Intellectual Property, Patents & Trademarks
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Big iDeas SMU

Andrea Perez
aperez@kesslercollins.com
(214) 379-0742
Overview

1. Type of Intellectual Property
   - Copyrights
   - Patents
   - Trademarks
   - Trade secrets

2. Legal Clauses in Intellectual Property Contracts
   - Non-disclosure
   - Non-compete/Non-solicit
   - Licenses
   - Representations and Warranties
   - Indemnification

3. Registering Intellectual Property and Enforcing Your Rights
   - Practical tips when registering intellectual property
   - Unauthorized use of your intellectual property and remedies
Types of Intellectual Property

1. Copyrights
   • Works of art
   • ©

2. Patents
   • Inventions
   • Utility, Design and Provisional Applications

3. Trademarks
   • Brand names, logos, and slogans
   • TM or ®

4. Trade secrets
   • Information used in business and gives an opportunity to obtain an economic advantage over competitors who do not know or use it.
Copyrights

- Books, brochures, newspapers, theatrical works, oral presentations, choreographic works, music, drawings, paintings, buildings, sculptures, designs, photographs, websites and computer programs

- Created the moment a work of art is tangible – no such thing as a protection for an idea

- Original author immediately owns the copyright, with some exceptions
  - Employees
  - Work for hire
  - University students and faculty

- Generally, registration lasts for the life of the author plus 70 years
  - If a joint work, then life of the surviving author plus 70 years
  - If an anonymous, pseudonymous, or a work made for hire, the shorter of 95 years from publication or 120 years from creation
Patents

• The grant of a property right to an inventor issued by the United States Patent and Trademark Office (USPTO). The term of a new patent is 20 years from the date on which the application was filed.

• A patent is the right to exclude others from making, using, offering for sale, or selling an invention in the United States or importing the invention into the United States.

• Two Common types of patents:
  • Utility patents
  • Design patents
Provisional Patent Applications

- A provisional application provides a means to establish an early filing date in a patent application and permits the term “Patent Pending” to be applied in connection with the invention. Provisional applications may not be filed for design inventions.

- The filing date of a provisional application is the date on which a written description of the invention and drawings are received in the USPTO. The applicant then has up to 12 months to file a nonprovisional application for patent. The later filed nonprovisional application is entitled to the benefit of the earlier filing date of the provisional application.

- Provisional applications are NOT examined on their merits and is not the grant of a patent. A provisional application will become abandoned 12 months from its filing date. **You must file a nonprovisional patent application within the 12 months to receive a patent.**
Trademarks

- Brand names, logos, and slogans

- Examples of nonconventional trademarks:
  - Southwest Airlines “Ding”
  - MGM “Roar”
  - Kiss face paint
  - Apple’s store design

- TM vs. ®

- Must actually be using the trademark in connection with the sale of goods or services across state lines

- Brand Guidelines for SMU trademarks
Trade Secrets

• information, including a formula, pattern, compilation, program, device, method, technique, process, financial data, or list of actual or potential customers or suppliers, that:
  • derives independent economic value from not being generally known to, and not being readily ascertainable by, other persons who can obtain economic value from its disclosure or use; and
  • is the subject of efforts to maintain its secrecy

• Protected under state laws and there is no registration requirement

• Trade secret could protect your IP better than a patent. This is a business decision and you should consult with an IP attorney
Common Legal Terms in IP Contracts

• **Non-disclosure**
  • Prevents you or another party from disclosing certain information that is defined as confidential

• **Non-compete/Non-solicit**
  • Prevents you from working for a competitor for a period of time and/or soliciting customers and employees to come work for you or a competitor

• **Licenses**
  • Grants permission to use IP for a certain period of time

• **Representations and Warranties**
  • Promises about the qualities and warranties of the IP that is being provided

• **Indemnification**
  • Promise to pay for costs that could occur in the event of a dispute or lawsuit
Practical Tips about Registering IP

1. Copyrights
   • [www.copyright.gov](http://www.copyright.gov)
   • Registration is required to sue for copyright infringement
   • Benefits of statutory damages
   • Joint ownership issues
   • Work for hire

2. Patents
   • [www.uspto.gov](http://www.uspto.gov)
   • First to register and not first to create
   • Is the invention something that can be registered?

3. Trademarks
   • [www.uspto.gov](http://www.uspto.gov)
   • Trademark searches
   • First to use and not first to register
   • Application process is between 9-12 months
   • Must actually use the trademark and continue using it to renew your registration
Enforcing Your Rights

1. Cease and Desist Letters

2. Take-Down Requests
   - Domain name issues
   - Digital Millennium Copyright Act
   - Social media take-downs

3. Judicial Remedies
   - Injunctions
   - Lawsuits
Andrea Perez concentrates her practice in the fields of intellectual property, business law and art law. She has consulted and represented hundreds of different businesses with regards to their intellectual property, trademark and copyright prosecution, licensing, business formation, contract drafting and negotiation needs. Andrea also works closely with galleries, artists, entertainers and other art professionals to assist them with their unique art law and entertainment law matters.

Andrea Perez
aperez@kesslercollins.com
2100 Ross Avenue, Suite 750
Dallas, Texas 75201
(214) 379-0742