

Keeling Patents & Trademarks, L.L.C.

INTELLECTUAL PROPERTY ATTORNEYS

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Patent attorneys and agents are attorneys or non-attorneys, respectively, registered to practice before the United States Patent and Trademark Office:

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- (1) Apply to the Commissioner in writing on a form supplied by the Director and furnish all requested information and material and
- (2) Establish to the satisfaction of the Director that he or she is:
 - (i) Of good moral character and repute;
 - (ii) Possessed of the legal, scientific, and technical qualifications necessary to enable him or her to render applicants valuable service; and
 - (iii) Is otherwise competent to advise and assist applicants for patents in the presentation and prosecution of their applications before the Office.

37 C.F.R. 10.7(a).

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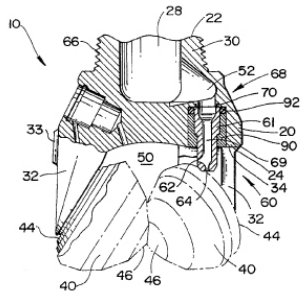
1 Forward

Businesses and individuals are protecting and enforcing intellectual property rights to an extent not previously seen. The predominant intellectual properties at issue are patents, trademarks, and copyrights, although other, lesser-known rights exist. This short introduction to intellectual property has been prepared by Keeling Patents & Trademarks, L.L.C. as a quick reference regarding these issues.

This quick reference has been divided into six major sections – Preparing for Intellectual Property Development, Patent Protection and Enforcement, Trademark Protection and Enforcement, Copyright Protection and Enforcement, Trade Secret Protection and Enforcement, and finally Intellectual Property Acquisition and Transfer. Other areas of intellectual property exist which are not addressed herein.

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 I, Section 8.*



U.S. Pat. No. 5,579,855

*Rotary Cone Rock Bit
and Method*

*Inventor:
Winton B. Dickey*

*Patent Attorneys:
Keeling Patents & Trademarks, LLC.*

2 Preparing for Intellectual Property Development

Certain steps should be considered when beginning any business venture which may give rise to intellectual property development to ensure its protection. Such agreements are typically prepared on an hourly rate basis.

A. Non-Disclosure Agreements

One precaution to be considered in business is the use of Non-Disclosure Agreements (NDAs), which protect the confidentiality of the business' secrets, methods, and inventions. The best time for execution of an NDA is before the employee or contracting party is provided access to the information. This is especially true as the business may develop intellectual property after the NDA is executed.

B. Non-Compete Agreements

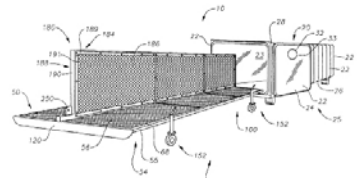
Another precaution to be considered before an employee begins work is the execution of a Non-Compete Agreement. A Non-Compete Agreement may restrict the ability of an individual to compete with the business for a specific time, within a specific geographic area, or as to specific businesses. Such agreements, however, may be problematic depending on the law of the applicable state. Of particular importance is that the law may require that the consideration for the Non-Compete Agreement must give rise to the need for such a restriction.

C. Agreements Regarding Copyright Ownership

Businesses should consider obtaining clear agreements regarding copyright ownership from employees and independent contractors. The Copyright Act of 1976 clearly provides that the business owns all copyrights to materials developed by its employees in the course and scope of their employment, but provides that absent a written agreement regarding copyright ownership the business does not own the copyrights to materials developed by independent contractors. Having clear written agreements in both instances can limit the likelihood and cost of establishing copyright ownership in case of any future dispute.

D. Agreements Regarding Technology Ownership

Businesses should also consider obtaining clear agreements regarding technology ownership from employees and independent contractors. Absent such an agreement independent contractors retain ownership of any technology developed on behalf of the business, including improvements to the technology of the business that employs the contractor. Agreements regarding technology can ensure ownership of patentable inventions and protectible trade secrets developed by employees.



U.S. Pat. No. 6,146,528

*Sludge Filtration
System including
Selectively Slidably
Removable Filter
Assemblies and Method*

Inventors:

*Carl R. Caughman Jr.
and Paul Kesterton*

Patent Attorneys:

Keeling Patents & Trademarks, L.L.C

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 [Title 35].

35 U.S.C. § 101

3 Patent Protection and Enforcement

Businesses generally refer to “patent protection” when meaning the protection afforded by utility patents. There are, however, three different types of patents: utility patents, plant patents and design patents. Each type of patent protects different intellectual properties.

A. Utility Patents

A utility patent protects machines, processes, articles of manufacture, compositions of matter, and improvements thereon. The invention itself must be novel, useful, and not obvious to one skilled in the art. Obtaining and protecting the patentable invention is neither quick nor inexpensive. However patent ownership allows the owner to exclude others from making, selling, or using the invention. In addition to their inherent value, patents are powerful marketing tool and affects the business’ valuation.

1. Preliminary matters

Before spending the time and resources in preparing and filing a utility patent application, businesses should consider several preliminary matters, including the use of patent searches and consideration of time bars, to avoid unnecessary expenses and more completely identify the patentable invention.

a. Patent Searches

The first step in determining whether a utility patent application should be filed and the scope of that application is typically a search. The business must first completely disclose the invention to the patent attorney and identify any publications and other inventions which describe or disclose, in whole or in part, related inventions.

The content of the invention disclosure varies depending on whether the invention is generally mechanical, electrical, or chemical, software, or is the result of a process. For mechanical inventions, the disclosure should include well-labeled drawings of the components and their interaction and provide a detailed description of the invention’s operation. For electrical inventions, the disclosure should include circuit diagrams. Chemical invention disclosures should provide a detailed written description of the methods of making and using the invention, its chemical structure, and end products.

Based on the disclosure, the patent attorney then examines the invention in light of the more than five million United States patents and any additional related publications identified to determine the possible scope of patent protection. While this search provides valuable information, it is limited to issued patents which have not been lost, misplaced, or incorrectly classified. Such searches are considered an indicator of potential impediments to patent protection. A more thorough search of patents in various countries and publications in indexed journals is possible and more reliable but may not be cost effective for the typical invention.

The patent attorney provides a written evaluation of the possible extent of patent protection. The search report with an evaluation identifies the prior art identified, the scope of the prior art, and the extent to which the invention may be patentable.

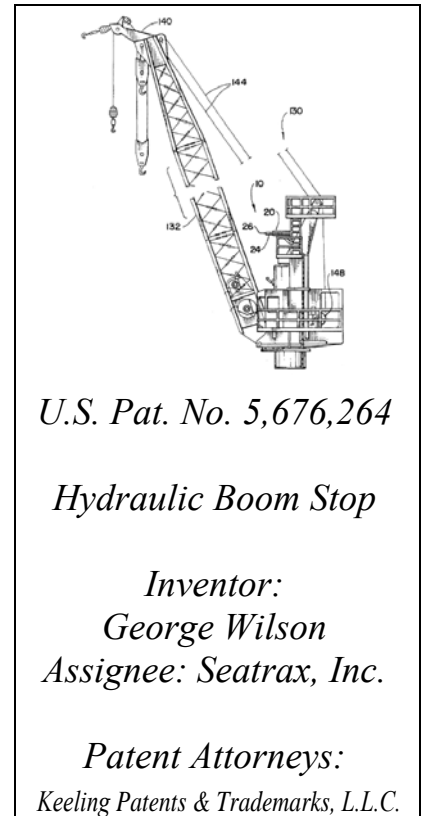
The patent attorney and client must then determine whether to pursue patent protection based on the written evaluation. Alternatively the patent attorney and client may elect not to pursue patent protection or instead to protect the invention as a trade secret, if possible.

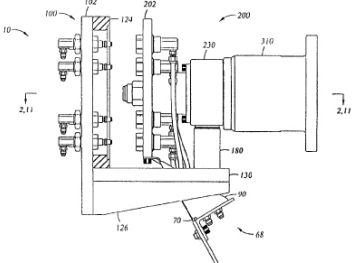
b. Time Bars

Even if the patent attorney determines the invention is not obvious to one skilled in the art and is useful, the patent attorney must identify dates which may render the invention unpatentable for lack of novelty. These bar dates preclude patent protection if:

1. the invention was in public use or offered for sale more than one year prior to the date of the application for patent protection in the United States; or
2. the invention was patented or described in a printed publication in the United States or a foreign country before the invention thereof by the applicant of a patent; or
3. the invention was known or used by others in this country or patented or described in a printed publication in this or a foreign country before the invention thereof by the applicant of a patent; or
4. the invention was first patented, caused to be patented or was the subject of an inventor's certificate by the applicant in a foreign country filed more than twelve months before the filing of the application in the United States.

In addition, many foreign countries bar patent protection of an invention if the invention is publicly disclosed before filing the patent application.





U.S. Pat. No. 6,017,065

*Remotely Operable
Underwater Connector
Assembly and Method*

*Inventor:
Bernt H. Hellesøe*

*Patent Attorneys:
Keeling Patents & Trademarks, L.L.C.*

2. Preparation and Filing of the Application

The inventor or assignee may pursue a provisional or a non-provisional application. Both require a specification that completely discloses the invention. The provisional application is not examined by the Patent and Trademark Office but does obtain a filing date that may be of consequence regarding time bars. Unlike the non-provisional application, the provisional application is not required to contain the specific claims that identify the metes and bounds of the invention. However, if claims and all other required materials are not filed within one year, the provisional application will be abandoned.

a. Foreign filing rights

United States inventors can claim the benefit of the filing date of their United States patent applicable in foreign countries which are signatories to specific international treaties. Foreign patent applications filed under such treaties must be filed within twelve months of filing of the application with the United States Patent and Trademark Office. If an inventor intends to file for patent protection abroad, the application will be published eighteen months after filing. A potential patent owner should confer with the patent attorney before public disclosure of the invention as some countries bar patent protection to any invention publicly disclosed.

In the event the applicant chooses to pursue patent protection abroad, the United States patent application may be translated if necessary and the drawings modified to comply with the specific foreign patent office's regulations.

3. Office Actions

The patent attorney typically receives correspondence from the patent examiner at the United States Patent and Trademark Office less than one year after the complete patent application is filed regarding the patentability of the invention and the detail of the drawings, if applicable. This office action is the result of a search by the patent examiner of prior art, including patents and other materials cited by the Applicant as relevant to the invention at issue.

The inventor must decide based on the patent attorney's advice whether, in whole or in part, to (1) pursue the application as filed and argue the patent examiner's objection is in error, (2) revise the application as necessary to overcome the patent examiner's objection, or (3) abandon the application. The response to the office action is due within three months, although the deadline may be extended to six months with payment of additional fees. Responses to office actions and telephone conversations with the patent examiner may result in further office actions or in allowance of the application. Typically after the second office action, the application is either allowed or "finally rejected." The average time between filing of an application and issuance of the resulting patent is nineteen months. The Patent Office has a system for appeal of final rejection.

a. Patent Issuance

If the patent application is allowed, the patent examiner will issue a formal "Notice of Allowance" which will identify the three month period for payment of the issue fee. If this fee is paid, prosecution of the patent application ends and a patent will issue. If any patent applications which are continuations in part of the patent application at issue are to be filed, they must be filed before issuance of the patent.

b. Maintenance Fees

To preserve the utility patent for its lifetime (20 years from the date of filing), the patent owner must pay maintenance fees during the six month periods beginning at three and one-half years, seven and one-half years and eleven and one half years (3.5 yrs, 7.5 yrs, 11.5 yrs) after issuance. Failure to timely pay maintenance fees results in loss of the patent. Patent attorneys calendar such dates to notify clients when these deadlines approach. As a result it is imperative that clients advise their patent attorneys of any change in address or patent ownership.

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.

35 U.S.C. § 111(a)(1)

U.S. Pat. No. 5,793,312

Data Entry System

Inventor:
Ryozo Tsubai

Patent Attorneys:
Keeling Patents & Trademarks, L.L.C.

4. Patent Infringement Issues

Receipt of a patent does not in and of itself prevent others from making, using, offering for sale, or selling any patented invention within the United States or importing any patented invention into the United States. This is accomplished through litigation or the specter thereof. Patent attorneys provide opinions and assist in litigation to enforce or defend patent rights, typically on an hourly rate basis.

a. Patent infringement opinions

Patent attorneys often provide opinions to clients regarding the potential of infringement between the client's invention or product and that of someone else. The patent attorney's opinion may include issues such as the validity of the patent, interpretation of the claims and whether a patent anticipates or is anticipated by the invention in question. In addition to providing some foresight regarding litigation, such opinions, when reasonably based on the law and relied upon by the client, provide a basis for good faith, which may minimize the damages at issue.

b. Patent infringement actions

Some disputes over patent rights cannot be resolved without litigation. Patent attorneys regularly participate in patent-related actions, either as primary counsel or as co-counsel for other trial attorneys. Recognizing the potential pitfalls in the patent's prosecution history and subsequent use is a specialized skill which is essential in such actions when determining whether there is literal infringement or infringement under the doctrine of equivalents.

B. Design Patents

"A design patent protects any new, original and ornamental design for an article of manufacture" for fourteen years and affords protection distinct from a utility patent.

4 Trademark Protection and Enforcement

Businesses create trademarks, service marks, or trade dress, the distinctive marks associated with the business' goods, services or product packaging (collectively "trademarks"). Patent attorneys counsel clients regarding trademark ownership, registrations, and enforcement actions.

A. Trademark ownership

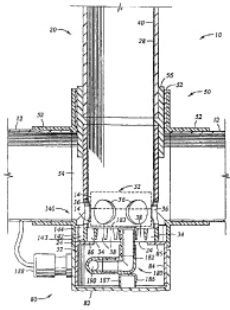
A business acquires common-law trademark rights by adoption and use of a distinctive mark in commerce in association with the goods or service. However, the rights and remedies associated with trademark ownership increase with registration. Patent attorneys counsel clients regarding trademark ownership and scope.

1. Trademark search and clearance

The first step in determining whether to use or register a trademark is a search. The business owner discloses the trademark and the goods or services associated or to be associated with the mark. The patent attorney then searches registered trademarks in the appropriate nationality, whether the United States or foreign countries. Based on the mark, its strength when compared to the associated goods or services, and existing registrations, the patent attorney advises the client whether the mark at issue is protectible or may infringe the rights of another.

Except as otherwise provided in [Title 35], 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.

35 U.S.C. § 271(a).



U.S. Pat. No. 6,183,630

*Chlorinator for Aerobic
Waste Treatment Systems*

Inventor:

Gary R. Reeves

Patent Attorneys:

Keeling Patents & Trademarks, L.L.C.

2. Trademark registration

Trademarks may be registered in the various states of the United States, for the entire United States, or abroad. In the United States and its various states, Texas in particular, registration of a trademark has noticeable benefits.

a. Texas

Registration of a mark in Texas is made through the Texas Secretary of State. The patent attorney prepares trademark applications which identifies the mark, the international class into which the goods or services fall, the description of the goods, and the date of first use of the mark in association with the goods or services, and responds to any office action from the Secretary of State's Office.

In the event of litigation, the Texas trademark registration is prima facie evidence of trademark ownership. However the protection is limited to the State of Texas and actions under Texas law for trademark infringement are limited to recovery of lost profits, which may can be difficult to establish.

b. Federal

Nationwide rights, subject to the rights of senior users, is provided by federal registration through the United States Patent and Trademark Office. Under the federal system the trademark owner may elect to pursue registration under one of two different regimes – the actual use application (AU) or intent-to-use application (ITU).

Federal trademark registration has significant benefits. In addition to constituting prima facie evidence of trademark ownership, federal registration provides additional monetary remedies in cases of infringement, including the infringer's profits and the trademark owner's actual damages or statutory damages, as well as attorney's fees. After five years of use the mark acquires additional strength, becoming "incontestable" with respect to specific defenses.

i. Actual Use Application

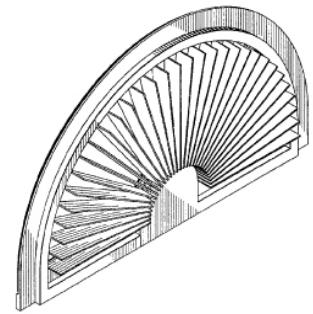
Under the actual use application, the patent attorney prepares a trademark application that identifies the mark, the international class into which the goods or services fall, the description of the goods, and the date of first use of the mark in association with the goods or services, and includes the specimens of use, then responds to any office action from the trademark examiner. Responses to office actions are typically performed on an hourly-rate basis.

ii. Intent to Use

Under the intent to use application, the patent attorney prepares a trademark application that identifies the mark, the international class into which the goods or services fall, the description of the goods, and responds to any office action from the trademark examiner. Actual use and intent to use applications have a significant difference – no actual use is required for intent to use applications. However within six months after issuance of the Notice of Allowance, the trademark owner must file a statement of use. Five extensions of six months to file the statement of use are permitted. Failure to timely file the statement of use or the extension results in loss of the mark.

c. Foreign Filing

The patent attorney may also work with attorneys in foreign countries to file for trademark registration in those countries designated.



*U.S. Des. Pat. No.
439,096*

Sunburst Window Blind

*Inventors:
John G. Clarson and
Troy D. Carlson*

*Patent Attorneys:
Keeling Patents & Trademarks, L.L.C.*

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.

17 U.S.C. § 102(a)

B. Trademark infringement issues

Patent attorneys also participate in actions regarding trademarks. This participation may begin long prior to any litigation with infringement opinions. Thereafter the patent attorney may participate in litigation related to trademark infringement, trademark dilution, false advertising and cybersquatting actions. Such work is typically performed on an hourly rate basis.

1. Trademark infringement opinions

Where a trademark-related action is possible the patent attorney may be called upon to provide an opinion letter regarding the potential exposure.

2. Trademark-related Actions

Patent attorneys regularly participate in trademark-related actions, either as primary counsel or as co-counsel for other trial attorneys. The issue in trademark infringement actions, both in federal and state courts, is whether potential purchasers would likely be confused as to an association, connection or sponsorship between the two entities. The court typically looks to eight factors in reaching a determination. The issue in trademark dilution actions in Texas courts is whether the use by the junior user is likely to make the senior user's mark less distinctive as an indicator of source. In Texas state actions, only injunctive relief is available. In federal dilution actions brought in courts governed by the Fifth Circuit, liability requires actual harm. Patent attorneys also work to deter cybersquatting under federal law, which typically focuses on trademark rights.

5 Copyright Protection and Enforcement

Copyright protection and enforcement has the ability to be a vexatious issue for a business. Businesses must note the creation of copyrightable matter, identify the author and ensure ownership of the copyright. With such information the business can register the copyright which, although not required for ownership, provides additional remedies and is necessary to bring suit.

A. Copyright Ownership

A copyright protects for a limited duration the original work of an author, artist, or composer fixed in a tangible media. The copyright owner has the exclusive right to reproduce, display, perform, sell or rent, or create derivatives of the original work.

1. Protectible Subject Matter

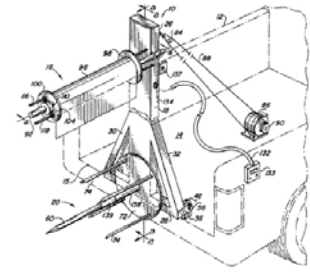
The subject matter protectible by U.S. copyright is statutorily defined and includes literary works; musical works, including any accompanying words; dramatic works, including any accompanying music; pantomimes and choreographic works; pictorial, graphic, and sculptural works; motion pictures and other audiovisual works; sound recordings; and architectural works.

2. Work for Hire

The "author" of the work for purposes of copyright law may not be the particular individual who created it, but the business which employed or commissioned the creator. This may be of critical importance if enforcement of the copyright is required.

a. Employees

Under the copyright laws, the business is the author of protectible subject matter created by an employee of the business in the course and scope of the employee's employment, absent some agreement between the employer and employee to the contrary. Such an issue may be addressed in an employment agreement regarding intellectual property.

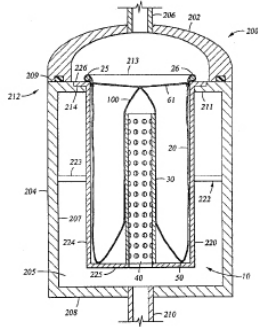


U.S. Pat. No. 5,352,080

*Bale Handling and
Wrapping Apparatus*

*Inventor:
Nayles G. Bakke*

*Patent Attorneys:
Keeling Patents & Trademarks, L.L.C.*



U.S. Pat. No. 5,910,247

Two Element Filter Bag

Inventor:

W. Mark Outterside

Patent Attorneys:

Keeling Patents & Trademarks, L.L.C.

b. Independent Contractors

Under the copyright laws, the independent contractor is the author of protectible subject matter created by the independent contractor in completing a commission for the business, absent a prior written agreement to the contrary which specifies the product will be a work for hire. Hence patent attorneys routinely contribute to contracts where an independent contractor is retained to produce protectible subject matter for the business.

3. Assignment

Even if a business does not take adequate steps prior to the creation of the copyrightable subject matter, the business may clearly acquire all copyright rights from the author through a written assignment.

B. Copyright Registration

The author of a copyrightable work, including the business itself, may file at any time for registration of its copyright with the Copyright Office at the Library of Congress. Such registration provides significant remedies in cases of infringement. Absent such a registration, or proof of compliance with the registration procedure, the author may not sue for copyright infringement. If the infringement commenced prior to registration, the copyright owner cannot recover attorneys fees or statutory damages, but is limited instead to recovery of the infringer's profits and the author's actual damages.

C. Copyright Infringement Issues

Participation in copyright infringement issues may begin long prior to any litigation with infringement opinions. Such work is typically performed on an hourly rate basis.

1. Copyright infringement opinions

Where a copyright-related action is possible, especially where the client may be the possible defendant, the patent attorney will provide an opinion letter regarding the potential exposure.

2. Copyright infringement actions

Patent attorneys regularly participate in copyright infringement actions, either as primary counsel or as co-counsel for other trial attorneys. Liability in copyright infringement actions is based on whether the purported infringement was created with access to the original work and is substantially similar to it.

6 Trade Secret Protection and Enforcement

A business may elect to protect confidential information that provides an advantage over competitors who do not have such information as a "trade secret." However this type of protection is limited and subject to actions taken to protect it by the business.

A. Trade Secret Ownership and Protection

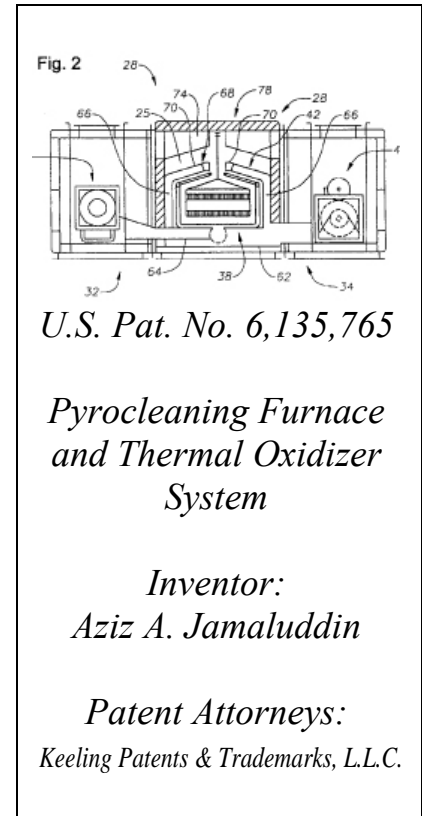
A business may own a trade secret through creation or through acquisition from another company. The business is required to maintain substantial secrecy with regard to the trade secret, which may be accomplished through confidentiality agreements executed before granting access to the trade secret, secured access to the trade secret, annual employee counseling sessions regarding trade secrets and employee exit interviews, among others. Patent attorneys counsel clients regarding institution of safeguards to protect the secrecy of the trade secret and how to recognize trade secrets. The scope of the work is determined by the extent of the business and the needs of the client.

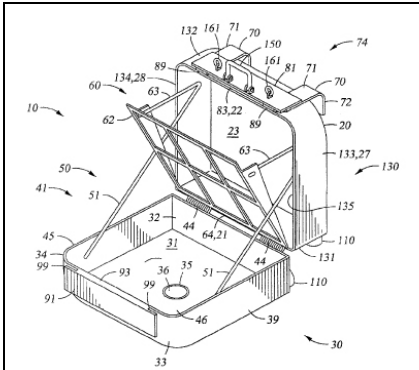
B. Trade Secret Misappropriation Actions and Remedies

Businesses are increasingly aware of the value of trade secrets. Jurisdiction over trade secret misappropriation actions, formerly the exclusive province of the state civil and criminal courts has recently been expanded to the federal criminal courts. Patent attorneys counsel clients regarding possible misappropriation and matter-specific actions to take, such as motions to seal court records and protective orders regarding access to discovery responses. Such work is typically performed on an hourly rate, with a total varying widely based on the scope of work to be performed.

1. State Causes of Action

In Texas, trade secret misappropriation is both civil and criminal misconduct. The trade secret owner may sue for improper acquisition of the trade secret in civil courts. District Attorneys may also prosecute the tortfeasor for criminal misconduct. However the protecting the trade secret within the judicial process must be considered while the cases are pending. It is often of little value to win a claim for trade secret misappropriation while disclosing the trade secret to the public.





U.S. Pat. No. 5,909,717

*Portable Collapsible
Livestock Feeder*

*Inventor:
Jimmie K. Randall*

*Patent Attorneys:
Keeling Patents & Trademarks, L.L.C.*

2. Federal Causes of Action

The federal criminal component of trade secret misappropriation, the Economic Espionage Act, was recently enacted. Although few cases have been tried under the act, at least one has been tried by the U.S. Attorney's Office in Houston, Texas. In the event such a case arises and federal criminal prosecution is sought, it is imperative that sufficient information be provided to the U.S. Attorney to permit an investigation by the Federal Bureau of Investigation and a successful outcome. As a result businesses should have clear precautions and protections in place to establish trade secret ownership and criminal conduct by the defendant. The patent attorney may work with the government to pursue the action.

7 Intellectual Property Acquisition and Transfer

Patent attorneys assist attorneys involved in commercial transactions to the extent intellectual property may be involved to evaluate the potential strength of the intellectual property and other IP-specific considerations.

Patent attorneys may perform a search of the business' existing intellectual property to identify both the intellectual property at issue and its strength. Such an intellectual property audit may include meeting with various employees to identify any trade secrets or inventions created by the business which may be of value, copyrightable subject matter, and trademarks used by the business. The search of each property must include all times from its creation to the present to identify the inventor or author, its date of invention, disclosure, publication, or use, and each manner in which it has been used since that time. It may be of little value to obtain inventions which are no longer patentable, or on which the patent has expired, or which have no trade secret status because it has been disclosed on at least one occasion. It may also be of little value to obtain copyright interests from the business if the authorship is less than clear. Alternatively if the acquisition of the intellectual property from a predecessor in interest was flawed, the intellectual property may have little value. As a result candor with the patent attorneys trying to identify such facts is essential.

