



# TOOLS FOR GROWTH: INTELLECTUAL PROPERTY

Callie M. Bell  
Foley & Lardner LLP  
Email: [cbell@foley.com](mailto:cbell@foley.com)

©2007 Foley & Lardner LLP

**FOLEY**  
FOLEY & LARDNER LLP



## What is “Intellectual Property”?

- Intangible property rights that can be bought, sold, licensed
- Typically divided into 4 areas:
  - Copyrights
  - Trademarks
  - Patents
  - Trade secrets

©2007 Foley & Lardner LLP

**FOLEY**  
FOLEY & LARDNER LLP

## Why Should You Care?

- Legal trade barrier
  - Use IP to strategically build and position your business
- Avoid infringement of the IP of others

©2007 Foley & Lardner LLP

**FOLEY**  
FOLEY & LARDNER LLP

## Copyrights

- What: **original** work of authorship
  - Photographs, music, maps, literary works, computer programs, videos, etc...
- How long does it last:
  - Life of the author + 70 years or
  - 95/120 years from publication/creation
- Owner has exclusive right to reproduce, publicly display, prepare derivative work, etc...

©2007 Foley & Lardner LLP

**FOLEY**  
FOLEY & LARDNER LLP

## Ownership of Copyrights

- Ownership of copyright vs. ownership of the object
- Initial owner is the author except...
  - A work made for hire
    - Prepared by employee within the scope of their employment
      - The employer is the author for copyright purposes
    - A work specially ordered or commissioned... if the parties expressly agree in writing that the work is made for hire
      - 9 itemized categories
      - This definition DOES NOT generally include copyrighted works prepared by third parties for companies

©2007 Foley & Lardner LLP

**FOLEY**  
FOLEY & LARDNER LLP

## WARNING! DANGER!

- If you hire an outside contractor/vendor/third party to write some copy, design a logo, create some artwork, produce a training video - they own the copyright
- Work should be done under a written agreement which transfers all copyright interests to the company

©2007 Foley & Lardner LLP

**FOLEY**  
FOLEY & LARDNER LLP

## Can I Copy Whatever I Want Off the Web, or From Other Sources?

- “Fair Use” limits the exclusive rights of the copyright owner
  - Where the use is for criticism, comment, news reporting, teaching, scholarship, or research
- Commercial Use is seldom (if ever) “Fair Use”

©2007 Foley & Lardner LLP

**FOLEY**  
FOLEY & LARDNER LLP

## How Do I Secure My Copyright?

- Attaches when the original work is created
  - Notice of copyright not required
- No registration required, but...
- You can do it yourself

©2007 Foley & Lardner LLP

**FOLEY**  
FOLEY & LARDNER LLP

## Trademark/Service Mark

- What: **any** word, name, symbol, or device used to indicate the **source** of goods and services
- How long does it last: indefinite
- Who owns: entity using in commerce
  - Be careful about copyright

©2007 Foley & Lardner LLP

**FOLEY**  
FOLEY & LARDNER LLP

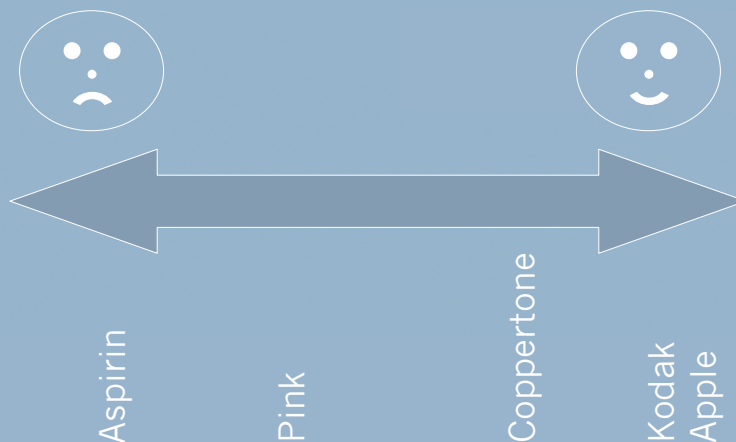
## Acquiring Rights in the U.S.

- Rights in mark based on use
  - No requirement to register
- Applications for registration based on intent to use
  - Use within 3 years from Notice of Allowance

©2007 Foley & Lardner LLP

**FOLEY**  
FOLEY & LARDNER LLP

## Choosing a Trademark



©2007 Foley & Lardner LLP

**FOLEY**  
FOLEY & LARDNER LLP

## Clear the Trademark

- Must not be confusingly similar to mark previously used by another
  - same or similar goods or services
- Conduct search

©2007 Foley & Lardner LLP

**FOLEY**  
FOLEY & LARDNER LLP

# Patents

- What is it: protects inventions and discoveries
  - New products and processes including software
  - Exclude others from making, selling, offering for sale or importing patented invention
- How long does it last: 20 years from filing
- Who owns: **inventor**
  - Need employment agreement requiring employee to assign all rights to the company
  - First to invent
    - Keep records

©2007 Foley & Lardner LLP

**FOLEY**  
FOLEY & LARDNER LLP

## 3 Basic Types of U.S. Patents

- Plant
- Design
- Utility
  - New, non-obvious, and useful process, machine, manufacture or composition of matter
  - Provisional
  - Non-provisional

©2007 Foley & Lardner LLP

**FOLEY**  
FOLEY & LARDNER LLP

## Utility - Provisional

- Typically used when time is critical, or if further experimentation is needed
  - No examination
  - No infringement
- 12 months to file non-provisional
  - Obtain filing date but...

©2007 Foley & Lardner LLP

**FOLEY**  
FOLEY & LARDNER LLP

## When is it Too Late to Apply For a Patent in the U.S.?

- Lost if application not filed in the U.S. Patent and Trademark Office within one year of the date of
  - A first public use in the U.S.
  - An offer for sale in the U.S.
  - Publication or patenting anywhere in the world

©2007 Foley & Lardner LLP

**FOLEY**  
FOLEY & LARDNER LLP



## Trade Secrets

- Protect confidential business information
  - Must provide economic value
  - Must actually take steps to protect
  - Employment agreements for all employees
- Third party can independently develop or discover the secret

©2007 Foley & Lardner LLP

**FOLEY**  
FOLEY & LARDNER LLP

## Importance of Comprehensive Program

- Need comprehensive plan
  - Avoid loss of IP
  - Avoid ownership issues
- Clearance searches to avoid high risk areas
- Your own success may make you a target

©2007 Foley & Lardner LLP

**FOLEY**  
FOLEY & LARDNER LLP