

How to Protect Your Intellectual Property

Vlad Shvartsman, Esq., LL.M.
Member of the New York Bar

Trademarks

What is a Trademark?

A Trademark names a product or service.

Escalator

Linoleum

Zipper

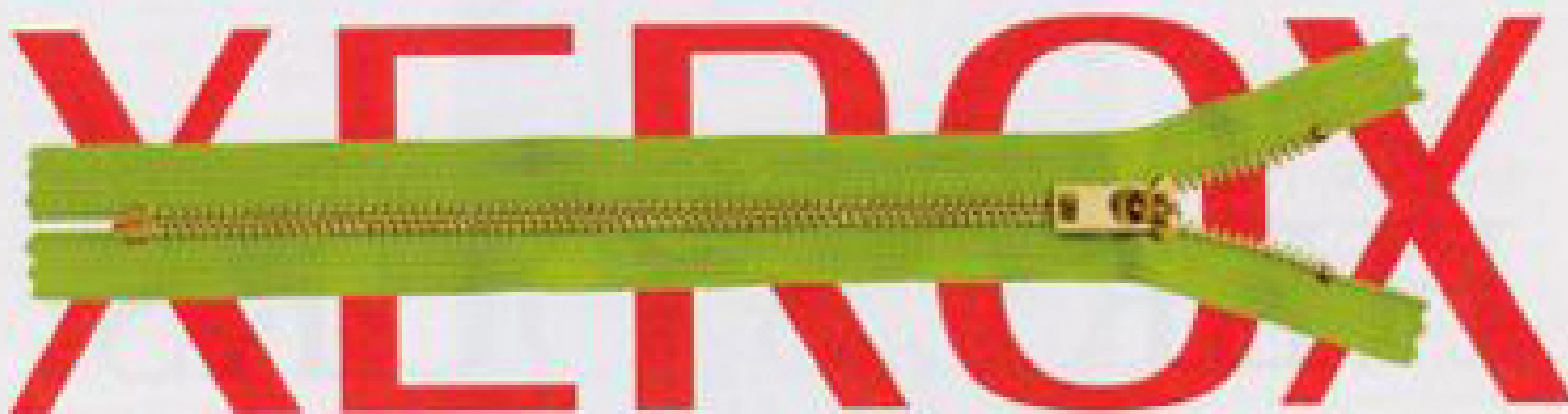
Kleenex

Xerox

Yo-yo

Kerosene

Plexiglass



If you use "Xerox" the way you use "zipper," our trademark could be left wide open. **There's a new way to look at it.**

No one likes to lose their name open to misuse. Which is what happens when you use our name in a generic manner. Basically you're putting it in a compromising position which could cause it to lose its trademark status. That's what happened to the name "zipper" years ago. So when

you use our name, please use it as an adjective to identify our products and services, such as "Xerox copiers." Never as a verb: "to Xerox" in place of "to copy," or as a noun: "Xeroxes" in place of "copies." Now that you're aware of all this, that should just about zip things up. Thanks.

XEROX

xerox.com/learn 1-800-438-XXXX or xerox.com/learn

Technology

Document Management

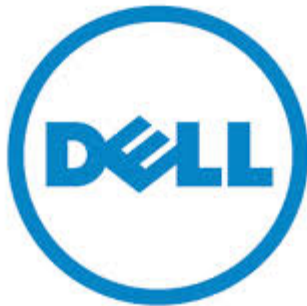
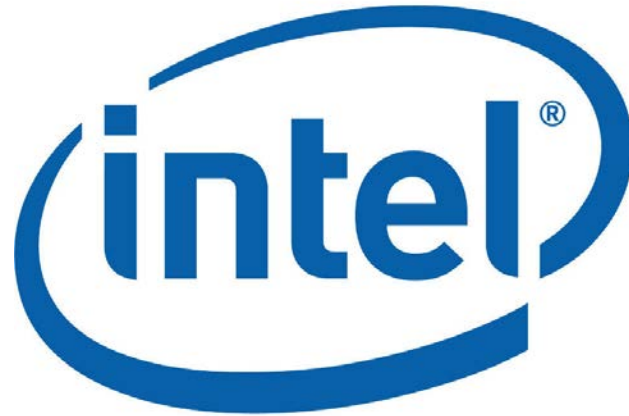
Consulting Services

© 2008 XEROX CORPORATION. All rights reserved. XEROX and There's a new way to look at it are trademarks of XEROX CORPORATION in the United States and/or other countries.

A TM prevents confusion
in the marketplace.



A TM answers the customer's question
“Who stands behind the product or service?”



A TM communicates
expectant quality



A TM plays an important part in **Branding**



The McDonald's roof design is an example of "Trade Dress".

A TM creates emotional ties to
company image



JUSTIN BIEBER

Word Mark JUSTIN BIEBER

Goods and Services IC 003. US 001 004 008 050 051 052. G & S: FRAGRANCES, SOAPS, ESSENTIAL OILS, COSMETICS, BODY AND HAIR LOTIONS AND OILS, BATH GEL, NON-MEDICATED HAIR, SKIN AND NAIL PREPARATIONS, SHAMPOOS. FIRST USE: 20111231. FIRST USE IN COMMERCE: 20111231

IC 009. US 021 023 026 036 038. G & S: DOWNLOADABLE RING TONES FEATURING MUSIC AND VOICE MESSAGES; PRERECORDED DISCS, TAPES AND DOWNLOADS FEATURING MUSICAL, DRAMATIC AND THEATRICAL PERFORMANCES; COMPUTER CARRYING CASES, CARRYING CASES FOR PORTABLE ELECTRONIC DEVICES AND MOBILE TELEPHONES; MICROPHONES. FIRST USE: 20091130. FIRST USE IN COMMERCE: 20091130

IC 014. US 002 027 028 050. G & S: JEWELRY, KEY CHAINS AS JEWELRY TRINKETS AND FOBS, WATCHES, CLOCKS. FIRST USE: 20111231. FIRST USE IN COMMERCE: 20111231

IC 015. US 002 021 036. G & S: MUSICAL INSTRUMENTS AND CASES THEREFOR. FIRST USE: 20111231. FIRST USE IN COMMERCE: 20111231

IC 016. US 002 005 022 023 029 037 038 050. G & S: PAPER PRODUCTS, NAMELY, STATIONERY, NOTEBOOKS, NOTEBOOK COVERS, POSTERS, NOTECARDS, GREETING CARDS, POSTCARDS, ORNAMENTAL ADHESIVE DECALS OF PAPER; PENS AND PENCILS; RUBBER STAMPS; INTERIOR AND EXTERIOR DECORATIVE STICKERS; BOOKS, MAGAZINES, COMIC BOOKS, GRAPHIC NOVELS, PRINTED PERIODICALS, COMIC STRIPS, NEWSPAPERS AND NEWSLETTERS, ALL IN THE FIELD OF MUSIC, FILM AND POPULAR CULTURE. FIRST USE: 20111231. FIRST USE IN COMMERCE: 20111231

IC 018. US 001 002 003 022 041. G & S: LEATHER AND IMITATION LEATHER GOODS, NAMELY, WALLETS, SHOULDER BAGS; BAGS AND BAGGAGE, NAMELY, LUGGAGE, BACKPACKS, PURSES, WALLETS, SHOULDER BAGS, KNAPSACKS, AND HANDBAGS. FIRST USE: 20111231. FIRST USE IN COMMERCE: 20111231

IC 021. US 002 013 023 029 030 033 040 050. G & S: BEVERAGE GLASSWARE; DISHES, NAMELY, PLATES, CUPS, MUGS, SHOT GLASSES; INSULATED CONTAINERS FOR BEVERAGES FOR DOMESTIC USE, NAMELY, BOTTLES AND CONTAINERS OF GLASS, PLASTIC AND METAL; KITCHENWARES, NAMELY, LUNCH BOXES. FIRST USE: 20111231. FIRST USE IN COMMERCE: 20111231

IC 024. US 042 050. G & S: LINENS, NAMELY, BED LINENS; BEDDING, NAMELY, SHEETS AND COMFORTERS. FIRST USE: 20111231. FIRST USE IN COMMERCE: 20111231

IC 025. US 022 039. G & S: CLOTHING AND WEARING APPAREL, NAMELY, SHIRTS, SHORTS, JEANS, JACKETS, SKIRTS, SLACKS, BLOUSES, DRESSES, VESTS, COATS, SWEATERS, SCARVES, SWIMSUITS, UNDERWEAR, UNDERPANTS, SLIPS, CAMISOLES, BRAS, NIGHTGOWNS, ROBES, SOCKS, HOSIERY, T-SHIRTS, LONG SLEEVED SHIRTS, PANTS, JUMPERS, JUMPSUITS, OVERALLS, ONE-PIECE PLEASURES, PAJAMAS, SOCKS; MEN'S, WOMEN'S, CHILDREN'S AND INFANT'S FOOTWEAR AND HEADWEAR; BELTS; FOOTWEAR; HEADWEAR. FIRST USE: 20101231. FIRST USE IN COMMERCE: 20101231

IC 026. US 037 039 040 042 050. G & S: ORNAMENTAL NOVELTY BUTTONS AND PINS. FIRST USE: 20111231. FIRST USE IN COMMERCE: 20111231

IC 028. US 022 023 038 050. G & S: TOYS AND GAMES, NAMELY, ACTION FIGURES, STUFFED TOY ANIMALS, DOLLS, DOLL ACCESSORIES AND PLAYSETS THEREFOR, NAMELY, DOLL CLOTHING; DOLL COSTUMES; STUFFED PLUSH TOYS; BOARD GAMES AND GAME EQUIPMENT SOLD AS A UNIT FOR PLAYING BOARD GAMES; JIGSAW PUZZLES; TOY MODEL VEHICLES AND RELATED ACCESSORIES SOLD AS A UNIT; ELECTRONIC BATTERY OPERATED ACTION TOYS; PARTY FAVORS IN THE NATURE OF SMALL TOYS; PLUSH TOYS; SOFT SCULPTURE PLUSH TOYS; TOY RECORD PLAYER FOR PLAYING TUNES AND CASSETTES AND DISCS THEREFOR SOLD AS A UNIT THEREWITH; MUSICAL TOYS AND TOY MUSICAL INSTRUMENTS; KITES; PAPER FACE MASKS; FLYING DISCS; ELECTRONIC HAND HELD GAME UNITS OTHER THAN THOSE ADAPTED FOR USE WITH AN EXTERNAL DISPLAY SCREEN OR MONITOR; ELECTRONIC GAME EQUIPMENT WITH A WATCH FUNCTION; STAND-ALONE VIDEO GAME MACHINES, COIN-OPERATED VIDEO GAMES; CHILDREN'S PLAY COSMETICS; EQUIPMENT SOLD AS A UNIT FOR PLAYING CARD GAMES. FIRST USE: 20111231. FIRST USE IN COMMERCE: 20111231

IC 041. US 100 101 107. G & S: ENTERTAINMENT SERVICES, NAMELY, OPERATING A WEB SITE FOR OTHERS FEATURING INFORMATION ABOUT MUSIC, CELEBRITY, FILM, TELEVISION, ANIMATION, COMICS AND CARTOONS, AND POPULAR CULTURE; OPERATING A WEB SITE FOR OTHERS FEATURING GRAPHIC NOVELS, ANIMATED AND LIVE-ACTION PROGRAM CONTENT; PRODUCTION OF TELEVISION PROGRAMS AND MOTION PICTURES; ENTERTAINMENT SERVICES, NAMELY, ARRANGING AND CONDUCTING LIVE PERFORMANCES FEATURING MUSIC; THEATRICAL AND MULTIMEDIA ENTERTAINMENT EVENT PRODUCTION SERVICES; MUSIC AND VIDEO PRODUCTION SERVICES; APPEARANCES BY A CELEBRITY; CONDUCTING EXHIBITIONS FEATURING LIVE PERFORMANCES BY MUSICAL, THEATRICAL, COMEDIC, AND DRAMATIC PERFORMERS; FAN CLUB SERVICES; OPERATING WEB SITES IN THE FIELD OF INFORMATION ABOUT MUSIC, CELEBRITY, AND ENTERTAINMENT; DISTRIBUTION OF AUDIOVISUAL MEDIA, NAMELY, MUSIC AND TELEVISION PROGRAMS; ENTERTAINMENT SERVICES, NAMELY, ARRANGING AND CONDUCTING LIVE CONCERTS, THEATRICAL EXHIBITIONS, AND PRODUCING MUSIC, THEATRICAL PRODUCTIONS, TELEVISION PROGRAMS, MOTION PICTURE FILMS, AND INTERACTIVE MULTIMEDIA ENTERTAINMENT, ALL FEATURING MUSICAL, DRAMATIC, AND THEATRICAL PERFORMANCES; VIDEO GAME SOFTWARE PRODUCTION SERVICES; ENTERTAINMENT SERVICES, NAMELY, MUSIC, TELEVISION PROGRAM AND MOTION PICTURE FILM PRODUCTION SERVICES, INTERACTIVE MULTIMEDIA PRODUCTION SERVICES; INTERNET-BASED TELEVISION AND ENTERTAINMENT PROGRAMMING, NAMELY, MUSIC- AND TALK-RADIO SHOWS, AND THE PRODUCTION AND DISTRIBUTION THEREOF; INFORMATION SERVICES IN THE FIELD OF ENTERTAINMENT PROVIDED OVER THE INTERNET; PROVIDING WEB SITES THAT FEATURE ENTERTAINMENT IN THE FORM OF MUSIC, FILMS, TELEVISION PROGRAMS, CELEBRITY AND ENTERTAINMENT NEWS, PERIODICALS, CARTOONS, COMIC STRIPS, ANIMATED AND LIVE-ACTION MOTION PICTURES AND SERIAL AUDIOVISUAL WORKS; SOUND RECORDING STUDIO SERVICES; SONGWRITING AND MUSIC COMPOSITION SERVICES FOR OTHERS; PRODUCTION OF MUSIC, SOUND RECORDINGS, RADIO AND TELEVISION PROGRAMS. ORGANIZING EXHIBITIONS FOR MUSICAL, DRAMATIC, ARTS AND CULTURAL ENTERTAINMENT PURPOSES; PROVIDING ON-LINE INFORMATION RELATING TO THE AFOREMENTIONED ENTERTAINMENT SERVICES; NON-DOWNLOADABLE ELECTRONIC PUBLICATIONS, NAMELY, BLOGS AND ONLINE MAGAZINES FEATURING INFORMATION ABOUT MUSIC, FILM,

A TM is an intangible asset with
attributable value

\$109,000,000,000 US



Trademarks are intrinsically tied to marketing campaigns

TAKE HP BACK TO SCHOOL AND SAVE
Great savings all week on select HP products

hp days THIS WEEK ONLY AUGUST 10 - 16

BEST BUY

Next Gen AMD A6 APU
• AMD Radeon HD 7520G Discrete Class Graphics
64-GB eMMC, Spill-Proof Black Web Code: 10208052

15.6" 6GB 750GB

SAVE \$140
429⁹⁹
AFTER SAVINGS

Ultrathin Laptop featuring Next Gen AMD A6 APU
DHPF 6-104RCA, Midnight Black Web Code: 10208053

15.6" 6GB 500GB 0.78"

SAVE \$70
599⁹⁹
AFTER SAVINGS

2nd Generation Intel® Core™ i3-2120 Processor and 21.5" LED Monitor
• HDMI Output
P7-12403 Web Code: 10208050 2211x Web Code: 10161415

21.5" 4GB 1TB

SAVE \$89
619⁹⁹
AFTER SAVINGS

HP All-in-One Inkjet Printer
• 40-sheet input paper tray
• Prints colour up to 4800 x 1200 resolution
3050A Black Web Code: 10172104

4GB 5.5" 4000

HOT PRICE
39⁹⁹

AVAILABLE AUG. 14 BUY BOTH FOR \$99⁹⁹

59⁹⁹ EA.

WHEN THE TECHNOLOGY'S RIGHT, ANYTHING CAN HAPPEN

FREE SHIPPING* on orders over \$20 only at **BestBuy.ca**

Prices and payments are subject to applicable taxes before programming credits. Prices and offers good August 10 through August 16, 2012. References to savings on sale prices are comparisons to Best Buy Canada regular prices. New release dates are subject to change without notice. © 2012 Best Buy. *Free shipping promotion applies only to ground shipping and to orders over \$20 (excludes TVs 40" and larger and special delivery products). Ground shipping discount is calculated off the total order value excluding taxes. Total order value is after discounts and coupons. Gift cards do not apply to total order value.

Trademarks are part of your company's 'storefront'



Apple brand is worth \$185,000,000,000

VladCola™



“Common Law” Trademark

- Denoted with TM
- Rights are born upon use, not registration
- Enforceable through litigation in Federal and State courts
- Tip: Meticulously retain earliest use history to increase chances of litigation success
- Pros: it's automatic
- Cons: litigation can be expensive

“Registered” Trademark

- Denoted with ®
- Register with USPTO for protection in US
- Register with TM Offices in other countries for enforceability in those countries
- “Intent to use” TM filing status – insurance policy to preempt others from using your TM before your public disclosure
- “In use” TM filing status - when the TM is already in use at time of filing

Why Invest in a Registered TM?

- Registration gives constructive notice to competition that you were first to use the TM, thus simplifying enforcement
- Quantifiable asset for the balance sheet
- Establishes a lawful fence around your property, treble damages for infringement
- Stakes a claim in your right to use your TM
- Denotes serious nature of your enterprise
- Bump 'junior users' off the playing field

A Brief History of TMs

- Roman Empire: blacksmiths stamped their unique symbol on their swords to avoid having their reputations tarnished by low-quality counterfeits.
- First Registered TM? Bass Ale in UK. When? 1876.
- IP is a very young law with limited precedents



TMs are Perpetual

- Utility Patents expire 20 years after filing
- Design Patents expire 14 years after filing
- Trademarks never expire as long as they're used in commerce.
- Oldest US ® still in use: No. 0011210
Samson Rope (Registered May 1884)



TM Evolution

- Just like API levels, Trademark concepts have evolved
- Colors, sounds, and smells can be TMs (think how a Subway smells)
- US TM No. 1395550: MGM's lion roar
- Thrifty Car Rental: trademarked blue color

Think Like a Lawyer

An exercise:



Think like a Property Owner

- What is the first contact your customers have with your company?
- How would you react if a competitor offered a similar, cheaper, App?
- Would your reaction be the same if this cheaper App had a very similar App Icon?
- What if the competitor's App with a similar Icon was inferior to your App?
- “Perfect paranoia is perfect awareness.”

Branding, Branding, Branding

- Your Brand is **property** of your company
- \$1 invested in marketing = \$1 invested in the Brand, reflected on the balance sheet
- Your App Icon is an integral part of your company's Brand, or "Trade Dress"
- Trade Dress is considered "Intellectual Property" by the *Lanham Act* (§43(a))
- "If I sold the company today, what *exactly* am I selling?"

How do your clients tell your app apart from others?



1.5 Million Android apps (June 15, 2015)

Are App Icons Trademarks?

- According to Apple, Yes:
- First TM: Reg. No. 3628321
- Filed March 25, 2008
- Priority of March 7, 2008 (iPhone released June 29, 2007)
- Registered May 26, 2009



- iOS 7 App Icon:
- Filed October 2, 2013



Apple: Early Adopter



3889642



3886196



3886225



3886165



3886200



3889686



3886169



3889685



3886189



3886197



3886167

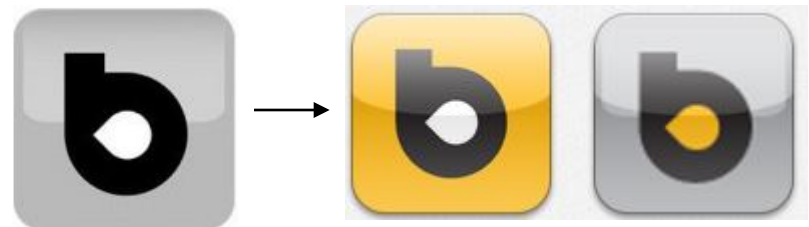
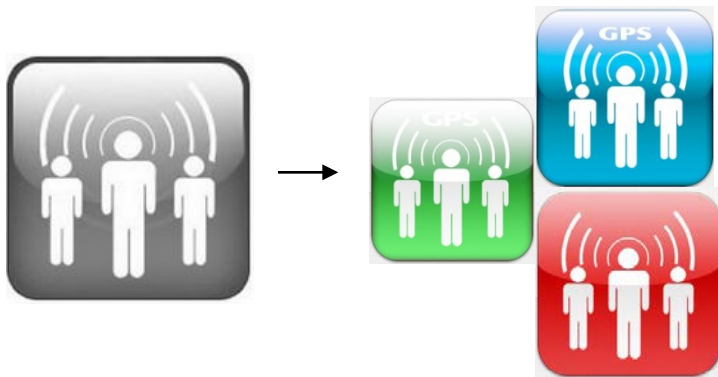
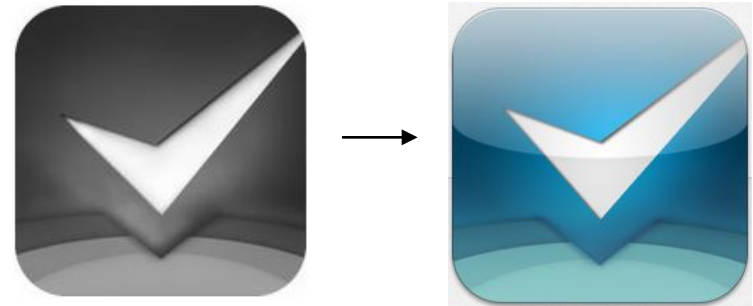
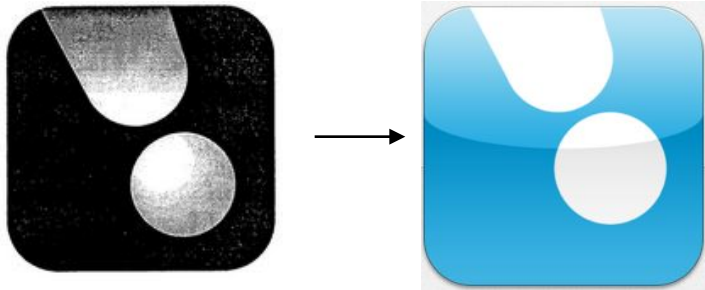


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Out of the Gates

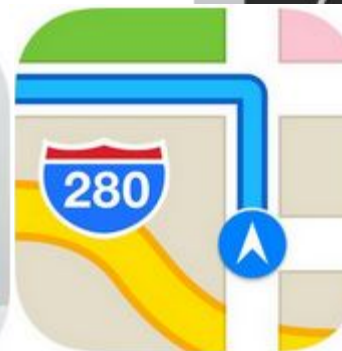


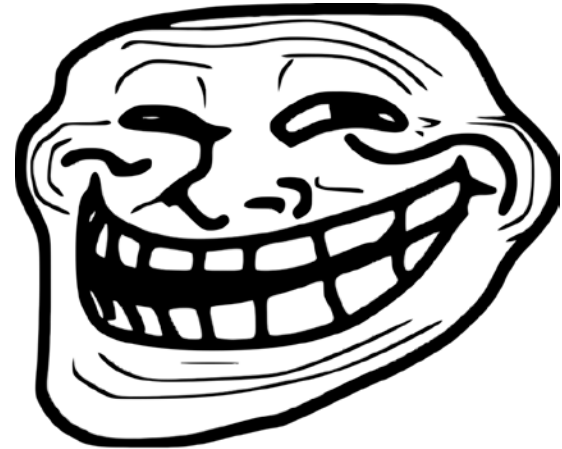
Black and White versus Color





Apple's iOS 7





PROBLEM?

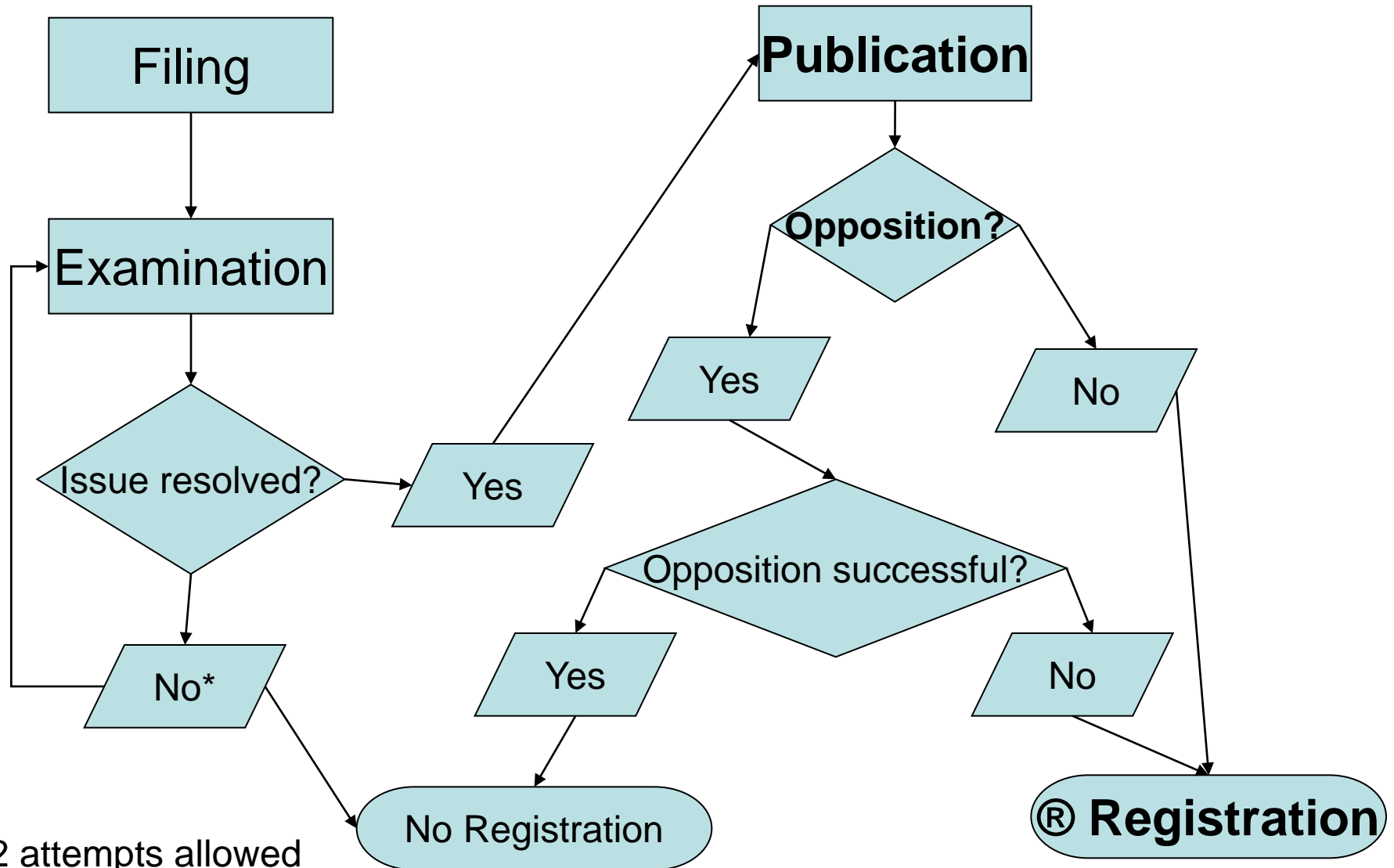




How Close is “Too Close”?



US TM Registration Procedure



Opposition

- US TM application 85041463
- Filed May 21, 2010
- Opposed by Samsung on May 19, 2011



- Samsung accused Apple that the mark is “...a pictorial representation of music notes in general[,] [...] a common design in use by many other manufacturers and sellers of computer software, including [Samsung]. Applicant’s Mark is merely descriptive of music related services generally[,] [...] cannot function as a trademark because it is a functional configuration incapable of trademark significance. [Samsung] will be damaged by registration of Applicant’s mark because it would purport to provide Applicant with the **exclusive** right to use Applicant’s Mark...”
- Currently, Samsung counsel requesting that the case remain suspended pending a civil action (last update July 9, 2015).

App Store > Music > Alfadevs



\$3.49 Buy

This app is designed for both
iPhone and iPad

★★★★☆ (9)

Rating: 4+

© Alfadevs

Musify Pro - Free Music Streamer and Mp3 Player! 4+

Alfadevs >

Details Ratings and Reviews Related

Screenshots

iPhone

iPad



Flexing your Trademark

- <https://play.google.com/about/developer-content-policy.html>
 - **Intellectual Property:** Don't infringe on the intellectual property rights of others, (including patent, trademark, trade secret, copyright, and other proprietary rights), or encourage or induce infringement of intellectual property rights.
- <https://goo.gl/BvJYQE> - infringement report form

Trademark Glossary

- Allowance: granted if the TM goes through 30 days of publication without opposition
- Application: how IP is called during its prosecution, given a Serial Number
- Assignment: how IP changes owners
- Descriptiveness: a TM cannot be registered if it describes what the product does
- Examiner: a government employee tasked with making sure that your IP is allowed to be registered without stepping on the toes of other IP. In the TM world, they are attorneys; in the patent world, they are engineers
- Filing basis: intent-to-use or in-use
- Intent-to-use: filing basis for TM applications when the TM is not being used in commerce yet (in USA, known as “1B”)
- International classification (IC): how TM Offices organize registered TMs
- In-use: filing basis for TM applications when the TM is already being used in commerce (in USA, known as “1A”)
- Likelihood of confusion: objection that can be raised by the Examiner if prior art is too close to application
- Opposition: launched within the 30-day publication period by a third party that believes that the TM should not be registered
- Prior art: IP that is already registered
- Prosecution: back-and-forth communication with the Patent and Trademark Office to hammer out protection scope and details
- Publication: 30-day period when the TM application is advertised in the TM Gazette
- Specimen: necessary to produce in intent-to-use applications as proof that the TM is indeed in use

Patents

Yes, it is possible to protect some Apps with a patent.

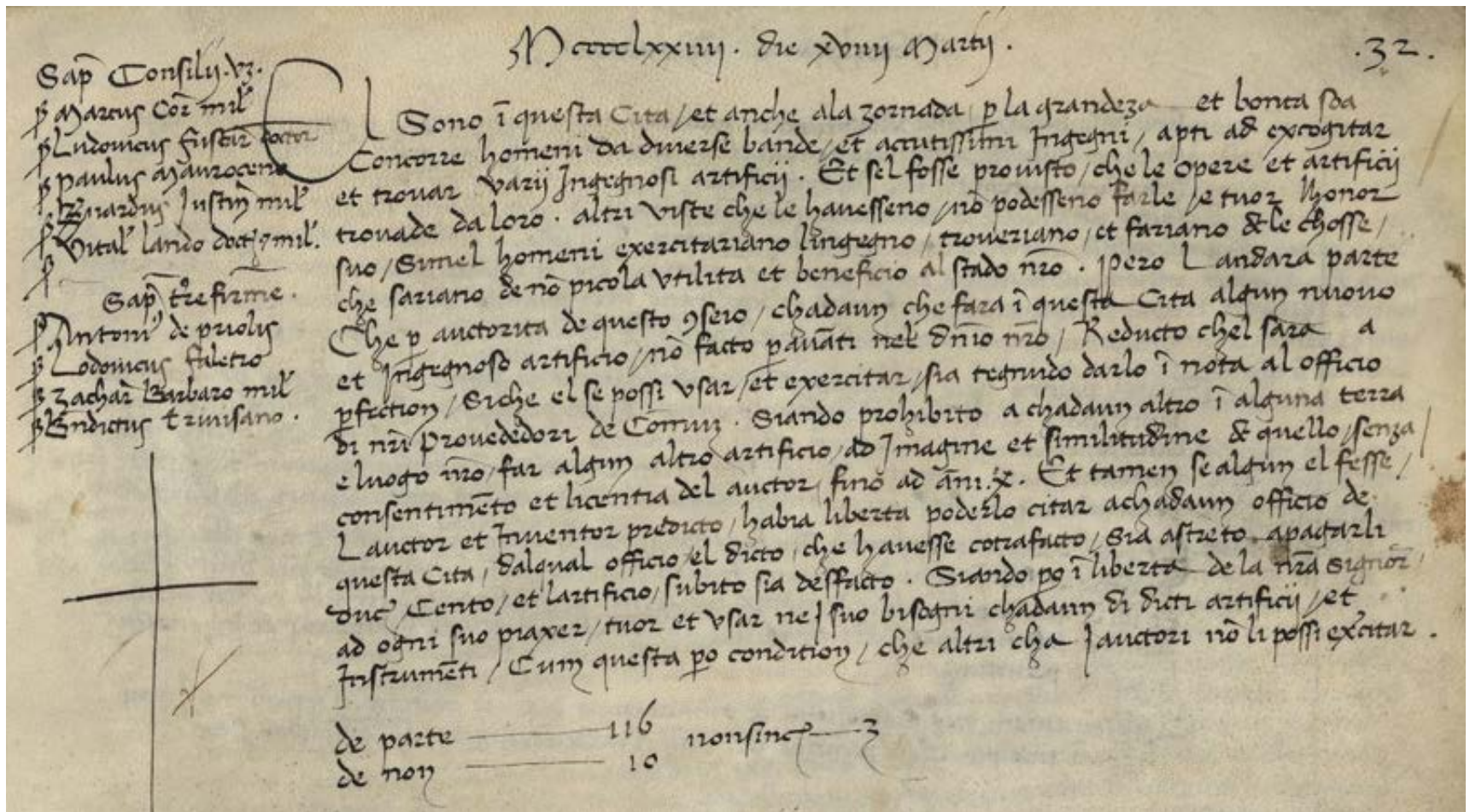
It can be a costly investment, and sometimes worth it.

Unless noted otherwise, all references in this presentation are made to the US patent system.

Patent History

- First patents were issued in Venice in 1450, mainly for glass-making techniques.
- First US patent was issued in 1790 for a method to produce potash
- Countries using Common Law system use the English model of Intellectual Property law.
- UK patent agent exam is hardest in the world.

Venetian Patent (circa 1450)



First US patent (1790)



The United States.

To all to whom these Presents shall come. Greeting.

Whereas Samuel Hopkins of the City of Philadelphia and State of Pennsylvania hath discovered an Improvement, not known or used before such Discovery, in the making of Pot ash and Pearl ash by a new Apparatus and Process, that is to say, in the making of Pearl ash 1st by burning the raw Ashes in a Furnace, 2^d by dissolving and boiling them when so burnt in Water, 3^d by drawing off and settling the ley, and 4th by boiling the ley into balls which then are the true Pearl ash; and also in the making of Pot ash by fluxing the Pearl ash so made as aforesaid; which Operation of burning the raw Ashes in a Furnace, preparatory to their Dissolution and boiling in Water, is new, leaves little Residuum; and produces a much greater Quantity of Salt: These are therefore in pursuance of the Act, entitled "An Act to promote the Progress of useful Arts", to grant to the said Samuel Hopkins, his Heirs, Administrators and Assigns, for the Term of fourteen Years, the sole and exclusive Right and Liberty of using, and vending to others the said Discovery, of burning the raw Ashes previous to their being dissolved and boiled in Water, according to the true Intent and Meaning of the Act aforesaid. In Testimony whereof I have caused these Letters to be made patent, and the Seal of the United States to be hereunto affixed Given under my Hand at the City of New York this thirty first Day of July in the Year of our Lord one thousand seven hundred & Ninety.

G. Washington

City of New York July 31st 1790. -

I do hereby certify that the foregoing Letters patent were delivered to me in pursuance of the Act, entitled "An Act to promote the Progress of useful Arts", that I have examined the same, and find them conformable to the said Act.

Edm. Randolph Attorney General for the United States.

Patents Today

- A strong patent system is considered a sign of industrial success. Japan went from post-war ruin to tech leader partly because they imported the US patent system.
- The EPO and USPTO patent databases are free resources with the entire catalog of innovation from 1800s to the present. Inventions are organized into 'classes' to make searching easier. The USPTO is full-text searchable for patents issued in 1976 and forward.
- The US Supreme Court still has no clear idea what is patentable, and this is a good thing.

“Worldwide” Patent

- Yeti, Loch Ness Monster, Trickle-down Economics, Worldwide Patent.
- The closest mechanism to a worldwide patent is the Patent Cooperation Treaty (PCT).
- PCT gives the application a unified filing date.
- Each country examines the patent application according to their own laws.
- Very few countries recognize software as ‘patentable subject matter’. Stick with the US.

3 Pillars of a Patent

- New: not disclosed in prior documents anywhere in the world. If an existing patent discloses all features of the invention at hand, it is not 'new', therefore not patentable. Sometimes it's called "novelty".
- Useful: the invention must work as described, and the disclosure must be complete - you can't omit a key detail. It is possible to get a patent based on scientific hypothesis. If, in use, the hypothesis is wrong, the patent can be invalidated.
- Unobvious: the invention must be inventive. If a 'skilled in the art' can arrive at the invention by combining known inventions without a spark of inventiveness, the invention is 'obvious' and unpatentable.

Benefits of a Patent

- The right to exclude others from making, selling or using a patented product.
- A patent is an intangible asset that can be sold, licensed, bequeathed, valued, depreciated, and auctioned off.
- In the US, courts are very friendly towards inventors, and very harsh on infringers. In Europe, you will be lucky to win enough to pay your lawyers.

Patent Enforcement

- Federal courts have jurisdiction to adjudicate patent disputes.
- US courts view patents as stimulating innovation rather than stifling it.
- Patent litigation is expensive, but this can be a good thing if you're the plaintiff with a strong patent.

Patent Caveats

- US and Canada follow the 1-year rule: If you disclosed your invention to a party not involved in the invention process, you have one year from date of disclosure to file for an application. If you miss this deadline, your invention becomes public property, and any patent on that invention can be challenged as invalid.
- For most countries (EU, China), 'absolute novelty' rule applies: if the inventor disclosed the invention prior to filing a patent application, the patent is invalid.
- First-to-file: the US was the last country to change from first-to-invent to first-to-file. However, if someone beats you to the PTO with your invention, you can always take them to court, and if you win, they will be deemed to be the patent application's 'trustee'.
- A patent is useless without great marketing behind it.

A Patent's Life

- A patent is enforceable for 20 years from date of filing. Since patent prosecution can take years (and years), the USPTO may grant an extension depending on how long the application was in the PTO's gears. Environmental patents get time extensions.
- After Issuance, maintenance fees are due at the 3.5, 7.5 and 11.5 year deadlines. Failure to pay maintenance fees will result in the patent's abandonment.
- It is good practice to file applications for patentable improvements to stay competitive.

Patent Anatomy

- Abstract: 150 words that state, in plain language, what the invention does, and problems it resolves
- Figures: a graphic representation of the invention's guts. For mechanical inventions, drawings of cross-sections, exploded views and structural relationships. For software, block diagrams and flow-charts.
- Specification: background behind the invention's development, description of drawings, and a complete disclosure of the preferred embodiment of the invention.
- Claims: the virtual fence around the invention's innovative features. The claims are the most important part of the patent, the part that is 'infringed'.

Patent Time/Costline

- Day 0: Patent search. It is crucial to do a search to find out what's out there, and if filing an application is worthwhile. Cost: from \$500
- Preparation and filing of a patent application. Fast is never good: budget at least 4 months and \$7,000 to prepare a good software patent application.
- One to two years after filing: Examination. A Patent Examiner will search the patent databases to see if the invention is not new, useful or obvious. If the Examiner finds fault in the application, she will issue an Examiner's Report, with a 3-month deadline to respond with an amended application. This back-and-forth can last for years, and patent professionals bill this work at an hourly rate.
- 3 to 7 years after filing: Issuance. Cost is about \$1,600.

Software Patents

- The US is the easiest place to protect software with a patent. It is not as easy as it used to be, but still possible.
- Countries that allow software patents: USA, Canada, Australia, Japan, South Korea. With some caveats, you may be able to get a software patent in UK, Europe and China.
- Software patents are a sore spot for industry, and governing bodies flip-flop between allowing and prohibiting them.

In re Bilski

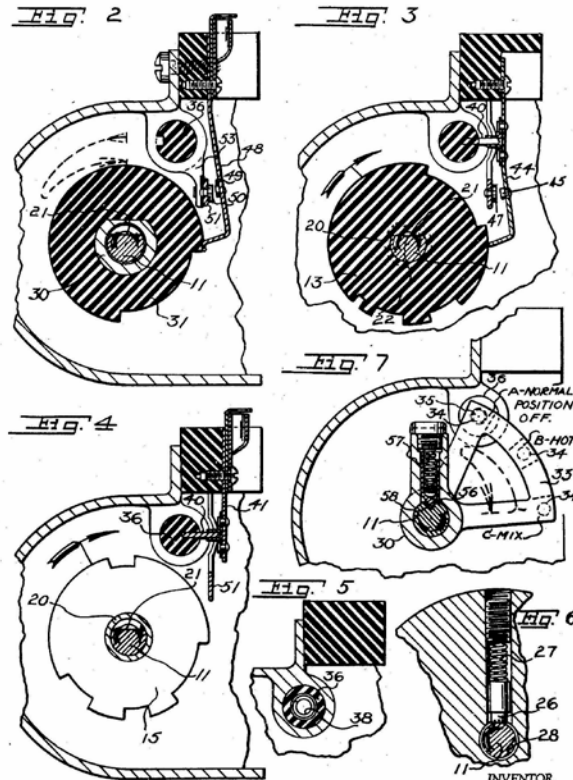
- US Supreme court's latest attempt to define what is patentable.
- The Court pushes the 'what is patentable' goalposts back to the 1980s.
- "The framers of the Constitution intended to exclude from the operation of the US patent system methods for organizing human activity that do not involve manufactures, machines, or compositions of matter"
- 'Machine-or-transformation' test is now current benchmark for deciding whether something is patentable or not.

Alice Corp. V. CLS Bank Int'l

- June 2014 US Supreme Court decision
- Patent covered an abstract idea to mitigate 'settlement risk', implemented by a 'generic computer'
- The computer did nothing to aid the idea, i.e. the idea was well-known and implementable without a computer
- Examples of ineligible ideas are:
 - Fundamental economic practices
 - Certain methods of organizing human activities
 - An idea of itself
 - Mathematical relationships or formulas
- An idea may be patentable if the claim recites more than a mere instruction to apply the abstract idea

Thought Experiment 1947

Sept. 9, 1947. W. F. OLIVER 2,427,300
COMBINED TIMER AND SELECTOR SWITCH MECHANISMS
Filed Sept. 25, 1942 4 Sheets-Sheet 2



INVENTOR.
WALLACE F. OLIVER
BY *William Bradbury-Hindle*
ATTORNEYS

Thought Experiment 2015





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(12) United States Patent
Appelman et al.**(10) Patent No.: US 8,474,628 B1****(45) Date of Patent: Jul. 2, 2013****(54) PRESENTING A RECIPIENT OF AN E-MAIL WITH AN OPTION TO INSTANT MESSAGE A SENDER OR ANOTHER RECIPIENT BASED ON THE SENDER'S OR THE OTHER RECIPIENT'S ADDRESS AND ONLINE STATUS**5,276,905 A 1/1994 Hurst et al.
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(75) Inventors: **Barry Appelman**, McLean, VA (US);
Larry L. Lu, Great Falls, VA (US);
Alisa Clemmons, Oakland, CA (US);
Peter Weck, Menlo Park, CA (US)**FOREIGN PATENT DOCUMENTS**EP 862304 A2 9/1998
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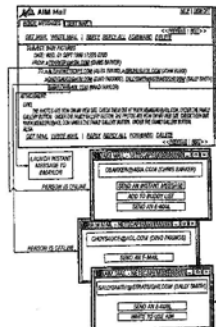
(73) Assignee: **Facebook, Inc.**, Menlo Park, CA (US)**OTHER PUBLICATIONS****(*) Notice:** Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 1603 days.

Office Action, U.S. Appl. No. 09/843,788, dated Apr. 19, 2007, 17 pages.

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(21) Appl. No.: 11/150,180**(22) Filed: Jun. 13, 2005***Primary Examiner* — Robert B Harrell**(74) Attorney, Agent, or Firm** — Keller Jolley Preece**Related U.S. Application Data****(63)** Continuation of application No. 09/848,232, filed on May 4, 2001, now Pat. No. 6,912,564.**(60)** Provisional application No. 60/201,738, filed on May 4, 2000, provisional application No. 60/229,311, filed on Sep. 1, 2000.**(51) Int. Cl.**
G06F 13/00 (2006.01)**(52) U.S. Cl.**
USPC 209/206**(58) Field of Classification Search**
USPC 709/206
See application file for complete search history.**(56) References Cited****U.S. PATENT DOCUMENTS**4,837,798 A 6/1989 Cohen et al.
5,086,394 A 2/1992 Shapira**(57) ABSTRACT**

Systems and techniques for transferring electronic data between users of a communications system include a host system structured and arranged to receive and deliver messages of various types between users of the communications system. The host system includes an instant messaging network; a mail gateway; and a configuring network in communication with both the instant messaging network and the mail gateway. The instant messaging network enables instant messaging communication between users of the communications system and has the capability to monitor whether a certain user is capable of receiving an instant message at a particular moment. The mail gateway receives and delivers e-mail messages to users of the communications system. The configuring network is dedicated to automatically configuring instant messaging communication between an intended recipient of an e-mail message and the sender of the e-mail message.

18 Claims, 9 Drawing Sheets

'628: Facebook

- Communication system for instant messages to sender and recipient by email.
- Instant message system for online subscribers such as weather, finances, sports, entertainment, using AOL and CompuServe.
- Host system includes an instant messaging network enabling instant messaging communication between user and communication system
- Flow charts and block diagrams
- Cites 330 prior art patents and 6 pages of cited references
- 18 claims
- All claims mention "hardware"

'606: Disney

- Mobile consumer devices and printed publications
- Provide consumer notifications on their mobile consumer device
- System includes a central platform in communication with mobile consumer devices
- Central system sends subscriptions of publications to each consumer according to their demand
- Flow chart and block diagrams
- 21 claims
- Claims include central processor or platform, and mention “computer”

'847: Google

- Method and system for providing geographic information on telephone device. Caller's location can be shown on receiving phone if Caller permits receiving information regarding current geographic information of caller.
- Related to computer-implemented method, mentioning "computing device" and "computer-readable storage"
- Flow chart and block diagrams
- 20 claims

'874: Microsoft

- Techniques for presenting an App change through tile permitting user to view changes to an App through a tile of user's interface, allowing easy determination if change is of sufficient interest to visit App.
- Flow chart and block diagrams
- 12 claims
- Claims mention "computer-implemented method"

'656: Mocana Corp.

- Apps are secured or security-wrapped either before they are downloaded onto a device, or after they are downloaded, before they are allowed to access the device operating system and cause any potential damage.
- Flow chart and block diagrams
- 26 claims
- Claims related to generating java-class files and device operating system “on a device”.

'674: Symphony Advanced Media

- Social content monitoring platform to switch channels, change audio volumes, interact with TV and select desired channels without physically touching it via operating remote TV control. User may operate mobile device to receive a list of TV programs and select channel via mobile phone.
- Flow chart and block diagrams
- 20 claims
- Claims emphasize that it's a "processor-implemented method"

8,850,490: Google (09/30/2014)

- “Online content sharing platforms typically allow users to upload, view, and share digital content such as media items. Media items may include audio clips, movie clips, TV clips, music videos, images, or other multimedia content. Users may use computing devices (such as smart phones, cellular phones, laptop computers, desktop computers, netbooks, tablet computers) to use, play, and/or otherwise consume media items (e.g., watch digital videos, and/or listen to digital music).”
- “[a] method for providing paid channels in an internet-based content platform is described. The method includes receiving, via a user interface, a request of an end user to subscribe to a paid channel of the internet-based content platform. The paid channel is one of a plurality of channels of the internet-based content platform and has dynamically changed content. The method further includes requesting, via the user interface, end user information that includes payment information of the end user. The method also includes receiving the end user information. The method includes creating a subscription to the paid channel for the end user based on the end user information. The method further includes providing, via the user interface, access to the content of the paid channel to the end user at substantially the same time as creating the subscription for the end user.”
- Claim 1: A method, implemented by an internet-based content platform, comprising: receiving, via a user interface, a request of an end user to subscribe to a paid channel of the internet-based content platform, the paid channel being one of a plurality of channels of the internet-based content platform and having dynamically changed content, the paid channel being presented to the end user with an indicator of a subscription status of the end user with respect to the paid channel; identifying end user information comprising payment information of the end user; creating a subscription to the paid channel for the end user based on the end user information; providing, via the user interface, access to the content of the paid channel to the end user at substantially the same time as creating the subscription for the end user; and causing the indicator of the subscription status of the end user to be changed to indicate that the end user is subscribed to the paid channel.

Lowest Common Denominators

- Flow-charts and block diagrams
- Hardware, hardware, hardware.
“Computer”, “processor”, “device”
“interface”, but not “Algorithm”, “sequence”
or “code”.
- The software must do something (using hardware).
- Did I mention ‘hardware’? If it’s not an integral part of the claims, your chances of getting a patent are slim.

Provisional Patent Application

- 🦆 Least expensive way to get 'patent pending' status. It is akin to a Non-Disclosure Agreement with the world.
- 🦆 Gives a 1-year window to file for a Regular patent application (think in terms of 8 months)
- 🦆 Pros: inexpensive, no claims required, only needs full disclosure of invention.
- 🦆 Cons: you have only 8 months to decide if you will pursue a Regular application.
- 🦆 Get all your marketing ducks carefully and quietly in a row before filing a Provisional to maximize the 'patent pending' window.

Non-Disclosure Agreements

- It is not recommended to sign NDAs, but sometimes you have no choice.
- Beware the boilerplate clause that states that “if we [the big company] are concurrently developing similar technology, this NDA is void.”
- NDAs must have a limit on time, definitions of what is ‘confidential’, and who is bound by the NDA.
- Invest in a lawyer review of any NDA you sign.

Cross-licensing of Patents

- Example: First came the diode. Two years later, the triode. The inventor of diodes could not make triodes, and the inventor of triodes could not make diodes. Why? Because there is a diode in a triode.
- Solution: cross-license.
- Mp3 compression is a pool of 94 cross-licensed patents.

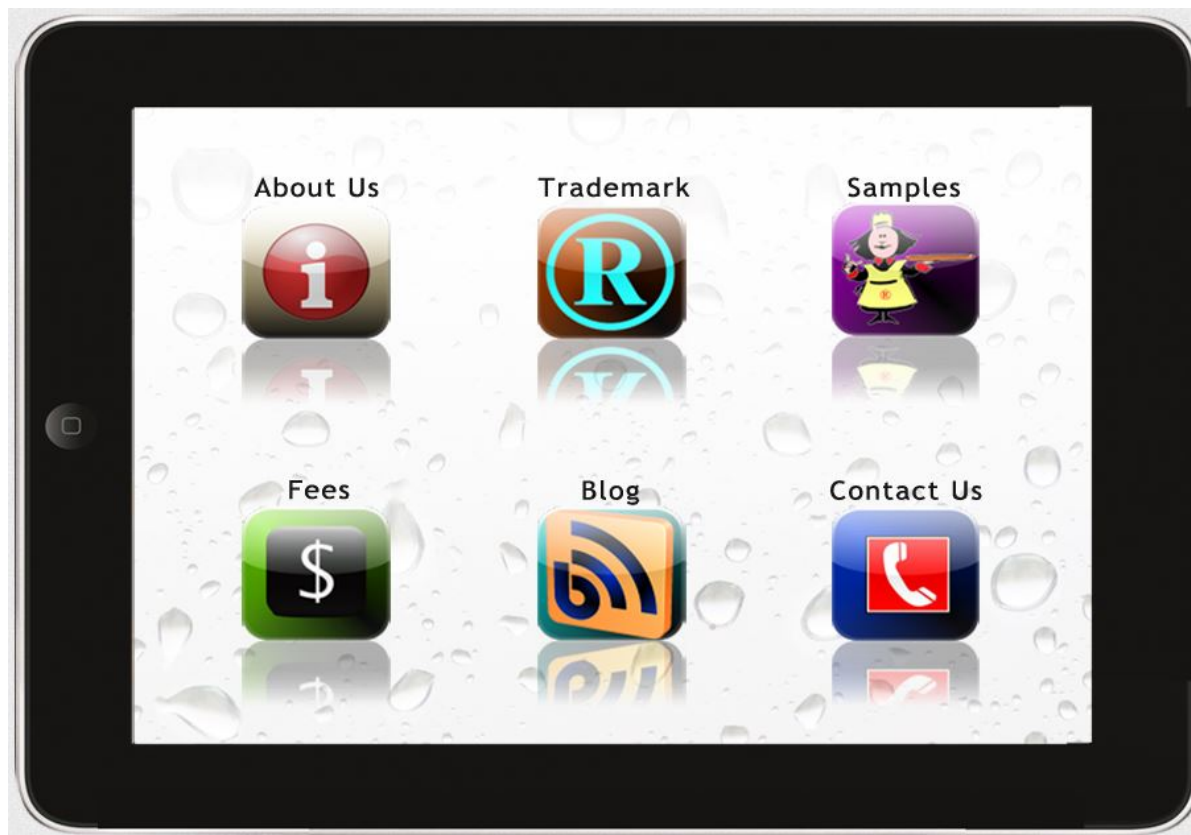
PICK UP Good IP Habits

- **Proactive** rather than reactive attitude
- **Investment**, not expenditure
- **Communicate** with your legal counsel
- **Keep** meticulous records of your process
- **Unify** your IP portfolio
- **Police** the market for infringement



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the class feedback form via the
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Thank you!

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