

Intellectual Property Misconceptions Debunked

October 31, 2017

by David E. Rogers

Many people have misperceptions about what intellectual property (IP) protects, and some common IP misconceptions are debunked below.

(1) Ideas Cannot Be Patented.

Only inventions can be patented. The legal difference between an invention and an idea is “conception.” Conception means that an idea is developed fully enough to teach another skilled in the art to which the invention pertains how to *make and use* the invention.

(2) A Patent Cannot Infringe Another Patent.

A patent or disclosure cannot infringe another patent. Only a machine, article of manufacture, composition of matter, or process can infringe a patent.

(3) Owning a U.S. Patent Does Not Give You the Right to Make, Sell, Offer to Sell, Use, or Import the Patented Invention.

Some believe that a patent grants the right to practice a patented invention free from infringing others’ patents. It does not. A patent grants the owner the right to *exclude* others from making, using, offering to sell, selling, or importing, the patented invention. It does not grant rights to practice the patented invention. A patented invention may *still infringe* another, earlier patent.

(4) Patent and Trademark Rights Are Not Worldwide.

Patent rights are granted on a per-country basis. A United States patent provides protection only in the United States and its territories. International patent protection is also available on a country-by-country basis. Even if you file for and obtain a regional patent, such as a European patent granted by the European Patent Office, which can potentially cover as many as 38 European countries, the European patent must, for a separate fees, be registered and maintained in each country in which you desire patent protection.¹ A Eurasian Patent, which is governed by the Eurasian Patent Organization and includes eleven former Soviet states, functions in the same manner as a European patent.

Trademark rights are also granted on a per-country basis. Exceptions are: (1) an EUTM registration, which covers over 30 European countries, and (2) a Benelux registration, which covers Belgium, Luxemburg, and the Netherlands.

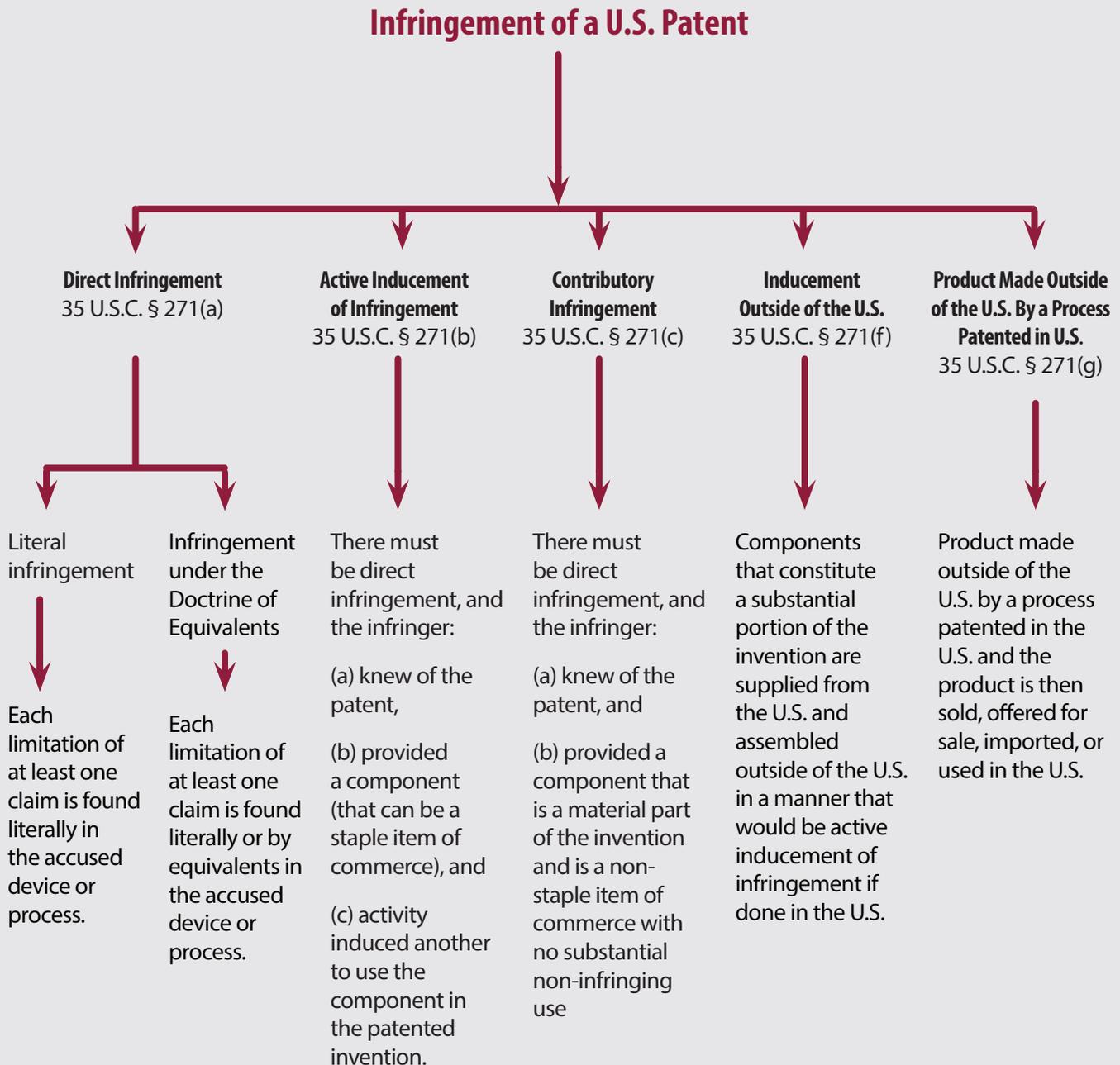
(5) Not Everyone Who Works on an Invention Is Necessarily an Inventor.

In the United States an inventor of a patent is someone who conceived part of the subject matter of at least one claim of the patent. An inventor is not one who merely contributed to reducing the invention to practice, wrote software code, performed experiments, or worked to prove the efficacy of the invention.

¹ The EU is considering a “unitary patent” that would automatically be enforceable in all EU member countries upon grant.

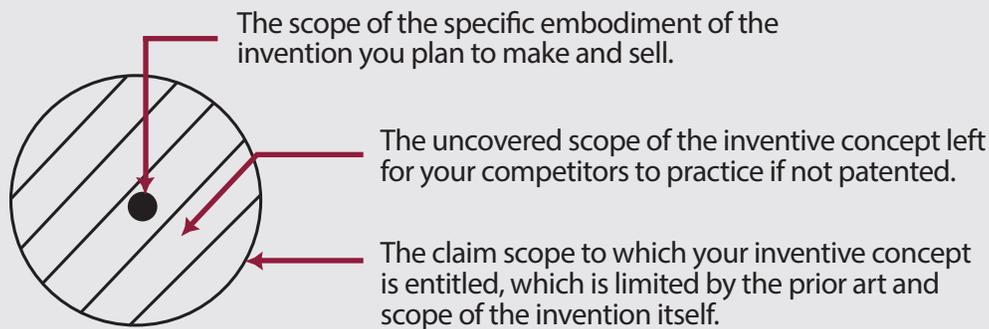
(6) There Are Several Types of Patent Infringement.

Many think that patent infringement occurs only when another uses, imports, makes, sells, or offers to sell an invention claimed in a patent. There are actually several types of infringement (shown below) designed to stop the others from taking the benefit of patented invention.



(7) A Patent Should Not Cover Only the Exact Product a Business Plans to Provide.

The importance of broad patent claim scope to carve out a large technology sector in which you have exclusive rights cannot be stressed enough. Do not leave patent scope (i.e., the scope of your exclusive technology sector) on the table for competitors to practice and circumvent your patent(s). This usually happens when patent scope is limited to the specific embodiment of the invention conceived by the inventor, rather than expanding the scope to encompass as much of the inventive concept as possible, in order to block design-around products.



(8) Provisional Patent Applications Should Not Be Sketchy and Cheap.

If you use a provisional application as an “inexpensive” alternative to a U.S. utility application and include only a brief, sketchy description of the invention without a complete set of drawings, and do not include claims or specific examples/statements of the invention, it may not provide adequate support for later-filed U.S. utility applications or foreign applications.

(9) There Is No Such Thing As a “Poor Man’s Patent.”

There are two definitions of a “poor man’s patent.” The first is when you draft a letter defining your invention, seal it in an envelope, and mail it to yourself by certified or registered mail. The belief is that if you keep the sealed envelope you can prove the date on which your invention was conceived. Even if correct, irrelevant. First, rights to inventions (with some narrow exceptions) are granted to the first-to-file for patent protection. Second, a mailing to yourself is not prior art against another’s patent – it is a secretive disclosure *suppressed* or *concealed* by you.

The second is filing an inexpensive, sketchy provisional patent application. The problems with that are discussed in the preceding section. Plus, a provisional patent application never matures into a patent.

(10) If Something Is Developed for You or Your Business, You Do Not Necessarily Own It.

The general rule is that she/he who invents owns. Exceptions to the general rule are when: (a) a contract between the parties specifies who owns inventions; (b) the employee/contractor was expressly hired to invent; or (c) the employee/contractor owed a fiduciary duty to assign inventions to you. Employee/contractor contracts should include provisions to: (a) assign rights in new inventions related to your business or project to you; (b) require a written disclosure to you of any new invention upon its conception; and (c) require the employee/contractor to assist, for no further remuneration, in securing intellectual property rights in your favor.

(11) You do Not Need a Prototype Before Filing for Patent Protection.

The United States patent system awards patent rights to the first to file for patent protection. File as soon as an invention is conceived in sufficient detail to teach others how to make and use it. Making a prototype of the invention before filing a patent application is unnecessary, and waiting until a prototype is developed will delay filing for protection.

If you develop improvements after filing a patent application, such as when developing a prototype, you can file other applications if warranted. Or, the improvements could possibly be protected as trade secrets.

(12) Owning IP Does Not Automatically Prevent Infringement of Your Rights.

Without an underlying patent, trademark, copyright, or trade secret, you likely have no rights to enforce. But, the existence of a patent, trademark, copyright, or trade secret, cannot by itself stop infringers. You must still enforce your rights, which may escalate to filing a lawsuit.

(13) Using a Trademark or Service Mark on a Business Card or Website May Not Support a Federal Trademark or Service Mark Registration.

The United States Patent and Trademark Office (“USPTO”) requires the following to receive a federal registration: (a) Trademark Registration. Unless impractical, the mark must be placed on the goods or packaging in which the goods are contained for provision in interstate commerce. (b) Service Mark Registration. The mark must be used on advertising or invoices related to providing the services in interstate commerce.

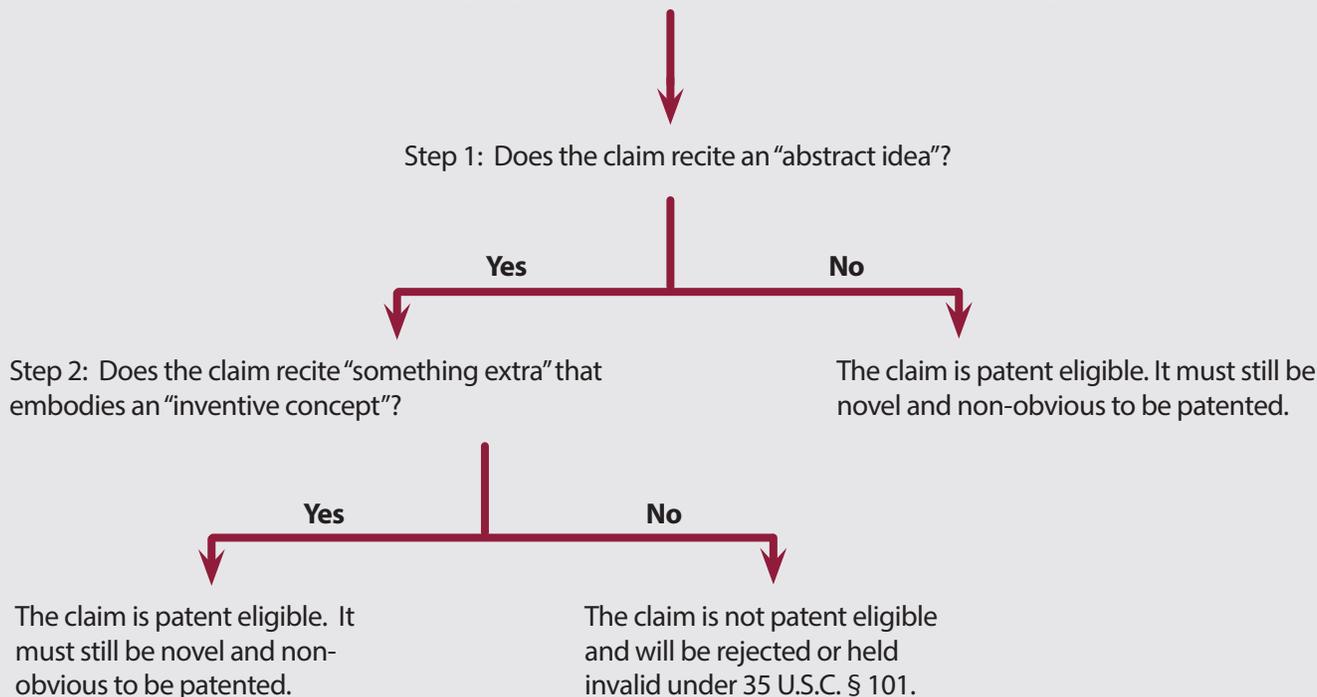
If products or services are not yet being offered in interstate commerce, websites or business cards that include the mark will not support a trademark or service mark registration.

(14) Software Processes Can Be Patented.

Under *Alice Corp. v. CLS Bank International*, 134 S. Ct. 2347 (2014) analyzing a claimed process implemented on a computer involves two steps. In step one, the claim language is interpreted to find if it is directed to an “abstract idea,” such as an algorithm, method of computation, or other general principle. If the answer is “no,” then the claim is patent eligible and you do not go to step two. If the answer is “yes,” you go to step two. In step two the claim is interpreted to find if it recites “something extra” that embodies an “inventive

concept.” The “something extra” could be a new and non-obvious process step (such as one that transforms data in a unique way), an improvement to the functionality of software or hardware, or a different type of hardware. The analysis is represented in the following chart:

Review Claim Language to Determine if the Invention Is Patent Eligible



(15) A Trademark Need Not Be Registered Before Being Used.

A trademark or service mark registration is not required before using a mark, but you should conduct a search before using a mark to avoid conflict with a pre-existing mark. Also, it is best to quickly file an application for federal registration because federal registration provides the strongest protection.

(16) Notice of IP Rights Is Not Required For Someone to Infringe.

Notice of IP rights is not required for infringement to be found, but notice may help enhance the available monetary damages. For patents and trademarks, marking provides constructive notice and enables you to obtain damages *from the date the infringement began* even if the infringer had no actual notice of your rights. 15 U.S.C. § 1111; 35 U.S.C. § 287. For copyrights, notice prevents an infringer from contending the infringement was innocent. 17 U.S.C. § 401. It is also a violation to remove a copyright notice with intent to “induce, enable, facilitate, or conceal” an infringement.

(17) Not All Negative Comments Can Be Removed from Blogs.

Most factually-incorrect information and some personal information, such as personal health information, can be removed from Internet blogs. General disparaging remarks and opinions, and publicly-

available information, cannot be removed, and an attempt to do so can magnify an inconsequential slight on a blog into a monster. This is sometimes called the “Streisand” effect because of the adverse effect Barbara Streisand caused when she sued to remove an aerial photograph of her Malibu, California home from an Internet photo blog.

Before her lawsuit was filed, the photo had been downloaded only six times, and two of those downloads were by Ms. Streisand’s attorneys. Because of the press surrounding the lawsuit, the photo received extensive publicity. More than 420,000 people reviewed the photo over the following month. The lawsuit was ultimately dismissed and Ms. Streisand was ordered to pay her opponent’s legal fees of \$155,567.

(18) The Same Device Can Be Protected By Utilitarian (or Functional) and Non-Utilitarian (or Esthetic) Intellectual Property.

The same device can be protected by a: (a) utility patent, and (b) design patent, trademark, and/or copyright. For example, the inner mechanisms of a clock could be protected by a utility patent and the exterior appearance could be protected by a design patent. If supported by the facts, the same exterior appearance may be protected by a trademark and/or copyright.

(19) Trade Dress Is a Type of Trademark or Service Mark.

Trade dress is not a separate category of intellectual property – it functions as either a trademark or service mark, and consists of a combination of elements, such as letters, words, size, shape, color, arrangement, and texture. Trade dress may be used to protect many things, including the design or configuration of: (1) a product, such as a lawn mower or clothing; (2) the labeling or packaging of a product; (3) the décor or environment in which services, such as restaurant services or the arrangement of displaying wine bottles in a store, are provided; and (4) website designs.

(20) Marks Need Not Be Identical to Conflict.

A common misconception about trademarks is that a junior mark must be identical to a senior mark to create a conflict, and that changing a letter, or adding or deleting a word, from the junior mark can avoid conflict. The law does not allow a trademark owner’s rights to be so easily circumvented and employs a *likelihood of confusion* test to determine whether there is a conflict. As examples, “Somy” for electronics would likely be found to conflict with “Sony;” “Shevy” for automobiles would likely be found to conflict with “Chevy;” and “Google Squared” for internet searching software would likely be found to conflict with “Google.”



David E. Rogers
602.382.6225
drogers@swlaw.com

Dave Rogers is a registered patent attorney with over 20 years of experience. He practices patent, trademark, trade secret and unfair competition law, including: litigation and arbitration; trademark oppositions, cancellations and domain name disputes; preparing manufacturing and technology contracts; and patent and trademark preparation and prosecution.