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INTERNATIONAL DESIGN APPLICATION SEARCH FUNCTIONS ADDED TO PAIR

by Daniel M. Lorentzen

The Patent Application Information Retrieval (PAIR) system is the United States Patent and Trademark Office’s (USPTO’s) web-based means of electronically viewing the status of and documents relating to a patent application. PAIR utilizes standard web-based screens to view the status and documents sent to the USPTO and check the progress of pending patent applications.

The Hague Agreement establishes an international registration system which facilitates protection of industrial designs in member countries and intergovernmental organizations (also referred to as “Contracting Parties”) by means of a single international design application filed either directly with the International Bureau (IB) of the World Intellectual Property Organization (WIPO) or indirectly through an applicant’s Contracting Party.

In preparation for the Hague Agreement taking effect with respect to the United States, the USPTO’s PAIR system is being upgraded to allow users to search for applications by international registration number. Two new related data elements have also been added to the Application Data tab in PAIR in anticipation of the Hague Agreement coming online in the United States.

An Advisory notice published on November 8, 2014, by the USPTO indicates that international design applications satisfying the requirements under the Hague Agreement for international registration will be assigned an international registration number by WIPO, which begins with the series code “DM/nnnnnn”. Thereafter, the international design application will be published by WIPO. Published international design applications designating the United States are assigned an application number by the USPTO beginning with the series code “35/nnn,nnn”. The updated PAIR interface can be used to search for a 35-series application by using the “Application Number” search shown in the screenshot below. In addition, users can search for a 35-series application corresponding to a published international design application designating the United States by the international registration number using the “International Design Registration Number.”

Search for Application: ⓘ

Choose type of number:

- Application Number (EXAMPLE: 99999999 or 99/999999)
- Control Number
- Patent Number
- PCT Number (EXAMPLE: PCT/CCYY/99999 or PCT/CCYYYY/999999)
- Publication Number
- International Design Registration Number (EXAMPLE: DM/999999)

Enter Number:

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Once an international design application is successfully identified in PAIR, users will see two new data elements, one for the International Registration Number (Hague) and another for the International Registration Publication Date. In the case where these data elements are unassigned by WIPO, a hyphen will be displayed to indicate that the data is not available.

Select New Case	Application Data	Transaction History	Image File Wrapper	Continuity Data	Published Documents	Address & Attorney/Agent	Supplemental Content
Bibliographic Data							
Application Number:	35/999,999						Correspondence Address Customer Number: -
Filing or 371 (c) Date:	-						Status: -
Application Type:	-						Status Date: -
Examiner Name:	-						Location: -
Group Art Unit:	-						Location Date: -
Confirmation Number:	-						Earliest Publication No: -
Attorney Docket Number:	-						Earliest Publication Date: -
Class / Subclass:	-						Patent Number: -
First Named Inventor:	-						Issue Date of Patent: -
First Named Applicant:	-						International Registration Number (Hague): DM/999999
Entity Status:	-						International Registration Publication Date: 01/01/2001
AIA (First Inventor to File):	-						
Title of Invention:							

Even though the search functions are now available in PAIR for international design applications, any data associated with international design applications will not be available in PAIR until entry into force of the Hague Agreement with respect to the U.S., which will likely occur three months after the U.S. deposits its instrument of ratification with the International Bureau of the World Intellectual Property Organization (WIPO).

ADDITIONAL PRECAUTIONS: GO BEYOND CONFIDENTIALITY AGREEMENTS

By Jill N. Link

Confidentiality agreements, often referred to as non-disclosure agreements, are a common practice in technology-based industries. For many they are a routine first step to business discussions and exchange of ideas within an industry or among competitors. In short, a confidentiality agreement places obligations on a party receiving the information to handle such confidential information in a prescribed manner. It sets in place obligations of maintaining and treating information as confidential. The agreements can be unilateral, when only a single party is disclosing confidential information, or can be mutual, when both parties exchange confidential information.

Although confidentiality agreements can play an important role in protecting a business' proprietary and confidential information, they are only a first step in protecting confidential information, including trade secrets which are to be handled with even greater caution and afforded greater security measures. A recent decision by the 7th Circuit Court of Appeals resulted in the unenforceability of a confidentiality agreement when no subsequent steps were taken to protect the information. *nClosures Inc. v. Block and Company, Inc.*, 770 F. 3d 598 (7th Cir. 2014). The decision highlights that a confidentiality agreement entered into at the beginning of a business relationship should be followed by additional steps to protect and enforce the confidential handling of the protected information.

This recent decision highlights that ongoing efforts to maintain confidentiality are important to ensure your confidentiality agreements remain enforceable. Most individuals and companies would not waste time entering into confidentiality agreements if they knew courts would not enforce them. Therefore, the court's guidance in this recent decision should be clear - take additional precautions beyond confidentiality agreements alone to protect confidential information.

What additional precautions are required? Must information be locked in a safe? Should employees never know a technology's best mode or "secret sauce"? Maybe. This answer depends on the particular technology at issue as well as a determination of what actions are "reasonable." For starters, the following are examples of reasonable steps one could take beyond a confidentiality agreement:

- Mark or designate all applicable information as confidential
- Encrypt or password protect confidential information to restrict access
- Limit access to confidential information (only those with a need to know – even within your own company)
- Have your own employees sign and abide by confidentiality agreements (not just third parties)
- Maintain records of signing (and enforcing) confidentiality agreements

If information has sufficient value to justify having a third party sign a confidentiality agreement the information is likely of sufficient value to warrant taking additional reasonable steps to ensure its protection. Not only will this enhance your protection of the information, it may also save you from a court refusing to enforce your contract due to insufficient protection of allegedly confidential information.

CREATIVE TRADEMARKS—SOUNDS, SMELLS, SPOKEN WORDS

The historical meaning of “trademark” is exactly that—some sort of physical mark that allows the viewer of the product to see a symbol that can be associated with the source of the product. In fact, the term has its origins in the branding of livestock. Thus, the term “brand” is sometimes interchanged with the term “trademark.”

That tradition is carried on by the legal requirement that trademarks should be applied directly on their products. The term “CAMPBELL’S” is on the can of soup so the buyer can see who makes it (its source). But sometimes the “product” is a service rather than a physical thing. How can a service be “branded”? It should be used in modes that allow the public to see it in association with those services. “PRINCIPAL FINANCIAL” is on a sign at or near their buildings. It is also on brochures, television ads, and insurance policies. Therefore, these goods and services are indeed “branded” with the name.

Can trademarks indicate the source of a product or service without using words? The logo, long recognized, does not convey the name of a company or a product. But it functions just as well as a brand indicator. When you see the Nike “swoosh stripe” you know it should be a Nike brand shoe.

What about trademark forms that are not words or graphic symbols? NBC has registered the three-chime sound it uses. See U.S. trademark registration no. 916,522 (“The mark comprises a sequence of chime-like musical notes which are in the key of C and sound the notes G, E, C ...”). They are relatively rare and hard to get. Harley Davidson fought long and hard, and gave up on, federal trademark registration protection of the sound of its motorcycle exhaust. It calls it the “two-note” exhaust sound; that “potato-potato-potato” sound you hear when the bike is idling. Harley argued that sound is an indicator of source. See U.S. trademark application no. 74/485,223.

What about smell? Believe it or not, a potpourri-based aroma added to one company’s different types of yarn was federally registered. Arguably anyone that adds (or even sells) yarn with a similar potpourri aroma could be targeted for infringement. The argument is that as one walks through a store with various manufacturers of yarn, if you smell that aroma, it indicates the source of that yarn. See U.S. trademark registration no. 1,639,128 (“The mark is a high impact fresh, floral fragrance reminiscent of plumeria blossoms.”)

And what about spoken words? We just came across U.S. trademark registration no. 1,795,371. Checkers Drive-In Restaurants advertises on radio and television with the word “CHA-CHING” along with the sound of a cash register. They also applied for and obtained a registration for the phrase “CHA-CHING” in spoken form. There is a question of how much more protection that might give than a registration just on the words “CHA-CHING,” but arguably it is broader than the spelled out words (somebody could argue that an alternative spelling “KAY-CHING” looks different enough).

Therefore, the U.S. Trademark Office has become fairly liberal about the types of things that can be registered as trademarks. However, these unconventional marks usually can be registered only after many years of use and much advertising or promotion. It is by no means automatic. Harley Davidson fought about it for years and quit.

To the extent anything more than words or graphic logos function to identify your product or service, you can at least investigate potential trademark protection.

MVS FILEWRAPPER® BLOG

McKee, Voorhees & Sease maintains the Filewrapper® blog at www.filewrapper.com. The blog is regularly updated to report on topics such as recent intellectual property case law, legislation, proposed legislation, administrative policies, and other intellectual property developments. We consciously refrain from expressing opinions on this blog and instead, offer it as a form of information and education.

We have always been proud of the fact that the content is original content authored by MVS attorneys. Although there are many contributors, Daniel Lorentzen, Ph.D coordinates efforts and is also the firm’s most prolific contributor.

We encourage clients interested in intellectual property developments to visit or subscribe to the blog.

MORE THAN JUST A PRETTY FACE

By Heidi S. Nebel

The United States Copyright Office recently published rules indicating that it would refuse to register a copyright in a “monkey selfie.” As odd as it seems, the new regulations were likely in reaction to a real-life controversy.

While a wildlife photographer was setting up a photo shoot in Indonesia, several macaque monkeys took his camera and snapped a series of “selfies.” The website “Wikimedia Commons” posted the photographs and the photographer alleged that the posting infringed his copyright in the pictures.

After investigating the issue, the website determined that the photographer did not have sufficient creative input to hold a copyright to the photo, and that if anyone owned the copyright, it was the monkey. As the monkey was not a legal person, they determined that no copyright would be available for the picture. The photographer argued that he was the creator and thus the copyright owner as he “engineered” the shot. He asserted that it was his artistry and his idea to leave the camera for the monkeys to play with and take selfies as he anticipated.

The United States Copyright Statute, 17 U.S.C. §102 provides that Copyright protection subsists in original works of authorship fixed in any tangible medium of expression, and grants to the owner of a copyright the exclusive right to reproduce the work. 17 U.S.C. §106.

In December 2014, apparently in reaction to controversy, the Copyright office published new regulations in its “Compendium of United States Copyright Office Practice,” stating that it will not Register works “produced by nature, animals or plants.”

I guess we will have to see if the “plant-selfie” issue will ever arise??

WE’RE THERE

January 2015

Ed Sease is teaching the Spring semester Patent Litigation course at Drake University, Des Moines, IA.

January 2015

Mark Hansing is teaching the Spring semester Patent Prosecution seminar at the University of Iowa College of Law in Iowa City, IA.

February 12, 2015

R. Scott Johnson will attend the Technology Association of Iowa Tech Town Hall in Des Moines, IA.

February 22-25, 2015

Jill Link and Heidi S. Nebel will attend the Association of University Technology Managers (AUTM) National meeting in New Orleans, LA.

March 4, 2015

Kirk Hartung will be speaking at the annual Celebrate Innovation Week at Des Moines Area Community College in West Des Moines, IA. His presentation is entitled “*Iowa Inventions That Changed the World*” and focuses on Iowa inventors who are in the Iowa Inventors Hall of Fame.”

March 22-26, 2015

Jonathan Kennedy and Dan Lorentzen will attend the American Chemical Society’s National Conference in Denver, CO.

April 15-17, 2015

Jill Link and Heidi S. Nebel will attend the Bio IP Counsels Committee Conference in St. Louis, MO.

April 16, 2015

R. Scott Johnson will attend the Technology Association of Iowa Pitch and Grow event in Des Moines, IA.

April 24-25, 2015

R. Scott Johnson will attend the Technology Association of Iowa Hyperstream IT Olympics in Ames, IA.

June 18-20, 2015

Kirk Hartung will attend the LEGUS meeting in New Orleans, LA.

July 20-22, 2015

Heidi S. Nebel will attend the Association of University Technology Managers (AUTM) central region meeting in Nashville, TN.

August 16-20, 2015

Jonathan Kennedy, Dan Lorentzen and Jill Link will be at the 250th American Chemical Society National Meeting in Boston, MA.

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