

# Strategically Securing and Protecting Intellectual Property in the Wind Industry

Robert P. Lord, Partner & Patent Attorney

Timothy M. Smith, Patent Attorney

*WINDPOWER 2010*

*May 25, 2010*

# Presentation Overview

## Overview of types of IP in the Wind Industry

- Copyright
- Trademark
- Trade Secret
- Patent

## Protecting your IP in the Wind Industry

- Practical examples - Why is an IP portfolio important?  
What can I do with it?

- Expediting patent protection
  - Petition to Make Special
  - Patent Prosecution Highway

## Copyright



- Right attaches to a creative work fixed in a tangible medium

- Book
- Design Plans
- Artistic Rendering
  - Sculpture
  - Musical work
- Promotional Materials (Photos)
- Etc.

- Registration is not required for copyright, but is necessary for enforcement

[www.copyright.gov](http://www.copyright.gov)

- Gives the owner the exclusive right to reproduce, distribute, perform, display, or license his work

- **Author** is generally presumed owner of copyright (typically **not** the party paying for the work)

- Also applies to derivative works

- work based upon one or more pre-existing works

# Examples of What Can Be Copyrighted in the Wind Industry

- Contracts/Agreements (e.g., land lease agreements, equipment agreements, service agreements, PPAs)
- Studies/Reports (e.g., environmental, wind, transmission)
- Presentations (e.g., to landowners, to local government, to an audience at WINDPOWER 2010)
- Press releases
- Promotional/Advertising materials, including photographs
- Design Documents/Technical Schematics/Architectural Plans (e.g., of a wind farm)
- Computer code

## Trademark

- Indication of source or origin of goods or services
- Rights flow from **use**
  - Registration is confirmation of rights
  - Gives various advantages



[www.uspto.gov](http://www.uspto.gov)

- Use of marks to identify ownership dates to 5000 B.C.
- Rights are tied to specific type or types of products or services in a specific market
- No rights in the absence of actual use of mark in the relevant market

## Examples of What Can Be Trademarked in the Wind Industry

- A name and/or graphical image of a logo for a company or division of a company
- The name and/or graphical image of a logo for a product (e.g., transformer, generator, control module, cable, tower, blade, crane)
- The name and/or graphical image of a logo for a service (e.g., environmental studies, construction services, wind study services, transmission study services, development services, financing services, generation services)
- A slogan of a company, product, process, or service
- A name of a wind farm

## Trade Secret

- General Definition:

- (1) a secret which gives its owner an actual or potential advantage in business, and
- (2) which the owner exercises reasonable measures to maintain as a secret.

- No standardized definition or uniform enforcement

- Seen as vital in today's high-tech society

- Protects against industrial espionage
- Protects investments in critical technologies with minimal costs but could be risky



# Patents

[www.uspto.gov](http://www.uspto.gov)

- The Patent Bargain:

- Inventor gets:
  - Exclusive right for limited time
- Public gets:
  - Full disclosure of the technology
  - Right to use when patent expires

•Patents rights are based on the U.S. Constitution and governed by 35 U.S.C.

**PATENT PENDING**

- Types of Patents

- Utility Patent
  - Protects the way something works, is used, or is made
  - Usually what is meant by “a patent”
- Design Patent
  - Protects the ornamental design of an article
- Plant Patent
  - Asexually reproduced plants



# Things to Consider When Applying for a Patent in Wind Industry

## BAD NEWS...

- In US, most rights do not exist until a patent is granted so speed is essential
- For patents in green technology, USPTO estimates that the application process takes about 3 years
- Delays in the application process results in
  - Lost opportunity costs - estimated to be over US\$11 billion annually worldwide - through inability to enforce/license invention
  - Greater out-of-pocket costs to get through application process

# Expediting the Application Process

GOOD NEWS...

- Petition to Make Special

- Includes Green Technology Pilot Program
- Inventions that qualify must materially
  - Enhance the environment; or
  - Contribute to the development or conservation of energy resources

- Patent Prosecution Highway

- Applies to inventions filed in multiple countries
- Not technology dependent
- Reduces application time by sharing work performed in partner country
- Agreements currently in place with Australia, Canada, Denmark, Finland, the European Patent Office (EPO), Germany, the International Bureau, Japan, South Korea, Singapore, and the United Kingdom

## Examples of What Can Be Patented in the Wind Industry

- Equipment (*e.g.*, wind turbine, rotor, transformers/inverters/converters/rectifiers)
- Control systems
- Configurations (*e.g.*, equipment)
- Circuit protection schemes
- Methods (*e.g.*, use of equipment, operating a wind park, power generation/distribution)

# Recent Developments

- Pendulum is Swinging
  - Subject Matter
    - Tougher for Computer software and methods of doing business
  - Obviousness
    - Becoming broader, making patent protection more challenging
- Moving to a first-to-file system?
- Patent Marking/False Marking

# Strategic Considerations of an IP Portfolio in the Wind Industry

## •Importance

- Protect technology
  - Defensively
    - Cross licensing
    - Slow disclosure/bad documentation scenario
  - Offensively
    - Licensing program
    - Exclusivity/competitive advantage
    - Litigation
- Add value
  - Valuation of IP

## •Establishing an IP Portfolio

- Outside vs. In-house
- Costs
- When to start?
  - It is never too early

## •Need Strategic Plan

# Example of a Well Used Patent

- **U.S. Patent No. 5,083,039 for a Variable Speed Wind Turbine**
  - Patent granted on January 21, 1992
  - Contains 138 claims (34 independent)
  - Rights held by 4 companies at different times (to date)
  - Used to prevent Enercon from selling direct drive wind turbine in U.S.
  - Generates revenues through multiple licensing agreements
  - Currently being used to keep Mitsubishi from selling its 2.4 MW wind turbine in U.S. since Feb. 2008
  - Last week, Mitsubishi sued GE for uncompetitive behavior in Arkansas and a patent infringement lawsuit in Florida

## Questions?

- Thank you for your attention
- Contact Information
  - Robert Lord
    - [lord@oshaliang.com](mailto:lord@oshaliang.com)
    - 408-450-6711
  - Tim Smith
    - [tsmith@oshaliang.com](mailto:tsmith@oshaliang.com)
    - 713-228-8600