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Intellectual Property Basics for Designers

In today's digital world, with its increasing emphasis on distributed and cloud computing, open-source software, and generally on the ubiquitous nature of information, designers face intellectual property issues in an ever-increasing number of areas. Intellectual property issues can arise with respect to both protecting your own works, as well as protecting yourself from the unintentional infringement of others' rights.

1. Ownership Basics

A common threshold question of intellectual property disputes is ownership—who owns the rights associated with the work at issue? Usually, the individual(s) responsible for the creation of the product, method, design, or work is the legal owner, unless or until ownership is transferred to another individual or corporation. However, ownership can become more complicated when you are hired to design or create a particular work. Therefore, the best practice is to ensure a written agreement explicitly delineates who will own the intellectual property rights at the conclusion of the project. At some levels, ownership of intellectual property rights depends on the type of intellectual property involved.

A patent is a grant by the government of the right, for a limited time, to prevent others from making, using, selling, offering to sell, and importing a patented invention. Generally speaking, a patentable invention is any new, useful, and non-obvious process, machine, manufacture, or composition of matter, or any improvement thereof. Until the recent change in law caused by the America Invents Act, the United States was

a first-to-invent system, which meant, under certain conditions, a patent would issue to the first person to have invented it. So, from that standpoint, an inventor could have latent rights in an invention at the moment of invention, so long as the inventor later took the necessary steps to obtain a patent for it. Now, the United States is a first-inventor-to-file country. In order to eventually obtain protectable rights in an invention, an inventor now must be the first person to file a patent application for it.

A trademark is a recognizable symbol, design, or even packaging that identifies the source of a product or service, distinguishing it from other sources. In the United States, trademark rights may arise simply by using the mark in commerce.

A copyright provides an author a bundle of rights to protect original works of authorship, which may include literary works, songs, paintings, sculptures, software, and architectural designs (including the form of a building itself) for a term of the author's life plus 70 years. Rights inhere upon the moment the work is created and fixed in a tangible medium of expression.

2. Registration Basics

Regardless of whether registration is required to obtain intellectual property rights, it is, in almost all cases, highly beneficial to the owner. The issuance of a patent, or the registration of a trademark or a copyright, provides the broadest scope of nation-wide protection, including in many cases a presumption of ownership.

Copyright registration is the simplest of the three, requiring only some basic paperwork and depositing copies of the work with the U.S. Copyright Office. However, it is important to note that in many jurisdictions a copyright registration must be obtained before an infringement action may be filed. Registration with the U.S. Copyright Office provides official recognition from the government of your ownership of the registered work.

Trademark registration requires that an applicant either be using or have an intent to use the mark. Registration further requires that the applicant submit an image of their trademark to the U.S. Patent and Trademark Office, and place the mark into a classification based on the goods or services with which the mark will be associated. If the Office does not find the mark to be merely descriptive or likely to confuse consumers, registration will be granted.

Unlike trademarks and copyrights, patents are not registered. Instead, an inventor prepares a detailed and comprehensive patent application and submits it to the U.S. Patent and Trademark Office. This begins a process called "prosecution", which involves many substantive arguments between the inventor and the patent examiner.

The examiner searches what is already known in the art and compares that with the invention disclosed. If the applicant presents a new, useful, and nonobvious invention, a patent will be issued.

3. Infringement Basics

Intellectual property rights are exclusionary rights, meaning the owner has the right to exclude others from doing certain things with the protected work (subject to certain exceptions). It is the responsibility of the owner to "self-police" their rights against infringers. So, in addition to protecting your own work via registration or issuance, it is wise to protect yourself from unintentionally infringing the intellectual property rights of others. Infringement of an intellectual property right generally does not require intent, and in most cases, does not require knowledge of the existence of someone else's right. For this reason, due diligence in the form of a thorough search of existing works and rights is necessary to protect yourself from the unintentional infringement another's rights.

For visual designs and trademarks this may include utilizing the reverse image search option on Google® or other dedicated image searching sites to unmask possible infringement. In your own designs, it is important to verify your right to use any component you incorporate that is not your original creative work. This includes any images selected from the internet that are incorporated into your design. Further, when you obtain any writing, image, design, architectural plan, etc., from another person or entity it is important to insist on a written grant of all rights to use the work, and full

indemnification for any intellectual property infringement that could possibly arise as a result of that element of the design. The legal standard for determining whether trademark infringement has occurred is whether a prospective customer would likely be confused by the similarity of the two marks. Therefore, the design of trademarks requires particular attention to the originality of the mark, as well as to the existence of similar marks, especially for similar or related goods or services. A thorough trademark search during the design and registration process allows for the discovery of similar marks prior to any infringement.

In the context of patents, it is important to remember that merely because an invention is not yet on the market for public consumption does not mean that there is not a patent covering a particular technology. Inventors should generally understand and stay apprised of the current state of their art. Additionally, it is important for inventors to conduct a search of patents and patent applications (both domestic and foreign) in order to minimize the likelihood of infringement.

In the context of copyrights in architectural works, it is important to remember that copyright infringement may occur at any stage of project development. Infringement

may be as direct as the copying of another's blueprints. It may also occur when a building is erected that is substantially similar in appearance to the blueprints or plans of another building. Minor changes to a building's design will not eliminate infringement, as courts often focus on the "look and feel" of the buildings. This creates a blurred distinction between inspiration and infringement of which designers, architects, and builders must be cognizant.

4. Summary

The upfront investment of protecting your own intellectual property rights, and the diligence to minimize the likelihood of infringing someone else's intellectual property rights will reap many long-term benefits. This investment will go a long way to ensuring your work is not used (or misused) without your permission and without compensation, thus protecting the investment of your time and effort in the creation of the work. Further, this upfront investment may also prevent your becoming entangled in lengthy and costly infringement battles.

Article provided courtesy of Robert H. Eichenberger, a registered patent attorney and chair of the intellectual property practice group at Middleton Reutlinger, Louisville Kentucky. He focuses his practice in patent prosecution and patent litigation. See his full bio at middletonlaw.com.

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