

Patents, Trademarks and Copyrights What, Why, When and How? Basic Answers for Inventors

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Disclaimer: This presentation does not constitute legal advice, only general information to educate you. Every legal concept presented has many exceptions and is subject to different interpretations. This presentation doesn't create an attorney-client relationship, even if you ask me individual questions.

Note: For more information and for materials referenced in this handout, go to www.milwaukeeipatents.com and click the "Inventors" tab.

Patents

What is a patent?

Answer: A patent is a right to exclude others from making, using or selling your invention for a twenty-year period. It is sometimes analogized to a "mini-monopoly."

This "right to exclude" extends to all inventions which accomplish what your invention does in the same way. This so-called "doctrine of equivalents" is why many experts view patents the most comprehensive form of legal protection.

Common types of patents include utility design and plant patents. You can protect apparatus, systems and methods with utility patents. Design patents protect ornamental designs.

Why do we have patent protection?

Answer: To encourage innovation, and make sure that the true inventors profit

Imagine a doctor who spends years of his life and all of his savings developing a cure for a dreaded disease, or a teacher who develops a new learning tool or a computer geek who designs the ultimate spam blocker. These inventions may be easy to copy or "reverse engineer." The patent protects the investment of the true inventors.

Note: Because a major rationale of the patent system is to get information into the public domain, inventors in the U.S. have one year to file a patent after they disclose their invention. (There is no one-year grace period in other countries.)

When should you get a patent?

Answer: When you have a novel idea that will require an investment of time and money to bring to market

How do you get a patent?

Legally, the subject matter of your invention must be:

- **New** (i.e., someone else did not invent it first - the invention is not found in the “prior art.”)
- **Useful**
Speaker’s viewpoint: this is almost never an issue since examiners now tend to view a wide range of apparatus that create an aesthetic effect as useful
- **Non-obvious – this is the most common hurdle inventors must overcome.**
- The USPTO can combine two prior art “references” (e.g. two other patented devices), but no more

Example: combining a bone-shaped cookie with a dog biscuit to defeat a patent for a bone shaped dog biscuit as obvious

Here are the steps I usually advise my clients to follow: (I will cover them in more detail in December):

Step #1: Maintain confidentiality: Do not disclose how to make and use your invention to anyone unless they have signed a non-disclosure form. You must file a patent within one year of making an “enabling disclosure” (if you have made it without the benefit of a non-disclosure agreement).

A sample nondisclosure form will be posted at www.abtechlaw.com

Step #2: Search the prior art (starting with these three sources):

- www.uspto.gov (click Patents, then Search)
- Your own knowledge of the industry

- Google

Instructions for searching the USPTO data base will be posted at www.inventoranswers.com/forum

Step #3: Develop a strategy: Talk to your attorney about strategies including what aspects of your invention you need to protect:

Example of a strategic decision to be made: filing a provisional versus a non-provisional patent application.

Provisional patent

- less expensive
- does not contain claims (which is the legal language that describes your invention)
- you get to use the “patent pending” designation.
- must file non-provisional application within 1 year

Non-provisional

- a patent gets issued sooner
- potential investors often want to review the pending claims

Trademarks

What is a trademark?

Answer: A trademark is a word, symbol, device, logo or slogan that distinguishes the source of one product from another. (Example: Hershey’s® chocolate)

Why do we have trademark protection?

Answer: To encourage improved products and services through branding.

For this reason, the USPTO will not register “confusingly similar” marks

Example: Fabreze™ has invested a lot in marketing, so consumers know there is a certain function, quality and smell associated with the product. What started imitating the smell or packaging and calling their products “Fab-breeze” or Fabriz?

How do you get trademark protection?

Trademark rights are based on use in commerce, not on registration. Protection is automatically granted to the first person to actually use the product in commerce.

When should you “register” your trademark?

Registering your mark gives you certain rights in the event the mark is infringed. You do not have to prove you have rights in the trademark in court if you have gone through the registration process. Also, it puts others on notice that you are using the mark commercially. You must register a mark separately for each class of goods and services you want associated with the mark.

Legally strong versus weak trademarks: Trademarks that are “fanciful” words (e.g., Xerox ®) are “arbitrary” designations (e.g., Apple® for computers) or considered strong trademarks. Trademarks that are “descriptive” of some feature of the good or service are considered “weak,” and are harder to protect under trademark law. To get full legal protection, the trademark owner can demonstrate public awareness of a weak trademark (known as “secondary meaning”). Once a trademark owner can demonstrate secondary meaning the mark will be considered distinctive and can be registered. Examples of weak marks that have acquired secondary meaning include “Bank America”® and “Vision Center.”®

The primary and supplemental registers: The USPTO uses two registers, or lists of trademarks, on which trademarks may be registered. The principal register contains trademarks that are suggestive, arbitrary and fanciful. Descriptive marks with secondary meaning are also on this register. The supplemental register contains all other marks, and marks on this register have few rights.

Copyrights

What is a copyright?

Answer: A copyright is the legal right to exclude others from copying your work.

- this includes selling performing displaying or making “derivative” works
- a copyright protects expression not underlying ideas or functionality
- copyrighted material must be in tangible, written form

Note: There is a lot of controversy surrounding copyright protection for software; copyright historically has protected direct copying of code, but not the ideas underlying it.

Why do we have copyright protection?

Answer: To make sure creators/authors are allowed to profit from their work

(Example: music downloading)

How do you get copyright protection?

Copyright is free and automatic. It attaches to your work upon creation and you can and should use the © symbol as I have done on these handouts. However, registration confers additional rights.

When should you “register” your copyright?

It's important to register your copyright before an infringement so that you can get attorneys' fees and statutory damages from an infringer. If you register prior to when the infringing activity has occurred you are entitled to “statutory” damages and attorneys' fees.

For copyrights registered before the infringement, the court can award statutory damages up to \$150,000 per infringement. Subject to the approval of the court, copyright plaintiffs may also obtain: (i) a temporary restraining order that prohibits the infringer from infringing the copyrighted work, and (ii) a court order authorizing the U.S. marshal to seize the allegedly infringing material.

The advantage of having the right to claim statutory damages is that there is no need to prove lost profits or the infringer's profits because the court has the discretion to award statutory damages to the infringer of up to \$30,000 for each copyrighted work infringed. If the infringement was willful, the court can award statutory damages up to \$150,000.

**Questions? Visit the Legal Information and Inventors and
Entrepreneurs Form Pages at www.milwaukeeipatents.com
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