



# Intellectual Property

## Class 2

# Intellectual Property (IP)

- Reading for this Class
  - Introduction to IP
  - Governing Law, Courts, and Agencies
  - Jurisdiction and Venue in Cases of Intellectual Property and Remedies Available
- Assignment #1 Posted

# Federal Court

- Patent cases
  - District Court
    - Appeal → Federal Circuit
  - Administrative → USPTO (PTAB, etc.)
    - Appeal D.C. District and/or Federal Circuit
- Copyright
  - District Court
  - Appeal → Local Circuit Court
- Trademark
  - State or Federal
  - Appeal → Local State / Circuit

# USPTO

- United States Patent & Trademark Office (Abbr. as USPTO)
  - Tells you the procedures to go through in order to get a patent;
  - Examines patent applications to see if they were done correctly;
  - Determines whether particular patents should be granted or not.
  - MPEP and TMEP

USPTO's website: [www.uspto.gov](http://www.uspto.gov)

*USPTO will grant a patent...*

*but that office does not enforce patents*

*- go to Federal Court for that.*

# USPTO.gov

**uspto.GOV**  
The United States Patent and Trademark Office  
an agency of the Department of Commerce

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### Independent Inventors Conference Coming September 14-15

Are you an innovator? If so, come learn from USPTO officials, IP professionals, and successful inventors in the Lone Star State. The next regional independent inventors conference is heading to Austin, Texas.



TEXAS Regional  
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#### America Invents Act

Your guide >>

#### >> patents

#### >> trademarks

#### >> ip law & policy

#### USPTO Track One

Prioritized patent examination



#### IP Awareness



#### POPULAR LINKS

- Patent Search
- Patents: File Online [EFS-Web]
- Patents: Check Application Status [PAIR]
- Patents Online Services

#### USPTO NEWS

U.S. Patent and Trademark Office Seeks Comment on Proposed Fee Schedule as Mandated by America Invents Act

<http://www.uspto.gov/forms/index.jsp>

PTO/SB/81 (01-09)  
Approved for use through 11/02/2011. OMB 0651-0036  
U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

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<b>POWER OF ATTORNEY OR REVOCATION OF POWER OF ATTORNEY WITH A NEW POWER OF ATTORNEY AND CHANGE OF CORRESPONDENCE ADDRESS</b>	<b>Application Number</b>	
	<b>Filing Date</b>	
	<b>First Named Inventor</b>	
	<b>Title</b>	
	<b>Art Unit</b>	
	<b>Examiner Name</b>	
	<b>Attorney Docket Number</b>	

I hereby revoke all previous powers of attorney given in the above-identified application.

☐ A Power of Attorney is submitted herewith.

**OR**

☐ I hereby appoint Practitioner(s) associated with the following Customer Number as my/our attorney(s) or agent(s) to prosecute the application identified above, and to transact all business in the United States Patent and Trademark Office connected therewith:

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Please recognize or change the correspondence address for the above-identified application to:

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I am the:

☐ Applicant/Inventor.

**OR**

☐ Assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) (Form PTO/SB/96) submitted herewith or filed on \_\_\_\_\_.

**SIGNATURE of Applicant or Assignee of Record**

Signature	Date
Name	Telephone
Title and Company	

**NOTE:** Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

☐ Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 37 CFR 1.31, 1.32 and 1.33. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 3 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



# Trademark Forms

- <http://www.uspto.gov/trademarks-application-process/filing-online/index-all-teas-forms>
- TEAS  
(Trademark Electronic Application System)
- Madrid Protocol

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3. A record from this system of records may be disclosed in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
4. A record in this system of records may be disclosed to a member of Congress or to a congressional staff member in response to an inquiry of the Congressional office made at the written request of the constituent about whom the record is maintained.
5. A record in this system of records may be disclosed to the Office of Management and Budget in connection with the review of private relief legislation (as set forth in OMB Circular No. A-19) at any stage of the legislative coordination and clearance process as described in the Circular.
6. A record in this system of records may be disclosed to the Department of Justice to determine whether disclosure is required by the Freedom of Information Act (FOIA).
7. The information may be disclosed to the agency contractors, grantees, experts, consultants, or volunteers who have been engaged by the agency to assist in the performance of a service related to this system of records and who have need to have access to the records in order to perform the activity. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 USC 552a(m).
8. The information may be disclosed to the Office of Personnel Management (OPM) for personnel research purposes as a data source for management information, for the production of summary descriptive statistics and analytical studies in support of the function for which the records are collected and maintained, or for related man-power studies.

# U.S. Copyright Office

- NOT an administrative agency. Creates and sustains an effective national © system, which ultimately promotes creativity.
- Part of Library of Congress
- 3 main functions
  - Reviews every © submission to determine whether it's eligible for © protection;
  - Provides information to the public regarding copyrighted works;
  - Builds up the Library of Congress' collection (keeps a copy of every work registered).

US Copyright Office's website: [www.copyright.gov/](http://www.copyright.gov/)



# Copyright.gov

THE LIBRARY OF CONGRESS

## Copyright

United States Copyright Office

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### Hot Topics

- Register's Priorities and Special Projects for 2011-2013
- Beijing Audiovisual Performances Treaty

### What's New

- Testimony, Online Piracy Judiciary Committee
- Testimony, Ensuring Efficiency House Administration Committee
- Testimony, FY 2013 Appropriations
- Verification of Cable and Satellite Statements of Account

### About Copyright

- Copyright Basics (en Español)
- Frequently Asked Questions (FAQ)
- Current Fees
- Taking the Mystery Out of Copyright (for students and teachers)

### Search Copyright Records

- Registrations and Documents
- Search Request Estimate
- Notices of Restored Copyrights
- Online Service Providers
- Vessel Hull Designs

### Publications

### How to Register a Work

- eCO Login



Electronic Copyright Office

### How to Record a Document

- Record a Document

### Law and Policy

- Copyright Law
- Federal Register Notices
- Legislative Developments

# Copyright Application

Copyright Office fees are subject to change. For current fees, check the Copyright Office website at [www.copyright.gov](http://www.copyright.gov), write the Copyright Office, or call (202) 707-3000.

Privacy Act Notice: Sections 408-410 of title 17 of the *United States Code* authorize the Copyright Office to collect the personally identifying information requested on this form in order to process the application for copyright registration. By providing this information you are agreeing to routine uses of the information that include publication to give legal notice of your copyright claim as required by 17 U.S.C. §705. It will appear in the Office's online catalog. If you do not provide the information requested, registration may be refused or delayed, and you may not be entitled to certain relief, remedies, and benefits under the copyright law.

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For a Nondramatic Literary Work  
UNITED STATES COPYRIGHT OFFICE

REGISTRATION NUMBER

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EFFECTIVE DATE OF REGISTRATION  
Month Day Year

DO NOT WRITE ABOVE THIS LINE. IF YOU NEED MORE SPACE, USE A SEPARATE CONTINUATION SHEET.

1

TITLE OF THIS WORK ▼

PREVIOUS OR ALTERNATIVE TITLES ▼

**PUBLICATION AS A CONTRIBUTION** If this work was published as a contribution to a periodical, serial, or collection, give information about the collective work in which the contribution appeared. Title of Collective Work ▼

If published in a periodical or serial give: Volume ▼ Number ▼ Issue Date ▼ On Pages ▼

2 a

NAME OF AUTHOR ▼

DATES OF BIRTH AND DEATH  
Year Born ▼ Year Died ▼

Was this contribution to the work a  
"work made for hire"?

☐ Yes  
☐ No

**AUTHOR'S NATIONALITY OR DOMICILE**

Name of Country

OR { Citizen of  
Domiciled in

**WAS THIS AUTHOR'S CONTRIBUTION TO  
THE WORK**

Anonymous? ☐ Yes ☐ No  
Pseudonymous? ☐ Yes ☐ No

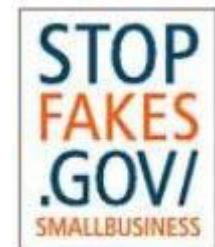
If the answer to either  
of these questions is  
"Yes," see detailed  
instructions.

**NOTE**  
Under the law.

**NATURE OF AUTHORSHIP** Briefly describe nature of material created by this author in which copyright is claimed. ▼

# International IP

- Some of the International Agreements Affecting IP Law:
  - The Paris Convention
  - Madrid Protocol / The Trademark Law Treaty
  - The Patent Cooperation Treaty
  - The WIPO Copyright Treaty
- International Treaties
  - NAFTA
  - TRIPS



# Venue and Jurisdiction

- So... we know we're bringing an IP case in Federal Court, but the question is: *which federal court???*
- The US has 94 federal districts.
- Each federal district has at least 1 trial court.
- Many districts have more than 1 federal court.

# Where, oh Where, is Proper Venue???

- Usually, plaintiff's choice. Not here though. Ohhhhhhhh no... 😊
  - Copyright - Only in a district where the defendant resides or "may be found."
  - Patent - Only in a district where the defendant resides or where he "has committed acts of infringement and has a regular and established place of business."
  - Trademark - Only in a district where any defendant resides or where "a substantial part of the events or omissions giving rise to the action occurred."



# Remedies Available in IP Cases

- Injunctive Relief (*Do this, or stop doing that*)
- Monetary Damages (collect lost profits)
- Profits Made by the Infringing Party  
(“Disgorgement”)
- Impoundment or Destruction of Offending Materials (*'nuf said...*)
- Criminal Penalties (ex. If fraud was committed)
- Attorney's Fees & Costs (*reasonable attorney's fees; amount spent*)

# Assignment 1

In *White v. Samsung Electronics*, 1992 U.S. App. LEXIS 19253 (9th Cir. 1992),

Wheel of Fortune hostess Vanna White sued Samsung for running a commercial that was, in part, based on her and used something resembling her likeness. In a dissenting opinion, cited above, a judge makes the following remark:

"Saddam Hussein wants to keep advertisers from using his picture in unflattering contexts. Clint Eastwood doesn't want tabloids to write about him. Rudolf Valentino's heirs want to control his film biography. The Girl Scouts don't want their image soiled by association with certain activities. George Lucas wants to keep Strategic Defense Initiative fans from calling it "Star Wars." Pepsico doesn't want singers to use the word "Pepsi" in their songs. Guy Lombardo wants an exclusive property right to ads that show big bands playing on New Year's Eve. Uri Geller thinks he should be paid for ads showing psychics bending metal through telekinesis. Paul Prudhomme, that household name, thinks the same about ads featuring corpulent bearded chefs."

# Assignment 1, cont.

Property Right: The intellectual property right at issue in this case is trademark rights, in particular the trademark of a person's face and likeness. The owner of such a trademark acquires the right to prevent his likeness from being used in commerce where it would tend to cause confusion in commerce.

The Lanham Act (15 USC § 1125): Right to protect against false or misleading advertising.

In this case, the use of a likeness of a celebrity could cause misleading advertising, giving the impression that the person supports a certain product. The Act provides a "likelihood of confusion" test and in meeting all of the elements of the test, the likeness will be considered a protected trademark.