A. Intellectual Property Strategies & Best Practices

Intellectual Property ("IP") is an intangible asset of your business unlike land, which is a tangible asset. As you would want to protect any other property or asset, you should also protect your IP. Products, designs, names and other valuable assets developed by you or your business are IP assets. Protecting your Intellectual Property (IP) asset is as important as protecting any other asset and without proper protection may be lost or stolen.

In addition to the products and their uses, any symbols, logos, words or phrases that are characteristic of the product or your business or the services may also be IP. If your clients associate your products/business/service with such symbols, logos, words or phrases, they may be considered unique and they become valuable assets to the business. Think of a situation where another business opens next door and starts selling a similar product or providing a similar service using similar logos/words or phrases to advertise, will you loose customers or business? If yes, this may be an example of IP that you may need to protect.

Trade secrets are any information that you may have that gives your business a competitive advantage. It does not matter that such information may be obtainable by others through hard work. Trade secrets include: technical "know how", customer lists, future product developments, inventory data and other such information that may give your company a competitive advantage. "Know how" is a term used to define unpublished technical or non-technical information that has economic value to your company. As long as you can keep the information secret, it will be your trade secret.

Patent Protection of your unique products may assist you in protecting your market. A patent is a grant from the U.S. government that allows you to stop others from making, selling or using the product or process covered by that patent.

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Trademark protection is used to distinguish your product or services from your competitors. The value of the entire company may be linked to a single trademark, thus a trademark can be extremely valuable.

Your words or phrases may also be covered by copyright. Copyright protection is for original works of authorship fixed in a tangible medium of expression. Copyright covers both published and unpublished works.

To protect your IP, you should get counsel on how you should define and categorize it. Depending on this, you should be able to file for a patent, trademark, trade service, copyright or protect your trade secret or "Know-How". You may find that a product or a service is covered by patents, trademarks, copyright and trade secret protection simultaneously, since each type of intellectual property covers a separate aspect of the product or service.

In order to protect your IP, you should ensure that those who have access to your IP follow proper procedures. You will need to apprise your employees of your company's IP practices and the employees' responsibilities. It is critical that your employees have a clear understanding of who owns the inventions that they develop while employed by your company and what their obligations are when they leave your employment—not disclosing your IP to others.

Having an employee sign an agreement to transfer intellectual property rights provides insurance against employees taking valuable company property, such as, patentable inventions, company names or slogans, copyrights, and trade secrets. Additionally, such an agreement may actually heighten employee awareness to intellectual property issues and may deter employees from improper use or disclosure of that property.

Proper disclosure and recording of your IP, including inventions, is an important part of IP protection. The US Patent system follows "first

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to invent" compared to the "first to file" system followed by other countries. In situations where two inventors may have invented the same invention and filed a patent application within a few months of each other, the evidence(s) showing who invented first are crucial in determining who gets the patent. Thus, it is essential that inventors/applicants maintain a proper record of the invention, starting from the concept to the making of the finished invention. In a dispute, an inventor who can provide the evidence to invent first gets the patent. This includes evidence of first to get the concept and the evidence of first to make and use.

If you have a patentable invention, once you disclose it in public, you have to file an application within a year of disclosure if desiring a US Patent. Examples of public disclosure are: presenting at a conference, publishing a paper, presenting to a potential licensee, business partner or vendors, etc. It is highly advisable that before disclosing your IP, invention or research work, a determination must be made regarding if it is appropriate to file for a patent application.

The offer for sale or for public use is another scenario that needs attention. If you do not have a confidentiality agreement or a non-disclosure agreement ("NDA"), contractors—who do not technically qualify as employees—can use your information to develop a similar product or share information with another party (e.g. your competitors). If the IP is to be presented to a potential business partner or a licensee, having a NDA signed by the business partners or potential licensee is advised. Such an agreement is a legal contract between at least two parties to protect IP (such as an invention, trade secrets) or any other confidential information that one of the parties who is a party to the agreement shares with the other(s).

For additional Information, visit:

http://www.USPTO.GOV–the official website of the United States Patent and Trademark Office

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http://www.stopfakes.gov–for a general discussion and frequently asked questions about IP
http://www.copyright.gov –the official website of the United States Copyright office

B. Trademarks

As a business owner, you would want your business to prosper without any competition. For this, you want to provide a service or a product to the consumer that others do not provide. For advertisement of your businesses you may create a logo or a slogan or both, that identify your business. For example, do you associate the following with a certain product?

"Have a Coke and a smile"

The logo and the slogan shown above make you think of Coca Cola and are IP of The Coca Cola Company. Specifically, they are the trademarks of The Coca-Cola.

If you have a logo for your business or use a slogan, you may have a trademark IP. Trademarks are business-oriented and protect brand names, slogans and logos. Protecting your trademark by registering it will help to preserve your business asset. Trademarks protect taglines and logos. Trademark protection distinguishes goods and services and it can be renewed every 10 years, provided the mark remains in use. Thus, trademarks may last forever. Sometimes, a product or a service is covered by patents, trademarks, copyright and trade secret protection simultaneously, since each type of intellectual property covers a separate aspect of the product or service.

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From the time that humans began to roam the Earth, people have used marks to indicate the maker or producer of goods. Essentially, a trademark is any word, letter, number, design, or combination of those, that identifies one party as the source of particular goods and services from those of others.

When you see a logo on a digital camera, or a bunch of bananas, or a pair of jeans, you know who made or produced those goods. You use the logo to distinguish the goods you want from the goods made or produced by a competing brand. Over time, trademarks gain reputations. Consumers come to expect a certain level of quality based upon that reputation, which then drives their purchasing decisions. The key to retaining Trademark protection is that every time you make, use or sell the product you always use the Trademark such that there is no question in any one's mind that on seeing the trademark only one product comes to mind.

A service mark is the same as a trademark except that it identifies and distinguishes the source of a service rather than a product. The terms "trademark" and "mark" are commonly used to refer to both trademarks and service marks. Trademark rights may be used to prevent others from using a confusingly similar mark, but not to prevent others from making the same goods or from selling the same goods or services under a clearly different mark. Trademarks, which are used in interstate or foreign commerce, may be registered with the USPTO.

Any time you claim rights in a mark, you may use the "TM" (trademark) or "SM" (service mark) designation to alert the public to your claim, regardless of whether you have filed an application with the USPTO. State trademark protection is a good first step but it only provides protection for your use of the mark in that particular state. If another party registers a similar mark with the U.S. Patent and Trademark Office, you may lose your rights in that trademark or be severely limited in several respects as to where you can use the trademark. You may be limited to a geographically restricted area or

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market or line of products. This loss in rights may adversely affect your business.

In the United States, trademark rights are derived from priority of "use." Registration of those rights is not required. However, each state has a system for registering trademarks, which are used in that state. The legal effect and value of a state trademark registration can vary from state-to-state. Many trademark owners that use their mark "in commerce" choose to register their trademarks with the United States Patent and Trademark Office in order to get the benefits associated with a federal trademark registration. The term "in commerce" means interstate commerce, territorial commerce, or between the United States and a foreign country.

Owning a federal trademark registration on the Principal Register provides several advantages, including:

• A public notice of your claim of ownership of the mark;
• A legal presumption of your ownership of the mark and your exclusive right to use the mark nationwide on or in connection with the goods/services listed in the registration;
• The ability to bring an action concerning the mark in federal court;
• The use of the U.S. registration as a basis to obtain registration in foreign countries;
• The ability to record the U.S. registration with the U.S. Customs and Border Protection (CBP) Service to prevent importation of infringing foreign goods;
• The right to use the federal registration symbol ®; and
• Listing in the United States Patent and Trademark Office's online databases.

However, you may use the federal registration symbol "®" only after the USPTO actually registers a mark, and not while an application is pending. Additionally, you may use the registration symbol with the mark only on or in connection with the goods and/or services listed in the federal trademark registration. It provides notice to the world that your mark is registered and helps to keep your intellectual property

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yours. In addition to any state law protection that you may have, you have federal protection as well. You would have the ability to sue infringers in federal court to prevent them from using your federally registered trademark.

Failure to monitor and control the use of your trademark may result in it being declared generic and thus loss of your exclusive use. Examples of trademarks that have become generic are: Aspirin, Escalator, Dry Ice, yo-yo and Zipper. Proper monitoring and control means not only your own use of the mark but also the use of your own employees and even others.

In the United States, trademark rights are derived from priority of "use." These rights are called "common law" trademark rights. If you are the first user of a mark, then these "common law" rights may allow you to challenge the use or registration of your trademark by someone else in several ways, depending on the factual situation.

Before beginning to use a trademark, a business should first determine whether some *other* business is already *using* an *identical or similar* trademark, on or in connection with the *same or related* goods or services, or whether some other company otherwise has any rights in the mark. By making that determination, a company reduces the risk of violating another company's trademark rights.

If you would like to determine if a trademark is available for "use" or "registration," you should consider contacting an attorney specializing in trademark law. A search of the registrations and applications in the United States Patent and Trademark Office (USPTO) database generally is insufficient since, in the United States, trademark rights are derived from priority of "use". Local bar associations and telephone directories usually have attorney listings broken down by specialties. Time can be of the essence. Click here for further information.

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For additional Information, visit:

http://www.uspto.gov/trademarks/basics/index.jsp–This website provides basic facts about Trademarks, Frequently Asked Questions, Instructional Videos, and processing timelines for trademarks.

http://www.uspto.gov/inventors/trademarks.jsp–This is a link for connecting to the Inventor Assistance Program for Trademarks. The site provides basic information about Trademarks, Service Marks, basics of applying for a trademark and the filing fee.

C. Copyrights

Your product and its packaging, advertising brochures or instructions are protected by copyright. All that is required, as the law states, is for the work to be fixed in a tangible medium. This means that as soon as you put pen to paper or press the record button, your original work is protected. Loss of your unique work may also result in loss of any competitive advantage that you may have over your competitors. It is always best to protect your original work.

Copyright is a form of protection grounded in the U.S. Constitution and the protection for copyright is provided by the Title 17 of the U.S. Code. Copyrights are granted for original works of authorship fixed in a tangible medium of expression and cover both published and unpublished works. 17 U.S.C. § 102 states:

-STATUTE-

(a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:

(1) literary works;

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(2) musical works, including any accompanying words;
(3) dramatic works, including any accompanying music;
(4) pantomimes and choreographic works;
(5) pictorial, graphic, and sculptural works;
(6) motion pictures and other audiovisual works;
(7) sound recordings; and
(8) architectural works.

(b) In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.

It is important to note that copyright protects "the expression of an idea" in any of the expression media described in section 102(a), not the idea itself. The rights of the copyright owner include reproducing the work in copies or phonorecords; preparing derivative works based upon the work; distributing copies or phonorecords of the works to the public by sale or other transfer of ownership, or by rental, or lending; performing the work publicly, and displaying the work publicly (Section 106 of the title 17).

While the copyright owner has exclusive rights, there are certain exemptions, such as the doctrine of "fair use" as stated in section 107. Additionally, according to the “first-sale doctrine”, if you buy a book or painting, you can resell your book or painting, however you cannot reproduce it.

Copyright is the property of the author or those deriving their rights through the author. Authors of joint work are co-owners of the copyright in the work, unless there is an agreement between or among them. However, for works created by an employee—or “work made for hire”—the employer, not the employee, owns the copyright.

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Copyright protection is available for all unpublished works, regardless of the nationality or domicile of the author.

Copyright is automatically secured when a work is created, and the work is created when it is fixed in a copy or phonorecord for the first time. No publication or registration or other action in the copyright office is required to secure a copyright. While the use of a copyright notice is not required, it is often beneficial. Use of notice informs the public that the work is protected by copyright, identifies the copyright owner, and shows the year of first publication. The use of the copyright notice is the responsibility of the copyright owner and does not require advance permission from, or registration with, the Copyright Office. The notice for visually perceptible copies should contain: the symbol ©—"the letter C in a circle"; the year of first publication of the work; and the name of the owner of copyright in the work or an abbreviation by which the name can be recognized, or generally known alternative designation of the owner. The notice for phonorecords of sound recordings should contain the following three: the symbol: the letter P in a circle; the year of the first publication of the sound recording; and the name of the owner of the copyright in the sound recording or an abbreviation by which the name can be recognized, or generally known alternative designation of the owner. The author or copyright owner may want to place a copyright notice on any unpublished copies or phonorecords that leave his or her control (for example: Unpublished work©2010 John Doe).

Protection against unauthorized use of an author's writings in a certain country depends on the national laws of the country and International treaties and conventions between United States and that country.

For additional Information, visit:

http://www.copyright.gov–The official website of the Copyright Office of the United States:
http://www.copyright.gov/title17/–the Copyright laws of the United States

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http://www.copyright.gov/circs/circ01.pdf, –Circular 1, *Copyright Basics* for general discussion of what is protected under the Copyright law, how to register a Copyright and how and where to get more information about Copyright.
http://www.copyright.gov/circs/circ38a.pdf,– Circular 38a for International Copyright Relations of the United States.

D. DESIGN PATENTS

Differences in structure, function or operation may be the basis for seeking patent protection. A patent is a property right granted by the Government of the United States of America to an inventor "to exclude others from making, using, offering for sale, or selling the invention throughout the United States or importing the invention into the United States" for a limited time in exchange for public disclosure of the invention when the patent is granted.

Design patents cover the unique appearance of your products. Think of them as protection for your industrial designs since they do not cover the structure or function of the device. Design patent protection can be quite powerful and very valuable. This is especially true when design patents are used with other forms of intellectual property. If you have product designs that are unique, failure to file an application may result in your being barred from ever receiving a design patent on that product. If you have made and used the design in public or offered the product with that particular design for sale more than one year before the file of a patent application on that design you cannot get a patent in the United States on that design. Design protection is both an offensive and a defensive strategy. It allows you to assert ownership over all that is yours and prevent others from encroaching in on your share of the market.

The patent law provides for the granting of design patents to any person who has invented any new, original and ornamental design for

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an article of manufacture. A design patent protects only the appearance of the article and not structural or utilitarian features.

35 U.S.C. 171 provides for designs patents. It states:

"Whoever invents any new, original, and ornamental design for an article of manufacture may obtain a patent therefore, subject to the conditions and requirements of this title."

A design consists of the visual ornamental characteristics embodied in, or applied to, an article of manufacture. Since a design is manifested in appearance, the subject matter of a design patent application may relate to the configuration or shape of an article, to the surface ornamentation applied to an article, or to the combination of configuration and surface ornamentation. An ornamental design may be embodied in an entire article or only a portion of an article, or may be ornamentation applied to an article. A design for surface ornamentation is inseparable from the article to which it is applied and cannot exist alone. It must be a definite pattern of surface ornamentation, applied to an article of manufacture. If a design is directed to just surface ornamentation, it must be shown applied to an article in the drawings, and the article must be shown in broken lines, as it forms no part of the claimed design.

35 U.S.C. 173 sets forth the term of a design patent: It states:

"Patents for designs shall be granted for the term of fourteen years from the date of grant."

A design patent application may only have a single claim (37 CFR § 1.153). Designs that are independent and distinct must be filed in separate applications since they cannot be supported by a single claim. Designs are independent if there is no apparent relationship between two or more articles. For example, a pair of eyeglasses and a door handle are independent articles and must be claimed in separate applications. Designs are considered distinct if they have different

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shapes and appearances even though they are related articles. For example, two vases having different surface ornamentation creating distinct appearances must be claimed in separate applications. However, modified forms, or embodiments of a single design concept may be filed in one application. For example, vases with only minimal configuration differences may be considered a single design concept and both embodiments may be included in a single application.

In general, a “utility patent” protects the way an article is used and works (35 U.S.C. 101), while a "design patent" protects the way an article looks (35 U.S.C. 171). Both design and utility patents may be obtained on an article if invention resides both in its utility and ornamental appearance. While utility and design patents afford legally separate protection, the utility and ornamentality of an article are not easily separable. Articles of manufacture may possess both functional and ornamental characteristics.

For additional Information, visit:

http://www.uspto.gov/patents/resources/types/designapp.jsp#types– A guide for filing a Design Patent Application.

E. Trade Secrets

Trade secrets are any closely held information that you may have that gives your business a competitive advantage. It does not matter that such information may be obtainable by others through hard work. As long as you can keep the information secret it will be your trade secret. Trade secret law varies from state to state but most states follow the Uniform Trade Secrets Act. Technical information that is not easily reverse engineered is a good candidate for trade secret protection. If the technical information is easily reversed engineered then you should consider filing a patent application to cover that product or process since if it is easily reverse engineered it will cease to be a secret. However, patent protection will only exist for the lifetime of the patent, which is 20 years from the filing date of the

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application, whereas trade secret protection can last indefinitely so long as the information remains secret.

Trade secrets are not just technical information. Having an understanding of trade secret law and the law as it relates to other forms of intellectual property will allow you to select the protection that is most appropriate for your business.

Part of treating trade secret information seriously is to limit the number of people that have access to that information. It is not much of a secret if all of your employees have access to it. Training on the proper handling of trade secret information is of the utmost importance since failure to have proper procedures in place for handling trade secret information may result in valuable information being made public. Further, if an employee or former employee uses your trade secret information and you do not have procedures in place for handling that information, a court may determine that you no longer have a secret to protect. Therefore, it is important for you to treat trade secret information as just that, a secret, and if you treat this seriously, so will your employees. A nondisclosure agreement is a contract between two parties that may be used to maintain the confidentiality of closely held information like a trade secret or a patent application.

For additional Information, visit:

http://uscode.house.gov/download/pls/18C90.txt– Chapter 90 of the Title 18, Protection of trade secrets.

F. Utility Patents

Differences in structure, function or operation may be the basis for seeking patent protection. A patent is a property right granted by the Government of the United States of America to an inventor "to exclude others from making, using, offering for sale, or selling the invention throughout the United States or importing the invention into the

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United States" for a limited time in exchange for public disclosure of the invention when the patent is granted.

A utility patent is provided for a new, non-obvious and useful: process, machine, article of manufacture; composition of matter; and an improvement of any of these. A patentable invention must be novel, non-obvious, adequately described and enabled (for one of ordinary skill in the art to make and use the invention) and claimed in clear and definite terms

Following cannot be patented: laws of nature; physical phenomena; abstract ideas; literary, dramatic, musical, and artistic works (these can be Copyright protected); inventions that are not useful (such as a perpetual motion machine); and inventions that are offensive to public morality.

For applications filed on or after June 8, 1995, utility and plant patents are granted for a term, which begins with the date of the grant and usually ends 20 years from the date you first applied for the patent subject to the payment of appropriate maintenance fees. Patents in force on June 8, 1995 and patents issued thereafter on applications filed prior to June 8, 1995 automatically have a term that is the greater of the twenty-year term discussed above or seventeen years from the patent grant.

Only a non-provisional application, when examined and approved at the Patent Office, results in a patent. However, under certain circumstances, filing a provisional application may be beneficial.

A provisional application for patent is a U. S. national application for patent filed in the USPTO under 35 U.S.C. § 111(b) . It allows filing without a formal patent claim, oath or declaration, or any information disclosure (prior art) statement. A provisional application is not examined and does not result in the grant of a patent. It provides the means to establish an early effective filing date in a later-filed non-provisional patent application filed under 35 U.S.C. § 111(a) .

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It also allows the term "Patent Pending" to be applied in connection with the description of the invention.

Applicants are entitled to claim the benefit of a provisional application in a corresponding non-provisional application filed not later than 12 months after the provisional application filing date. Under the provisions of 35 U.S.C. § 119(e) , the corresponding non-provisional application would benefit in three ways: (1) patentability would be evaluated as though filed on the earlier provisional application filing date, (2) the resulting publication or patent would be treated as a reference under 35 U.S.C. § 102(e) as of the earlier provisional application filing date, and (3) the twenty-year patent term would be measured from the later non-provisional application filing date.

A provisional application for patent (provisional application) has a pendency lasting 12 months from the date the provisional application is filed. The 12-month pendency period cannot be extended. Therefore, an applicant who files a provisional application must file a corresponding non-provisional application for patent (non-provisional application) during the 12-month pendency period of the provisional application in order to benefit from the earlier filing of the provisional application. In accordance with 35 U.S.C. § 119(e) , the corresponding non-provisional application must contain or be amended to contain a specific reference to the provisional application within the time period and in the manner required by 37 CFR 1.78.

Once a provisional application is filed, an alternative to filing a corresponding non-provisional application is to convert the provisional application to a non-provisional application by filing a grantable petition under 37 CFR § 1.53(c)(3) requesting such a conversion within 12 months of the provisional application filing date. However, converting a provisional application to a non-provisional application (versus filing a non-provisional application claiming the benefit of the provisional application) will have a negative impact on patent term. The term of a patent issuing from a non-provisional application

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resulting from the conversion of a provisional application will be measured from the original filing date of the provisional application.

By filing a provisional application first, and then filing a corresponding non-provisional application that references the provisional application within the 12-month provisional application pendency period, a patent term endpoint may be extended by as much as 12 months.

Completing an audit will assist you in finding new products and services that can enhance your growth potential. Further, knowing when inventions were created and disclosed to the public or sold is very important. You may not be able to get protection on your invention in the United States if it was publicly disclosed or offered for sale more than one year before the filing date of the application. Finally, not knowing when an invention was disclosed or offered for sale may prevent you from getting a patent in other counties since most other countries have an absolute novelty requirement and thus do not allow any disclosures prior to filing of the application. Having a system for documenting new inventions will allow you to more easily write the patent application or assist your attorney or patent agent in writing the patent application. It will also assist you with proving when you created the invention and other ownership issues. It will assist you in tracking the contributions that were made by each of your employees. This is important since any patent that issues must name the actual inventors. Patent misuse may be found where the patent owner forces a licensee to purchase additional and usually unnecessary products as a condition for obtaining the license for the patented invention. An example of this would be contractually requiring a licensee to buy a license for patents to manufacture CDs along with the license for a patent to make a vaccine.

Antitrust issues are a concern here because the patented invention is tied to an unpatented product. Additionally, false marking may be a misuse of the patent. Either labeling a product or process as patented or patent pending when it is not may result in the imposition

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of a monetary penalty. If the patent has expired or the patent application is abandoned, the safest course to take is to discontinue using the phrases "patented" or "patent pending" as quickly as practicable.

For additional Information, visit:

http://www.uspto.gov/patents/process/index.jsp–A flow chart that describes the process for obtaining a Utility Patent.

http://www.uspto.gov/inventors/iac/–The Inventors Assistance Center (IAC) provides patent information and services to the public. The IAC is staffed by former Supervisory Patent Examiners and experienced Primary Examiners who answer general questions concerning patent examining policy and procedure.

http://itunes.apple.com/us/podcast/uspto-intellectual-property/id303531158?ign-mpt=uo%3D4– Podcasts from USPTO that discuss basics of patents and trademarks.

G. **USING TECHNOLOGY OR CONTENT OF OTHERS**

The use of Intellectual Property (IP) protection has grown tremendously over the past few years. This is largely due to the growth of technology and the changes demonstrated by the million to billion dollar award settlements for infringement of IP rights. While purchase and use of a patented product for its intended purpose includes an implied license from the patent holder, there may be some unintended consequences if the full extent of patent claim language is not understood. Use of the patented technology, for its intended purpose does give a cause for a suit. However, if you make modification to the patented device outside of the scope of the claimed invention, you may cause yourself some legal problems.

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Unauthorized use of copyrighted materials, either wholesale copying or copying of just a portion, or the making of a derivative of the copyrighted work, may subject you to a lawsuit with a possible injunction or monetary damages. Copyrighted material from another should not be used without their permission. As a caveat to this, there are fair use exceptions in the copyright laws. However, it would be an extremely rare situation for a business to fall into one of the fair use exceptions. Unlike other forms of intellectual property, trade secrets of another party are freely usable, provide the information was not stolen or obtained by some other illicit means.

Likewise, the intended or unintended use of a portion of another party's trademark may create a problem for companies. Copyright and trademark lawsuits are much more common that patent infringement. Extreme caution should be taken when using portions of another party's trademark.

Unlike other forms of intellectual property, trade secrets of another party are freely usable, provide the information was not stolen or obtained by some other illicit means.

If you are using the products, wording, descriptive identity or other type of IP of another, a search should be made to determine if any of these items is covered under some form of IP. If you are planning to use the work of another, it is recommended that you get their authorization. A licensing agreement may be your easiest means for resolving the right to use the intellectual property of another. One way to make sure is to do a search to determine if the product is covered under some form of intellectual property. This search is termed "Freedom to Operate" ("FTO"). This search will allow you to identify what kind of licensing agreement you would need to negotiate.

It may then be a good idea for you to contact the person in the company who is responsible for licensing out rights in company products. It is critical that you do this very carefully and strategically. Ask yourself, do you know anyone in that company who you could first

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approach casually to assess if this company is interested in licensing rights in its product. Based on this individual's response you may want to further develop your strategy of how much to disclose to the company. If the company agrees to sign non-disclosure agreement it is the first sign that this company maybe interested in licensing. This company will then give an outline of the license terms, "a term sheet", "letter of intent" or a "heads of agreement."

An issues to consider in a licensing agreement is do you want a non-exclusive or Exclusive license. Under a non-exclusive license, the licensor can sell the same rights to others. On the other hand, under an exclusive license, the licensor provides exclusive rights to one licensee. The determination for giving exclusive or non-exclusive rights in a license agreement depends on multiple factors such as the type of IP, type of the product or service, etc. Other factors include- length of the agreement (term); rights to modify or combine with other products, (if you want to use the IP to make a combination product with your own product); non-disclosure of confidential information; prohibited use; assignment, distribution of product, diligence, transfer and sublicense rights; acceptance, testing and training; warranties; limitations on the licensor's liability; support and maintenance services; insurance, indemnity for liability, indemnity for infringement; enforcement of remedies; and termination.

On a financial level, the company will ask for royalties and an upfront license fee at a minimum and patent cost reimbursement and patent maintenance costs. Other financial terms could include equity, annual maintenance fees, and milestones.

A system for tracking license agreements is necessary for any business. It will allow you to maintain only those licenses that you use or anticipate using. This will keep your licensing expenses down.

For additional Information, visit:

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http://www.lesi.org/Article/About_LESI.html–Website of the Licensing Executive Society International.

http://www.lesi.org/Article/Resources/Licensing_FAQs.html–Frequently Asked Questions on Licensing and Technology Transfer at the Licensing and Executive Society International Website

H. LICENSING TECHNOLOGY OR CONTENT TO OTHERS

Licensing agreements may be one way for you to expand your business and create company value. Use of a particular technology in a business that you had not previously considered may allow you to expand your business without creating a new competitor. Having additional people selling your products may allow you to expand geographically or into different markets without the additional overhead and risk.

A licensing agreement is a special agreement whereby one party (licensor), in exchange for a value, gives permission to another party (licensee) a do a certain activity or to use certain property. Without protecting your IP, it will be very difficult to interest others in your licensing your IP.

IP can be used both offensively and defensively. The key is to use it to either grow into a new business area or to protect your own. Once you have filed an application for protecting your IP, you need to clearly understand its potential both for protecting and growing your business. For example, if you are interested in entering a new market are, you should identify the market players and understand their IP. This process will allow you to then identify any complimentary skills or IP that these market players may have. You could then explore the possibility for combining your resources with those of the market players. It may then be a good idea for you to contact the person in the company who is responsible for receiving new potential inventions/ideas. Based on this individual's response you may want to

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decide on your strategy of how much to disclose to the company. In any case, it is always important to get a non-disclosure agreement in place if you do end up sharing your IP in a meeting or conversation. Once you get a positive response from the company, you can give an outline of the license terms, "a term sheet", "letter of intent" or a "heads of agreement" to the company.

Some issues to consider in a licensing agreement are: non-exclusive vs. exclusive. Under a non-exclusive license, the licensor can sell the same rights to others. On the other hand, under an exclusive license, the licensor provides exclusive rights to one licensee. The determination for giving exclusive or non-exclusive rights in a license agreement depends on multiple factors such as the type of IP, type of the product or service, etc. Other factors include- length of the agreement (term); rights to modify or combine with other products, (if you want to use the IP to make a combination product with your own product); non-disclosure of confidential information; prohibited use; assignment, distribution of product, diligence, transfer and sublicense rights; acceptance, testing and training; warranties; limitations on the licensor's liability; support and maintenance services; insurance, indemnity for liability, indemnity for infringement; enforcement of remedies; and termination.

On a financial level, you may consider including appropriate royalty, an upfront license fee, patent cost reimbursement, and patent maintenance costs. Other financial terms that may be added to the licensing agreement are equity, annual maintenance fees, and milestones.

While the best scenario is that a legal professional draft the licensing agreement from start to finish, another option is that you start on your own and an attorney reviews it and finalizes it. You can find examples of licensing agreements in a local law library or on the internet. For software licensing agreements, one could look at the agreement on software you currently own.

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For additional Information, visit:

http://www.iphandbook.org/index.html–A website containing sample agreements and general discussions/resources about IP

I. EXPORTING & INTERNATIONAL IP RIGHTS PROTECTION

If your company makes or sells products in other countries, it is incumbent upon you to seek intellectual property protection in those countries. Without some form of intellectual property protection, your property may be used without compensation. Furthermore, you may have inferior products produced by these competitors that reduce the value of the products that you sell.

An investigation into the manufacturing capabilities of the business in the country your product is made or sold is one of the first steps that should be made if you are operating globally. This will provide you with the knowledge of where potential competitors may appear.

The cost of securing intellectual property protection varies greatly throughout the world and can be quite costly. However, a balance must be achieved between the cost of securing protection and the possible loss of market opportunities.

It is important that you analyze the cost and benefits of seeking intellectual property protection and adopt the level of protection that fits your individual needs. Failure to analyze the intellectual property landscape in the countries that you are planning on operating may result in your losing the ability to manufacture your product or may increase the number of competitors.

Our international trade agreements and related IP treaties require member countries to provide means for US IP right holders to obtain and enforce IP rights. IP rights are generally territorial, for example, a US Patent provides protection only in US. For protecting the same IP (protected by the US Patent) in Japan, you will have to get a Japanese Patent. For more information about how to apply for

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patents or trademarks in individual foreign countries, you have to contact the intellectual property office in that country directly. Once a company has registered for appropriate IP protection in a country, it can use that country's local laws to enforce its rights. Although most countries do not require registration to enjoy copyright protection, registration can bring certain benefits, such as proof of ownership.

The United States is a member of two treaties: for patents, the Patent Cooperation Treaty (PCT), and, for trademarks, the Madrid Protocol. These treaties make it easier for U.S. citizens and firms to file for patent and trademark protection in other countries. The USPTO processes applications for protection pursuant to these treaties. The Patent Cooperation Treaty streamlines the process by which U.S. inventors and businesses can obtain patent protection in other countries. By filing one international patent application with the USPTO, U.S. applicants can concurrently seek protection in more than 140 countries. For an invention made in the United States, U.S. law prohibits filing abroad without a foreign filing license from the USPTO, unless six months have elapsed since filing a U.S. application.

The Madrid Protocol streamlines the process by which U.S. trademark owners can obtain trademark protection in other countries. By filing one international trademark application with the USPTO, U.S. applicants can concurrently seek protection in any member country. Changes to a registration— for example transfers, name or address changes, and renewals— also can be handled through a single procedural step.

A good first step in seeking international patent protection is filing an application through the patent cooperation treaty (PCT). The PCT application allows you to file one application as a placeholder while you investigate the market and manufacturing potential in each of the countries that you are considering. While you still must complete the file in each of the countries you are interested in, with the additional time that the PCT application affords you, you can reduce your cost to

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only those countries that you really want protection. In addition, for trademarks use of the Madrid Protocol allows you to file one trademark application and receive protection on your mark throughout the world.

The development and maintenance of an intellectual property rights portfolio also should include consideration of trademarks and domain names. A domain name is part of a Uniform Resource Locator ("URL"), which is the address of a site or document on the Internet. In general, a domain name is comprised of a second-level domain, a "dot," and a top-level domain ("TLD"). A trademark, on the other hand, is a word, phrase, symbol or design, or a combination of words, phrases, symbols or designs, that identifies and distinguishes the source of the goods (or services) of one party from those of others. A mark comprised of an Internet domain name can be registered as a trademark or service mark only if it functions as an identifier of the source of goods or services.

Many businesses today register their company name and key brands as domain names in at least the .com domain (and sometimes other generic top-level domains such as .biz and .info). Businesses also may consider the registration of their company names and key brands in the top-level domains for countries in which their products are made or sold (e.g., .cn for China, .eu for European Union). Registration may be sought proactively, to indicate a local in-country presence for marketing products, or defensively, to protect against registration of a domain name by another. Third-party domain name registrations in a country top-level domain also may provide indication of trademark rights that could preclude adoption of a desired mark in that country. The decision to seek Internet domains in every country where the products are made or sold may be prohibitively costly or a U.S.-based business may not be able to meet the local registration requirements. Like other decisions regarding a business' intellectual property rights portfolio, such decisions should be undertaken thoughtfully and prior to commencing manufacturing operations or sales in a country.

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For additional Information, visit:

www.uspto. gov/web/trademarks/madrid/madridindex.htm.– Information on filing an international trademark application under the Madrid Protocol.

www.buyusa.gov–General discussion and FAQs on IP and export

www.wipo.int/news/en/links/addresses/ip/index.htm. –A list of contact information for most intellectual property offices worldwide

www.uspto.gov/go/pct/.–Information on filing an international patent application under the PCT

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J. IP ASSET TRACKING MAINTENANCE

The IP of an enterprise or business may provide crucial resources for new market opportunities, new inventions, new collaborations and source of new revenue. Realizing that a business or enterprise has an Intellectual property(s) is the first step in IP asset management and tracking. In order to track and manage IP, an enterprise has to first determine the types of IP the enterprise:

(1) Owns and uses.
   a. Copyright
   b. Trademark
   c. Trade service
   d. Trade secret
   e. Know how
   f. Patents granted
   g. Patents filed

(2) Licenses out
   a. Copyright
   b. Trademark
   c. Trade service
   d. Trade secret
   e. Know how
   f. Patents granted
   g. Patents filed

(3) Licenses in
   a. Copyright
   b. Trademark
   c. Trade service
   d. Trade secret
   e. Know how
   f. Patents granted
   g. Patents filed

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An IP audit can be used to identify, catalogue, and evaluate the IP assets of an enterprise. Once an IP audit has been completed, the assets can be tracked as the enterprise enters into new business decisions, including acquiring a new business, starting the development of a new product or service, etc. Based on the review of one's IP asset an enterprise can acquire new business based on need and its ability to strengthen the enterprise. Likewise, based on an IP audit, business decisions to funnel resources from one area to other can be made. Knowing your IP assets can also help in identifying potential competitors or infringers in the market.

Costs associated with IP include fees for maintaining IP protection, such as a protecting a Patent, filing of new IP applications, and legal fees. Once a patent is granted by the USPTO, for maintaining a patent in an active status, the patent owner has to pay a maintenance fee during the life of the patent. Such fees may multiply as the same product or service is patented in multiple countries. An enterprise may make a business decision to pay maintenance fees or not depending upon the value of the patent.

When an entity files for an IP protection with the corresponding Federal Office and the Federal Office sends correspondence to the entity for a response from the entity, there may a requirement to respond to the correspondence within a certain time period required by a statute of law. In certain situations, the time period may be extended for a defined time period, while under other situations no extensions may be allowed. Therefore, it is crucial that such correspondence is answered within the allowed time period. Failing to respond in a timely manner may result in abandonment of the IP application such as a patent application or in some other action that may adversely affect the granting of the IP protection. Maintaining a proper docket management system helps in responding to correspondence on time. Failure to respond to deadlines may delay action that may be taken by the administrative agency, or worse, may

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result in the loss of your property rights. It is incumbent upon you to respond within any time period that may be set.

For additional Information, visit:

http://intellectualpropertyexplorer.com/–A free tool for IP asset Identification and IP Audit.

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