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A Comprehensive Approach to IP Lawyering

By Gregory W. Carr and Theodore F. Shiells

With more powerful communications technologies promising a sustainable recovery of the Internet as a delivery vehicle for Web-enabled services, intellectual property lawyers limiting their focus to one of the sub-specialties of patents, trademarks, copyrights and trade secrets might think twice. The resulting convergence of virtually every aspect of a business into a single platform will demand a comprehensive approach employing all sub-specialties of intellectual property (IP).

Despite the current financial climate, innovative companies with strong business plans are still receiving funding, but in more measured steps than during the last “bubble.” They will be held to agreed time and budget constraints, with a careful watch that the intellectual and technological capital are properly protected. Virtually every aspect of a business, including technology, business methods, services, advertising and data will merge into a single delivery vehicle. IP lawyers representing this new breed of business face the challenge of cost-effectively preserving the full complement of IP rights available for even a single Web page, before the first click of a mouse becomes a roar.

The sheer breadth and speed of their launch into every corner of our Internet-connected marketplace, with just a few clicks of a mouse, virtually ensures that new and innovative products and services have even brighter prospects today than at the height of the dot-com frenzy almost two years ago. Wide deployment of higher-speed or broadband communication technologies, such as third generation (3G) wireless communication systems, will accelerate this evolution. With additional 3G capabilities, such as identifying what store is nearby combined with delivering interactive voice and video to mobile phones and Personal Digital Assistants (PDAs), offerings previously unimaginable will be available instantly to a larger market, at costs lower than owning a personal computer.

The merger of virtually an entire business into one screen or delivery vehicle, demands more than ever that the IP lawyer understand the technology, correctly apply the various forms of intellectual property protection available, and formulate a comprehensive and consistent approach in preparation for eventual review in an acquisition,

licensing efforts and any infringement litigation. Valuable aspects of a Web page offering must be protected with the correct form of intellectual property or risk invalidation of those rights later.

Infringement of valid and enforceable intellectual property rights of third parties must also be avoided. These circumstances will call for many IP lawyers to return the fashion of wearing multiple hats—one for each IP sub-specialty.

Crucial Understanding

Intellectual property can secure exclusive rights to information and things that perform a useful function (utility patents), indicate the source or approval of a product or service (trademarks, trade dress and product configuration) and/or are organized in an original or non-obvious form (copyrights and design patents). Information reserved from disclosure could in addition or alternatively be protected as a trade secret.

Intellectual property protects information in various forms and applications. A Web page-enabled service delivered via the Internet is pure information to which all forms of intellectual property might apply.

For example, think of a plumber-technician diagnosing a drain problem and instructing a customer in the replacement of a pipe, while viewing the project remotely though a 3G wireless phone. The service allows access to data indicating whether tools and parts needed for the job are available at nearby stores and their prices. Selection of the tools and parts or diagnostic services can be made through voice recognition or toolbars appearing on the screen at the command of the customer or the attending plumber. Visual and audible symbols and sounds unique to this service guide the customer through the process and service options available.

The need for a consistent and comprehensive approach to protecting the various intellectual properties of this system simply arises from commingled and possibly overlapping features of the Web page. Critical to securing patent, trademark or copyright protection capable of withstanding a validity attack is a determination of which aspects or combinations of features are considered “functional” and which are not.

For example, in *Traffix Devices Inc. v. Mktg. Displays Inc.*, the U.S. Supreme Court held last year that regardless of acquired secondary meaning, the existence of a patent on a product and prior patent infringement litigation indicated that the feature was functional, precluding trade dress protection. Similarly, in 2000, the court also held in *Wal-Mart Stores Inc. v. Samara Bros.* That a claim under §43(a) of the Lanham Trademark Act for infringement of an unregistered trade dress of a product design requires proof of secondary meaning and non-functionality of the allegedly infringing feature.

Thus, portions of the numerous graphics, buttons, icons, sounds, processes and interactive tools that are “functional” only could be protected by a utility patent and would not be entitled to trademark or copyright protection. Other portions that are not “functional” would be candidates for only design patent, trademark, copyright and trade secret protection, depending upon other factors. To a great extent, this functionality determination will be defined by the features selected for patenting and their descriptions.

Successfully protecting the various Web page features requires a thorough technical understanding and a coordinated application of all intellectual property. Lines drawn in making the primary determination of functionality and the secondary determination of what type of protection to apply are often not abundantly clear. To avoid raising validity issues unnecessarily, care must be taken in all official correspondence with the U.S. Patent and Trademark Office, advertising and third party communications, to be consistent with the distinctions drawn, particularly when describing the salient and subtle functions and features of the page.

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