

Intellectual Property Protection for the Lab

Office of General Counsel

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Questions?

- Interrupt us at any time – or - Please email us your questions during the presentation

IPWebinar@UCAR.edu

Getting your IP house in order

- IP = Intellectual Property
- It's your work, e.g., software, designs, reports, analysis, patents, ideas, books, articles, papers, publications
- Scholarly works – you own
- The rest – UCAR owns

Government Sponsors

- The government sponsor that originally funded the work often dictates who has what IP rights
- Typically, UCAR keeps all IP rights (patents, copyrights), and the government retains royalty free right to use the IP
- UCAR cannot abrogate these rights for private industry
- Need to remember who funded you in the first place

Who benefits when we protect our IP rights?

- You, the creator/inventor
- Your lab/program
- UCAR, the owner
- The government sponsor

What are the benefits to you, your lab and UCAR?

- Ensures proper attribution
- Avoids first-to-file complications
 - Protect ability to conduct research in areas where commercial patent interest is high
- Prevents others from claiming credit for your work
- Defensive - infringement
- Prestige – Reputation
 - Increased sponsor funding

What is intellectual property?

Creations of the human mind, including inventions; literary and artistic works; designs; symbols; names and images.

U.S. law (and the laws of most other countries) grant certain exclusive rights to the owners of intellectual property.



What are the exclusive intellectual property rights?

- Patent: right to exclude others from making, using and selling the invention in the United States for a period of 20 years from the date of filing.
- Copyright: exclusive right to copy, publicly display, create derivative works and distribute granted to the creator of “a tangible expression of a creative work” (including literary works and source code).
- Trademark: phrase, word or symbol used to identify or distinguish the source of goods or services.

What is a patent?

- It's the right to exclude others from making, using or selling your invention
- Three very different kinds of patents: utility, design, and plant
- Legal requirements: novelty, non-obvious, best mode, duty of candor
- Term is 20 years from the date of filing the application

New invention – What to do

- Timing matters
 - First to file the invention – (new America Invents Act)
 - First to invent
 - Deadlines: one year from date of publication or sale
- Invention Disclosure
 - Required by sponsors
 - Notify OGC - assists and manages all IP
- Provisional Patent
- Patent Application
- Publication; public disclosure

Patent Examination & Administration

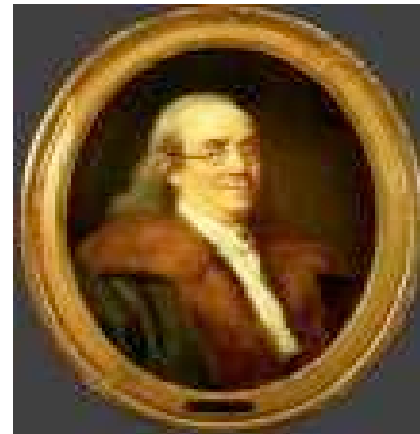
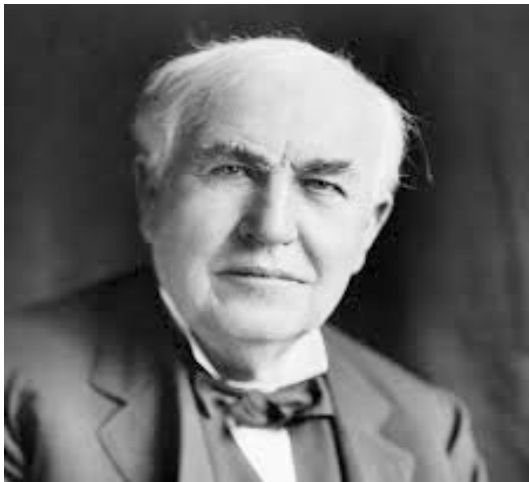
- **Prioritized Examination**
 - Disposed of within 12 months
 - \$4,300 surcharge
- **Hiring more patent examiners**
- **New Regional Patent Offices:**
 - Dallas
 - Denver !!!
 - Detroit
 - San Jose

New Patent Strategies (or not)

- Challenge existing & pending patents and patent applications
- File more patents (provisionals?)
- Publish, public disclosure
 - www.defensivpublications.org
- Private, confidential & proprietary [trade secrets]

Edison v. Franklin debate

- Both prolific inventors
- Patent v. open source/public domain



Copyright

- Protects original work that is written or otherwise recorded “in a tangible medium,” including text, presentations, photographs, artwork, software, by granting the work’s author the exclusive right to:
 - Copy
 - Publicly Display (and Perform)
 - Create derivative works
 - Distribute the work

When must you act & what must you do? – new software or literary work

- Copyright protection is automatic (unlike patent - no filing required), but . . .
 - put a copyright notice in the code and on any documentation associated with the code
 - Before publication
 - Before distribution

Copyright Strategy - Notice

- Include a Copyright notice
 - Acts as a form of attribution
 - Deters infringement
 - Avoids conclusion that work is not subject to copyright
 - Note that U.S. Government employees are not protected authors and cannot claim copyright protection (some incorrectly consider UCAR to be government entity)
- Copyright notice includes 3 elements
 - Author name, "copyright" or "©" and year of publication
 - © UCAR 2015, all rights reserved.
 - Copyright UCAR 2015
- Place notice in an "obvious" location

Copyright Strategy – Government Sponsor Considerations

- Under FAR and typical contractor relationships, Government requires contractor to grant Government ownership of newly developed software code, but...
 - NSF Cooperative Agreement permits UCAR to own copyrights in all software developed; and Government has a paid up license to all such developments. These are the terms that UCAR negotiated.

Copyright Strategy – Government Sponsor Considerations

When working with government sponsors, UCAR has included the following notice within our software code.

© *University Corporation for Atmospheric Research 2015. The Government's right to use this data and/or software (the "Work") is restricted to a **nonexclusive, nontransferable, irrevocable, royalty-free license to exercise or have exercised for or on behalf of the U.S. throughout the world all the exclusive rights provided by copyright. Such license, however, does not include the right to sell copies of the copyrighted works to the public.***

Copyright Strategy – Copy Control

- **Require Agreement before sharing**
 - Require attribution/credit
 - Provide only object code and prohibit reverse engineering
 - Require notice of code modifications
 - Retain ownership of what you create
 - Require confidentiality
 - Prohibit redistribution
 - Notify government sponsor regarding pre-existing material not first produced under the contract
- **Consider location and reputation of user before sharing**

Copyright Strategy – When your software includes Third Party Code

- Pay attention to all terms and comply
 - Placement of copyright notices on copies
 - Required notice if software is modified
 - Attribution to the author
 - Disclaimers of liabilities
 - Limitations of damages
 - Requirement that all subsequent versions both source and object code be “free” or limited distribution charge

Trademark

- A trademark is a word, phrase, symbol, or design, or a combination of these that identifies and distinguishes the source of goods of one party from those of others.

CHOBANI®



The COMET® Program



Pikalert®

- Protection continues indefinitely unless mark abandoned or becomes a generic term

Trademark

- A trademark functions in the commercial context:
 - to identify its source, and
 - thereby assure a certain degree of quality, and
 - create good will and brand recognition
- A trademark can be (and has been) used by UCAR in a similar manner

When must you act & what must you do? – product identifier

- Determine whether you want/need a trademark
- Do you want users to know where the “product” came from (without looking at the © in the source code)?
- Sophisticated users and collaborators will see the copyright notice
- Are you concerned that others may call their product by a similar name in an effort to “steal” the goodwill (credit)?
- Work with OGC to select a mark (word, phrase or symbol) that can be registered and protected

Trademark Strategy

- marks (words, phrases or symbols) that can be registered and protected
 - Best: fanciful (JEEP) or arbitrary (Yoplait) and nondescriptive
 - No protection for descriptive marks unless and until they acquire secondary meaning as applied to the owner's product (American Airlines)
 - Suggestive marks are acceptable but harder to obtain because may be considered descriptive (WeatherIntell) and difficult to enforce
 - No protection for generic nouns (table, computer, system)
 - Avoid acronyms if you want protection

Trademark Strategy

- OGC will clear the mark to avoid identical or confusingly similar use, particularly with similar goods/services
 - Perform USPTO search
 - Perform internet search
- OGC will register the mark at the federal level
 - In the United States, a mark must be in use before it can mature into a registration
 - Common law provides a non-registered trademark user with limited local protection, but this should not be relied upon by UCAR
 - A party can register a mark at either the state or the federal level, but a federal registration carries the presumption of nationwide rights

Trademark Strategy

- Maintain the mark's distinctiveness
 - Ensure your own proper use
 - Unless used properly, the mark will no longer be an adjective identifying an object from a particular source. Rather, it becomes a generic noun.
 - See UCAR Trademark Guidelines
 - Include registration symbol with mark
 - Use mark as an adjective to describe a noun
 - Distinguish the mark from surrounding text
 - Include the mark on the product

Trademark Strategy

- Do not permit others to use improperly
 - When others are allowed to use a mark without restriction and the quality of goods provided under the mark is not controlled, the mark loses its source-identifying function and results in the loss of trademark rights through abandonment.
 - Kleenex tissue is now known as kleenex. Xerox almost lost its mark when people began to routinely refer to copies as Xeroxes. Google internet searching is in danger of becoming “Googling,” no matter the browser.
 - Consider whether abandonment likely and whether trademark is valuable in the short term anyway.

Questions

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