

Intellectual Property Law 知识产权法



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Common IP Mistakes Made by Entrepreneurs 企业家常犯的知识产权方面的错误



- **Failing to properly register trademarks** 未适当地登记商标
- **Failing to secure rights from founders to all needed IP by assignment or licensure** 未从创建人处通过转让或者许可获得所需的知识产权
- **Failing to address how jointly owned patents are to be licensed and utilized in joint development situations** 在联合开发中未明确共同所有的专利如何许可和使用

Common IP Mistakes Made by Entrepreneurs

企业家常犯的知识产权方面的错误



- Failing to file US patent application within one year of public disclosure or other statutory bar 未在公开披露后一年内及时提交美国专利申请或者其它法定障碍
- Failing to consider international patent protection prior to disclosure (no one year grace period) 未在公开披露之前考虑国际专利保护（没有一年的宽限期）
- Failing to use nondisclosure agreements 未使用保密协议



Importance of Intellectual Property (“IP”) to a Company

知识产权对一个企业的重要性



- Increasingly important as a business asset 作为一项商业资产越来越重要
- May constitute the most valuable asset in technology companies 可能为高科技企业最有价值的资产



Why do Companies Care about IP?

企业为何关心知识产权?



- ▣ **Freedom to Operate** – make sure someone else’s IP will not prevent your company from carrying out its business objectives

生产自由-确保他人的知识产权不会阻碍企业商业目标的实现

- ▣ **Competitive Advantage** – protect your company’s IP so it can be used to gain a competitive advantage in the marketplace through precluding others from utilizing the IP

竞争优势-保护企业的知识产权以便企业通过排除他人对该知识产权的使用而在市场中获得竞争优势



Ways to Protect IP

保护知识产权的途径



- ▣ **Copyrights** – original works of authorship, including software 著作权 – 原创作品，包括软件
- ▣ **Trademarks** – word, symbol or device that identifies the source of goods 商标 – 用于区分商品来源的文字，标记或者图形，
 - ▣ Company logos 公司的标志性图标
- ▣ **Patents** – right to exclude others from making, using, or offering for sale the invention 专利 – 排除他人制作，使用或者承诺销售其发明创造的权利
- ▣ **Trade Secrets** – secret information that gives owner a competitive advantage 商业秘密 – 能给予所有人竞争优势的秘密信息
 - ▣ KFC’s secret recipe 肯德基的秘密菜谱



Hershey's Kisses
Protected by Five Types of Intellectual Property Protection
好时巧克力受五种知识产权的保护

- ▣ Trademark for its shape (#1,584,608) 形状受商标权的保护
- ▣ Patent for its method of reducing fat levels in cocoa used (#5,464,649) 在使用的可可中减少脂肪成分的制作方法受专利保护
- ▣ Copyright for commercials made to advertise (PAU-697-741) 广告受著作权的保护
- ▣ Trade secret on its recipe for producing the milk chocolate candy 生产牛奶巧克力的配方受商业秘密保护
- ▣ Contracts (nondisclosure agreements, employment agreements, etc.) 合同保护 (保密协议, 劳动合同等等)



Copyrights 著作权

- ▣ Exclusive Rights of Copyright Owner
著作权人的排他性权利
 - ▣ Reproduction
复制
 - ▣ Prepare derivative works
制作衍生作品
 - ▣ Distribute copies
发行
 - ▣ Public performance or display
公演或展览



Copyrights - Ownership of Work of Others

著作权-对他人作品的所有权



- ▣ **Employers** - can gain copyright over works of employees if the work was created *within the scope of employment*

用人单位-可以对员工在**职务范围内**产生的作品享有著作权

- ▣ **Work for Hire** - company commissioning the work may or may not become the owner

委托作品-委托该项工作的企业可能成为著作权人

- ▣ **Prudent to document these issues in a signed agreement which also contains language addressing assignment of copyright** 将这些问题写入包含著作权转

让条款的合同中是明智的做法



Copyrights - How to Gain Protection

著作权- 如何获得保护



- ▣ **Protection exists from the date the work is created in fixed form even without publication or registration** 著作权保护从作品在有形媒介上表现出来的那一天开始，即使未发表或者登记

- ▣ **Marking a work with the © symbol provides notice to the world that the work is protected but is not required for newer works** 标上©标记公示该作品受著作权保护，但较新的作品没有这一要求

- ▣ **Registering a work with the U.S. Government provides the highest degree of protection, allowing for the recovery of statutory damages in addition to injunctive relief** 向美国政府进行著作权登记给予一作品最高层次的保护，能获得除停止侵权以外的法定赔偿



Trademarks – Source of Goods

商标- 商品的来源

- ▣ Trademark: a word, symbol or device that identifies and distinguishes the *source of goods* of one party from those of others 商标: 文字, 标记或图形用于识别和区分商品来源
 - ▣ Service Mark – similar to trademark except that it identifies services as opposed to goods 服务商标-与商品商标类似但用于识别服务而不是商品
- ▣ Allows first actual or constructive (i.e. federally registered) user to prevent others from using the trademark for goods or services on same or related goods or services 允许第一个实际的或者推定的(即联邦登记的)使用者防止他人将该商标用于相同或类似的商品或服务上

Trademarks – Items That Can be Protected

商标-能受保护的事物

- ▣ Can protect: 能保护的
 - ▣ product names and logos 产品名称和标志性图标
 - ▣ the name Nike and the Nike swoosh 耐克名称和耐克勾图案
 - ▣ sales slogans 销售标语
 - ▣ container shapes and distinctive packaging 容器形状和特色包装
 - ▣ Shape of a Coke bottle 可乐瓶的形状
 - ▣ Sounds 声音
 - ▣ Intel chime 英特尔的乐声

Trademarks – Obtaining and Keeping

商标-获得和维持

- ▣ **Perform a Search 调查**
 - ▣ Make sure the potential trademark is not already being used 确认潜在的商标未已被使用
- ▣ **Avoid generic or descriptive terms 避免通用的或描述性的词语**
 - ▣ Arbitrary marks that have no relation to the product stand the best chance of being recognized as a mark with product-unrelated arbitrary marks most likely to be remembered as trademarks
- ▣ **Make wide use of the trademark and make sure that it is used and marked properly 广泛使用商标并确保正确使用和标示**
- ▣ **Register your trademark at the federal and state levels 分别在联邦和州注册你的商标**



Patents – Definition

专利 - 定义

- ▣ **RIGHT TO EXCLUDE others from making, using, selling, or offering for sale the invention in the U.S. or importing the invention to the U.S. 排除他人在美国制造，使用，销售或承诺销售该发明创造或者将其进口到美国的权利**
- ▣ **Can have a patent but not be able to use the invention if it would infringe on another patent 可能出现享有一专利但不能付诸实施的情况，因为实施会侵犯另一专利**
- ▣ **Generally US patents last 20 years from when application filed with USPTO 美国专利的保护期一般为20年，从向美国专利和商标局提出申请之日起算**



Patents – Requirements

专利 – 要求

- ▣ **Useful** and fit into one of the following categories:
实用性,并属于以下其中一类
 - ▣ Process, machine, manufacture, composition of matter, ornamental design, or biological plant 工艺过程, 机械, 制造, 物质构成, 外观设计或者生物物种
- ▣ **Novel** – must not already be in the public knowledge or in public use 新颖性-必须未为公众所知悉或者公开使用过
- ▣ **Nonobvious**–in the view of prior art and knowledge to a person having an ordinary level of skill in the pertinent area 非显而易见性-从现有技术和本技术领域普通技术人员知识角度判断

Patents – Issues Prior to Filing Application

专利-提交申请前的问题

- ▣ Is there already a patent or a patent pending for a similar device? 是否已有类似的设备获得专利或正在申请专利?
- ▣ What is the life-span of the invention? 该发明创造的寿命有多长?
 - ▣ A short life-span may make a patent impractical 短暂的寿命可能导致申请专利不可行
- ▣ Is a patent the appropriate protection? 专利权是否是合适的保护?
 - ▣ Would disclosing the information required to patent give an advantage to competitors? 披露要求的信息是否会给竞争对手带来好处?
 - ▣ Would company goals be better served by holding the information as a trade secret? 如果该信息以商业秘密是否更有利于该企业?

Patents – Prior to Filing Application

专利-提交申请之前



- **US a first to invent country (rest of world first to file)** 美国实行先发明原则（世界其他国家实行先申请原则）
- **Documenting date of invention (conception and reduction to practice) important – use witnessed laboratory notebooks and invention disclosure forms** 发明（构想和付诸实施）的纪录日期非常重要 – 可采用有证人证明的实验室纪录和发明公开披露表格

Patents – Bars to Patentability

专利-可专利性的障碍



- **US Patent** – must file U.S. application within one year of public disclosure of the invention 美国专利-必须在该发明创造公开披露后一年内提交申请
- **Foreign** – most foreign patent applications must be filed prior to public disclosure of the invention 国外-大多数专利的国外申请必须在该发明创造公开披露之前提起
- Use of nondisclosure agreements is important in order to prevent public disclosure 为防止泄密，保密协议是很重要的
- Section 102 is complex and has bars to patentability that include printed publications, sales or offers for sale, public use, public knowledge, and invention by another – check with patent attorney prior to taking action with respect to potentially patentable invention 第102条很复杂，并包含很多可专利性的障碍，如书面发表，销售或承诺销售，公共使用，公共认识和第三人发明-在采取行动之前应就可申请专利的发明创造咨询专利律师

Patents – US Provisional Patent Application

专利 – 美国临时专利申请



- ▣ An option that can be utilized to avoid, for a certain time, loss of patent rights through public disclosure 可在一定时间内避免因公开披露而导致专利权丧失一个选择
 - ▣ Example: article containing enabling disclosure of the invention will be published in scientific journal 举例：在科学杂志上发表包含有披露发明信息的文章
- ▣ Filing date as of the date of filing the provisional application 临时申请日将被视为申请日
- ▣ Must file a regular application within one year or lose your filing date (and ability to obtain a patent if public disclosure made) 必须在一年内提交正规申请否则丧失临时申请日（和获得专利的能力如果已公开披露）
- ▣ Does not count against the 20 year term 不计算在20年保护期内

Trade Secrets – Definition

商业秘密 – 定义



- ▣ Any formula, pattern, device or compilation of information used in a business that gives the trade secret owner an *opportunity to obtain an advantage* over competitors who do not know it. The trade secret can not be public knowledge. 一个企业所使用的，能给该企业带来超过不知道该秘密的竞争者的优势的机会的任何配方，设计，装置或者信息编辑。商业秘密不可以是公共常识。
- ▣ Examples: KFC secret recipe, Coke formula 举例：肯德基的秘密菜谱，可乐的配方

Trade Secrets – Protection

商业秘密 – 保护

- ▣ If information is secret and *reasonable measures are taken to keep it secret*, it will be protected by law 如果一信息是秘密的并被采取了合理的保密措施的，法律将对其予以保护
- ▣ The law does not create a monopoly for use on the secret like other protections of intellectual property, but it only *protects* the secret from being *improperly appropriated* 与其它知识产权不同，法律保护不会对该秘密信息的使用产生垄断，法律仅保护该秘密信息不被盗用
- ▣ Unlike patents, trade secrets may be “reverse engineered” and thus no longer secret 不同于专利，商业秘密可被“逆向开发”从而不再是秘密



Trade Secrets – Protection

商业秘密 – 保护

- ▣ Businesses need to take proper steps to ensure the security of their trade secrets 企业需要采取合理的措施来确保其商业秘密的安全
 - ▣ Security within the plant or office 工厂或办公室的保全
 - ▣ Contractual safeguards with employees and business partners such as non-competition agreements and confidentiality agreements 与员工和商业伙伴的合约保障，例如竞业禁止协议和保密协议
 - ▣ Workplace controls to prevent the dissemination of trade secrets to individuals that do not need access to them 工作场地控制以防止商业秘密传播到无须知晓的个人



Licensing Issues

许可使用问题



- ▣ **Exclusive vs. Nonexclusive** 排他性许可与非排他性许可
- ▣ **One or a few fields of use vs. all fields of use** 一个或某些领域的许可和全面许可
- ▣ **Territory – worldwide vs. geographic restrictions** 地域范围-全世界的和区域性限制
- ▣ **Right to sublicense** 再许可权利
- ▣ **Royalty rate and sharing of sublicensing revenues** 许可费用和再许可收入的分配
- ▣ **Term or duration** 期限



Licensing Issues in a University Setting

高校里的许可问题



- ▣ **Inventor in University setting required to disclose invention to University** 高校里的发明者需要向学校披露其发明创造
- ▣ **University will evaluate and decide whether to patent** 高校会进行评估和决定是否申请专利
- ▣ **If University pursues patent it will become the owner of the patent** 如果高校申请专利，学校会成为专利的所有人



Licensing Issues in a University Setting

高校里的许可问题

- ▣ University will frequently license the patent to startup company owned by inventor if the startup is serious about commercializing the technology 高校经常会许可发明者的创业公司使用该专利如果该创业公司真的想把该技术商业化
 - ▣ Be a company 是一个公司
 - ▣ Be capable of meeting market demand 有能力适应市场需求
 - ▣ Have written plan to commercialize the technology 有书面计划将该技术商业化
 - ▣ Address conflicts of interest (time constraints for faculty, influence over students, influence on junior faculty, effect on research) 解决利益冲突问题 (教职员时间上的限制, 对学生的影响, 对年轻教职员的影响, 对研究的作用)



Licensing Issues in a University Setting

高校里的许可问题

- ▣ Due Diligence milestones 尽职调查里程碑
- ▣ Minimum royalty payments 最低许可费用的支付
- ▣ Repayment of patent costs advanced by University 学校预付的专利费用的返还
- ▣ Equity in startup to be taken by University? 学校在创业公司里是否享有股份?
- ▣ Issue fee 专利领证费
- ▣ License of trademarks 商标的许可使用
- ▣ www.otm.uiuc.edu



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