Mark Usually Shown by Advertising
- Use In Commerce Date is Shipment of 1st Goods
- Use In Commerce Date is Shipment of 1st Goods
- Use In Commerce Date is Interstate Ads for Services

Understanding the Difference Between Trademarks and Service Marks. In many ways, trademarks and service marks are similar, but there are a few important differences. For example, use of the trademark requires that the mark be “affixed” to the goods. In other words, the trademark must be placed on the goods or on/in product packaging to acquire trademark rights. Advertisements showing the mark are generally inadequate for showing affixation to the goods.

In contrast, a service mark is a mark used in conjunction

with providing services, and does not require affixation. Use is usually demonstrated with advertisements showing the mark in conjunction with the services provided. In order to show use in interstate commerce, the applicant can show that the services were advertised in interstate commerce, rather than actually performing the services across state lines.

Use in Commerce. Obtaining a federal trademark registration requires that the mark has been used “in commerce.” There are numerous cases taking somewhat different views as to what constitutes use in commerce—especially for services. The safest approach is to consider the date of use in commerce to be the date that goods were actually shipped to someone in another state or in which services were advertised in a publication which is circulated in another state. One can argue an earlier use based on any of the commerce theory cases.

Foreign Registration

Depending on your company, protection of your mark abroad may be important. Most foreign countries have a first-to-file system that awards protection based on filing, rather than use. In most countries, oppositions to registration may be filed by a prior user of a mark. If you desire foreign trademark protection, consult an intellectual property law attorney promptly. It is not uncommon for individuals in some countries to file trademark registrations for U.S. brands once those brands become popular. Filing foreign registrations early reduces this risk.

TRADEMARK Service Mark DISCLOSURE INFORMATION

1. Proposed Trademark:
2. Is this mark stylized or does it include a design? Describe:
3. Description of the product(s) with which this mark is to be used:
4. When was this mark first used?

Use Anywhere in U.S.:

In Interstate Commerce:

5. Names of all the persons who assisted in the development of this mark:
6. Do you know of any marks that are similar to this mark?
If so, describe the marks:
7. Describe the trade dress, or the product packaging, this trademark will be used on:
8. Name the individuals who designed the trade dress:
9. Reasons for choosing this trade dress:
10. Has an application been filed to register the mark with:

The State of Utah? __YES__ __NO__ Date if YES: _____

The U.S. Patent and Trademark Office? __YES__ __NO__
Date if YES: _____

11. Name of person completing this form:

Title/Position:

12. Provide an example of the trademark/service mark-photo, label, etc.

Date of this example _____ Completed by _____

13. Proof of Use in Interstate Commerce

Provide a copy of an invoice, etc. to prove the product has been sold in interstate commerce.

Date of this example _____ Completed by _____

14. Instances of Confusion

List all instances of confusion between your mark and any competitor. (For example, if you receive an order for a product that is similar to your trademark, but the product is not offered for sale by your company, please record that information – name of person confused, product they asked for, their address and phone number, any information you can obtain concerning the source of their confusion.)

TRADE DRESS

Trade dress is closely related to trademarks. However, rather than a mark such as a word or symbol, trade dress is the product packaging or, occasionally, the product itself which serves to identify the source of the services. Think of your favorite restaurant chain. It probably has a unique look across its stores. Trade dress protection prevents competitors from adopting a look which is so similar that customers are likely to be confused about the affiliation of the products or services.

Trade Dress

- Can Be Product Packaging
- Can Be Product Itself
- Rights Develop Over Time
- Unique Look

Likewise, trade dress can exist in product packaging. If a competitor adopts the same color scheme and layout of product packaging, it is likely that consumers will be confused. Where customers are likely to be confused, the junior user of the trade dress has created the confusion.

Unlike trademarks which can be inherently distinctive (i.e., the public appreciates immediately that a trademark is a product name and not merely a description of the product), trade dress rights develop over time. The ability of packaging, etc., to serve as trade dress can be helped along by advertising which emphasizes the unique packaging, etc. For example, Owens-Corning was famous for pink building insulation. The shape of a Coca-Cola bottle is well known. NEXIUM® is advertised as “the little purple pill.”

If product packaging, color schemes or some other unique look is used across a product line, call the public’s attention to the unique look. Not only will this help the public remember your products or services, it will also help establish protectable trade dress.

TRADE DRESS DISCLOSURE INFORMATION

1. Proposed Trade Dress:
2. Is this trade dress stylized or does it include a design?
Describe:
3. Description of the product(s) on which this trade dress is to be used:
4. When was this trade dress first used?
Use Anywhere in U.S.: _____
In Interstate Commerce: _____
5. Names of all the persons who assisted in the development of this trade dress:
6. Reasons for choosing this trade dress:
7. Is this trade dress similar to any other trade dress of which you are aware? If so, describe the trade dress.
8. Name of person completing this form:
9. Title/Position
10. Provide a picture of the product bearing the trade dress.
Date of this example _____ Completed by _____
11. Modifications to the Trade Dress
Date of Modification
Reason for the Modification
Date the new trade dress was used in commerce

(Provide a photo of the new trade dress)

Date of this example _____ Completed by _____

12. Instances of Confusion

List all instances of confusion between your trade dress and any competitor. (For example, if you receive an order for a product that looks similar to yours, but the product is not offered for sale by your company, please record that information here – name of person confused, product they asked for, their address and phone number, any information you can obtain concerning the source of their confusion.)

Printable/Fillable Forms Available at www.batemanip.com.

DOMAIN NAMES

Another close relative of trademarks are domain names. While domain names can function as your trademark (e.g., Amazon.com, Expedia.com), they also serve as your internet address. Thus, someone adopting a confusingly similar domain name may be trying to high-jack traffic from your website.

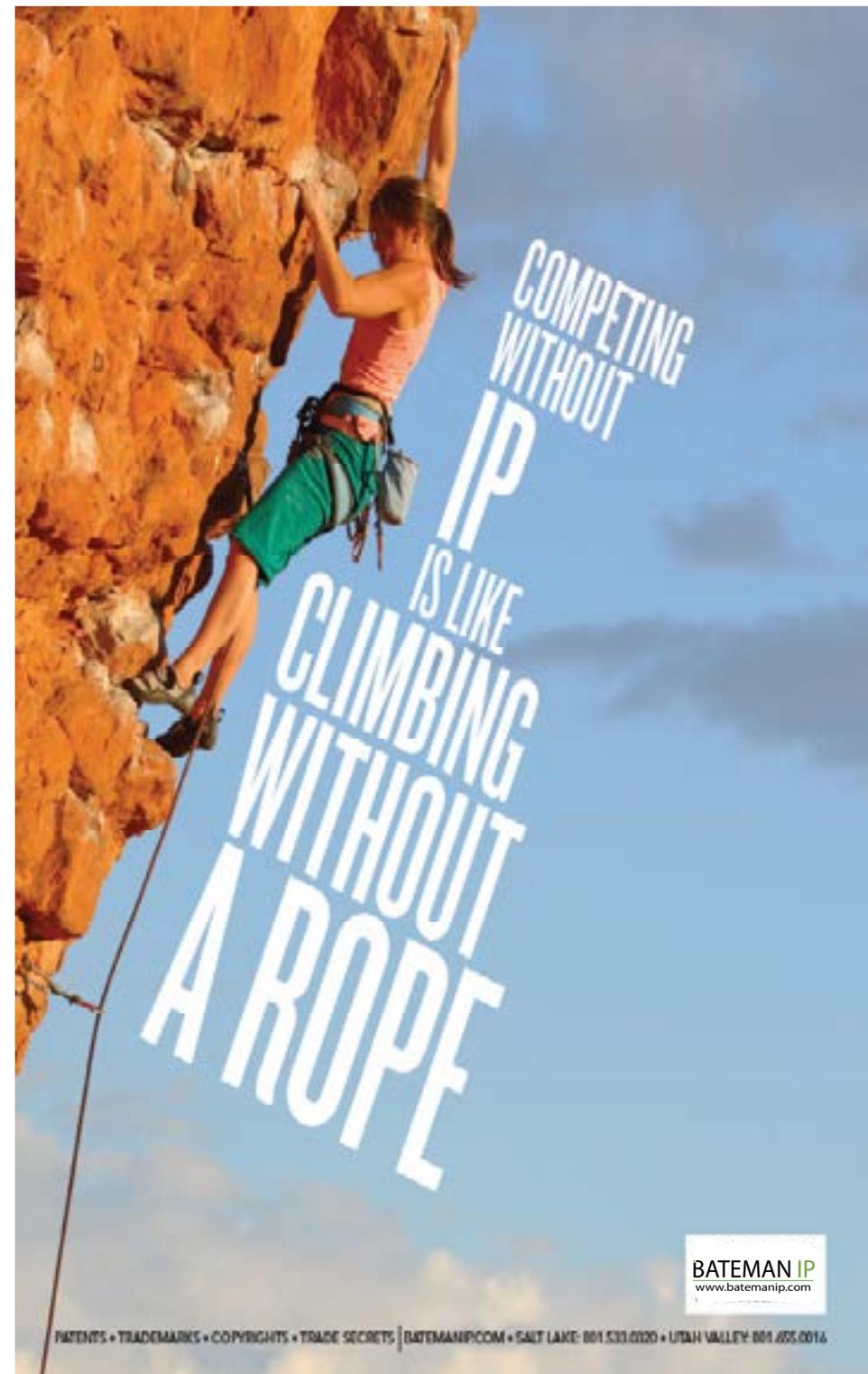
There are several ways of stopping those who improperly adopt domain names – often called cybersquatting. Under the Uniform Domain Name Dispute Resolution Policy (UDRP), the owner of a trademark may be able to cancel the domain name of another who registered and used the domain name improperly. If someone has a domain name which is close to yours or to one of your trademarks, keep any correspondence in which they offer to sell you the mark. The UDRP procedure cannot give damages or costs. However, it is generally less expensive than litigation.

While the UDRP merely cancels or transfers the offending domain name, there are also federal laws that provide for damages and costs. Under the Anti-Cybersquatting Consumer Protection Act (ACPA), the cybersquatter must have a bad faith intent to profit from a distinctive or famous mark. Furthermore, you can combine other disputes or assertions with your cybersquatting claim. The ACPA also allows *in rem* actions against the domain name itself, which is useful when bad-faith registrants provide false identification to the domain name registrar.

The strategic decision of which route to take depends on the facts surrounding your dispute. We suggest that you discuss your situation with an experienced intellectual property firm, so that you can make an informed decision about your brand, domain name and business situation.

Domain Names

- UDRP Less Expensive than Litigation
- UDRP Never Gives Damages or Costs, only Domain Name
- Federal Laws Provide Possible Damages, Costs and Domain Name



COPYRIGHTS

Unlike patents which protect inventions, and trademarks which protect source indicators, copyrights protect expression. In other words, a copyright protects how you express an idea and not the underlying idea itself.

There is a broad array of copyrightable subject matter. When people think of copyrights they typically think of books, songs, and movies. Other things may be protected as well. For example, architectural drawings and designs can be protected.

A copyright attaches to a work as soon as original expression has been created. However, to enforce the copyright it must be registered with the United States Copyright Office at The Library of Congress. The rights of a copyright owner include the right of reproduction, adaptation, public distribution, public performance, public display, and creation of derivative works. Copyrights last 70 years after the death of the author. For “works made for hire,” the rights last 120 years from creation or 95 years from publication, whichever is shorter.

Limitations on Copyright Protection

Copyrights are limited in two important ways: independent development and fair use. If someone independently develops something that is substantially the same as the copyrighted material, the copyright owner has no recourse. Similarly, the copyright material can be used for “fair use” purposes and there is no infringement. Fair uses include criticism, comment, news reporting, teaching, scholarship, and research.

If a copyrighted work is created by an employee for an employer, it may be a “work for hire,” in which case the copyright is owned by the employer, rather than the employee who created the work. Employers should have clear, signed agreements with their employees and with independent contractors regarding works for hire and who owns the copyright.

Copyright

- Protects Expression not Idea
- Protected Immediately
- Register Copyright to Enforce

Benefits of Registration

To enforce a copyright in court, the copyright must be registered with the United States Copyright Office at The Library of Congress. Registering copyrights is a relatively simple process and provides significant benefits for the copyright owner. If someone has a copyright which has been infringed, they are entitled to their damages and/or the infringer’s profits. This can be a substantial remedy where the copyright owner has suffered substantial harm or where the defendant has made significant profits in the infringing work. If the copyrighted work has been registered prior to the infringement, however, there are several other remedies provided to the copyright owner which can be significant.

Registration Benefits

- Statutory Damages or Profits
- Entitled to Attorney’s Fees
- Enables Enforcement

A copyright owner with a registration may be entitled to statutory damages for infringement. This allows the copyright owner to opt out of proving damages and allows the judge to determine an appropriate penalty against the infringer between \$750 and \$30,000 per infringement. Additionally, those with copyright registrations are entitled to attorney’s fees and costs. Availability of attorney’s fees often results in quick settlements by infringers once the infringer realizes they will be paying both sets of attorneys litigating the case. If the infringement is willful, statutory damages up to \$150,000 may be awarded. The court also has the power to grant an injunction and impound materials and articles used to make copies that allegedly violate the copyright.

Registration Process

Copyright registration applications can be filed on-line. Forms are available at www.copyright.gov. Once you have been through several filings, they are relatively easy. However, an attorney should be consulted for the first few filings to ensure that proper information is submitted.

TRADE SECRETS

Most people think of a trade secret as a highly confidential chemical formula or computer algorithm. However, the scope of protectable subject matter is much broader in most states. Moreover, the loss of some types of more pedestrian information can have a greater impact on your business. Trade secret protection can be broader and provide coverage for things that cannot be protected by a patent or copyright, like ideas.

Trade Secret

- Any Information not Generally Available to Public
- Reasonable Steps to Keep Information Confidential

Any collection of information which is not generally available to the public can be deemed a trade secret or protectable “confidential information.” This can include, for example, customer lists (especially specific contacts within customers), supplier information, business plans, and information regarding when customers submit orders or special requirements. Trade secret protection does not protect against third parties who obtain the information by legitimate means (e.g., independent discovery or reverse engineering).

While you may consider information to be confidential, courts will only enforce the confidential nature of the information if the owner took reasonable steps to keep the information confidential. This can include: 1) employment agreements wherein employees agree that certain types of information are confidential; 2) controlling access to confidential information to those who need to know; and 3) advising employees as to what information is deemed confidential and may not be discussed outside the work place.

Too often, an employer will learn of the misappropriation of confidential information only after former employees have gone into competition with the company and started to lure customers away. Protecting confidential information in advance will keep former employees and competitors from gaining an unfair competitive advantage. Employees who call on specific customers should have non-compete agreements and should only be provided with customer contacts for those accounts that they service. Additionally, the contact lists should be marked

confidential and not located where they are available to anyone in the company.

TRADE SECRETS CHECKLIST

Identify information that you want to protect. Consider what information is valuable enough to justify the costs of implementing a protection program and identify relative levels of importance and need for protection. Some types of information that may be valuable include things such as:

<u>Technical Information</u> Formulas Prototypes Processes Compounds	<u>Experiments & Data</u> Analytical Data Calculations Lab Notebooks	<u>R & D Information</u> Reports Know-How Negative Know-How
<u>Process/Production Information</u> Manufacturing Technology Special Production Machinery	<u>Quality Control</u> Quality control procedures Maintenance Know-How	<u>Vendor/Supplier Information</u> Vendor/Supplier contacts Cost/Price Data
<u>Sales & Marketing</u> Sales Forecasts Customer Lists Sales Call Reports Competitive Intelligence Sales/Marketing Studies & Reports Marketing & Sales Promotion Plans Customer Needs & Buying Habits	<u>Internal Financial Information</u> Budgets Operating Reports Forecasts Product Margins Product Costs & Estimates Internal Financial Documents Profit And Loss Statements	<u>Internal Administrative</u> Internal Organization Key Decision Makers Strategic Business Plans Internal Software

Identify the risks of such information being misappropriated. Risks include employees taking work home at night, computer network access (internally and externally), and competitive espionage (dumpster diving, cleaning staff, computer system hacking, etc.).

Establish and document a protection plan. Your plan should include guidelines for protecting the information through both physical (office and network access controls) and other means (employee training sessions, confidentiality agreements, etc.). You should consider the following to protect your information:

- Limit the information to as few people as possible, only those who need it
- Identify the information as confidential (mark as confidential with a stamp or designate with a confidential footnote on a document)
- Protect information on computers with passwords
- Inform employees, independent contractors, and vendors that the information is proprietary and confidential
- Require employees to sign confidentiality and non-compete agreements
- Conduct exit interviews with terminated employees to tell them what information they can and cannot use
- Create required documentation for each of the steps you take

Implement your plan. Implement, and, perhaps most important, police compliance, document and enforce, the plan. You should re-evaluate your trade secrets and confidential business information and your plan for protecting the information at least annually. Your portfolio of trade secrets is constantly changing: some information becomes obsolete and is no longer commercially valuable; new information is created which is extremely valuable but may not be properly protected.

We hope the information contained in this handbook is helpful to you. If you have any questions regarding this handbook or protecting your intellectual property, please contact us.

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