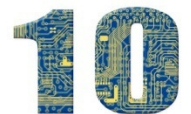

Introduction to Intellectual Property Rights (IPR): US and Global Perspectives

by

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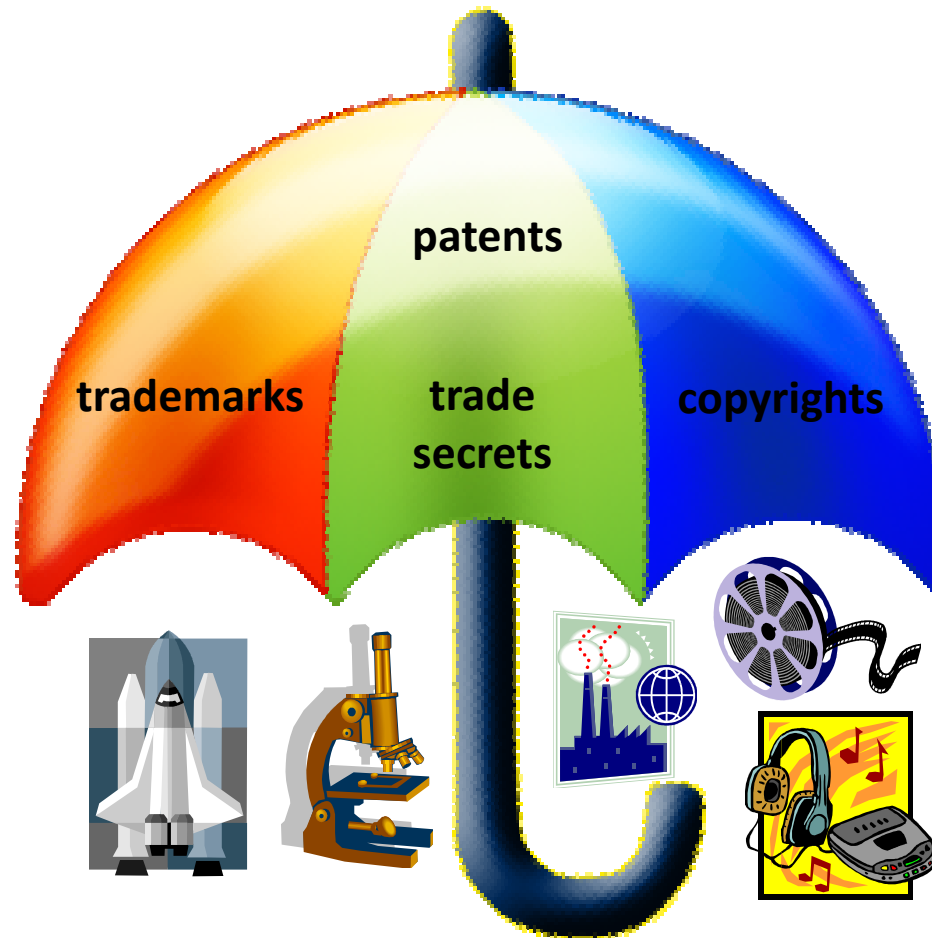
Outline

- **The Intellectual Property Rights (IPR) Umbrella:**

- copyrights
- trademarks
- patents
- trade secrets



The Intellectual Property Rights (IPR) Umbrella



Copyrights

- **Protect “original works of authorship”:**

- literary works
- dramatic works
- musical works
- artistic works
- certain other intellectual works
- protection is available to both published and unpublished works



Copyrights (cont.)

- **Generally gives the owner of copyright the exclusive right to do and to authorize others to do the following:**
 - reproduce the work in copies or phonorecords
 - prepare derivative works based upon the work
 - distribute copies or phonorecords of the work to the public by sale or other transfer of ownership, or by rental, lease, or lending
 - perform the work publicly, in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works



Copyrights (cont.)

- **Generally gives the owner of copyright the exclusive right to do and to authorize others to do the following (cont.):**

- display the work publicly, in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work

- perform the work publicly (in the case of sound recordings*) by means of a digital audio transmission

*“works that result from the fixation of a series of musical, spoken, or other sounds, but not including the sounds accompanying a motion picture or other audiovisual work.” Common examples include recordings of music, drama, or lectures. A sound recording is not the same as a phonorecord. A phonorecord is the physical object in which works of authorship are embodied. The word “phonorecord” includes cassette tapes, CDs, and vinyl disks as well as other formats.



Copyrights (cont.)

- **Who Can Claim Copyright?:**

- Copyright protection subsists from the time the work is created in fixed form.
- The copyright in the work of authorship immediately becomes the property of the author who created the work.
- Only the author or those deriving their rights through the author can rightfully claim copyright.
- In the case of works made for hire, the employer and not the employee is considered to be the author.

Copyrights (cont.)

- **Copyright and National Origin of the Work:**

- Copyright protection is available for all unpublished works:

- regardless of:

- the nationality or

- domicile of the author.

- Published works are eligible for copyright protection in the United States when certain conditions are met.



Copyrights (cont.)

- **What Is Not Protected by Copyright?:**

- Works that have not been fixed in a tangible form of expression (e.g., choreographic works that have not been notated or recorded, or improvisational speeches or performances that have not been written or recorded).
- Titles, names, short phrases, and slogans; familiar symbols or designs; mere variations of typographic ornamentation, lettering, or coloring; mere listings of ingredients or contents.

Copyrights (cont.)

- **What Is Not Protected by Copyright? (cont.):**

- Ideas, procedures, methods, systems, processes, concepts, principles, discoveries, or devices, as distinguished from a description, explanation, or illustration.
- Works consisting entirely of information that is common property and containing no original authorship (e.g., standard calendars, height and weight charts, tape measures and rulers, and lists or tables taken from public documents or other common sources).



Copyrights (cont.)

- **Copyright Secured Automatically upon Creation:**

- No publication or registration or other action in the Copyright Office is required to secure copyright.
- There are, however, certain definite advantages to registration.
- A work is “created” when it is fixed in a copy or phonorecord for the first time.
- For example, a song (the “work”) can be fixed in sheet music (“copies”) or in phonograph disks (“phonorecords”), or both.



Copyrights (cont.)

- **Form of Notice for Visually Perceptible Copies:**

- © 2010 John Doe

- **Form of Notice for Phonorecords of Sound Recordings:**

- (P) 2010 A.B.C. Records Inc.

- **Publications Incorporating U. S. Government Works:**

- © 2010 Jane Brown

Copyright claimed in chapters 7–10, exclusive of U. S. government maps

- **Unpublished Works:**

- Unpublished work © 2008 Jane Doe



Copyrights (cont.)

•How Long Copyright Protection Endures (Works Originally Created on or after January 1, 1978):

- Automatically protected from the moment of its creation and is ordinarily given a term enduring for the author's life plus an additional 70 years after the author's death.
- In the case of "a joint work prepared by two or more authors who did not work for hire," the term lasts for 70 years after the last surviving author's death.
- For works made for hire, and for anonymous and pseudonymous works (unless the author's identity is revealed in Copyright Office records), the duration of copyright will be 95 years from publication or 120 years from creation, whichever is shorter.



Copyrights (cont.)

- **Transfer of Copyright:**

- Any or all of the copyright owner's exclusive rights or any subdivision of those rights may be transferred, but the transfer of exclusive rights is not valid unless that transfer is in writing and signed by the owner of the rights conveyed or such owner's duly authorized agent.
- Transfer of a right on a nonexclusive basis does not require a written agreement.



Copyrights (cont.)

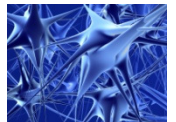
- **Transfer of Copyright (cont.):**

- A copyright may also be conveyed by operation of law and may be bequeathed by will or pass as personal property by the applicable laws of intestate succession.

- Copyright is a personal property right, and it is subject to the various state laws and regulations that govern the ownership, inheritance, or transfer of personal property as well as terms of contracts or conduct of business.

- **Fairly long shelf life:**

- 70 years from death of the author.



Copyrights (cont.)

•International Copyright Protection:

- There is no such thing as an “international copyright” that will automatically protect an author’s writings throughout the entire world.
- Protection against unauthorized use in a particular country depends, basically, on the national laws of that country.
- However, most countries do offer protection to foreign works under certain conditions, and these conditions have been greatly simplified by international copyright treaties and conventions.
- For further information and a list of countries that maintain copyright relations with the United States, see Circular 38a, International Copyright Relations of the United States.



Trademarks



Trademarks (cont.)

- **Trademarks Provide Protection For:**

- Words, names, symbols, sounds, or colors that distinguish goods and services from those manufactured or sold by others and to indicate the source of the goods.
- Trademarks, unlike patents, can be renewed forever as long as they are being used in commerce.



Trademarks (cont.)

- USPTO Newsflash Videos: Before and After You File for a Trademark:

- <http://www.uspto.gov/trademarks/process/TMIN.jsp>



Trademarks (cont.)

- **So What Did We Learn From the Videos?:**

- Before starting the application, use the Trademark Electronic Search System, or TESS, to search for marks that are confusingly similar:

- If there's a live mark in the system that is similar and used with related goods and services, the application may be refused.

- Use the Trademark Electronic Application System, or TEAS, to file the application:

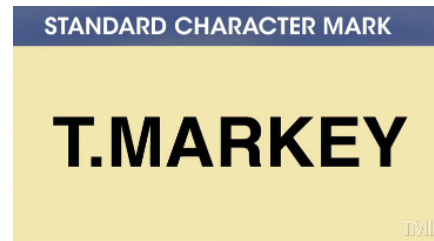
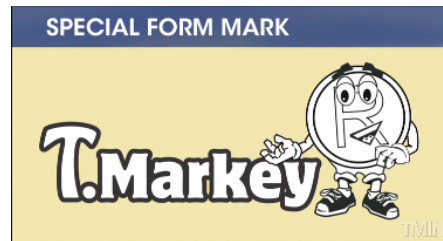
- The Owner of the Mark is not necessarily the name of the person filling out the form.



Trademarks (cont.)

- So What Did We Learn From the Videos? (cont.):

- A drawing shows what the mark is:



- A specimen shows how the mark is used:



Trademarks (cont.)

- **So What Did We Learn From the Videos? (cont.):**
 - Make sure to correctly identify the goods or services:
 - An incorrect identification of goods and services could prevent registration down the road.
 - What is an “identification” or what is meant by “goods and services”:
 - If it’s **products**, you’ve got **goods**.
 - If it’s **activities**, you’ve got **services**.



Trademarks (cont.)

- **So What Did We Learn From the Videos? (cont.):**

- The selling of one's own goods is never a service, but the providing of a convenient place to purchase goods is:
 - For example, "Retail store and online retail store services featuring t-shirts."
 - **Goods** are **things** that bear your trademark.
 - **Services** are **activities** that you perform for others.
- The goods or services identified should only be those on which the mark is actually being used or on which there is a bona fide intent to use the mark.
- Theoretical usage doesn't count.



Trademarks (cont.)

- **So What Did We Learn From the Videos? (cont.):**
 - Figure out the correct filing basis:
 - Using the mark in interstate commerce, requires filing under the Section 1(a), “Use-in-Commerce” basis.
 - If not yet using the mark in interstate commerce, but having a bona fide intent to do so within the next 3 to 4 years, requires filing under the Section 1(b), “Intent-to-Use” basis.
 - Registration is not instantaneous or guaranteed:
 - Each application must be reviewed for legal requirements and this takes time.



Trademarks (cont.)

- **So What Did We Learn From the Videos? (cont.):**
 - Registration is not instantaneous or guaranteed (cont.):
 - Application usually will begin to be examined within 3 months, final disposition may be months or years down the road.
 - Refusals by the USPTO examining attorney must be responded to, additional paper work may need to be submitted work, and additional fees may need to be paid.
 - Especially true if for filing under the “Intent to Use” basis.
 - Additional forms must be submitted.
 - Payment of additional fees required.



Trademarks (cont.)

•So What Did We Learn From the Videos? (cont.):

- Use the electronic resources provided by the USPTO:
 - The USPTO.GOV website allows many things to be done on-line.
 - Once the application has been received, one can check the status of the application and view and download all of the documents and information in the application file.
 - Check application status every 3 or 4 months to avoid missing deadlines and having the application go abandoned.
 - To check application status use the Trademark Applications and Registrations Retrieval system (TARR).
 - To see the actual documents in the application file use the Trademark Document Retrieval (TDR) system.



Trademarks (cont.)

- **So What Did We Learn From the Videos? (cont.):**

- Make sure correspondence information, including current e-mail address, is up to date in the Office records:

- If Office e-mails are treated as spam, or responses are filed after a deadline, or no response is filed at all:

- The application will go abandoned.

- No refund will be issued.

- For answers to questions or technical difficulties:

- Contact the TEAS Help Desk or for general information, contact the Trademark Assistance Center or, once the case has been assigned to an examining attorney, contact the examining attorney OR hire an attorney who specializes in trademarks to represent you before the Office.



Trademarks (cont.)

- **So What Did We Learn From the Videos? (cont.):**

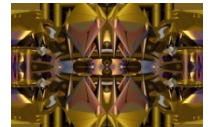
- Beware of solicitations that resemble official documents:

- Unsolicited communications from non-USPTO entities offering trademark monitoring, document filing, and representational services.

- Responding to Office Actions:

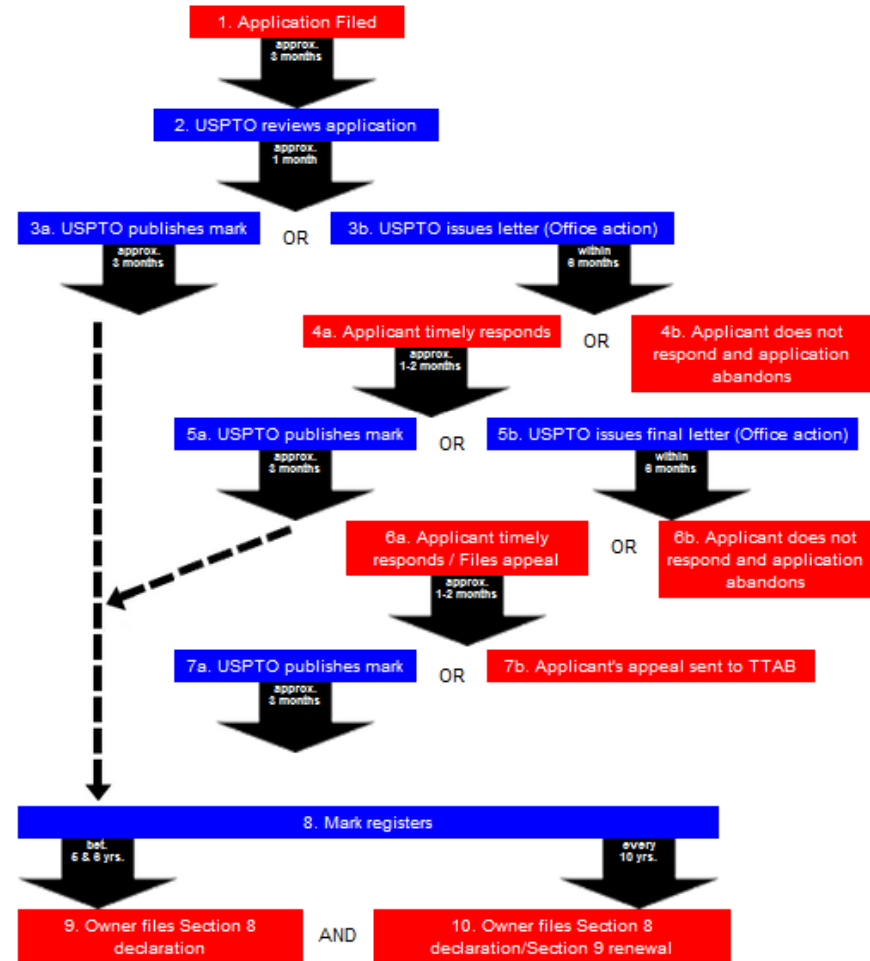
- USPTO examining attorney may argue that the mark causes a “likelihood of confusion” with another mark.

- Responses to Office Actions must be filed or the application will go abandoned.



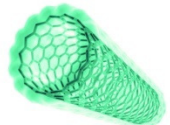
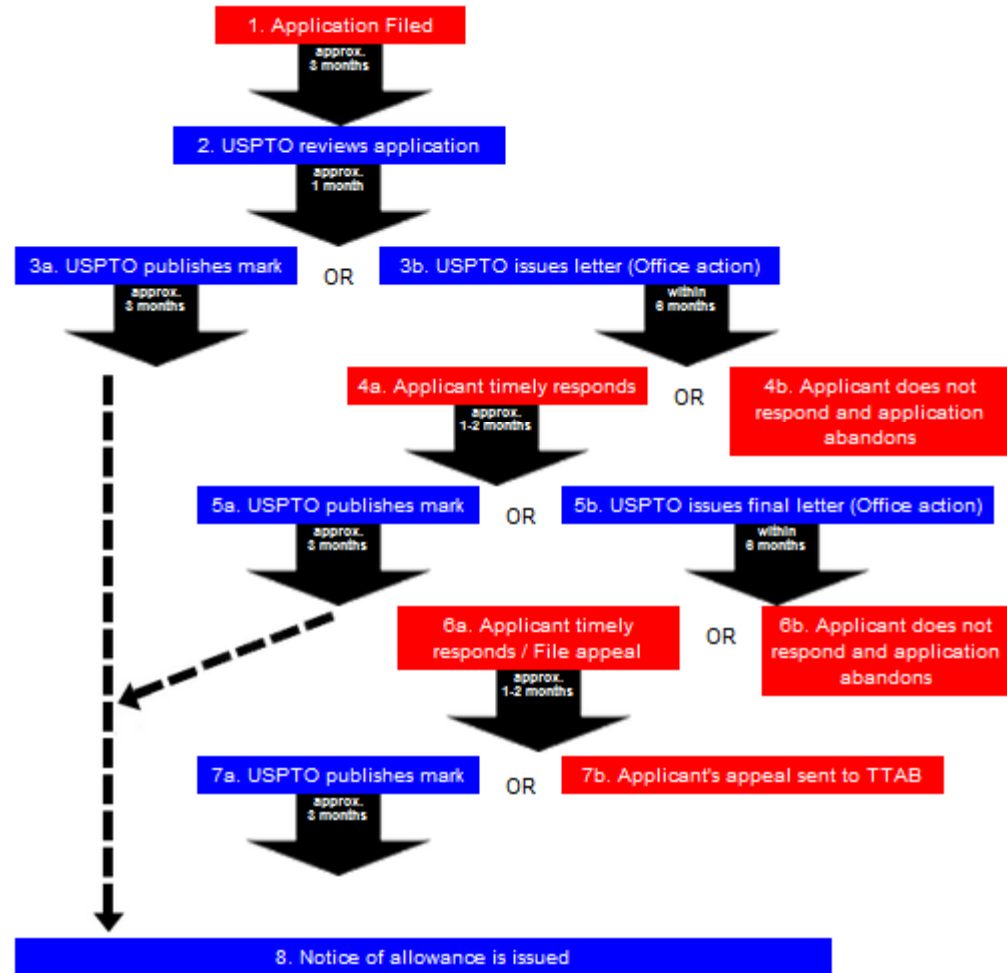
Trademarks (cont.)

- Timelines (use in commerce):



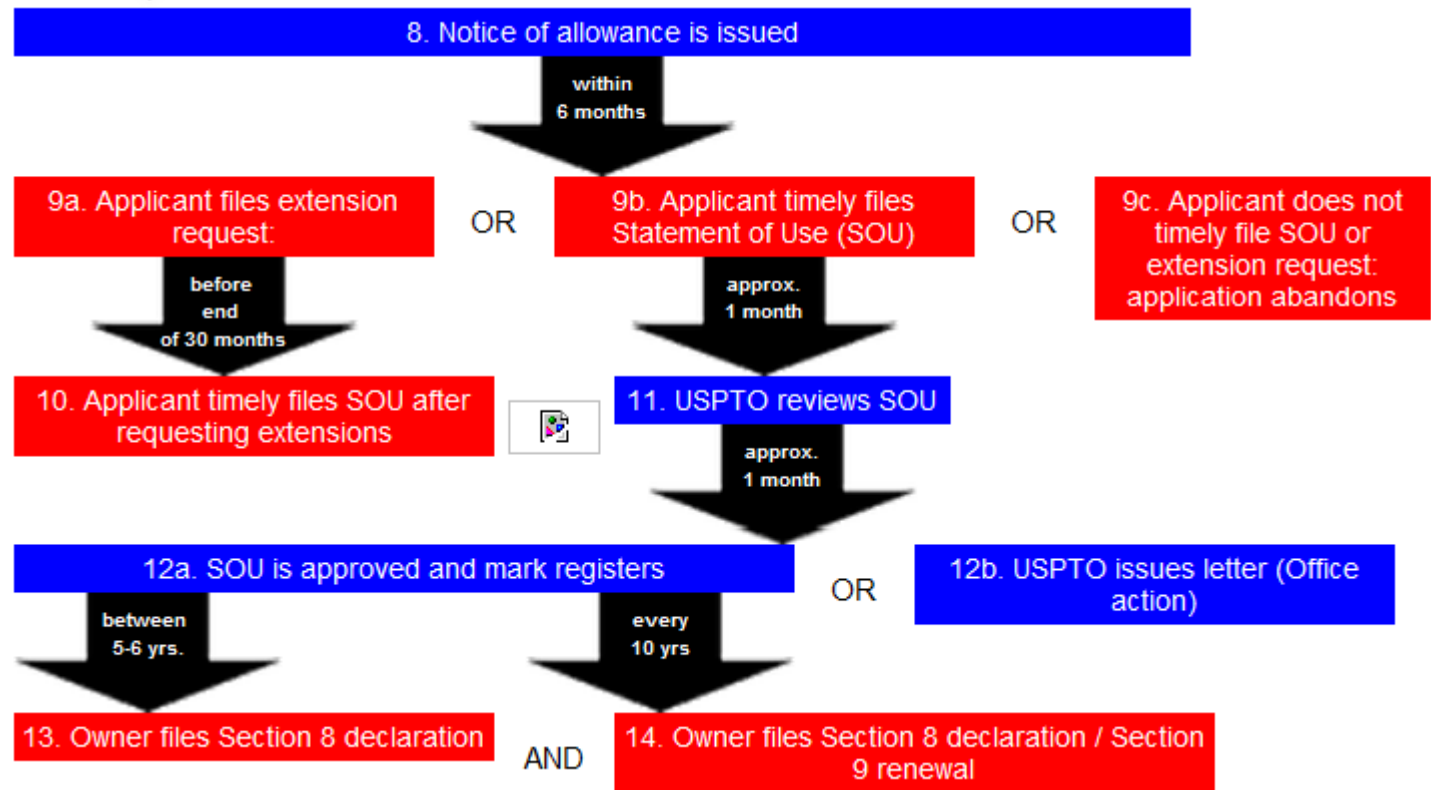
Trademarks (cont.)

- Timelines (intent to use):



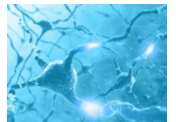
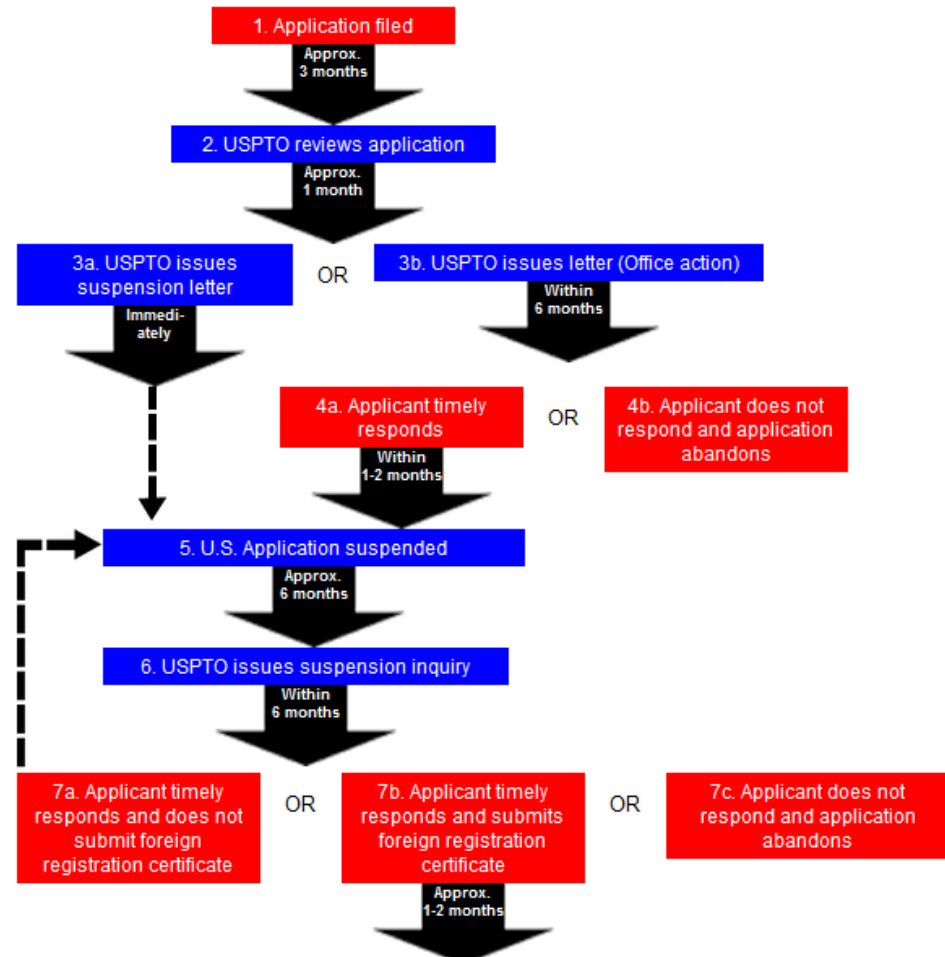
Trademarks (cont.)

• Timelines (intent to use, cont.):



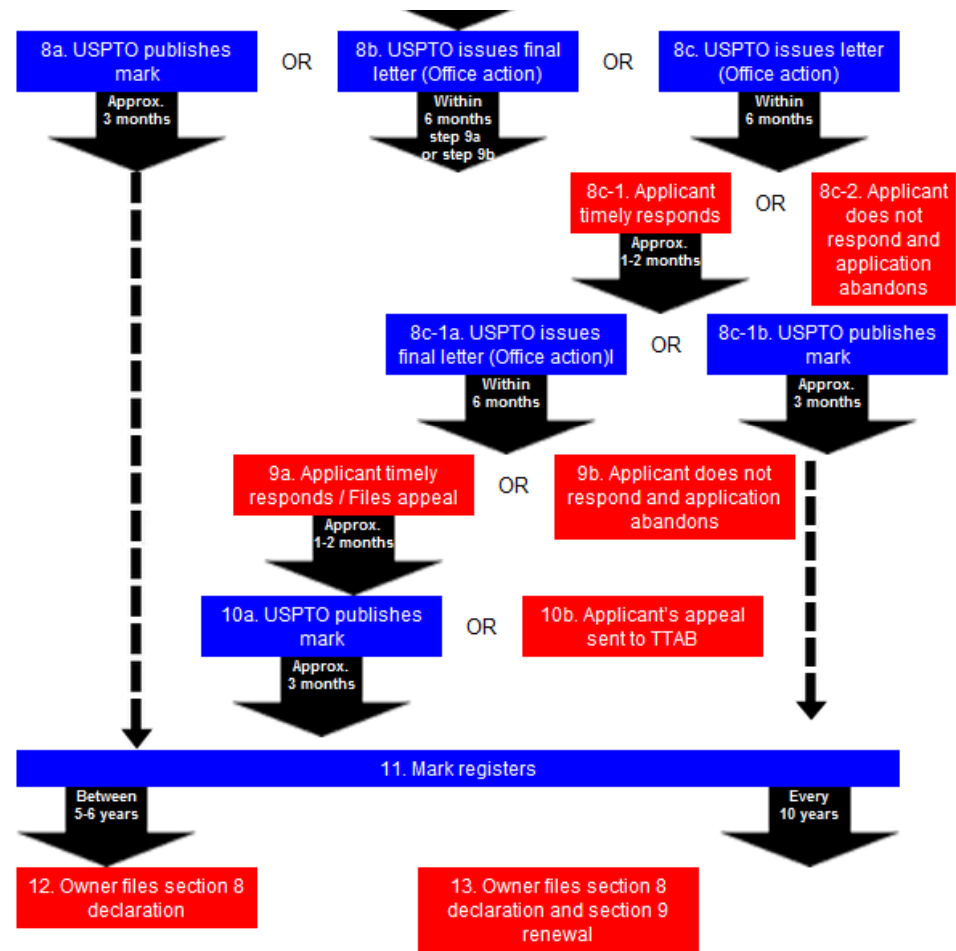
Trademarks (cont.)

- Timelines (based on foreign application):



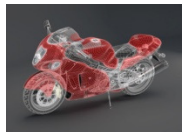
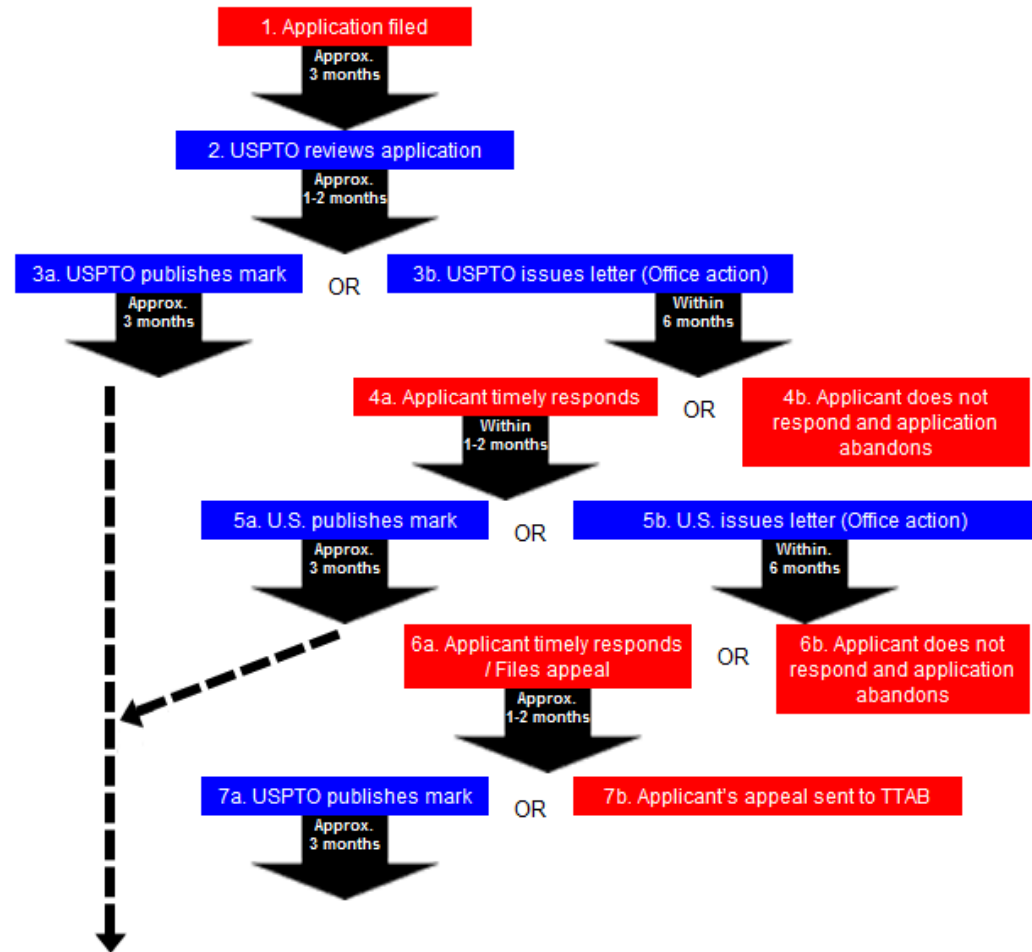
Trademarks (cont.)

- Timelines (based on foreign application, cont.):



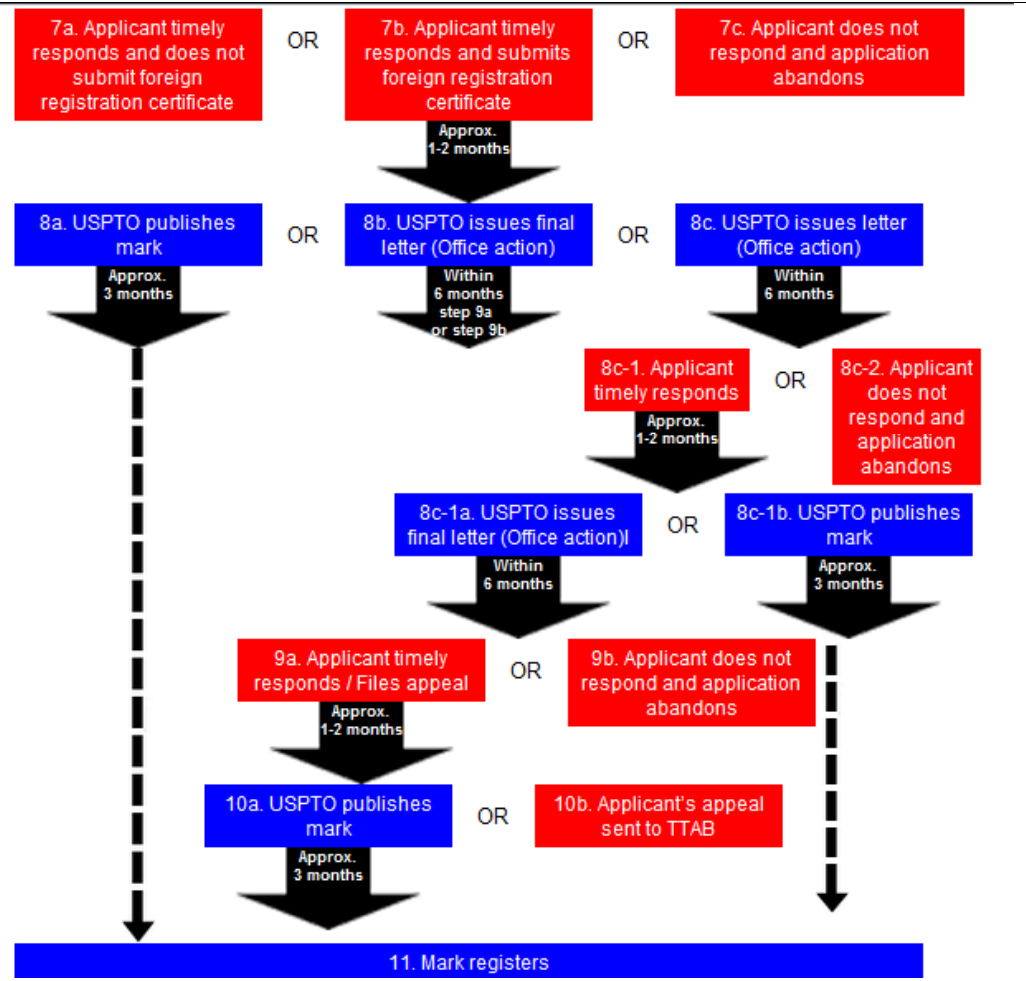
Trademarks (cont.)

- Timelines (based on foreign registration):



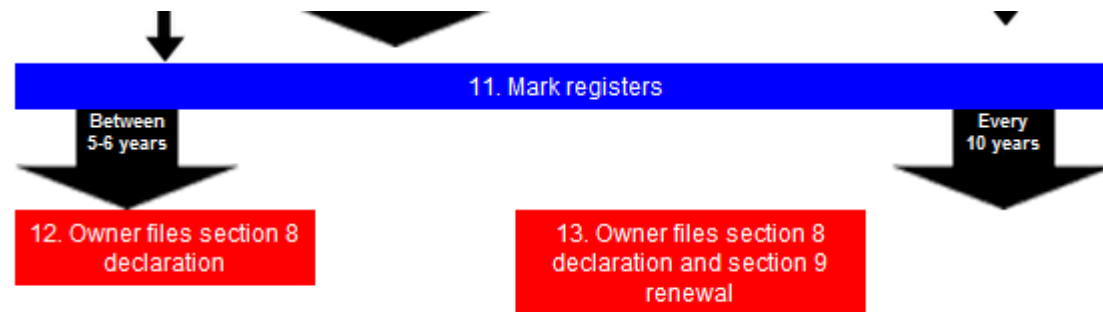
Trademarks (cont.)

• Timelines (based on foreign registration, cont.):



Trademarks (cont.)

- Timelines (based on foreign registration, cont.):



Trademarks (cont.)

- **Madrid Protocol:**

- The Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks
- One of two treaties comprising the Madrid System for international registration of trademarks.
- The protocol is a filing treaty and not a substantive harmonization treaty.
- Cost-effective and efficient way for trademark holders -- individuals and businesses -- to ensure protection for their marks in multiple countries through the filing of one application with a single office, in one language, with one set of fees, in one currency.



Trademarks (cont.)

- **Madrid Protocol (cont.):**

- No local agent is needed to file the application.
- While an International Registration may be issued, it remains the right of each country or contracting party designated for protection to determine whether or not protection for a mark may be granted.
- Once the trademark office in a designated country grants protection, the mark is protected in that country just as if that office had registered it.



Trademarks (cont.)

- **Madrid Protocol (cont.):**

- The Madrid Protocol also simplifies the subsequent management of the mark, since a simple, single procedural step serves to record subsequent changes in ownership or in the name or address of the holder with World Intellectual Property Organization's International Bureau.
- The International Bureau administers the Madrid System and coordinates the transmittal of requests for protection, renewals and other relevant documentation to all members.



Trademarks (cont.)

- **Community Trade Mark (CTM) System:**

- Applies in the European Union.
- Registration is with the Office for Harmonization in the Internal Market (OHIM)
- Registration effective throughout the EU.
- CTM registration applies indivisibly across all European Union member states.
- CTM system did not replace the national trademark registration systems
- CTM system and the national systems continue to operate in parallel to each other.



Trademarks (cont.)

- **Community Trade Mark (CTM) System (cont.):**

- If outside the EU, must hire professional representative familiar with procedures before the OHIM.
- If you are a European resident, professional representation to file an opposition not required but strongly recommended by the OHIM.
- CTM owner must monitor later applications to see if similar to earlier trademark.
- Monitoring difficult and requires professional expertise (Trademark Watching services).



Trademarks (cont.)

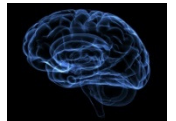
- **Community Trade Mark (CTM) System (cont.):**

- Oppositions filed on standard opposition form in any official language of the European Union.
- Substantive part of the opposition (e.g., the argumentations) must be submitted only in the language of the opposed application, that is one of the working languages of the OHIM, e.g., English, Spanish, German.
- In most of cases opponents file oppositions in English.



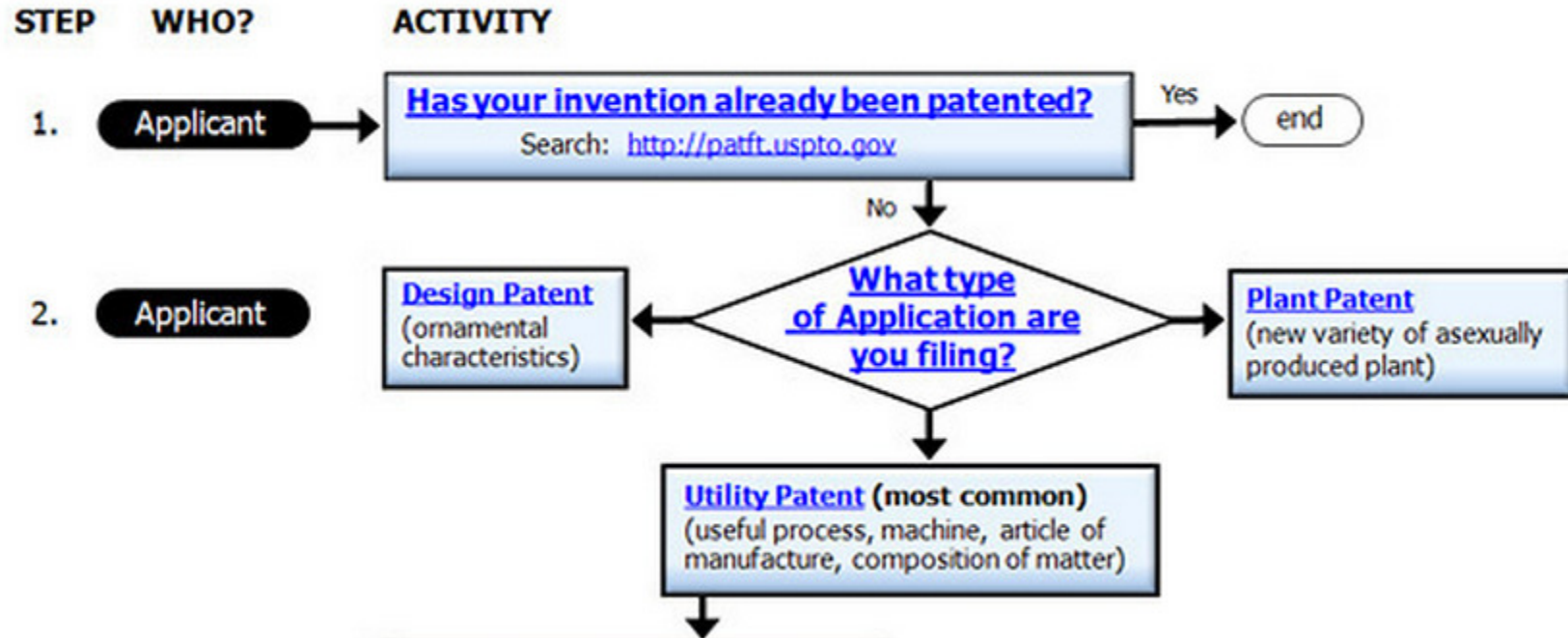
Trademarks (cont.)

- **A trademark is designated by the following symbols:**
 - TM (for an unregistered trade mark, i.e., a mark used to promote or brand goods)
 - SM (for an unregistered service mark, i.e., a mark used to promote or brand services)
 - [®] (for a registered trademark)
- **Indefinite shelf life:**
 - Can be renewed in perpetuity.



Patents

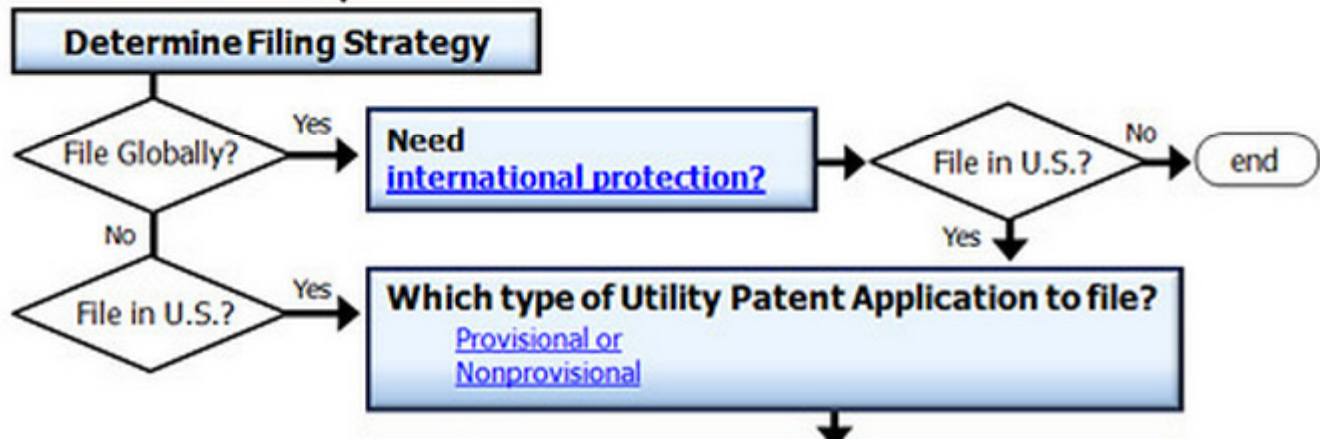
•The Patenting Process:



Patents (cont.)

•The Patenting Process (cont.):

3. Applicant



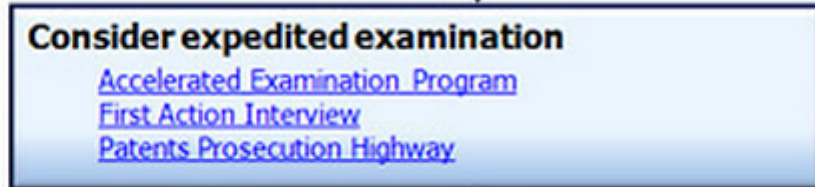
4. Applicant



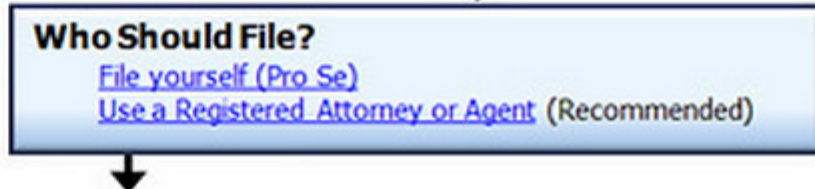
Patents (cont.)

•The Patenting Process (cont.):

5. Applicant

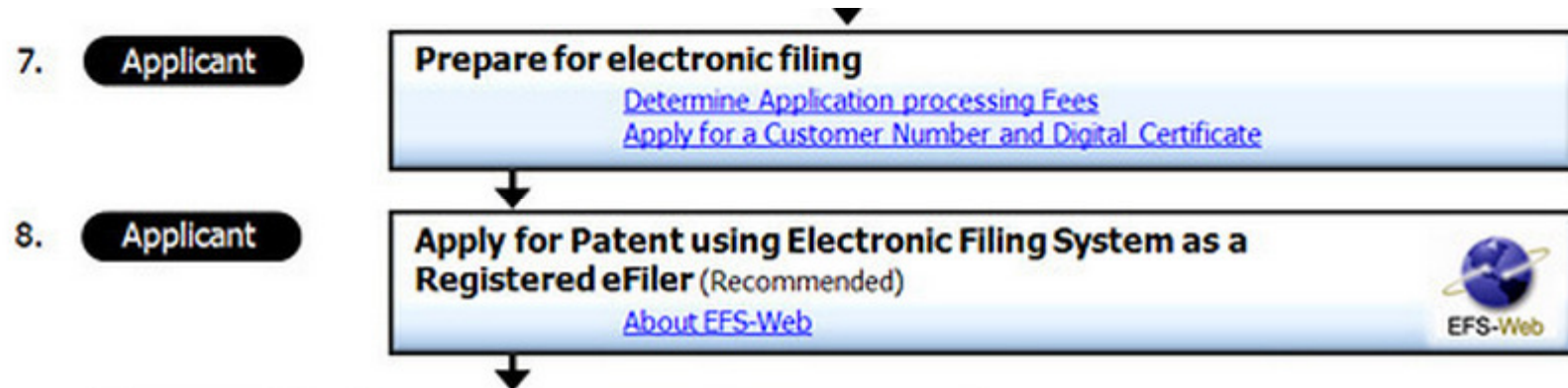


6. Applicant



Patents (cont.)

•The Patenting Process (cont.):



Patents (cont.)

•The Patenting Process (cont.):

9. **USPTO**

USPTO examines application
Check application status

Yes

Allowed?

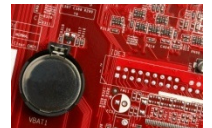
No

10. **Applicant**

Applicant files replies, requests for reconsideration, and appeals as necessary

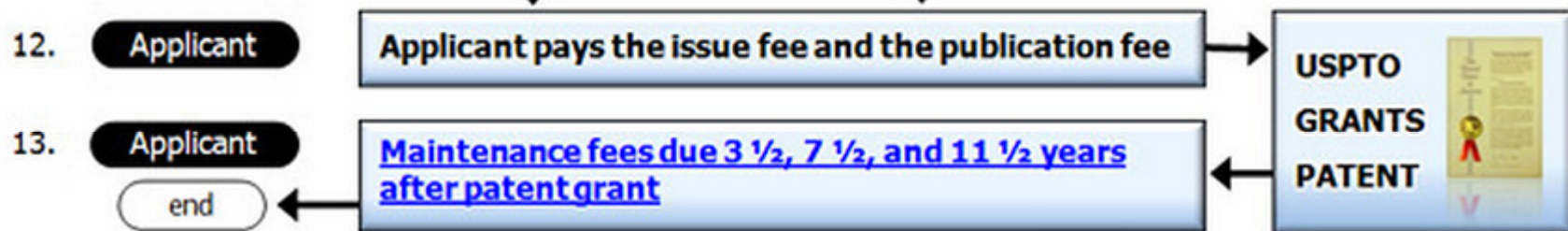
11. **USPTO**

If objections and rejection of the examiner are overcome, USPTO sends Notice of Allowance and Fee(s) due



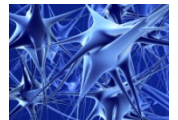
Patents (cont.)

- The Patenting Process (cont.):



- Relatively short shelf life:

- 20 years from earliest priority date.



Trade Secrets



- **A trade secret is used to protect:**
 - A formula, practice, process, design, instrument, pattern, or compilation of information (“secret sauce”), by which a business can obtain an economic advantage over competitors or customers and which is:
 - Not generally known or reasonably ascertainable (i.e., must be able to be kept secret and not easily reversed engineered).
 - In some jurisdictions, referred to as “confidential information” or “classified information”.
 - For example, the Coca Cola formula.



Trade Secrets (cont.)

- **Definition varies from jurisdiction to jurisdiction but generally is defined as information that:**
 - Is not generally known to the public (i.e., secret).
 - Confers some sort of economic benefit on its holder (benefit must derive specifically from trade secret not being generally known, not just from the value of the information itself).
 - Is the subject of reasonable efforts to maintain its secrecy.



Trade Secrets (cont.)

- **Definition varies from jurisdiction to jurisdiction but generally is defined as information that (cont.):**
 - Under US law, a trade secret, as defined under 18 U.S.C. § 1839(3) (A), (B) (1996), has three parts:
 - (1) information;
 - (2) reasonable measures taken to protect the information; and
 - (3) which derives independent economic value from not being publicly known.



Trade Secrets (cont.)

- **Protection of Trade Secrets:**

- Through non-compete agreements.
- Through non-disclosure contracts.
- Through mechanical and electrical means, safes, vaults, encryption, etc.

- **Perpetual monopoly in secret information:**

- A trade secret does not expire as would a patent.
- Lack of formal protection, does not prevent a third party from independently duplicating and using the secret information once it is discovered.



Trade Secrets (cont.)

- **In U.S. not protected by law in the same manner as trademarks or patents:**
 - Arise out of state laws.
 - Most states have adopted the Uniform Trade Secrets Act (UTSA).
 - Most significant differences between patents and trademarks and trade secrets is that a trade secret is only protected when the secret is not disclosed.



Trade Secrets (cont.)

- **How to Discover trade secrets:**

- Lawful methods:

- Reverse engineering.
 - Independent development.

- Unlawful methods:

- industrial espionage.

- Impact of method used:

- If unlawful, secret is generally deemed to have been misappropriated and legal action can be taken.



Thank you!



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The Villamar Firm is a Professional Limited Liability Company (PLLC) law firm based in Virginia with easy access to the [United States Patent and Trademark Office](#). **The Villamar Firm** specializes in the practice of Intellectual Property Law, including [patents](#), [trademarks](#), [copyrights](#), [trade secrets](#) and [computer and internet law](#).

At **The Villamar Firm** we strive to provide the best possible work product, at a competitive price, and with superior client service.

We specialize in helping high-tech companies and universities protect their Intellectual Property in a most efficient manner.

Carlos R. Villamar, J.D., M.S.E.E., B.S.E.E.

attorneys



Carlos R. Villamar is a founding partner of **The Villamar Firm**.*

Areas of Practice: Patents, Trademarks, Copyrights, Licensing.

Mr. Villamar is a patent attorney with broad experience assisting clients with foreign and domestic patent application preparation and prosecution, opinion work, litigation, and IP counseling.

*Mr. Villamar is licensed to practice US state law in Virginia and the District of Columbia.



Mr. Villamar's expertise covers a wide variety of technologies, including wired, wireless, optical, terrestrial broadcast and satellite communications, neural networks, fuzzy logic and artificial intelligence, encryption, digital signal processing, speech recognition and language understanding, sound and image processing, video processing, medical imaging, video games, on-line gaming, gaming engines, physics engines, 3D graphics, virtual worlds, Digital Rights Management, e-commerce, military technologies, radar, sonar, fighter aircraft, missiles, ground guidance, heads-up displays, computers and architectures, computer networks and security, semiconductors, device manufacturing, nanotechnology, oil and gas exploration, renewable energy, electrical, solar, thermal and wind power, automotive technologies, and electromechanical technologies.

Prior to founding **The Villamar Firm**, Carlos gained extensive experience in numerous aspects of intellectual property law as an attorney in large, national general practice and IP boutique law firms and as a patent examiner in the Speech Signal Processing Group of the [U.S. Patent Trademark Office](#).

As an electrical engineer, Mr. Villamar has over nine years of commercial experience, including production design and testing for the [Standard Missile](#) Program at the [General Dynamics Corporation](#) Missile Systems Group (purchased by [Raytheon](#)), high-speed digital logic and computer design for the [Advanced Tactical Fighter](#) Program at the [Hughes Aircraft Company](#) Radar Systems Group (purchased by Raytheon), and IR&D and design of high-speed digital signal processing and communications systems at the Hughes Aircraft Company Advanced Circuits Technology Center (purchased by Raytheon, spun off as TelASIC and then purchased by [MTI](#)).



Education: J.D., The George Washington University Law School (1998); M.S.E.E., California State University, Long Beach, emphasis in Digital Signal Processing & Neural Networks, (1992); and B.S.E.E., California State Polytechnic University, Pomona, emphasis in Digital Signal Processing, (1987).

Admitted: Virginia, the District of Columbia, the United States Supreme Court, the Court of Appeals for the Fourth Circuit, the Court of Appeals for the Federal Circuit, the Virginia Supreme Court, and the District Court for the Eastern District of Virginia. Served on the Board of Directors of the Federal Circuit Bar Association.

Carlos R. Villamar may be reached by email at cvillamar@villamars.com or by telephone at (703) 623-4122.



Barbara Villamar, S.J.D., LL.M.

attorneys



Dr. Barbara Villamar is Of Counsel to **The Villamar Firm**.*

Areas of Practice: International Business Transactions, Corporate, International Trademark Law.**

*Dr. Villamar is only licensed to practice US state law in the District of Columbia.

**Dr. Villamar's practice will be limited to Trademark Law while licensed in the District of Columbia.



Dr. Villamar is licensed to practice law in [Germany](#) and the United States and specializes in international and domestic corporate and business issues and trademark law. She is also available to serve in a liaison capacity between German and U.S. counterparts. Before joining the firm, Dr. Villamar worked on both sides of the Atlantic advising and representing clients in corporate, regulatory and transactional matters. She has broad experience guiding clients through the evaluation, negotiation and closing process of commercial arrangements, specifically pertaining to Internet service providers. She has assisted in the formation and restructuring of corporations and joint ventures, execution of domestic and cross-border transactional agreements, and formulation of internal and external corporate policies.

Dr. Barbara Villamar ist für **The Villamar Firm** als freie Mitarbeiterin tätig.*

Schwerpunkte: Internationales Handels- und Gesellschaftsrecht, Internationales Markenrecht. Dr. Villamar ist in Deutschland und in den Vereinigten Staaten als Rechtsanwältin zugelassen und konzentriert sich in ihrer Tätigkeit auf nationales und internationales Handels - und Gesellschaftsrecht und Markenrecht. Darüberhinaus steht sie als Verbindungsperson zwischen deutschen und US-amerikanischen Partnern zur Verfügung. Dr. Villamar hat sowohl in Deutschland als auch in den USA Mandanten im Unternehmensrecht beraten und vertreten. Sie hat, u.a. im Bereich der Telekommunikation tätige, Klienten während des Evaluierungs - und Verhandlungsprozesses unterstützt, z.B. bei der Gründung und Umstrukturierung von Unternehmen und Joint Ventures, im Zusammenhang mit nationalen und internationalen Handelsverträgen und bei der Formulierung von internen und externen Unternehmenspraktiken.



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