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# Protecting Your Work: Navigating Intellectual Property Laws In The United States

**Protecting Your Work:**  
**Navigating Intellectual Property**  
**Laws In The United States**

December 10, 2024



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The content in this guide reflects the law in force in the United States as of November 2024.



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# Introduction

Intellectual property or “IP” is the branch of law that protects creations of the human intellect, including inventions, symbols, and original works of creative expression. It also allows owners of this property to enforce their rights in such creations and prevent unauthorized use of their intellectual property by third parties. While it might seem like intellectual property protection only applies to businesses, it’s just as important for non-profits and social enterprises. Protecting IP like logos, inventions, and written materials can help any organization maintain its unique identity, avoid legal problems, secure funding, and build trust with its supporters.

There are different branches of intellectual property protecting different types of creations, each of which this guide will discuss in turn.

Intellectual property has distinct features that make it different from physical property. While only one person can possess a specific physical object at a time, intellectual property is intangible and therefore can often be used by multiple people at once. Relatedly, while it may be possible to recover a physical object from an unauthorized user, the owner of intangible intellectual property often cannot easily prevent others from exploiting the property without some sort of external legal protection.

Intellectual property law exists because of these differences. The law gives the holder of intellectual property a temporary “monopoly” on the invention, symbol, or creative work, which in turn allows the owner to overcome the challenges of protecting that intangible property.

Many entities and individuals rely on intellectual property law for a variety of purposes, including protecting customer lists and other valuable secret information from competitors, blocking counterfeit products, maintaining commercial or artistic integrity, fostering consumer recognition and goodwill, and earning a profit from licensing the property.

Intellectual property protection takes several forms in the United States, the most common of which are discussed in this guide:

- » Copyright, which protects original works of authorship
- » Trademark, which protects brands, logos, and other symbols of the identity of an entity
- » Patent, which protects new and useful inventions
- » Trade secret, which protects information that is valuable because it is secret

This guide will also discuss the licensing of intellectual property rights.

## Summary of Intellectual Property Rights in the United States

PROTECTIONS	REGISTRATION	DURATION
<b>COPYRIGHT</b>		
Protects original works of authorship against unauthorized copying of the work.	No registration required in order to establish copyright rights, but registration is required to bring a copyright infringement lawsuit.	Copyright term varies, but for most works protection will last for the lifetime of the author plus 70 years.
<b>TRADEMARK</b>		
Symbol of the owner and allows the owner to differentiate itself from competitors and identify its goods and services.	No registration is required for the establishment or enforcement of trademark rights, but benefits to registration include nationwide rights.	Protection lasts as long as the mark is in use. Federal registrations must be renewed every 10 years.
<b>UTILITY PATENT</b>		
Protects inventions of new and useful machines, compositions of matter, articles of manufacture, or processes, or new and useful improvements thereof.	Registration is required to establish rights and requires demonstrating a number of elements, including inventorship and novelty.	Protection lasts for 20 years from the effective filing date of the patent application.
<b>TRADE SECRET</b>		
Protects information that is valuable to a business because it is kept secret, such as a secret formula or customer lists.	No registration required.	Protection lasts as long as the information remains a secret.





# Copyright

## What is Protected by Copyright

Copyright protects works of authorship against unauthorized copying of the work. In order to be protectable by copyright, a work must meet three basic requirements. It must be:

- » A work of authorship
- » Original
- » “Fixed” in a tangible medium

### Work of Authorship

Copyright protects many different types of works. Examples of works that are protectable under copyright law include:

- » Literary works, such as novels or articles
- » Photographs
- » News articles
- » Website text
- » How-to guides
- » Computer software code
- » Sculptures
- » Music and other sound recordings
- » Architecture

Copyright protects both published and unpublished works. Generally, publication of a work subject to copyright occurs on the day on which copies or reproductions of the work are first distributed to the public.

### Originality

Works need to be original to be protected by copyright. A work need not be artistic or attractive or even interesting to be subject to copyright. However, the work may not have been entirely copied from an earlier work, and it must reflect at least a small amount of human creativity.

### “Fixed” in a Tangible Medium

An original work of authorship is protected by copyright from the moment it is put into a “fixed” medium. A work is “fixed” when it is set down in a medium that allows it to be viewed, listened to, or otherwise communicated for more than a short time. For example, recording a song, writing down a book, or filming a performance would all be considered “fixing” the work. On the other hand, a live performance of an improvised work is not fixed unless it is recorded.

## What is Not Protected by Copyright

Not every creation can be protected by copyright. Matters that are *not* protectable by copyright include:

- » **Unoriginal works** – Wholly unoriginal works cannot be protected by copyright.
- » **Mere ideas** – Ideas cannot be protected by copyright – only expressions of those ideas are protectable. Once an idea is



used to create a novel or a sculpture or software code, the resulting work may be protectable by copyright.

- » **Titles, names, or short phrases** – These cannot be protected by copyright, but they may be protectable under trademark law in certain situations. See the “Trademarks” section of this guide for more information.
- » **Lists** – “Mere lists” of ingredients or contents, such as recipes, cannot be protected by copyright. However, a story or other written element that accompanies the recipe can be.
- » **Works not created by humans** – A work must be created by a human author to be protectable by copyright. For example, works created by AI or by animals are not subject to copyright.

## Exclusive Rights of Copyright Owners

The owner of copyright in a work has the exclusive right to:

- » Reproduce or copy the work
- » Distribute copies of the work to the public (i.e., sell, rent, or lend copies)
- » Prepare “derivative works” based on the work (for example, a sequel to a book or a remix of a song)
- » Perform the work, either in person or via a recording or media transmission (radio, television, streaming, etc.)
- » Publicly display the work

Of course, a copyright owner can enter into licensing agreements to authorize others to exercise some or all of these rights. See the

“Licensing” section of this guide for further information.

Certain third-party uses of protected works that might otherwise be considered infringing may be permissible as “fair use.” This can arise, for example, in the context of criticism, wherein a certain amount of the protected work may be reproduced in order to critique the work. We advise seeking legal counsel to evaluate whether a proposed use of a third-party work may be deemed fair use. For more information on this topic, consult the U.S. Copyright Office’s Fair Use Index (<https://www.copyright.gov/fair-use/>).

## Ownership and Authorship

The author of the work is the original owner of copyright. The author is either the creator of the work or her employer or client, if the work is a “work made for hire.”

When a work is created by an employee acting within the scope of her regular employment, the work is automatically deemed a work made for hire, and authorship (and ownership) is automatically assigned to the employer. On the other hand, if a consultant, independent contractor, or other non-employee creates a work for a client, the work is not automatically a work made for hire, and the client will not be automatically considered the author and copyright owner. In order to ensure that the client commissioning a work retains copyright in works created on its behalf by non-employees, the parties must enter into an express written agreement specifically assigning all copyright rights to the client. To avoid later disputes regarding ownership, such “work made for hire” agreements should be in place before the consultant or contractor begins work on the project and are most often incorporated into the underlying contract between the parties.

## Copyright Enforcement and Infringement

In the United States, works are protected by copyright from the moment of creation. There is no requirement of registration in order to claim copyright protection.

While registration is not mandatory, registration of a work is required in order to act against an unauthorized user through a copyright infringement lawsuit. For more information on copyright registration, please consult the “How to Register a Copyright” section on page 37 of this guide.

## PRACTICAL TIP: EVALUATING THE VALUE OF A COPYRIGHT

Let’s say an organization creates a detailed educational guide called “Sustainable Living: A Comprehensive Guide to Eco-Friendly Practices.” This guide includes unique research, practical tips, illustrations, and case studies about reducing environmental impact, and the organization hopes to license excerpts from the guide to other entities, including textbook publishing companies and other non-profit environmental groups.

- » **Without Registered Copyright:** If copyright in “Sustainable Living” is not registered, the organization still automatically holds copyright protection from the moment the guide is created. This means that legally, the organization has the right to control how the guide is used and distributed. However, if another organization or individual copies and distributes the guide without permission, thereby infringing the organization’s copyright in the work, the copyright owner will not be able to bring a federal infringement lawsuit without having first registered the work. While the organization can seek an expedited registration even after infringement begins, such belated registration may make it difficult or impossible to collect damages or attorneys’ fees from the infringer, which could deter enforcement efforts. Funders and partners may also be concerned about the security

of the content – including, for example, about the prospect that content from the guide could be used without permission to mock environmentalists or otherwise in a way opposed to the goals of the copyright owner – or reluctant to pay to license the content, given that third parties are using the work for free.

- » **With Registered Copyright:** If the organization registers its copyright in “Sustainable Living,” it gains several advantages. Most notably, in the event of unauthorized use, the organization will have the ability to bring quick legal action against the infringer and to seek statutory (automatically calculated) damages and attorneys’ fees. The prospect of a copyright litigation in which statutory damages and attorneys’ fees may be awarded can actually deter potential infringers and reduce the likelihood of disputes. Additionally, registering copyright in a valuable original work may enhance the organization’s credibility, making it more attractive to funders and partners who value the materials they support.

In summary, while the “Sustainable Living” guide is protected by copyright even without registration, registering the copyright offers additional benefits that can streamline legal enforcement, save time and costs, and enhance credibility.



## Copyright Term

Copyright protection is limited in duration. The period of copyright protection for a given work, called its “term,” depends on several factors, including when the work was created. Standard copyright terms for works created on or after January 1, 1978 are described below:

- » For works created by a single author, copyright protection lasts for the lifetime of the author plus 70 years after the author’s death.
- » For works created by two or more authors, the copyright term lasts until 70 years after the last author dies.

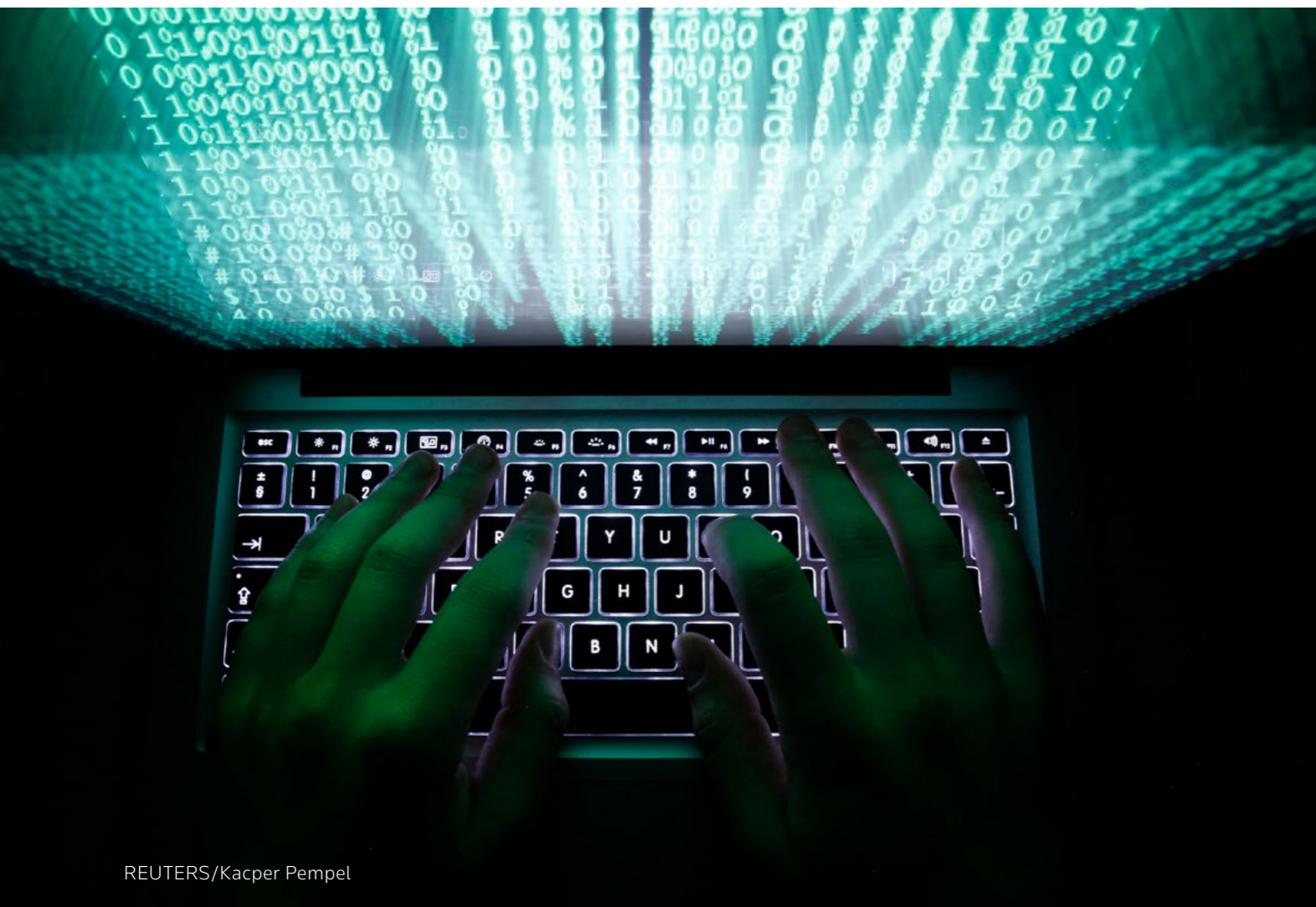
- » For works made for hire or works made under a pseudonym, copyright lasts either 95 years from first publication or 120 years from creation, whichever is shorter.

### Public Domain

If copyright protection in a work expires, is waived, or otherwise ceases to apply, the work enters the “public domain” and may be copied, modified, adapted, or otherwise used by anyone for any purpose. For example, very old works in which the copyright has now expired, such as *Alice in Wonderland* or the early novels of Agatha Christie, may now be copied, distributed, adapted, or otherwise used without restriction.



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REUTERS/Kacper Pempel

## COPYRIGHT ENFORCEMENT COMPANIES

Copyright enforcement companies monitor the internet for unauthorized use of works subject to copyright, including photos, and may contact your organization with a request to take down allegedly infringing material and/or a demand to pay a fee to resolve the dispute. If you receive such a communication, it is important to act promptly and responsibly. First, review your use of the identified material and determine whether you have a license or other right to use the work. If your organization is using the work without proper authorization, or if you cannot immediately deter-

mine whether you have the right to use the work, you should disable public access to it immediately and consider how to resolve the claim, such as paying a fee to obtain a license. We recommend consulting with legal counsel regarding the demand and your organization’s response.

To prevent such issues, all organizations should implement clear guidelines for use of third party-created content, such as only using photos to which the organization holds a clear license or purchasing stock images.



### Useful Resources

The purpose of this guide is to provide general information on copyright law in the United States. For additional resources or information, we recommend consulting the below resources:

- » <https://www.copyright.gov/>
- » <https://www.copyright.gov/what-is-copyright/>
- » <https://www.copyright.gov/help/faq/index.html>
- » <https://www.copyright.gov/fair-use/>
- » <https://www.copyright.gov/circs/>





## Trademarks

### What is a Trademark?

A trademark, sometimes called a brand, identifies the source of a good or service. A trademark can be the name by which a non-profit organization or social enterprise is known to the public, often known as a “trade name,” or any other logo, slogan, or symbol recognized as an identifying sign of the group. Use of a distinct trademark allows supporters and other stakeholders to easily identify a given organization and its programs, services, and campaigns, and can

help the organization establish and maintain reputation, influence, and public trust.

Trademark protections permit brand owners to exclude others from using their marks. With this protection, a trademark owner can invest in its brand and cultivate public goodwill without running the risk that another entity will simply adopt the same brand name and “steal” the reputation the owner has developed.

### TIP: TRADEMARK PROTECTION IN ACTION

The Nature Conservancy is able to raise money from donors because those donors support the work of the organization and want to further its goals. But if another entity adopts the trademark NATURE CONSERVANCY for itself, or a confusingly similar mark such as NATURAL CONSERVANCY, potential donors might not give as readily, since they may be uncertain about which similarly named organization is which. The new entity operating under the NATURAL CONSERVANCY mark might even wind up with some donations intended for the Nature Conservancy, if donors accidentally confuse the two. Relatedly, the reputation of

the “real” Nature Conservancy could suffer from the presence of another entity with a confusingly similar name. For example, if the new entity using the trademark NATURAL CONSERVANCY turns out to be engaged in illegal dumping or otherwise gets bad press, potential donors may mistakenly believe that the negative coverage refers to the Nature Conservancy itself, causing the Nature Conservancy to lose goodwill and future donations. In order to avoid this outcome, organizations like the Nature Conservancy protect their exclusive trademark rights, including by enforcing those rights against infringers like the fictional Natural Conservancy.



## What is Protected by Trademark Law?

Nearly any word, symbol, design, or combination thereof can be a trademark, as long as it serves to identify the source of particular goods or services. Some common types of trademarks are:

- » “Trade names,” or the name that identifies a particular company or organization
  - **Examples:** WWF, SIERRA CLUB, HABITAT FOR HUMANITY
- » Product/service names that identify particular products, services, or programs offered by the organization
  - **Examples:** LIVING PLANET, OPPORTUNITY ACCELERATOR, ALL ANIMALS
- » Slogans or taglines
  - **Examples:** RACE FOR THE CURE, PREPARED. FOR LIFE., BECAUSE THE EARTH NEEDS A GOOD LAWYER
- » Logos or designs
  - **Examples:**



An entity may have one trade name and use multiple product or service marks in connection with various offerings.

Less common types of trademarks include scents, sounds, or colors. For example, the production company Metro-Goldwyn-Mayer owns protectable trademark rights in the famous “roaring lion” sound that opens MGM movies, because the sound itself clearly identifies the source of the movie and sets the movie apart from those produced by other companies.

## Rights of the Trademark Owner

A trademark owner does not own universal rights in a mark. Rather, a trademark owner owns exclusive rights in its mark *in connection with the particular goods or services offered under the mark*. Given this, a trademark owner has the right to prevent third parties from using its mark or confusingly similar marks for related goods or services, but – absent special circumstances, including unusual fame or uniqueness of the mark – generally cannot prevent *all* third-party use of the mark. For example, Wendy’s trademark rights would likely permit the company to prevent another entity from opening a restaurant under the trademark WENDY’S, but might not stretch to bar the use of WENDY’S as a brand name for towels.

Trademark registration is discretionary rather than mandatory, and in the United States, trademark rights and protection derive from use of the mark rather than registration. Given this, trademark rights are established from the moment a mark – registered or unregistered – is used in commerce. However, unregistered rights are generally limited to the specific geographic areas where the mark is used. Federal registration provides for nationwide protection of a mark, even if the use itself remains geographically limited.

Use of the symbol ® indicates that the associated trademark has been registered with the United States Patent and Trademark Office (“USPTO”). Therefore, only owners of a federal registration may use the symbol. On the other hand, any trademark owner can use the symbol ™ alongside its mark. The ™ indicates to competitors and third parties that the trademark owner claims rights in the mark but does not convey a registration claim.

Unlike copyright protection or patent protection, which is limited to a specified term, trademark protection lasts as long as the mark is in use. Once the mark is no longer used or “abandoned,” protection will end. If a mark is federally registered at the time it is abandoned, the registration will be subject to cancellation.

For more information on trademark registration and maintenance, please consult the “How to Register a Trademark” section on page 38 of this guide.

## Trademark Strength

Trademarks have different levels of “strength,” which indicate the extent to which the trademark owner can prevent others from using similar marks. A strong trademark is generally unique or creative in the area in which it is used and does not have any obvious meaning in connection with the products or services offered under the mark. Because it is unique, a strong mark will effectively distinguish products or services bearing the mark from those of competitors.

On the opposite end of the spectrum are descriptive marks and generic terms. Descriptive marks merely describe some aspect of the goods or services offered under the mark, without adding any distinctive element.

### TIP: CHOOSING A STRONG MARK

If an animal rescue agency focusing on rabbits chooses to call itself RABBIT RELIEF, that trade name is considered descriptive since it describes the services offered by the organization: namely, relief to rabbits. Descriptive marks may be difficult to protect against third-party use – which is to say, to monopolize – because such third parties arguably need to be able to use the terms in order to describe their own goods and services. Given this, descriptive marks are not generally registrable except under special conditions – for example, if the mark has been in exclusive use by the entity for more than five years.

Generic terms are even weaker. A term is generic if it is the common name for the goods or services offered under the mark. An example of this might be RABBIT RESCUE for our hypothetical rabbit

## Useful Resources

The purpose of this guide is to provide general information on trademark law in the United States. For additional resources or information related to registering, maintaining, or enforcing trademarks, we recommend consulting the below resources:

- » <https://www.uspto.gov/trademarks/basics>
- » <https://www.uspto.gov/trademarks/search>
- » <https://idm-tmng.uspto.gov/id-master-list-public.html>
- » <https://www.uspto.gov/trademarks/trademark-updates-and-announcements/nice-agreement-current-edition-version-general-remarks>
- » <https://www.uspto.gov/trademarks/apply/teas-tutorial>



# Patents

## What is a Patent?

A patent is a temporary exclusive right to an invention granted by the government in exchange for sharing that invention with the public. Unlike copyright and trademark rights, patent rights do not develop automatically. In order to obtain a patent right, the patent must be publicly disclosed in an application filed with the USPTO. During the term of the patent, Congress grants the rightsholder a legal monopoly, allowing it to prevent others from making, using, selling, or otherwise commercially exploiting the identified invention. However, the life of a utility patent is only twenty years from filing, after which the patent expires, and the invention becomes available for free use by the public.

The term-limited nature of patent protection stands in contrast to trademark rights. Patent rights protect inventions that are useful to the public and sometimes even lifesaving, like innovations in pharmaceutical drug development. As such, while the monopoly right of a patent can be very valuable, it is brief in duration, to balance the need to encourage inventor investment in innovation with the competing need to allow public access to the

invention once the term is expired. On the other hand, a trademark owner can hold exclusive rights in a brand name forever, as long as the trademark is used in commerce. While granting a patent owner indefinite monopoly rights to an invention could function to deprive the public of access to a crucial innovation, allowing a trademark owner a permanent monopoly on its mark does not hurt the public and is in fact a net positive. Third parties should not ever *need* to adopt the trademark owner's mark – this is called infringement – and as long as they are prevented from doing so, consumers can continue to distinguish between various brands. See the “Trademarks” sections of this guide for more information.

In the non-profit context, even simple and practical inventions may benefit from patent protection to enhance their impact. For instance, an organization might develop a basic, low-cost tool designed to improve daily tasks for individuals in underserved communities. By securing a patent for this tool, the organization may ensure that the design is protected, which can help attract funding and partnerships to facilitate its broader distribution and ensure that it remains affordable.

## TIP: THE REALITIES OF APPLYING FOR A PATENT REGISTRATION

Evaluating whether to seek patent registration can be a complex decision, especially for resource-limited social enterprises and non-profits. It may be helpful to consider the following before starting the process:

### » Assess Value, Impact, and Costs

- Ensure the invention aligns with your non-profit's mission and has the potential to significantly advance your goals. Evaluate whether it has commercial potential or can be licensed to generate revenue to support your mission. Involve your board of directors in the decision-making process.
- Perform a cost-benefit analysis, taking into account the expense and complexity involved and the long-term commitment required. Legal counsel will almost certainly be necessary in order to navigate the complex patent process. Applying for a patent can be expensive (often \$15,000 or more in legal fees), and there will be ongoing maintenance fees after issuance as well.

### » Explore Funding Options and Alternatives

- Seek grants specifically aimed at supporting innovation and intellectual property protection for non-profits and look for pro bono or reduced-fee legal services, like those offered by the USPTO's Patent Pro Bono Program.
- Consider alternatives such as protecting the innovation as a trade secret if it can be kept confidential, or open licensing models that allow others to use the innovation while still recognizing your non-profit's contribution.

### » Conduct Due Diligence and Seek Expert Advice

- Conduct a thorough prior art search to ensure that your invention is novel and not already patented.
- Partner with experienced organizations if possible and obtain legal or other expert advice.





## What Can Be Patented?

There are three types of patents that cover different subject matter: utility patents, design patents, and plant patents.

**Utility patents** are by far the most common class of patents. Many useful inventions can be covered by a utility patent, the most common being the following:

- » Machines (like engines or computers);
- » Compositions of matter (like pharmaceutical or biological products);
- » Articles of manufacture (like toys or tools); and
- » Processes (like methods of treating an illness or methods of running a business).

Matters that cannot be covered by utility patents include:

- » Abstract ideas (like mathematical concepts, methods of organizing human behavior, and mental processes);
- » Naturally occurring products (like animals or viruses); and
- » Laws of nature (like gravity or magnetism).

**Design patents**, as their name suggests, cover non-functional design elements of products, like the shape and button layout of a smartphone or the design of a pair of sunglasses or shoes.

**Plant patents** cover new and unique properties of plants and are most often used by companies that genetically modify plants for particular uses and benefits.

## Utility Patent Protection

A patent, at its heart, grants the patent owner a right to exclude. Specifically, it grants the right to exclude others from making, using, selling, or offering to sell a product, method, or system that falls within the scope of the patent owner's invention. In order to obtain a patent right, the invention must be disclosed in an application filed with the USPTO.

"Freedom to operate," or the patent owner's ability to "practice" or use the invention claimed in the patent, is separate from patentability and the grant of patent protection. We recommend seeking legal counsel for advice on this aspect of patent law.

There are numerous requirements for obtaining a utility patent, including that the invention must be:

- » **New** (i.e., something that hasn't been created yet)
- » **Useful** (the invention has to do something);
- » **Non-obvious**, or not readily apparent from what is known to the public already (known as the "prior art");
- » **Described sufficiently** such that a person having ordinary skill in the relevant field of knowledge, or art, would recognize that the inventor was able to properly create and use the invention; and
- » **Enabled** such that a person with ordinary skill in the relevant field could make and use the claimed invention without undue experimentation.

The exact requirements for patentability can vary from technology to technology. As a general matter, though, these requirements ensure that the public is getting the benefit of its bargain with the patent owner in the form of full disclosure of a new invention in exchange for the owner's right to exclude others from making or using the invention for a limited time.

**Provisional applications** allow utility and plant patent applicants to obtain earlier effective filing dates by filing simplified applications. A provisional utility application does not require the detail that must be included in a non-provisional utility application, and the owner of a provisional application may state that its invention is "Patent Pending." However, an applicant that has filed a provisional application must follow up by filing a corresponding non-provisional application within 12 months, or the application will be deemed abandoned and the patent owner will not be able to claim the earlier filing date of the provisional application. A provisional application is never examined by the USPTO; it is merely relied upon for its earlier effective filing date.

Again, the patent application process is often long, complicated, expensive, and extremely difficult to navigate without professional assistance. A patent lawyer can help guide you through drafting a patent application, searching prior art, and preparing the many filings and other communications required with the USPTO.

For more information on registering and maintaining a patent, please consult the "How to Register a Patent" section on page 39 of this guide.

## Enforcing Patents

Patent rights can be enforced in numerous ways. If you believe a person or company is using the subject matter of your claimed invention, you can approach that third party and ask that it take a license to your patent or pay you a royalty for the rights to use your invention. See the "Licensing" section of this guide for more information.

If the party refuses to take a license, more aggressive action may be warranted. This could include sending a cease-and-desist letter to the infringer or threatening legal action. A cease-and-desist letter may include charts that map the accused product or process to your patent

claims, thereby demonstrating the infringement of your patent rights. If the infringing party still refuses to take a license or cease its infringement, the last resort is to file a lawsuit.

Patent lawsuits are always filed in federal court, and these lawsuits can be very expensive and time consuming. You will need to hire patent lawyers to run the case.



## Useful Resources

The purpose of this guide is to provide general information on patent law in the United States. For additional resources or information related to registering, maintaining, or enforcing patents, we recommend consulting the below resources:

- » <https://www.uspto.gov/patents/basics>
- » <https://www.uspto.gov/patents/basics/essentials>
- » <https://www.uspto.gov/patents/basics/apply#types>
- » <https://www.uspto.gov/patents/basics/apply>
- » <https://www.wipo.int/patents/en/>
- » <https://www.uspto.gov/patents/basics/using-legal-services/pro-se-assistance-program>





## Trade Secrets

### What is a Trade Secret?

A trade secret is a piece of information that is valuable to a business because it is kept secret. Such information may include a secret formula, a business practice, the design of a particular piece of equipment or physical device, a list of customers or suppliers, or a collection of information. Crucially, it is the secrecy of the information that gives it value.

One key difference between trade secrets and other types of intellectual property discussed in this guide is this secrecy. Trademarks and patents require some level of public use in commerce or public disclosure, and both published and unpublished works may be subject to copyright protection. But trade secrets, by their very nature, are kept away from the public eye. There is no system for registering trade secrets, no master list of trade secrets kept by the government, and no mechanism to inform the public that a company holds a trade secret.

### TIP: TRADE SECRETS IN PRACTICE

A classic example of a trade secret is the formula for Coca-Cola. The Coca-Cola company goes to great lengths to keep the exact formula a secret, including by limiting the number of people who are aware of the full formula and not fully labeling the ingredients that it sends to its mixing factories. There are a few reasons for the company to do this, including that it makes for a great marketing campaign, but one key reason is that it ensures that no competitor can make its own version of Coca-Cola. Other companies can, and do, make their own colas (that have their own fans), but no one has been able to replicate the exact taste of Coca-Cola, and this uniqueness can be used as a selling point.

Trade secret protection can also be relevant to non-profits and social enterprises. For example, maintaining the secrecy of a donor list may reduce the prospect that organizations with a similar

mission will identify and target the same donors, allowing you to maintain your unique relationship with your donors and maximizing your chance of obtaining future support from these sources. Some organizations may also hold trade secrets in the form of proprietary data such as patient lists or other information about members of the community served by the organization. For example, a recent court decision found that a compilation of data relating to members of the traumatic brain injury community constituted a trade secret of the Brain Injury Association of California. If your organization has developed a unique methodology for delivering services or a specialized training program, keeping this information confidential can help maintain your competitive edge and can also provide a marketing advantage, as supporters and funders may be drawn to the innovative and exclusive nature of your programs.



## What Type of Information Can Be a Trade Secret?

A wide range of information can be deemed a trade secret, including:

- » Financial information;
- » Business information, such as donor lists;
- » Scientific information, including formulas, techniques or processes for making products, or scientific methods in use;
- » Engineering information, including information relating to devices or designs; and
- » Computing information, such as source code, which is the building block of computer programs.

A trade secret can be written down on paper or exist only in digital form, in separate pieces or compiled all together in a single document.

There are two key elements that must be present for a piece of information to be a trade secret.

- » *The owner of the secret must work to keep the information secret.* If the person or organization that has the trade secret reveals the information publicly, then it may lose trade secret protection. The owner must take steps to keep the information secret in order for it to actually remain a trade secret. Because this can be quite complicated and difficult, claiming trade secret protection is generally only advisable for information that cannot otherwise be protected.
- » *The information must be valuable because it is secret.* It must be the secrecy itself that makes the information valuable. To put it another way, if another person who finds out about the trade secret information would be able to derive economic benefit from the information, then the fact that the information is being kept secret is what makes it valuable to its owner.

## How Long Does Trade Secret Protection Last?

A trade secret lasts for as long as the information remains secret. To use the example from above, Coca-Cola has been selling its product since the 19th century (although there may have been changes in that time) and continues to sell it while keeping the formula secret. If everybody involved is successful in keeping the information a secret, then in theory the information can remain a trade secret forever.

But there are a few complications. A trade secret requires the owner to practice constant vigilance, always working to ensure that the information is kept secret. That means knowing who has access to the information, whether any third parties have access to the information, where the information is kept, and the level of protection used.

Once trade secret information is revealed, either by accident or through a malicious actor, then the information loses its secret status and therefore its protection. That's why it is so important that a trade secret owner work to keep the information secret! A trade secret that is no longer secret cannot be made secret again.

## How Can Organizations Work to Protect Trade Secret Information?

There are a number of actions an organization can take to protect its confidential information.

One way is basic information security. Digital confidential information can be protected with passwords, and access to potential trade secret information should be limited to individuals within the organization on a need-to-know basis. If the information is in more physical form, storing it in a safe or otherwise limiting access can ensure that the secret information is not revealed to members of the public.

Additionally, trade secret information may be protected by having individuals with access to the information sign non-disclosure agreements (“NDAs”). NDAs create an obligation on the part of the parties to work to keep designated information secret and to refrain from disclosing that information to the public, or to any person who should not have access.

Organizations can also make clear to employees through employee manuals and trainings what is expected of them with regard to confidentiality. If the organization has information that it wants to remain confidential or to maintain as a trade secret, every employee with access to that information should know what is confidential, who should and should not be allowed access to that information, and what steps to take to keep the information secure.

## Useful Resources

The purpose of this guide is to provide general information on trade secret law in the United States. For additional resources or information related to trade secrets, we recommend consulting the below resources:

- » <https://www.uspto.gov/sites/default/files/documents/tradesecretsiptoolkit.pdf>
- » <https://www.uspto.gov/ip-policy/trade-secret-policy>
- » <https://www.wipo.int/tradesecrets/en/>
- » [https://www.wipo.int/tradesecrets/en/tradesecrets\\_faqs.html](https://www.wipo.int/tradesecrets/en/tradesecrets_faqs.html)



REUTERS/Jerry Lampen





## Licensing

### What is a License?

A license is an agreement pursuant to which intellectual property owners (or “licensors”) grant other parties (or “licensees”) the right to use their intellectual property within a defined field of use. Licenses are helpful to licensees because they allow the licensee to make authorized use of IP owned by third parties and limit the risk of an infringement claim. IP licenses also provide a mechanism for licensors to establish clear terms and standards pursuant to which licensees may use their IP – in effect providing a way for a licensor to maintain a level of control over the use of its IP by third parties.

### Points to Cover in a License

» **Scope of Use:** It is important to define exactly how a licensee can use the licensed IP, which is commonly called the field of use. The field of use will be determined based on the context of the agreement and goals of the parties. For example, a company may grant a website developer a license to use a copyright-protected work for the sole purpose of developing a website for the company, or a patent owner may grant a pharmaceutical company a license to use its patented invention to develop and commercialize a new pharmaceutical product. Any use of the licensed IP outside of the authorized field of use is not authorized by the licensor.

### TIP: WHY GRANT A LICENSE?

Licensing IP can be a strategic move for non-profits and social enterprises to amplify their impact and sustainability. By licensing IP such as training materials, educational content, or proprietary software, organizations can generate additional revenue streams that support their mission and operations. This approach also allows wider dissemination of innovative solutions, allowing other organizations and stakeholders to benefit from and implement these resources in their own communities. Moreover, licensing agreements can foster collaborative partnerships, enhancing the organization’s reach and influence while ensuring that its IP is used ethically and in alignment with its values. Ultimately, licensing IP not only protects the organization’s creations but also leverages them for greater social good and financial stability.

» **Exclusivity:** A license can be exclusive to a licensee, meaning the licensee is the only party that is allowed to use the licensed IP in the defined field of use, or non-exclusive, meaning multiple parties can use the licensed IP in the defined field of use. Special consideration should be given to any exclusive license granted



and the potential limiting effect of an exclusive license on a licensor's ability to use its own IP. It is also helpful to consider if the licensee should have the right to sublicense the right to use the licensed IP, for example to a subcontractor that may be needed to help complete a project.

- » **Term and Termination:** The term will define the length of time that a licensee can use the licensed IP. This could take the form of a set period of time, or a non-fixed but clearly defined window (for example, until the expiration of the last of the licensed patents to expire). A license agreement may also indicate the circumstances in which a party can terminate the license prior to the expiration of the term – e.g., breach of the agreement, bankruptcy, or failure to pay license fees.
- » **Fees:** Some licenses require that a licensee pay a fee to the licensor for the right to use the licensed IP, commonly called a royalty. This can take the form of a fixed fee, like an upfront payment paid at the time the parties enter into the license, or a variable rate, like a percentage of the net sales of products marked with a licensed trademark.

## Special Considerations for Licensing Specific Types of IP

- » **Trademarks:** Trademark licenses should require that the licensee maintain a defined standard of quality for all goods and/or services offered in connection with the licensed mark(s). Such "quality control" provisions are intended to ensure that the trademark owner maintains sufficient control over the licensee's use of the mark to prevent that use from diminishing the reputation or "goodwill" of the mark and, by extension, the owner's entity or brand represented by that mark. A trademark license should therefore grant the licensor the right to regularly review the use of the licensed mark by the licensee and to reject any use that does not conform to the defined standard. The license should also make clear that the licensee's use of the mark "inures to the benefit of the licensor," meaning that the use is for the legal benefit of the licensor and does not result in the licensee developing any ownership rights in the licensed mark. For more information on trademarks, see the "Trademarks" section of this guide.

### EXAMPLE LICENSE GRANT CLAUSE:

Licensor hereby grants to the Organization, and the Organization hereby accepts, subject to the terms and conditions of this agreement, a non-exclusive, royalty-free, non-transferable, non-sublicensable, revocable license to use the Licensed Intellectual Property in the United States solely for advancing the Organization's mission, including but not limited to the development, dissemination,

and implementation of educational programs, community outreach initiatives, and advocacy efforts relating to children's theater.

*Note that for the purpose of this example, the terms "Licensed Intellectual Property," "Licensor," and "Organization" were defined elsewhere in the agreement (such as in an exhibit, schedule, or defined terms section).*

- » **Patents:** Patent licenses can be granted for a set term or for the life of the patent. Special consideration must be paid to whether licensed patents should consist of a set "universe," or group of patents, such as the patents existing as of the date of the license, or whether the license should include additional related patents, such as divisionals, continuations, continuations-in-part, reissues, or foreign equivalents that may not be active at the time of the effective date of the agreement, but which may be relevant to the license. Patent licenses may also include a corresponding license to certain know-how consisting of information necessary or useful to the utilization of the licensed patent rights. For more information on patents, see the "Patents" section of this guide.
- » **Trade Secrets:** Secrecy/confidentiality is the basis of rights in a trade secret. As a result, any license for a trade secret should require the licensee not to disclose the trade secret and to maintain its confidentiality. Many trade secret licenses require individual employees or representatives of the licensee to sign an NDA attached as an exhibit to the license agreement in advance of gaining access to the licensed material. For more information on trade secrets, see the "Trade Secrets" section of this guide.
- » **Software:** Software licenses are very common and almost all entities will hold licenses that allow them to use third-party software. These licenses are most common for commercially available/non-customized software, like Adobe, Microsoft, or Box, the terms of which are usually in click-through or other non-negotiated form.
- » **Licenses with Service Providers:** An organization may need to grant a license to a third-party service provider (like a software developer or manufacturer)

to allow the provider to use the organization's intellectual property to fulfill service obligations. For example, a non-profit organization contracting with a manufacturer for the production of promotional hats will need to grant the manufacturer a trademark license in order to permit the manufacturer to produce hats bearing the organization's trademark. Such a license will often be limited in time and subject to termination by the trademark owner. On the flip side, a freelance software developer may need to grant a commissioning organization a license to any source code incorporated into the work that was created by the developer. In that case, the contract between developer and commissioning organization should grant the organization an irrevocable (cannot be terminated), royalty-free license to the work to ensure that the organization can continue to use the software created by the developer without incurring any additional fees or risk of infringement in the future. The contract should also clearly define who owns any additional intellectual property developed as a result of the services provided under the agreement with the service provider.



### Useful Resources

The purpose of this guide is to provide general information on intellectual property licensing in the United States. For additional resources or information on this topic, we recommend consulting the below resources:

- » <https://www.wipo.int/sme/en/assignment-licensing.html>
- » <https://www.aipla.org/list/innovate-articles/licensinwg-intellectual-property-101-what-every-entrepreneur-and-business-owner-should-know>
- » <https://www.inta.org/fact-sheets/assignments-licensing-and-valuation-of-trademarks/>





## HOW TO REGISTER A COPYRIGHT

Copyright protection exists from the moment that a work of art is created, or “fixed,” and does not depend on registration. However, copyright must be registered with the United States Copyright Office before it can be enforced via litigation. Registration is also useful to give notice to others that the owner claims exclusive rights in the work, and registration creates a presumption in the event of a lawsuit that the information on the registration is correct.

Copyright registration information for works registered since 1978 is publicly available on the Copyright Office’s website at <https://www.copyright.gov/public-records>, though the underlying registered works are not visible to the public.

Most copyright applications can be filed online at <https://www.copyright.gov/registration>. While applications may differ by type of work and otherwise, all copyright applications must include the following:

- » The title of the work
- » The author of the work
- » Contact information, including name and address, of the owner of the work
- » Whether the work has been published, either in the U.S. or internationally
- » Whether the work has been previously registered
- » Whether the work includes preexisting material
- » A copy of the work
- » A filing fee

For more information on copyright registration, see the U.S. Copyright Office’s Circular at <https://www.copyright.gov/circs/circ02.pdf>.

An additional, optional method of asserting copyright in a work is to apply a copyright notice to the work. This is typically done by adding the following information to the work:

- » The symbol © or the word “Copyright”
- » The name of the copyright owner
- » The year of first publication.

A copyright notice is not a substitute for registration but does serve to put others on notice that the owner is claiming copyright protection in the work.





## HOW TO REGISTER A TRADEMARK

Trademark applications are filed online through the Trademark Electronic Application System of the USPTO (<https://www.uspto.gov/trademarks/apply>) and then “examined” by attorneys at the USPTO. All applications must include:

- » The mark applied for
- » The name, address, and contact information of the trademark owner
- » The goods or services in connection with which the mark is or will be used
- » The “international class” into which those goods or services fall – for example, Class 41 for educational services, or Class 44 for health care services
- » The “basis” of the application: namely, claimed current use of the mark in connection with the identified goods or services, or “intent to use”
- » If applicable, the date of first use of the mark and a specimen of use of the mark

### A Note on Filing Basis

- » **In-Use.** Applications based on claimed current use of the applied-for mark must include a “specimen,” or proof of use of the mark for the goods or services identified in the application. This could be a photograph of goods bearing the mark, or a screenshot of the owner’s website showing the mark used to advertise services specified in the application.
- » **Intent-To-Use.** If a trademark has been selected but is not yet in use, an applicant may effectively pre-reserve rights in the

mark through an intent-to-use (“ITU”) trademark application. ITU applications are examined just like applications based on use in commerce, but following examination, a notice of allowance rather than a registration will be issued. In order for the mark to progress to registration, the applicant must submit proof of use of the mark within three years of issuance of the notice of allowance. During that three-year period, the USPTO will require the applicant to submit extensions of time every six months.

The USPTO offers a TEAS Plus trademark application form for quicker, less expensive trademark applications. Though this form allows for significantly less flexibility than the standard form, the TEAS Plus form is often the easiest and most straightforward option for organizations filing trademark applications “pro se,” or without an attorney.

As part of the examination process, the USPTO compares applied-for marks with existing marks on the trademark register to determine if the new mark may create a likelihood of confusion with a prior mark. If an applied-for mark is found to cause such a likelihood of confusion, the application may be refused on that basis. In order to reduce the risk of such a refusal, it is a good idea to search the USPTO’s database at <https://tmsearch.uspto.gov/search/search-information> for similar or identical marks covering similar or identical goods before filing a new application.

For more information and a detailed walkthrough of the application process, see the USPTO’s TEAS tutorial at <https://www.uspto.gov/trademarks/apply/teas-tutorial>.



## HOW TO REGISTER A PATENT

It is extremely difficult, if not impossible, for a non-practitioner (i.e., someone other than a patent agent or patent attorney) to successfully draft, file, and prosecute a patent application on his or her own. Accordingly, we do not recommend attempting to prepare a patent application without professional assistance.

With that said, a non-provisional utility patent application will include the following:

- » **Oath or declaration:** under US law, an inventor must sign a declaration stating that he or she and any co-inventor(s) invented the invention.
- » **Specification:** a utility application’s specification, or description of the invention, should include:
  - **Title of Invention:** brief, usually describes the invention.
  - **Priority paragraph** (if applicable): if the application claims priority to one or more prior filings, e.g. a provisional application, it must identify the prior filings.
  - **Background:** description of the field of the invention.
  - **Brief summary:** describes the problem(s) solved by the invention and briefly conveys the idea or point of the invention.
  - **Detailed description:** describes methods for practicing the invention. The description can include examples

of how the invention is made and used or is expected to be made and used. This section generally comprises the bulk of the specification and can be anywhere from a few pages to several thousand.

- **Claims:** define the exact invention for which you hope to obtain patent protection. The claims set forth the scope of your protection, i.e., the invention that you are allowed to exclude others from using.
- **Abstract:** a brief introductory description of your invention indicating how it is new.
- **Drawings and brief description of drawings** (if applicable): if drawings are necessary to understand the claimed invention, each drawing must be accompanied by a very short description.

More details are available at <https://www.uspto.gov/patents/basics/apply/utility-patent>.

Applications for design patents or plant patents may have different or additional requirements. Once again, we strongly recommend seeking legal counsel before filing any patent application.





REUTERS/Ina Fassbender