

Intellectual Property: Ideas Worth Protecting

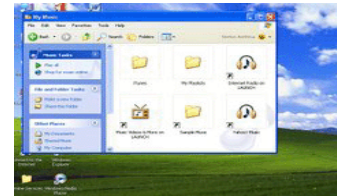
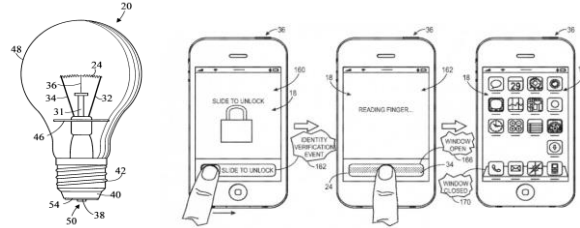
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Agenda

- Introduction to Intellectual Property
- Patents
 - What Is a Patent
 - How to Get a Patent
- Considerations in Government Contracting

Intellectual Property Categories

- Patents: protect new and useful ideas
- Trademarks: protect names of goods or services; source identifiers for goods or services
- Copyrights: protect expressions formed in tangible media
 - Expression not subject matter
 - Created in fixed medium

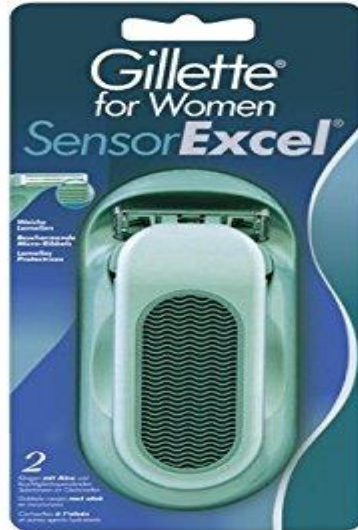


Intellectual Property Categories

- Trade secrets
 - Protect information not known by the public
 - Proprietary, used in business, commercially valuable
- Technical data and computer software
 - Technical data is data of a scientific or technical nature (e.g., recorded test data, documentation)
 - Computer software is the executable, object, or source code that causes computer to act

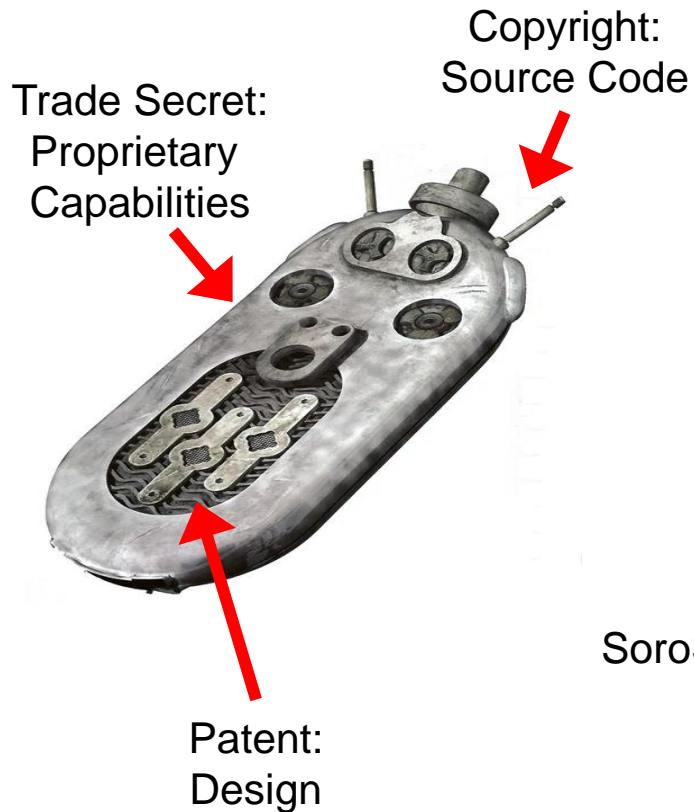


Prior Art



Gillette for Women SensorExcel

Improved Device



SoroSuub Corporation Hush-98 Comlink

Trademark:
Name

Trademark:
Name

Patents

- Protect new and useful ideas (machine, process, article of manufacture, composition of matter)

The Congress shall have Power... To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries;

———— (Article I, Section 8 of the Constitution) ————

- Right to exclude others from making, using, selling, or importing the claimed invention
 - You can shut others down; except the government
 - But not a right to use

Two Types of Patents

Utility Patents

- Protects structure and function
 - Software, vehicles, weapons, satellites
 - Expires 20 years from filing date
 - Provisional application
 - One year to file nonprovisional application (note: compare to government-funded)
 - Not examined by USPTO
 - Not publicly available
 - Can include changes in nonprovisional application
 - Nonprovisional application
 - No changes permitted
 - Eventually examined
 - May become publicly available

Design Patents

- Protects ornamental features of a product
 - User interfaces, appearance of functional products
 - No provisional applications
 - Expires 14 years from date of patent grant

Examples of Issued Patents

So the patent must be new and useful, but as the next few slides demonstrate, "usefulness" is a term of art...

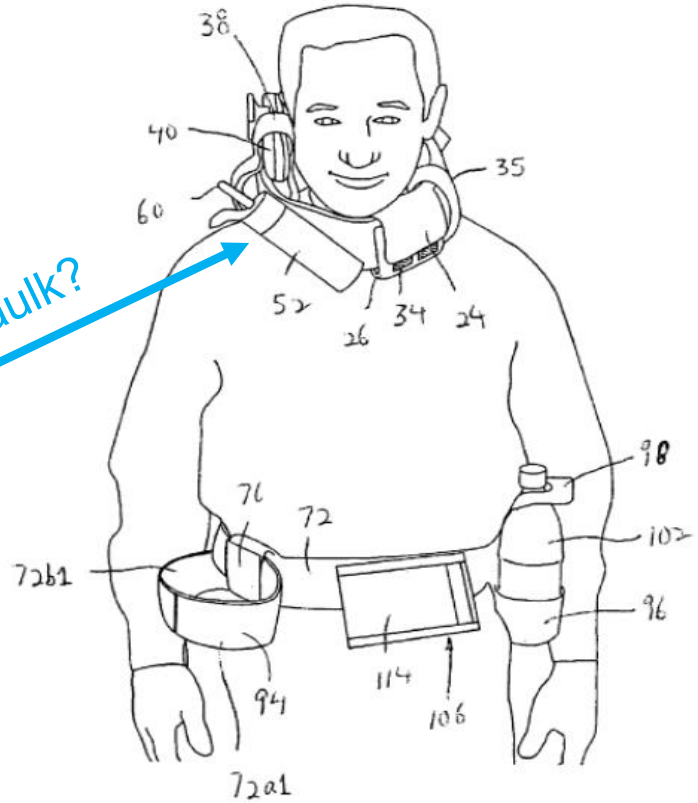
Neck Wrap for Holding Items

US Patent No. 6,929,164

- A belt for your neck to hold your cell phone and other items; it even has a speaker phone built into belt

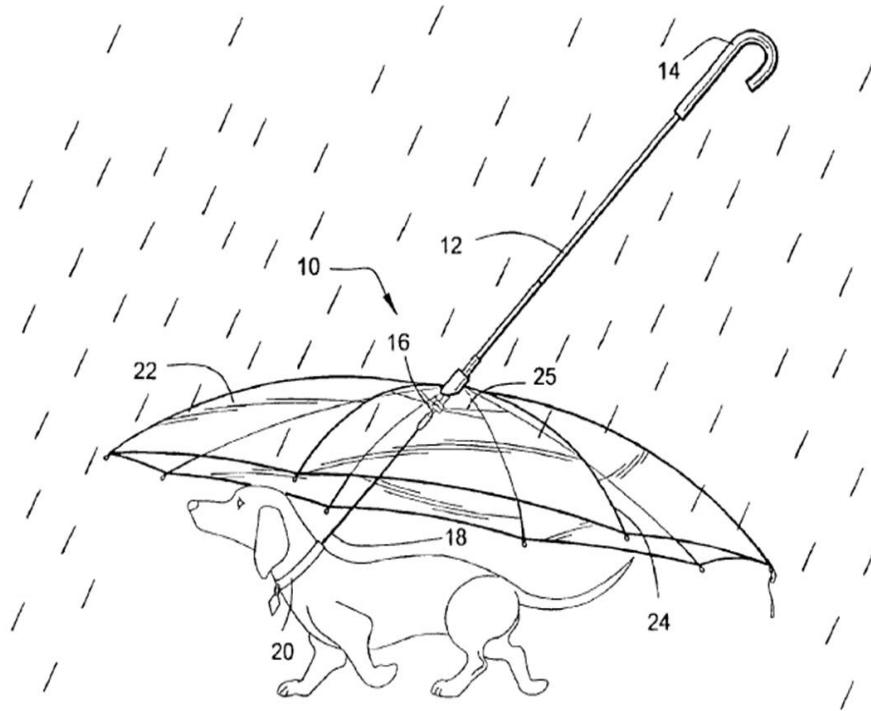


Caulk?



Pet Umbrella

US Patent No. 6,871,616



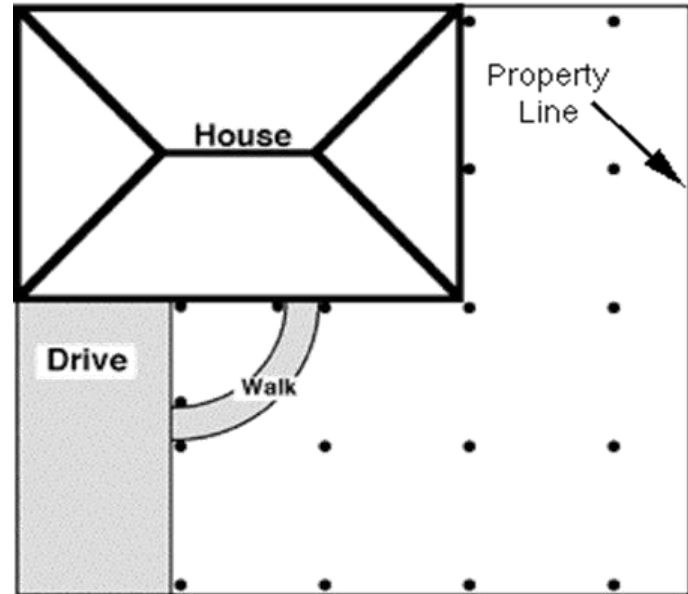
Surface Pattern Applied to Doughnut Pastry

US Patent No. D458,003



Claim Scope Strategy

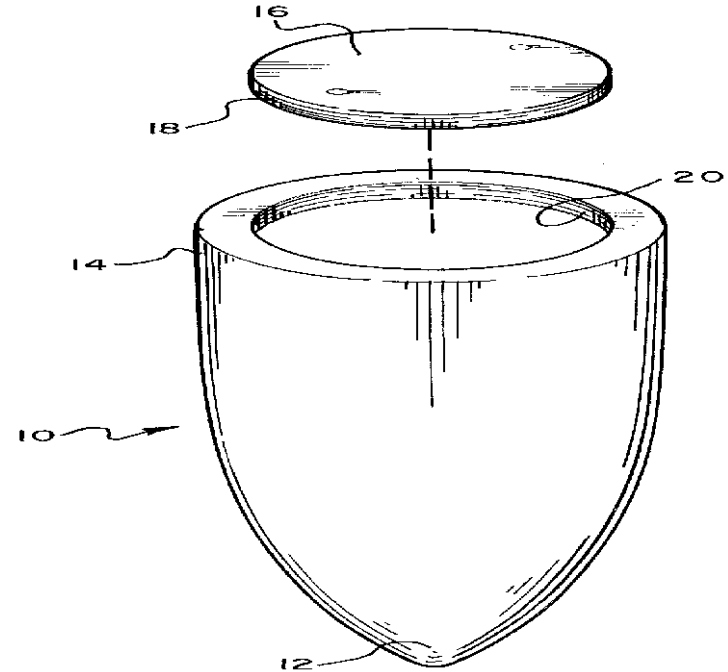
- Harder to define intellectual property than real property
- Broad enough to capture infringers and variations on the invention
- Narrow enough to avoid prior art



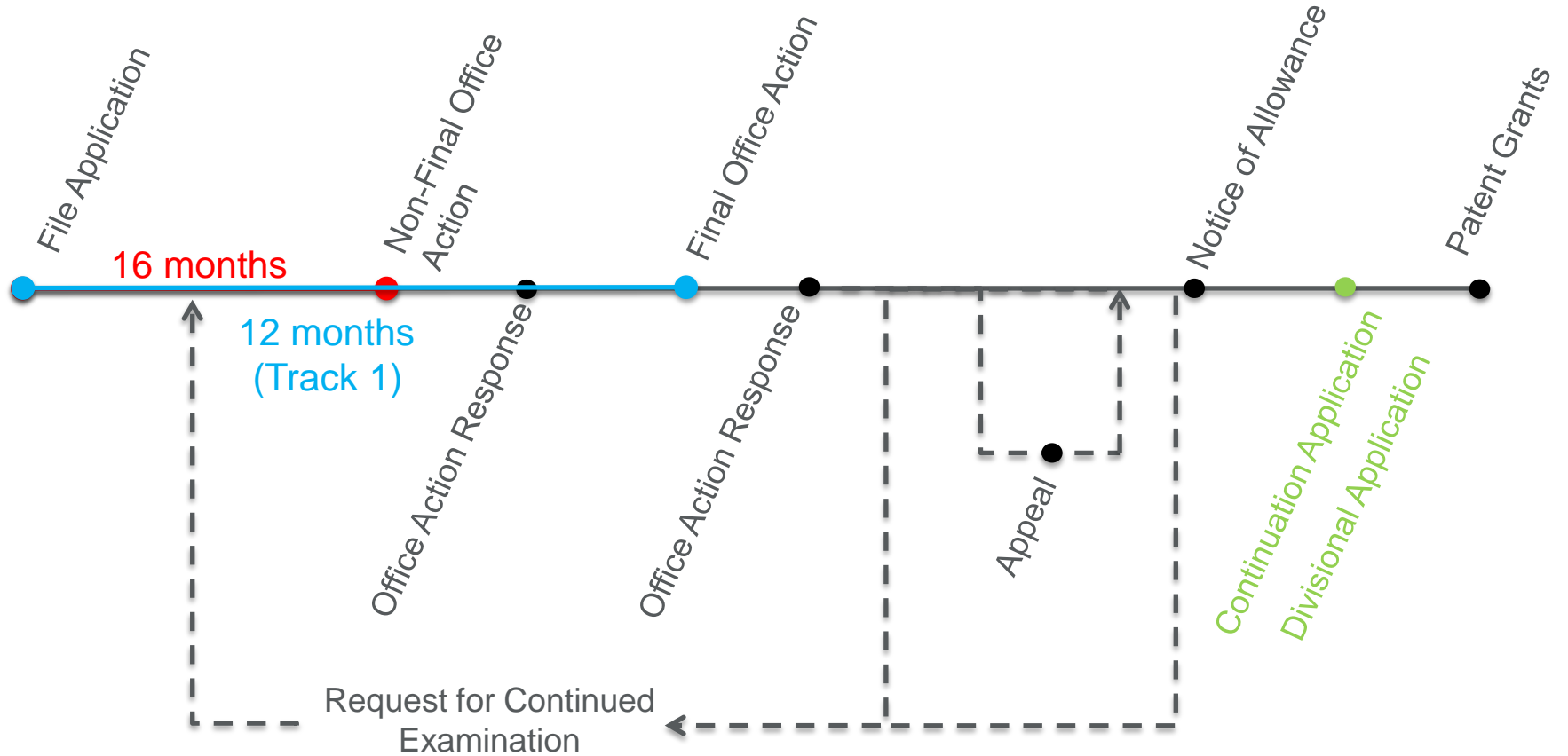
Claim Scope Strategy

U.S. Patent No. 6,846,967

1. A method for disposing of nuclear waste comprising the steps of:
 - loading nuclear waste into a container;
 - locating an undersea volcano where the volcano is pouring lava along the sea bed;
 - placing said container onto the sea bed in the path of the lava, wherein said lava flows over said container.



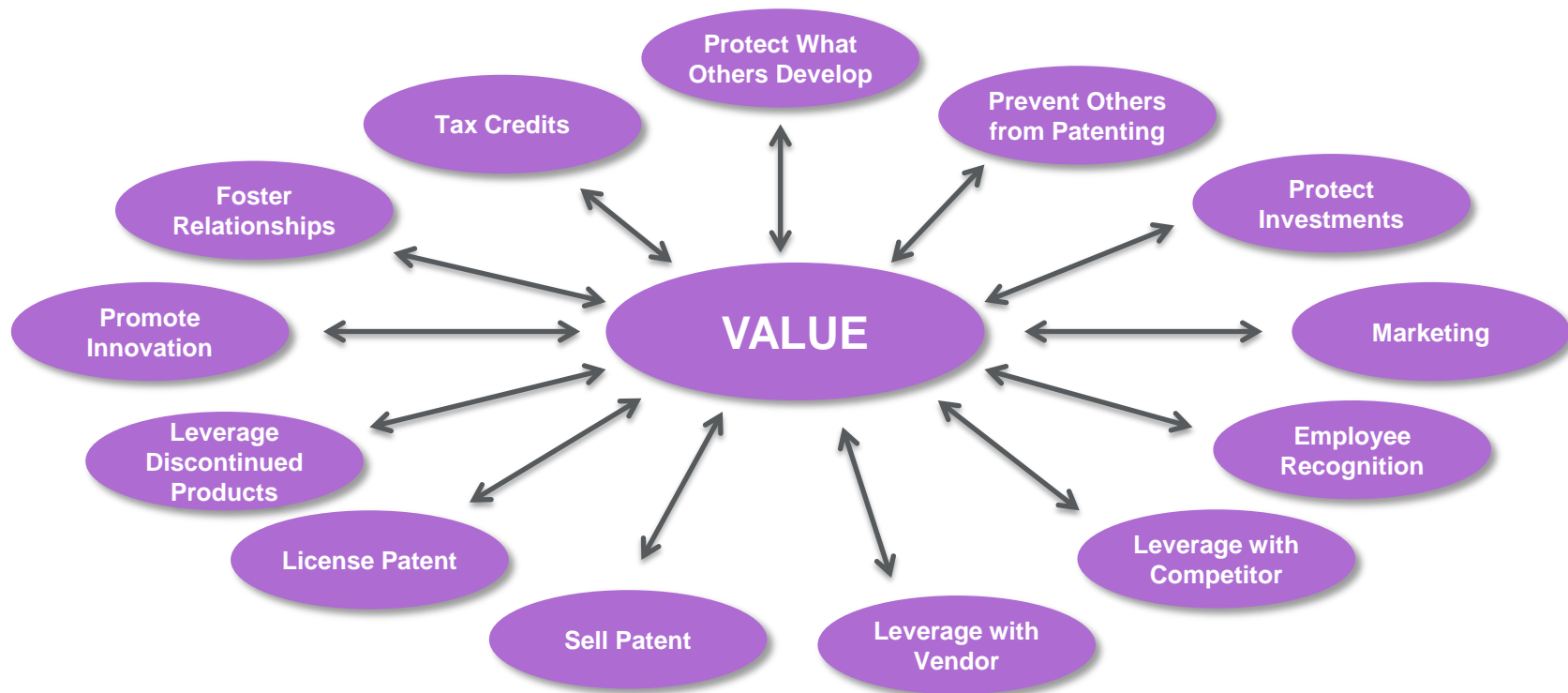
Prosecution Timeline



Hurdles to Obtaining a Patent

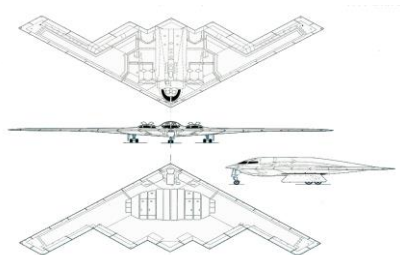
- Patent eligibility (35 U.S.C. § 101)
 - Is this a business method that is not necessarily required to be performed in a computing environment?
 - Is this invention the same as the inventor's earlier invention?
- Novelty (35 U.S.C. § 102)
 - Is there any prior art showing this same invention?
- Nonobviousness (35 U.S.C. § 103)
 - Is this invention an obvious improvement over a previous system/method?
 - Could more than one previous system/method be combined to form this invention?
- Written description (35 U.S.C. § 112)
 - Does the application sufficiently describe how to make this invention?

Leveraging Intellectual Property to Create Value



Government's Rights in Your Patent

- Government retains title in "subject inventions" that are "conceived" or "reduced to practice" in performance of work under a government contract
 - Must be actual reduction to practice in the performance of work under a government contract
 - Small businesses are afforded more protections



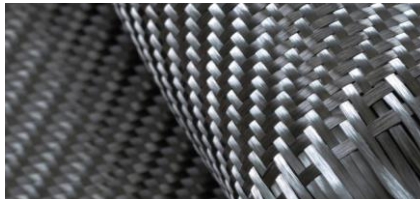
- Many agencies typically just want a broad license, not ownership; generally a nonexclusive, nontransferable, irrevocable, paid-up license to practice or have practiced for, or on behalf of the government, throughout the world

Take Action or Risk Losing Your Patent Rights

- Contractors must elect to retain title to subject inventions
 - Disclose invention to government within 2 months after inventor discloses invention to contractor personnel responsible for patent matters
 - Elect to retain title within a period of time from disclosure to agency
 - Typically within 2 years
 - Check FAR and supplements for very specific reporting obligations
 - File patent application within 1 year after election or 10 months after filing provisional application
- Contractors may forfeit their rights if they fail to timely disclose invention, elect to retain title or pursue patent protection

Government Can Take Your Patent Rights

- March in rights
 - Though rarely used, government may require a contractor to license
 - If contractor failed to take steps for practical application
 - To alleviate health or safety concerns
 - To meet requirements for public use
 - To meet domestic production preference
- Government may allow others to use inventions (28 U.S.C. § 1498(a))
 - Significant limitation on right to exclude third parties
 - Compensation is exclusive remedy in COFC
 - No injunction
 - Generally cannot prevent use of patent



Questions?