



Tech
Law
Garden

Intellectual Property for Engineers and Scientists

(Stuff I wish my clients knew before they called)

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Tennille Christensen, Esq. - History

- Analyst and engineer for a few years at several start-ups
- Became a US patent agent (Note for engineers and scientists)
- Became too nerdy about open source software, and eventually went to law school, focused on IP law and FOSS
- Large law firms 2003-2010, my own law firm since 2010
- Work w/independent inventors, creators, and start-ups
- Typical client is post seed/incubator/venture capital investment, between 1 – 200 employees
- Advice, counseling, negotiation, contract drafting
- I don't litigate or go to court – My job is to minimize the chance that my clients will get sued.

Intellectual Property Law Is Based on REAL Property Law



- Property rights allow you to exclude people from accessing your property.
- Property rights allow you to condition access to your property (No shirt, No shoes, No service; Paying Customers Only)

4 Main Types of Intellectual Property

- Patents – inventions you disclose to the public in exchange for a limited term monopoly.
- Trade Secrets – commercially valuable information you keep secret.
- Copyrights – *expressions* of ideas fixed in a form that can be reproduced.
- Trademarks – words or logos designating the origin or maker of goods/services.

Patents – A Property Right

- Patents are based in property law.
- Just like owning property allows you to put up a fence and prohibit others from accessing your property, a patent allows the patent holder to prohibit *anyone* from practicing the patent claims.
- Patents are granted by countries, application contains description of the invention, drawings, and claims.

35 USC §271

Patent Infringement

Except as otherwise provided in this title, whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefor, infringes the patent.

In the case of software, a license, offer to license, or distribution of software that infringes a patent while it is running is held to be an “offer to sell”

Who Holds the Patent Rights?

- It is common to hear named inventors listed on patents say things like, “I have 10 patents” or “I have a patent on that”.
- The patent holder is ***ONLY*** the inventor if there was not a patent assignment.
- In technology companies and at Universities, it is usually a condition of employment that inventors ***MUST*** assign their patents to their employers if the patent is related to the business of the employer.
- So, even if you are a named inventor on a patent, the patent holder is most likely your employer at the time you created the invention, not you.

Patent Infringement is Strict Liability

- Intent does not matter (criminal examples: statutory rape, possession crimes, failure to pay taxes)
- Patent infringement is a strict-liability offense because the defendant's state of mind is irrelevant to the analysis, which involves only comparing the claims and the accused product.
- An infringer's state of mind is only used when determining the remedies.
- Independent development is not a defense
- Not knowing of the existence of the infringed patent is not a defense

Trade Secrets – Protection by Secrecy

- Classic examples – coca cola formula; discounts and pricing given to key customers; unpatented inventions kept secret.
- Must have value that allows you to have some sort of commercial advantage.
- Non-disclosure Agreements (NDA, CDA, etc.) required if you disclose to third parties and still want to keep it a secret.
- Misappropriation of Trade Secrets is the legal cause of action.

Copyright

- In the US and under most countries' laws, copyright vests in the creator of a work of original authorship immediately upon creation of the work.
- Under the work-for-hire doctrine, copyrighted works created by employees doing paid work immediately vest copyright in the employer.
- Copyright does not protect *Ideas*
- Copyright protects specific expressions of ideas
- An Example: A poem about a particular topic (e.g. Dickinson, Shelly, Neruda, Bronte, etc. on Death)

Practically Everything Ever Written (or produced) By Anyone is Copyrighted

No application or governmental registration required – automatic protection

Blog posts

Emails

User Manuals

Videos/Films

Music

Software (Video games)

Sculptures/Photographs

TAKE HOME: Don't use stuff written or produced by others without their written permission (permission = email, FOSS/commercial license)

Exclusive Copyright Rights

17 USC § 106 (similar in all 168 Berne countries)

- (1) to reproduce the copyrighted work in copies or phonorecords;
- (2) to prepare derivative works based upon the copyrighted work;
- (3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending;
- (4) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly;
- (5) 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, to display the copyrighted work publicly; and
- (6) in the case of sound recordings, to perform the copyrighted work publicly by means of a digital audio transmission.

FAIR USE

- It's an area of much litigation right now. It's a defense, which means it's a fight, it's not automatic or easy to rely upon.
- the purpose and character of your use (education, political commentary, news = likely; commercial use = less likely)
- the nature of the copyrighted work.
- the amount and substantiality of the portion taken, and.
- the effect of the use upon the potential market.

What is a Trademark?

An intellectual property right used to protect words

- Names (slogans)
- Symbols (logos)
- Sounds
- Colors

that distinguish goods (and/or services) from those manufactured or sold by others and to indicate the source of the goods (or services).

- Common Law rights [™] or Registered rights [®]

Best Practices

Keep doing what you already do – honest, hard, independent work

Respect Non-Disclosure Agreements

Read your contracts and understand what work you can own, can use, etc. (Note: the default with most employers is nothing.)

Unless you get explicit permission from your employer (or client):

- Don't take work you do from one employer/client to another one (or use it to start your own business)
- Don't plagiarize anything
- Don't independently search and read third party patents in the course of developing technology (willful infringement vs. unknowing infringement)
- Don't email theories about third party intellectual property. (A note about litigation and discovery – every work email you write may be read by lawyers some day.)



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Questions?

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