

Preface

THE PROPER PERSPECTIVE—A FABLE

After a long and productive life on earth, an engineer arrived at the gates of heaven. The gatekeeper scanned through the book of expected arrivals, and then advised the engineer that there was a mistake and that he was supposed to go to the “other place.” The engineer was directed by the gatekeeper to a long escalator, and told to take the escalator all the way down, where he would be greeted by someone in a red suit. The engineer did what he was told, and ended up in Hades.

After being in Hades for a short while, the engineer noticed that it was uncomfortably hot. Being that he had been a heating, ventilating and airconditioning (HVAC) engineer on earth, he began assembling various parts of scrap materials lying around, and in a matter of three weeks, had constructed and was operating an air conditioning system throughout Hades. A week later, he had completed a cold water delivery system. Shortly thereafter, God and the devil were on the phone for their monthly status conference call, and the devil stated: “You wouldn’t believe! We have an engineer down here, of all people. He’s installed air conditioning and cold water down here; he’s done great things. It’s almost livable down here now.” God replied: “You have an engineer down there? That’s a horrible mistake! You have to send him up here right away!”

“No!” said the devil. “He’s doing wonderful things down here, and I love him a lot!”

God said: “You send him up here right away!”

“No!” retorted the devil.

“You send him up here immediately, or I’ll sue you,” responded God.

The devil said: “You’re bluffing.”

“What do you mean, I’m bluffing!” said God.

The devil replied: “Where are you going to get a lawyer?”

OVERTURE

Having thus established the appropriate relationship between technology and the law, the material in this book pertains to protection afforded by the law to ideas, creations and inventions of engineers, scientists and others covered by the umbrella term “technology professionals.” With technological advancements moving forward today at what appears to be an exponential rate, the need to transform intangible novel ideas into tangible, protectable assets has increased. Where in the past, the word “patent” or “copyright” only rarely appeared in the daily newspapers, today the popular press is repeatedly relating news items regarding the effect of intellectual property protection in our everyday lives. For example, pharmaceuticals and patents have become a global issue. Also, each time

you install a new program on your computer, or open the shrink wrap on a package containing software, you must “agree” to respect the intellectual property rights of the creator of the software.

The fields of science and engineering have, and always have had, a direct correlation to the work of intellectual property attorneys and agents throughout the world. In case you’re wondering, the term “intellectual property attorney” encompasses all of us who practice in the areas of patent, copyright, trade secret, trademark and unfair competition law, and their related fields, as included in this text. For example, I have been counseling and dealing with engineers, scientists and other creative types for over 40 years, and throughout this period, I have constantly worked with the interface between technology and the law that, for the most part, defines “intellectual property creation and protection.”

The one thing that has been evident to me throughout my practice is that the engineers and scientists I have worked with have wonderful educations and experience in the technology field in which they toil. However, practically each time I have advised an inventor or creator of the steps to be taken to protect their new invention or novel creation, I found myself describing the law to them from the beginning. Since an inventor or creator may actually lose rights in their intellectual property before deciding whether to obtain protection or not, I came to an understanding that technology professionals should at least have a handy resource available to obtain general knowledge about intellectual property law before they complete their inventions and creations, so as to avoid taking steps that would cause the loss of all or mostly all intellectual property rights before they have the opportunity to reap the rewards of their creative work.

As an adjunct faculty professor at the College of Engineering of the University of Illinois at Chicago, I prepared a course entitled “Intellectual Property Law for Engineers and Scientists,” which was and is taught as part of the Master of Engineering degree program offered totally over the Internet. I prepared fifteen weekly lectures of one-half to one-hour duration. The lectures are delivered orally to students who enroll in the course as a voice-over to a slide presentation depicting highlights of each lecture. In addition, the entirety of each lecture is posted on our web site, on a week-by-week basis, and can be downloaded, printed and used to follow the audio presentation. My ad libs, some anecdotes, and poor attempts at humor forming the audio broadcast are not included in the written text. From the assignment answers submitted by the students, I can perceive a keen interest in the subjects covered in our course, and enrollment in the course keeps increasing.

Professor George Uslenghi, Associate Dean of the College of Engineering at UIC suggested that the series of lectures that I prepared, with augmentation, be prepared as a draft manuscript and submitted for publication. Professor Uslenghi determined that a proper background in intellectual property modalities was becoming increasingly important for an engineer and scientist to have an awareness of. To make a long story into a saga, the result of the Professor’s suggestion is this text.

I don’t expect that this text will be read from cover to cover. The table of contents and index have been carefully crafted to allow you, the reader, to go directly to the information you need regarding a specific project you are involved in. For example, I expect the electrical and mechanical engineers to avoid the chapter on Biotechnology.

A major purpose of this text is to enable you, as an inventor or creator, to efficiently interface with an intellectual property attorney, for example, and provide him or her with information enabling you to obtain the maximum protection for your invention or creation. On the other side of the coin, the text material will aid you and the intellectual property attorney to take steps to ensure that your invention or creation does not infringe upon the in-

tellectual property rights of others. The last thing in the world you want is to invite a lawsuit when you introduce your new product or process to the world.

Included in this text are patent, copyright, trade secret, mask work, trademark and cybersquatting legal and procedural principles, as well as how to properly use new vehicles of intellectual property protection for novel software, biotech, and business method inventions. Also, this text covers trademark protection for domain names, and other ancillary matters that fall within the genre of intellectual property protection.

The material in the pages that follow also provides you with information regarding employment contracts as they relate to an assignment of intellectual property rights to an employer, the concepts of confidentiality of proprietary information, and covenants not to compete following a change in employment.

By no means is this text intended to transform you into an intellectual property attorney, or to do the work of one. The purpose is to provide you with knowledge of a very arcane, but important, adjunct to the technology professions, that of the protection of the technology you develop, and the steps necessary to prevent stepping on the intellectual property “toes” of others.

Between each of the chapters of this work devoted to intellectual property subjects, I have placed essays on famous and noteworthy inventors and their inventions, followed by a copy of the first page of patents resulting from these inventors’ efforts. A complete copy of each patent may be obtained from the United States Patent & Trademark Office website, <http://patft.uspto.gov/netahtml/srchnum.htm>. I found the research devoted to these historical incidents to be fascinating, particularly the differences between those who developed their inventions through diligent periods of trial and error, and others whose inventions resulted from an act of serendipity.

The content of this text does not provide everything there is to know about intellectual property protection. Such a text would be too thick to be mobile. In covering each of the subjects, I have taken you, the reader, to the point where your next step will be to consult with a competent intellectual property law professional to provide you with the detailed information necessary to protect the results of your intellectual endeavors. Keep in mind that the publisher of this text is not in the business of offering or rendering legal advice, or other professional services to the reader.

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