

# WHAT YOUR CORPORATE ATTORNEY NEVER TOLD YOU ABOUT PATENTS, TRADEMARKS AND COPYRIGHTS

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So, you are an independent inventor, the CEO of a corporation or a start-up who never had to worry about protecting your inventions or those of your company. You have done everything your corporate attorney and accountant told you to do and you now feel protected. Unfortunately, there are deadlines built into the United States patent laws and the patent laws of other countries that could lead to the loss of all the rights to your invention.

When someone new to the patent system contacts us about protecting their innovations, they often tell us how well their product or process has been received in the marketplace or by potential customers. We immediately ask how long the product, device, or method has been in public use, on sale, or described in a printed publication. Most are shocked to learn that if a patent application is not filed within one year of the first public disclosure or sale, they will be barred from obtaining a U.S. patent. Nearly all are shocked to learn that even if this one-year grace period has not expired, a public use or sale for even one day before filing their U.S. patent application will entirely prevent or substantially limit their ability to obtain foreign patents because most other countries do not have an equivalent to the U.S. grace period.

The mere filing of an application does not give you the right to prevent anyone else from making, using or selling the invention disclosed in the application. So, if you start marketing or selling your invention, even after filing a patent application (which may not turn into an issued patent for years), then the person to whom confidential information is disclosed can completely copy, market, sell, and make money from your invention and you would have no recourse if the infringing person stops selling, making, or using the inventive product before the date on which your patent issued. Therefore, if you have a new idea you should seek patent protection as early as possible. If you are about to show or sell your item, a provisional application may be filed inexpensively in the U.S. in order to preserve the one-year period in which to file U.S. and foreign patent applications.

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Another intellectual property area is trademark law. Trade and service marks protect

names, slogans, and logos (which can include words in addition to designs) that are used to identify origin in conjunction with the sale of goods or services. A “trademark” is used generically for both marks for goods and marks for services, but a “service mark” applies only to a mark for providing services.

If you want no one to use or infringe your name or logo, then you should contact a competent trademark attorney, who could submit an application for your mark with the U.S. Patent & Trademark Office (USPTO) for a total filing fee of less than \$1000, including the current \$335 USPTO fee for one class of services or goods. A class is a list of various groups of similar goods or services defined by the international trademark community. Typically, you need only one class for a mark, so only one filing fee is paid. Two trademark application filing fees are required for two classes of goods when, for example, you wish to register a mark with respect to baked goods and, also with respect to T-shirts, hats, and other clothing items.

You should also be aware that incorporation in your state most likely does not protect your trademarks and service marks used in conjunction with your products, processes, and services. You should register your mark in the USPTO (or in your state if your mark is only used statewide). Such a registration will serve as notice to others of your ownership to the mark.

The minimum requirements necessary for filing a trademark application include the owner’s name and address, the class of good(s)/service(s), the mark, the date of first use anywhere, and the date of first use in interstate or international commerce. Therefore, if you are not going to advertise or sell your goods across state lines, a federal trademark will not likely be the preferred course of action. Instead, if you only sell in Florida, for example, a Florida state trademark would be more appropriate.

There are two kinds of federal trademark applications that can be filed. The first, an “actual use” application, is the one that most people commonly understand as being a trademark application. “Actual use,” as you would expect, is an application for a trademark that you have already used in interstate or international commerce and are still using. A lesser-known type of trademark filing is an “intent-to-use” application. In such an application, you are telling the USPTO that you would like to use and intend to use your mark, but you have not actually used it yet. The examination of the intent-to-use trademark application is conducted in the same way as an actual use application, except for one important feature -- when an actual use application is filed,

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a specimen of the mark as it is used in commerce is required; in contrast, for an intent-to-use application, a specimen is not required because, by definition, intending to use the mark means that a specimen does not exist. After examination by the USPTO, you will be required to file a specimen after actual use occurs. It is important to note that rules and penalties apply to the proper and improper use of the trademark registration notice ®.

The third intellectual property subject, copyrights, is an area that covers more ground than both patent and trademark in the sense that there are many types of expressions that are covered. For example, copyright covers literary works, such as poems, short stories, songs, articles, etc., and pictorial, graphic, and sculptural works. Copyrights also cover musical and dramatic works, motion picture and audiovisual works, sound recordings, performances, architectural works, and many other tangible expressions of ideas that an artist could have. Also, like trademarks, it is important to properly label copyrighted material with the copyright notice ©. But, unlike trademarks, immediate use of the symbol is proper and encouraged. You may be pleased to know that the current Copyright Office filing fee is \$30.

Early filing and issuance of a copyright registration has important benefits as registration is a prerequisite to obtaining the two most important remedies under the Copyright Act: (1) statutory damages and (2) attorney's fees and costs. Simply put, if you register your copyright before infringement, there is a greater likelihood that an attorney will accept your case knowing that significant damages and attorney's fees may be recovered in an infringement action.

*The hiring of a lawyer is an important decision that should not be based solely upon advertisements. Before you decide, ask us to send you free written information about our qualifications and experience.*