

Intellectual Property Law Basics for non-IP Lawyers

ProVisors® Attorney Affinity Group – December 6, 2019

Law Office of Lesley A. Wallerstein, LLC
Merchandise Mart, Suite 1225
Chicago IL 60654
(847) 912-3553
law@wallerstein-ip.com

_____ once said:

GENIUS is...

1% inspiration

99% perspiration



What is Intellectual Property?

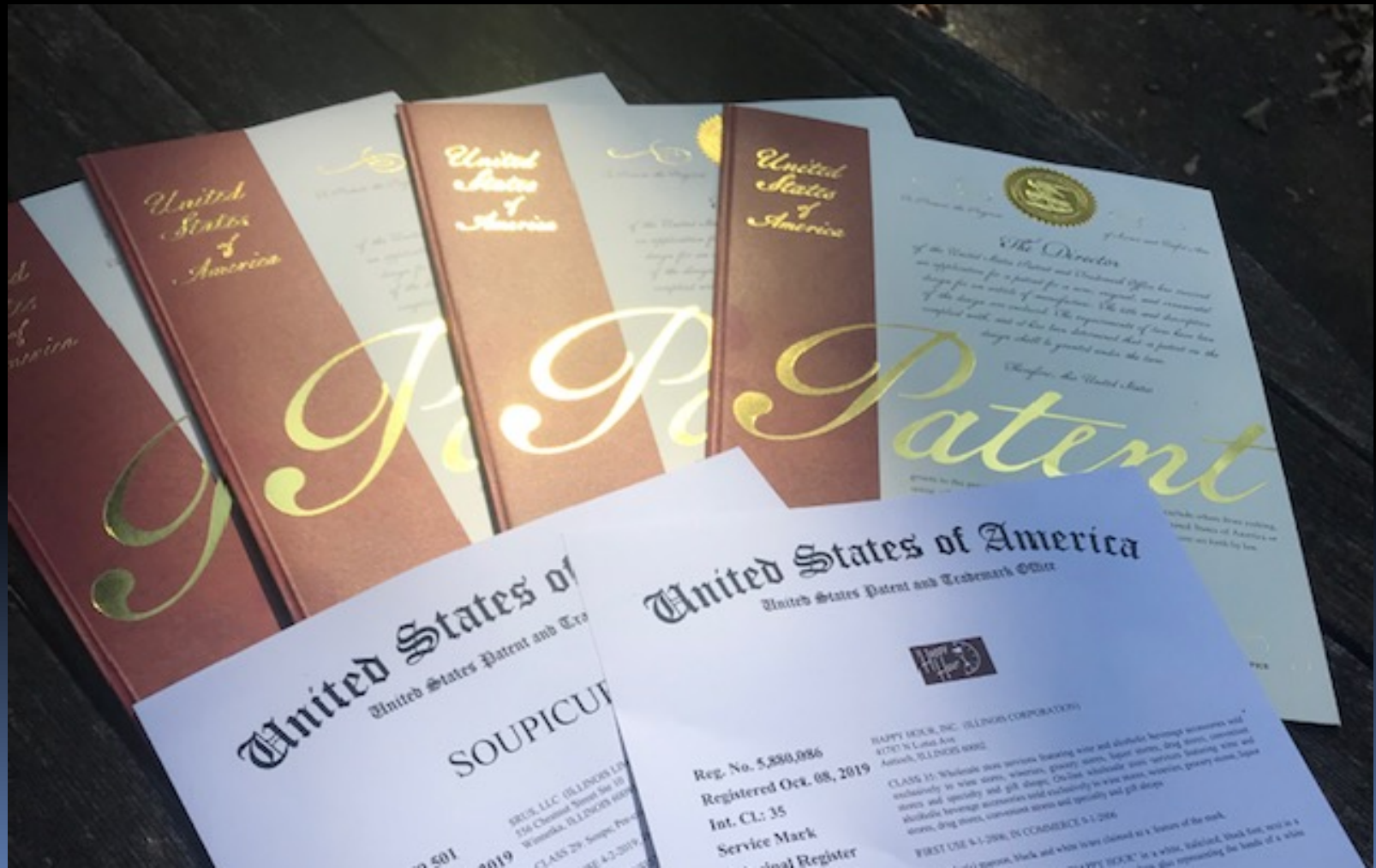
- In short, an idea that you can “own”
- May have monetary value
- Can be bought, sold, assigned, licensed or given away by will

Types of Intellectual Property and what they protect:

1. Patents – tangible, useful things and methods
2. Trademarks – brand identity and reputation
3. Copyrights – artistic works (music, text, sculpture)
4. Trade secrets – intangible (secret recipe)

Patents

What is a patent?



Why do we have patents (& copyrights)?

U.S. Constitution Art. 1, Sec. 8 gives Congress 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**

"Science and useful arts":

To be patentable, an invention must be:

1. Useful (for a utility patent)
2. Original in ornamentation (for a design patent)
3. New
4. Not obvious

"For a limited period of time":

1. 20 years - utility patents
2. 15 years - design patents
3. 20 years - plant patents

NO EXTENSIONS

"The exclusive right..."

1. Exclude others from making, selling, importing...
2. Sue in federal court
3. Enforce by ITC and/or Customs and Border Patrol

Costs of Obtaining Patent Protection

1. Attorney/agent preparation fee
2. Government filing fees
(75% discount for independent inventors who meet certain financial qualifications)
3. Professional drawings
4. Registration/Maintenance fees
5. Enforcement

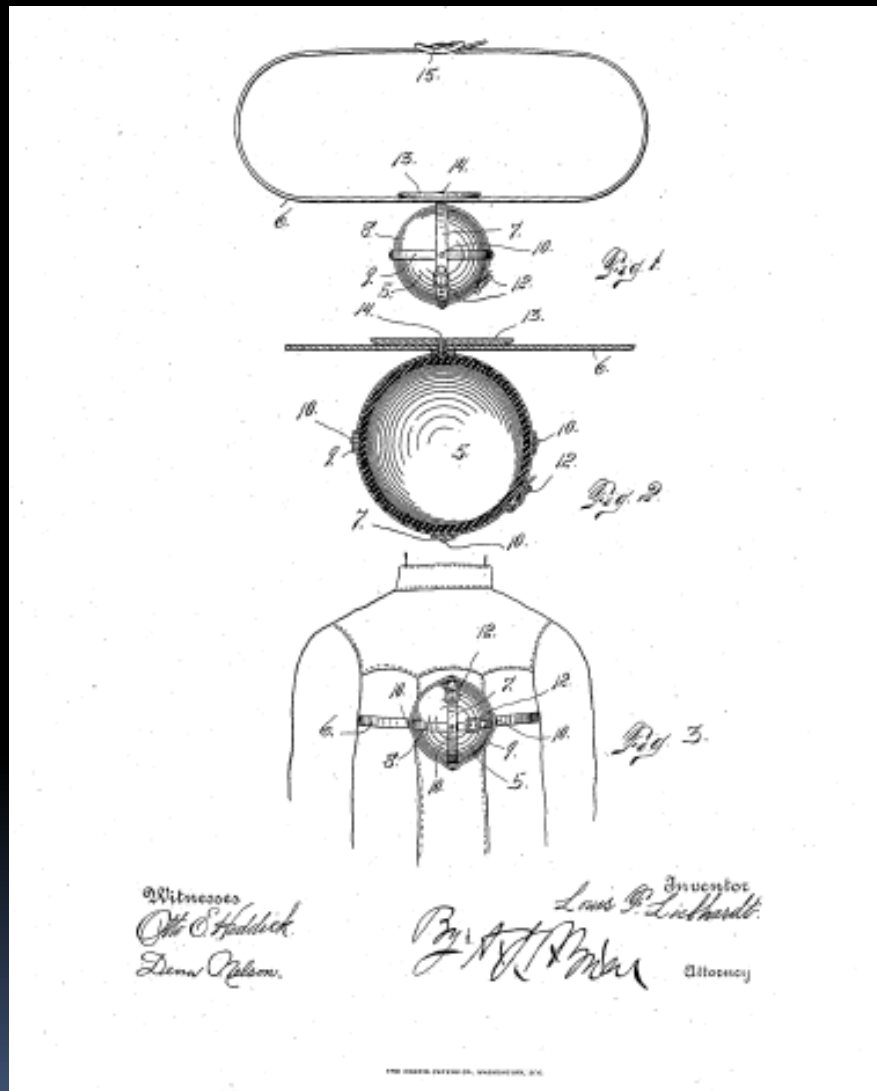
"Respective writings and discoveries":

1. Machine/device/apparatus
2. Chemical composition
3. Article of manufacture
4. Method of doing/making any of the above

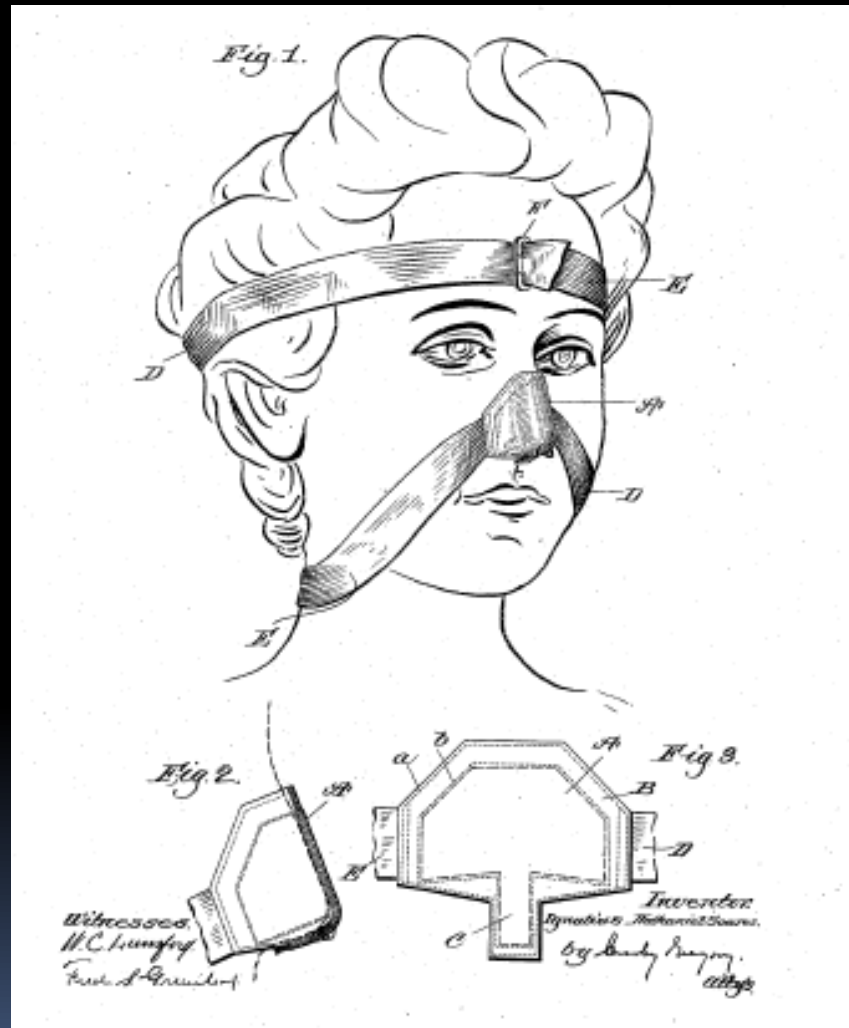
Types of Patents and what they protect:

1. Utility – how something works
Provisional or non-
2. Design – how something looks
3. Plant – yes, you can invent a plant!

Utility Patents



Source: Colitz, Wacky Patents



Source: Colitz, Wacky Patents

“Beerbrella”
McMullin *et al.*
(2003)

U.S. Patent

Oct. 28, 2003

Sheet 1 of 5

US 6,637,447 B2



Figure 1

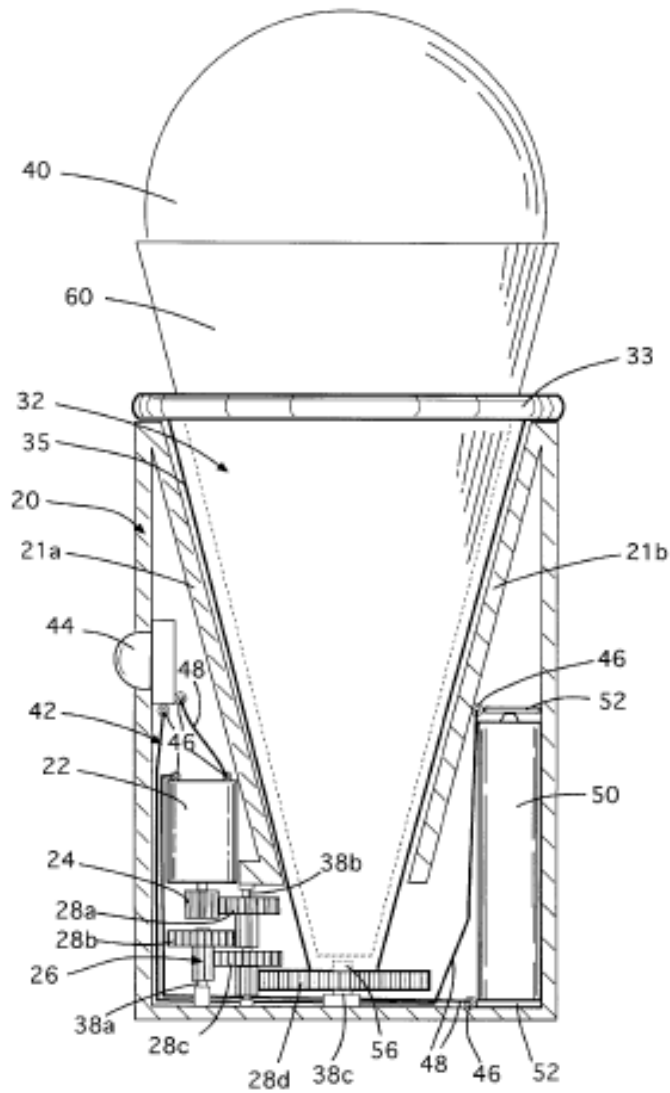
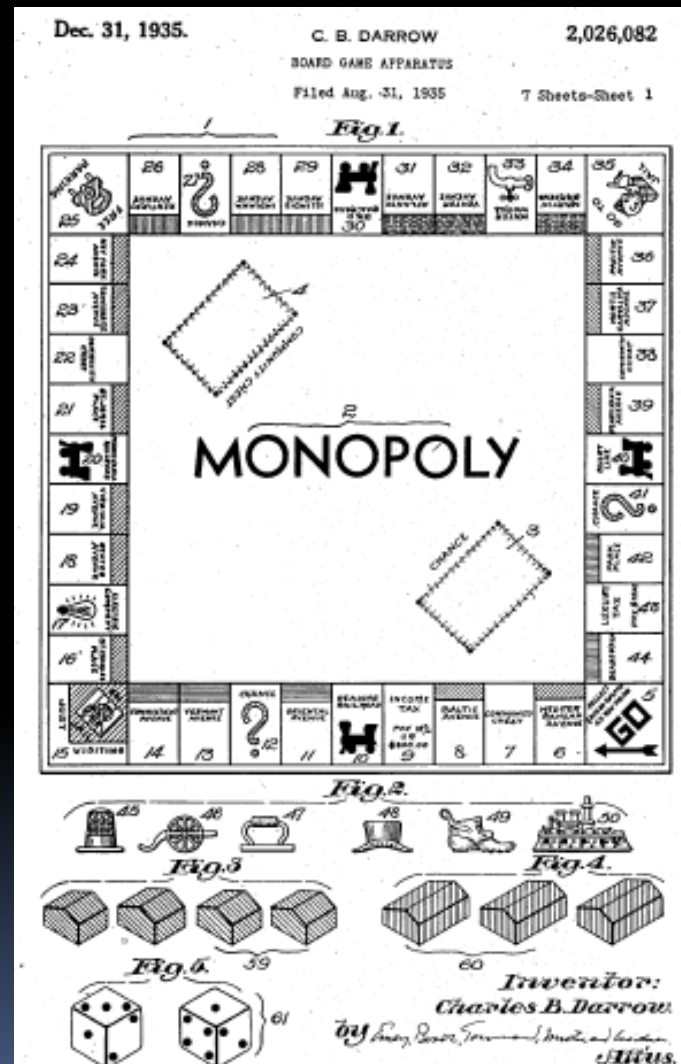


FIG. 4

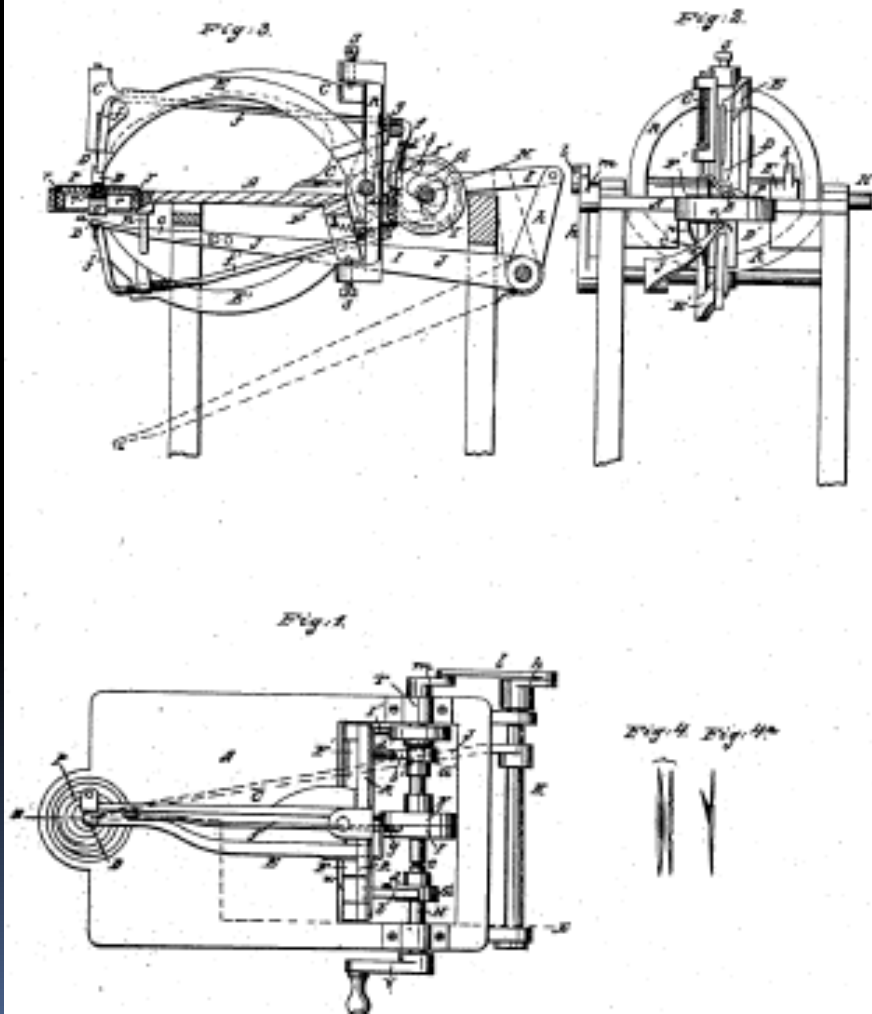
Hartman, Motorized Ice Cream Cone
(1999)

Darrow, Board Game Apparatus (1935)



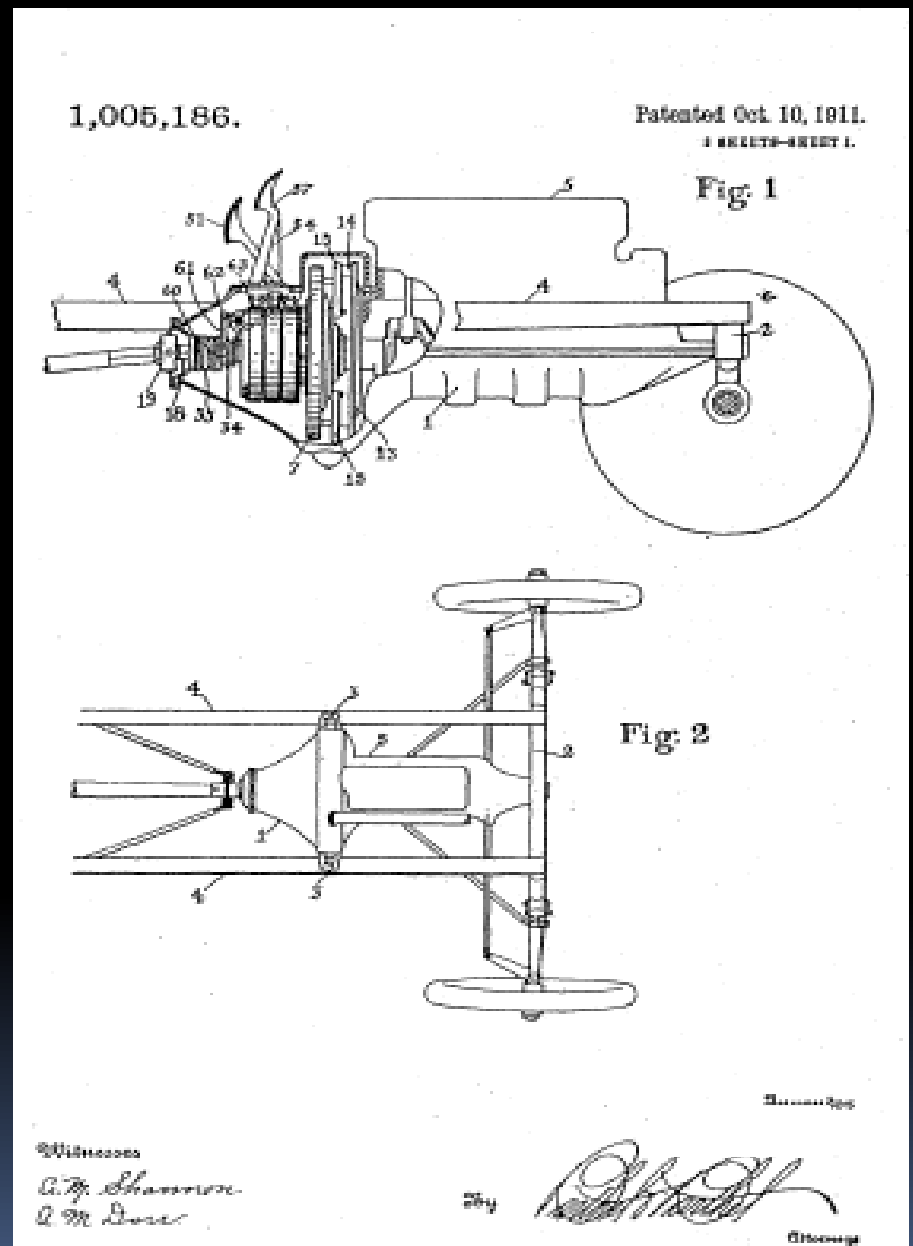
No. 16,436.

Patented Jan'y 20, 1857.



Can you guess what this is?

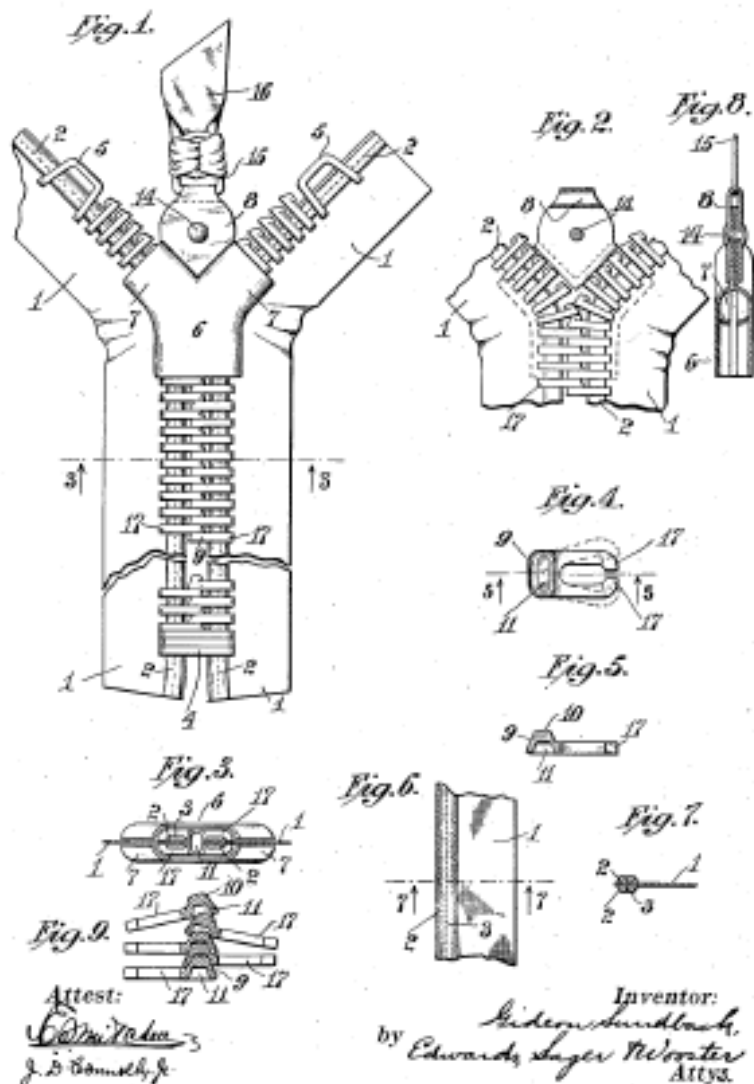
What about this?



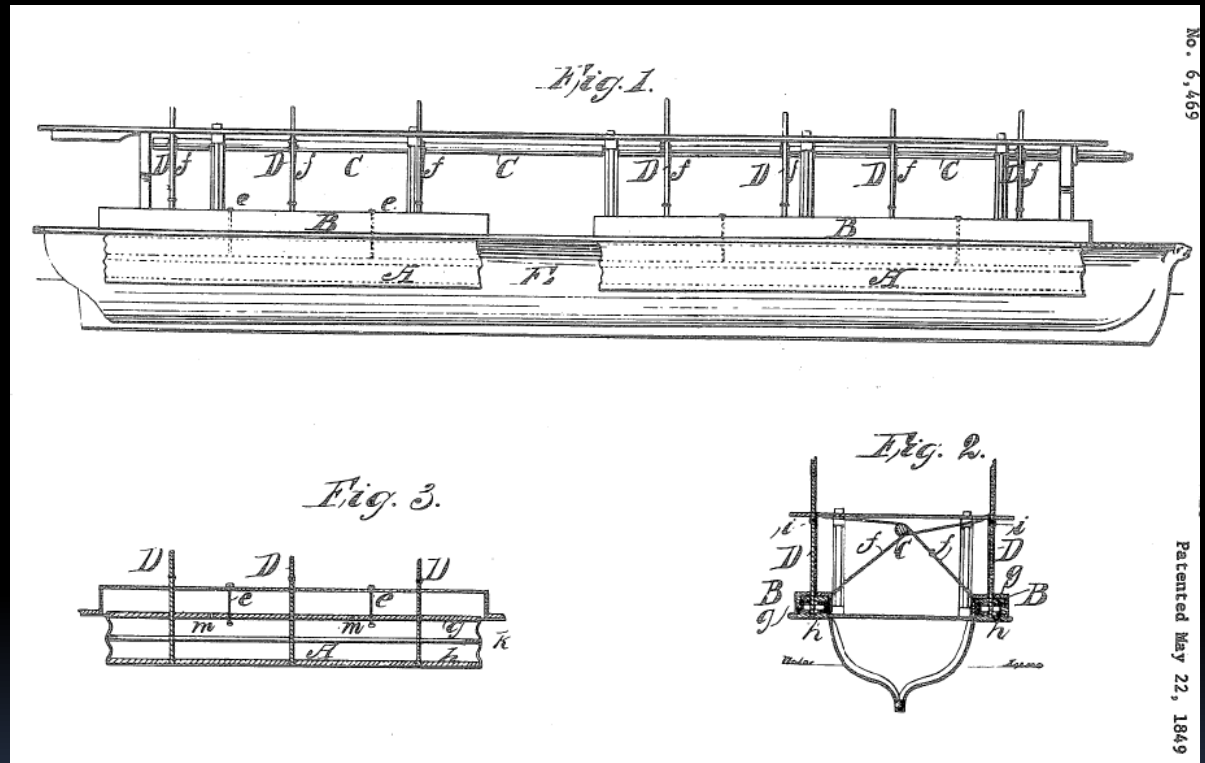
G. SUNDBACK.
SEPARABLE FASTENER.
APPLICATION FILED AUG. 27, 1916.

1,219,881.

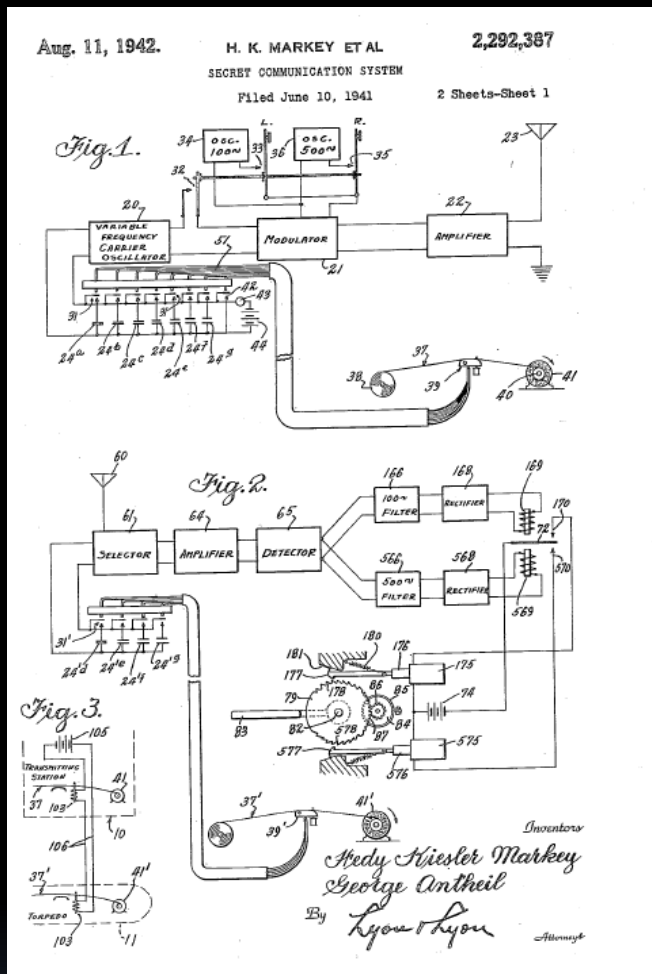
Patented Mar. 20, 1917.



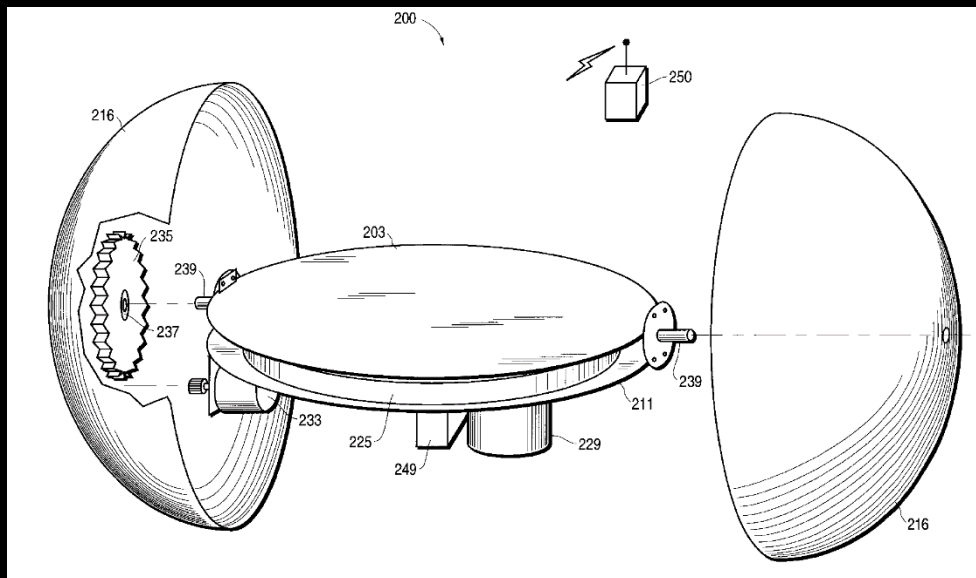
Sundback, Separable Fastener (1917)



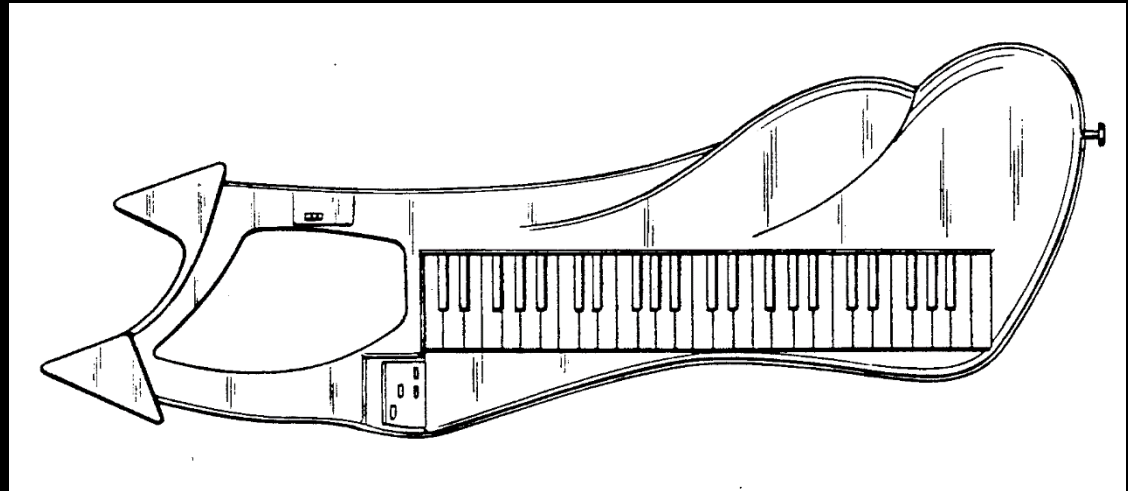
Buoying vessels over shoals (1849)



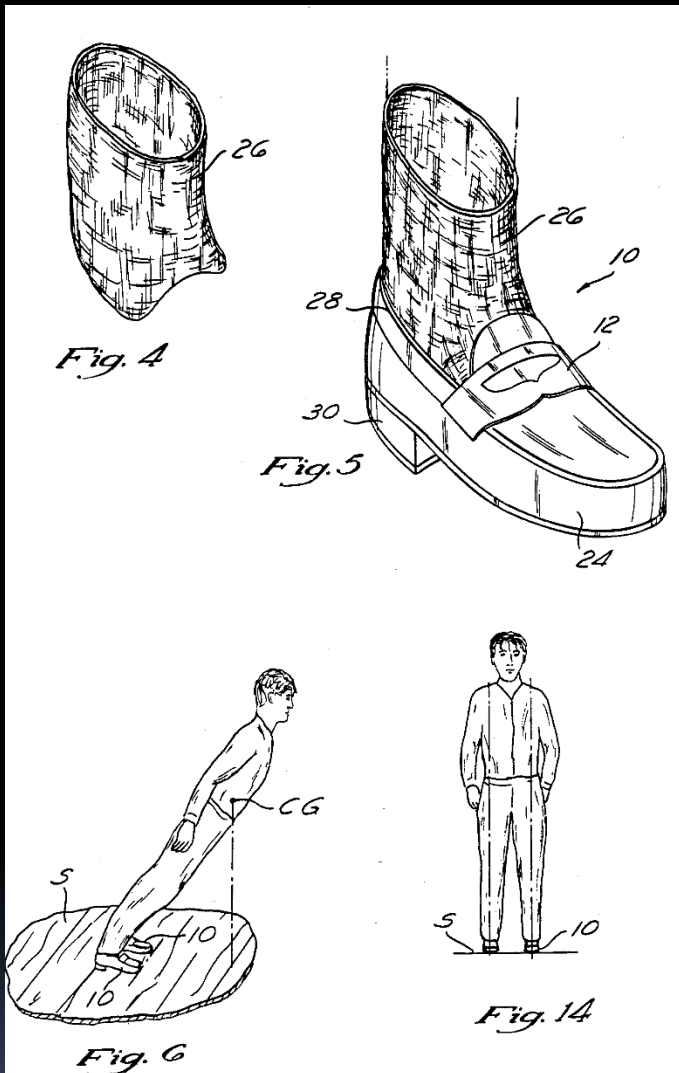
Secret Communications System - an early version of Bluetooth
(Hedy Lamarr, 1942)



Gyroscopic Remote Control (Jamie Hyneman, 2002)



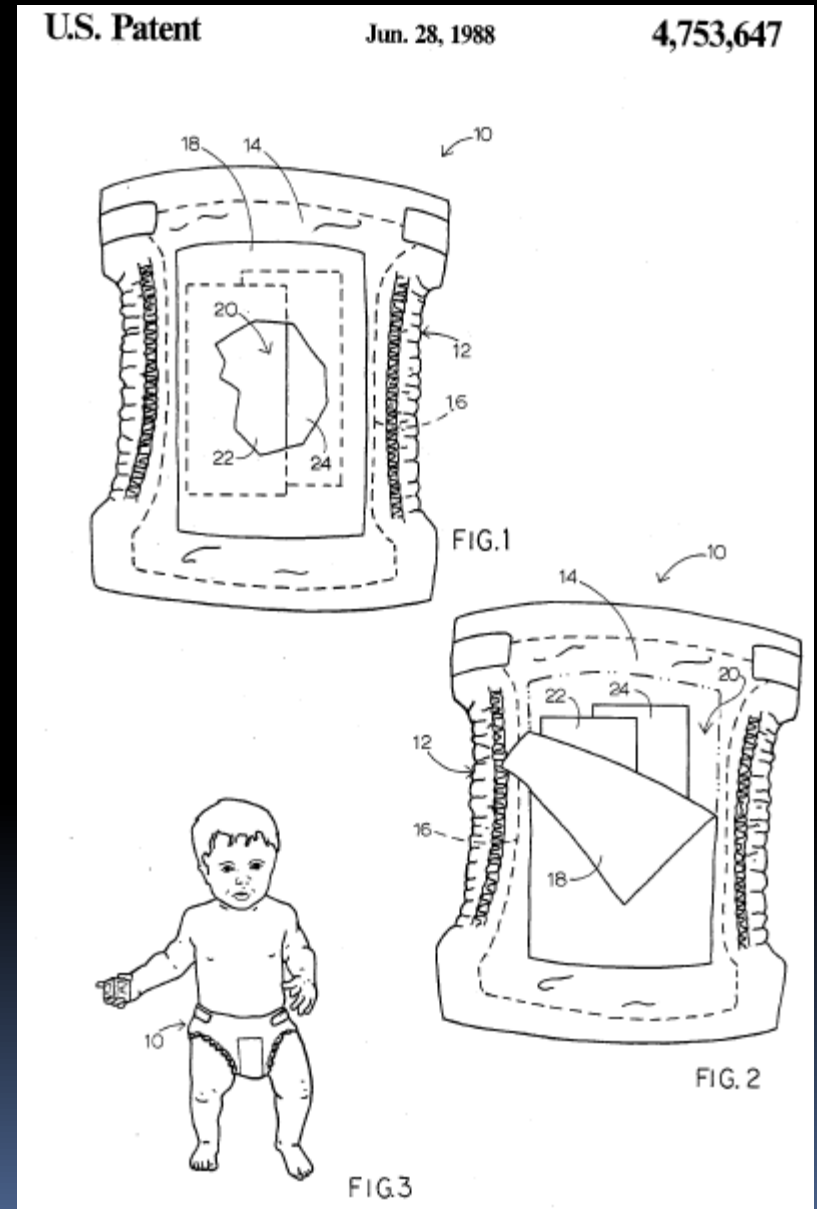
Portable Electronic Keyboard (Prince, 1994)



Anti-Gravity Illusion (Jackson, 1993)



Jamie Lee Curtis, Infant Garment (1988)



Patents must **not** be:

- Abstract idea
mathematical algorithm, e.g. $E=mc^2$
- Things occurring in nature
new mineral discovered in the earth
new plant found in the wild
- Physical phenomena, e.g. laws of gravity

“I’ve got a great app” – Is it patentable?

Alice Corp. v. CLS Bank, 573 U. S. 208 (June 19, 2014)

Patent claims directed to a computer system for mediating the exchange of financial obligations between two parties

Question presented: whether these claims are patent eligible under 35 U.S.C. § 101, or are instead drawn to an **abstract idea**

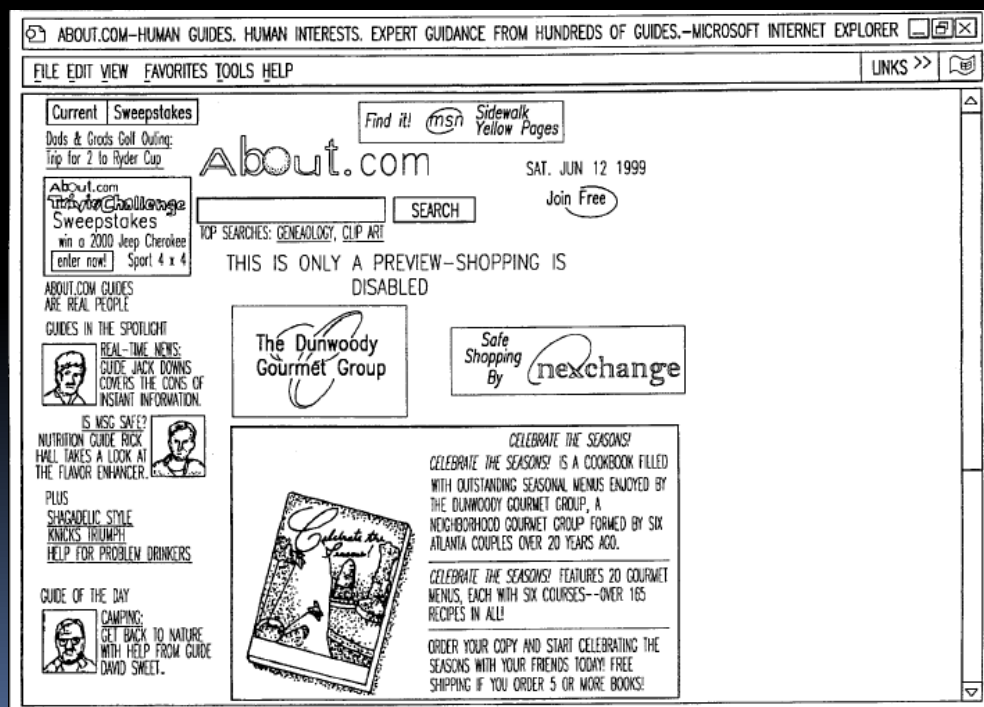
Why *Alice's* patents were invalidated:

- Concept of intermediated settlement is "a **fundamental economic practice** long prevalent in our system of commerce"
- Claims require **generic computer implementation**, [and thus] fail to transform that abstract idea
- Claims require only a "**general-purpose digital computer**"
Nearly every computer will include a "communications controller" and "data storage unit" capable of performing the **basic calculation, storage, and transmission functions**
- "depend[ed] simply on the draftsman's art"

DDR Holdings v. Hotels.com et al, 773 F.3d 1245 (Fed. Cir. 2014)

Software claimed in DDR's patents :
(6,629,135; 6,993,572; 7,818,399)

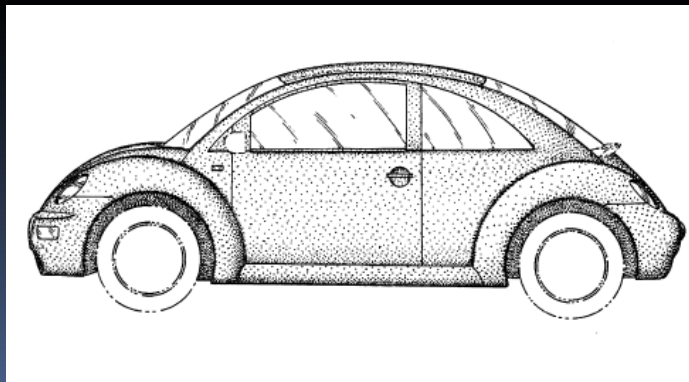
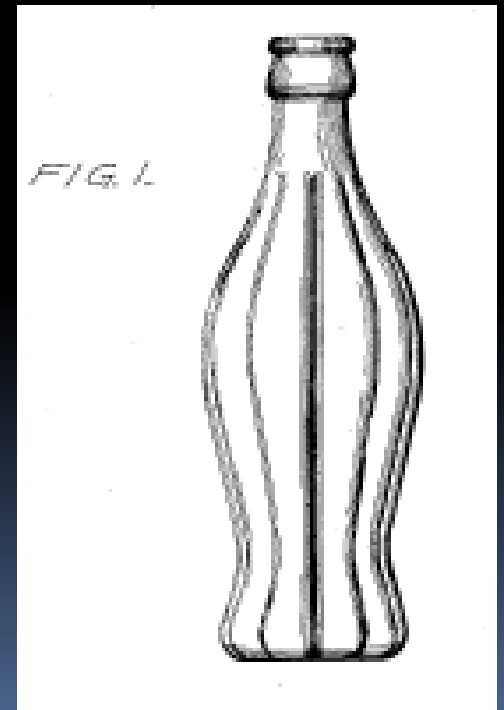
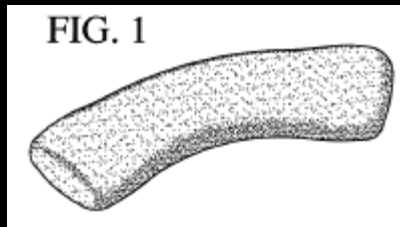
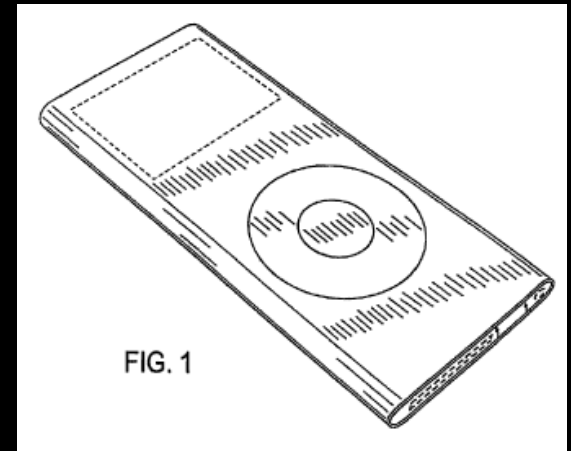
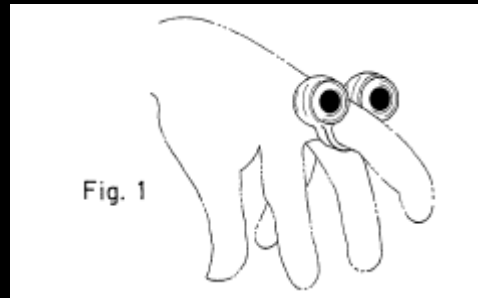
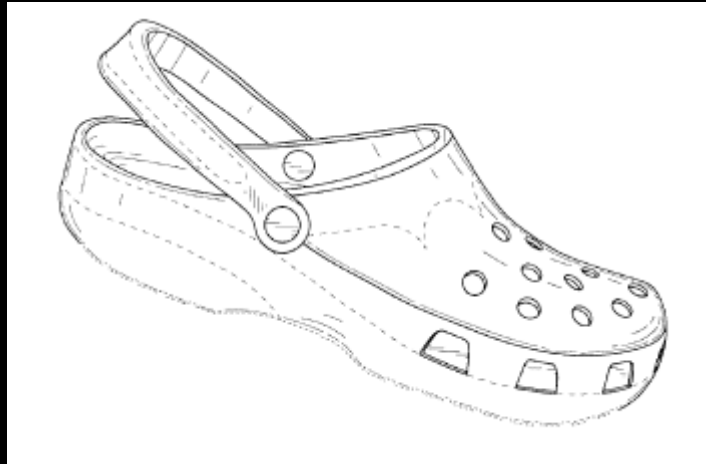
- Creates a website within a website
- Preserve host page's original "look and feel"



Why these patents were valid and enforceable:

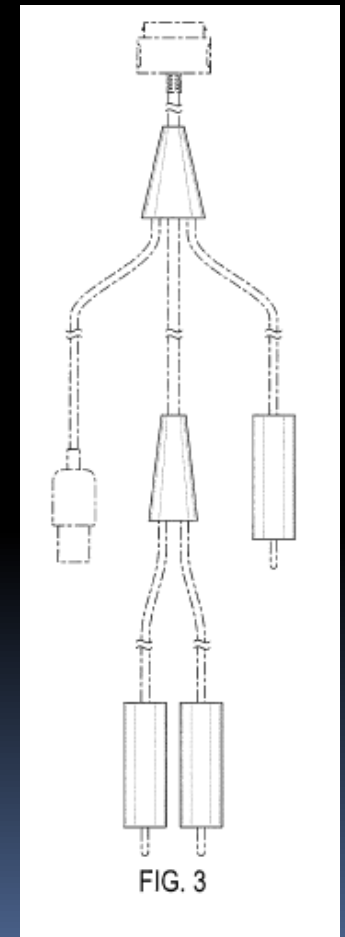
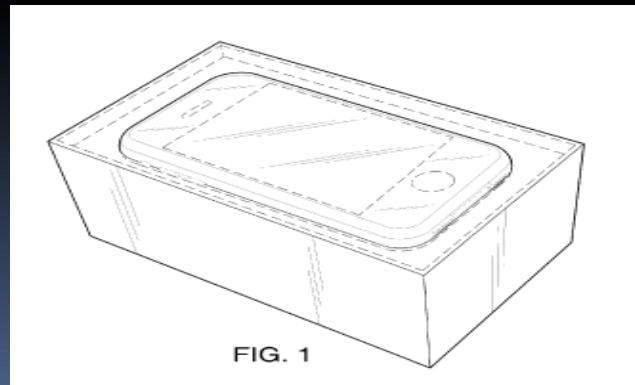
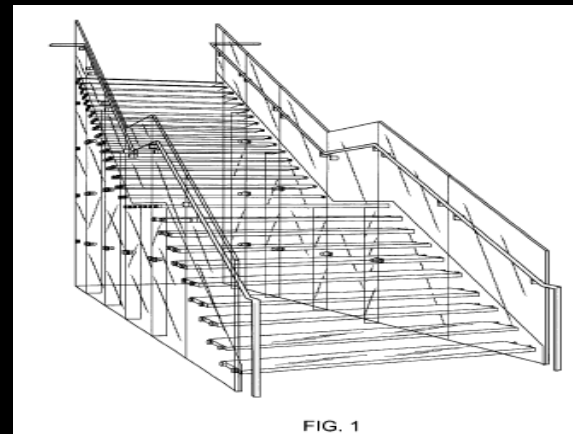
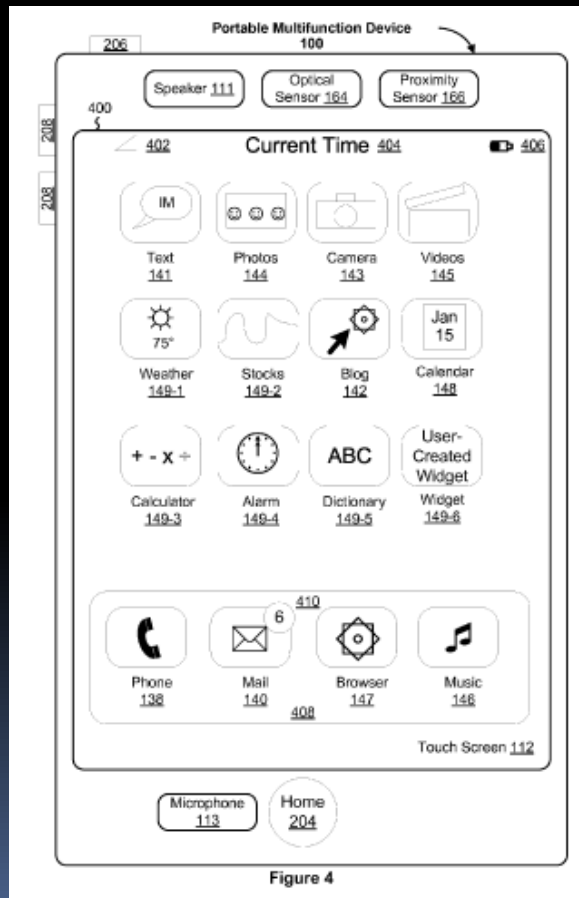
- Recited a **specific** way to automate the creation of a composite webpage
- Problem (ability to keep shoppers on your host page) **specifically arises in the realm of computer networks**
- **Does more** than “broadly and generically claim use of the Internet” to perform an abstract business practice
- **Specifies** how interactions with the Internet are manipulated to yield a desired result that **overrides the routine and conventional sequence of events** ordinarily triggered by a hyperlink
- **More than a drafting effort** to monopolize this abstract idea

Design Patents:

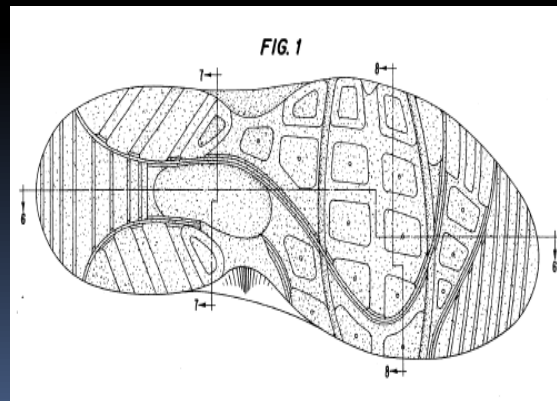
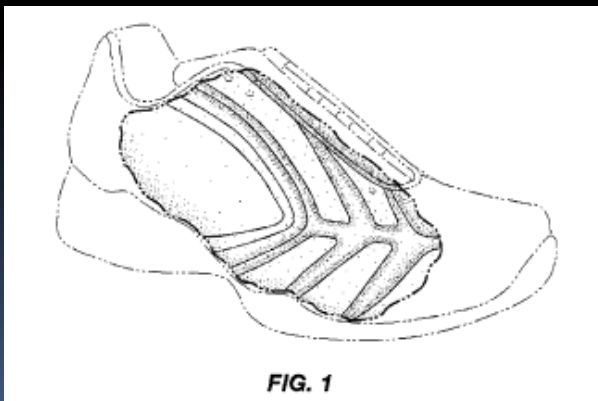
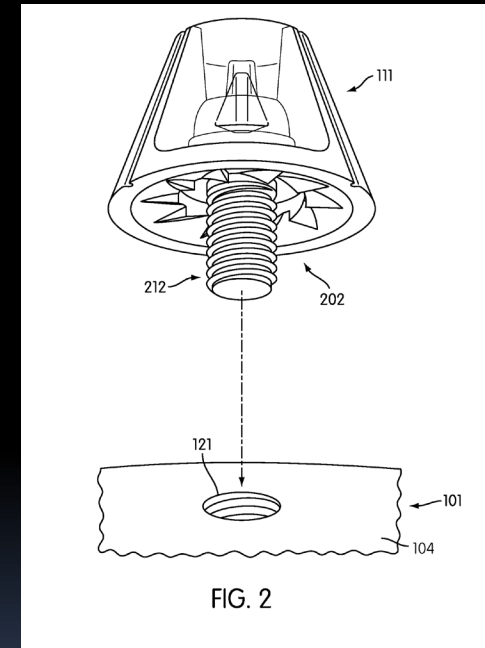
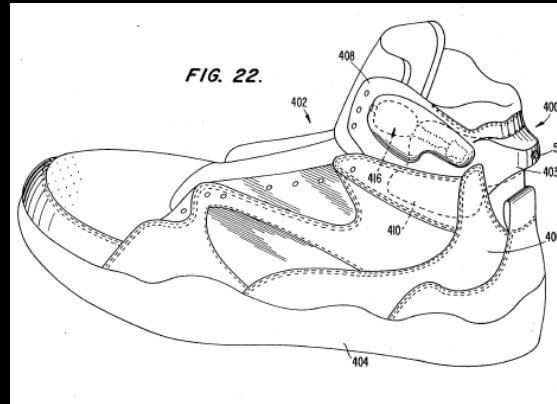
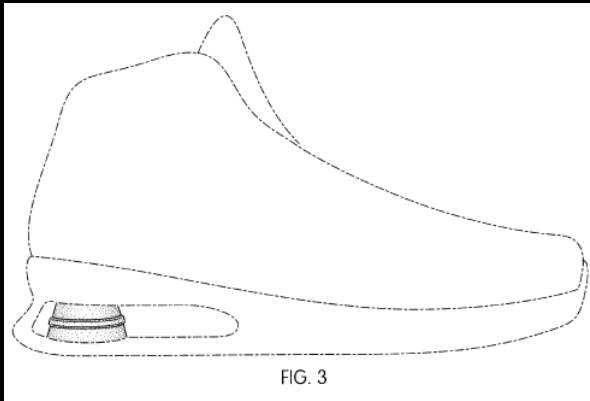


About Patent Portfolios:

Case Study, Apple Computer



Case Study, Nike Shoe



TRADEMARKS



What is a Trademark?

Uniquely identifies a source or quality of goods/services:

1. Word
2. Logo/image
3. Color alone
4. Sound

BENEFITS OF HAVING A REGISTERED TRADEMARK:

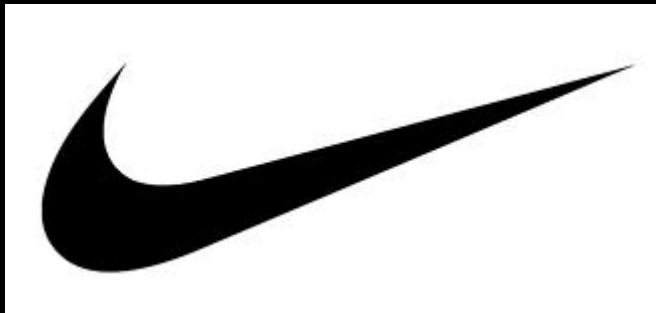
- 1.Brand identity/loyalty
- 2.Right to use ®
- 3.Right to sue

TM or ®?

butter



escalator



Coca-cola



zipper



aspirin





Cannot trademark:

Goods and services which are not permitted in **U.S.** commerce, e.g. marijuana/THC

BUT, new in December 2018, you *can* trademark certain CBD/hemp products, that meet certain THC concentration requirements:

2018 Farm Bill: ***C. sativa* dry weight of THC \leq 0.3% and derived from hemp** are “no longer a controlled substance”

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2	88674792		PURE CHILL	TSDR	LIVE
3	88674181		GOODGOOD	TSDR	LIVE
4	88673944		THE ROSE & HEMP	TSDR	LIVE
5	88673790		KADENWOOD BIOSCIENCES	TSDR	LIVE
6	88673669		NEW ENGLAND HEMP FARM	TSDR	LIVE
7	88673641		NEW ENGLAND HEMP FARM EST 2019	TSDR	LIVE
8	88673615		MAKING THE WORLD GREEN	TSDR	LIVE
9	88673578		GUS'S GREEN THUMB	TSDR	LIVE
10	88673279		SHABOINK	TSDR	LIVE
11	88672625		GREAT SMOKIES	TSDR	LIVE
12	88672067			TSDR	LIVE
13	88310688		CELEBRATING THE FRUITS OF LIFE, LABOR, LOVE AND FAMILY	TSDR	LIVE
14	88285893		TOP COLA	TSDR	LIVE
15	88280534		CBDTHIN	TSDR	LIVE
16	88270316		VEE'S HEMP GUMMIES EST. 2018 FULL SPECTRUM PREMIUM HEMP OIL	TSDR	LIVE
17	88222408		VITABLOSSOM	TSDR	LIVE
18	88170597		PRANA PRINCIPLE	TSDR	LIVE
19	88065010		DIVIOS	TSDR	LIVE
20	88048589		HEMP HEAVEN	TSDR	LIVE
21	88027705		LIKEBONGS .COM	TSDR	LIVE
22	88670744		ZENVANA	TSDR	LIVE
23	88669763		DOOR COUNTY HEMP	TSDR	LIVE
24	88669252		THE GOOD STUFF	TSDR	LIVE
25	88669236		NEW SPECTRUM CBD	TSDR	LIVE
26	88667503		PEACE GARDEN HEMP	TSDR	LIVE
27	88464706		HOLY CACAO THE EDIBLES CULT	TSDR	LIVE



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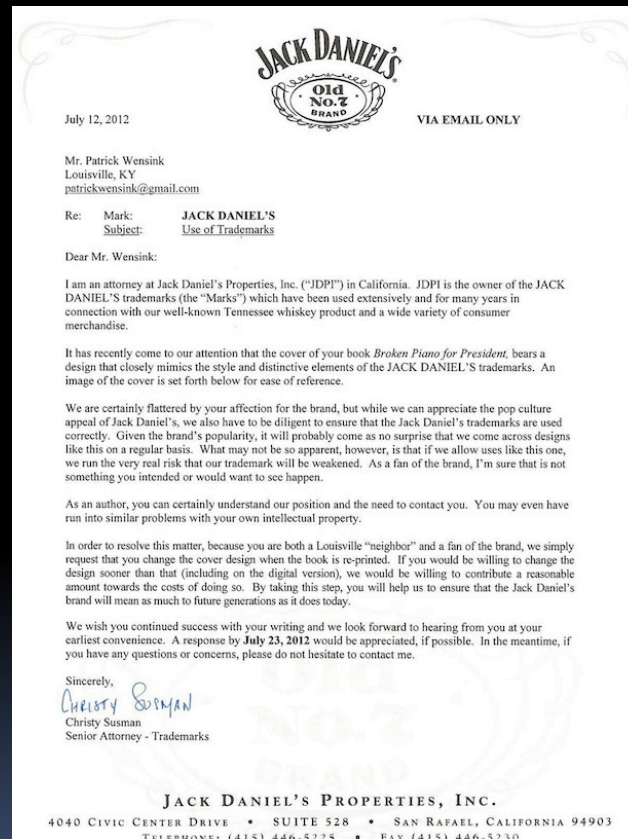
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DR. JACK'S CBD

Word Mark	DR. JACK'S CBD
Goods and Services	IC 003. US 001 004 006 050 051 052. G & S: massage oils; Cosmetic creams for skin care; Cosmetic preparations for skin care; body oils; Lotions for cosmetic purposes; all of the foregoing containing cannabidiol derived from ind more than .3% on a dry weight basis. FIRST USE: 20181223. FIRST USE IN COMMERCE: 20181223
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Serial Number	88285478
Filing Date	February 1, 2019
Current Basis	1A
Original Filing Basis	1A
Published for Opposition	August 6, 2019
Registration Number	5889085
Registration Date	October 22, 2019
Owner	(REGISTRANT) Lucom USA, LLC LIMITED LIABILITY COMPANY FLORIDA 1680 Michigan Av. Suite 920 Miami Beach FLORIDA 33139
Attorney of Record	Mark Terry
Disclaimer	NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "CBD" APART FROM THE MARK AS SHOWN
Type of Mark	TRADEMARK
Register	PRINCIPAL
Other Data	The Name "DR. JACK" does not identify a living individual.
Live/Dead Indicator	LIVE

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What may happen if you use your mark without first checking...



What happens when you don't enforce your trademark?

1. Dumpster
2. Ping-Pong
3. Dry Ice
4. Videotape
5. Escalator

Choosing a strong trademark:

Avoid confusion to a reasonable consumer



But see:



Choosing a strong trademark:

“Fanciful” – made-up word – is best

1. Adidas
2. Xerox
3. Polaroid
4. Exxon
5. Yoyo

Avoid generic

1. Apple – for fruit
2. Windows – for windows

Copyrights



What is a Copyright?

Copyright Act (17 USC §101 et seq.) gives “authors” the exclusive right to:

- Perform
- Display
- Distribute
- Reproduce
- Create “derivative works of”

Their work

Who can own a copyright?



Naruto the macaque took this selfie but he is not a “person” therefore can’t copyright it

What does a copyright protect?

1. Paintings, sculpture, photographs
2. Books
3. Music
4. Drama
5. Movies
6. **Software** – an alternative to a patent?

Why register a copyright?

1. Inexpensive - \$35/\$55
2. Long term – Author's life + 70 years
3. **Required** to sue in federal court
4. Statutory damages
\$750 - \$30,000 per work, up to \$150,000 if willful
5. Attorneys' fees

About the registration process:

- “Examined” for originality/lack of utility
- Process is difficult to track / opaque
- 9+ months to receive certificate
- Appeal rejections - \$200+

Certificate of Registration



This Certificate issued under the seal of the Copyright Office in accordance with title 17, United States Code, attests that registration has been made for the work identified below. The information on this certificate has been made a part of the Copyright Office records.

Marybeth Peters

Register of Copyrights, United States of America

Registration Number:



Effective date of registration:

January 17, 2005

1

Title of Work: The Greatest Movie Ever Made

Nature of Work: Motion Picture

2

Author: Finest Films Inc.

Nature of Authorship: Entire motion picture excluding some music

Work made for hire: Yes

Citizen of: United States

Domiciled in:

Year Born:

Year Died:

Anonymous:

Pseudonymous:

3

Year of Creation: 2005

Date of 1st Publication: January 10, 2005

Nation of 1st Publication: United States

4

Copyright Claimant: Finest Films Inc.

1234 Main St., Los Angeles, CA 94321

Transfer:

5

Previous Registration: No

Previous Registration Number:

Year of Previous Registration:

6

Preexisting Material: Previously published music used with permission

Material Added to this Work: Entire motion picture excluding some previously published music

Certified by

Name: John A. Smith

Author:

Other Copyright Claimant:

Owner of Exclusive Right(s):

Authorized Agent Of: Finest Films Inc.

Date: January 12, 2005

PA0000000149

1 of 2

Copyright Infringement

- What is infringement and what is not?
 - Copying without permission
 - Strict liability - Intent or knowledge not needed
- “Fair Use” defense – depends on purpose and effect of copying
 - Social commentary / First Amendment
 - Educational
 - Minimal borrowing
 - Financial impact on copyright owner

When do you need permission to **use** a photo? When you do not?

Rule of thumb: if you did not take the photo, you need permission.

Exceptions:

- Public Domain – works created before 1923
- Creative Commons license
- Other, written, permission

When do you need permission to *take* a photo of someone?

- Can you identify the person in the photo?
- Expectation of privacy: public / private space
- Celebrities and public figures
- When in doubt, ask permission (written is best!)



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Yes, you need permission even if the subject is deceased...

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