California [Name of Department or Agency]

# Intellectual Property Policy: Roles and Responsibilities

## Registration of Trademark and Service Mark

1. The Office of Legal Services [NAME OF UNIT, ETC.] will register all [NAME OF AGENCY OR DEPARTMENT] service marks and trademarks as identified by the Directorate.

## Registration of Copyright

Each division, in consultation with [NAME OF UNIT, ETC.], may register work items created by its own Division. In evaluating the registration of each item of work, the following factors are considered:

1. Can the work be protected under copyright law? Since law and facts are not protected under copyright law, [NAME OF AGENCY OR DEPARTMENT] does not register such work.
2. Are there any statues, other authority or agreements which may prohibit [NAME OF AGENCY OR DEPARTMENT]’ assertion of copyright protection?
3. Do the benefits obtained by copyright registration outweigh the costs of obtaining the registration?
4. Is the public interest best served by asserting copyright protection?

## Licensure

The Director of [NAME OF UNIT, ETC.] has responsibility for determining whether or not to license [NAME OF UNIT, ETC.] copyrights and patents.

1. Deputy Directors will advise the Director on matters of copyrights and patents for work items relevant to their division.
2. The division originating the work to be protected by copyright may choose to prepare the license agreement, which includes [NAME OF UNIT, ETC.] review.
3. [NAME OF UNIT, ETC.] reviews the license agreement provided by the divisions and supplies sample license agreements to the division upon request.

## Preparing Copyrighted Materials

When preparing work that is protected by copyright law for publication, each division shall include the following copyright notice when copyright protection is sought.

 “(c) [Date of first publication] California Department of \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_ .”

1. The date in the notice should be the year in which the work is first published.
2. Examples of work that may have copyright protection include, but are not limited to, [NAME OF AGENCY OR DEPARTMENT] databases, publications, videos, software, and similar materials.

## Protecting Trade Secrets

Each division must take reasonable efforts to maintain the confidentiality of any trade secret used by the Department, including but not limited to, the training of employees regarding the use and maintenance of trade secrets employed by its own division.

[NAME OF AGENCY OR DEPARTMENT] will compile a list of its intellectual property, including copyrighted materials, trade secrets, and similar materials. The database containing this inventory will be housed and maintained in [NAME OF UNIT, ETC.].

[NAME OF AGENCY OR DEPARTMENT] employees are prohibited from publicly distributing or displaying a known [NAME OF AGENCY OR DEPARTMENT] trade secret unless required by law or legal process after consultation with [NAME OF UNIT, ETC.]. This restriction does not apply to authorized discussions or displays of trade secrets that are required in order to permit an employee to perform his or own customary job duties or responsibilities.

## Contracts

[NAME OF AGENCY OR DEPARTMENT] will use contractual language that ensures the agency or department retains the rights to any intellectual property generated pursuant to a contract. The Department unit/section that maintains the copyright/patent/trade secret in consultation with [NAME OF UNIT, ETC.] will evaluate contracts on a case-by-case basis to determine if additional protections are required in a given procurement.

If additional protections are deemed necessary or desirable in a specific instance, [NAME OF AGENCY OR DEPARTMENT] has the discretion to negotiate additional

intellectual property protection after obtaining the advance approval of [NAME OF UNIT, ETC.]. These additional protections include, but are not limited to, terms of use provisions that limit the use of state intellectual property resources to only appropriate purposes. [See Govt. Code sec. 13988.2(a)(7).] Appropriate purposes are those that

further the mission, goals, objectives, and related interests of the specific state agency or department.

## Copyright, Trademark, Patent & Trade Secret Law

Refer questions regarding Copyright, Trademark, Patent & Trade Secret Law and definitions of intellectual property to:

Department of General Services

Intellectual Property Program

Office of Legal Services

707 3rd Street, Suite 7-330

West Sacramento, CA 95605

Phone: (916) 376-5080

Fax: (916) 376-5088

## Reporting Potential Misuse of [NAME OF AGENCY OR DEPARTMENT] Intellectual Property

Suspected misuse and/or misappropriation of [NAME OF AGENCY OR DEPARTMENT] intellectual property may be reported through the employee’s chain-of-command.

1. Potential misuse may be reported to the employee’s immediate supervisor for possible escalation. Deputy Director of Branch Chiefs, in consultation with [NAME OF UNIT, ETC.], will determine if the suspected misuse warrants further action.
2. Employees should not contact [NAME OF UNIT, ETC.] directly without approval from their management.

# Definitions

## Trade/Service Mark (15 U.S.C. sections 1051 et seq.)

A trademark/service mark is the identification of goods or services.

* Trademarks/service marks can be words, designs, slogans, or symbol [Name of unit, etc.].
* The test for trademark infringement is the “likelihood of confusion” by the public as to the source of goods or services.
* A trademark/service mark is valid for as long as it is in use.
* Registration is optional, but recommended.
* The symbol ® indicates that the mark is has obtained federal registration with the United States Patent and Trademark Office.
* “TM” or “SM” next to an unregistered trademark/service mark indicates a claim to common law trademark rights. Marks registered with the California Secretary of State can use “TM” or “SM” to denote registration.

## Trade Secret (California Civil Code section 3426)

A trade secret is information that must derive actual or potential economic value from not being generally known to the public or to those who can obtain economic value from its disclosure or use.

1. Reasonable efforts must be taken to maintain the secrecy of the trade secret in order for the information to be considered a trade secret.
2. Trade secrets include formulas, compilations, programs, devices, or methods.
3. Even knowledge of what will not work may be a trade secret.
4. A trade secret does not have to be continuously used in one’s business.

## Copyright (17 U.S.C. sections 101 et seq.)

1. Copyright protection automatically attaches to original works of authorship.
* Copyrightable works include: Literary works, pictorial works (including architecture plans) and graphic works, motion pictures, sound recordings, and certain databases.
* Pure facts, ideas, laws, regulations or blank forms are not eligible for statutory copyright protection. (See [https://www.usa.gov/government-works.)](https://www.usa.gov/government-works)
1. Copyright protects an original work against commercial copying, distributing, publicly displaying, and preparing a derivative work. “***Fair use***” exceptions to using a copyrighted work without the copyright owner’s permission are

scholarship and criticism, especially regarding matters of public importance. (For example, a critic may copy selected paragraphs of a document or paraphrase a document.)

1. A copyright notice announces to the public that a work is protected under copyright law.
* A copyright registration with the U.S. Copyright Office allows a copyright owner to sue an infringer.
* The test for copyright infringement is access to the original work plus “***substantial similarity***” between the two works.
1. The registration of a copyright is optional and can be done at any time during the period of copyright used by sending two copies of the work, an application, and the required fee to the U.S. Copyright Office. (See http://copyright.gov/comp3/chap200/ch200-registration-process.pdf.)

Potential benefits of registration include the ability to sue an infringer and obtain an award of attorney’s fees if registration is done within 3 months after publication of the work or prior to an infringement of the work. (See 17 U.S.C. section 412.)

## Patent (Title 35 U.S.C. sections 100 et seq.)

“Whoever invents of discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent subject to the conditions and requirements of this title.” (35 USC § 101)

1. An application must be made for the federal grant of a patent within one year of public use or sale. [See 35 U.S.C. section 102(b).]
2. A patent allows the patent owner to exclude others from making, using, or selling an invention for the term of the patent (20 years for most patents while it is 17 years for a patent granted prior to 1995).
3. The patentability of computer software is an open question in light of recent U.S. Supreme Court decisions. Copyrighting software currently may be the best option, depending on the type of software involved as certain software patents, such as business method patents, are much more vulnerable than others.