

**INTELLECTUAL PROPERTY Q AND A (LABBOOK, PATENT, COPYRIGHT,
WEBLAW, MARKS, AND TRADE SECRETS)**

The Q&A herein are excerpts from “Technology Commercialization Manual. Strategy, Tactics, and Economics for Business Success.” (www.tclearningcenter.com). Notation after each heading reflects the (# of excerpts/total Q&A).

The Q&A are for information only. Seek legal or accounting advice for specific situations.

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LABBOOK (10/24)

1. How will the law be applied?

Inventors outside of the United States will be able to prove a date of invention of January 1, 1996 or later for patent applications filed after January 1, 1996. Over time patent applicants outside the United States will share equal footing with United States inventors with respect to their ability to establish priority dates earlier than the patent application filing date.

As one example of how the law will be applied, laboratory notebooks from an invention first conceived and documented on January 10, 1996, but not filed as a patent application until September 10, 1996, can be submitted to the U.S. Patent Office to overcome novelty rejections based on a reference by another disclosing the invention and published on April 10, 1996. This evidence is offered as proof that the inventor was in a possession of the invention before the publication date of the reference.

However, also based on the GATT legislation, the earliest priority date available to inventors outside the United States is January 1, 1996. Therefore, an application filed on January 10, 1996 will be limited to a priority date no earlier than January 1, 1996 even if the inventors can prove a conception date years earlier. As noted, this disparity will even out over time.

2. What does this change mean to the inventor outside the United States?

Unless procedures are already in place, inventors outside the United States must establish rigorous invention documentation procedures to corroborate statements made to the United States Patent Office. United States courts have held that mere statements of invention and diligence are not sufficient. The inventor must provide corroborating evidence to establish what was done and when it was done. This evidence is preferably documentary in nature and is used to establish a "priority date." Priority date is one of two potential dates; either the date the invention was conceived and reduced to practice prior to patent application filing or the date the invention was first conceived and subsequently worked on diligently until the patent application was filed.

3. When is establishing a priority date earlier than the patent filing date important?

Proof of the priority date is useful in both litigation and patent examination within the United States Patent Office. Proof of conception and reduction to practice is important in litigation in any patent infringement case, when the date of invention is at issue. Invention dates are also important in trade secret misappropriation litigation.

During patent prosecution, evidence of the date of invention can be used to remove references from examination when the references are published less than one year before the patent filing date. Here, the inventor must document conception and diligence from a time prior to the publication date to the time the invention was either reduced to practice or filed as a patent application. Proving the date of invention is also critical in interference practice where the outcome of the proceeding rests upon a determination of which of two or more inventors was the first to invent the claimed invention. Finally, laboratory notebooks and invention disclosures may be used to remove prior art rejections from reissue and re-examination proceedings.

4. How is the date of invention, "the priority date", established in the U.S. Patent Office?

Under the U.S. system, invention begins with the conception of the invention; that is, the formulation of a definite and permanent idea of an operative invention. The inventive process ends when the invention is reduced to practice. Reduction to practice is said to occur when either the invention is reduced to a tangible and useful form or when an enabling patent application is properly filed in the United States or elsewhere. Priority is awarded to the inventor who first reduces the invention to practice or who first conceives of the invention and can prove that he or she has worked diligently on the invention toward reducing the invention to practice until a patent application was filed. Diligence has been held in the courts to mean consistent, mostly daily activity directed toward the goal of reducing the invention to practice. However, even if an inventor can prove conception and diligence in reducing an invention to practice, priority will be lost with proof that the inventors abandoned, suppressed or concealed their invention. Therefore, even under the U.S. patent system, timely filing of a patent application is essential.

5. What type of references can be antedated using corroborating evidence?

"Antedation" refers to the ability of the patent applicant to prove that he or she was in possession of as much of the information in a reference as the Patent Examiner is using to form the rejection. Evidence of prior conception and diligence in reducing an invention to practice is used to antedate patents, published patent applications or printed publications from anywhere in the world.

There are at least four basic exceptions to this rule. First, a reference cannot be antedated with corroborating evidence if the publication date of the reference is more than one year prior to the effective filing date of the patent application under examination. Nor can a reference be antedated if the reference is a patent issuing to the same applicant outside the United States prior to the filing date of the U.S. application where the non-U.S. patent application was filed more than twelve months before the effective date of the United States patent application. Third, one cannot antedate a U.S. patent claiming the same invention as claimed in the patent application under examination if the patent is issued to another inventor. This dispute is managed by an interference proceeding. Finally, an Examiner can refuse to enter evidence introduced to remove a reference from prosecution where the Applicant has previously admitted that the reference was prior art.

6. What form of corroborating evidence is permissible?

Laboratory notebooks, invention disclosures, internal memoranda, monthly reports and laboratory data sheets are all permitted documentary evidence. Invention disclosure forms can be prepared by the inventor to prove the date that the invention was first conceived. Signed and witnessed copies of these forms can be used to establish conception and, in some cases, reduction to practice. While invention disclosures, internal memoranda and monthly reports may be accepted by the Patent Office, they may also be viewed as self-serving. Similarly, laboratory data sheets that were not attached to a laboratory notebook at the time of their preparation may also be considered suspect.

7. Why isn't witness testimony enough to antedate a reference?

Corroboration may take the form of independent testimony; however, when the testimony is provided long after the facts occurred, it may not be well received. In general, original exhibits, drawings, records or photocopies must accompany and form part of the affidavit or declaration by the inventor or their absence must be satisfactorily explained.

In some cases testamentary evidence is enough where the absence of documentary evidence can be adequately explained. When the testamentary evidence is provided solely by an inventor or an interested party without supportive documentary evidence, the testamentary evidence may be viewed as self-serving. Third party testamentary evidence is rarely sufficient to antedate a reference because the third party must be able to swear to facts which would necessarily be documented in a laboratory notebook. Thus, the third party may be called on to swear to dates, details regarding laboratory experiments, results, and details relating to the progress of the invention. It is rare that a third party has first hand information related to these details or was available to view and review the experiments at each stage of the inventive process. The Patent Office is free to conclude that witness testimony is not credible or reliable.

8. What type of corroborating documentary evidence is preferred?

Legible laboratory notebooks are preferred as a corroborating source by the United States Patent Office because the notebooks represent an unbiased resource for the laboratory worker who is attempting to reduce the invention to practice. The notebooks were prepared contemporaneous with conception and reduction to practice. Thus, there is a presumption that these notebooks are an unbiased and true representation of the data. Notebooks should be signed and witnessed at or near the time of their preparation by someone (a non-inventor, under a duty of confidentiality) who has read and understood their contents. It is possible that a Patent Examiner will not accept notebooks that are not witnessed.

9. How much documentary evidence is needed to antedate a reference?

An applicant is only required to provide evidence of priority with respect to so much of the claimed invention as the references happen to show. Thus, it is not necessary that the laboratory notebook evidence demonstrate each and every fact provided in a particular publication. Rather, the applicant must demonstrate only that he was already in possession of the particular information in a reference that was used to form the novelty or obviousness rejection at the time the reference was published. The Applicant is also permitted to provide evidence demonstrating an obvious variation of the information provided in a reference that is being used to reject the application.

10. When should laboratory data be submitted to the Patent Office to antedate a reference?

Laboratory data, accompanied by the appropriate testimonial proof, must be timely presented. Patent Examiners generally will consider this evidence if it is submitted prior to a final office action. These rules change somewhat if a petition for expedited examination has been filed with the United States Patent Office. After final rejection the Applicant must provide a showing of good and sufficient reasons why the evidence was not earlier presented. Without this evidence, the Applicant may be required to file a continuation application in order to have the evidence submitted into the record.

PATENT (10/118)

Most countries use a "first to file" patent system. The first inventor to file a patent application receives the right to exclude others, including those who first invented the same invention, but filed at a later date. Under the United States System, the person who first invents is entitled to exclude others from practicing a claimed patented invention. Until recent GATT legislation, only

U.S. inventors were permitted to establish a date of invention prior to the U.S. patent application filing date. Other inventors seeking earlier priority dates could only rely on the earliest patent application filing date established under the Paris Convention. On January 1, 1996, GATT legislation will take effect to allow all inventors, including those outside the United States, to establish a date of invention of January 1, 1996 or later for all patent applications filed in the United States after January 1, 1996. The following includes questions to help understand new legislation. The GATT legislation offers patent opportunities for inventors and assignees outside of the United States who are able to adequately document their inventive process in a manner that is acceptable to the United States Patent Office.

1. If an idea is generated; what should they do next to protect it?

Before an inventor begins spending money on the patent process, they must first verify the marketability or feasibility of the invention. Way too often inventors go down the road of inventing “just knowing their invention will sell” but not having the desire to see whether it won't sell. So the recommended steps to proceeding with the invention process are: (1) begin an inventor's journal and record in writing everything having to do with the invention, (2) complete some good market research and verify the marketability, and (3) begin the patent process.

2. What is a patent?

In the United States there are three kinds of patent -- utility patents, design patents, and plant patents. A patent allows one to prohibit others from making, using, selling, offering for sale or importing into the United States for a period of up to twenty years from the date of filing the application. Most countries of the world have patent systems, although the patent terms and types of patents vary.

In the United States, the term of a utility patent depends on when the patent application was filed. If the patent issued from an application filed prior to June 8, 1995, the term is the later of (1) 17 years from the date of issuance of the patent, or (2) 20 years from the first U.S. filing date for the patent. If the patent issued from an application filed on or after June 8, 1995, then the term is 20 years from the first U.S. filing date for the patent. This complicated rule for the term of a utility patent is the result of the transition from the old term (17 years after issuance) to the uniform term prescribed by GATT (20 years after filing). It applies to all patents still in force on June 8, 1995.

Design patents in the United States have a term of 14 years, while plant patents have a term of 17 years. A common misconception is that the patent gives its owner the right to make, use, import, offer for sale or sell the invention. It only gives the owner the ability to exclude others from making, using, importing, offering for sale or selling the invention. The patent owner may be forbidden from using the invention, usually due to the existence of another patent, or sometimes due to other legal restrictions.

To illustrate this principle, consider the following common case: Person 1 patents an invention. Person 2 later patents an improvement to the invention. In order to make, use, or sell the improved invention, one may need permission from 1 (due to the patent on the original invention), and also permission from 2 (due to the patent on the improvement). For example, suppose person 1's patent has a claim covering apparatus comprising a seat and legs (a chair). Suppose person 2's patent has a claim covering apparatus comprising a seat, legs, and two curved rails (a rocking chair). Someone who would hope to make apparatus comprising a seat, legs, and two curved rails will have to get permission from both person 1 and person 2. Another choice is to wait for person 1's patent to expire; then permission is needed only from person 2. Still another choice is to wait for both patents to expire.

The US Patent Office publishes a good brochure about patents entitled General Information Concerning Patents.

3. What are the different types of United States patents?

The most common type of patent is a utility patent. Utility patents protect function, usually in a device or method. A utility patent may be filed either as a provisional patent application or a standard patent application. The next most common is a design patent, which protects aesthetic appearances. A third, highly uncommon, patent exists. This is a plant patent, which protects asexually reproduced plants such as roses.

4. Why does the law recognize patents?

Patents were designed to reward persons for particular benefits provided to the government and the people with a monopoly. Originally, the "benefits" was loosely defined and the monopoly was not well connected to the benefit provided. In time the "benefit" to be offered became more narrowly defined to require a teaching about something unknown. The monopoly offered as a reward also became more closely related to the benefit. The inventor received a limited monopoly on the subject matter of the teaching (i.e., the invention as described in the claims). The impact of these events still permeate patent law today.

5. What inventions can be patented?

The question "what is patentable" is a complicated one. Here is a simplified answer. In addition, we will discuss some common misconceptions about patentability. In order to be patentable, an invention must pass four tests:

1. The invention must fall into one of the five "statutory classes" of things that are patentable:
 - processes,
 - machines,
 - manufactures (that is, objects made by humans or machines),
 - compositions of matter, and
 - new uses of any of the above.
2. The invention must be "useful". One aspect of the "utility" test is that the invention cannot be a mere theoretical phenomenon.
3. The invention must be "novel", that is, it must be something that no one did before.
4. The invention must be "unobvious" to "a person having ordinary skill in the art to which said subject matter pertains". This requirement is the one on which many patentability disputes hinge.

Typically inventions are aesthetic designs, functional items, functional methods, or asexually reproduced plants.

Other technical requirements must be met for the patent to issue, relating to the disclosure and form of the claims. Meeting the technical requirements is generally within the ability of a skilled patent practitioner.

6. What is the requirement of "new" or "novel"?

New and novel have the same meaning. Specifically, one's invention is new or novel if the invention is not identical to a single invention found in the prior art. Any public disclosures or offers for sale of your invention more than one year prior to your filing for a patent are prior art. This is called the on-sale bar and is perhaps the single most common reason why an invention may not be new or novel.

7. What is the requirement of "useful"?

An invention that is useful is one that functions. This requirement is to avoid issuance of patents on perpetual motion machines. Some inventions are so advancing of science that many people do not currently have the capacity to understand how the invention functions. Scientific testing can be used to prove that this requirement has been met.

8. What is the requirement of "non-obvious"?

Non-obviousness is anything that is outside the ability of one having ordinary skill in the art. This is a subjective test that is difficult to explain and difficult to apply. In essence, one looks to two or more prior existing inventions to find the part of the invention in question. Typically, this can be found in all inventions. To combine the parts of different inventions there must also be a teaching to make the combination. Typically, this teaching is not present in patentable inventions.

There is much misunderstanding over what "unobvious" means in the context of U.S. patent law. The level of unobviousness required to render an invention patentable is a function of the particular art area containing the invention. An experienced patent attorney or agent will often be able to give some indication of the likelihood of a particular invention being held obvious or unobvious. In some cases the unobvious part of an invention (the part that renders the invention patentable) is simply identifying the problem, even if the solution is obvious once the problem has been identified.

9. Are algorithms or computer software patentable?

If one has invented a novel and unobvious algorithm or piece of computer software, and wishes to obtain patent protection, then one's next step should be to consult one or more patent attorneys or patent agents who are experienced in getting patents on inventions having algorithms or software in them. The law (in the U.S.) is settled that the mere presence of software in an invention does not automatically render it unpatentable. It is commonplace for inventors to obtain patents in inventions composed largely or nearly entirely of software.

Many of the well-known cases in the Patent Office Board of Appeals, and many of the well-known cases in the Court of Appeals for the Federal Circuit, in which the patentability of a software-related invention was contested, are instances not of inventions that were unpatentable subject matter, but rather are instances in which the parties got caught up in disputes over the wording and style of the pending claims. Inventors have been getting strong patent protection for software-intensive inventions for decades, essentially by being thoughtful about the wording and claim-drafting style of the patent applications.

Prosecution of software-intensive patent applications tends to take longer than prosecution of some other types of patent applications, for the simple reason that the examining groups handling the former tend to have large backlogs.

The USPTO web site provides the draft Examination Guidelines for Computer-Related Inventions.

10. Why should one file before the first public disclosure or offer for sale?

Filing a patent application before the first public disclosure or offer for sale permits later filing in foreign countries. It also allows one to mark their product patent pending, which can provide a practical protection when introducing a new product into the market. Another advantage is that people often forget to file a patent application in a timely manner if they do not file the application before bringing the product into the market.

10a. When must a patent application be filed before the first public disclosure or offer for sale?

Almost everywhere in the world, except the United States, a patent application must have a priority date before the first public disclosure. Filing a patent application in any country ascribing to the Patent Cooperation Treaty gives the priority date. One invention may have multiple priority dates.

COPYRIGHT (10/111)

1. What is a copyright?

The owner of a registered copyright enjoys the ability of blocking the unauthorized copying or public performance of a work protected by copyright. Depending on how old a work is, whether or not copyright was renewed, when the work was published (if at all), and whether or not it is a work for hire, the U.S. copyright term for a work may be 28 years, 56 years, the life of the author plus 70 years, 95 years from the publication date, or 120 years from the date of creation. The reader will appreciate that these terms are much longer than the 17-year or 20-year term of a U.S. utility patent.

2. What are the meanings of letters in circles?

C in a circle (©) represents copyright protection

R in a circle (®) represents a trademark protected by a federal trademark registration.

P in a circle represents a phonograph or other sound recording protected under pertinent portions of the copyright law.

M in a circle represents a "mask work", protected under the mask work provisions of U.S. copyright law.

Another commonly used symbol within a circle is the U within a circle, which has nothing to do with intellectual property, but which indicates that a product has been found to be kosher by the Union of Orthodox Jewish Congregations of America (also known as the "OU").

K in a circle indicates a product is certified as kosher by the Organized Kashruth Laboratories. (U in a circle and K in a circle symbols are registered trademarks, even though they don't have an R-in-a-circle or TM after them.)

3. How do I copyright my software?

The question whether a work is "copyrighted" might, depending on who is talking, mean either of two things. Someone who says a work "is copyrighted" might be trying to say that a copyright registration on the work has been obtained from the U.S. Copyright Office (gopher server, web server). A different person who says a work "is copyrighted" might mean that the work is protected by the U.S. copyright laws. Lots of people say the former, but it is sloppy usage. The latter is more correct. In the United States, an original work becomes protected by the copyright laws from the moment it is "fixed in a tangible medium". This provides several obvious examples of ways that a work could fail to be protected by the copyright laws: the work might contain no originality, or it might not be fixed in a tangible medium. Yet another example is if a work has gone into the public domain, perhaps because the term of copyright has expired or because the owner has dedicated the work to the public prior to the expiry of the copyright term.

From this it becomes clear that the answers to the question "what must I do to protect my software through copyright" is, roughly, "fix it in a tangible medium". This is a fairly simple step, one which probably occurred no later than when the author stored the software on a hard disk or floppy disk. Generally once it is explained that works are automatically copyrighted from the moment the programmer saves the file to disk, the person asking the question restates the question "How may I register the copyright in my software?" We will now address that question.

It is, of course, possible for authors to obtain copyright registrations pro se, i.e., without representation by intellectual property counsel. The U.S. Copyright Office has a circular on software copyright protection. There is the danger, however, that an improperly drafted copyright registration application could fail to preserve the trade secret rights in a work of software. For this reason, authors of computer software are encouraged to seek advice of competent counsel. There is another reason why the software author who is inclined to proceed pro se in applying for copyright protection might be well advised to seek advice of competent counsel. In our

experience, it is rare that the only steps needed to attend to a client's intellectual property needs are copyright registration steps. It frequently develops that there are other aspects of the client's business that also require attention. A work may contain material prepared by subcontractors, or material recycled from a previous programming task. The software may call for design patent protection, utility patent protection, or trademark protection. The programmer may have failed to give enough attention to the placement and content of copyright notices. Dozens of other intellectual property issues may present themselves. A consultation with competent intellectual property counsel will improve the likelihood that these other aspects are considered. While there are several reasons to consult intellectual property counsel before filing a copyright registration application on software, it is also in our experience that an author who plans to register numerous similar works will find it fruitful to work with intellectual property counsel on the first one or two registration applications, after which it may be possible for that author to proceed filing subsequent registration applications with minimal assistance of counsel. In other words, it should not be taken as a foregone conclusion that the legal costs for the first copyright registration would have to repeat themselves for subsequent copyright registrations.

4. When must I file a copyright application?

Those who are familiar with the rather strict time limits for filing a U.S. patent application may find it to be a pleasant surprise that under the U.S. copyright law, a copyright application can be filed many years after the initial publication of a work, and still be eligible for a copyright registration. This does not, however, mean that you should put off filing your copyright registration. Stated differently, even though there is no particular time limit for filing a copyright registration application, this should not lull the author into a false sense that copyright registration is unnecessary or that it need not be done promptly. The registration of a U.S. copyright offers many benefits to the owner of the copyright. For example, it creates a presumption that ownership of the copyright is as set forth in the registration. In addition, if you happen to have the good luck that you registered the copyright on a date earlier than the date of an act of unauthorized copying, or under certain other circumstances set forth in the copyright law, then if you prevail in court against the unauthorized copier, you may find yourself eligible for statutory damages and for recovery of attorney's fees.

The damages and attorney's fee benefits that come from registering a copyright in advance of infringement are so great, and the cost of registering a copyright is so small, that it is wise to attend to copyright registrations promptly. Many people successfully file copyright registration applications on their own without the assistance of counsel. However, some authors find it convenient to pay someone else to do it for them, simply to avoid the paperwork. Additionally, those whose authorship is in computer software may wish to retaining competent counsel to assist them in filing registration applications, since filing the application incorrectly could conceivably result in loss of trade secret rights, or, in an extreme case, could result in loss of all copyright rights. For example, there are steps which may be taken in filing a copyright registration application in software which preserve trade secrets that are contained in the software. Additionally, since most software is produced in versions, with each version based in part on previous versions, there are certain disclosures which must, under certain circumstances, be made in the registration application to acknowledge the older content. To give one example, the owner of the dBase programming language came very close to losing all copyright rights in the language due to failure to disclose that portions of the work were based on older works.

Registering a copyright

5. Can I register a copyright myself?

Many types of copyright registrations are easy and straightforward to do, in which case a layperson can obtain a copyright registration for little more than the \$20 and a bit of one's time. In the area of computer software, however, it is often helpful to retain experienced counsel to

prepare the copyright application. The reason for this is that for any copyright registration application there is the requirement that the applicant deposit a copy of the work with the Copyright Office (gopher server, web server); the deposit becomes available to the public. In the particular case of software it is possible to deposit less than all of the work, which helps to protect trade secrets. (The Copyright Office has a helpful circular on this subject.) Experience is helpful in determining what, exactly, needs to be deposited with the Copyright Office. Advice of experienced counsel is also helpful in determining whether the application is complete, e.g., whether it needs to disclose previous works upon which the present work is based. Failure to disclose prior works runs the risk that copyright protection will be lost later. Another trap for the unwary is characterizing a work incorrectly as a work-for-hire when it is not; this, too, runs the risk of later loss of copyright rights.

6. What does it cost to register a copyright?

At the time of writing, the filing fee for registering a copyright with the U.S. Copyright Office is \$20. The Copyright Office will do a registration on an expedited basis as well, for example if litigation is imminent. An extra fee must be paid and the application has to be submitted to a different address for expedited registration. The factors described above explain why the lawyer's fees in a software copyright registration application are likely to be at least \$200-\$300, exclusive of copying and courier charges.

6a. What steps are involved in hiring an intellectual property lawyer to register a copyright?

Here are some of the steps that are generally followed when a new client wants to register a copyright. First, determine what, exactly, is needed. Is it really a copyright registration that is needed, or (as sometimes turns out to be the case) a trademark registration or patent application? At the same time, Counsel will do a conflict check to see if accepting the new client would present a conflict with respect to any existing clients. Assuming that it is indeed a copyright registration that is needed, then find out what it is that needs to be registered - software, a videotape, a sculpture - and then determine what needs to be deposited. This might require a photocopy, a photograph, or some other type of copy, depending on the type of work.

It is also a good idea to review the types of information the Copyright Office is going to want to know. How, for example, did the applicant come to own the work? In the case of software, is there a written agreement between the programmer and the applicant? Was the work published? If so, when? Another step is to establish the correct form of copyright notice to be placed on the work. Counsel usually will ask for money in advance, which is held in escrow and applied toward the cost of the professional services.

Notice

7. What constitutes a satisfactory copyright notice?

There are two popular misconceptions which it is important to dispel: One misconception is that under the Berne Convention it does not matter whether a copyright notice is correct or not. It is also important to dispel the misconception that it does not matter, under the Berne Convention, whether a copyright notice has been placed on a work.

This misconception has its origin in the fact that, prior to the 1978 Copyright Act, publication of a work without a proper copyright notice often resulted in a complete loss of copyright rights. The 1978 Copyright Act provided for the salvaging of copyright rights if certain efforts were taken to cure the failure to mark with copyright notices. After the 1978 Act, the United States adhered to the Berne Convention. Under the Berne Convention, the absence of a copyright notice does not necessarily lead to the automatic loss of all copyright rights. It does not, however, follow from this that an author can place an incorrect copyright notice without any

risk of harm flowing from the notice being incorrect. As will be discussed below, certain defects on a copyright notice might still jeopardize the copyright rights of an author.

Having said all this, let us return to the original question, which is what constitutes a proper copyright notice. A proper copyright notice is (1) the C in a circle symbol (©) or the word "copyright" or the abbreviation "Copr.", (2) the copyright date, and (3) the name of the copyright owner. Each of these three elements will be discussed in turn.

The symbol. As is well known to computer programmers, the ASCII character set does not include the © symbol. (It is noted that the extended character set used in the World Wide Web does provide a © in many browsers.) It is not uncommon for programmers to attempt to approximate this symbol by means of a "(C)". Until such time as the courts have interpreted the copyright law in the way that it approves of this approximation, we cannot advise the use of "(C)" as a proper copyright symbol. Thus, where the character set is limited to ASCII, it is suggested that in a copyright notice the word "Copyright" be spelled out in full, or that the abbreviation "Copr." be used instead.

The date. The copyright date is perhaps the most important trap for the unwary. One of the purposes of the copyright date, under U.S. copyright law, is to assist members of the public in identifying works which are so old that the copyrights have expired. To do this, a member of the public would take the copyright date appearing in the notice, add to it the number of years of the copyright term, and thereby arrive at a conclusion as to when the copyright would have expired. In the case of computer software, it is commonplace for the work to include original matter from many different dates including original work dating from any of several different years. Consider what would happen if the most recent year were the only year used in the notice. A member of the public would then be led to the conclusion that the entirety of the work is protected by copyright starting from that year and ending at the end of copyright term. But if part of the work dates from a previous year, then its term expires one year earlier than the rest of the work. This could mislead members of the public in the sense that they would incorrectly think that none of the work could be copied until the end of the term that is based on the date in the notice, when in fact part of the work would have entered the public domain one year earlier than the end of that term. There have been court cases where judges have stricken all of the copyright rights in a work due to such incorrect statements in the copyright notice. Because of this, it is wise to ensure that nothing in the copyright notice would mislead the public regarding the end of the copyright term. If only one year is to appear in a notice, it should be the oldest year, associated with the oldest of the matter in the work. In other words, if one must err it should be in the direction of omitting newer years, not older years. Another approach is to put a range of years. For example, if the oldest matter in the work dates from 1991 and if the newest matter dates from 1994, the notice might say copyright 1991 to 1994 and the name of the owner.

This problem of listing multiple years in a copyright notice is not unique to computer software. Any work that is regularly updated, such as a dictionary or almanac or encyclopedia, will contain items dating from many different years. If you look at such a work you may expect to see at least one copyright notice, and many different years in the notice or notices.

The copyright owner. The third element required in the notice is the name of the copyright owner. The intention is that the members of the general public would, by contacting the entity in the notice, be capable of reaching the actual owner of the rights. Thus, the copyright law is not so strict as to require that the precise legal owner be listed in the notice. If you have some question as to the name that should appear in your copyright notice, we suggest you seek advice of counsel.

Even though copyright notices are not required under the Berne convention, there are numerous benefits that flow from being consistent and thorough in application of copyright notices. Some of these benefits are legal, in that certain rights may be stronger with the notice in place, while other benefits are more practical--if notices are prominently displayed, this may dissuade would-be wrongdoers from making unauthorized copies of the work.

For these reasons, we generally recommend that a detailed review be made of the manner in which a particular client's software is used. We often suggest a copyright notice on the medium by which the software is distributed (e.g., a floppy disk or CD-ROM), a notice that appears when the software is executed, and at least one notice that appears within the executable code in a way that would become visible if someone were to attempt to disassemble or reverse-compile the software. As a separate issue, it is noted that many software works are distributed with user manuals or other documentation, and we often suggest that such materials should also bear appropriate copyright notices.

8. Is there information other than the standard copyright notice that can be included with the notice?

In select situations one may want to include any of the following on a copyright notice:

Copyright 20__ [company or individual] All Rights Reserved.; or
© 20__ [company or individual] All Rights Reserved.; or
Copr 20__ [company or individual] All Rights Reserved.

Examples of additional language follow.

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9. Is there a conflict between trade secrets and copyrights?

Most computer software contains trade secrets. The programmer prepares the software in source code, but the software distributed to customers is generally mere executable code. The internal format and structure of the executable code is relatively uninterpretable by humans, which to some extent protects trade secrets contained in the source code.

Prior to the 1978 Copyright Act, the filing of a federal copyright registration application carried with it the sense that the work to be registered must have been "published". Under that Copyright Act works were divided into unpublished and published works, and only the latter were protectable by federal copyright law. Thus, the mere act of asserting federal copyright protection arguably represented an admission that the work had been published. What's more, the applicant was required to deposit a copy of the protected work with the Copyright Office (gopher server, web server). These two factors prompted some anxiety among programmers that seeking copyright protection might count as a tacit admission that there were no trade secrets in the software. The impression was that a programmer could not have it both ways -- that a work protected by copyright did not, by definition, contain trade secrets.

Regardless of the possible ambiguity that existed prior to 1978 for those who wanted to have both trade secret and copyright protection in software, programmers will be relieved to know that the potential ambiguity is no longer present. Under the 1978 Act and under the associated copyright rules that have been promulgated by the Copyright Office, it is possible for the author of computer software simultaneously to assert trade secrets in the source code, and to assert copyright rights in the source code (and in executable code).

10. What is a mask work?

A mask work is a creative work protected under the Semiconductor Chip Protection Act. Although nowadays few chip makers worry about it, there was a time several years ago when semiconductor chip makers were concerned that a competitor would knock off a semiconductor chip by purchasing one of the chips, removing the semiconductor layers one by one, photographing the layers, and using the photographs to generate replicas of the chip. The Semiconductor Chip Protection Act was intended to allow chipmakers to register the masks, which would then provide certain remedies against copiers. The protection is thus a copyright-like protection.

It turns out that there have been virtually no lawsuits brought under the Semiconductor Chip Protection Act, and a very few mask work registrations have been filed. We believe this is because people who are attempted to knock off someone else's integrated circuit nowadays typically have easier ways to do it than by photographing layers and making photographs of the layers. Thus, the Semiconductor Chip Protection Act protects against a type of infringement that is no longer a day-to-day economic threat.

The U.S. Copyright Office has a circular about mask work protection.

WEB LAW (10/15)

1. When am I violating copyright on the Internet?

The Internet, inarguably one of the most remarkable developments in international communication and information access, is fast becoming a lair of copyright abuse. The notion of freedom of information and the ease of posting, copying and distributing messages on the Internet may have created a false impression that text and graphic materials on World Wide Web sites, postings in "usenet" news groups, and messages distributed through e-mail lists and other electronic channels are exempt from copyright statutes.

In the United States, copyright is a protection provided under title 17 of the U.S. Code, articulated in the 1976 Copyright Act. Copyright of a creative work extends 50 years beyond the

lifespan of its author or designer. Works afforded copyright protection include literature, journalistic reports, musical compositions, theatrical scripts, choreography, artistic matter, architectural designs, motion pictures, computer software, multimedia digital creations, and audio and video recordings. Copyright protection encompasses Web page textual content, graphics, design elements, as well as postings on discussion groups. Canada's Intellectual and Industrial Property Law, Great Britain's Copyright, Designs and Patents Act of 1988, and legislation in other countries signatory to the international Berne Convention copyright principles provide similar protections.

Generally speaking, facts may not be copyrighted; but content related to presentation, organization and conclusions derived from facts certainly can be. Never assume that anything is in the "public domain" without a statement to that effect. Here are some copyright issues important to companies, organizations and individuals. - LINKS: Even though links are addresses and are not subject to copyright regulations, problems can arise in their presentation. If your Web site is composed using frames, and linked sites appear as a window within your frame set, you may be creating the deceptive impression that the content of the linked site is yours. Use HTML coding to ensure that linked external sites appear in their own window, clearly distinct from your site. Incidentally, you may wish to disavow responsibility for the content of sites to which you provide links.

Work for hire: While copyright ordinarily belongs to the author, copyright ownership of works for hire belong to the employer. The U.S. Copyright Act of 1976 provides two definitions of a work for hire: 1. a work prepared by an employee within the scope of his or her employment; or 2. a work specially ordered or commissioned for use as a contribution to a collective work, as a part of a motion picture or other audiovisual work, as a translation, as a supplementary work, as a compilation, as an instructional text, as a test, as answer material for a test, or as an atlas, if the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire. U.S. Copyright Office documentation further states, "Copyright in each separate contribution to a periodical or other collective work is distinct from copyright in the collective work as a whole and vests initially with the author of the contribution."

Employee activities: Just as making bootleg tapes of recorded music and photocopying books are illegal activities, printing and distributing contents of Web pages or discussion group postings may constitute copyright infringement. And companies may be liable for such activities conducted by their employees using company computing or photocopying equipment. However, the law does not necessarily prohibit downloading files or excerpting and quoting materials. The doctrine of fair use preserves your right to reproduce works or portions of works for certain purposes, notably education, analysis and criticism, parody, research and journalistic reporting. The amount of the work excerpted and the implications of your use on the marketability or value of the works are considerations in determining fair use. Works that are not fixed in a tangible form, such as extemporaneous speeches, do not qualify for copyright protection. Titles of works, and improvisational musical or choreographic compositions that have not been annotated, likewise cannot be copyrighted. Names of musical groups, slogans and short phrases may gain protection as trademarks when registered through the U.S. Patent & Trademark Office.

Protecting your own works. Although copyright automatically applies to any creative work you produce, you can strengthen your legal copyright protection by registering works with the U.S. Copyright Office. Doing so establishes an official record of your copyright, and must be done before filing an infringement civil lawsuit in Federal district court. Registration costs \$20. For information, visit the Copyright Office Web site at <[http:// www.loc.gov/copyright](http://www.loc.gov/copyright)> or call (202) 707-3000; TTY is (202) 707 6737. If you appoint an independent Web developer to create and maintain your Web site, make sure through written agreement that you retain the copyright to your Web content. Place a copyright notice on each of your Web pages and other published materials. Spell out the word "Copyright" or use the encircled "c" symbol, along with the year of publication and your name, as shown in this example: Copyright 1998 EditPros marketing

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How to stay legal. If you'd like to share the contents of an interesting Web page with your company employees, describe the page and tell them the URL address of the Web site so they can look for themselves. And if the latest edition of a business newspaper contains an article you'd like to distribute to your 12 board members, either ask the publication for permission to make copies, or buy a dozen copies of the newspaper. Retention of value through sales of that newspaper, after all, is what copyright law is intended to protect.

2. May I freely copy, print, and email things I find on the Web?

The Internet is the sort of place where it is extraordinarily easy to copy things, although it must not be forgotten that ease of copying did not start with the Internet. The cassette recorder made it easy to copy record albums. The photocopier made it easy to copy printed works. The videocassette recorder made it easy to copy movies. Floppy disks made it easy to copy computer software. In any of these media, the fact that something is physically easy to copy something does not mean that it is legal to copy it, or morally acceptable to copy it.

Absence of a copyright notice does not mean it is okay to copy something. Under U.S. copyright law, for example, any original work fixed in a tangible medium is automatically protected by copyright regardless of whether any copyright formalities are done. Under the Berne Convention the absence of a copyright notice does not mean that a work is not protected by copyright.

Clearly one way to solve the problem is the simple step of obtaining the permission of the copyright owner. Yet another way is to confine one's copying to items that are in the public domain, for example because they were created hundreds of years ago.

Obtaining permission is a more difficult task than one might think. Suppose you see a web site that contains something you wish to copy, and suppose you obtain permission from the webmaster of that site to copy it. Does this mean you may post it on your web site without fear of liability? The answer is no, unless it happens that the webmaster is in fact the owner of all rights in the work you wish to copy. Can you be sure the work was not copied (in an unauthorized manner) from someplace else?

If not, then permission from the webmaster does not put you in the clear. The legal system does, however, permit some kinds of copying if it is done without the permission of the copyright owner. Under U.S. law, for example, even if the copyright owner has not given permission, it is still okay to copy something so long as the copying falls within what is called "fair use". Regrettably for those who are eager to copy things, it is not easy to say for sure what is or is not fair use. Legal factors that are taken into account include: the portion of a work being copied (copying a small portion is more likely to be fair use than copying a large portion); the effect of the copying on the market for the item being copied (if the copying activity makes people less likely to buy the item, then the copying is unlikely to be fair use); and the use to which the copied matter is put (quoting for use in literary criticism or for educational purposes is more likely to be fair use than some other uses).

If you see something on the Web and are tempted to copy it, why not just put in a link to it?

For example, Internic has a policy according to which domain names are registered, and the policies are posted on Internic's web site. If I am tempted to copy the policy into my web site, why not just put in a link to the place where the policy may be found?

It is clear that the law will evolve in this area. Perhaps after some years of experience

with the Web, courts will decide some cases that will provide guidance as to what is fair use and what is not. No discussion of copyright and the Web would be complete without at least a mention of the notion of "implied license". For example, when I use my web browser to view a site, I am necessarily copying information from that site to the screen of my computer. Many web browsers have "cache" capabilities, in which case I am also necessarily copying the information into the cache as well. Most browsers have the capability to print what is on the screen, so if I print it I am automatically making a copy of it on paper.

As years go on the courts will develop the notion of implied license in connection with the Web, but it is clear that there is some sort of implied license that is automatically granted by anyone who sets up a web site and makes it open to the public. The implied license surely includes those things we think of as "normal" web activity -- viewing web pages, clicking on links, seeing the web text on the computer screen. What must not be forgotten, though, is that such an implied license is by no means a grant that permits members of the public to do whatever they may please with the material found on a web site. To draw analogies, the person who publishes a book is not granting to the public the right (via implied license) to photocopy the entirety of the book and to sell the copies. The musician who releases a compact disk is not granting an implied license to set up a facility for copying the CD's and selling the copies.

Common sense suggests that if a webmaster has placed a Copyright notice so that visitors to a web site see it, then the webmaster probably is trying to communicate to the public that the contents of the site are not to be freely copied in all ways. Of course, as mentioned above, the absence of a copyright notice does not mean a site is not protected by copyright. As will be appreciated from the above discussion it is impossible, of course, to answer the "may I copy this?" question in general. If you care about copying some particular item you should consult competent counsel for advice.

May I scan any image I wish and post it on my Web site? The short answer is "no" While it is physically and technically easy to scan images out of books and magazines, and to place computer-readable (GIF and JPG) copies in one's web site, the fact that it is physically and technically easy does not make it legal or moral. See the discussion above regarding copying works of others into one's web site.

The safest course of action is to obtain permission from the copyright owner before posting a scanned image into your web site. Suppose you take a photograph yourself -- can you freely scan it and put it on your web site? Even this sort of photograph can cause trouble. If it is a photograph of someone else, it is safest if you obtain a "model release" from that person releasing you from liability for use of the photograph. From the above discussion it should be clear that if you really care about this you should seek advice of competent counsel.

3. May I use images from the Web sites of others?

Before the Web came along, the only way a publisher could make use of images from others was by physically copying the images into the work being published. The above discussions regarding the copying of text or images address such copying. But the Web allows a new and quite interesting way of using the images of others, namely the "IMG" hypertext reference. It is physically and technically easy to include an IMG reference in your web site, giving a URL (address) located on somebody else's web site.

The use of an IMG reference to somebody else's web site is intriguing. Suppose your web site is on a machine in which you are charged "per megabyte" for its use by visitors. Then when a visitor to your web site views one of your pages, and if the image on your page is an IMG reference pointing to somebody else's web site, the visitor's browser will obtain the image from that web site. It won't run up your bill.

Or suppose your web site is on a machine that has only a slow (narrow bandwidth) link to the Internet. Then if a visitor to your web site views a page of yours that contains an IMG

reference to some other web site, the visitor's retrieval of the image won't slow down your link. It will slow down the link of that other web site instead.

There are practical reasons why you might not wish to use IMG links to images on the web sites of others. The image might be changed without your knowing it, leading to an unpredictable result for visitors to your web site. The image might be deleted from its web site, leaving a gaping hole in your web page.

But in addition to practical reasons why you might not wish to use IMG links to the web sites of others, there are legal reasons, and that is the purpose of this discussion. Consider one case that really happened. A fellow noticed that two of his favorite cartoon comic strips were posted daily on a web site hosted by the distributor of the strips. He looked closely at the distributor's web page and determined the IMG URL addresses containing the actual strips. He then made up his own web page saying something like "here are my two favorite comic strips" in a header, followed by the two IMG references. A visitor to his web page would see the header and the two strips.

The next thing that happened was, of course, that lawyers got into the picture. This fellow got a letter saying that he was violating the distributor's copyrights by his placement of the comic strips onto his page. He posted an article in a usenet group asking for comments about the letter.

One commenter said that the distributor's conduct in making its strips available as image files on the Internet amounted to placing them in the public domain, so that anybody who wished could do anything they please with the images. Common sense suggests that this cannot be so; the publisher of a book, in a world in which there are photocopiers, is not giving permission to the world to make copies of the book.

One commenter pointed out that it is technologically possible to reduce unauthorized IMG references, for example by programming the server so that it will provide the requested image file only if the previously accessed page was the distributor's page that might normally contain the image.

Such an approach has several drawbacks, chief among them that it only works if the browsing client being used by the visitor happens to provide what is called a "referrer" header; not all do this. Another drawback of this approach is that it makes every image request take longer. The way this particular story ended was that the fellow chose to delete the IMG references entirely, and to use instead more commonplace HREF references so that a visitor to his site could click on the HREF references and reach the distributor's web pages. As a result, we will never know what would have happened if the case had been decided in court.

Clearly the safest course is to avoid the use of IMG references except in the special case where permission has been obtained from the owner of the site having the image file.

4. May I freely link to the Web sites of others?

This is a question that has led to heated discussion in various Internet discussion groups in recent months. As will become clear, however, most of the disputes turn out to be semantic; once the definitions of certain terms are agreed upon most of the disputes disappear. The question seems easy enough to state: is there any legal or ethical impediment to setting up a link to someone else's web site?

A first difficulty comes if one succumbs to the temptation to rephrase the question as "is a URL copyrightable?" The person who phrases the question this way triumphantly states that the answer is "no" and thus that anyone who wishes may place any URL into any web site without having to answer to anyone else. A URL is rather like a telephone number or a street address. Arguably it is no more protectable by copyright than a telephone number, due to its primarily functional quality. So indeed the answer to the question "is a URL copyrightable?" is "no". But the world is filled with legal constraints on behavior in addition to those that come from the copyright laws. If you post a sign saying "call this telephone number to reach a chronic liar", then

unless the person at that telephone number is indeed a chronic liar, you will be subject to legal liability for libel. And it will be no defense at all that the telephone number was uncopyrightable.

Having discerned that the question "is a URL copyrightable?" is irrelevant, how can we arrive at an answer to the original question? An important step is to figure out what kind of link we are talking about. The previous section discusses a somewhat esoteric kind of link, the so-called IMG link. For the reasons discussed in that section, it seems prudent never to make an IMG link to someone's web site without getting permission first.

But the fact is that if you were to study several hundreds web sites, you would find that the links from one web site to another are virtually all so-called HREF links, and that virtually none of them are IMG links. An HREF link is the kind we are all accustomed to. It is a region on the screen which, when selected by the visitor, causes the present screen to be erased and causes an entirely new screen to be loaded. The words "previous section" in the previous paragraph are an HREF link -- they cause the screen to be loaded anew with the text of the previous section.

So now for clarity let us redefine the question as "may I freely set up HREF links in my web site, to the web sites of others?" As will be clear in a moment, the short answer to that question is "yes". (Except in the case of framing, discussed below.)

The general rule proposed and set forth here, that one may freely set up non-framed HREF links to the web sites of others, is a rather reassuring rule since it happens to comport well with common practice and with common sense. The designers of the World Wide Web intended that it would be precisely that -- a web. One of the hopes and goals of the designers was that after the passage of some years, a meaningful fraction of the sum total of human knowledge would be on the Web, and that it would be fully cross-linked. The idea was that while you might not find the answer to your question on the first web page you encountered, after a few rodent movements you would find the answer, as one web page led you to another, and another, eventually finding your answer.

Such a result -- a web of knowledge -- is only possible if people feel free to set up any and all HREF links that might come to mind. A person who steadfastly objects to any and all HREF links to his or her web site is missing the point of the World Wide Web. Having said this, it is important to acknowledge that the proposed rule cannot be taken as a justification for setting up all imaginable links. A few fact patterns will illustrate.

A couple of months after our firm opened this web site to the public, we happened upon a web site in Massachusetts that had a link to the place in our web site where the most recent article of our firm newsletter appeared. The Massachusetts web site explained that its purpose was to provide web capability to those who could not afford it. As an example, the site invited readers to look at our newsletter. The clear message was that our law firm could not afford its own web site, and that this Massachusetts site was kindly providing a way for our firm newsletter to be seen by the public. We asked the site operator to delete any mention of anything in our web site, and he complied. Suppose someone was to set up a link to our web site, saying, "Click here to reach a web site of chronic liars". Assuming that our firm is not a bunch of chronic liars, then the link libels our firm. A court would not hesitate to order the party setting up the link to delete it. Suppose someone were to set up a link to our web site, saying "See how prolific we are? We wrote all this!" The result would be someone taking credit for the work of others; stating it differently, they would be passing off our work as theirs. In the US, this would probably give rise to liability under the Lanham Act.

Framing. More recently a change in the capabilities of commonly used browsers has given rise to a way in which HREF links can lead to disputes. The new capability is that of "frames". A web author can cause a page to be divided into "frames", each of which can receive an HTML-constructed window of information. On most web sites that use "frames", the web designer provides all the content in each of the frames. Typically a small frame to the left is used as a menu, and a large frame in the center and right of the screen contains the main body of text, all of which originates from the same web site.

The controversial sites using "frames" are the sites that place advertising or editorial content in small frames around the edge of the screen, and that set up the main frame, in the middle of the screen, to contain HTML text from some other web site. In one site that recently drew controversy, the main screen contained content from MSN and from other news sources, while a frame across the bottom contained a banner advertisement.

This sort of frame-linking can lead and has led to disputes. The content provider whose content is in a middle frame might find itself juxtaposed with advertisements for products or services which it opposes. A conservative content provider might find itself juxtaposed with a liberal advertisement, or vice versa. There is also the danger that a web visitor might be misled as to the origin of the content in the middle frame, thus possibly giving rise to a claim under the Lanham Act (part of the US federal trademark law). It might appear that the web operator is passing off someone else's content as their own. And in any event the web operator could be deriving advertising revenue from the effort of others.

This article suggests that one should do "frame" links to the web sites of others only after obtaining permission to do so.

But again let us try to keep reality in view. The vast majority of HREF links on the Web are not libelous and do not pass off one's work as another's. Most HREF links are quite clear to the visitor, who has no difficulty perceiving that by clicking on a colored line of text, she is going to a different web site. Such a user is also aware that by clicking the "back" button she can return whence she came. Most of these links give rise to no legal liability at all. Even if there is no legal requirement that the person setting up an HREF link (at least, a non-libelous, non-misleading, non-framed link) obtain permission from the owner of the site linked to, is there at least a moral requirement? Isn't it somehow "good form" to contact a webmaster to say that an HREF link is proposed or has been set up? To this the answer we offer is this: If you are quite confident that you are not doing anything wrong in setting up a non-framed HREF link, then you probably are not doing anything wrong. Millions of HREF links have been set up in the World Wide Web, and the sky has not fallen and common sense has prevailed. Nonetheless, if you have any misgiving or doubt about a particular link, then the ethical thing to do is to write to the webmaster and ask if there is any objection. This will give the webmaster an opportunity to view the page containing the link, and to consider whether there is any reason to object to it. A couple of additional examples may help to illustrate the common-sense aspects of this proposed rule.

Suppose that someone has set up a web site, and has not publicized it in any way. Suppose further that there is no choice but to make the site public, so as to permit testing of the site by means of visits from other countries. Then the person who stumbles on the URL for this site should, as a courtesy, ask if there is any reason not to link to the site. Setting up a link to the site might interfere with the testing, for example. One Internet discussion group about a year ago contained a posting from a fellow who operated a web site for a nonprofit organization relating to some particular educational needs. On his site, he had laboriously compiled federal laws relating to the subject of the web site; the laws were contained in a series of sub-pages. What prompted his posting was that another site (operated, if I recall correctly, by a competing non-profit organization) had set up HREF links to the sub-pages in such a way that this fellow's effort would go unrecognized. The inattentive visitor might not even notice having passed from one web site to the next.

This fellow wondered what his options were? Could he compel them to drop their links to his sub-pages?

It wasn't exactly traditional passing off. The site never exactly said they had compiled these laws, for example, but merely had a link to the laws as provided on these sub-pages. Quite a few participants in this Internet discussion group had no difficulty figuring out the right answer. This fellow should simply plaster the name of his non-profit organization all over the sub-pages. And at the end of each of his sub-pages, he should put in a link to his own main page. The result is that now the competing organization is directing its visitors to his own web site. Linking to

something other than a home page. There are some webmasters who say that they don't want people linking to anything but their home page. Webmasters who say this might be motivated by any of several concerns:

1. The webmaster might want to be able to change around the internal structure of the web site at will, thus perhaps denying responsibility for the trouble that is caused to others when the change causes links to break.
2. The webmaster may feel strongly that a visitor to a sub-page ought to be forced to read the contents of the home page first.
3. The view suggested here is that a webmaster should be prepared for the possibility that members of the public may set up bookmarks to subpages, and that other HTML authors may set up links to subpages. Since this sort of bookmarking and linking can and will happen, the webmaster should be courteous to those visitors and HTML authors. The webmaster, upon moving a page, should have the courtesy to supply a "forwarding" page that lets the visitor know the new page URL. The webmaster should lay out each page with the expectation that bookmarks and links will be made to any and all possible locations within each page and sub-page. (On the Oppedahl & Larson site a copyright notice and disclaimer is provided on each page and sub-page for this reason, and each page and sub-page has a link that returns to the top of the page or to the home page, again for this reason.)

In general, of course, it is desirable for one's site to be the subject of links from other sites. Most people who create web sites hope that lots of people will visit, and links from other sites promote this goal.

5. Someone has set up a link to my Web site without my permission -- what can I do?

The first question would be, why do you care? Does the link cast you or your site or your organization in a bad light? Does it lead to a situation where someone else is taking credit for your work? For these or other reasons, as discussed in the previous section, you may have a legitimate gripe. Before you spend money on lawyers, though, it is suggested that you try resolving the problem by direct communication. Send an email or a paper letter explaining what you want done. Then if you must, consider retaining counsel, preferably counsel who are familiar with the Internet as well as with intellectual property.

If the link is an IMG (image) reference, consider changing the URL of your image, and put some nuisance image in the place of the original URL for the image. That should discourage people from using your image without your permission.

But generally unless there is some special reason to the contrary, you should be pleased if someone sets up a regular (non-framed HREF) link to your web site.

6. How may I keep people from taking things from my Web site?

There are a number of steps which the operator of a web site may take to attempt to minimize the extent to which others take things from it. The simplest is not to post on the web site. Another is to use the access controls built into the web server to limit the range of IP addresses that are permitted to enter the site. Still another is to set up password protection, so that only certain persons are permitted access to your site.

As will be appreciated, however, such suggestions would be of no help to most web site operators. Most web site operators want their web sites to be available and open to the world at large. Thus we can recommend some other steps that may dissuade others from taking things from you. These steps include: filing copyright registrations, placing copyright notices and related notices on your web site, obtaining trademark registrations, placing trademark notices on your web site, and seeking patent protection for whatever there may be in your web site that is patentable.

7. How do I obtain a domain name?

In general terms, you obtain a domain name by making application to a domain name registration authority. For example, to obtain a domain name that ends in .com or .org or .edu, you make application to Internic, whose designated representative is Network Solutions, Inc. Internic by no means handles all domain names, however; domain names that end with two-letter country codes are administered by other authorities.

Prior to making application to the registration authority, you must find someone who operates a domain name server (DNS), who will agree to provide domain name service for your domain name.

In addition, assuming you plan to use your domain name for email, you need to find someone who operates a mail exchanger (MX), who will agree to provide email service for your domain name.

Finally, assuming you plan to use your domain name for a web site, you need to find someone who offers an HTTP server, who will agree to provide equipment hosting your web site. Often it is convenient to purchase all three services from the same Internet service provider, but nothing about how the Internet works requires that you do so. At Oppedahl & Larson, for example, we use Panix for all three services.

Having obtained at least your DNS service and having tested it (see a description of this process in an article in the New York Law Journal) then you may submit an application to the registration authority. Once the domain name is granted to you, then you should make careful note of the due dates (if any) for payment of maintenance fees (see a discussion of this in another article in the New York Law Journal).

8. How do I protect myself from loss of my domain name?

The protective steps to take to keep from losing your domain name differ depending on which organization administers your domain name. If your domain name ends, for example, in .com or .org or .edu, then what matters to you are the policies of Internic, whose designated representative is Network Solutions, Inc. NSI has published various policies with which you must be familiar, and which are discussed in articles by Carl Oppedahl that have been published in the New York Law Journal. Another article that is a must-read was published in Network World. Among other things, it is wise to obtain a trademark registration for the domain name immediately if one has not already done so. You should check to be sure that your registration authority has correctly listed who owns your domain name (on rare occasions an unscrupulous internet service provider will list itself as the owner). You should also check the record to be sure it lists up-to-date postal, email, and telephone contact information for you. Finally, if your registration authority (e.g. Internic) charges maintenance fees, then you should make note of when your maintenance fees are due, and make inquiries if for some reason you do not receive reminders from your registration authority.

9. What is the correct format for a URL on a business card?

There seems to be three common styles for giving URLs:

1. `http://www.patents.com/`
2. URL: `http://www.patents.com/` (note the space before the `http://`)
3. `<URL: http://www.patents.com/ >` (note space before `http://` and after the trailing `"/`)

The last is kind of ugly and probably best left for email and other computer-readable forms of communication. Clearly, anybody who knows what "http:" means should have no trouble making sense of any of the three forms. The most important thing is to be sure that the printer doesn't insert spurious spaces, or make periods into commas, or the colon into a semicolon, or misprint / as a \.

Most people leave off the ending /, but it is good to provide it. Most widely-used web browsers are programmed to supply it (along with the "http://" if necessary) if omitted by the

user. (Those who are printing business cards can be sloppy about leaving off the http:// or the / but those who are writing html text must be very careful about such things.)

If you want to label things on your business card (like "phone:" and "fax:" and "email:") then use "URL:" for the URL.

Note that an email address becomes a URL in this way: mailto:webmaster@patents.com.

10. What is the correct format for a URL when provided in computer-readable form, for example in an email or news posting?

The goal is to provide text which someone else's mail or news reader can easily parse into URLs to make it easy to click on the URL as a browser link. For this, the third form above is appropriate. Note the space before the closing ">" which is required. If you employ the first or second forms, keep in mind that the URL must have a space before it and a space after it. (A common blunder is to place the URL at the end of the sentence, contiguous with a period, thus tricking the reader's browser into including the period as part of the URL, which then guarantees that the browser will not reach the desired page.)

MARKS (10/72)

1. What is protectable under trademark law?

A trademark is anything that indicates source, sponsorship, affiliation, or other relation of a product or service to a business. The specific identity of the business does not need to be known.

2. How long does a trademark or service mark last?

Trademark protection lasts as long as the trade dress or trademark indicates source. This generally means that the protection lasts as long as the trademark or trade dress is being used with some exceptions. Registrations require renewal.

3. What type of competition does trademark law prohibit?

Trademark law prevents consumer confusion as to the source of products or services. (i.e., good will). There is a second minor trend that trademarks are like property and diminishment of value is basis for an infringement action.

4. What is the geographic scope of protection of a trademark?

Common law trademarks, i.e., unregistered, exist in the area in which the mark is being used or is known. State registrations exist throughout the state. Federal registrations exist throughout the country. First in time is first in right. Thus, two or more users may all have the same rights in different locations if the first user did not promptly obtain a federal registration.

5. How important is federal trademark registration?

Federal registration is a must to avoid future expansion problems due to geographic scope issues.

6. What is a trademark?

A trademark is anything that indicates source, sponsorship, affiliation or other business relationship of the goods or services. Start with the notion that an indicator must be perceived through one of the five senses. This includes taste, touch, smell, sight and sound. Some senses lend themselves to interaction with trademarks better than others, but all are capable of doing so. Currently, the following have been registered as trademarks:

Sight - Single words, word strings, slogans, logos, letters (e.g. initials), numbers, drawings/pictures, devices, product configurations, single colors, and multiple colors

Sound - Chimes, many of the items listed under sight are also spoken

Smell - Fragrance

Taste - None known to the authors of this material

Touch - Product configurations

The types of indicators that can function and be protected as trademarks are very much in development. The true test is whether "it" is capable of indicating a single source, sponsorship, affiliation or other business relationship, regardless of whether or not the exact entity(ies) is(are) known.

7. What is the difference between a trademark and a service mark?

Trademarks and service marks are distinct in whether the mark is used with goods or services. The manner of fixing the mark is of significance in seeking a federal registration. There is some difference on how the mark is associated with the goods or services. Goods commonly have labels, where services have no place to put a label. For nearly all other practical purposes trademarks and service marks are treated the same.

8. What are common law, state registered, and federally registered trademarks?

A common law trademark is a trademark that has not been registered with the state or the federal government. Common law rights arise upon use or recognition. Such trademarks are at a distinct disadvantage. See question: "What is the geographic scope of protection of a trademark?"

A state registered trademark is a trademark that has been registered at the state level.

A federally registered trademark has been registered with the federal government. To obtain a federal registration the applicant must use or intend to use the trademark in interstate commerce.

9. Why should I federally register my trademark?

A business can have its expansion efforts limited if it fails to obtain a federal registration. See Question "What is the geographic scope of protection of a trademark?" on the [About TM's](#) page. A federal registration provides prima facie (i.e. rebuttable) evidence of exclusive rights in the mark. After five years of registration the rights become incontestable (i.e. non-rebuttable), eliminating nearly every defense to trademark infringement. This aspect can save tens of thousands of dollars if litigation is ever needed and may help the avoidance of litigation all together.

Infringing goods and services may be impounded by the U.S. Customs with a federal registration. A federal registration provides constructive notice of the holder's trademark rights, allows one to proceed in federal court (if necessary), and provides for special statutory remedies.

These benefits are obtained for the nominal cost of obtaining and maintaining federal trademark registrations.

10. How do trademark rights protect the owner?

Trademark infringement occurs when another uses a confusingly similar trademark. An infringer is trying to reap benefits from or shed responsibility for their actions on the trademark holder. Thus, the trademark laws protect the owner from diversion of sales or market-place responsibility as a result of a competitor's bad acts.

TRADE SECRETS (10/39)

1. What are trade secrets?

"Trade secrets" is the legal term for confidential business information. A good nonlegal definition of a "trade secret" is a secret belonging to a business. This information allows your company to compete effectively. Examples of trade secrets include customer identities and

preferences, vendors, product pricing, marketing strategies, company finances, manufacturing processes and other competitively valuable information.

Under the Uniform Trade Secret Act, information must meet three criteria to qualify as a trade secret. First, the information must not be "generally known or readily ascertainable" through proper means. Second, the information must have "independent economic value due to its secrecy." And third, the trade secret holder must use "reasonable measures under the circumstances to protect" the secrecy of the information. These requirements are explored throughout these frequently asked questions.

2. Why protect trade secrets?

Failure to adequately protect your company's proprietary information will allow your competitors and ex employees to reduce your profits. The trade secret laws will help prevent such misfortune if your company acts in accordance with its requirements.

Imagine if your top employee left your company. The employee had learned every major area of your company. S/he was an invaluable asset to the company. Now imagine if that employee set up his/her own business in direct competition with you or became an employee of your toughest competitor. You can stop this individual if your company protected its business information properly under the trade secret laws. Proper protection requires action today to be ready for tomorrow.

3. What technology is protectable by trade secrets?

Under the Uniform Trade Secret Act information must not be generally known, not readily ascertainable, have independent economic value due to secrecy, and be the subject of reasonable efforts to protect secrecy. This includes essentially any confidential business information such as customer lists, financial information, employee data, production cost or sales data, and documents memorializing important negotiations.

4. How long is a trade secret protectable?

Information is protectable as long as the information fits the definition of trade secrets. This can be moments or decades.

5. What specific type of protection is offered by a trade secret?

Trade secret law prevents wrongful taking of confidential or secret information. Independent development and reverse engineering by another party are defenses to claims of trade secret theft.

6. What is the geographic scope of protection of a trade secret?

Trade secret protection is a state right. A vast majority of states, including Minnesota, have adopted the Uniform Trade Secret Act. Other states have a law or laws similar to the Uniform Act. Foreign countries have similar laws, although, the particular country should be checked before reliance is placed on trade secrets in a foreign country. The rights will seem to be national or international in scope, since registration of trade secrets is not required and since most states and foreign countries protect trade secrets.

7. How important is trade secret protection?

Trade secret protection is a must for virtually any business. It's most often not addressed until an employee or competitor obtains and uses against you valuable secret information, thereby stealing your sales, customers, technology base, damaging financial information, or other.

8. What is misappropriation of trade secrets?

Trade secret law prevents misappropriation, wrongful taking, of trade secret information. A wrongful taking can occur in a variety of manners. For example, the taking of information would be wrongful when the taking is a: breach of contract, breach of fiduciary obligation, theft, or other legal wrong.

9. What remedies are available when trade secrets are misappropriated?

Control of the information can be recovered along with payment of damages. Attorney fees and/or exemplary (e.g., punitive) damages can be recovered in an exceptional case. Criminal penalties are available in cases of theft.

10. What is the Uniform Trade Secret Act?

Trade secret laws are state granted rights. Minnesota, along with most other states, has adopted the Uniform Trade Secret Act. The Uniform Trade Secret Act attempts to make the trade secret laws the same from state-to-state. These frequently asked questions follow the Uniform Trade Secret Act.