

# PATENT LAW

Randy Canis

## CLASS 1

**Class Introduction;  
Overview of Law and the Legal System;  
Overview of Intellectual Property  
ST: Hiring an Attorney and  
Should I Go to Law School?**

## Today's Agenda

- Primary Topics & Skills
  - Class setup
  - Key terms
    - Know meaning of key terms
  - Overview of legal system
    - Associate an activity with a particular branch of government
  - Various types of intellectual property
    - Identify and distinguish between different types of intellectual property

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## Randy Canis

### EDUCATION

- B.S. in Computer Science, University of Missouri-Rolla, 1993-1997
- J.D., University of Missouri-Columbia, 1996-1999

### PRACTICE OF LAW

- Associate, Greensfelder, Hemker, & Gale, P.C. 1999-2006
- Associate, Schwegman, Lundberg & Woessner, P.A. 2006-2009
- Of Counsel, Polsinelli Shughart PC, 2009-2011
- Senior Legal Counsel/Intellectual Property, Express Scripts 2011-2016
- Assistant General Counsel, Express Scripts 2016-Current

### TEACHING

- Adjunct Professor, CS Department/Eng Mgt Department
  - Fall 2000 – Current: "Intellectual Property for Computer Scientists a/k/a Computers and the Law"
  - Fall 2002 – Current: "Patent Law"
  - Spring 2010 – Current: "Legal Environment"
  - Fall 2015 – Current: "Privacy and Information Security Law"

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## Randy's Patents and Patent Applications

- 8,294,015 Method and system for utilizing a gaming instrument controller
- 8,296,055 Method and system for positional communication
- 8,880,613 System and method for managing mail messages
- One other patent application pending

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## Getting to Know You

- Who are you?
- Where are you located?
- What is your background?
- Why are you taking this class?

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## Class Introduction

- What is the purpose of this class?
- What will I learn in this class?
- Do I really have to do that much reading?
- Will this class help me meet my personal goals?
- Who is Tim Clise?
- Will I do well in this class?
- Will I have fun in this class?

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## Class Introduction

- What times will the class meet from?
  - Tuesdays from 7:00 p.m. -> 9:30 p.m.
- Can I watch the class at home on the Internet?
- How can I participate from my computer?
- What if I can't make the class?
- When do I get to meet you in person?
- Is this class like your other courses?

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## Introduction to Law

- Do all lawyers practice law like the lawyers of television?
  - No!
  - How many times have I been to court and dealt with judges?
  - Transactional v. non-transactional law
- What is Intellectual Property?
  - Patents, Trademarks, Copyrights, Trade Secrets, Rights of Publicity, Right of Privacy, etc.
  - Rights developed in intangible property that is protected by law.
- What is the difference between civil law and criminal law?

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## Branches of U.S. Government (3)

	Legislative	Executive	Judicial
<b>Body</b>	Congress	Pres & Admin Agencies	Federal Courts
<b>Role</b>	“Make”	“Enforce”	“Interpret”
<b>“Product”</b>	Statutes	Regulations	Case Opinions
<b>Location</b>	U.S. Code	Federal Register and C.F.R.	Case Reporters

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## Branches of Missouri State Government

	Legislative	Executive	Judicial
<b>Body</b>	MO Legislative	Governor and State Executive Agencies	State Courts
<b>Role</b>	“Make”	“Enforce”	“Interpret”
<b>“Product”</b>	Statutes	Regulations	Case Opinions
<b>Location</b>	MO Revised Statutes	MO Code Regulations	Case Reporters

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## Federal Court Structure

- US Supreme Court (1)
- US Court of Appeals (13)
  - 8<sup>th</sup> Circuit
  - Federal Circuit
- US District Courts (144); at least 1 per state
  - Missouri - 2 Federal District Courts
    - Eastern District - St. Louis
    - Western District - Kansas City
    - + Federal Bankruptcy Court

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## Principal Sources of Legal Authority

- Statutory Law - contained in codes
- Common Law – developed from judicial decisions
- Case Law - law created by trials and appeals of trials

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## What are our legal sources?

- U.S.C. – United States Code.
- C.F.R. – Code of Federal Registers.
- M.P.E.P. – Manual Patent Examination and Practice
  
- What is the significance of the aforementioned sources?

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### Must Know Terms of the Art

- What is stare decisis?
  
- What are Secondary Sources?

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### Must Know Terms of the Art

- What is the Statute of Limitations?
  
- What is Voir Dire?

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### Civil Lawsuit: Pretrial Phase

- A. Prospective Plaintiff files suit containing at least one claim for relief
- B. Pleading
- C. Discovery
  1. Interrogatories
  2. Produce documents, other materials
  3. Request for admission
  4. Deposition
- D. Pretrial Conferences

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## Civil Lawsuit: At Trial

- A. Plaintiff must prove his prima facie case
  - 1. Plaintiff bears the burden of proof
  - 2. Plaintiff must prove the elements
- B. Three Burdens of Proof
  - 1. Preponderance of the evidence (more likely correct than not)
  - 2. Clear and convincing evidence
  - 3. Beyond a reasonable doubt
- C. Defendant's Defense
  - 1. Can negate plaintiff's elements
  - 2. Bears burden to prove affirmative defenses
  - 3. Judge/Jury - apply law to facts

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## Civil Lawsuit: Post Trial

- A. Enforce Judgments
- B. Post Trial Motions
  - 1. Cost and Fees
  - 2. New Trial
  - 3. Appeal

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## Jurisdictional Requirements

- What is jurisdiction?
  - the power of a court to decide a matter in controversy (i.e., a case)
- What is needed to establish jurisdiction?
  - Authority of the court to hear the case (e.g., original or appellate jurisdiction)
  - Authority of the court over the subject matter (subject matter jurisdiction)
  - Jurisdiction over the parties (personal jurisdiction) or property (in rem jurisdiction) of the suit
  - Proper notice

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## Subject Matter Jurisdiction

### Diversity Jurisdiction

§ 1332. Diversity of citizenship; amount in controversy; costs

- (a) The district courts shall have original jurisdiction of all civil actions where the matter in controversy exceeds the sum or value of \$ 75,000, exclusive of interest and costs, and is between--
- (1) Citizens of different States;
  - (2) citizens of a State and citizens or subjects of a foreign state;
  - (3) citizens of different States and in which citizens or subjects of a foreign state are additional parties; and
  - (4) a foreign state, defined in section 1603(a) of this title [28 USCS § 1603(a)], as plaintiff and citizens of a State or of different States. ...

### Federal Question Jurisdiction

Cases arising under the Constitution, Acts of Congress or treaties, and involving their interpretation and application

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## Power over Person or Property

- **Jurisdiction in personam** – power which a court has over the defendant’s person and which is required before a court can enter a personal or in personam judgment.
- **Jurisdiction in rem** – power of a court over a thing so that its judgment is valid as against the rights of every person in the thing

Black’s Law Dictionary

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## Types of Intellectual Property

- Unfair Competition
- Right of Publicity
- Trademarks
- Trade Secrets
- Patent
- Copyright

Note: Lay people often erroneously term one type of intellectual property by another name, such as copyrighting a name, patenting a music CD, trademarking an invention, etc.

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## Unfair Competition

- The appropriation of business goodwill by false or misleading labeling, or by predatory marketing practices by a competitor with consequent deception among customers about origin of goods or about the comparative quality of goods.

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## Right of Publicity

- The right of publicity protects the appropriation of name or likeness of a person for commercial advantage.

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## Trademarks

- **A trademark is any word, phrase, symbol, letter or number or any combination used to identify products and distinguish them from products of other companies.**
- Examples: Coca-Cola soft drink, Yahoo! Internet services, American Airlines travel services, etc.

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## Other Types of Marks

- **Service mark** – “to identify and distinguish the services of one person ... from the services of others and to indicate the source of the services”
- **Certification Mark** – “to certify regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of such person's goods or services or that the work or labor on the goods or services was performed by members of a union or other organization.”
- **Collective Mark** - indicates membership in a union, an association, or other organization.

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## Devices for Trademarks

- **Words** – MICROSOFT for computer software
- **Symbol** – Nike SWOOSH
- **Device** – McDonalds GOLDEN ARCHES, Levis Pocket
- **Sound** – Michael Buffer LET'S GET READY TO RUMBLE, NBC THREE CHIMES

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## Trade Secret

- A trade secret is any information that has not been published and that could give a company a competitive advantage.
- Examples: Coca-Cola's secret formula, Google's search engine strategy, AOL's subscriber list

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## MO Trade Secret Definition

- (4) "Trade secret", information, including but not limited to, technical or nontechnical data, a formula, pattern, compilation, program, device, method, technique, or process, that:
- (a) Derives independent economic value, actual or potential, from not being generally known to, and not being readily ascertainable by proper means by other persons who can obtain economic value from its disclosure or use; and
  - (b) Is the subject of efforts that are reasonable under the circumstances to maintain its secrecy.
- 417.453(4)
  - <http://www.moga.mo.gov/statutes/C400-499/417000453.HTM>

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## What are the Primary Categories of Trade Secrets?

- The various categories of trade secrets include financial information, organization information, marketing information and technical information.
- Financial information may include profit margins, overhead costs, material costs and supplier discounts.
- Organizational information may include expansion plans, key employee acquisitions, record-keeping information and methods of operation.
- Marketing information includes customer lists, terms of licenses, new product developments and contracts and contract negotiations.
- Technical information includes formulas for producing products, computer software, chemical formulas and processes and methods of manufacture.

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## Patent

- A patent grants a limited monopoly over the use of technological idea for a process, machine, item of manufacture, or composition of matter that is novel, useful and nonobvious.
- Patents may not be granted over discoveries of natural phenomena.
- The term of a patent is usually 20 years from the date of the patent application was filed with the United States Patent and Trademark Office.
- The United States is evolving from a first to invent to a first to file patent system.

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## Copyright Requirements

- For an author to have a valid copyright in a particular work, the work must
  - (i) be original,
  - (ii) remain fixed in a tangible medium of expression, and
  - (iii) have involved a minimum degree of creativity.

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## Originality

- Must:
  - be an original work of the author
  - “a work independently created by its author, one not copied from pre-existing works, and a work that comes from the exercise of the creative powers of the author’s mind, in other words, ‘the fruits of [the author’s] intellectual labor.’”
- Artistic merits are irrelevant,
- The underlying idea of a work is not subject to copyright protection.

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## Fixation

- Works must be fixed in a tangible medium of expression to be protected under the Copyright Act.
- Works must be embodied in a tangible form that is “sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration.”
- The requirement for fixation is met when the work can either be directly perceived or perceived with the aid of a machine or other device.

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## Scenes a faire doctrine

- “The doctrine refers to ‘incidents, characters or settings which are as a practical matter indispensable, or at least standard, in the treatment of a given topic.’ These devices are not protectable by copyright.”
- *Incredible Technologies, Inc. v. Virtual Technologies, Inc.*

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## Term

- What is the term of a copyright registration?
  - Life of the Author + 70 years
  - For anonymous works, pseudonymous works, and works made for hire - 95 years from publication or 120 years from creation, whichever expires first

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## Current Notice Requirements

- Copyright notice no longer required...
- Proper copyright notice:
  - (i) the symbol © (the letter C in a circle), or the word “Copyright”, or the abbreviation “Copr.”,
  - (ii) the year of first publication of the work, and
  - (iii) the name of the owner of the copyright in the work.
- Why still include the notice?

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## Ownership

- General Rule – Copyright ownership vests with the author(s) of the work
  - Copyright ownership of a work can be assigned to another
  - Important exception – work made for hire

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## Work Made For Hire

### Employees

- Within the Scope of Employment
  - the work is deemed authored by the employer and the employer will have all exclusive rights associated with the work.
- Outside the Scope of Employment
  - the work is deemed authored by the employee and the employer will simply have a license to use the particular embodiment of the work without the exclusive rights associated with the work

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## Work Made For Hire

### Non-Employees

- The work must be:
  1. specially ordered or commissioned,
  2. for use as a contribution to a collective work, as a part of a motion picture or other audiovisual work, as a translation, as a supplementary work, as a compilation, as an instructional text, as a test, as answer material for a test, or as an atlas, and
  3. in a written instrument signed by the parties that states the work shall be considered a work made for hire.

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## Viewing Patent Information on the Web

- Governmental web site
- Other web sites

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## Patent Office

- USPTO or PTO: United States Patent and Trademark Office ([www.uspto.gov](http://www.uspto.gov))
- Each country has its own national patent and trademark office. Why?
- WIPO: World Intellectual Property Organization ([www.wipo.int](http://www.wipo.int))

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## Other Web Resources

- **Google Patents** – Patent Searching
- **PatentlyO.com** – Patent News
- **FreePatentsOnline** – PDF Patent Downloads
- **PatentBuddy.com** – Find information on patent attorneys

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## Hiring an Attorney

- Special topic #1

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## Hiring an Attorney

- Points to Consider When Selecting Counsel
  - Experience with the Subject Matter
  - Number and Range of Attorneys in the Field
  - Relationship
  - Location
  - Billing Policy/Practice

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## Hiring an Attorney

- Conflict Checks
  - Subject Matter
  - Parties
- Engagement Letters
- Fee Arrangements
  - Hourly fee
  - Flat fee
  - Contingency fee
  - Patent Work
    - Caps, fees and budgets

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## Typical Costs

- How much do attorneys charge?
- How much does a patent search cost?
- How much does a patent application cost?
  - US
  - International
- How much does it cost to prosecute a patent application?

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## Should I Go to Law School?

- Special topic #2
- I can provide you additional information and greater analysis on your particular circumstance if you arrange a meeting or call with me

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## How do I get in?

- LSAT + GPA
- Law Schools Tiers
- Pay

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## Do the dollars make sense?

- Tuition - ~160K (for 3 years)
- Living Expenses - ~35K
- Differential between attorney salary and engineer salary
  - Big firm – 140K
  - Engineer – 70K
- So, the day you start law practice you are down significant \$\$\$, and need a number of years to break even
- However, not all jobs start at rate of big firm.

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## New Economy Legal Market

- Check out AboveTheLaw.com
- Evolution of the patent attorney job field
  - Pre-1999 – pre-software
  - 2000-2001 – dot com explosion
  - 2001-2005 – post dot com explosion; steady state
  - 2006-2007 – excess work
  - 2008-2010 – first layoffs, difficult market
  - 2011 – rebound, work moving in-house

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## Reason to Attend Law School

- #1 – To obtain a high paying and/or rewarding job that requires obtaining a law degree
- #2 – Because you (or your family) have too much money, and you don't want to work (yet)
- Law school is an expensive endeavor. Make sure you know what you are doing before starting.

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## Where Should I go to Law School?

- Where do you want to work?
  - What law firms interview on campus at the schools you are considering?
- Where do you want your network of connections to be based?
- Does the law school specialize in the area in which you would like to study?

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## Dual Degree Programs

- Some law schools have 4 year programs that enable you to get an additional master's degree at the same time
  - JD/MBA
  - JD/Nursing Degree
- The programs are school specific

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## Desirable Background for Patent Law Jobs

- #1 – Electrical engineer (BS)
- #2 – Biotechnology (PhD)
- #3 – Chemistry, computer engineering, software (BS or higher)
- #4 – Mechanical or Physics (BS), Biotechnology (MS)
- #5 – Biotechnology or Biology (BS)
- #6 – Other technical qualifying area

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### Job Types - Patent

- Patent Prosecution Attorney
- Patent Agent
- Patent Litigator
- Patent Examiner
- Patent Searcher
- Patent Enforcement/Licensing Attorney
- Patent Opinion Counsel

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### Job Types – Non-Patent IP

- IP/Technology Transactional Attorney
- IT/Telecommunications Transactional Attorney
- IP Litigation Attorney
- Software Licensing Attorney
- Copyright/Trademark Attorney

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### Job Types – Further Afield

- General Counsel
- General Attorney
- First Amendment Attorney
- Mergers and Acquisition Attorney
- Commercial Contractors Attorney
- Product Attorney

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## Final First Day Thoughts

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## Reading the Course Text

- How should you read the text?
- Should you take notes?
- Do you need to know case names?
- How much time will it take to read the cases?
- This book seems complicated; what is the deal?
- What happens if I don't read a case and I am called on during class to discuss it?
- Online legal dictionary - <http://dictionary.lp.findlaw.com/dictionary.htm>

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## Legal Reasoning

- 1) Identify facts and issues with case
- 2) Identify applicable law(s)
- 3) Determine how law(s) apply to the facts and issues of the case

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***Program  
Completed***

All course materials - Copyright 2000-16 Randy L. Canis, Esq.

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