

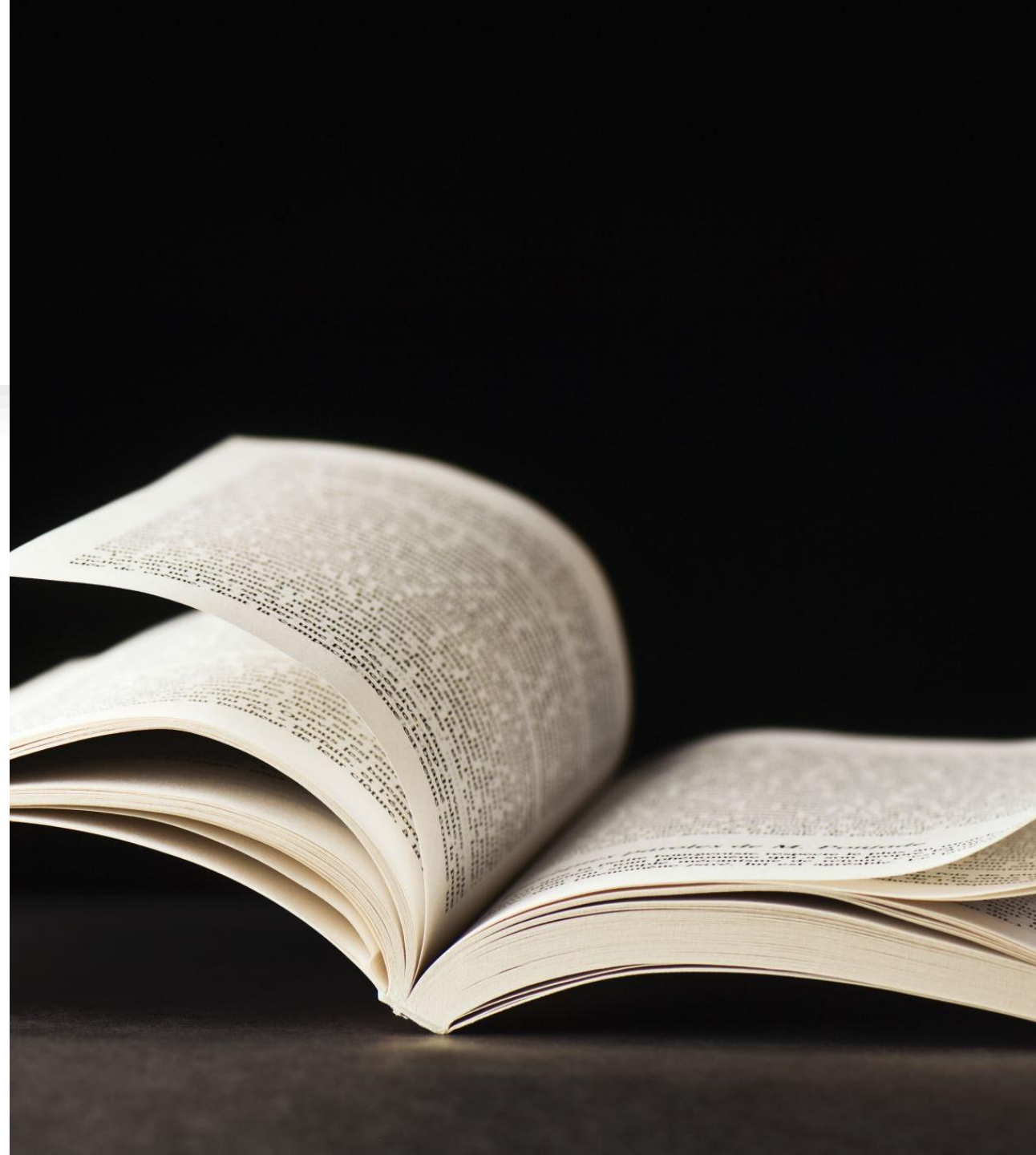
Intro to U.S. IP Law

CONSTITUTIONAL FOUNDATIONS: Intellectual Property Rights

*[The Congress shall have Power . . .] To promote the Progress of Science and useful Arts, by securing for limited Times to **Authors** and **Inventors** the exclusive Right to their respective **Writings** and **Discoveries**.*

U.S. Constitution

Article One, Section Eight, Clause Eight



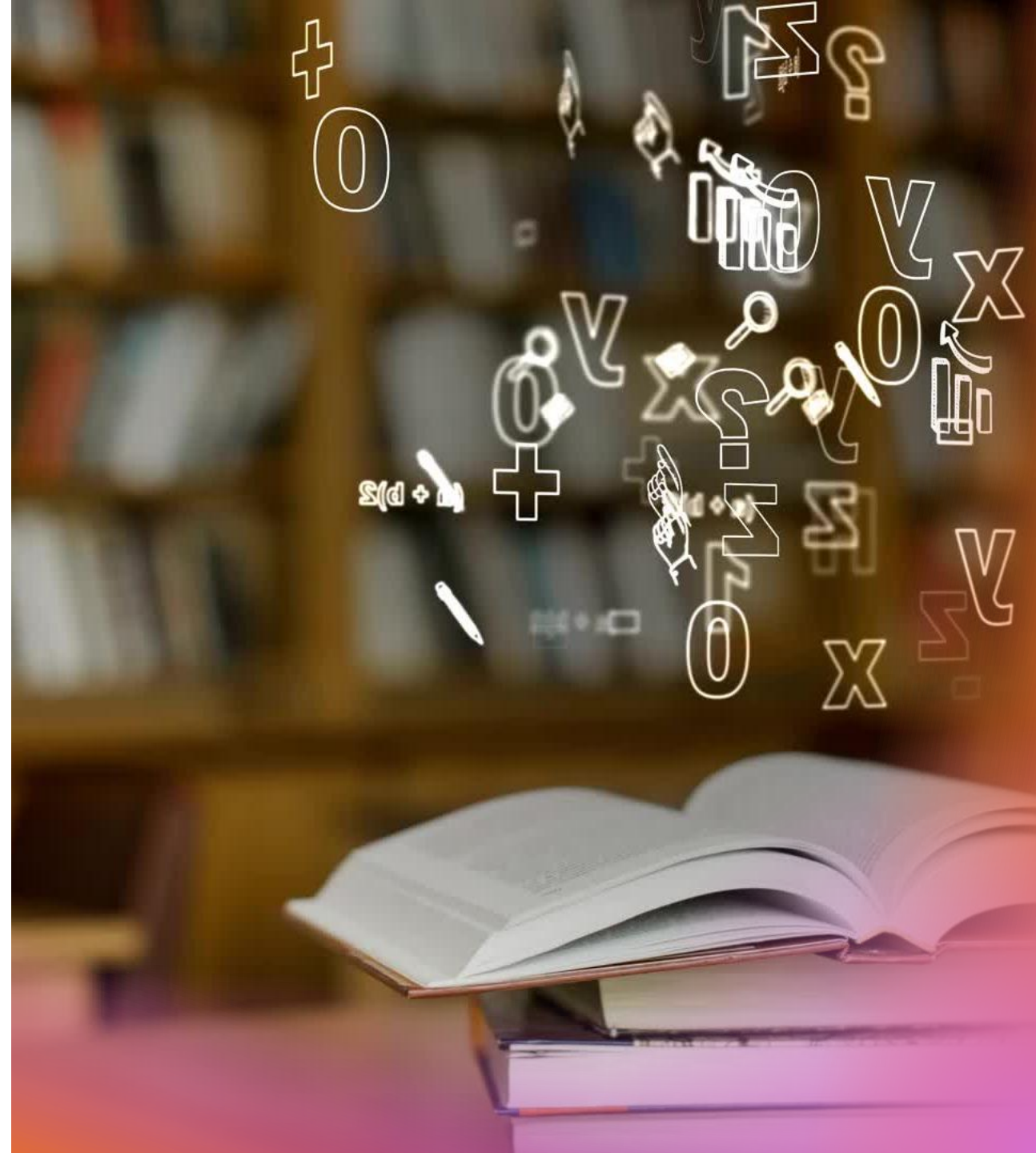
Promoting Progress

"The Congress shall have Power . . .

To promote the Progress

of Science and useful Arts..."

The U.S. Constitution affirmatively recognizes that ownership of the outputs of mental labors enables Americans to invest themselves in advancing science and the arts.



Exclusive Ownership

“the exclusive Right”

Just as with physical forms of property, qualifying outputs of mental labors are protected in U.S. law by a “right to exclude” others from their use or reproduction.





Time Limits

"for limited Times"

As directed by the Constitution, Congress has made exclusive IP rights available to inventors, authors, and brands for only limited terms of protection.



Recognizing the public benefit from dissemination of knowledge and ideas, the U.S. Constitution authorizes Congress to enact laws that, unlike those protecting physical labor, afford inventors and authors exclusive rights to the fruits of their mental labors for only a set period of time before those works enter the public domain.

Intellectual Property Rights

Consistent with its constitutional authority, beginning with the Patent Act of 1790 the U.S. Congress has established exclusive legal rights to certain outputs of mental labors in the form of intellectual property (“IP”).



Forms of IP Rights

The U.S. Congress has exercised its constitutional authority to provide for various forms of intellectual property (“IP”) rights in U.S. law. Currently, four types of work are statutorily protected:


- Inventions and discoveries are eligible for **patents**;
- Creative works are covered by **copyrights**;
- Brands, logos, and identifying marks are recognized as **trademarks**; and,
- Proprietary information and know-how can be protected as **trade secrets**.





IP Law in U.S. Statute

IP laws are found in United States Code:

- ✓ **Title 15 - Trademarks**
 - ✓ **Title 17 - Copyrights**
 - ✓ **Title 18 - Trade Secrets**
 - ✓ **Title 35 - Patents**
- 

Key Principles in U.S. IP Law

Subject Matter & Eligibility

Ownership & Exclusive Rights

Application, Examination & Certification

Term

Validity

Infringement & Remedies

Opposition

Transferability

Key Principles of U.S. IP law in United States Code

	Subject Matter	Eligibility	Ownership	Exclusive Rights	Application	Examination	Certification	Term	Validity	Infringement	Remedies	Opposition	Transferability
Trademarks Title 15 Chapter 22	§1052	§1051	§1057 §1072	§1115	§1051	§1062	§1057	§1058	§1052	§1114 §1124	§1116	§1063 §10666a §1067	§1060
Copyrights Title 17	§102	§104	§201	§106	§408	§410	§410	§302	§102	§501	§502 §503 §504 §505	§107?	§201
Trade Secrets Title 18 Chapter 90	§1839	§1839	§1839		N/A	N/A	N/A	N/A	§1839	§1832 §1839	§1836	N/A	
Patents Title 35	§100	§101	§261	§154	§111	§131	§151 §153	§154	§102 §103 §112 §282	§271	§281 §283 §284	§311 §312 §231 §322	§261

Key Concepts
of Trademark Law

Brands, Logos & Identifying Marks

**United States Code
Title 15, Chapter 22 (abridged)**

Statutory Basis: Trademarks

SUBCHAPTER I—THE PRINCIPAL REGISTER (§§ 1051 – 1072)

SUBCHAPTER II—THE SUPPLEMENTAL REGISTER (§§ 1091 – 1096)

SUBCHAPTER III—GENERAL PROVISIONS (§§ 1111 – 1129)

SUBCHAPTER IV—THE MADRID PROTOCOL (§§ 1141 – 1141n)

15 U.S. Code

Chapter 22 - TRADEMARKS

Statutory Basis: Trademarks

Subchapter I - THE PRINCIPAL REGISTER

§ 1051. Application for registration; verification

§ 1052. Trademarks registrable on principal register; concurrent registration

§ 1053. Service marks registrable

§ 1054. Collective marks and certification marks registrable

§ 1055. Use by related companies affecting validity and registration

§ 1056. Disclaimer of unregistrable matter

§ 1057. Certificates of registration

§ 1058. Duration, affidavits and fees

§ 1059. Renewal of registration

15 U.S. Code

Chapter 22, Subchapter I

§ 1060. Assignment

§ 1061. Execution of acknowledgments and verifications

§ 1062. Publication

§ 1063. Opposition to registration

§ 1064. Cancellation of registration

§ 1065. Incontestability of right to use mark under certain conditions

§ 1066. Interference; declaration by Director

§ 1066a. Ex parte expungement

§ 1066b. Ex parte reexamination

§ 1067. Interference, opposition, and proceedings for concurrent use registration or for cancellation; notice; Trademark Trial and Appeal Board

§ 1068. Action of Director in interference, opposition, and proceedings for concurrent use registration or for cancellation

§ 1069. Application of equitable principles in inter partes proceedings

§ 1070. Appeals to Trademark Trial and Appeal Board from decisions of examiners

§ 1071. Appeal to courts

§ 1072. Registration as constructive notice of claim of ownership

Statutory Basis: Trademarks

Subchapter III - GENERAL PROVISIONS

§ 1111. Notice of registration; display with mark; recovery of profits and damages in infringement suit

§ 1112. Classification of goods and services; registration in plurality of classes

§ 1113. Fees

§ 1114. Remedies; infringement; innocent infringement by printers and publishers

§ 1115. Registration on principal register as evidence of exclusive right to use mark; defenses

§ 1116. Injunctive relief

§ 1117. Recovery for violation of rights

§ 1118. Destruction of infringing articles

§ 1119. Power of court over registration

§ 1120. Civil liability for false or fraudulent registration

15 U.S. Code Chapter 22, Subchapter III

§ 1121. Jurisdiction of Federal courts; State and local requirements that registered trademarks be altered or displayed differently; prohibition

§ 1121a. Transferred

§ 1122. Liability of United States and States, and instrumentalities and officials thereof

§ 1123. Rules and regulations for conduct of proceedings in Patent and Trademark Office

§ 1124. Importation of goods bearing infringing marks or names forbidden

§ 1125. False designations of origin, false descriptions, and dilution forbidden

§ 1126. International conventions

§ 1127. Construction and definitions; intent of chapter

§ 1128. Repealed. Pub. L. 110–403, title III, § 305(a)(1), Oct. 13, 2008, 122 Stat. 4270

§ 1129. Transferred

Subject Matter

§ 1052 - Trademarks registrable on principal register; concurrent registration

[Any] trademark by which the goods of the applicant may be distinguished from the goods of others...

Ownership

§ 1072 - Registration as constructive notice of claim of ownership

Registration of a mark on the principal register... shall be constructive notice of the registrant's claim of ownership thereof.

§ 1057 - Certificates of registration

(b) Certificate as prima facie evidence

A certificate of registration of a mark upon the principal register provided by this chapter shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the owner's ownership of the mark, and of the owner's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate, subject to any conditions or limitations stated in the certificate.

Eligibility

§ 1051 - Application for registration; verification

(3) The statement shall be verified by the applicant and specify that—

- (A) the person making the verification believes that he or she [is] the owner of the mark sought to be registered;
- (B) ...the facts recited in the application are accurate;
- (C) the mark is in use in commerce; and
- (D) ...no other person has the right to use such mark in commerce either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods of such other person, to cause confusion, or to cause mistake, or to deceive...

Trademark Application

§ 1051 - Application for registration; verification

(a) Application for use of trademark

(1) The owner of a trademark used in commerce may request registration of its trademark on the principal register hereby established by paying the prescribed fee and filing in the Patent and Trademark Office an application and a verified statement...

Examination & Publication

§ 1062 - Publication

(a) Examination and publication

Upon the filing of an application for registration and payment of the prescribed fee, the Director shall refer the application to the examiner in charge of the registration of marks, who shall cause an examination to be made and, if on such examination it shall appear that the applicant is entitled to registration... the Director shall cause the mark to be published in the Official Gazette of the Patent and Trademark Office...

Trademark Registration

§ 1057 - Certificates of registration

(a) Issuance and form

Certificates of registration of marks registered upon the principal register shall be issued in the name of the United States of America, under the seal of the United States Patent and Trademark Office... . The registration shall reproduce the mark, and state that the mark is registered on the principal register under this chapter, the date of the first use of the mark, the date of the first use of the mark in commerce, the particular goods or services for which it is registered, the number and date of the registration, the term thereof, the date on which the application for registration was received in the United States Patent and Trademark Office, and any conditions and limitations that may be imposed in the registration.

Exclusive Right

§ 1115 - Registration on principal register as evidence of exclusive right to use mark; defenses

(a)Evidentiary value; defenses

Any registration issued under the Act of March 3, 1881, or the Act of February 20, 1905, or of a mark registered on the principal register provided by this chapter and owned by a party to an action shall be admissible in evidence and shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the registration

Trademark Term

§ 1058 - Duration, affidavits and fees

(a) Time periods for required affidavits

Each registration shall remain in force for 10 years, except that the registration of any mark shall be canceled by the Director unless the owner of the registration files in the United States Patent and Trademark Office affidavits ... within the following time periods:

(1) Within the 1-year period immediately preceding the expiration of 6 years following the date of registration under this chapter or the date of the publication under section 1062(c) of this title.

(2) Within the 1-year period immediately preceding the expiration of 10 years following the date of registration, and each successive* 10-year period following the date of registration. ...

** Registration renewable for additional, consecutive 10-year periods while the mark remains in use (§ 1059 - Renewal of registration).*

Infringement

§ 1114 - Remedies; infringement; innocent infringement by printers and publishers

(1) Any person who shall, without the consent of the registrant—

(a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive; or

(b) reproduce, counterfeit, copy, or colorably imitate a registered mark and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive, shall be liable in a civil action by the registrant for the remedies...

Counterfeits

§ 1124 - Importation of goods bearing infringing marks or names forbidden

[N]o article of imported merchandise which shall copy or simulate the name of any domestic manufacture, or manufacturer... shall be admitted to entry at any customhouse of the United States...

Injunctive Relief

§ 1116 - Injunctive relief

(a) Jurisdiction; service

The [courts] shall have power to grant injunctions, according to the principles of equity and upon such terms as the court may deem reasonable, to prevent the violation of any right of the registrant of a mark registered in the Patent and Trademark Office...

A plaintiff seeking any such injunction shall be entitled to a rebuttable presumption of irreparable harm upon a finding of a violation...

Opposition (Pre-Grant)

§ 1063 - Opposition to registration

- (a) Any person who believes that he would be damaged by the registration of a mark upon the principal register, including the registration of any mark which would be likely to cause dilution by blurring or dilution by tarnishment [...may...] file an opposition in the Patent and Trademark Office, stating the grounds therefor... .

Opposition (Post-Grant)

§ 1066a - Ex parte expungement

(a) Petition

Notwithstanding sections 1057(b) and 1072 of this title, and subsections (a) and (b) of section 1115 of this title, any person may file a petition to expunge a registration of a mark on the basis that the mark has never been used in commerce on or in connection with some or all of the goods or services recited in the registration.

Trademark Trial and Appeal Board (TTAB)

§ 1067 - Interference, opposition, and proceedings for concurrent use registration or for cancellation; notice; Trademark Trial and Appeal Board

(a) In every case of interference, opposition to registration, application to register as a lawful concurrent user, or application to cancel the registration of a mark, the Director shall give notice to all parties and shall direct a Trademark Trial and Appeal Board to determine and decide the respective rights of registration.

Cancellation

§ 1064 - Cancellation of registration

A petition to cancel a registration of a mark, stating the grounds relied upon, may... be filed... by any person who believes that he is or will be damaged... by the registration of a mark on the principal register...

- OR -

(3) ...if the registered mark becomes the generic name for the goods or services... for which it is registered, or is functional, or has been abandoned, or its registration was obtained fraudulently

- OR -

...if the registered mark has never been used in commerce on or in connection with some or all of the goods or services recited in the registration...

Transfer of Ownership

§ 1060 – Assignment

(a)

(1) A registered mark or a mark for which an application to register has been filed shall be assignable with the good will of the business in which the mark is used, or with that part of the good will of the business connected with the use of and symbolized by the mark.

Key Concepts of Copyright Law

Creative Works

**United States Code
Title 17 (abridged)**

STATUTORY BASIS: Copyrights

CHAPTER 1—SUBJECT MATTER AND SCOPE OF COPYRIGHT (§§ 101 – 122)

CHAPTER 2—COPYRIGHT OWNERSHIP AND TRANSFER (§§ 201 – 205)

CHAPTER 3—DURATION OF COPYRIGHT (§§ 301 – 305)

CHAPTER 4—COPYRIGHT NOTICE, DEPOSIT, AND REGISTRATION (§§ 401 – 412)

CHAPTER 5—COPYRIGHT INFRINGEMENT AND REMEDIES (§§ 501 – 513)

CHAPTER 6—IMPORTATION AND EXPORTATION (§§ 601 – 603)

CHAPTER 7—COPYRIGHT OFFICE (§§ 701 – 710)

CHAPTER 8—PROCEEDINGS BY COPYRIGHT ROYALTY JUDGES (§§ 801 – 805)

CHAPTER 9—PROTECTION OF SEMICONDUCTOR CHIP PRODUCTS (§§ 901 – 914)

CHAPTER 10—DIGITAL AUDIO RECORDING DEVICES AND MEDIA (§§ 1001 – 1010)

CHAPTER 11—SOUND RECORDINGS AND MUSIC VIDEOS (§ 1101)

CHAPTER 12—COPYRIGHT PROTECTION AND MANAGEMENT SYSTEMS (§§ 1201 – 1205)

CHAPTER 13—PROTECTION OF ORIGINAL DESIGNS (§§ 1301 – 1332)

CHAPTER 14—UNAUTHORIZED USE OF PRE-1972 SOUND RECORDINGS (§ 1401)

CHAPTER 15—COPYRIGHT SMALL CLAIMS (§§ 1501 – 1511)

17 U.S. Code

Statutory Basis: Subject Matter and Scope of Copyright

§ 101. Definitions

§ 102. Subject matter of copyright: In general

§ 103. Subject matter of copyright: Compilations and derivative works

§ 104. Subject matter of copyright: National origin

§ 104A. Copyright in restored works

§ 105. Subject matter of copyright: United States Government works

§ 106. Exclusive rights in copyrighted works

§ 106A. Rights of certain authors to attribution and integrity

§ 107. Limitations on exclusive rights: Fair use

§ 108. Limitations on exclusive rights: Reproduction by libraries and archives

§ 109. Limitations on exclusive rights: Effect of transfer of particular copy or phonorecord

17 U.S. Code

Chapter One

§ 110. Limitations on exclusive rights: Exemption of certain performances and displays

§ 111. Limitations on exclusive rights: Secondary transmissions of broadcast programming by cable

§ 112. Limitations on exclusive rights: Ephemeral recordings

§ 113. Scope of exclusive rights in pictorial, graphic, and sculptural works

§ 114. Scope of exclusive rights in sound recordings

§ 115. Scope of exclusive rights in nondramatic musical works: Compulsory license for making and distributing phonorecords

§ 116. Negotiated licenses for public performances by means of coin-operated phonorecord players

[§ 116A. Renumbered § 116]

§ 117. Limitations on exclusive rights: Computer programs

§ 118. Scope of exclusive rights: Use of certain works in connection with noncommercial broadcasting

§ 119. Limitations on exclusive rights: Secondary transmissions of distant television programming by satellite

§ 120. Scope of exclusive rights in architectural works

§ 121. Limitations on exclusive rights: Reproduction for blind or other people with disabilities

§ 121A. Limitations on exclusive rights: reproduction for blind or other people with disabilities in Marrakesh Treaty countries

§ 122. Limitations on exclusive rights: Secondary transmissions of local television programming by satellite

Statutory Basis:

Copyright Ownership and Transfer

§ 201. Ownership of copyright

§ 202. Ownership of copyright as distinct from ownership of material object

§ 203. Termination of transfers and licenses granted by the author

§ 204. Execution of transfers of copyright ownership

§ 205. Recordation of transfers and other documents

17 U.S. Code
Chapter Two

Statutory Basis: Duration of Copyright

§ 301. Preemption with respect to other laws

§ 302. Duration of copyright: Works created on or after January 1, 1978

§ 303. Duration of copyright: Works created but not published or copyrighted before January 1, 1978

§ 304. Duration of copyright: Subsisting copyrights

§ 305. Duration of copyright: Terminal date

17 U.S. Code

Chapter Three

Statutory Basis:

Copyright Notice, Deposit, and Registration

§ 401. Notice of copyright: Visually perceptible copies

§ 402. Notice of copyright: Phonorecords of sound recordings

§ 403. Notice of copyright: Publications incorporating United States Government works

§ 404. Notice of copyright: Contributions to collective works

§ 405. Notice of copyright: Omission of notice on certain copies and phonorecords

§ 406. Notice of copyright: Error in name or date on certain copies and phonorecords

§ 407. Deposit of copies or phonorecords for Library of Congress

§ 408. Copyright registration in general

§ 409. Application for copyright registration

§ 410. Registration of claim and issuance of certificate

§ 411. Registration and civil infringement actions

§ 412. Registration as prerequisite to certain remedies for infringement

17 U.S. Code

Chapter Four

Statutory Basis: Copyright Infringement and Remedies

§ 501. Infringement of copyright

§ 502. Remedies for infringement: Injunctions

§ 503. Remedies for infringement: Impounding and disposition of infringing articles

§ 504. Remedies for infringement: Damages and profits

§ 505. Remedies for infringement: Costs and attorney's fees

§ 506. Criminal offenses

§ 507. Limitations on actions

§ 508. Notification of filing and determination of actions

[§ 509. Repealed. Pub. L. 110–403, title II, § 201(b)(1), Oct. 13, 2008, 122 Stat. 4260]

§ 510. Remedies for alteration of programming by cable systems

§ 511. Liability of States, instrumentalities of States, and State officials for infringement of copyright

§ 512. Limitations on liability relating to material online

§ 513. Determination of reasonable license fees for individual proprietors

17 U.S. Code

Chapter Five

Subject Matter

§ 102 (a) Copyright protection subsists... in original works* of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.

*including literary, musical, dramatic, choreographic, pictorial, graphic, and sculptural works; motion pictures and other audiovisual works; sound recordings; and architectural works.

Ownership

§ 201 - Ownership of copyright

- (a) Initial Ownership.— Copyright in a work protected under this title vests initially in the author or authors of the work....
- (b) Works Made for Hire.— In the case of a work made for hire, the employer or other person for whom the work was prepared is considered the author for purposes of this title, and, unless the parties have expressly agreed otherwise in a written instrument signed by them, owns all of the rights comprised in the copyright.

Eligibility

§ 104 - Subject matter of copyright: National origin

(a) Unpublished Works.—

The works specified by sections 102 and 103, while unpublished, are subject to protection under this title without regard to the nationality or domicile of the author.

(b) Published Works.—The works specified by sections 102 and 103, when published, are subject to protection under this title...

[subject to certain conditions]

Registration

§ 408 - Copyright registration in general: ...[T]he owner of copyright or of any exclusive right in the work may obtain registration of the copyright claim... . Such registration is not a condition of copyright protection.

Examination & Issuance

§ 410 - Registration of claim and issuance of certificate:

- (a) ...[A]fter examination... the Register shall register the claim and issue to the applicant a certificate of registration under the seal of the Copyright Office.
- (b) In any case in which the Register of Copyrights determines that... the material deposited does not constitute copyrightable subject matter or that the claim is invalid for any other reason, the Register shall refuse registration and shall notify the applicant in writing of the reasons for such refusal.

Exclusive Rights

§ 106 - Exclusive rights in copyrighted works: ... the owner of copyright under this title has the exclusive rights to... **reproduce...** prepare **derivative** works... **distribute** copies... perform... [or] display the copyrighted work... .

Copyright Term

§ 302 - Duration of copyright: Copyright in a work created on or after January 1, 1978, subsists from its creation and, except as provided by the following subsections, endures for a term consisting of the **life of the author** and **70 years** after the author's death.

Transfer of Ownership

§ 201 - Ownership of copyright

(d) Transfer of Ownership.—

(1) The ownership of a copyright may be transferred in whole or in part by any means of conveyance or by operation of law, and may be bequeathed by will or pass as personal property by the applicable laws of intestate succession.

INFRINGEMENT

§ 501 - Infringement of copyright:

- (a) Anyone who violates any of the exclusive rights of the copyright owner... is an infringer of the copyright or right of the author... .
- (b) The legal or beneficial owner of an exclusive right under a [registered] copyright is entitled... to institute an action for any infringement of that particular right committed while he or she is the owner of it... .

Remedies: Injunctions

§ 502 - Remedies for infringement: Injunctions

- (a) Any court having jurisdiction of a civil action arising under this title may, subject to the provisions of section 1498 of title 28, grant temporary and final injunctions on such terms as it may deem reasonable to prevent or restrain infringement of a copyright.

...

Remedies: Damages

§ 504 - Remedies for infringement: Damages and profits

(a) In General.—Except as otherwise provided by this title, an infringer of copyright is liable for either—

(1) the copyright owner's actual damages and any additional profits of the infringer, as provided by subsection (b); or

(2) statutory damages, as provided by subsection (c).

...

Remedies: Costs

§ 505 - Remedies for infringement: Costs and attorney's fees

In any civil action under this title, the court in its discretion may allow the recovery of full costs by or against any party other than the United States or an officer thereof. Except as otherwise provided by this title, the court may also award a reasonable attorney's fee to the prevailing party as part of the costs.

Limits on Civil Action

§ 411 - Registration and civil infringement actions: ...[N]o civil action for infringement of the copyright in any United States work shall be instituted until preregistration or registration of the copyright claim has been made in accordance with this title.

Exceptions & Limitations: Fair Use

§ 107 - Limitations on exclusive rights: Fair use

... [T]he fair use of a copyrighted work, including such use by reproduction ..., for purposes such as criticism, comment, news reporting, teaching... , scholarship, or research, is not an infringement of copyright.

Fair Use Factors

§ 107 - Limitations on exclusive rights: Fair use

In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include—

- (1) the **purpose and character** of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
- (2) the **nature** of the copyrighted work;
- (3) the amount and substantiality of the **portion used** in relation to the copyrighted work as a whole; and
- (4) the effect of the use upon the **potential market** for or **value** of the copyrighted work.

Key Concepts
of Trade Secrets Law

Proprietary Information & Know-How

**United States Code
Title 18, Chapter 90 (abridged)**

Statutory Basis: Trade Secrets

§ 1831. Economic espionage

§ 1832. Theft of trade secrets

§ 1833. Exceptions to prohibitions

§ 1834. Criminal forfeiture

§ 1835. Orders to preserve confidentiality

§ 1836. Civil proceedings

§ 1837. Applicability to conduct outside the United States

§ 1838. Construction with other laws

§ 1839. Definitions

Subject Matter

§ 1839 – Definitions

(3) the term “trade secret” means all forms and types of financial, business, scientific, technical, economic, or engineering information, including patterns, plans, compilations, program devices, formulas, designs, prototypes, methods, techniques, processes, procedures, programs, or codes, whether tangible or intangible, and whether or how stored, compiled, or memorialized physically, electronically, graphically, photographically, or in writing if—

(A) the owner thereof has taken reasonable measures to keep such information secret; and

(B) the information derives independent economic value, actual or potential, from not being generally known to, and not being readily ascertainable through proper means by, another person who can obtain economic value from the disclosure or use of the information...

Ownership

§ 1839 - Definitions

(4) the term “owner”, with respect to a trade secret, means the person or entity in whom or in which rightful legal or equitable title to, or license in, the trade secret is reposed;

Theft (Infringement)

§ 1832 - Theft of trade secrets

(a) Whoever, with intent to convert a trade secret, that is related to a product or service used in or intended for use in interstate or foreign commerce, to the economic benefit of anyone other than the owner thereof, and intending or knowing that the offense will, injure any owner of that trade secret, knowingly—

- (1) steals, or without authorization appropriates, takes, carries away, or conceals, or by fraud, artifice, or deception obtains such information;
- (2) without authorization copies, duplicates, sketches, draws, photographs, downloads, uploads, alters, destroys, photocopies, replicates, transmits, delivers, sends, mails, communicates, or conveys such information;
- (3) receives, buys, or possesses such information, knowing the same to have been stolen or appropriated, obtained, or converted without authorization;
- (4) attempts to commit any offense described in paragraphs (1) through (3); or
- (5) conspires with one or more other persons to commit any offense described in paragraphs (1) through (3), and one or more of such persons do any act to effect the object of the conspiracy...

Misappropriation (Infringement)

§ 1839 - Definitions

(5) the term “misappropriation” means—

(A) acquisition of a trade secret of another by a person who knows or has reason to know that the trade secret was acquired by improper means; or

(B) disclosure or use of a trade secret of another without express or implied consent by a person who—

(i) used improper means to acquire knowledge of the trade secret;

(ii) at the time of disclosure or use, knew or had reason to know that the knowledge of the trade secret was—

(I) derived from or through a person who had used improper means to acquire the trade secret;

(II) acquired under circumstances giving rise to a duty to maintain the secrecy of the trade secret or limit the use of the trade secret; or

(III) derived from or through a person who owed a duty to the person seeking relief to maintain the secrecy of the trade secret or limit the use of the trade secret; or

(iii) before a material change of the position of the person, knew or had reason to know that—

(I) the trade secret was a trade secret; and

(II) knowledge of the trade secret had been acquired by accident or mistake

...

Remedies

§ 1836 - Civil proceedings

(3) Remedies.—In a civil action brought under this subsection with respect to the misappropriation of a trade secret, a court may—

(A) grant an injunction— (i) to prevent any actual or threatened misappropriation... (ii) ,,,requiring affirmative actions to be taken to protect the trade secret; and (iii) ...that conditions future use of the trade secret upon payment of a reasonable royalty...

(B) award—...(I) damages for actual loss caused by the misappropriation of the trade secret; and (II) damages for any unjust enrichment caused by the misappropriation of the trade secret... or... in lieu of damages measured by any other methods, the damages caused by the misappropriation measured by imposition of liability for a reasonable royalty for the misappropriator's unauthorized disclosure or use of the trade secret;

(C) ...award exemplary damages...

Federal Preemption

§ 1838 - Construction with other laws

Except as provided in section 1833(b), this chapter shall not be construed to preempt or displace any other remedies, whether civil or criminal, provided by United States Federal, State, commonwealth, possession, or territory law for the misappropriation of a trade secret...

State Law - Uniform Trade Secret Act

The Uniform Trade Secrets Act (UTSA) is a piece of legislation created by the Uniform Law Commission (ULC). The UTSA defines trade secrets and describes claims related to trade secrets. As of 2024, 48 states, the District of Columbia, the U.S. Virgin Islands, and Puerto Rico, have adopted the UTSA.

The UTSA defines a "trade secret" as: Information, including a formula, pattern, compilation, program, device, method, technique, or process that:

- Derives independent economic value, actual or potential, from not being generally known to, and not being readily ascertainable by proper means by, other persons who can obtain economic value from its disclosure or use; and
- Is the subject of efforts that are reasonable under the circumstances to maintain its secrecy.

Remedies will vary depending upon the state, and whether the Economic Espionage Act is involved.

Source: Wex, Legal Information Institute

Key Concepts
of Patent Law

Inventions & Discoveries

**United States Code
Title 35 (abridged)**

STATUTORY BASIS: Patent Rights

PART I—UNITED STATES PATENT AND TRADEMARK OFFICE (§§ 1 – 42)

PART II—PATENTABILITY OF INVENTIONS AND GRANT OF PATENTS (§§ 100 – 212)

PART III—PATENTS AND PROTECTION OF PATENT RIGHTS (§§ 251 – 329)

PART IV—PATENT COOPERATION TREATY (§§ 351 – 376)

PART V—THE HAGUE AGREEMENT CONCERNING INTERNATIONAL
REGISTRATION OF INDUSTRIAL DESIGNS (§§ 381 – 390)

United States Code

Title 35

Statutory Basis:

Patentability of Inventions and Grant of Patents

CHAPTER 10—PATENTABILITY OF INVENTIONS (§§ 100 – 105)

CHAPTER 11—APPLICATION FOR PATENT (§§ 111 – 123)

CHAPTER 12—EXAMINATION OF APPLICATION (§§ – 135)

CHAPTER 13—REVIEW OF PATENT AND TRADEMARK OFFICE DECISIONS (§§ 141 – 146)

CHAPTER 14—ISSUE OF PATENT (§§ 151 – 157)

CHAPTER 15—PLANT PATENTS (§§ 161 – 164)

CHAPTER 16—DESIGNS (§§ 171 – 173)

CHAPTER 17—SECRECY OF CERTAIN INVENTIONS AND FILING APPLICATIONS IN FOREIGN COUNTRY (§§ 181 – 188)

CHAPTER 18—PATENT RIGHTS IN INVENTIONS MADE WITH FEDERAL ASSISTANCE (§§ 200 – 212)

United States Code

Title 35, Part Two

Statutory Basis: Patentability of Inventions

§ 100. Definitions

§ 101. Inventions patentable

§ 102. Conditions for patentability; novelty

§ 103. Conditions for patentability; non-obvious subject matter

[§ 104. Repealed. Pub. L. 112–29, § 3(d), Sept. 16, 2011, 125 Stat. 287]

§ 105. Inventions in outer space

United States Code

Title 35, Part Two, Chapter 10

Definitions

§ 100 – Definitions

When used in this title unless the context otherwise indicates—

- (a) The term “invention” means invention or discovery.
- (b) The term “process” means process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.

Definitions (cont...)

§ 100 – Definitions

When used in this title unless the context otherwise indicates—

(f) The term “inventor” means the individual[(s)]... who invented or discovered the subject matter of the invention.

(d) The word “patentee” includes not only the patentee to whom the patent was issued but also the successors in title to the patentee.

Definitions (concl.)

§ 100 – Definitions

When used in this title unless the context otherwise indicates—

(j)The term “claimed invention” means the subject matter defined by a claim in a patent or an application for a patent.

Inventions Patentable (Eligible Subject Matter)

§ 101 - Inventions patentable

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Conditions for Patentability (Validity)

§ 102 - Conditions for patentability; novelty

(a) Novelty; Prior Art.—A person shall be entitled to a patent unless—

(1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention...

Conditions for Patentability (cont.)

§ 103 - Conditions for patentability; non-obvious subject matter

A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. Patentability shall not be negated by the manner in which the invention was made.

Statutory Basis: Application for Patent

§ 111. Application

§ 112. Specification

§ 113. Drawings

§ 114. Models, specimens

§ 115. Inventor's oath or declaration

§ 116. Inventors

§ 117. Death or incapacity of inventor

§ 118. Filing by other than inventor

§ 119. Benefit of earlier filing date; right of priority

§ 120. Benefit of earlier filing date in the United States

§ 121. Divisional applications

§ 122. Confidential status of applications; publication of patent applications

§ 123. Micro entity defined

35 U.S. Code

Part Two, Chapter Eleven

Application

§ 111 - Application

(a) In General.—

An application for patent shall be made, or authorized to be made, by the inventor, except as otherwise provided in this title, in writing to the Director.

(2) Contents.—Such application shall include—

(A) a specification as prescribed by section 112;

(B) a drawing as prescribed by section 113; and

(C) an oath or declaration as prescribed by section 115. ...

Specification and Claim(s)

§ 112 - Specification

(a) In General.—

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention.

(b) Conclusion.—

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention.

Statutory Basis: Examination of Application

§ 131. Examination of application

§ 132. Notice of rejection; reexamination

§ 133. Time for prosecuting application

§ 134. Appeal to the Patent Trial and Appeal Board

§ 135. Derivation proceedings

35 U.S. Code

Part Two, Chapter 12 – Examination of Application

Examination

§ 131 – Examination of application

The Director shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Director shall issue a patent therefor.

Patent Examination

When a patent application is filed with the **U.S. Patent & Trademark Office**, “there are a number of legal requirements that must be met, including **novelty** (35 U.S.C. 102), **utility** and **eligibility** (35 U.S.C 101), **non-obviousness** (35 U.S.C. 103), and written description (35 U.S.C. 112)...”

A patent examiner, “review[s] the contents of the application to determine if it meets all legal requirements for a patent to be granted. The examination consists of a study for compliance with legal requirements... and a search through U.S. patents, publications of patent applications, foreign patent documents, and available literature.”

“This is to see if the claimed invention is new, useful, and non-obvious, and if the application meets patent statute requirements and rules of practice.”

U.S. Patent & Trademark Office

“Patent Process Overview”



Rejections

§ 132 - Notice of rejection; reexamination

(a) Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention. ...

Statutory Basis:

Issue of Patent

§ 151. Issue of patent

§ 152. Issue of patent to assignee

§ 153. How issued

§ 154. Contents and term of patent; provisional rights

[§§ 155, 155A. Repealed. Pub. L. 112–29, § 20(k), Sept. 16, 2011, 125 Stat. 335]

§ 156. Extension of patent term

[§ 157. Repealed. Pub. L. 112–29, § 3(e)(1), Sept. 16, 2011, 125 Stat. 287]

35 U.S. Code

Part Two, Chapter 14 – Issue of Patent

Issue of Patent

§ 151 - Issue of patent

(a) In General.—

If it appears that an applicant is entitled to a patent under the law, a written notice of allowance of the application shall be given or mailed to the applicant. The notice shall specify a sum, constituting the issue fee and any required publication fee, which shall be paid within 3 months thereafter.

(b) Effect of Payment.—

Upon payment of this sum the patent may issue, but if payment is not timely made, the application shall be regarded as abandoned.

Issue of Patent

§ 153 - How issued

Patents shall be issued in the name of the United States of America, under the seal of the Patent and Trademark Office, and shall be signed by the Director or have his signature placed thereon and shall be recorded in the Patent and Trademark Office.

Patent Contents

§ 154 - Contents and term of patent; provisional rights

(a) In General.—

(1) Contents.—

Every patent shall contain a short title of the invention and a grant to the patentee, his heirs or assigns, of the right to exclude others from making, using, offering for sale, or selling the invention throughout the United States or importing the invention into the United States, and, if the invention is a process, of the right to exclude others from using, offering for sale or selling throughout the United States, or importing into the United States, products made by that process, referring to the specification for the particulars thereof.

...

(4) Specification and drawing.—

A copy of the specification and drawing shall be annexed to the patent and be a part of such patent.

Patent Term

§ 154 - Contents and term of patent; provisional rights

(2)Term.—

Subject to the payment of fees under this title, such grant shall be for a term beginning on the date on which the patent issues and ending 20 years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application or applications under section 120, 121, 365(c), or 386(c), from the date on which the earliest such application was filed.

Patents and Protection of Patent Rights

CHAPTER 25—AMENDMENT AND CORRECTION OF PATENTS (§§ 251 – 257)

CHAPTER 26—OWNERSHIP AND ASSIGNMENT (§§ 261 – 262)

CHAPTER 27—GOVERNMENT INTERESTS IN PATENTS (§§ 266 – 267)

CHAPTER 28—INFRINGEMENT OF PATENTS (§§ 271 – 273)

CHAPTER 29—REMEDIES FOR INFRINGEMENT OF PATENT, AND OTHER ACTIONS (§§ 281 – 299)

CHAPTER 30—PRIOR ART CITATIONS TO OFFICE AND EX PARTE REEXAMINATION OF PATENTS (§§ 301 – 307)

CHAPTER 31—INTER PARTES REVIEW (§§ 311 – 319)

CHAPTER 32—POST-GRANT REVIEW (§§ 321 – 329)

35 U.S. Code

Part Three

Patents and Protection of Patent Rights

§ 261. Ownership; assignment

§ 262. Joint owners

35 U.S. Code

Part Three, Chapter 26 – Ownership and Assignment

Patent Ownership and Transferability

§ 261 - Ownership; assignment

Subject to the provisions of this title, patents shall have the attributes of personal property. The Patent and Trademark Office shall maintain a register of interests in patents and applications for patents and shall record any document related thereto upon request, and may require a fee therefor.

Applications for patent, patents, or any interest therein, shall be assignable in law by an instrument in writing. The applicant, patentee, or his assigns or legal representatives may in like manner grant and convey an exclusive right under his application for patent, or patents, to the whole or any specified part of the United States.

Statutory Basis: Infringement

§ 271. Infringement of patent

§ 272. Temporary presence in the United States

§ 273. Defense to infringement based on prior commercial use

35 U.S. Code

Part Three, Chapter 28 – Infringement of Patents

Infringement Defined

§ 271 - Infringement of patent

(a) Except as otherwise provided in this title, whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefor, infringes the patent.

(b) Whoever actively induces infringement of a patent shall be liable as an infringer.

(c) Whoever offers to sell or sells within the United States or imports into the United States a component of a patented machine, manufacture, combination or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial noninfringing use, shall be liable as a contributory infringer.

Statutory Basis:

Remedies for Infringement of Patent

§ 281. Remedy for infringement of patent

§ 282. Presumption of validity; defenses

§ 283. Injunction

§ 284. Damages

§ 285. Attorney fees

§ 286. Time limitation on damages

§ 287. Limitation on damages and other remedies; marking and notice

§ 288. Action for infringement of a patent containing an invalid claim

§ 289. Additional remedy for infringement of design patent

§ 290. Notice of patent suits

§ 291. Derived patents

§ 292. False marking

§ 293. Nonresident patentee; service and notice

§ 294. Voluntary arbitration

§ 295. Presumption: Product made by patented process

§ 296. Liability of States, instrumentalities of States, and State officials for infringement of patents

§ 297. Improper and deceptive invention promotion

§ 298. Advice of counsel

§ 299. Joinder of parties

35 U.S. Code

Part Three, Chapter 29

Remedies

§ 281 - Remedy for infringement of patent

A patentee shall have remedy by civil action for infringement of his patent.

Presumption of Validity

§ 282 - Presumption of validity; defenses

(a) In General.—

A patent shall be presumed valid. Each claim of a patent (whether in independent, dependent, or multiple dependent form) shall be presumed valid independently of the validity of other claims; dependent or multiple dependent claims shall be presumed valid even though dependent upon an invalid claim. The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting such invalidity.

Injunctive Relief

§ 283 – Injunction

The several courts having jurisdiction of cases under this title may grant injunctions in accordance with the principles of equity to prevent the violation of any right secured by patent, on such terms as the court deems reasonable.

Damages

§ 284 – Damages

Upon finding for the claimant the court shall award the claimant damages adequate to compensate for the infringement, but in no event less than a reasonable royalty for the use made of the invention by the infringer, together with interest and costs as fixed by the court.

...

Statutory Basis: Inter Partes Review

§ 311. Inter partes review

§ 312. Petitions

§ 313. Preliminary response to petition

§ 314. Institution of inter partes review

§ 315. Relation to other proceedings or actions

§ 316. Conduct of inter partes review

§ 317. Settlement

§ 318. Decision of the Board

§ 319. Appeal

35 U.S. Code

Part Three, Chapter 31

Inter Partes Review

§ 311 - Inter partes review

(a) In General.—

Subject to the provisions of this chapter, a person who is not the owner of a patent may file with the Office a petition to institute an inter partes review of the patent ...

(b) Scope.—

A petitioner in an inter partes review may request to cancel as unpatentable 1 or more claims of a patent only on a ground that could be raised under section 102 or 103 and only on the basis of prior art consisting of patents or printed publications.

(c) Filing Deadline.—A petition for inter partes review shall be filed after the later of either—

(1) the date that is 9 months after the grant of a patent; or

(2) if a post-grant review is instituted under chapter 32, the date of the termination of such post-grant review.

Petitions

§ 312 – Petitions

(a) Requirements of Petition.—A petition filed under section 311 may be considered only if—

...

(2) the petition identifies all real parties in interest;

(3) the petition identifies, in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim...

Standard for Institution

§ 314 - Institution of inter partes review

(a) Threshold.—

The Director may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

Proceedings

§ 315 - Relation to other proceedings or actions

(a) Infringer's Civil Action.—

(1) Inter partes review barred by civil action.—

An inter partes review may not be instituted if, before the date on which the petition for such a review is filed, the petitioner or real party in interest filed a civil action challenging the validity of a claim of the patent.

...

Statutory Basis:

Post Grant Review

§ 321. Post-grant review

§ 322. Petitions

§ 323. Preliminary response to petition

§ 324. Institution of post-grant review

§ 325. Relation to other proceedings or actions

§ 326. Conduct of post-grant review

§ 327. Settlement

§ 328. Decision of the Board

§ 329. Appeal

35 U.S. Code

Part Three, Chapter 32

Post-Grant Review

§ 321 - Post-grant review

(a) In General.—

Subject to the provisions of this chapter, a person who is not the owner of a patent may file with the Office a petition to institute a post-grant review of the patent. ...

(b) Scope.—

A petitioner in a post-grant review may request to cancel as unpatentable 1 or more claims of a patent on any ground that could be raised under paragraph (2) or (3) of section 282(b) (relating to invalidity of the patent or any claim).

(c) Filing Deadline.—

A petition for a post-grant review may only be filed not later than the date that is 9 months after the date of the grant of the patent or of the issuance of a reissue patent (as the case may be).

Post-Grant Review Petitions

§ 322 – Petitions

(a) Requirements of Petition.—A petition filed under section 321 may be considered only if—

...

(2) the petition identifies all real parties in interest;

(3) the petition identifies, in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim...

Standard for Institution

§ 324 - Institution of post-grant review

(a) Threshold.—

The Director may not authorize a post-grant review to be instituted unless the Director determines that the information presented in the petition filed under section 321, if such information is not rebutted, would demonstrate that it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable.

(b) Additional Grounds.—

The determination required under subsection (a) may also be satisfied by a showing that the petition raises a novel or unsettled legal question that is important to other patents or patent applications.

Proceedings

§ 325 - Relation to other proceedings or actions

(a) Infringer's Civil Action.—

(1) Post-grant review barred by civil action.—

A post-grant review may not be instituted under this chapter if, before the date on which the petition for such a review is filed, the petitioner or real party in interest filed a civil action challenging the validity of a claim of the patent.

Primary Sources

- Legal Information Institute, United States Code, <https://www.law.cornell.edu/uscode/text>
- U.S. Patent & Trademark Office, Trademark Basics, <https://www.uspto.gov/trademarks/basics>
- U.S. Copyright Office, What is Copyright?, <https://www.copyright.gov/what-is-copyright/>
- Legal Information Institute, Trade Secret, https://www.law.cornell.edu/wex/trade_secret
- U.S. Patent & Trademark Office, Manual of Patent Examining Procedures, <https://www.uspto.gov/web/offices/pac/mpep/index.html>