

## A PRIMER ON INTELLECTUAL PROPERTY PROTECTION

### COPYRIGHTS

**WHAT IS PROTECTED.** *Expression* embodied in original work of authorship such as writing or art, not ideas. If compilation or derivative, only original portion is protected. “Fair Use” and “Public Domain Material” are not protected. Fair use depends on nature and character of use, nature of the work, amount used in relation to whole work, and effect of use on market and value of the work. Public domain is material after expiration of copyright, plus software created before 1/1/76 and published without copyright notice, and software created by U.S. government employee.

**WHERE TO FILE.** U.S. Copyright Office. Easy to file 2 page form. See [www.copyright.gov](http://www.copyright.gov). Filings are public and not trade secret.

**WHEN EFFECTIVE.** From creation even without copyright notice. Registration effective from creation if filed within 90 days, otherwise effective upon filing.

**DURATION OF PROTECTION.** During life of author plus 70 years. 95 years from publication or 120 years from creation, whichever is shorter, for works for hire.

#### HOW TO PROTECT.

**Provide Copyright Notice.** Notice helps prove infringement. Three essential elements to copyright notice: 1) © or Copyright, 2) Year of First Publication, 3) Name of Owner. Also good to add "All Rights Reserved" for use outside the U.S., especially for South America. E.g. “© 2004, Bradley Smith. All Rights Reserved.” Provide copyright notice at beginning of written work. Mark copyright on software at beginning of each source code module, on initial screen to be run by customer, on label, at beginning of user manuals, and on software packaging.

**Register Copyright.** Greater protection if register copyright with U.S. Copyright Office. Can enforce without registration, but no statutory damages or attorneys fees if not registered. Best to use attorney for compilations, derivations, and software. Must disclose any licensed components in application. Registration within 5 years of first publication helps establish validity

**Protect Works for Hire.** Employer owns copyright on works produced within course and scope of employment. To extend protection, provide for ownership of copyrights in employment contracts to cover all work, whether created during or after work time, during period of employment. On works for hire created by independent contractor, have contractor either assign copyright before work done or sign copyright application.

**LAW GOVERNING.** 17 U.S. Code sections 101 and following.

**INTERNATIONAL CONSIDERATIONS.** Use “All Rights Reserved” for additional protection. General international protection is automatic for signatory countries of the Berne Convention. Recently the World Intellectual Property Organization (WIPO) prepared the WIPO Copyright Treaty (WCT) with more specific protection for software, databases, and other works. See [www.wipo.int](http://www.wipo.int). Also, the Trade-Related Aspects of Intellectual Property Rights Agreement (TRIPS) requires signatories to enforce copyright protection. See [www.wto.org](http://www.wto.org).

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## PATENTS

**WHAT IS PROTECTED.** Inventions and embodiments of *ideas*, including processes, machines, manufactures, and compositions of matter. Must file application within one year after first public distribution or sale or offer for sale.

**WHERE TO FILE.** U.S. Patent and Trademark Office (USPTO). See [www.uspto.gov](http://www.uspto.gov). U.S. filings are secret without limit. Foreign filings are public and lose trade secret status after 18 months.

**WHEN EFFECTIVE.** Upon filing, if approved by USPTO.

**DURATION OF PROTECTION.** Utility patents (process, machine, manufacture, or composition of matter) - 20 years from date of filing of application. Design patents (ornamental design for article of manufacture)- 14 years from date of patent grant.

**HOW TO PROTECT.** Include patent clause in employment agreements. Contest infringement.

**LAW GOVERNING.** 35 U.S. Code section 1 and following.

**INTERNATIONAL CONSIDERATIONS.** International patents can be filed under the authority of the Patent Cooperation Treaty with the World International Property Organization (WIPO). For more information, see [www.wipo.int](http://www.wipo.int). Also, the Trade-Related Aspects of Intellectual Property Rights Agreement (TRIPS) requires signatories to enforce patent protection. See [www.wto.org](http://www.wto.org).

## MASK WORKS

**WHAT IS PROTECTED.** Three-dimensional computer *chip designs*, also called integrated circuit designs.

**WHERE TO FILE.** Applications for mask work registration are filed with the U.S. Copyright Office, but they are not considered copyrights. Portions of the filing may be withheld from deposit to protect trade secrets. See [www.copyright.gov](http://www.copyright.gov).

**WHEN EFFECTIVE.** Upon filing of application for protection with the U.S. Copyright Office, but only if filed within 2 years after date of first commercial exploitation of the mask work.

**DURATION OF PROTECTION.** Until the end of the 10<sup>th</sup> calendar year after the earlier of the date of registration or the date of first commercial exploitation.

**HOW TO PROTECT.** Give notice of mask work rights by using 1) the words “mask work”, the symbol \*M\*, or the symbol M in a circle and 2) the name or abbreviation of the name of the owner of the rights on the mask work or chip. File civil lawsuit to protect mask work registration rights.

**LAW GOVERNING.** Semiconductor Chip Protection Act (SCPA) of 1984, 17 U.S. Code §901 and following.

**INTERNATIONAL CONSIDERATIONS.** World Trade Organization (WTO) members and other countries such as Australia, Canada, Japan, Switzerland and European Community Members are eligible for mask work protection in the United States. Canada, Australia, Hong Kong, and possibly other countries give equivalent protection. Some protection is afforded by the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs Agreement) of the WTO, which requires member countries to protect mask works.

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## TRADEMARKS / SERVICE MARKS / TRADE NAMES / DOMAIN NAMES

**WHAT IS PROTECTED.** Trademark or service mark is recognition of *brand*, product or service *name*. Trademarks can be text, stylized text, design, color, or combination. Includes names, slogans, and logos. Trade or business name can be considered trademark or service mark only if used to identify goods or services. Trade name filing is not trademark protection unless separately protected as trademark. Domain name registration is separate from trademark or service mark. Use of domain name, even if registered, can be found to be trademark infringement.

**WHERE TO FILE.** Federal trademarks and service marks at U.S. Patent and Trademark Office. Can file online with jpeg attachments. See [www.uspto.gov](http://www.uspto.gov). State trademarks and service marks at California Secretary of State. See [www.ss.ca.gov](http://www.ss.ca.gov). Filings are public information and not trade secret. Trade name filing is done at county level through fictitious business name filing, and at state level through corporation, limited liability company or limited partnership filing. Domain names can be registered through the Internet Corporation for Assigned Names and Numbers (ICANN) or a domain name registrar accredited by ICANN.

**WHEN EFFECTIVE.** Trademarks and service marks are effective upon first use and only in areas of use. Registration effective upon filing or actual use in commerce, whichever is first.

**DURATION OF PROTECTION.** Federal marks have 10 year term, renewable indefinitely during use. Must file Affidavit of Use during 6<sup>th</sup> year and 10<sup>th</sup> year of each term. Federal mark incontestable after 5 years of continuous use, and rights continue indefinitely during continuous use. California registers marks for 10 years, renewable during use.

**HOW TO PROTECT.** Perform trademark search - federal, state, and common law. Use <sup>TM</sup> for trademarks or <sup>SM</sup> for service marks before federal registration. Use 7 after federal registration. File for state registration for intra-state use. File for federal registration upon actual use in commerce in two or more states, or upon intent to use, with later filing upon actual use. File separate applications for name, slogan, and logo. Maintain rights by contesting infringement if likelihood of confusion. Domain name registration is not the same as trademark registration. Domain name registration will protect use of the domain name but will not be effective against previously used or registered trademarks. Domain names can be registered as trademarks in the same way as other names, but not necessary if the domain name is the same as an already trademarked name. Domain name disputes can be handled through courts or ICANN resolution procedures (including World Intellectual Property Organization (WIPO) processes).

**LAW GOVERNING.** 15 U.S. Code sections 1051 and following. California Business and Professions Code sections 14200 and following. Common law at state and federal levels.

**INTERNATIONAL CONSIDERATIONS.** Filing with USPTO under Madrid Protocol provides protection in signatory countries. It is in addition to standard federal filing. The USPTO and the World International Property Organization (WIPO) have more information. See [www.uspto.gov](http://www.uspto.gov) and [www.wipo.int](http://www.wipo.int). European Community also has trademark protection. Also, the Trade-Related Aspects of Intellectual Property Rights Agreement (TRIPS) requires signatories to enforce trademark protection. See [www.wto.org](http://www.wto.org).

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## TRADE SECRETS / CONFIDENTIAL INFORMATION

**WHAT IS PROTECTED.** Business *information*, including devices and ideas, that confer competitive advantage. Must have independent economic value, not be generally known in the industry or to the public, and be subject to reasonable efforts to maintain secrecy.

**WHERE TO FILE.** Not applicable.

**WHEN EFFECTIVE.** Upon creation or receipt.

**DURATION OF PROTECTION.** No limit.

**HOW TO PROTECT.** Limit access to information. Mark information "Secret" or "Confidential" or similar. Require confidentiality agreements of agents, employees, independent contractors, and potential investors. Use physical security, including encryption, copy protection, and restriction of physical access. File trade secret information in court only under seal and protective order. Require information surrender at termination of employment or contract.

**LAW GOVERNING.** Uniform Trade Secrets Act (UTSA), CA Civil Code §§3426-3426.11. Common law.

**INTERNATIONAL CONSIDERATIONS.** Principals similar to the UTSA are protected under the North American Free Trade Agreement (NAFTA) and General Agreement on Tariffs and Trade (GATT). GATT established the World Trade Organization (WTO) which is establishing a dispute settlement body to decide trade secret disputes, and GATT promulgated the Trade-Related Aspects of Intellectual Property Rights Agreement (TRIPS), which includes protection against disclosure of "undisclosed information." Signatory countries to TRIPS must provide a mechanism for protecting undisclosed information. See [www.wto.org](http://www.wto.org).

## LICENSES

**WHAT IS PROTECTED.** *Right to use* property and other rights, such as intellectual property, including patents, trademarks, trade names, mask works, software, copyrights, and trade secrets, as well as other rights such as personal physical attributes and rights to publicity.

**WHERE TO FILE.** Not applicable

**WHEN EFFECTIVE.** When right to use property or right is granted by licensor to licensee.

**DURATION OF PROTECTION.** Determined by agreement.

**HOW TO PROTECT.** Require users of property and rights to enter into agreement specifying their rights to use the property or rights, compensation for use, duration of rights, and other terms and conditions.

**LAW GOVERNING.** Federal and state common law. Laws specific to particular intellectual property.

**INTERNATIONAL CONSIDERATIONS.** See international considerations for particular intellectual property.

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