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# TOP TEN COMMON IP MISTAKES YOU CAN AVOID

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1

## Contents

We'll discuss issues related to:

1. Timely filing for patent applications and patent searching
2. Using the internet for copyrighted content and drafting agreements
3. NDAs and employee/contractor agreements
4. Trademark prosecution and functionality including domains

Bonus:

IP Territoriality

Distinctiveness in a culture of copying

Cost of cutting corners

2

2

## Fail to timely file a patent application on your invention

- What do the sharks often ask?
  - Do you have a patent?

- New products, new services, new features, new GUIs, etc.

- 35 U.S.C. §102(a):

### **(a) Novelty: Prior Art.** – A person shall be entitled to a patent unless--

- (1) The claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention; or
- (2) The claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.

3

3

## Fail to timely file a patent application on your invention (cont'd)

### **(b) Exceptions.—**

- (1) **Disclosures made 1 year or less before the effective filing date of the claimed invention.**—A disclosure made 1 year or less before the effective filing date of a claimed invention shall not be prior art to the claimed invention under subsection (a)(1) if—
  - **(A)** the disclosure was made by the inventor or joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or
  - **(B)** the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

4

4

# Timing Example

Method and Means for Creating Anti-Gravity Illusion  
 US Pat. No. 5,255,452 to Jackson et al.



United States Patent [15] Patent Number: 5,255,452  
 Jackson et al. [45] Date of Patent: Oct. 26, 1993

US5255452A

[54] METHOD AND MEANS FOR CREATING ANTI-GRAVITY ILLUSION

[75] Inventors: Michael J. Jackson, Los Angeles; Michael L. Bush, Dennis Tompkins, both of Hollywood, Calif.

[73] Assignee: Triumph International, Inc., Los Angeles, Calif.

[21] Appl. No.: 905,479

[22] Filed: Jan. 29, 1992

[51] Int. Cl. A43B 5/00; A43B 3/00

[52] U.S. Cl. 36/132; 36/136; 36/30; 36/132

[53] Field of Search 36/1, 80, 103, 113, 36/114, 131, 132, 136, 402/70, 71, 105

[56] References Cited

U.S. PATENT DOCUMENTS

1,050,244 4/1913 Dennis 36/114  
 2,114,780 4/1918 Vesalio 36/132  
 2,473,099 6/1949 Hatch 36/1

3,885,399 6/1975 Euerich 36/1  
 4,045,217 9/1986 Garcia 36/114  
 4,318,440 9/1980 Trumble 36/111  
 4,645,666 9/1989 Ellis 36/132  
 4,782,019 8/1988 Boyl 36/111  
 4,882,818 10/1989 Spagnoli 36/111  
 5,042,173 8/1991 Blaszczak et al. 36/113

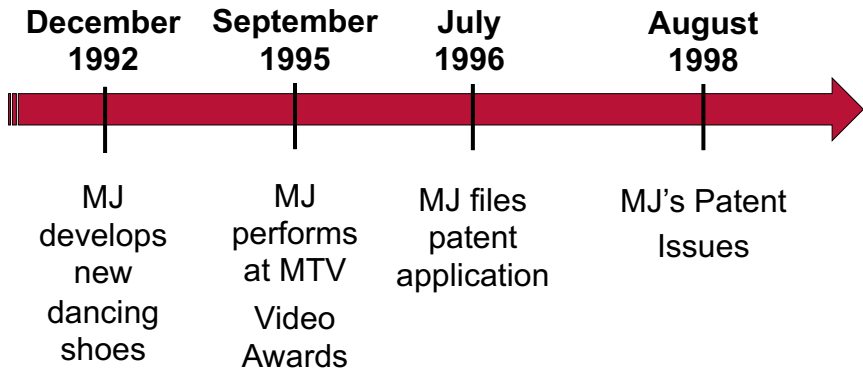
Primary Examiner—Steven M. Meyers  
 Assistant Examiner—M. Denise Patterson  
 Attorney, Agent, or Firm—Drucker & Sommers

ABSTRACT

A system for allowing a shoe wearer to lean forwardly beyond his center of gravity by virtue of wearing a specially designed pair of shoes which will engage with a hitch member movably projectable through a stage surface. The shoes have a specially designed heel slot which can be detachably engaged with the hitch member by simply sliding the shoe wearer's foot forward, thereby engaging with the hitch member.

13 Claims, 4 Drawing Sheets

# Timing Example (Cont'd)



Is MJ's patent valid?

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Title search: Top Ten Common IP Mistakes You Can Avoid

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"Common IP Pitfalls and How to Avoid Them"