



**PATENTS™ TRADEMARKS® COPYRIGHTS® LICENSING ♦ LITIGATION ♦ TRADE SECRETS**  
209 kalamath street, unit 9, denver, colorado 80223-1348 usa  
main phone 303-271-9468  
website [www.jacksonesquire.com](http://www.jacksonesquire.com)  
roger a. jackson  
registered patent attorney  
email [roger@jacksonesquire.com](mailto:roger@jacksonesquire.com)

## PATENTS

Contract between inventor and the public, where the inventor discloses the invention to the public domain in return for a limited monopoly

### Patent Rights

To exclude others from making, using, selling, import, or offer to sell the claimed invention for 20 years from the file date

Inventor is not required to make, use, or sell the invention

Patent rights are on a per country basis

### Patent Types

#### Utility

- Most common-strongest legally, for process, product, machine, or composition of matter

#### Provisional

- 12 months of pendency only

#### Design

- Ornamental and non-functional

#### Plant

- Non-natural, asexual reproduction (cannot occur in nature)

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## Patent Legal Requirements

Statutory subject matter

Novelty

Utility

Non-obviousness

## Patent Components

Field and background

Objectives

Summary

Drawings

Description

Claims

Abstract

## Patent Process

Strictly confidential

•Until 18 month publication or issue

File application

1<sup>st</sup> office action in 23 months

Amendment in 3-6 months

2<sup>nd</sup> or final office action in 4 months

Amendment in 3-6 months

Issue (34 month avg) or appeal (Can accelerate to 12 months for \$2,400-8,000)

20 year life

## Patent Cost Estimates (non-complex invention)

Search and opinion \$1,250

Patent drafting by attorney \$5,000

Drawings \$700

Filing fee \$530

Prosecution \$3,000

Publication fee \$300

Issue fee \$870

Maintenance fees \$4,355

Total \$16,005

## Why Patent?

To protect your much larger investment in commercialization  
From theft or your infringement  
Reduce “knock-offs”  
Allows unlimited income potential  
Build equity  
Distinguish in market  
Legitimize in market

## **TRADEMARKS**

What can be a trademark, the range for what can be a trademark is fairly broad;

Letter Initials (at least two, also can be an acronym, and the like)  
Word (singular)  
Slogan (usually 2-4 words, any more words that 4 is cumbersome) Graphic Logo (signs, symbols, designs, fancy fonts, multicolored or black and white)  
Smells  
Sounds  
Colors only  
Singular or any combination of the above

A good trademark is novel, distinctive, short, catchy, and easy to say, spell, and remember

Trademarks 3rd cousin "Trade Dress" Ferrari and Interior Design

### Trademark Clearance Search

Country-wide-in use in commerce registered or not for similar *sounding*, similar *spelling*, similar *appearing*, and similar *meaning* trademarks-professional search and opinion \$1,250.

### Basic Trademark Law

Trademark similarity and the associated goods and services similarity typically have an inverse relationship. This means that two very like or even exact marks could co-exist on their having highly legally dissimilar goods and / or services associated with them, such that the consumer would not see the highly dissimilar goods for instance within close proximity at the retail level. Converse to this if the associated goods and / or services are similar, then their associated marks must be more legally dissimilar to prevent consumer confusion. An exception to this would be

if the mark is “famous” being known nationally or across multiple types of goods and / or services which allows the mark’s owner to preclude others from using a confusingly similar mark on any good or service.

### Trademark Registration

Federal registration-goods / services description is key (in use or not) \$1,250  
Only 3-4 months until you know if approved (cannot be generic or descriptive)  
Life is forever-just stay in commerce-but subject to opposition  
Renewals-5 years \$600 plus every 10 years after that \$800  
Notice below;

[*your trademark*]<sup>TM</sup>  
brand [*generic description of your good or service*]

® in place as a notice to the public after federal registration and <sup>TM</sup> prior to federal registration,

## **COPYRIGHT**

The creation of a work in a fixed tangible medium that encompasses literary, dramatic, musical, artistic, motion pictures, screen plays, computer programs, novels, sculptures, songs, sculptures, songs, fabric designs, photographs, paintings, sculptures, dolls, jewelry, sound recordings, brochures, leaflets, and generally most items that are not solely functional or utilitarian in nature. A copyright can also be a compilation of items in the public domain, or of copyrighted items (with permission from the owner) or a combination of public domain items and copyrighted items in the compilation.

### What is not a copyright?

Copyright protection does not cover any underlying ideas or facts, only the expression in a fixed tangible form. Also if the creative work is very short i.e.; initials, a word, a slogan, or a phrase, the creative content is too minimal to be copyrightable. Also, methods, systems, principals, layouts, coloring, and lettering are not copyrightable. Also, copyright is not available for ideas or procedures for doing, making, or building things, nor scientific or technical methods, or discoveries, business operations, or procedures, mathematical or other formulas, some of which may qualify for patent protection that have a definite functional end result. However, a series of phrases for instance may qualify under copyright law to be a “compilation” as defined above, in addition, initials, words, phrases, or slogans may qualify for trademark protection.

### What makes a strong copyright?

Copyright protection is strongest where the creative content is distinctive and unique and more

fiction based versus fact based creations, which have a lower level of protection. For instance, a drawing that is more abstract or cartoonish, (more creative content), i.e. not closely representing what exists in nature, or a photo that has unique settings, lighting, backgrounds, poses, and the like (again more creative content) is stronger than a plain photo of something that exists in nature. Another example is a book that is pure fiction (high creative content) has a stronger copyright than a book that is mostly factual based.

### Copyright Infringement Defined

As a copyright owner you have the rights to copy, reproduce, publish, publicly perform, record, display, and make new versions of your original work.

A copyright work is original if it is not copied from another, if two individuals completely separately and independently created the same copyrightable work, they would both have a valid copyright in theory, of course for two people to create an identical work independently is unlikely. The key issue in proving copyright infringement is that the infringing party had access to the original copyrighted work. Compare this to the broader scope of patent protection wherein if an infringer makes the same product that is patented, they are infringing even if they completely created the product independently without any knowledge of the patented product.

Plagiarist-one who copies works that are in the public domain, (with the copyright currently expired) under their own name and publishes as such. A plagiarist is not normally liable for copyright infringement unless a separate contractual issue precludes it, say for a journalist or author.

Infringement-one who publishes another's copyrighted work under the copyright owners name without permission when the copyright is unexpired.

The life of a copyright depends upon who is the creator of the work.

For individual or joint authors, the copyright exists from the time of the works creation to 70 years beyond the last surviving authors life.

Works made for hire, sometimes called corporate authorship, the copyright exists from either 95 years from publication or 120 years from creation, whichever is shorter.

### Defenses to Copyright Infringement

Fair Use, This is use of the copyrighted material for educational, scholarly, research, news reporting, criticism, commentary, or non-profit purposes, which is allowable. Note that the fair use must be for the advancement of learning and not to commercially exploit the copyright owner. Thus, it would not be a fair use to make unlimited copies of school textbooks claiming use for the advancement of learning, which would be an exploitation of the textbook publisher and author.

Merger, This is where a semi factual copyrighted work must be used in a new work for a new

expression. In other words there is no other way to get a point across other than to use another's copyrighted material, however this would only apply to a fact based copyright, hence the weaker protection. In the case of highly fictional works, there is always another way to state an expression, and thus the Merger doctrine would not apply.

Independent Creation, This is to prove that there was no access to the copyrighted work and that the similarities are purely coincidental.

Parody and Satire, The copied work would normally be the subject of the satire, using no more of the original that necessary to accomplish the parody.

Copyright Invalidity, Although this has much less scope than patent validity for instance, copyright invalidity includes filing for registration for a non-original creation or lack of candor in front of the Copyright Office.

Misuse of the copyright, Akin to patent and trademark, this would be misuse of the copyright for antitrust issues, such as over reaching license agreements, etc.

Statute of Limitations, The time for bringing a copyright action is normally 3 years from when the plaintiff has knowledge of the infringement.

Laches, estoppel, and acquiescence, This would stem from excessive delay in bringing an action, or giving an implication that permission was somehow given, and a history of non-enforcement of copyright rights.

Federal copyright registration is mandatory prior to initiating an infringement action. If you wait to register when an infringement action is imminent, it will cost you more to register on an expedited basis. \$500

Federal copyright registration at the time of creation, prior to publication, gives another important bonus in an infringement action, as additional recovery damages are allowed being statutory damages and possibly attorney's fees and court costs if you win. Compare this to a late federal registration of copyright (when an infringement action is imminent) where you are only entitled to actual damages, which can be difficult to prove that you suffered from the infringer. The actual damages may be substantially less than the statutory damages, attorney's fees and court costs that you may be entitled to if you are successful in the infringement action for early federal copyright registration. The result of all this is that it may be uneconomical to bring an infringement action if you had a late federal copyright registration, thus allowing the infringer to essentially steal your copyright with no consequences and could result in you losing derivative rights in that copyright.

## **TRADE SECRET**

Covers everything-no limits (tech-financial-competitive-business-process)  
(before you patent an idea and before public disclosure-you have a trade secret-conceptually)  
No formal registration requirements-basically it's your control of information

### Two requirements-

1. Secrecy
2. Value

### Positives of trade secret-

1. Never expires
2. Best for "hidden" process in a commercial product-i.e. computer chip manufacture
3. Can be licensed / sold
4. Compilation of public items in new use can be trade secret
5. Different use for a public item can be trade secret
6. Two people can hold the same trade secret (no communication between them)

### Negatives of trade secret-

1. Reverse engineering is legal-thus a good trade secret is difficult to reverse engineer
2. Misappropriation (theft) is difficult to prove
3. Very fragile intellectual property asset
4. Difficult to maintain secrecy
5. Patent kills trade secret

## **CONFIDENTIALITY AGREEMENTS**

A contract basically to protect your trade secret-proof of the "Secrecy Requirement"

A good confidentiality agreement includes;

1. Custom detailed agreement between the parties (note boiler plate out of a book is bad)
2. Consideration required-bargained for exchange of value
3. Parties legal relationship defined
4. Inventory and tracking of all information exchanged
5. Trade secret ownership definition-for suggestions and created content
6. Warranties of disclosure and creation
7. Documentation of created content
8. No term limits
9. No reverse engineering
10. No solicitation
11. Fiduciary obligations
12. Authorized parties and respective authority
13. No assignment
14. Notarized