What every product manager should know about Intellectual Property: Patents, Copyrights, Trademarks

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- This presentation does not commence an attorney-client relationship
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- Some portions may be overly generalized for explanation
- To prevent injury, please hold on to your seats during the exciting parts of this presentation
Is there any protectable intellectual property in a watch?
Protection of Design

Design Patent
D506936
Agenda

- Hickman Palermo Truong & Becker
- Trademarks
- Copyrights
- Patents
Focusing on patent procurement for computer, networking, software, and video technologies

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Hickman Palermo Truong & Becker LLP

- **Services**
  - Counseling in all areas of Intellectual Property
  - Patent preparation and prosecution in the US and abroad
  - Trademark search, clearance, and registration
  - Copyright registration
Services

- Software and technology licensing, development, and related agreements
- Patent and trademark risk evaluation, patent monitoring and pre-litigation claim evaluation, including guidance on responding to claims by patent trolls
- Anonymous patent acquisition and sale or licensing
Varun A. Shah, Esq.

- **Education**
  - Computer Science, B.S., *Upper Division Honors*
  - Law, Juris Doctorate (JD)

- **Experience**
  - Intel – *Engineering*
  - Motorola – *Patent Portfolio Management*
  - Superior Court, Judge Michael D. Jones – *Law Clerk*
  - Hayes Soloway – *Patent Prosecution*
  - Osha Liang – *Patent Prosecution*
  - Hickman Palermo Truong & Becker – *Patent Prosecution*
Trademarks

- Sign or Indicator used by individual, business, or other entity to identify products or services

- Typically a name, word, phrase, logo, symbol, design, image, or a combination of these elements
Why register a trademark if it can be automatically established by use?

- Constructive notice of the registrant’s claim of ownership
- Legal presumption of the registrant’s ownership
- Sue for trademark infringement in federal court
- What about suing based on non-registered trademarks?
Why register a trademark if it can be automatically established by use?

- Basis to obtain registration in foreign countries
- Prevent importation of infringing foreign
- Registrant’s exclusive right to use the mark nationwide
- Registrant’s exclusive right to use with the goods and/or services listed in the registration
- Cannot register a picture of your mother-in-law to prevent entry into the country
Trademarks

- May be referred to as a service mark (SM)

- Unlike Costco samples, trademarks may last forever.

SAMPLERS SM
Copyright

- **Exclusive right granted to author of an original work**
- **Right to ban or authorize publications**
- **Examples:**
  - Music
  - Painting
  - Poems
  - Plays
  - Novels
  - Films

- **What about software??**
Copyright


- Copyright applies to the creative aspects of information: the creative choice of what data to include or exclude, the order and style in which the information is presented, etc., but not on the information itself.
Copyright

- **How do comedians show clips of other shows and comment on them?**
- **Fair Use Doctrine**
  - Purpose and character of use (e.g., Commercial, Non-profit? Transformative vs. Derivative?)
  - Nature of the copyrighted work
    - Kennedy Assassination Video / Public Interest
  - Amount and substantiality of the portion used
  - Effect of use upon potential market for or value of the copyrighted work
- **Work for Hire Doctrine**
Copyright

- Copyright applies to any expressible (and creative) form of an idea or information that is substantive and discrete and fixed in a medium.
Copyright

- **Individual:** Death + 70 years
- **Corporate:** 95 years after publication, 120 from creation
What is the use of Copyright registration when it is possible to sue without registration?

*Prima Facie* evidence of valid copyright

- Statutory Damages (Compensation for work)
- Without Registration: Actual Damages & Lost Profits

Can two people have Copyrights on essentially identical works?
Copyright

- Is a recipe copyrightable?
- Are a collection of recipes copyrightable?
- Are house architectural plans copyrightable?
- Are software design plans copyrightable?
- Is software code copyrightable?
- Are requirements documents copyrightable?
What rights do patents convey?
What is the use of patents?
What can be patented?
What should be patented?
What are the legal requirements to obtain a patent?
When should patents be pursued?
What are the types of patents / patent applications?
What is the process for obtaining a patent?
What does it cost to obtain a patent?
Patent Rights

- Right to exclude others from making, using, selling, offering for sale, or importing into the U.S. the claimed invention
- Presumption of validity
- Can be asserted against others in Federal court or before the International Trade Commission (ITC)
- Becomes prior art against others, as of filing date
- Life of 20 years from the filing date
- First to invent entitled to patent (US)
Why Patent?

- Protect proprietary technology
- Create tangible evidence of intangible assets
- Build credibility and prestige among peers and competitors
Why Patent?

- **Offensive uses**
  - Licensing for revenue
  - Equitable relief and money damages

- **Defensive uses**
  - Retaliatory threat (avoid royalties and litigation)
  - Preserve freedom to sell and improve products
  - Cross licensing
What Can Be Patented?

- Any process, machine, article of manufacture or composition of matter: “everything under the sun made by man”
- Architectures, protocols, interfaces
- Product features
- Algorithms
- Computer software (Front End & Back End)
- Products and solutions as a whole
- Standards—subject to obligations to standards body
- No prototype, model or implementation is needed
What Should Be Patented?

- **Products and services**
- **Things that competitors want**
  - or would find useful,
  - or that provide competitive advantages
- **Things which, if copied, would be detectable**
  - in an infringing system
- **At the outset, don’t worry about obviousness**

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Is Patenting Hard?

- Not as hard as most think
- About 2,000 patents issue in the U.S. *per week*
- Most cover small incremental improvements to existing things
Legal Requirements

- Claimed invention must be **new** in view of everything that has come before (new combination)
- Claimed invention must be **useful**
- Claimed invention must be **non-obvious**, to someone of ordinary skill in the field, based on all prior knowledge in the field (“prior art”)
Non-obviousness

- One or more prior art documents, products or solutions must teach or suggest *all features* of the invention
- When multiple prior art documents are relied upon, the principle operation of the prior art cannot be modified to obtain your invention
- Knowledge of a skilled person in the field would naturally lead to your invention
When Should Patents Be Pursued?

- **One-year time bar**—**must** file by 1 year from:
  - Released product that contains invention
  - Publication or public disclosure or use outside the company
  - Sale or offer for sale, *even if under NDA*
  - Other countries have no 1-year grace period

- **Disclose inventions early**
  - Release to test
  - Upon design freeze or code freeze
Types of Patents

- **Design Patents (14 Years)**
- **Utility Patents (20 Years)**
  - Provisional Patent Applications
  - Non-Provisional Patent Applications
- **Patent Cooperation Treaty (PCT) Applications**
- **National Phase Applications**
Timeline / Costs

- **Initial Filing Costs**
  - Attorney Fees
  - Patent Office Fees

- **18 Months - Publication**

- **Additional Prosecution Costs**
  - Office Action Responses
  - Request for Continued Examination | Appeal Fees

- **Annuity Payments**

- **International Costs (foreign associate fees, fees charged by foreign patent offices)**
Patent Process—Pre-Filing

- Identify idea
- Prepare brief description for review
- Patent Review Committee (PRC) review and approval
- Disclosure meeting: 1-2 hours
- Patent attorney writes patent application (20-50 pages including implementation examples, drawings, claims)
- Inventor reviews draft: 1-3 hours
- Application is revised and filed
Patent Process—Post-Filing

- Examiner reviews application, searches prior art, issues report (Office Action)
- Patent attorney responds & negotiates allowance of claims, in writing and/or by telephone
Patent Process—Post-Allowance

- Patent attorney reviews allowed claims
- Patent attorney may consult with inventors regarding scope of allowed claims in view of products and services of competitors
- File divisional, continuation and continuation-in-part (CIP) applications
Patent Process – Inventor Role

- Identify and define inventions
- Prepare invention disclosure materials for Patent Review Committee
- Attend invention disclosure meeting with patent attorney
- Review drafts of patent application and assist patent attorney to complete filing
- Assist in identifying competitors’ products and services at disclosure meeting and after allowance
Increasing the Value of Patents

- **Effective claim coverage**
  - Forms (method, computer-readable medium, apparatus, device, means-plus-function)
  - Adequate scope
  - Single infringer
  - Infringement detectable
  - Draft claims for literal infringement
  - Strong dependent claims

- **Anticipate and limit prosecution estoppel**

- **Increase numbers**
Patents, Copyrights, Trademarks

- Fair Use?
- Lasts Forever?
- Identical Allowed?
- Right to exclude others?
- Other Questions?
Thank you

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