

Intellectual Property Issues When Thinking Green

By Tracy Bornman

"Green" technology and new businesses catering to the desire to be environmentally friendly are everywhere. And while those involved may not realize it, intellectual property issues abound. Successful companies will take advantage of opportunities to protect intellectual property rights in their green inventions and services.

In general, the same intellectual property issues and procedures that apply to non-green technology also apply to green technology. There are four primary types of intellectual property protection available: patents; trademarks; copyrights; and trade secrets.

Patents

Probably the most significant mistake a business owner or inventor new to the patent world can make is a failure to timely file a patent application. In the U.S., a patent applicant has one year from the date of first public use, sale, offer to sell, or dissemination of a printed publication disclosing the invention to file a patent application, or protection for that invention will be barred. While most foreign countries are even more strict and do not have any such grace period, most are also signatories to treaties with the U.S., so that a patentee can "claim back" to the original U.S. filing, provided foreign applications are filed within 12 months of that filing. Thus, getting a U.S. patent application on file prior to commercializing or publicizing an invention is imperative. As soon as an application is on file, the invention can be marked "Patent Pending," which can provide competitive advantages in and of itself. Although, the road to patent protection is a long one, an accelerated examination process is available for those inventions that justify the time and expense of requesting accelerated examination. One advantage for green inventions is that the fee for requesting accelerated examination is waived if the invention will materially enhance the quality of the environment or contribute to the development or conservation of energy resources.

Trademarks

Trademarks are different from patents in that a trademark protects an identifier for a good or service. For example, if a company creates a green product or service and markets that product or service under a brand name, the company could register a trademark of the brand name if it is sufficiently non-confusing to other names for the same or similar goods or services. Trademark protection is different from patent protection in that it doesn't prevent a competitor from commercializing a similar product. Rather, it prevents a competitor from commercializing similar goods or services using a confusing similar name. Often, trademark and patent protection will be, and should be, sought for the same commercial product. For example, the company's green product mentioned above may be a patentable invention entitled to patent protection, while the name under which the company commercializes the product is entitled to trademark protection.

Copyrights

Copyrights protect creative authorship, which can take many forms, including literary works, musical works, artistic works, source code (the written text of a computer program), and more. As soon as the work is fixed in a tangible medium, copyright protection arises; however, there are significant advantages to federally registering a copyright. A copyright protects the copyright owner should a third party copy the protected work. However, if the third party independently creates the same or a similar work (i.e., copying did not occur), there is no copyright infringement. Although copyrights protect different intellectual property rights than do patents or trademarks, overlap can occur. For example, if a company develops a computer program that could be used to determine the most efficient design for a solar panel system, that company could seek patent protection for the function of the software while also registering a copyright for the source code. Furthermore, should the company sell the software under a unique brand name, it could also seek trademark protection for that name.

Trade Secrets

The final primary avenue for protecting intellectual property rights is that of trade secret protection. The key for having trade secret protection is to really and truly behave as if something is a secret. This is a

fact-based determination, but it includes controls such as restricting access to the secret to only those who absolutely need access. There should be strict policies and procedures in place, and diligently followed, in order to allow the trade secret owner to prove that the information truly was a trade secret. While trade secret protection can be valuable, it is also the most fragile form of protection in many instances. Once the secret becomes known (even through no fault of the trade secret owner), the trade secret bubble bursts, and it can no longer be considered a trade secret. Furthermore, like copyright protection there is not protection against another party independently developing the same information. Rather, the trade secret owner would need to prove that the trade secret was misappropriated if they were to pursue an action against a third party.

Green Innovation Funding

One final and related area that is commonly encountered among small and/or start-up businesses developing green technology is that of government funding. Government funding can be a much-needed boost to a business to facilitate green innovation. However, there are certain issues that must be addressed when an invention is developed using government funds. It is essential that the business have a person in charge of reading and rereading the funding contract with regularity to verify that the required milestones are being met and appropriate reporting is being carried out. Also, most funding contracts will award the government with certain rights in the intellectual property developed with the funds and will also require that all relevant patents contain a notice of such rights. As intellectual property protection is being sought for green inventions, it is important to notify any attorneys assisting in protecting those rights of the relevant requirements under the particular funding contract.

The above information is the tip of the iceberg in a very complex area of the law. Businesses venturing into green technology and services should consult an intellectual property attorney early in the process to avoid costly pitfalls.

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