



DEWITT
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L A W F I R M

leadership

SHORT COURSE ON INTELLECTUAL PROPERTY

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TOPICS

- SUMMARY OF IP
- INVENTORSHIP
- OWNERSHIP OF PATENTS
- TRANSFER OF OWNERSHIP

DEWITT MAXIMS

MAXIM 1

DO NOT DISCLOSE YOUR
INVENTION OUTSIDE YOUR
ORGANIZATION UNTIL

- CLEAR WITH MANAGEMENT
- APPLICATION IS FILED

MAXIM 2

**APPLICATIONS MUST BE FILED WITHIN 1
YEAR OF PUBLIC DISCLOSURE**

INTELLECTUAL PROPERTY UMBRELLA

- PATENTS
- TRADEMARKS
- TRADE SECRETS
- COPYRIGHTS

EXAMPLES OF INTELLECTUAL PROPERTY

- INVENTIONS
- PRODUCT NAMES
- SOFTWARE PROGRAMS
- CUSTOMER LISTS, SALE RECORDS
- PROFIT AND PERFORMANCE REPORTS
- ANYTHING THAT GIVES YOUR COMPANY A COMMERCIAL ADVANTAGE OVER YOUR COMPETITORS

PATENT

- FULLY DISCLOSES INVENTION
- ESTABLISHES INVENTOR'S RIGHTS
- EXCLUDE OTHERS FROM INVENTION FOR A LIMITED TIME

PATENTABLE SUBJECT MATTER

- **PROCESS**
- **MACHINE**
- **ARTICLE OF MANUFACTURE**
- **COMPOSITION OF MATTER**
- **MEDICAL DEVICE TO SAVE AN
INFANT'S LIFE**

TRADEMARK

- WORD, NAME, SYMBOL OR DEVICE
- ADOPTED BY A COMPANY OR PERSON
- IDENTIFY GOODS OR SERVICES
- DISTINGUISH THEM FROM THOSE MANUFACTURED OR SOLD BY OTHERS

TRADEMARK FUNCTION

- INDICATE THE ORIGIN OF THE GOODS OR SERVICES
- GUARANTEE THE QUALITY OF THE GOODS BEARING THE MARK

TRADE SECRET

- IMPORTANT INFORMATION
- KNOWN TO YOU AND YOUR COMPANY
- NOT KNOWN TO OTHERS
- GIVES YOU A COMMERCIAL ADVANTAGE OVER YOUR COMPETITORS

COPYRIGHT

- RIGHT TO PREVENT OTHERS FROM COPYING THE “FORM OF EXPRESSION” USED BY THE CREATOR OF CERTAIN TYPES OF WORKS
- BOOKS, PICTURES, SOFTWARE, SOUND RECORDINGS

INVENTORSHIP

- What is an invention and how do I know when I invented something?
- Who is/is not an inventor?
- Can I list my boss/spouse/friend/co-worker as an inventor in my patent application?

- What if two or more of us come up with the idea simultaneously? Are we all inventors?
- What are my responsibilities as an inventor?
- I never did like my co-inventor and he/she left the company anyway. Can I leave him/her off the patent application? What happens to the patent application if I do?

CONCEPTION

- FORMATION IN THE MIND OF THE INVENTOR
- OF A DEFINITE AND PERMANENT IDEA
- OF THE COMPLETE AND OPERATIVE INVENTION

TWO STEPS

INVENTOR MUST:

- RECOGNIZE ULTIMATE RESULT
- DEVELOP A MEANS TO ACHIEVE THE DESIRED RESULT

**WHO IS NOT AN
INVENTOR?**

- SUGGEST AN AREA OF RESEARCH
- SUGGEST A DESIRED END OR RESULT
- FOLLOW INSTRUCTIONS

JOINT INVENTORS

- TWO OR MORE PERSONS
- WORKING TOGETHER
- EACH CONTRIBUTES TO THE "CONCEPTION"
- EQUAL CONTRIBUTION NOT A REQUIREMENT

**EFFECT OF
IMPROPER
INVENTORSHIP**

**PATENT
INVALIDATED!!!**

OWNERSHIP

- INVENTION BELONGS TO INVENTOR
- PATENT ISSUANCE PRESUMES THAT THE NAMED INVENTORS ARE THE TRUE AND ONLY INVENTORS
- THE RIGHT TO SUE INFRINGERS IS NORMALLY THE PRIVILEGE OF THE PARTY THAT HAS TITLE TO THE PATENT

**OWNERSHIP CAN
BE
TRANSFERRED**

ASSIGNMENT

DEFINITION

- TRANSFER OF SUFFICIENT RIGHTS SUCH THAT THE TRANSFEREE (ASSIGNEE) HAS TITLE TO THE PATENT
- LIKE A CAR

**WHOLE OR
PARTS**

AN ASSIGNMENT IS A TRANSFER OF EITHER:

- ALL RIGHTS OF EXCLUSIVITY IN THE PATENT
- AN UNDIVIDED FRACTION, E.G., A 50 PERCENT INTEREST
- ALL RIGHTS IN A SPECIFIED PORTION OF THE UNITED STATES

**WHEN CAN AN
ASSIGNMENT BE
MADE?**

- AFTER THE TIME OF INVENTION BUT PRIOR TO THE ISSUANCE OF A PATENT
- LEGAL TITLE TO THE PATENT WILL PASS TO THE ASSIGNEE UPON THE GRANT OF THE PATENT
- ASSIGNMENT OF RIGHTS IN AN INVENTION CAN ALSO BE MADE PRIOR TO THE EXISTENCE OF THE INVENTION (EMPLOYMENT AGREEMENT)

**ASSIGNMENT MUST
BE RECORDED IN
U.S. PATENT OFFICE**

FINAL MAXIM

ADMINISTRATORS:

**MAKE SURE YOUR EMPLOYMENT
AGREEMENTS AND CONSULTING
AGREEMENTS INCLUDE OBLIGATION
TO ASSIGNMENT INTELLECTUAL
PROPERTY**

THANK YOU

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