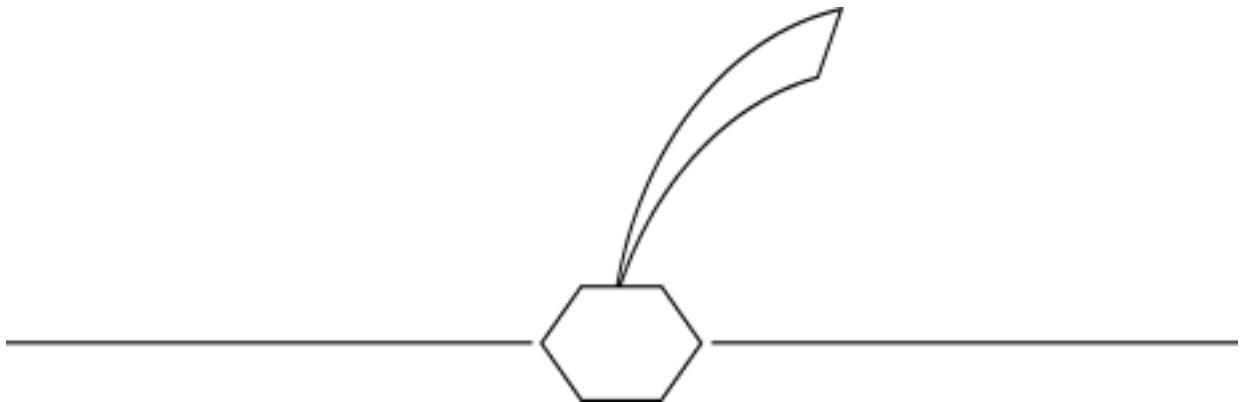


# **The Essentials of Intellectual Property**

Christian R. Anderson

*Instructor Guide & Test Bank*



## Introduction

In general, the book is structured to present the different areas of intellectual property to the student. It also introduces the student to the basics of searching for references to intellectual property rights.

Intellectual property is a difficult concept as it represents an intangible property. In areas such as real estate, you can present a tangible point of reference. A concept as adverse possession can be demonstrated by someone grabbing an apple from someone else. However, intellectual property rights are largely intangible. In fact, it has been stated that intellectual property rights do not exist unless they are infringed. This is an overstatement but it points to a fundamental mystique about the different areas of intellectual property.

A website is maintained at "<http://home1.gte.net/chrisand/>" to serve as a reference a resource tool for both the instructor and the student. Any forms referenced may be found through links at this site.

I recommend that the chapter questions be used as discussion tools for each chapter. You may wish to assign the chapter as reading for the student and ask them to prepare answers for the chapter questions.

Exercises are given at the end of each general section in the different areas, namely chapters 3, 6, 9 and 11. These would best function as take home exams. The students will need sometime to prepare their answers as the exercise are not "yes or no" questions but rather are applied logic applications of the lessons. A final exam is provided with this guide. It should be given as a sit down test for the student.

If you wish to research any of the areas of intellectual property in greater detail, I would refer you to the recommended reading and reference table found on pages 147 through 152.

Comments or questions may be sent to Pearson Publications Company, 9614 Greenville Avenue, Dallas, TX 75243 or e-mail at [pearsonpub@aol.com](mailto:pearsonpub@aol.com).

*Christian R. Andersen*

This chapter along with chapters 2 and 3 offer an overview of the area of patents and patent protection.

I would encourage the instructor to stress the meanings of some basic terms in intellectual property. Perhaps a vocabulary list could be made for each section from the glossary. The terms of the glossary are available for you and the student on the Internet.

The book is designed in a progressive manner that will allow you to teach the elements of patents. The sections should not be taught out of sequence. I would stress the following as an outline of the lesson plan for chapter 1.

**1. Patent Law in General**

**2. Types of Patents**

- Utility Patents
- Plant Patents
- Design Patents

**3. Statutory Requirements for Patents**

- First to Invent
- Novelty
- Nonobviousness

**4. Statutory Bars from Receiving a Patent**

- Known or Used by Others
- On-Sale
- Public Use
- Abandonment
- Not the Inventor (Derivation)
- Prior Invention

**Insights for the Chapter Questions**

1. *Explain the nature of a patented invention as it differs from other types of intellectual property.*  
It is important that the students understand the concept that a patent is a grant of protection for an actual process or actual invention. That is, the idea is protected. This differs from the expression of the idea, which is copyrightable.
2. *Outline and define the three (3) types of patents granted in the United States.*  
This can be derived directly from pages 3 through 6 of the text.
3. *An inventor has approached you with a new concept for a machine part, explain the requirements for obtaining a U.S. patent under current law along with the bars that prevent a person from receiving a patent.*  
This question is looking for a summary of the main headings in pages 7 through 10 of the text. It is important that the student use the key words of the headings of the paragraphs to describe the requirements and bars.

This chapter builds on the basic patent concepts given in Chapter 1. The considerations in this

chapter refer to the filing and obtaining of a patent grant in the United States. The student should be made aware that patent practice in the United States is unique to the United States and while similar aspects exist with patent practices in different countries, the concepts are not universal.

I would stress the following as an outline of the lesson plan for chapter 2:

### **1. Elements of the U.S. Patent Application**

- Front Page and Abstract
- Drawings
- Background and Summary
- Information Disclosure Statement
- Preferred Embodiment
- Claims
- Fees

### **2. The Life of a U.S. Patent Application**

- Initial Application
- Responses to Office Actions
- Understanding Claims (Charting Claims)
- Continuation and Continuation-In-Part Applications
- Divisional Applications
- Interferences by Third Parties
- Petitions to Revive
- Publication and Issuance of Final Registration

### **3. Postissuance Matters**

- Reexamination
- Reissuance
- Maintenance Fees

I am using the front page of the issued U.S. patent as a guide for understanding the elements of a patent application. It may be advisable to distribute a copy of U.S. Patent No. 3,573,454 granted to Andersen, et al, entitled "Method and Apparatus for Ion Bombardment use Negative Ions." Copies of the patent may also be found at the website for the book.

### **Insights for the Chapter Questions**

1. *Describe the elements that comprise a United States patent application. Which of these elements are usually included but is not required by current law?*

I am looking for the description of the elements in pages 11 through 14. The element that is not always required is the drawing (see page 13).

2. *Explain the course of a patent application in the United States Patent Office.*

This question is looking for the student to give the steps outlined in pages 15 through 21.

3. *Why would a party file a divisional application? How does this differ from a continuation and continuation-in-part application?*

A divisional application is required when the patent examiner feels that more than one invention is claimed in an application. Since only one application may be claimed in a single application, a second, or divisional, application must be filed for the second invention. By contrast, continuation and continuation-in-part applications are additional filings for a original single application that has been rejected. (Refer to pages 19 and 20)

4. *What is a patent claim? Explain the difference between an independent and dependent claim.*  
As you can find in the glossary, a claim is a section of a patent wherein the invention is specifically defined as a grammatically correct numbered sentence. The differences between independent and dependent claims are on page 14. Simply put, an independent claim can stand alone, such as the ones in the Andersen patent. Dependent claims always incorporate the text of an independent claim, which precedes it. A patent may have only independent claims but cannot have only dependent claims.

*Chapter Three*  
**THE INTERNATIONAL PATENT**

This chapter applies the basics in chapter 1 and the concepts in chapter 2 to patent prosecution worldwide. You may wish to refer the student to the copy of the Andersen patent for reference. The concepts of international treaties are stressed in this chapter.

In general, international patent prosecution is determined for the U.S. applicant by the different treaties in force, or not in force, with the countries of interest to the inventor. You may wish to refer to the web site for additional information and teaching resources about the treaties.

The following is the outline for teaching this chapter.

1. **International Patent Concepts**  
-Priority
2. **International Patent Classification (IPC) System**
3. **Paris Convention for the Protection of Industrial Property**
4. **Patent Cooperation Treaty (PCT)**
5. **European Patent Convention (EPC)**

Refer the student to table 2 (pp. 153-164) to show how these treaties apply to different countries.

### **Insights for the Chapter Questions**

1. *What is an international patent and how may one apply to receive protection around the world?*  
This is a trick question. There is no universal patent.
2. *What is the IPC and what body currently administers its maintenance?*  
This is the International Patent Classification system (see page 27). It is administered by the World Intellectual Property Organization (WIPO) in Geneva, Switzerland. For extra credit, you may ask the student to point out that the United States does *not* follow the IPC but rather uses its own national classification system.
3. *Compare and contrast the Patent Cooperation Treaty and the European Patent Convention.*  
The PCT is described on page 28 and the EPC on page 29. Both treaties are multi-national in nature. The basic difference is the PCT offers a standard method of filing in many countries but still represents individual, multiple filings in each country while the EPC represents a single filing for all countries concerned.

### **Insights to Patent Exercises**

The patterns are straightforward from the book. A simple outline will suffice as an answer. Of course, you may also wish to assign a short explanatory essay.

A)- *Compose memos recommending a course of action for you and your attorney concerning the following fact patterns. Be certain to address questions about forms and procedures needed as well as the research tools (refer to Tables 1 and 2) needed to accomplish each project.*

1) *A person claims to have invented a new way of calculating fractions. She also tells you that he has worked for years on this matter alone and can prove all his work.*  
This is a trick question. Mental processes cannot be patented (Page 3).

2) *A fashion designer shows you a new style of earrings. The pair is distinctive and very unusual. The earrings are a standard clip design in the way they attach to the ears. There is interest in filing in Europe particularly France for the Paris fashion markets.*  
This is essentially another trick question. The earrings are subject to copyright protection. However, a student may want to try a design patent approach. This is acceptable. However, the clip design cannot be claimed as is not new (it is "standard.")

3) *Two inventors have approached your firm claiming that they have developed a new method for manufacturing spark plugs for automobiles. They want their invention to be owned by small company they have just formed. They have also received inquiries from manufacturers in Japan, England, Australia, Germany and Thailand and would like to begin the patenting process in those countries.*  
This question is looking for applied logic of all three chapters. Look for assertions of joint inventorship and the small entity status of the company. The lower fees would apply in the United States.

B) *Referring to a copy of U.S. Patent No. 3,573,454 granted to Andersen, et al, entitled "Method and Apparatus for Ion Bombardment use Negative Ions" complete the following exercises:*

- 1) *List the elements of the front page of the '454 patent.*
- 2) *List the inventors and assignee of the patent*
- 3) *Indicate whether or not the patent is in force*
- 4) *Chart the claims of the '454 patent.*

1. The elements are the same as those listed on page 12.
2. The inventors are Christian Andersen and Henry Rodin. The assignee is Applied Research Laboratories.
3. The patent is not in force.
4. The claims are all-independent and would, therefore, not be able to be charted.

#### *Chapter Four* **TRADEMARK BASICS**

This chapter introduces the concept of trademarks and service marks. Trademarks are words or symbols that identify its products or services and to distinguish them from the products or services of others.

- Please note one error on page 200 of Table 8, International Trademark Classes. We stated that retail store services were moved from Class 42 to 34. This is the error; retail store services now belong in Class 35. This is important for completing the exercise on page 73.

The following is the outline for teaching this chapter:

## **1. Trademark Law in General**

### **2. Types of Trademarks**

- Trademarks
- Service Marks
- Designs Used as Trademarks and Services
- Certification Marks
- Collective Marks

### **3. Strong versus Weak Marks**

- Arbitrary Marks
- Suggestive Marks
- Merely Descriptive Marks
- Generic Terms

### **4. Potential Problems to Use of a Trademark**

- Trademark Infringement
- Dilution
- Prior Registration
- Prior Common Law Use of the Mark
- Term Is Generic
- Term Is Highly Descriptive

## **Insights to Chapter Questions**

1. *What is a trademark and what effect does a trademark have on the public?*  
Care should be taken to show that a trademark represents the goodwill, or business reputation, of the company identity as being the source of the goods or services offered under the trademark. For example, you tend to pay more for a brand name than for a generic, as you do not know the supplier of the generic. The old phrase "you get what you pay for" seems to accurately describe the concept of trademarks.
2. *A person has asked you to help them pick a new name for a computer. They are torn between "PC PLUS" and "KIWI JR." What might you tell them about the choices?*  
"PC PLUS" is descriptive or at least suggestive (page 39) and therefore not very protectable. "KIWI JR" is an arbitrary mark (page 38) and much stronger.
3. *A client of your attorney has told you that they want to adopt the name "MYST" for a computer mouse. Do you think that the attorney may tell them of any potential problems?*  
While "MYST" is a name for a computer game and this use would be for a mouse, it would represent dilution (page 43) of the well-known game.

*Chapter Five*

## **THE U.S. TRADEMARK APPLICATION**

This chapter is a detailed look at the filing and procuring of a U.S. trademark application. Care should be taken to work through the following outline. It might be worthwhile to distribute a form trademark application (attached).

### **1. Elements of the U.S. Trademark Application**

- Types of Applications
  - a- Actual Use Applications
  - b- Intent-To-Use Applications

- c- Applications Based on a Foreign Registration or Application
- e- Concurrent Use Applications

- Supplemental Register
- Specification
- Method of Use Clause
- Power of Attorney
- Appointment of Domestic Representative
- Drawing Sheet
- Specimens

## **2. The Life of a U.S. Trademark Application**

- Initial Deadlines
- Responses to Office Actions
- Amendments to Alleged Use
- Petitions to Revive
- Appeals to TTAB
- Publication
- Opposition Proceedings Filed by Third Parties
- Post Publication Procedures
- Changes of Title

## **3. Post-Registration Matters**

- Filing Section 8 & 15 Affidavits
- Renewal of Registrations
- Cancellation of Registrations

## **4. The Trademark Symbols**

### **Insights to the Chapter Questions**

1. *What are the different types of trademark applications in the United States? How does the question of use of the mark affect the type of application to be filed?*  
This question is asking for a review of the information given on pages 47-54. The question of use either means an actual use or intent-to-use application (page 49).
2. *Explain the typical lifecycle of a United States trademark application. How does the question of use of the mark affect its lifecycle?*  
This question is asking for review of the information pages 54-60. The student should give the information as it appears in the headings for the sections. The question of use means that if use was alleged during the prosecution a certificate of registration will issue after examination. If use was not alleged, the application will go through the allowance and statement of use cycle described on pages 56-58.
3. *It is between the fifth and sixth year of registration for one of your client's marks. Your client has told you that although they stopped using the mark three (3) years ago, they have just re-introduced the product to the market. Can you file any documentation to preserve the original registration or is it necessary to file a new application with the new dates of use?*  
A registration will be considered statutorily abandoned after 3 years. So you will be able to file a section 8 affidavit (page 59) claiming that the mark is currently in use. However, you cannot file a section 15 affidavit (page 59) claiming that the mark is incontestable for being in continuous use.

As with Chapter 3 in the patent section, this chapter builds on the general and U.S. trademark application to show applicability in the international markets. Once again, the focus is on applying the concepts learned to the existing international treaties. I have also added a section on the paralegal's role in the area as it is much more proactive for the paralegal. Foreign trademark prosecution requires liaison work between the foreign agent and the U.S. client.

The following outline should be followed for this chapter:

- 1. The Myth of the Universal Trademark Registration**
  - The Madrid Agreements
  - The Paris Convention
  - Regional Treaties
- 2. The Community Trademark**
- 3. International Trademark Filing Considerations**
  - Use of a Mark Is Often Not a Requirement
  - Trademark Piracy
  - International Translation of Marks
- 4. The Life of an International Trademark Application**
  - Initial Deadlines
  - Powers of Attorney and Related Documents
  - Responses
  - Registered User or License Agreements
  - Issuance of Registration
- 5. Postissuance Matters**
  - Meeting Use Requirements
  - Renewal of Registrations
- 6. A Paralegal's Role in International Trademark**
  - Prosecution
  - Research Country Law and Requirements
  - Liaison Between Foreign Agent and U.S. Attorney
  - Liaison Between Client and Attorney
  - Preparation of Documents for Filing

### **Insights to Chapter Questions**

1. *How does the Paris Convention affect filings in foreign countries?*  
The Paris Convention allows an applicant to file claiming an earlier filing date of an identical application in another member country (page 64).
2. *Does the Community Trademark application differ from any of the other multi-national registration applications?*  
The Community Trademark offers a single registration for the entire European Union. Other multi-national treaties only offer a way of obtaining individual registrations in different countries (pages 65-66).
3. *How does the question of the use of the mark affect applications in different foreign countries?*  
Use of the mark is very often **not** a requirement for obtaining and maintaining a registration (pages 66-67). However, use is required for maintaining a Community Trademark registration.
4. *A letter has come in from a foreign agent telling you of a two (2) week deadline for responding to a problem raised by the Trademark Office in that country. What steps would you take as a*

*paralegal?*

This question is looking for the procedures outlined on pages 71 to 72 of the book. The student should be encouraged to be creative.

### **Insights to Trademark Exercises**

As before, the patterns are straightforward from the book. A simple outline will suffice as an answer. Again, you may also wish to assign a short explanatory essay. The trademark form is available on the Internet at <http://www.uspto.gov/>.

A)- *Compose memos recommending a course of action for you and your attorney concerning the following fact patterns. Be certain to address questions about forms and procedures needed as well as the research tools (refer to Tables 1 and 2) needed to accomplish each project.*

1) *An owner of a pet shop located on Main and Elm wants to register the name of the business, "MAIN & ELM STREET PET STORE."*

Although you may get arguments to the contrary, this mark is not registerable as it is generic and geographically descriptive (pages 44-45).

2) *A doll importer has developed the name of "MR. ALONZO'S FINDS." The dolls are imported from Switzerland, Germany and Thailand and are distributed throughout the United States. He would like to protect the name in as many countries as would seem reasonable for his work. For the sake of this exercise, assume that the mark is clear and available for use.*

The mark is strong and is only vaguely suggestive of the services. The student should present a plan for filing in the United States as well as the countries of origin, namely Switzerland, Germany and Thailand. The student may suggest a Community Mark filing. This is a good application of the lessons as it would cover Germany and Switzerland in one application as well as offer protection in the rest of the European Union.

B) *Using the forms supplied by the United States Trademark Office, complete an application to register a mark under the following conditions:*

1) *The mark is ZEBRA STRIPES*

2) *The mark will be used on running shoes and for the name of a shoe store*

3) *The mark is not in use but the owner plans to use it within a year*

4) *The owner is Zebra Stripes Corporation, a Delaware Corporation, located and doing business at 1212 Main Place, Anytown USA, 11122.*

5) *Mr. Raymond Smith is the president of Zebra Stripes Corporation.*

6) *Mr. Smith wants your attorney to act on his behalf. You can create the identity of your attorney if necessary.*

7) *Zebra Stripes Corporation has a sister company in Germany called Tiger Stripes, GmbH who will first ship the shoes to the United States.*

Please see attached blank and completed U.S. application. The form is found on the Website. Step 7 is a trick and does not affect the preparation of the application.

### *Chapter Seven* **COPYRIGHT BASICS**

This chapter introduces the concept of the copyright. It is important that the student learn that a

copyright protects the particular expression of an idea that is created and fixed in a tangible form, such as writing or an audio visual work.

Copyright protection does not extend to any idea; procedure, process, system, method of operation, concept, principle, or discovery. It is not a general idea, but rather the specific expression of an idea that is protectable under copyright law.

The following is the outline for the chapter:

- 1. Copyright Law in General**
- 2. Statutory Elements of Copyrightable Subject Matter**
  - Originality
  - Fixation
- 3. When Originality Is Not Original**
  - Derivative Works
  - Fair Use
- 4. Bars from Receiving Copyright Protection**
  - Ideas
  - Facts and Titles
- 5. Ownership of Copyright**
  - Works for Hire
  - Joint Works
  - Derivative Works and Contributions
  - Collective Works
  - Compulsory Licenses

### **Insights to Chapter Questions**

1. *Someone asks you if they can copyright this idea that they have had. How would you respond?*  
Ideas cannot be copyrighted (pages 78 and 81)
2. *Can anything that is not original be copyrighted?*  
Yes. Derivative works (such as the Madame Butterfly example on page 79) may be copyrighted.
3. *Explain the different types of ownership of a copyright. Is there a form that is not owned by the author?*  
This question is asking for the information on pages 82 - 84 excluding compulsory licenses. There is no copyright that is not owned by the author. In the case of works made for hire, the author is the company contracting for the work rather than the creator of the work.

## *Chapter Eight* **THE COPYRIGHT APPLICATION**

This chapter is very straightforward and factually oriented. You may wish to pull examples of the forms from the web site for illustration.

The following is the outline for this chapter:

- 1. Copyright Filing**
  - The Forms

- The Deposit
- Completing the Forms
- Other requirements
- The Copyright Deposit
- What do I get back in return?

## **2. Other Filings**

- Recordations

## **3. Terms of Protection**

- Initial Terms
- Renewals
- Processing Time for an Application

### **Insights to Chapter Questions**

1. *A person approaches you wanting to file copyright applications for an unpublished manuscript of a novel and a necklace they have designed. What forms would be required?*  
Form TX.

2. *How long would a copyright last if an author registered it in 1935? Would there be any difference if the author was still living?*  
This work would be subject to the pre-1964 law (page 92). Therefore, the copyright would have been registered for an initial 28 years until 1963. If it was renewed then, it will be valid for an additional 75 years until 2038. If it was not renewed, then it is in the public domain.

## *Chapter Nine* **INTERNATIONAL COPYRIGHT PROTECTION**

As with international patents and trademarks, international copyrights are driven by the relevant treaties between the United States and foreign countries. However, unlike patents and trademarks, it is very likely that only one filing in a country will give the copyright owner some degree of protection in other countries without additional filings.

The outline for this chapter is as follows:

- 1. The Berne Convention**
- 2. 1976 Copyright Act**
- 3. Copyright Notice**
- 4. Moral Rights**
- 5. Visual Artists Rights Act of 1990**
- 6. A Paralegals Role in International Copyright Protection**
  - Research Country Law and Requirements
  - Liaison Between International Agent and Attorney
  - Liaison Between Client and Attorney

### **Insights to Chapter Questions**

1. *What is the Berne Convention in the context of copyright protection?*  
The Berne Convention is the basic copyright treaty as described on pages 95-97.
2. *Is the phrase "All Rights Reserved" always required in a copyright notice? If not, is it ever required?*

No the phrase is not always required. However, it is usually added so that American authors can receive protection under the Buenos Aires Convention (page 99).

3. *An artist who is involved in animal rights sells his sculpture of a mother bear and cubs to a collector to raise money for his cause. He later finds out that the collector then sold the sculpture to a fur shop to attract business. Does the artist have any basis to object to the placement of the statute?*

This question relates to an artist's moral rights (pages 100-101). Theoretically, the artist would have a basis to object to the placement of his art in a context objectionable to him as he still has his moral rights in the work even though the tangible rights were sold.

### **Insights to Copyright Exercises**

- A)- *Compose memos recommending a course of action for you and your attorney concerning the following fact patterns. Be certain to address questions about forms and procedures needed as well as the research tools (refer to Tables 1 and 2) needed to accomplish each project.*

- 1) *A research assistant has developed a certain format for listing the telephone numbers of company employees. She shows you several company listings all in the same format and wants to copyright the lists.*

While the information is not subject to copyright protection, the format is copyrightable (pages 81-82).

- 2) *A jewelry designer has been hired by a watch company to design a new line of men's and women's wrist watches. The designer has been asked to have you and your attorney register the copyright in the watches. She wants to own the copyrights because she is the designer. To prove her point she shows you a section in her work-for-hire contract that names her as the only designer of the line.*

She is not the author of the work as it is a work-for-hire (pages 82-83). She is the creator, but her contract proves that the company she works for is the owner.

- 3) *A manufacturer of playing cards from Denmark wants to start selling the cards in the United States. The cards have been registered with the Danish Copyright Office. He is worried that he will have to take the time to register the cards in the United States.*

Page 155 of Table 2 shows that Denmark is a member of the Berne Convention.

Therefore, no additional registration is required as the United States is also a member of the Berne Convention (pages 95-97)

- B) *Referring to the forms described in Chapter 8, list the type of United States Copyright application that would be needed for each of the following situations:*

- 1) *A new recording by a local band (Form SR)*
- 2) *A renewal of a previously registered copyright (Form RE)*
- 3) *A computer software program (Form TX)*
- 4) *A novel based on the writings of Shakespeare. (Form TX)*

- 5) *A collection of poems by unknown authors (Form TX and GO/CP)*

- 6) *A new sculpture of globes incorporating by permission elements of another sculpture that was completed last year (Form VA).*

## **OVERVIEW OF OTHER INTELLECTUAL PROPERTY AREAS**

This chapter introduces the student to other areas of intellectual property that are not commonly discussed. It is a good area to introduce discussion about the nature of the purely commercial aspects of intellectual property. That is, elements of intellectual property such as trade secrets and rights to publicity that are based solely on economic considerations and damages.

The outline is the layout of the chapters themselves. No additional planning is required.

### **Insights into Chapter Questions**

1. *An engineer designs a special type of blade for a blender that makes his company's blenders very successful. A competitor later hires him. Is the engineer prevented from designing another special type of blade for a blender?*  
This question invites discussion on the elements of trade secrets, that is the commercial secrets of a company, versus the right of a person to make a living.
  
2. *You are walking down the street and happened to be photographed next to a famous celebrity walking out of a hotel. Later the photograph is used in a magazine ad campaign for champagne. Do you and the celebrity have any recourse about this use of the photograph? Is there any difference between you and the celebrity in this situation?*  
Yes, you and the celebrity have the right to control the use of your images. However, assuming that the celebrity is more famous than you, the celebrity has more to lose than you. (pages 110-112). Does your class feel that this is an fair situation?

## *Chapter Eleven* **LEGALIZATION AND AUTHENTICATION OF DOCUMENTS**

This chapter introduces the student to the concept of preparing documents for filing in foreign countries. This is required in all aspects of foreign intellectual property work as well as many other fields. Usually, a practitioner will need the help of an outside service.

The outline for this chapter is as follows:

- 1. Definition of Legalization**
- 2. Determining When Legalization is Required**
- 3. Legalization Process**
  - Privately Drafted Documents
  - Authentication
  - Federal Government Documents
- 4. Embassies**
- 5. The Hague Convention of October 1961**

### **Insights into Chapter Questions**

1. *Why would anyone want to "legalize" a document? When, if ever, would it be necessary?*  
This question asks for the fact patters on pages 115-116.
  
2. *Can the U.S. Treasury Department issue a privately drafted document?*

No. By definition a governmental body cannot issue a privately drafted document. (page 116)

3. *How does the Hague Convention affect the legalization process for a document?*  
The Hague convention eliminates much of the need for legalization for member countries (page 121)

### Insights to Legalization Exercises

- A)- *Your client has just completed a foreign filing program for its trademarks. Powers of Attorney are now being requested by the individual agents in the countries. For the following countries, please indicate what level of legalization may be required and if there are any special considerations:*

The answers for all the countries are found in Table 2. Any country not belonging to the Hague Convention requires full legalization. Any other considerations are noted below.

- 1- *Singapore* ..... (FULL LEGALIZATION)
- 2- *Australia*
- 3- *Great Britain*
- 4- *Thailand* ..... (FULL LEGALIZATION)
- 5- *France*
- 6- *Mexico*
- 7- *Brazil*..... (FULL LEGALIZATION)
- 8- *Japan*
- 9- *Jordan*..... (FULL LEGALIZATION)
- 10- *Haiti*..... (FULL LEGALIZATION and currently under U.S. embargo)
- 11- *Denmark*
- 12- *Cuba* ..... (FULL LEGALIZATION and currently under U.S. embargo)
- 13- *Latvia*..... (FULL LEGALIZATION)
- 14- *India* ..... (FULL LEGALIZATION)
- 15- *Iraq*..... (FULL LEGALIZATION)
- 16- *The Bahamas*
- 17- *China (mainland)*..... (FULL LEGALIZATION)
- 18- *Yugoslavia*
- 19- *Canada*
- 20- *Italy*

### *Chapter Twelve* **PATENT, TRADEMARK AND COPYRIGHT SEARCHING**

This chapter gives an overview to the areas of investigation that are required in the different types of intellectual property. This is an area where the paralegal can excel in supporting the attorney. You may wish to obtain speakers from intellectual property service providers. Web sites for these providers may be found at the web site.

You may also wish to search the Internet for new questions and resources and then assign these research projects to your class using the tools found at the website. Also, the Dialog7 page offers links to its own searching resources and the instructor is encouraged to take the class through the boolean logic examples shown in Table 9.

The outline for this chapter is as follows:

**1. The Requirement to Search Intellectual Property**

**2. Defining the Scope of the Search**

**3. Accessing on-Line Databases**

- Patent Searching
- Trademark Searching
- Copyright Searching

**4. The Manual Search**

- Search for Published Papers and Articles
- The Manual Design Mark Search
- The Manual Copyright Registration Search

**5. Use of the Internet**

- Nature of the World Wide Web
- Internet Basics
  - Using the Internet Search Engines

**Insights into Chapter Questions**

1. *Why would you want to search for information pertaining to a patent, trademark or copyright property?*

This is a question relating to introductory concepts presented on pages 123 to 124.

2. *A client has designed a new formula for correction fluid used in typing, has designed and new bottle and wants to call it "IT'S BETTER THAN WHITE." How would you define the scope of the searches required?*

This is a question relating to concepts presented on pages 124 to 126 as well as Table 9.

3. *Why is the Internet becoming so important to intellectual property searching?*

This is a question relating to concepts presented on pages 130 to 134.

**Section 1: PATENT LAW**

1. Before the passage of the GATT in 1995, patents (other than design patents) were granted for a term of:  
a) 10 years    b) 17 years    c) 20 years    d) 30 years    e) None of these  
*ANSWER: B*
  
2. After 1995, patents (other than design patents) are now granted for a term of:  
a) 10 years    b) 17 years    c) 20 years    d) 30 years    e) None of these  
*ANSWER: C*
  
- 3) Will the subject of a patent ever pass into the public domain?  
*ANSWER: YES after the expiration of its term*
  
- 4) U.S. Patent law is governed by with title of the U.S. Code  
*ANSWER: TITLE 35*
  
- 5) Which of the following is not a type of patent granted in the United States?  
a) Mechanical    B) Design    c) Utility    d) Plant  
*ANSWER: A*
  
- 6) What are the statutory requirements under Section 102(g) of Title 35 to determine who was the first to invent the subject of a patent?  
*ANSWER: The inventor must prove his/her conception of the idea, diligence in developing the idea, and reduction to practice of the idea.*
  
- 7) What other elements must be shown by an inventor to obtain a U.S. patent?  
*ANSWER: The inventor must show NOVELTY and NONOBVIOUSNESS*
  
- 8) List the statutory bars from receiving a U.S. Patent:  
*ANSWER: No patent will be granted if it is proven that:*
  - *The subject of the invention is known or used by others*
  - *The subject of the invention has been on sale for over 12 months*
  - *The subject of the invention is in public use*
  - *The subject of the invention been abandoned by the inventor*
  - *The inventor is not the inventor or*
  - *If the invention is the subject of a prior invention*
  
- 9) List the sections of an issued U.S. patent:  
*ANSWER: 1) the front page and abstract, 2) the drawings, 3) the background and summary of the invention, 4) the preferred embodiment, and 5) the claims.*
  
- 10) Which of the following is not a type of claim found in a U.S. patent?  
a) Independent    b) Interdependent    c) Dependent  
*ANSWER: B*
  
- 11) What is the basic filing fee for a U.S. application for a small entity as of October 1, 1997?  
*ANSWER: \$395.00*
  
- 12) Does the United States follow the International Patent Classification System?

*ANSWER: No - It has its own national system.*

- 13) What is a divisional patent application in the United States?  
*ANSWER: If a patent examiner feels that more than one invention is claimed in a single application then he/she can require that the additional inventions be filed in separate new applications known as divisional applications.*
- 14) After a U.S. patent is granted, when are maintenance fees due?  
*ANSWER: They are due at 3, 7 and 11 years.*
- 15) Does a U.S. patent grant offer protection to the inventor throughout the world?  
*ANSWER: No. A U.S. patent will only grant rights to the inventor within the 50 states and the United States territories.*
- 16) How long does an inventor have to file additional applications in countries belonging to the Paris Convention if he/she wishes to claim the priority of the first filing?  
*ANSWER: Twelve months from the original filing date.*
- 17) The Patent Cooperation Treaty (PCT) offers two (2) major provisions to international applicants. What are these advantageous provisions?  
*ANSWER: 1) It established centralized filing procedures for international patent applications.  
2) It standardized the application format.*

**Section 2:  
TRADEMARK LAW**

- 18) What is a trademark or service mark?  
*ANSWER: A trademark or service mark is a word, phrase, symbol, design or combination of these elements that identifies and distinguishes the goods and services of one party from those of any other party.*
- 19) Which of the following is **not** considered to be a type trademark?  
a) Service Mark      b) Trade Name      c) Certification Mark  
d) Brand Name      e) None of these  
*ANSWER: D*
- 20) Rank the following types of marks in order of strength. 1 being the strongest type of mark and 5 being the weakest type of mark?
- |                                |                       |                        |
|--------------------------------|-----------------------|------------------------|
| Merely Descriptive Marks (___) | Fanciful Marks (___)  |                        |
| Generic Terms (___)            | Arbitrary Marks (___) | Suggestive Marks (___) |
- ANSWER:  
Merely Descriptive Marks (4)      Fanciful Marks (1)  
Generic Terms (5)      Arbitrary Marks (2)      Suggestive Marks (3)*
- 21) Which of the following is **not** a problem to the use of a trademark by an individual?  
a) Trademark Infringement    b) Dilution    c) Prior Registration    d) Term Is Generic  
e) All of the above may present problems  
*ANSWER: E*

- 22) The U.S. Patent and Trademark Office publishes guidelines for the examination of trademark applications files in the United States. What is the name of this publication?  
 ANSWER: *The Trademark Manual of Examining Procedure (TMEP)*
- 23) What are the three (3) separate bases provided by the Lanham Act for an applicant to register a mark in the United States?  
 ANSWER: *1 -Use of a mark "in commerce," 2 -A foreign application or registrations owner by a qualified foreign applicant, or 3- A bona fide intention to use the mark "in commerce" in connection with the goods or services identified in the application.*
- 24) Section 1051(b) of the Lanham Act permits an applicant to file what type of a U.S. trademark application?  
 ANSWER: *An intent-to-use application*
- 25) What is the specification of goods and services in a trademark application?  
 ANSWER: *It is the statement by the applicant as to the scope of protection to be sought by the trademark application. It identifies the specific goods and services in connection with which the mark will be used.*
- 26) On the average, what how long does the full cycle of a trademark application run from the time of filing to the final decision on registration?  
 ANSWER: *Between 18 and 24 months*
- 27) After a registration has been granted, a registrant will need to file which document between the fifth and sixth years of registration?  
 a) Section 9 Affidavit                      b) Section 15 Affidavit                      c) Section 8 Affidavit  
 d) Combined Section 8 & 15 Affidavit                      e) No filing is required  
 ANSWER: *C - Only a Section 8 Affidavit is required. A Section 15 Affidavit is voluntary*
- 28) Which of the following symbols is granted by the government:  
 a) ®                      b) <sup>SM</sup>                      c) <sup>TM</sup>                      d) None of these  
 ANSWER: *A - this is the only federally granted trademark symbol*
- 29) Is there a Universal Trademark Registration authority?  
 ANSWER: *No*
- 30) List the current multi-national trademark registries: (for extra credit, list the member countries for each multi-national registry)  
 ANSWER: *Currently, there are four (4) multinational trademark registries.*

- 1- **Organization Africaine de la Propriete Intellectuelle** or the African Intellectual Property Organization (OAPI or AIPO) comprised of Benin, Burkina Faso, Cameroon, Central African Republic, Chad, Congo, Gabon, Guinea, Ivory Coast, Mali, Mauritania, Niger, Senegal, and Togo
- 2- **African Regional Industrial Property Organization (ARIPO)** comprised of Botswana, Gambia, Ghanam Kenya, Lesotho, Malawi, Sierra Leone, Somalia, Sudan, Swaziland, Tanzania, Uganda, Zambia and Zimbabwe
- 3- **Benelux** comprised of Belgium, Luxembourg and the Netherlands
- 4- **The Office for Harmonization in the Internal Market (OHIM** also known as The Community Trademark) comprised of the members of the European Union, namely Austria, Belgium, Denmark, England, Finland, France, Germany, Greece, Ireland, Italy,

*Luxembourg, Netherlands, Portugal, Spain, and Sweden*

**Section 3:  
COPYRIGHT LAW**

- 31) Copyright law protects the \_\_\_\_\_ of an idea rather than the idea itself.  
*ANSWER: Expression*
- 32) List the eight (8) works of authorship currently protected by U.S. copyright law.  
*ANSWER:*  
*1. literary works*  
*2. musical works*  
*3. dramatic works*  
*4. pantomimes and choreographic works*  
*5. pictorial, graphic, and sculptural works*  
*6. motion pictures and other audiovisual works*  
*7. sound recordings; and*  
*8. architectural works.*
- 33) When does copyright exist in a work of authorship?  
*ANSWER: From the moment of creation of the work.*
- 34) In any work that was created on or after January 1, 1978 and the copyright is owned by an individual, the copyright will last for the life of the author, plus an additional \_\_\_\_ years.  
*ANSWER: 50*
- 35) In any work that was created on or after January 1, 1978 and the copyright is owned by an employer of the author (a work-for-hire), the copyright will last for the life of the author, plus an additional \_\_\_\_ years from the date of publication or \_\_\_\_ years from the date of creation. Whichever occurs first..  
*ANSWER: 75 and 100*
- 36) List the two (2) statutory requirements for a work to be considered copyrightable.  
*ANSWER: The work must have both originality and fixation*
- 37) Any work that contains an editorial revision, annotation or explanation to another work is considered to be a \_\_\_\_\_ work.  
a) Collective    b) Infringing    c) Derivative    d) Unregisterable    e) None of these  
*ANSWER: D*
- 38) What is the term for the limited use of a copyrighted work without the copyright owner=s permission?  
*ANSWER: Fair use*
- 39) Which of the following cannot receive copyright protection?  
a) Ideas                      b) Facts and titles              c) Sculptures  
d) Music session recording              e) None of these  
*ANSWER: A & B*
- 40) Name the one situation were a work is not owned by the actual creator of the work but the owner is still considered to be the author of the work.  
*ANSWER: A work made for hire*

- 41) The current U.S. copyright act allows for five (5) compulsory licenses. List the subjects of the these compulsory licenses:  
*ANSWER:*  
 1. *Cable television transmissions*  
 2. *Phonographic recordings*  
 3. *Jukeboxes*  
 4. *Noncommercial broadcasting*  
 5. *Satellite transmissions*
- 42) Which U.S. copyright forms would be used for filing applications for the following works?  
 A screen play Form \_\_\_\_\_  
 Each edition of a local newspaper as a group Form \_\_\_\_\_  
 An unpublished novel Form \_\_\_\_\_  
 A soundtrack for a motion picture Form \_\_\_\_\_  
 A sculpture Form \_\_\_\_\_  
*ANSWER:*  
*A screen play Form PA*  
*Each edition of a local newspaper as a group Form SE*  
*An unpublished novel Form TX*  
*A soundtrack for a motion picture Form SR*  
*A sculpture Form VA*
- 43) What is the current filing fee for a copyright application?  
*ANSWER: \$20.00*
- 44) Is it possible to receive international protection for a copyright without effecting national filings in multiple countries?  
*ANSWER: Yes.*
- 45) List the two (2) primary conventions governing international copyright protection.  
*ANSWER: 1. The Berne Convention is the International Convention for the Protection of Literary and Artistic Works (The Berne Convention) 2. The Universal Copyright Convention (UCC)*
- 46) Which element of the following copyright notice is included to give the author protection under the Buenos Aires Convention? "Copyright, 1998, The Jones Company, All Rights Reserved."  
*ANSWER: The element "All Rights Reserved"*
- 47) Which act was passed in the United States to include protection to an artist "moral rights?"  
*ANSWER: The Visual Artists Rights Act of 1990*

**Section 4: OTHER AREAS OF INTELLECTUAL PROPERTY**

- 48) How long may a trade secret be kept out of the public domain?  
*ANSWER: Indefinitely. Secrecy is the defining aspect of a trade secret.*
- 49) What is the federal statute governing trade secret law?  
*ANSWER: None. This is a trick question. Trade secret law remains a matter of individual state law.*

- 50) The right of every human being to control the commercial use of his or her identity and likeness is known as what type of intellectual property?  
*ANSWER: The right to publicity.*
- 51) Which of the following would have the largest damage claim (if any) if their image was used without their permission in a national ad campaign?  
 a) you            b) the anchor on your local news            c) Queen Elizabeth II of England  
*ANSWER: Queen Elizabeth (the more famous the more damages)*
- 52) Define the term Alegalization.@  
*ANSWER: The term Alegalization@ is defined as to make lawful or to sanction as by law.@ In international business and legal transactions, documents accompanying the transaction often must be legalized in order to complete the transaction. Making documents lawful, or legalizing them, involves a series of administrative steps in which representatives of various governments notarize and approve documents in preparation for filing them overseas.*
- 53) Can a governmental agency issue a “privately drafted” document?  
*ANSWER: No*
- 54) Which of the following agencies is not required for full legalization?  
 a) Notary Public            b) Embassy            c) Secretary of State’s Office  
 d) U.S. Department of State            e) Secretary of Commerce            f) All of these are required  
*ANSWER: E*
- 55) What is the advantage of the Hague Convention of October 1961 as it relates to legalization?  
*ANSWER: It allows simplified authentication processes (such as Apostilles) for member countries. This eliminates the need for full legalization in member countries.*
- 56) Is anyone required to search for intellectual property belonging to someone else?  
*ANSWER: No. No one is required. However, it is expected.*
- 57) What elements define the scope of:  
 a) a patent search  
 b) a trademark search  
 c) a copyright search  
*ANSWER:*  
**a) a patent search**  
 - the area of the invention and  
 - common terms in the industry  
**b) a trademark search**  
 - length and size of the mark  
 - proposed use of the mark  
 - meaning of the mark  
 - phonetics of the mark  
 - variations of the mark  
**c) a copyright search**  
 - the medium used for the copyrighted material  
 - the name of the work and the author
- 58) What are the operators in Boolean logic that control the search queries operated by Boolean

logic?

*ANSWER: "or," "and," and "not" along with parentheses to control structure of the search.*

- 59) Complete the meaning of the current seven (7) top-level names used in domain names on the Internet.

**".edu"** for \_\_\_\_\_

**".com"** for \_\_\_\_\_

**".net"** for \_\_\_\_\_

**".int"** for \_\_\_\_\_

**".org"** for \_\_\_\_\_

**".gov"** for \_\_\_\_\_,

**".mil"** for \_\_\_\_\_

*ANSWER:*

***".edu"** for educational organizations,*

***".com"** for commercial entities,*

***".net"** for computers of network providers such as InterNIC,*

***".int"** for international databases and organizations established by international treaties,*

***".org"** for other organizations,*

***".gov"** for federal government offices and agencies, and*

***".mil"** for the United States military.*

- 60) How does "surfing the net" differ from "searching the net?"

*ANSWER: Surfing refers to unstructured searching that basically blindly follows links to links in a haphazard manner. Searching refers to structured searching using Internet search engines.*