

**Obtaining, Maintaining and Sustaining Intellectual  
Property Rights in Your Brand,  
Products and Processes**

**Summary of Anthony S. Volpe's  
Presentation at the  
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***"Law for the Entrepreneur"***

**Sponsored By:  
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## Identifying Intellectual Property

Any attempt to address the protection of intellectual property rights must begin with an understanding of those rights. Since most intellectual property rights—patents, trademarks, copyrights, trade secrets and confidential business information—are not tangible property, like a house or car, they are more difficult to identify and value. Yet, they can constitute the most valuable and useful asset of the business. The effort to identify and protect these assets may determine the success or failure of a business.

Most intellectual property can be identified with minimum effort if the process for identifying it is established early and followed faithfully. A first and perhaps most important step in the process is to institute a policy of using a combined non-disclosure and non-compete agreement (NDA-NCA) for any disclosure outside of the business. These agreements can be relatively simple and, in fact, it is preferable to have a standardized form so as to avoid conflicting terms. Their purpose is two fold. One, avoid disclosure of the information to a third party and, two, to prohibit the discloser from making use of the information, directly or through research spurred by the disclosure from your business.

Once identified, intellectual property requires some specialized attention.

If it is copyrightable, the copyright notice should be provided in the legend and registration with the Copyright Office, part of the Library of Congress, should be considered. The fact that it is copyrightable information does not necessarily mean that it must be publicly disclosed. There are provisions for copyrighting trade secret information and the Copyright Office has published regulations for just such a situation. This procedure is most suitable to things like source code or manuals which may be provided as part of a service or license.

If it is a trade secret, whether or not copyrightable, there should be an immediate identification of those with a "need to know" the trade secret and disclosure should be limited to them. However, that disclosure should not be made until each individual to whom it will be disclosed has signed a writing acknowledging that the information is trade secret and is disclosed for the purpose of continued employment. Pennsylvania has a Uniform Trade Secrets Act which is very much like the model trade secrets act which has been adopted by many states. The adoption of this Act removed the prior common law standard and established a statutory system for trade secret protection. The Act is broad enough to encompass confidential business information, which includes virtually any information that gives you a competitive advantage.

If it is a potentially patentable right, due consideration is necessary for both domestic (U.S.) and foreign protection. Under domestic law, there is a grace period of one (1) year between disclosure and the filing of a patent application. Under most foreign laws, there is no grace period and absolute novelty is necessary to file applications for patents. Fortunately, the U.S. does provide for the filing of provisional patent applications. Provisional applications have two very important

features. One, they generally are less expensive to prepare and file than non-provisional applications; two, they receive an application number and filing date which can be used to support a claim of priority. Although these applications are not examined for patentability, they are an excellent vehicle for preserving an early filing date before there is any disclosure. By using the provisional patent, you can make a disclosure without losing the right to file for foreign patents and without the expense of filing a non-provisional application. In addition, the provisional application, if properly prepared, can be used as the basis for a disclosure once an NDA-NCA is signed.

By taking advantage of both the NDA-NCA and the provisional application procedure, it is possible to make the necessary commercial disclosure without jeopardizing the available protection for the intellectual property.

One additional concern with regard to inventions, whether or not patentable, is to be certain that the inventor or inventors are under a prior obligation of assignment to the company and that an actual assignment is executed for each invention. In the U.S., the patent application is filed in the inventor's name, not the company's, and the patent issues to the inventor. If the rights are of substantial value or critical to the company's operation, this can be a major impediment to operations, to on going financing, and, in the case of a sale or IPO, to a transaction. Assignments should be obtained from employees and owners in order to avoid issue in the future.

In the case of trademarks, it is critical to remember the value of proper use of the mark as an adjective and not a noun. Use as a noun raises the risk that the mark will become generic and lose its value as a trademark. It must be remembered that a trademark becomes protectable and gains value through use. And, that use must be on the product or service for which trademark protection is desired. It is also important to have an understanding of the various types of trademark rights and the scope of their protection.

Trademarks may enjoy federal protection, state protection, common law rights or all three. Federal registration of a mark provides the broadest protection, but it requires that the mark is used in interstate commerce. State registration and common law do not require interstate use. The scope of protection available under state registration and common law rights is a function of how many registrations were acquired or how broadly the mark was used. Common law rights require nothing more than proper use. Trademark registration, federal or state, is not a great expense; however, a comprehensive trademark search is recommended before a mark is adopted. It can be expensive to re-brand a product or service if the chosen mark is an infringement upon the rights of another entity.



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# TABLE OF CONTENTS

<b><u>Part 1: Preventative Care: Standardizing Protective Research and Development Policies in Your Workplace</u></b> .....	<b>1</b>
<b><u>Part 2: Deciding Between Patent or Trade Secret Protection</u></b> .....	<b>12</b>
<b><u>Part 3: Branding and Product Reputation</u></b> .....	<b>23</b>
<b><u>Part 4: Intellectual Property Issues in Packaging</u></b> .....	<b>40</b>
<b>Additional Definitions</b> .....	<b>45</b>
<b>Helpful Links</b> .....	<b>48</b>

**Part 1: Preventative Care:  
Standardizing Protective Research and  
Development Policies in Your Workplace**

## **I. INTRODUCTION**

Intellectual property can be a company's most important asset. Due to the intangible nature of intellectual property, it can often be more difficult to protect than tangible property. Tangible property, such as real property or personal property, has a physical manifestation and can often be secured, controlled and protected by physical means such as fences, alarms, ownership documentation, etc. Intellectual property, on the other hand, is a product of the mind, and while it may be expressed or carried out in a physical form or embodiment, it may be easily copied and transported or transferred.. As a result, there is often no easy way to build a "fence" around intellectual property. Because of the fragile nature of this type of property, important and valuable rights can be easily forfeited. Therefore, it is essential to understand how to secure and protect your intellectual property rights. A company's best approach to protecting intellectual property rights is to implement uniform internal procedures and administer an appropriate confidentiality policy.

## **II. WHAT ARE INTELLECTUAL PROPERTY RIGHTS?**

Intellectual property rights are valuable ideas and concepts, that are protected by giving the inventor, author, etc. rights to prevent others from practicing their invention, work, tradename etc. The four key classes of intellectual property are:

1. **Patent:** Patents may be granted for the invention of any new and useful process, machine, manufacture or composition of matter or any new useful improvement thereof. In its most general sense, a patent is a property right that grants the inventor or owner the right to exclude others from making, using, selling, or offering to sell the invention in the United States for a limited period of time.

2. **Trademark:** A TRADEMARK is either a word, phrase, symbol, or design, or combination of words, phrases, symbols, or designs which identifies and distinguishes the source of the goods or services of one party from those of others. Trademarks promote competition by giving products corporate identity and marketing leverage.

3. **Copyright:** Copyrights protect original works of authorship fixed in a tangible medium of expression. Copyrighted works include literary, dramatic, and musical compositions, movies, pictures, paintings, sculptures, computer programs, etc. Copyright protects the expression of an idea, and not the physical expression of the idea.

4. **Trade Secret:** Generally, a trade secret is any formula, manufacturing process, method of business, technical know-how, etc. that gives its holder a competitive advantage and is not generally known. The legal definition of a trade secret and the protection afforded to a trade secret owner varies from state to state.

### **III. EMPLOYEE CONFIDENTIALITY PRACTICES**

Protection of your intellectual property within an organization should begin at the date of hire when an employee executes an employment agreement and should be more specifically reinforced on a project by project basis.

## **A. Employment Agreements**

An essential place to start protecting your intellectual property is when hiring employees. Every employee that may be working on developing or with your company's existing intellectual property should be required to sign an agreement that includes a standard non-disclosure and assignment of interest provision.

Non-disclosure agreements, also known as confidentiality agreements, define the limits of the employee's and employer's rights and responsibilities regarding intellectual property. Non-disclosure agreements allow a company to share its IP without unduly jeopardizing that information. The agreement should include a recitation of the confidential relationship created, a list of the types of material and information that are deemed confidential, indemnification against disclosure, and a statement defining the term of the agreement.

A non-compete agreement should have a limited and clearly defined scope that is tailored toward the technology, business markets, and geographic location of the employee. It should also include a specified duration that is reasonable – most agreements don't last longer than two (2) years. Furthermore, due to the volatility in this area of the law, it is useful to include a clause that allows for severance or splitting of any provisions deemed unenforceable.

The assignment of interest provisions should address all forms of intellectual property developed by the employee during the scope of employment or with company resources. Any inventions or intellectual property the employee claims prior to beginning employment can result in disputes. Therefore, the agreement should also include a list of those claimed inventions or secrets.

## **B. Project Agreements**

Each project requires individualized protection. Every employee assigned to work on a project should sign a project specific non-disclosure agreement, non-compete, and assignment of interest provision. The same applies to any third parties that are consulted for a specific project. An appropriate non-disclosure agreement is particularly important in the following examples:

- If a project requires advice or assistance from out an outside consultant, the appropriate non-disclosure agreement ensures that the consultant will not disclose the details of any confidential or sensitive business information to competitors.
- If a new prototype is developed and a production cost estimate is required from a third party manufacturer.
- If a new business plan is developed and it needs to be presented to investors.
- If you are attempting to sell your company or some of your intellectual property and the buyer needs your company details, including sensitive business information.

## **IV. UNIFORM INTERNAL PRACTICES**

To be effective, company processes and procedures must be formalized into standard procedures. For example, inadvertent disclosures, whether by publication, display of products at a trade show, or the sale of a product that embodies the company's intellectual property, can result in a forfeiture of your intellectual property rights. Similarly, filing a patent application too late or failing to prepare and maintain good records of the invention can be fatal to securing patent protection.

For example, under the patent statute, an inventor is barred from receiving a patent if the invention was “patented or disclosed in a printed publication in this or a foreign country or in public use or on sale in this country more than one year prior

to date of the application for patent in the United States.” 35 U.S.C. § 102(b). Employees can inadvertently run afoul of § 102(b) by displaying or presenting protectable information at conferences, trade shows and professional society meetings because a disclosure is any release of information that allows one of skill in the art to make or use the invention.

#### **A. Educate Your Employees**

Education and training prepares your employees to recognize and avoid these pitfalls. A brief training program is useful to introduce new employees to the company's intellectual property policies. The program should describe how the employee should treat intellectual property such as reporting and documenting new discoveries. Areas such as publishing articles, presenting at conferences and integrating discoveries into production activities should be discussed so the employee is informed about the risks. It is critically important to discuss scope of employment with your employees so they are aware of risks of inadvertent disclosure and the opportunities that are created by new developments and innovations. Take the time to explain your rights as an employer to any innovations, ideas or discoveries developed using company assets, resources or time.

#### **B. Develop An Internal Tracking System**

As soon as an employee develops an idea that the company intends to pursue, a project reference number and file should be assigned to the project to allow the company to monitor and document progress. Once the project is identified, a conscious decision should be made regarding which type of intellectual property protection best suits the project. Making these determinations early helps prevent

the loss of property rights due to the unique characteristics associated with each form of intellectual property protection.

### **C. Record Keeping**

An essential part of every intellectual property protection program is a strong, consistent record keeping policy. Inventor's notebooks should be a part of every research and development project that might produce protectable subject matter because these notebooks are an important form of evidence in intellectual property law. They can be used to prove who the inventor is and when the invention was made.

Who invented first is an essential inquiry in U.S. patent law. The courts look at two factors to determine who invented first: (1) *conception* and (2) *reduction to practice*. Conception is the mental formulation and disclosure by the inventor of a complete idea for a product or process. The test for conception is whether the inventor had an idea that was definite and permanent enough that one skilled in the art could understand the invention. If required to prove conception, conception must be proved by corroborating evidence preferably by showing a contemporaneous disclosure to a third party who is qualified to understand the material.

There are two types of reduction to practice, “constructive” and “actual.” Filing a complete patent application constitutes a “constructive” reduction to practice for purposes of determining priority and patentability. To prove “actual” reduction to practice an inventor must have: (1) constructed an embodiment of the invention, and (2) tested the device or process so as to establish its capacity to successfully perform its intended purpose.

A third element, *reasonable diligence* between the date of conception and reduction to practice may be considered if a party is challenging the date of invention. Reasonable diligence to reduce the invention to practice after the time of conception is considered if a party was first to conceive but last party to reduce to practice. To establish diligence, the evidence must show that the inventor worked diligently to reduce the invention to practice after conception without any substantive periods of delay.

A properly kept inventor's notebook is the best evidence of conception, diligence and reduction to practice because it establishes a permanent record which can be referred to in the future to prove what was done during the course of a project and particularly what inventions were made and when. When improperly kept, it may fail to prove what was conceived or done, and it may fail to fix important critical dates.

The notebook must document the inventive process and must demonstrate that the events took place at the time asserted. A well kept notebook should conform to at least the following requirements:

- a) Notebooks should consist of permanently bound, good quality paper with page numbers.
- b) The notebook should include a printed set of maintenance instructions
- c) Each entry should identify the particular project and include a date and full details of the experiments, conditions, and procedures performed.
- d) The pages should be corroborated by a witness, preferably at least once a week. The witness should be a competent non-inventor capable of

reading and understanding the entries. The witness must sign and date all pages of the notebook that have been read and understood.

- e) When each notebook is completed, it should be returned to a central record keeping authority and maintained as a corporate record.
- f) Access to the notebooks or project files should be limited to those involved in the project.

#### **D. Track Employee Contributions**

To prevent minor contributors from later claiming rights to the invention, employee contribution should be documented. This is particularly important in the context of patent protection because every inventor needs to be identified on the patent application. In a typical corporate research and development atmosphere, many people make contributions on the project. Nevertheless, only people making significant contributions to the project will be considered inventors. To be significant, the contribution must be a definite and permanent element of the invention. Contributions of labor or supervision are typically insufficient to vest inventorship rights in the invention.

## **Part 2: Deciding Between Patent or Trade Secret Protection**

## **I. INTRODUCTION**

Patents and trade secrets are two essential venues for protecting business innovations. Patent and trade secret protection are often complementary and overlap to a degree, requiring careful consideration for evaluating the benefits of each with respect to a company's innovations. Deciding between patent or trade secret protection requires a careful balancing of various commercial, business, technical and legal factors.

A brief overview of patent and trade secret law and the advantages/disadvantages of each is provided below.

## **II. PATENTS**

A patent is a contract between the United States and the inventor(s) in which the inventor is granted a limited monopoly to exclude others from making, using, or selling a claimed invention in the United States for a pre-defined period of time. In exchange for these rights, the inventor is required to disclose the full and complete details of the invention to the public to promote innovation. The theory behind the patent system is that one inventor reading a patent disclosure of another may promote innovation by improving on that invention, and potentially filing a patent application for that improvement.

The patent system is grounded in Article I, §8 of the U.S. Constitution which states, "Congress shall have [the] power...to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive

right to their respective writings and discoveries.” Based on this Constitutional authority, Congress promulgated the Patent Act, under Title 35 of the United States Code.

### ***A. Types Of Patents***

There are three types of patents: utility, design and plant. A utility patent protects new and useful inventions. Utility patents protect functional innovations such as processes, machines, compositions of matter, or any improvement thereof, and once issued, has a term of 20 years from the earliest effective filing date of the application. A design patent protects the appearance of an item, not its structural or functional features, and has a term of 14 years from its date of issuance. A plant patent protects new varieties of man-made asexually reproduced plants. Naturally occurring plant varieties, however, are not patentable. Like a utility patent, a plant patent expires 20 years after its earliest effective filing date.

### ***B. Applying For A Patent***

A patent application must be filed by the actual inventor(s) of the subject matter. Determination of inventorship can be a difficult and complex task which requires legal analysis. Conception is typically considered the key for determining inventorship. Conception is the mental formulation and disclosure by the inventor or inventors of a complete idea for a product or process. Contributions of labor or supervision are typically insufficient to vest inventorship rights in the invention.

After conception, the inventor should act diligently to reduce the invention to practice and file a patent application, if patent protection is desired. A patent application requires a specification including at least one claim, an oath or declaration executed by the inventor(s), and the application filing fee. The specification includes a full and complete disclosure of the best mode of making the invention. A claim defines the legal scope of protection which sought by the patent applicant. The oath or declaration requires a statement from each inventor that he/she is the original and first inventor of the subject matter in the claims. Finally, drawings should be included in the application when necessary to assist describing the invention.

Once a complete patent application is filed with the U.S. Patent and Trademark Office, a filing date and application serial number are assigned to the application. The filing date is important because it can act to set a date which any prior art cited to reject the claims must antedate, and it can set the date for determining any statutory bars under 35 U.S.C. § 102(b).

### ***C. Patent Requirements***

In order for an invention to be patentable, it must be directed to patentable subject matter, and must be new, useful, and nonobvious over the prior art.

#### **1. Patentable Subject Matter**

Under 35 U.S.C. § 101, “[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful

improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.” Patentable subject matter has been said to “include anything under the sun that is made by man.” However, (1) laws of nature; (2) natural phenomena; and (3) abstract ideas are not patentable.

## **2. Utility Requirement**

To satisfy the requirements of §101 it is not only necessary to demonstrate that the subject matter of the invention is patentable, but the patentee is also required to demonstrate that the claimed invention is "useful" for some purpose. In most fields, the utility requirement is easily met by demonstrating any useful result. However in the biotech field, a slightly higher threshold is required to meet the utility requirement necessary for patentability. For a claimed invention to fail to meet the utility requirement it must be "totally incapable of achieving a useful result." Therefore, an invention that is at least partially useful will satisfy the utility requirement.

## **3. Novelty Requirement**

The novelty requirement is defined 35 U.S.C. § 102. In particular, 35 U.S.C. § 102(a) and (b) state:

A person shall be entitled to a patent unless

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than

one year prior to the date of the application for patent in the United States,

A claimed invention is said to be "anticipated" and therefore unpatentable if a comparison of the claimed invention with a prior art reference reveals that each and every element of the claimed invention under attack is in the prior art reference. Prior art is "everything" existing prior to the date of invention. To be the basis for a rejection of a patent, in most cases, prior art must have been accessible somewhere in the world (i.e., "secret" materials cannot act as prior art).

Furthermore, under the "statutory bar" provision of 35 U.S.C. § 102(b), disclosure of an invention, anywhere in the world, more than one year before applying for a patent serves as a bar to obtaining a patent. Any public disclosure, use, offer for sale or sale of the invention by another, with or without the inventor's consent, can be a statutory bar.

#### **4. Non-Obviousness Requirement**

The obviousness requirement is set forth in 35 U.S.C. § 103(a) which states:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

A patent may not be obtained if it contains only obvious differences from prior art. An invention is obvious if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole

would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

The obviousness determination is based on four (4) factual inquiries: (1) the differences between the prior art and challenged claims; (2) the level of ordinary skill in the pertinent art field at the time of the invention; (3) what one possessing that level of skill would have deemed to be obvious from the prior art reference; and (4) objective evidence of obviousness or nonobviousness.

## **5. Patent Application Requirements**

An invention must be described in a patent application with enough particularity such that those skilled in the art will be able to make, use and understand the invention. This requirement consists of three components:

- (1) **Enablement Requirement:** must describe the invention in the manner that would allow one skilled in the art to make and use the invention without undue experimentation.
- (2) **Best Mode Requirement:** the description must disclose the preferred way of carrying out the invention at the time the application is filed.
- (3) **Adequate Written Description:** the application must describe the invention in sufficient detail to show one skilled in the art that the inventor possessed the claimed invention at the time of filing.

### ***D. Patent Infringement***

Patent infringement is governed by 35 U.S.C. § 271, which in its broadest sense provides, “whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefor, infringes the patent.” 35

U.S.C. § 271(a). In order to determine if a product or method infringes a patent, the product must read on all elements of the claims or the equivalent of each element (e.g. if there 5 elements and accused device has 4, then no infringement). Remedies for infringement can include lost profits or reasonable royalties.

### **III. TRADE SECRETS**

Unlike patent law, which has its roots firmly grounded in federal constitutional and statutory law, trade secret law is a state law doctrine that developed out of the common law doctrine of unfair competition and unfair business practices. Until the Uniform Trade Secrets Act (UTSA) was developed in 1985, trade secret law varied significantly from state to state. However, to date, forty-two (42) states have adopted the USTA to implement more uniformity in trade secret law.

A trade secret is defined in the USTA as “information, including a formula, pattern, compilation, program device, method, technique, or process, that: (i) derives independent economic value, actual or potential, from no being generally known to, and not being readily ascertainable by proper means by, other persons who can obtain economic value from its disclosure or use, and (ii) is the subject of efforts that are reasonable under the circumstances to maintain its secrecy.” Trade secrets are protectable only as long as they are kept secret. Failure to obtain written agreements with persons who have access to the trade secret or establish security measures to prevent disclosure of the trade secret will jeopardize trade secret rights.

As the roots of trade secret law are grounded in the common law of unfair competition, the focus is prohibiting dishonest or improper conduct that is intended to uncover or reveal the trade secret. Theft, bribery and industrial espionage are types of conduct that trigger a trade secret violation. Similarly, violating a non-disclosure agreement or obtaining the trade secret from a third party that is bound by a duty of confidentiality or has no right to disclose the trade secret will also give rise to a violation.

Under patent law, a subsequent inventor can be liable even though the invention was developed completely independent of the patented invention; under trade secret law, independent discovery and use of the trade secret is not a violation. Competitors are also allowed to discover trade secrets through "reverse engineering." In other words, they are allowed to take apart a product to learn how it was made.

Trade secret protection covers a wider range of possible innovations and inventions and it has a potentially unlimited duration. As set forth above, the UTSA defines trade secret as any information, including a formula, pattern, compilation, program, device, method, technique, or process that derives independent economic value from being "secret." While concepts, databases, and compilations are generally not patentable; the UTSA expressly protects them if they are valuable to the business and the business takes steps to keep them secret.

Unlike patents, there are no formal application or registration requirements for trade secrets. Any valuable and secret information used by a business is

protected as long as the business takes reasonable steps to keep it secret. This generally means the cost of trade secrets are lower; however, sometimes the cost of trying to keep information secret is more than the cost to secure a patent.

#### **IV. SELECTING THE RIGHT IP STRATEGY**

It is best to have an appropriate IP strategy devised once the conception of an invention is complete. Patent protection is typically favored when:

- it is likely that a product can be reverse engineered;
- the innovation might be discovered by others simultaneously;
- the technology is difficult or costly to keep secret;
- the technology must be disclosed to be of use;
- the subject matter is patentable; and
- the commercial value of the innovation exceeds the registration and maintenance costs.

Inventions which are easily kept secret and not easily reverse engineered are well suited for trade secret protection. Trade secret protection is favored when:

- the subject matter may be unpatentable;
- the subject matter is part of a relatively “crowded” art;
- the potential profits are low;
- keeping the innovation a secret is easy;
- the potential market is likely to last longer than 20 years;
- the technology is developing rapidly and the innovation is likely to be obsolete in a few years; and
- an invention is no longer patentable.

Other points to consider include: trade secrets are cheaper compared to the expense involved in obtaining a patent; and trade secrets require careful procedures to maintain secrecy. For example, contracts and NDA’s must be routinely executed and maintained.

In deciding the best strategy to protect your innovations, it is important to carefully weigh the potential benefits and detriments of patent versus trade secret protection, and consultation with an IP attorney is recommended.

## **Part 3: Branding and Product Reputation**

## I. INTRODUCTION

As the effects of globalization spread, it is becoming clear that with the resulting increased competition, goods and services can be produced anywhere in the world and delivered in the United States at ever lower costs. In order to achieve a premium price for their goods and services, many companies are looking to their trademarks or brand to maintain their margins. In some ways, brand names no longer merely indicate the origin of their associated goods and services, but are now "the" good or service. Frequently, brands are at the heart of corporate acquisition strategies, as witnessed by the recent acquisition of IBM's PC business by a Chinese company. Brands are also used as collateral to secure loans, as assets for capital gains purposes under federal tax law, and are considered property of "the estate" under the Bankruptcy Code. Clearly, a distinctive brand name in a competitive marketplace can be among a company's most valuable assets and must be protected accordingly.

## II. TRADEMARKS

### A. **Defining the Terms**

1. **Trademark.** The term trademark<sup>1</sup> is used broadly and interchangeably to refer to almost any type of mark, but technically a "trademark"

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<sup>1</sup> The term "brand" is often used interchangeably with "trademark" in many industries and in the advertising community in reference to a word trademark. "Brand name" is similarly used. "Name brand," refers to a very well known word trademark. The word "brand" is also commonly used in the advertising industry immediately after a word trademark and before the generic name of the product (e.g., Scotch brand transparent tape) to make it clear that the word is a trademark and not a generic term.

includes any word, name, symbol, or device, or any combination thereof, used to identify and distinguish goods or products, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

**2. Service mark.** The term "service mark" means any word, name, symbol, or device, or any combination thereof used to identify and distinguish the services of one person, including a unique service from the services of others and to indicate the source of the services, even if that source is unknown. Titles, character names and other distinctive features of radio or television programs may be registered as service marks notwithstanding that they, or the programs, may advertise the goods of the sponsor.

**3. Trade names.** The terms "trade name" and "commercial name" mean any name used by a person to identify his or her business or vocation. It typically refers to the corporate, partnership or other name of a business. The business may, in turn, market goods or services under one or more trademarks or service marks. Thus, "General Motors Corporation" is used as the trade name of the business which sells products under the trademark CADILLAC. Part of a trade name can also be a trademark. Trade names are not registrable under the Lanham Act for federal registration, although they may be registered as trademarks if they are *used* as trademarks. For example, FORD is a trademark, but Ford Motor Company is a trade name. However, there is protection for trade names under common law.

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4. **Trade Dress.** The term trade dress refers to the overall impression created by a product. It can be comprised of any combination of shape, color, design and wording. It can be packaging, a restaurant design or a product itself such as the Coke bottle.

5. **Certification Mark.** The term "certification mark" is any word, name, symbol, device, or any combination thereof, used, or intended to be used, in commerce with the owner's permission by someone other than its owner, to certify regional or other geographic origin, material, mode of manufacture, quality, accuracy, or other characteristics of someone's goods or services, or that the work or labor on the goods or services was performed by members of a union or other organization.

6. **Collective Mark.** The term "collective mark" is a trademark or service mark used, or intended to be used, in commerce, by the members of a cooperative, an association, or other collective group or organization, including a mark which indicates membership in a union, an association, or other organization.

## **B. Functions of a Trademark.**

Trademarks serve the following functions:

1. **Source Identifier.** The essential function of a trademark is to indicate a common source for goods or services irrespective of whether the consumer knows the actual identity of the source.

2. **Indication of Sponsorship of Authorization.** Trademarks can also indicate a secondary source. For example, the presence of a collegiate logo

on a sweatshirt such as the mark and logo of the Notre Dame Fighting Irish can signify that the mark has been licensed by the university.

**3. Distinguish Goods or Services.** A trademark is used by a business to identify itself and its products or services to consumers, and to distinguish its products or services apart from other businesses.

**4. Indicate Value and Image.** A trademark can create in the mind of a consumer the impression that a product has certain characteristics or value. For example, when consumers hear CADILLAC, BMW, DELOREAN, EDSEL, or CHEVY they instantly assign a value to the mark. These brands are so strong that they are often used outside the field of automobiles. For instance, people will often refer to a product or service as the Cadillac of XYZ and the Chevy of XYZ.

### **C. Forms of Marks**

Marks can come in many forms, including:

- Word, Abbreviation (e.g., COCA-COLA; COKE)
- Logo (e.g., COCA-COLA)
- Representation of Quality (e.g., UL certification)
- Symbol (e.g., McDonald's Arches)
- Shape (e.g., Pepperidge Farm's goldfish, Coca-Cola bottle)
- Letters (e.g., IBM)
- Slogan (e.g., "*Just Do It*")
- Sound (e.g., Harley-Davidson exhaust sound)
- Color (e.g., Pink for Owens Corning's insulation)

## **D. Selecting and Adopting Marks.**

### **1. Strength of the Mark**

Selection of a strong, protectable mark is important because a strong mark is typically given a broader scope of judicial protection. In addition, with a strong mark, likelihood of confusion with similar marks will be more readily inferred.

The strength of a mark depends on where it falls on the spectrum of distinctiveness. The types of marks on the spectrum are identified below in order from strongest to no protection at all.

**a. Fanciful or Coined Marks.** A fanciful mark is a coined term that has no dictionary meaning and was created for the sole purpose of serving as a trademark. One of the most famous examples of a fanciful mark is EXXON for petroleum based products.

**b. Arbitrary Marks.** A mark is arbitrary if it has meaning in common usage in the language, but does not suggest a meaning or describe any feature of the mark. APPLE for computers is a famous example of an arbitrary mark.

**c. Suggestive Mark.** A suggestive mark is a mark that requires some imagination, thought or perception to reach an idea as to the nature of the goods. An example of a suggestive mark is WHIRLPOOL for washers.

**d. Descriptive Marks.** A descriptive mark describes the intended purpose, function or use of the goods. An example of a descriptive mark is Excedrin's mark EXTRA STRENGTH PAIN RELIEVER. Many people involved in

the selection of marks understandably prefer to select descriptive marks because less time and money is required to educate the consumer about the trademark. However, a descriptive mark cannot be registered or protected until it has acquired distinctiveness or "secondary meaning" which means that through use and marketing the descriptive mark has come to identify a product or service and can distinguish it from others.

*e. Generic Marks.* A generic mark is a mark which loses its ability to function as a source identifier and becomes the name of a particular type or category of product. The following marks are considered to have been genericized:

- cellophane,
- escalator,
- thermos,
- aspirin (in U.S.), and
- Yo-Yo

## **2. Necessity of a Trademark Search**

In the United States, trademark rights are acquired through use of a trademark. Anyone who introduces a new trademark faces the risk that someone else may have already obtained rights to a similar mark in the same market. Although a trademark search is not required, the failure to search can lead to a trademark infringement claim which can possibly result in:

- loss of investment in market research, advertising and promotional materials;

- loss of marketing momentum;
- embarrassment; and
- monetary damages, costs and attorneys fees.

## **E. Obtaining a Federal Registration**

**1. Advantages of Federal Registration.** Although a trademark owner acquires rights through use of the mark in the geographic area where it is used, a federal trademark registration on the Principal Register provides several advantages, including:

- The right to use the ® with all federally registered marks;
- Provides constructive notice to the public of the registrant's claim of ownership of the mark;
- Confers nationwide priority of rights effective from the U.S. application filing date;
- A legal presumption of the registrant's ownership of the mark and the registrant's exclusive right to use the mark nationwide;
- The ability to bring an action concerning the mark in federal court;
- The U.S. registration may serve as a basis to obtain registration in foreign countries without first using the mark; and
- The ability to file the U.S. registration with the U.S. Customs Service to prevent importation of infringing foreign goods.

## **2. Trademark Application Process**

In order to file a trademark application in the United States, a U.S. based entity must file an application based on a bona fide intent-to-use or actual use of the mark on all the goods and/or services identified in the application. The application will likely be examined by the U.S. Patent and Trademark Office (USPTO) in approximately four (4) to six (6) months. The examination consists of a search by an examiner to assess whether the mark identified in the application is likely to cause confusion with any preexisting valid applications or registrations as well as a determination of whether the mark itself is registrable. If approved by the examiner, the application is published for opposition in the USPTO *Official Gazette*. If no opposition or request for extension of time to file a notice of opposition (for a maximum period of ninety (90) days is filed within thirty (30) days of publication, the application will proceed to registration. In the case of an intent-to-use application, it would then be necessary to submit a declaration evidencing use of the mark in commerce with all of the designated goods and/or services. On average, it takes approximately thirteen (13) months from filing of the application until a registration is issued. However, the period can be shortened if the applicant uses the goods and services designations that have been pre-approved by the USPTO.

## **3. Post registration issues**

After a trademark registers, it is necessary to continue using the mark. A mark is generally presumed abandoned if it has not been used for a period of three

(3) years. The USPTO also requires that a declaration of continued use of the mark on all the designated goods and/or services be filed between the fifth and sixth year after registration. In order to maintain a registration it is also necessary to file a similar declaration of continued use and renew the registration every ten (10) years.

## **F. International Protection**

Trademark protection is also available internationally. Unlike the U.S., most countries award trademark rights solely on a first to file basis. Therefore, it can be extremely important to file a trademark application in key foreign jurisdictions. As noted above, another advantage of a U.S. registration is that it can form the basis of an application in a foreign country without the necessity of first having used the mark in that country. Moreover, in most countries, a U.S. company can file a trademark application that claims the same U.S. application date if the trademark application is filed within six (6) months of the U.S. filing date. However, foreign trademark protection is often very expensive and the costs multiply depending on the jurisdictions in which protection is sought.

### **1. Madrid Protocol**

Foreign filing costs can be reduced by utilizing what is known as the Madrid Protocol. The Madrid Protocol is a trademark treaty entered into by many countries, including the United States, for the purpose of permitting the owner of a “home country” registration to file an international application with its national Trademark Office and designating other member countries where extension of

protection is desired. The Madrid Protocol offers cost savings and increased efficiency for U.S. trademark holders. The International Trademark Association has aptly summarized the benefits of the Madrid Protocol as offering:<sup>2</sup>

- one application;
- in one place;
- with one set of documents;
- in one language;
- with one fee;
- resulting in one registration;
- with one number;
- and one renewal date;
- covering more than one country.

The cost savings of registration through the Madrid Protocol are also significant. In 2002, the International Trademark Association estimated the costs of registering a mark in the United States plus ten (10) other countries, including attorneys' fees, would be at a minimum over \$15,000. Whereas, “[u]nder the Madrid Protocol, the fee, depending on the amount that the various national offices have agreed with World Intellectual Property Organization (WIPO) to charge would be preset and would be about \$5,800.”<sup>3</sup>

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<sup>2</sup> International Trademark Association, The Madrid Protocol: Impact of U.S. Adherence on Trademark Law and Practice, at p. 1 (Revised April 2003).

<sup>3</sup> International Trademark Association, The Madrid Protocol: Impact of U.S. Adherence on Trademark Law and Practice, at p. 1 (Revised April 2003).

Another cost savings of the Madrid Protocol is the simplicity in filing application amendments. Without the Madrid Protocol, amendments would have to be made individually in every country in which the mark is registered. However, the Madrid Protocol simplifies this process requiring only one amendment to be made to the application at a greatly reduced cost.

Other advantages of an International Registration under the Madrid Protocol include having priority of protection in all designated countries from the date of international registration, as opposed to the date of registration in the individual countries. Also, the Madrid Protocol limits the time a national office has to act once it receives a request for extension of a Madrid registration. If the office does not act to oppose protection during the allotted time, the registration is automatically granted.

By offering simultaneous registrations in the U.S. and foreign countries, the Madrid Protocol also reduces trademark piracy. Without the Madrid Protocol, individuals in foreign countries are often free to register a U.S. company's trademark, and then sell the mark to the U.S. company at highly inflated prices. However, registration under the Madrid Protocol alleviates such piracy since all designated countries are given the same priority date.

**a. Disadvantages**

Notwithstanding the cost savings and increased efficiency associated with the Madrid Protocol, there are some drawbacks for U.S. applicants. First, the Madrid Protocol requires that the scope of goods or services covered by the registration be

limited to the home country's registration rules. U.S. companies that seek registration through the Madrid Protocol will be prejudiced in this respect since the USPTO requires more detailed identification of goods and services than most other countries. Unlike many other countries, the USPTO will not accept registration of marks for broad classes of goods and services. Therefore, U.S. companies may be limiting the scope of protection that could otherwise be obtained in other countries, by filing an International Registration as opposed to filing individual national applications.

Another potential consequence of the Madrid Protocol for U.S. trademark owners is the limitation that the USPTO imposes on applicants to provide a statement of use or *bona fide* intent to use the mark in commerce before obtaining a filing date, and proof of use in commerce before a registration will issue. Most other countries do not require a similar statement of use or intent to use the mark in commerce, or proof of such use. Therefore, U.S. trademark applicants may be disadvantaged by their inability to "reserve" a trademark under USPTO procedure.

Trademark owners filing under the Madrid Protocol are also subject to "central attack." If a home country application or registration is cancelled or abandoned during the first five (5) years of registration, whether completely or partially, the home country must notify WIPO. The International Registration then lapses with respect to all designated countries. This is particularly disadvantageous to U.S. trademark owners because there are usually more grounds for challenging registrations under U.S. law than in other countries.

The Madrid Protocol provides for a partial safeguard against “central attack” by providing a three (3) month grace period for the owner of a cancelled registration to file national applications in designated countries that enjoy the same priority as the International Registration. However, this process can be costly and time consuming.

Unlike national application systems, under the Madrid Protocol an assignment may only be recorded if the assignee is itself qualified to file a Madrid Protocol application. Although this only effects the recordation of the assignment and national laws will govern the legal effect of the assignment, member countries such as the U.S. have passed laws which make assignments to non-member citizens invalid. This assignment provision may be problematic in cases where a U.S. citizen or corporation wishes to assign registration(s) to a non-member citizen or corporation for tax or other purposes.

The final drawback of implementation of the Madrid Protocol for U.S. trademark owners are the additional costs of searching existing trademark registrations. Because foreign trademark owners have already applied for an International Registration, designating the U.S., searches in the U.S. must be expanded to include trademark records in the WIPO data base.

## **G. Trademark Infringement**

The test for whether there is trademark infringement is whether there is a likelihood of confusion between two products or services. The confusion can arise when one product is confused for another, where the consumer wrongly thinks the

products are from a different source, or whether the consumer thinks the product is sponsored or associated with some other product through a license.

Courts look at several factors when assessing likelihood of confusion, but the most important factors are:

- The similarity of the marks. The commercial impression, i.e. sight, sound and meaning, are all considered. In assessing similarity, the marks are considered as a whole.
- The relatedness or proximity of the goods and/or services. Goods and/or services are related if a reasonable purchaser would likely believe that they came from the same source.
- The strength of the plaintiff's mark. The *spectrum of distinctiveness* is applied. Secondary meaning is considered, if appropriate. The level of commercial recognition is also considered.
- The marketing channels used. This equates to how and when goods and/or services are sold. The similarity or dissimilarity between the consumers of the parties' goods and/or services is also a consideration.
- The degree of care likely to be exercised by purchasers in selecting goods and/or services. The typical buyer exercising ordinary caution is the standard. Generally, the more expensive the product, the higher the degree of care exercised. Potential sophistication of consumers may also need to be examined.
- The defendant's intent in selecting its mark. Intentional or knowing use of a similar or identical mark is the primary inquiry. Whether or not there is a likelihood of confusion, however, will be determinative, regardless of the level of intent found.
- The evidence of actual confusion. Evidence of past confusion or that such evidence should have existed in the circumstances alleged may be examined.

- The likelihood of expansion in product lines. Expansion in types of goods and/or services, as well as geographic expansion are considered.

## H. Proper Trademark Usage.

As noted above, there have been many instances where important and powerful trademarks have become generic. Brand managers must understand that trademarks rights can be fragile. A trademark owner must protect their trademark not only from infringement but also from misuse. Even if accidental, misuse can diminish the degree of protection to which a mark is entitled and, in extreme cases, can even result in an owner's loss of trademark rights altogether. The following tips can help protect the value of a trademark.

- Do not trademark the name of your product. If you can not provide the generic name of your product without referring to your brand, then the trademark is likely indefensible.
- When using a trademark in a sentence, always use the trademark as an adjective. If this rule is not followed, the public may come to see the trademark as the generic name of the product or service which is what happened to former trademarks such as escalator and cellophane, and kerosene. Use of the word "brand" also can help emphasize that a term is a mark and not a generic descriptor, for example: Jell-O® brand gelatin dessert. There is one caveat to this rule. Many companies use their trade names as trademarks. In those instances where the trade name is being used, it is a proper noun, not an adjective.
- In a sentence, the trademark should be set apart from the text in some fashion. This can be accomplished by using ALL CAPITAL LETTERS; **bold face type**; Initial Capital Letter; *italics*; or, through the use of a unique font.
- Do not allow your trademark to be defined. If your trademark is found in a dictionary intentionally or not, that can be strong evidence that the trademark is generic. Corrective action in the

form of a letter to the dictionary publisher should be taken immediately.

- Use the brand in a consistent manner. Not only is recognition of the mark enhanced through consistent use, inconsistent use may confuse consumers, dilute the distinctiveness of the mark, and lead to abandonment of the mark.
- Use the appropriate trademark designation. In the United States the symbol TM can be used to identify an unregistered trademark, and SM can be used to identify an unregistered service mark, and ® can be used to identify a registered trademark or service mark. Many foreign countries use similar terms. Local laws should be consulted because many countries require proper use of the symbol in their country in order to collect damages for infringement and such symbols may not be the same as those accepted in the United States.

## **Part 4: Intellectual Property Issues in Packaging**

## **INTRODUCTION**

A consumer's first introduction to a company's food product is often product packaging. This includes the labeling, graphics, colors, designs, or any other distinctive features accompanying the product. The "packaging" should not be thought of as limited to the actual container of the food product, but extends to the display materials and any signage.

Product packaging is clearly an important element of any company's advertising and marketing campaign because consumers are influenced by attractive pleasing, "eye catching," or distinctive designs. Packaging design raises many intellectual property issues. Since certain intellectual property rights, like trade dress and copyright, can restrict others from copying product packaging, company's must be cognizant of how to best obtain and maintain protection. Aesthetic elements might draw consumers to a product initially, but trade dress and copyright laws will help ensure that consumers are able to find their way back.

Developing effective product packaging may require a designer to combine a variety of different colors, illustrations graphics, textures, shapes, and text. Sometimes, these components are separate from the product. At other times, they blended with the product itself to create a unique configuration. To obtain the greatest benefit, it is important to understand how trade dress and copyright protection work.

Trade dress is a form of trademark law. Generally, trade dress can be thought of as protecting the overall appearance, look or "image" of a product's

packaging, or in certain cases, the product itself. A trade dress must designate a single source, meaning that in the minds of consumers, the trade dress is associated with one company. In addition, in order for a trade dress to be protectable, it must be distinctive and “non-functional.” Trade dress may be registered with the United States Patent and Trademark Office, just as with a trademark.

A trade dress that is so unique, a consumer would immediately associate the trade dress with a single source, is considered to be “inherently distinctive.” Inherently distinctive trade dress is protectable as soon as it is used in interstate commerce.

When trade dress is not considered to be inherently distinctive, a company can still obtain trade dress protection if the company can prove that its trade dress has acquired “secondary meaning” or “*acquired* distinctiveness.” To have acquired “secondary meaning,” in the minds of the public, the primary significance of a product package must be to *identify the source of the product* rather than the product itself. Thus, not every product package will qualify for trade dress.

“Product configuration” refers to the actual shape or configuration of a product itself. For example, a snack cracker may have a distinctive shape that signifies it is from a particular source. In the case of a product configuration, however, it must be proven that the product configuration has achieved a secondary meaning. That is to say, no product configuration may be considered “inherently distinctive.”

Several factors are weighed in determining if a trade dress has developed a secondary meaning. For example, trade dress might have achieved a secondary meaning if it was exclusively associated with one product or service for a long period of time. Another factor is the amount of advertising and marketing devoted to linking the trade dress image and the origin of the goods. When a trade dress receives unsolicited media coverage, this also suggests that the public may associated it with a particular source. In theory, trade dress protection can last indefinitely, so long as the trade dress is continually used in the marketplace, and continues to act as a designator of a sole source.

## **COPYRIGHT**

Copyright protects original works of expression. Copyrights may be used to protect all types of original expression, including the design of product packaging. Copyright does not protect individual words or short phrases. However, copyright does apply to logos, software, photographs, graphics, label designs, and even written instructions (if such instructions show enough creativity).

It is important to note that Copyright only protects *expression*-- it does not protect *ideas*. For example, the *idea* of a penguin character used to sell ice cream is not in and of itself protectable by copyright. However, the particular original design or drawing of a penguin character on an ice cream package is copyrightable.

Three criteria determine if a work is protected by copyright. First, the work must be original. This does not mean the work must be novel or unique. "Original,"

in the context of copyright law, means that a work must be originally created by the author.

Second, it must be fixed in a tangible means of expression. This requirement prevents the protection of unexpressed ideas. The courts have recognized paper, canvas, audio tape, video tape, plaster, electronic media and numerous other forms of tangible expression.

A copyright owner has several exclusive rights including: the right of reproduction (*i.e.*, to make), the right to make derivative works), distribution of copies, publication, public performance, and public display. The copyright owner can divide up these rights, and license others to use the copyrighted work.

As soon as an original work is fixed in a tangible medium, copyright attaches. Although a copyright registration is not required, such registrations are relatively easy and inexpensive to obtain. The Copyright Office website (<http://www.copyright.gov/>) provides downloadable forms and fact circulars. Obtaining a copyright registration is significant in that it allows the copyright owner to bring an action in federal court, and also can provide for certain types of recoveries in litigation.

## **DESIGN PATENTS**

As stated in the United States Patent Act, “[w]hoever invents any new, original and ornamental design for an article of manufacture may obtain a patent.” Unlike a utility patent that protects the way an article functions, an entire area of

patent law is dedicated to the ornamental appearance of articles. Design patent protection can be a potent form of protecting a product package, or the appearance of a product itself.

Like a utility patent, a design patent must be novel and non-obvious in order for a design patent to be granted. However, unlike a utility patent, in order for a design to be the subject of a design patent, the design must be non-functional. The design's appearance controls.

A design patent application is not extensive. The design patent application must include drawings showing the design from various perspectives. In addition, the design patent application must include a single "claim" which generally reads: "The ornamental design of a [PRODUCT NAME] as shown."

A design patent can be directed to the ornamental appearance of any facet of a product or product package. The following are candidates for design patent protection: the ornamental appearance of a snack cracker in a whimsical shape; the appearance of a specially shaped package for lunch meats; a display case for displaying food products in a supermarket; the lid of a carton for holding eggs; the ornamental design of a handle of a spatula.

A design patent lasts fourteen (14) years from the date it issues. During that time period, the design patent owner may exclude all others from making, using or selling a product featuring the claimed design. Design patents do not require maintenance fees, or any form of periodic renewal.

## **OVERLAPPING FORMS OF PROTECTION**

In considering a particular product package, with some many available forms of protection, the question will arise: “Which form of intellectual property do I pursue? Should I file a copyright? A design patent application? A trademark registration?”

All of these forms of intellectual property protection discussed herein can apply to a single product package. Therefore, a company may have copyrights in the design of the labeling and text on the package, and trade dress rights in the overall appearance of the package. In addition, a design patent may be available for the appearance of the front panel of the package. It is apparent that valuable intellectual property may be created with each new product package, and it is critical that the different forms of protection be assessed in order to carve out a niche in a crowded marketplace.

## **ADDITIONAL DEFINITIONS**

### **INVENTION**

The inventor's work in producing a solution to an identified problem. The essential feature of invention is the requirement that it be the work or discovery of the inventor.

### **PATENTABLE INVENTION**

The inventor's work which is neither anticipated by nor obvious in light of the prior art associated with the inventor's field of endeavor.

### **CLAIMED INVENTION**

The inventor's patentable work as defined in the enumerated claims of an issued patent.

### **CLAIM**

A word description of the patentable invention. A patent claim describes the inventor's property in much the same way that a real property deed describes the metes and bounds of real estate. Claims are frequently described as broad (a pioneering invention), medium (a reasonably significant improvement over the prior art) or narrow (a minor but still patentably significant improvement over the prior art).

### **PRIOR ART**

The generally available public information that relates to the inventor's field of endeavor.

### **ANTICIPATION**

The legal conclusion that the claimed invention was invented by another prior to the second inventor's invention thereof.

### **OBVIOUSNESS**

The legal conclusion that the claimed invention would have been obvious to one of ordinary skill in the art at the time of the inventor's work.

### **ONE OF ORDINARY SKILL IN THE ART**

The hypothetical person who is presumed to have knowledge of all of the existing prior art, at the time of the inventor's work, in the inventor's field of endeavor.

### **ON SALE OR IN PUBLIC USE**

Broad terms used to describe any non-confidential disclosure of the invention which has any purpose other than reducing the invention to practice.

## **EXPERIMENTAL USE**

An American **expression** to on sale or in public use which is a legal conclusion that the activities have as their principle purpose a reduction to practice of the invention.

## **PATENT APPLICATION**

A formal document which describes the invention, with reference to any necessary drawing figures, and concludes with one or more claims which define the invention. The specification must disclose the best mode of practicing the invention and must describe the invention with sufficient particularity to enable one skilled in the art to practice the invention without undue experimentation.

## **BEST MODE**

An American concept for requiring disclosure of the preferred or best way known to the inventor, at the time of the application, for practicing the invention. An inventor does not have an obligation to revise or update an application with later learned information. However, an inventor is not permitted to describe an inferior embodiment when a better embodiment is known at the time of the application.

## **LITERAL INFRINGEMENT**

A patent claim is literally infringed when the claim language can be read on the alleged infringement without any significant deviation from the terms of the patent claim. In other words, the patent claim would be understood by one skilled in the art to accurately describe that which is accused of infringement.

## **EQUIVALENT INFRINGEMENT**

An American doctrine that affords the patentee the opportunity to show that the accused infringement includes the equivalent of the literal language in the claim. For instance, a claim which recites a rivet or nut and bolt assembly as a fastening means may be the equivalent of a welded joint. To determine such equivalents, a study must be made of the patent file history and any relevant prior art. This concept has been greatly restricted in scope by recent U.S. case law.

## **PATENT FILE HISTORY**

All of the documents mailed to or from the Patent Office in connection with an application are maintained, by serial number, in a designated file. Once the patent issues, the file becomes publicly available.

### **PROSECUTION HISTORY ESTOPPEL**

An American doctrine which holds that the examiner's actions and the applicant's responses thereto establish the respective positions of the parties during the prosecution. If the application is amended or arguments are advanced to gain allowance of the claims, those amendments or arguments may be used to restrict the claim equivalents available to the patentee. Recent U.S. law has enhanced the restrictive nature of this doctrine with the result that it has greatly reduced the patentee's use of the doctrine of equivalents. This has generally not been a consideration in most industrialized nations.

### **PARENT APPLICATION**

An earlier filed application which is referred to in a subsequent application. Thus, you may have parent, grandparent, great grandparent and so on applications. This concept is more limited in European and Pacific Rim practice.

### **PRIORITY APPLICATION**

The national application(s) used as the basis for a claim of convention priority in foreign filed applications. In U.S. practice, it also refers to any application, i.e. a parent, which preceded a later filed and related application.

## **HELPFUL LINKS**

All of these links can be found on [www.volpe-koenig.com](http://www.volpe-koenig.com)

United States Patent and Trademark Office

[www.uspto.gov](http://www.uspto.gov)

United States Copyright Office

[www.copyright.gov](http://www.copyright.gov)

International Trademark Association

[www.inta.gov](http://www.inta.gov)

Small Business Administration (SBA) Pennsylvania District Office

[www.sba.gov/pa/phil](http://www.sba.gov/pa/phil)

Ben Franklin Technology Partners

[www.benfranklin.org](http://www.benfranklin.org)

Women's Business Development Center

[www.wbdc.org](http://www.wbdc.org)

Greater Philadelphia Venture Group

[www.gpvg.com](http://www.gpvg.com)