INTELLECTUAL PROPERTY LAW FOR THE ENTREPRENEUR

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INTELLECTUAL PROPERTY FROM THE BEGINNING OF THE BUSINESS

Next to its management team, intellectual property is a startup's most important asset. If intellectual property is properly identified, protected and managed, it can help the entrepreneur to grow the business, develop and market successful products and generate wealth. The importance of securing and protecting intellectual property from the beginning of the business is of the utmost importance to an entrepreneur. Attempts to short cut the intellectual property protection process will almost always have unintended consequences. Due diligence at critical funding or acquisition points in a startup's history will ferret out the loss or diminution of intellectual property caused by early attempts to short cut intellectual property protection. The result can be a diminished valuation of the business or, perhaps, a venture fund's decision not to go forward with a planned investment in it. Therefore the entrepreneur is urged to consider the following information closely. Most of the steps needed to protect intellectual property from the beginning are low in cost and, in some cases, can be accomplished merely by taking care in protection of the property. In other cases, the help of a trained intellectual property lawyer will be needed.

This paper provides essential information for the entrepreneur that is necessary both to protect and perfect a startup's intellectual property and also to guard against its potential loss. The various types of protection available and necessary for intellectual property protection are discussed in layperson's terms. Finally, this paper will discuss the types of agreements the entrepreneur must use to obtain, secure and protect the business's

intellectual property. These agreements, and the situations to which they apply, are summarized in the table at the end of this paper.

WHAT IS INTELLECTUAL PROPERTY?

Intellectual property exists in intangible creations of the human mind. Because this type of property originates in one's mind, the word "intellectual" is used to describe it.

The distinction between intellectual property and other forms of property can be seen by comparison. For example, real property is real estate. Personal property is tangible property other than real property, in which one takes personal ownership interest. These are objects like automobiles, wristwatches, furniture, personal computers and an almost endless number of other things.

Intellectual property, on the other hand, is property that is intangible when created although it can be embodied in tangible form. For example, a computer program is intangible information that can be expressed in tangible form like lines of code on a page or magnetized spots on a storage medium. The law gives these creations of the mind the status of property, just like real property and personal property, by protecting them under the intellectual property laws relating primarily to patents, copyrights, trademarks, trade secrets and contracts.

Intellectual Property Laws and Confidentiality

While the law affords patent, copyright, trademark, trade secret, contract and other forms of protection to intellectual property, the first step in protecting intellectual property is to maintain it as confidential.

CONFIDENTIAL INFORMATION

In addition to technological and marketing leadership, your business' success comes from its ability to maintain the information that provides that leadership confidential from your competitors who would benefit from using it. Therefore, your unpublished business and technical information that gives you a business advantage should be maintained in confidence as a first step in protecting it as your intellectual property.

Your business should follow security procedures to prevent loss of your confidential information. All unpublished writings, documents, media, articles, items of work-in-progress, and work products that embody your confidential information should be secured, when not in use, in locked files or in areas providing restricted access to prevent its unauthorized disclosure. In the event of any loss or unauthorized disclosure of your confidential information you should contact your attorney to determine whether corrective steps can be taken.

What Should You Consider as Your Confidential Information?

All unpublished information relating to your business that you or your employees generate in the course of employment, and that relates to your business, is your business's confidential information. This can be ideas, technology, concepts, techniques, technical information, inventions, know-how, computer code, business information, business plans, employee records, salary information, or any other valuable information that relates to your business, its products, its development efforts or its business plans. This information can be in written form or in non-written form such as spoken or visual form. Regardless of form, the information is your confidential information and should not be disclosed or transmitted to others except under strict and well formulated guidelines.

Confidential Information in Written or Other Recorded Form

Confidential information can exist in documentary form, whether hard copy form or electronically encoded form stored on magnetic, optical or other media. Documents in hard copy form should be marked "Confidential" on ***every page***. The confidentiality legend should also include the name of your company. Information in electronic form should also bear a confidentiality legend that is readable on every page that is printed or displayed.

Confidential Information in Non-Written Form

Confidential information can also exist in non-written, spoken or visual form. It is elementary that your confidential information should be discussed only with your employees who have a need to know that information. This information should not be communicated outside your business except under the guidelines discussed below in connection with non-disclosure agreements.

Computer Code

Confidential information also includes all of your computer code that has not been published. This can be source code, object code or microcode. To maintain the confidentiality of your computer code, the legend "Confidential" should be embedded within the code so that it is clearly visible on each page that is displayed or printed.

How Can Your Confidential Information Lose its Value?

Disclosing your confidential information outside of your business without maintaining its confidentiality is the primary way in which information can lose its status as protectable intellectual property. This can result in unintentionally declassifying your confidential information to non-confidential status. As a result, your competitors could be free to use your valuable confidential information for their own products. Unintended

declassification is usually done by providing your confidential information to people or organizations outside of yours, either in document form, in e-mails or in spoken or other non-documentary form, without first executing a written non-disclosure agreement (NDA) with the receiving party.

NON-DISCLOSURE AGREEMENTS GENERALLY

An NDA is an agreement between two parties that adequately protects each of them with respect to confidential information that is disclosed by one of the parties (usually called the disclosing party) to the other (usually called the receiving party). Generally, an NDA provides two kinds of protection. First, it grants the receiving party the right to use the information for a limited purpose. Second, the NDA obligates the receiving party not to disclose the confidential information of the disclosing party to others or use it other than
for the limited purpose stated in the NDA. Thus, the receiving party is protected because it is granted a positive, if restricted, right to use the confidential information, and the disclosing party is protected by the receiving party's confidentiality and restricted use obligations with respect to that information

An NDA also sets forth certain procedures under which confidential information must be disclosed for the information to be considered confidential information, and therefore protectable, under the NDA. For example, information that is disclosed in written form including, for example, by e-mail, usually must be marked "Confidential" at the time of disclosure. An NDA also usually provides that if the information is disclosed in other than written form, the receiving party must be told that the information is confidential at the time of disclosure, and this must be followed up with a brief written description of the information and that writing sent to the receiving party within a specified period of time after disclosure. The reason for these somewhat elaborate procedures is to give the receiving party notice of what it is that he or she is obligated to protect. This is also valuable to you if you are the disclosing party because there is a clear record of what confidential information the receiving party must

protect. If you are the receiving party, as you will be in some instances, this record will prevent the disclosing party from later wrongly alleging that you had access to confidential information that was not disclosed to you. See the discussion under "DAMAGE TO YOUR BUSINESS…" on page 8, below, for more information on this point.

Merely Executing an NDA is not Enough

While these disclosure procedures benefit both parties to an NDA, they require care when disclosing confidential information under it. Thus, executing an NDA is not all that is required to protect your confidential information. You must also manage the disclosure of that confidential information ***after*** executing the NDA and ***during*** the actual process of disclosing the information to the other party, to make certain you meet the required disclosure procedures outlined above. Failure to do so can result in the information you disclose not being considered as confidential information, and thus not protectable, under the NDA.

Your business should have its own standard mutual NDA specially drafted to be most advantageous to your particular business, keeping in mind the principles outlined above.

Considerations When Disclosing Confidential Information to Others Outside Your Business

Only confidential information that others have a need to know to advance your business objectives should be disclosed to them, and then only after you have entered into a written NDA with the receiving party. An example of this is when your business decides to enter into a development agreement or a joint development agreement with another business. The first step in this process is usually to execute an NDA for the confidential information that is to be disclosed for evaluation purposes to decide whether the ultimate objective is feasible.

You should always use your form of NDA when disclosing or receiving

confidential information. It is not advisable to change any of your NDA's terms when executing it with the other party without first consulting your attorney. If the other party offers ***its*** own NDA, it is likely that it contains terms beneficial to that party and detrimental to you. Therefore, it is advisable not sign another party's NDA without first consulting your attorney.

Disclosing Your Confidential Information to Your Customers

You should be particularly vigilant when providing your confidential information to your customers or prospective customers. There is a natural temptation to provide confidential information to customers without first entering an NDA, in order to enhance the possibility of obtaining the desired business. However, providing your confidential information to a customer without an NDA can declassify that information as certainly as if it were provided to a competitor without an NDA. The result can be that your customer can later legally use that information to your detriment, and legally disclose it to your competitors.

Computer Code is a Special Case

There are times when computer object code has to be disclosed to potential customers for evaluation prior to their entering into a license agreement for the code. An NDA is not sufficient for disclosing computer object code for evaluation. If object code is disclosed for evaluation, a specially drafted evaluation agreement is required. The agreement should include a very limited evaluation license and should include safeguards whose objectives are to prevent the evaluator from reverse engineering or reverse compiling the object code to obtain its source code.

Your source code is extremely valuable. Disclosing it outside your business or licensing it is always a serious risk. It is advisable not to transmit source code outside your business unless doing so advances a strategic interest. Even then, source code should not be disclosed or licensed except under a carefully drafted source code agreement providing

extremely restricted use provisions and secure procedures for handling the source code. These procedures include identifying authorized employees of the receiving party that will have access to the source code and carefully specifying trade secret protection for the code. The agreement should provide for a certification by the receiving party at set periods, showing that it is in compliance with the source code agreement. It should also include audit provisions to allow you to audit the receiving party to determine whether the receiving party is in compliance with all restrictions of the agreement.

DAMAGE TO YOUR BUSINESS BY ACCEPTING THE CONFIDENTIAL INFORMATION OF OTHERS

Your business can suffer serious liability by incorporating the confidential information of others into its products without first obtaining the right to use that information. In the worst case, receiving the confidential information of others without the right to use it can result in your business being legally prevented from developing products it might otherwise wish to develop. Therefore, no employee of your business should receive the confidential information of others unless it is necessary for your business interests. Furthermore, even when that necessity is met, confidential information of

others should not be received by your employees unless your standard NDA is executed with the discloser *before* you receive the information. Thereafter that confidential information must be treated in accordance with the NDA in all respects, and used only for the purposes stated in the NDA, usually only for evaluation purposes. If you desire to use the information in your products after you evaluate it, an additional license agreement is required. It is best to contact your attorney well in advance of this use for advice and counsel in obtaining any license that may be needed.

INVENTIONS

What is an Invention?

Invention has been defined by one author as the human creation of a new or different technical idea, and the physical means that can embody or accomplish that idea. An invention need not be a technological landmark to be an invention. Even a slight change or a slight improvement to something that already exists can be a valuable invention.
There are both patentable inventions and unpatentable inventions. Although a patent cannot be obtained for an *un*patentable invention, that invention is most likely still valuable as your confidential information and should be protected as described above.

A patentable invention, on the other hand, is one that meets the legal tests for patentability defined by the United States patent laws. These tests are, generally, whether the invention in patentable subject matter as defined by the patent laws, and then whether it is useful, novel and unobvious. The usefulness requirement is met if the invention achieves a concrete and tangible result. The novelty requirement is met if the invention is not identical to what existed in the past. The unobviousness requirement is met if the differences between the invention, taken as a whole, and what existed before it, would not have been obvious to one of ordinary skill in that technology at the time the invention was made. .

Often one overlooks the fact that he or she has made an invention by judging that the innovation does not rise to the level of invention. Frequently, however, a person judges his or her own work too harshly. If you have a technical idea that adds value to a product, you may well have made an invention. You should discuss your idea with your patent attorney. Together you can determine whether you have made a patentable invention and whether a patent should be applied for on it. However, as discussed below, there are acts that can occur that result in loss of right to a patent, even though the invention itself is otherwise patentable.

PATENTS

What is a Patent?

A patent is a monopoly granted by the federal government that allows an inventor to exclude others from making, using, offering for sale, or selling the patented invention, or importing it into the United States. The life of the patent monopoly (for other than design patents) was previously seventeen years from its issue date. Since June 8, 1995, the life of a U.S. patent, other than a design patent, filed on or after that date has been from its issue date until twenty years after its effective filing date.

What Types of Inventions are Patentable?

Patents can be obtained on inventions that are machines, compositions of matter, manufactured articles, processes, and improvements to any of the foregoing. Patents can be obtained for software, including microcode, by patenting either the innovative process the software carries out or by patenting storage media with the software recorded on it, as a manufactured article. In addition, patents are available on new business models.

Patents and Your Business

To compete effectively in the market place, your business requires an organized patent portfolio covering all of your important inventions. Patents covering your inventions are a corporate asset. Failure to obtain a patent on an important invention can amount to wasting a valuable corporate asset. One of the first things a venture capitalist or a potential acquirer will look at in due diligence when deciding whether or not to invest in your business is the strength of your patent portfolio.

Your patent attorney's role should be to formulate a strategy that will implement an effective patent portfolio for your business to prevent others from using your inventions. The portfolio can also be used as trading material when licenses under the patents of others may be required. In addition, your patent portfolio should be designed to allow licensing your inventions for royalty income if that is advantageous to your business. If your business is a small business, then in some cases you may be pleasantly surprised to learn that one or more of your patented inventions may become

implemented in a product line of a much larger corporation. In that case, that larger corporation's royalty exposure in your favor could be very large because of its prospective usage of your invention and might even lead to an acquisition. In any case, your patent portfolio, and the economic well-being it brings to your business, can be secured only if you disclose your inventions to, and discuss them with, your patent attorney early enough to secure patents on them.

What Acts Can Result in Loss of Patent Rights?

As mentioned previously, certain acts result in loss of rights to a patent, even if the invention is otherwise patentable. Generally, if an invention is published or placed on sale before a patent application is filed on it, the right to a patent is lost. To protect patent rights, all patent applications covering inventions to be used in a product should be filed before the date the product is first made public or offered for sale. This means that all inventions to be used in that product should be discussed with your patent attorney well in advance of that date. What constitutes publication, or placing an invention on sale, depends on the facts. As an example of placing on sale, even though there is no set price and no completed model of the invention available, presenting your product to a prospective customer might still amount to placing the inventions in that product on sale. This is true regardless of whether or not the act of offering for sale is made under an NDA because it is the act of *placing* the invention on sale that is the act of concern, not whether that act is done in confidence. So it's important to discuss these situations with your patent attorney well in advance of the fact.

COPYRIGHTS

What is a Copyright?

A copyright is a federal statutory right granted to every author of an original work that is expressed in a tangible medium of expression. An example of such a work is text or lines of computer code. The copyright is said to spring up as soon as the work is created. Copyright can be thought of as

arising when the words leave the pen. The copyright exists even if the copyright is not registered with the United States government. It is important to register the copyright for certain procedural advantages that registration gives, particularly in the case of copyright litigation. But copyright exists automatically even in the absence of registration.

The copyright laws grant to the author of the copyrighted work the exclusive right to do each of the following acts with that author's original work of authorship: (1) reproduce or copy it, (2) modify it (called "creating a derivative work"), (3) distribute it to the public, (4) perform the work publicly, and (5) display the work publicly.

Copyrights and Computer Code

Copyrights are particularly valuable in connection with computer code. If your business owns computer code it is protected by copyright, as well as by other forms of intellectual property protection as will be discussed below. Thus because of the copyright on your code you can prevent others from copying, modifying or executing the code for their own purposes, and from distributing it or publicly displaying it. This is because, as explained above, the copyright laws grant you as the author or owner of the code the exclusive

right to perform those acts with respect to it. On the other hand, you can obtain revenue from your code by granting a license under the copyright to permit others do any or all of the foregoing acts with the code.

Copyright Notice

A copyright notice reminds the public that your work of authorship is copyrighted. Under earlier copyright law, failure to include a copyright notice on a work when it was published resulted in loss of copyright. With the change in the copyright laws in recent years, failure to include a copyright notice no longer results in loss of copyright. However, each work of authorship, including each module in the case of software, should include your copyright notice. The notice is of the form **"Copyright, Year of First Publication, Owner's Name"**.

MULTIPLE FORMS OF LEGAL PROTECTION FOR THE SAME INTELLECTUAL PROPERTY

Multiple forms of legal protection can exist in the same intellectual property. For example the underlying algorithms in computer code, or a storage medium with the code recorded on it, can be protected by patent. The code itself, if kept as confidential information, can be afforded trade secret protection. At the same time, copyright immediately springs up in the computer code when it is written. Thus, certain types of intellectual property can be protected by two or even three forms of intellectual property protection simultaneously.

TRADEMARKS

What is a Trademark?

A trademark is a word, design or phrase which is used by a company to identify its product or service. When used to identify a service it is called a service mark. Examples of trademarks are "Kodak", "3M", and other well-known marks. Examples of service marks are "You Deserve A Break Today," owned by McDonald's Corporation, and "This Calls for a Coke," owned by the Coca-Cola Company. The primary purpose of a trademark or a service mark is to differentiate a company's products or services from its

competitor's products or services. It assures the consuming public that the product or service is of a certain quality. The owner of a trademark who uses

it for certain products or services has the right to prevent others from using the same or similar mark on similar products or services in the jurisdiction in which the trademark is protected.

Generic Names are not Trademarks

Trademark law cannot be used to protect "generic" names that describe a category or type of product. For example, a manufacturer cannot obtain a trademark on the word "chair" for use with furniture because "chair" is a generic name for a category of furniture. But "Barcalounger" can be a trademark. Trademarks can be lost if the mark becomes generic as a result of widespread misuse. If the mark comes to be used to refer to a category of products rather than as a brand name to identify a product from a particular manufacturer it will become unprotectable as generic under trademark law. An example of a trademark that became generic is "Thermos". The name "Thermos" was once a trademark but lost its status as a trademark because its owner did not police its use by others, allowed it to be used generically ("thermos" instead of "Thermos Bottle") and, consequently, over time trademark protection was lost. You should always use your trademark in an adjectival sense (e. g., "Xerox copier") and with a trademark notice. You should police your industry and inform your attorney if you find anyone who refers to your trademark without a trademark notice.

Trade Mark Clearance and Trademark Registration

You should have your attorney perform a trade mark clearance as soon as you decide on a trademark you would like to use for your product. It may well be that another person has already used the same or a similar trademark for the same or similar product for which you plan to use it. In such a case the trademark may not be available for your use. It is far better to obtain this information before you expend funds and effort in promoting use of a trademark that you will later have to cease using. Delaying this clearance can lead to discovering that a trademark is not available for use at critical times, such as at a late stage of funding or of an initial public offering. This can cause serious problems that negatively affect these activities.

Likewise, you should have your trademark registered in the United States Patent and Trademark Office (USPTO) promptly, in an effort to obtain registration before a competitor tries to do so with the same or similar mark. The trademark registration procedure involves a well formulated prosecution process between the trademark examiner and the trademark attorney. The examiner will attempt to prevent your registration of the same or similar mark that is used by another for products that are the same as, or similar to, yours. The USPTO's objective is to prevent likelihood of confusion as to the source of the product. Thus the earlier your use and the earlier your registration date, the more likely you are to be successful at obtaining registration.

Trademark Notice

When a trademark has not yet been registered in the USPTO, the letters TM (SM for service marks) in small caps should be used as the proper designation for a trademark notice. Similarly a footnote which identifies the trademark and its owner is also appropriate. For example, a notice that states, "RS 6000 is a trademark of the IBM Corporation" is appropriate when referring to that trademark.

After a trademark has been registered in the USPTO, the symbol ® should be used as the proper designation for a trademark notice. In addition to the symbol ® when the trademark has been registered, the following alternative trademark notices may also be used in a footnote for as a trademark for a registered trademark.

1. "Registered in U.S. Patent and Trademark Office"
2. "Reg. U.S. Pat. & Tm. Off."

However, the *filing* of a trademark application is not the same as *obtaining* a trademark registration. It is improper to use ®, or to otherwise indicate that the trademark is registered, until ***after*** the certificate of registration has actually been issued for the trademark by the USPTO. Penalties for use of

the registration symbol ® or the two alternative designations above ***before*** registration can be the USPTO's refusal to subsequently register the trademark, or the mark's becoming unenforceable against an infringer.

Where Should a Trademark Notice Appear in a Publication?

If the trademark notice appears with the first or most prominent use of the trademark in a publication, it is not necessary that the notice be repeated each time the trademark is used thereafter in the same publication. All marks, when used, should have the correct symbol adjacent to the mark (*i.e.* TM, ®, and SM, as discussed above) and the owner of the mark should be properly identified either in the text or in a footnote.

INFRINGEMENT OF YOUR INTELLECTUAL PROPERTY BY OTHERS

Your business makes a substantial investment in intellectual property. From time to time you may observe, at trade shows or other demonstrations, instances in which your competitors may have infringed your intellectual property rights. If you observe a competitive product that appears likely to embody any of your intellectual property you should attempt to learn whatever information is publicly available about the operation and content of the competitive product. You should then promptly discuss this information with your intellectual property attorney to determine whether and how you should enforce your intellectual property rights against the competitive product.

WRITTEN AGREEMENTS ARE NECESSARY TO PROTECT INTELLECTUAL PROPERTY CREATED BY OR FOR YOUR BUSINESS

When work is performed, intellectual property is often created. It is essential that any work done for your business, whether done by yourself or your employees, consultants, or other corporations, be performed under written agreement that secures your rights in the intellectual property that is

created as that work is done. Each such agreement must specify ownership of and license rights to any resulting intellectual property. The agreement should be drafted by your intellectual property attorney after you discuss the salient points of the matter, and should be executed before the work is begun. This written agreement is in addition to any NDA that you may have with the party doing the work. An NDA does not secure intellectual property rights. Therefore a mere NDA is not sufficient for securing your rights in the intellectual property that is created when work is done for your business. Likewise, a purchase order is generally not sufficient for this purpose. Schwegman, Lundberg and Woessner lawyers provide intellectual property services in securing the intellectual property rights, and in drafting the agreements, discussed above.

SUMMARY OF TYPES OF INTELLECTUAL PROPERTY AGREEMENTS

To protect your intellectual property, the following types of work should have the indicated agreement drafted, negotiated and executed before the work is undertaken.

WORK SITUATION	**AGREEMENT REQUIRED**
Hiring New Employee into Your Business	Employee Proprietary Information And Inventions Agreement
Hiring Consultant to Perform Work for Your Business	Consulting Agreement
Before Discussing Your Business's Confidential Information with Third Party	Mutual Non-Disclosure Agreement
Selling Hardware Products to Customer	Your Terms And Conditions of Sale
Developing Software	Software Development Agreement
Licensing Existing Software to a Customer	Software License Agreement
Jointly Developing Products with Third Party	Joint Development Agreement
Having Third Party Develop	Hardware Development Agreement

Hardware Product	
Having Third Party Develop Software Product	Software Development Agreement
Having Third Party Supply Existing Software	OEM Software License Agreement
Loaning Equipment to Third Party	Equipment Loan Agreement
Distributing Third Party's Products	Marketing and Distribution Agreement
Contract Manufacturing	Contract Manufacturing Agreement
Equipment Lease	Equipment Lease Agreement
Facilities Lease	Lease Agreement
Appointing a Sales Representative	Sales Representative Agreement
Appointing Distributor (Exclusive or Non-Exclusive)	Distributor Agreement
Government FAR Matters	FAR Agreement
Structuring a Proposed Business Relationship	Memorandum of Understanding
License-In or License-Out	License Agreement
Original Equipment Manufacturer Relationship	OEM Agreement
Accessing Your Business's Website	Website User Agreement and Privacy Policy
Website Advertising	Website Advertising and Reciprocal Linking Agreements
Website Development	Website Development Agreement
Website Hosting	Website Hosting Agreements

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