



Patents, Trademarks & Copyrights

Consumer Pamphlet Series



State Bar
of Georgia

PATENTS

What is a patent?

A U.S. patent is a grant to an inventor from the U.S. Government of the legal right to exclude others from making, using, selling, importing or offering to sell the invention, within the United States for a limited period of time.

How is a patent obtained?

Patents are granted by the U.S. Patent & Trademark Office (USPTO). A written application is filed with the USPTO describing the invention in detail and specifically stating what the inventor claims to be new and patentable. There is no patent application “form” to be filled out and submitted to the USPTO, since each invention must be unique to be patentable; therefore each application is individually prepared. Each patent application is examined by the USPTO and if the invention is novel, useful and unobvious to a person of ordinary skill in the art and other procedural requirements are met, a patent will be granted for the invention.

Are there different kinds of patents?

Yes. The most common kinds are utility patents and design patents.

A utility patent may be obtained for the utilitarian or functional nature of a machine, an article of manufacture, a composition of matter or a process. Generally speaking, utility patents protect the way an invention works.

A design patent may be obtained for the ornamental appearance of an article. A design patent protects only the physical appearance of an article and may not be used to exclude others from using the functional properties of the article. Generally speaking, design patents protect the way an invention looks. While design patents are typically much less expensive to obtain than utility patents, a competitor may get around a design patent by changing the appearance of a product without altering how it functions. Because of this, inventors should be wary of unscrupulous invention marketing services or promoters who sometimes mislead customers into obtaining a design patent for an invention that would be better protected by a utility patent.

In addition to utility and design patents, a plant patent may be obtained by anyone who develops or discovers, and asexually reproduces a new variety of plant (i.e., tree, flower, etc.).

What is the duration of a patent?

The term of protection of a utility patent begins on the date of grant and ends 20 years from the first filing date of the application for patent. Maintenance fees must be paid at three, seven and 11 years after issuance to keep a utility patent in force. Design patents expire 14 years from the date of the grant. Patents cannot be renewed, so after the patent expires, the invention becomes public property and then may be used by anyone.

Are all inventions patentable?

No. An invention must fall into one of four classes of patentable subject matter as set forth in U.S. Patent Laws. The specific classes are: machines, articles of manufacture, compositions of matter and processes. An improvement to an invention included in these classes may also be patentable.

In addition to qualifying in one of the four classes, an invention must be useful, new and unobvious. A prior patent, publication, pre-existing product, public disclosure or offer for sale, which predates and describes or includes the subject matter of your invention, may prevent you from obtaining a patent on that invention. Whether or not such prior art will be a legal bar to patentability can depend on a number of factors, such as timing, whether in the United States or abroad, and the identities of the relevant parties.

How can an inventor determine whether an invention is patentable?

A patentability search may be conducted to ascertain whether or not the proposed invention is patentably different from those disclosed in prior patents or publications (prior art). Therefore, it is advisable to conduct a patentability search within the records of the USPTO. The USPTO maintains a searchable online database that can be searched via the Internet (www.uspto.gov) as a starting point, but it may also be advisable to retain the services of an experienced and reputable patent searcher.

Is an inventor required to conduct a patentability search on an invention prior to applying for a patent?

No. A patentability search is optional. However, many inventors desire to review the prior art before filing a patent application. For example, a patentability search may reveal a disclosure of a similar device in an earlier U.S. patent. If the results of the search are unfavorable, then the inventor may save the expenses incurred preparing and

filing an application or developing the invention. Even if the search indicates an invention may be patentable, understanding the scope of the prior art will help in drafting a stronger patent application.

A patentability search typically only examines whether an invention is patentable. These searches do not investigate whether practicing the invention might violate another party's patent rights. It is possible that an invention may be patentable on its own, but still infringe a broader dominant patent. As such, it may be advisable to conduct a freedom-to-operate or clearance study prior to launching a new product or service.

Does a working model of an invention have to be constructed in order to file a patent application?

Not usually. However, if the USPTO suspects that your invention is not operable, a model may be required to demonstrate that the device works as described in the application. For example, purported perpetual motion machines that seem to defy the laws of science often draw additional scrutiny.

Is a patent required on an invention prior to the inventor selling it?

No. However, only after a patent on your invention is granted by the USPTO will you have legal rights to prevent others from making, using or selling the invention. Note, however, that sales of a product, even by the inventor, that are made prior to applying for a patent may work as prior art that can prevent the inventor from ever obtaining a patent.

What do the terms “patent pending” and “patent applied for” mean?

These two terms are synonymous and mean that the inventor has filed a patent application that is active in the USPTO. The patent application remains pending until the USPTO makes its final determination either to deny or to grant a patent to the inventor.

In some instances, a patent applicant may be able to recover some measure of damages for infringing activities that occur prior to the issuance of a patent, if the infringer had notice of a pending patent application that was officially published by the USPTO. Patent applications normally publish 18 months after their filing date, but publication can be delayed or expedited if certain procedural requirements are met. No cause of action for infringement

of a published patent application exists, however, unless and until a patent actually issues.

Is it too late to apply for a patent if the invention is already on the market?

That depends on when the invention was first disclosed, offered for sale or in public use. Your invention cannot be patented if it was in public use or on sale in the United States or if the invention was described in a publication anywhere in the world more than one year prior to filing a patent application with the USPTO. When an invention can only be tested through extensive use, experimental use may not count when determining whether an invention has been in use for more than one year. The experimental use exception, however, is only applicable when an inventor is genuinely experimenting to determine whether or not he or she has a workable invention.

Can protection be preserved on an invention before a patent is applied for?

Although you have no enforceable patent rights until a U.S. patent is issued on your invention, the right to patent your invention may be preserved by establishing evidence of your inventive activities and by keeping your invention secret, while using diligence in finalizing your invention. Under U.S. patent law, it is the first inventor who is entitled to a patent, not necessarily the first to file a patent application. But many other countries' patent laws favor the first party to file an application, and even in the United States there are procedural advantages to being the first to file.

While you are finalizing your invention prior to filing your application, you can create evidence to prove your invention date by keeping a written record of your invention which begins with its conception and includes additions or improvements. Each page of this written record should be signed and dated by you when you prepare it, should include sketches or drawings of your invention and should be signed and dated by one or more trustworthy witnesses who understand the invention, but did not participate in its development.

You may also file a provisional patent application, which will establish an early effective filing or priority date in a later-filed utility patent application. The utility application must be filed within one year of the provisional filing date in order to take advantage of this legal claim to priority.

If you disclose your invention to another party for commercial evaluation prior to filing a patent application, you should ask the other person to sign a non-disclosure

agreement, agreeing in writing not to disclose your invention to anyone else. Most businesses will insist that you execute an agreement under which the company does not agree that your invention is a trade secret, requiring you to rely solely upon any patent rights you may obtain in the invention. For this reason, it is advisable to contact a patent attorney in the early stages of the development of your invention in order to take the steps necessary to preserve your rights to your invention.

Is it necessary to hire a patent attorney to file a patent application?

An inventor has the right to prepare and file his or her own patent application. But a patent application is a highly technical document, and a person unskilled in this specialized area of law may not be able to obtain a patent that fully protects the invention. A do-it-yourself patent filing may be adequate if all you want is a sealed document to frame and hang on your wall. But if you plan to commercialize your invention, sell or license the patent, or if the need ever arises to enforce your patent rights, the other side will almost certainly be represented by an attorney who will look for weaknesses in your patent rights.

For this reason, the inventor should seek the advice of a patent attorney or patent agent, and have the attorney or agent prepare the patent application and communicate with the USPTO. Only attorneys or agents who have been registered to practice before the USPTO may represent others in the filing and prosecution of patent applications. Registered practitioners generally must have a science or engineering degree, as well as an understanding of patent law and USPTO procedural rules. The USPTO maintains a registry of all patent attorneys and agents. A patent attorney may also assist the inventor in other ways (e.g., conducting a patentability search on the invention, negotiating license terms, enforcement of a patent against infringement).

What about these invention marketing or promotion services I see advertised?

Some may be legitimate operations and provide useful services to their customers. Unfortunately, some are not, and will simply take your money and provide impressive sounding but worthless evaluations of the value of your invention. Even worse, in some instances their actions can harm the inventor's interest by publishing the details of an invention and creating prior art that prevents the inventor from ever obtaining a patent, or by filing ineffective patent applications.

The USPTO and the Federal Trade Commission receive complaints about fraudulent activities by such entities, but their ability to investigate and take action is limited. Further information can be found online at the USPTO's website (www.uspto.gov) and the Federal Trade Commission's website (www.ftc.gov).

What are the official fees for patent applications?

There are fees for filing an application, fees for issuance of the patent after it is granted and fees for maintaining a utility patent in force during its life, the amount of which is set by law. Individuals and small companies may pay half the set fee by filing the appropriate documentation. If the invention is assigned or licensed to a large company, the full fees must be paid. Additionally, the USPTO may raise fees periodically. The current fee schedule is available at the USPTO's website (www.uspto.gov).

May a patent be transferred?

Like personal property, a patent or patent application can be assigned by a written instrument. A patent or patent application may also be conveyed by operation of law, may be bequeathed by will or pass under the law when a person dies without a will.

An inventor or anyone owning a patent or patent application may assign the patent to a third party or may grant a license under the patent to make, use or sell the device covered by the patent. To be valid against third parties, the assignment of a patent should be in writing and should be promptly recorded in the U.S. Patent and Trademark Office.

How are patents enforced?

A patent owner must take the initiative to enforce their patent rights if they wish to stop an infringer. Patents are not self-enforcing, and neither the USPTO nor law enforcement officials will take action against an infringer. Patents are enforced by bringing a civil action for patent infringement in federal district court.

If an infringement lawsuit is successful, the court may require an infringer to pay damages to the patent owner for the patent owner's lost profits, or in the amount of a reasonable royalty. Enhanced damages of up to three times the patent owner's actual damages can be awarded in exceptional cases, such as where the infringement was willful. The court can also issue an injunction prohibiting further infringing activities.

Does my U.S. patent protect me against a copycat overseas?

Your U.S. patent protects you against a copycat overseas only to the extent that the overseas product comes to the United States. A U.S. patent gives you the right to exclude others from making, using, selling, importing or offering to sell the invention within the United States. So if a patented product is made in China and sold into the United States, a cause of action for infringement of the U.S. patent arises when it is sold here. But a U.S. patent cannot prevent a competitor from making a product in China and selling it in Canada.

Filing a U.S. patent application can give the applicant a priority right for filing later foreign patent applications under international treaties to which the United States is a party. For utility patents, foreign applications filed within one year of a U.S. filing are entitled to claim priority to the U.S. filing date. For design patents, the foreign applications must be filed within six months. There is also an international patent application system called the Patent Cooperation Treaty to which most industrialized countries are a party.

TRADEMARKS

What is a trademark?

A trademark is a word, device or symbol used by an individual or business to identify its goods or services and to distinguish them from others.

When a trademark is used in relation to services rather than products, it may sometimes be called a service mark. Trademarks and service marks identify the goods and services as coming from a single source, and consumers rely upon these marks to locate goods and services with which they are familiar. Thus, the business utilizing a trademark builds goodwill, or a reputation for quality that is immediately communicated to the consumer by the mark. In short, a trademark is a brand name.

How are trademark rights obtained?

Trademark rights are acquired by using a mark on goods or services in commerce. County or state registration of a corporate or business name cannot create trademark rights in that name. Generally, the first person to use a trademark is the first person to acquire rights to the mark.

Under current law, one can file an application to register a mark in the USPTO based on a bona fide intent-to-use the mark. Such an intent-to-use application cannot proceed to registration until the mark is in use in commerce. Once

the intent-to-use application matures into a registered mark, it will be granted national priority back to the original filing date of the application.

Who can own a trademark?

A trademark generally is owned by the person who owns the mark. That person can be an individual, sole proprietor, a general partnership, a limited partnership, joint venture, corporation, limited liability company, unincorporated nonprofit association or other legal entity.

How are trademarks protected?

State common law protects trademark rights as soon as the mark is used, but common law protection is generally limited to the geographic area of actual use.

State registration of trademarks used in Georgia may be obtained by filing an application with the Secretary of State for Georgia. After a trademark has been used in interstate commerce or a bona fide intention to use a mark is formed, one may file an application with the USPTO. Although federal registration is not mandatory, it gives notice to would-be innocent infringers throughout the United States, in addition to providing other advantages and rights to the registrant.

Please visit www.uspto.gov for more details on the federal registration process.

When can “®” or “™” be used with a trademark?

Prior to obtaining federal registration, the symbols “™” (for a trademark) and “SM” (for a service mark) can be used to indicate a claim of trademark or service mark rights in the mark. The federal registration symbol “®” may be used once the mark is actually registered in the USPTO. The federal registration symbol should only be used on goods or services that are the subject of the federal trademark registration.

Several foreign countries use symbol “®” to indicate that a mark is registered in that country. Use of the symbol by the holder of a foreign registration may be proper.

The proper manner to display either symbol is immediately following the mark in superscript style.

What are the rights of a trademark owner?

The reputation or goodwill of a business is a valuable asset of the business. The owner of a registered trademark may commence legal proceedings for trademark infringement to prevent unauthorized use of that trademark. The

law allows the trademark owner to stop others from using the same or similar marks for similar or related goods or services where consumers would likely be confused as to the true source of the goods or services. The owner of a common law trademark may also file suit, but an unregistered mark may be protectable only within the geographical area within which it has been used or in geographical areas into which it may be reasonably expected to expand. Also, in the case of very famous trademarks, protection can even extend to unrelated goods.

How can it be determined whether someone has a valid trademark?

In the United States, a trademark owner is not required to register the mark anywhere, so there is no single central list of them all. Because registration is not required, a trademark might be a protected mark even if it is not registered.

To avoid conflicts with earlier trademark rights, it is highly recommended to conduct trademark searches, which include search of the USPTO and various state offices. It may also be advisable to conduct a broader search as well, including databases that contain names of registered companies and also an Internet search to determine if the desired trademark is either already registered as a domain name or otherwise being used.

Even the most exhaustive search will not be conclusive. When selecting a new brand, it may be advisable to contact a trademark attorney to help determine whether a particular trademark is available for commercial use.

What are the criteria for selecting a strong trademark?

Words, slogans and drawings which merely describe characteristics or functions of goods are available for all to use and usually cannot be trademarks. The strongest marks are coined, arbitrary terms that have no descriptive meaning with respect to the product or service. Terms that suggest a product or a quality of the product can be protected as trademarks, but are generally not given as broad of a scope of protection as are arbitrary terms.

If, however, someone has been the sole user of a heavily advertised descriptive term for a substantial period of time, the term may then develop a secondary meaning, in that consumers view the term as an indication of the source of goods or services and be protectable as a trademark. Secondary meaning can never exist for the generic or common name of a product such as automobile for cars. Trademark rights may be lost if the public adopts

a trademark as a generic name for the product. This is exemplified in the former trademarks escalator for moving stairways and aspirin for pain pills.

Because selecting and protecting trademarks involve various legal requirements, an attorney familiar with trademark law should be consulted before a mark is first used.

How can it be determined whether a particular mark is available?

A search should be conducted before a word is used as a trademark to see if the proposed trademark is likely to cause confusion with someone else's trademark. Trademark searches should cover the existing federal registrations and pending applications in the USPTO as well as look for marks that are registered at the state level or are simply in use.

Does the use of a trademark in the United States create rights in foreign countries?

Trademark law is basically territorial, and trademark rights generally are confined to the country of the government that grants them. The owner of a U.S. trademark generally cannot stop others from using the same term in another country.

May a trademark be transferred?

A trademark registration or trademark application is like personal property and, along with the goodwill of the business in which the mark is used, can be assigned or licensed by a written instrument.

In various other countries a trademark may be sold with or without the underlying goodwill which subsists in the business associated with the mark. In the United States, where the courts have held that this type of transfer would "be a fraud upon the public," a trademark registration can only be sold and assigned if accompanied by the sale of an underlying asset or business. The assignment of a registered trademark or service mark should be promptly recorded in the USPTO.

The use of trademarks can be licensed to third parties. The licensor (usually the trademark owner) must monitor the quality of the goods being produced or the service being rendered by the licensee to avoid the risk of the trademark being deemed abandoned by the courts. A trademark license should therefore include appropriate provisions dealing with quality control.

How long do trademark rights last?

Trademark rights generally can last indefinitely as long as the trademark owner continues to use the mark to identify goods or services.

A trademark is a valuable business asset. Properly adopted, used and protected, it can last forever. Please consult a trademark attorney of your choice for specific information.

COPYRIGHTS

What is a copyright?

A copyright is a federally granted right to protect the owner of original works of authorship from unauthorized copying or performance.

How do you obtain a copyright?

Although copyright arises automatically when the work is created, a notice of copyright may be placed on the work when published. For example, the copyright notice on a book or work of art would include: the word Copyright or the symbol “©”, the year in which the work was first published and the name of the copyright owner. An example of an appropriate notice is: Copyright 1996 Sam Doe. Notice of copyright is not required for works published after March 1989 and the failure to give notice will not forfeit the copyright.

When does a copyright need to be registered?

The copyright can be registered either before or after the work is published. The copyright must be registered before a suit for copyright infringement can be brought and, for maximum protection, should be registered within three months after first publication.

How do you register a copyright?

Registration is obtained by applying to the Copyright Office at the Library of Congress. This procedure requires filing an appropriate application with the Copyright Office, along with the required fee and copies of the work.

What type of things can a copyright protect?

Copyright protection is designed to protect original works of authorship. The protection of the author goes to the form of expression embodied in the work and not to the concept or idea which the expression embodies. Ideas, names, titles and unoriginal works cannot be copyrighted. Some common examples of authorship include writings such as books, computer programs, written articles, catalogs, advertising copy and compilations of information. Visual works such as graphic art, paintings, photographs,

prints, maps, charts and technical drawings are also subject to copyright protection. Other examples of authorship include performing arts works in the nature of plays, songs, dance and motion pictures; and sound recordings such as phonograph records, tapes and CDs.

When does an employer own the copyright?

When a work is created by an employee within the scope of employment, the employer owns the copyright. The copyright in a commissioned work or a work created by an independent contractor, however, is generally owned by the creator of the work. If it is not clear whether a work is commissioned or made for hire, the parties should initially enter into a written agreement as to the ownership of the copyright.

What is the duration of a copyright?

The term of copyright for a particular work depends on several factors, including whether it has been published, and, if so, the date of first publication. As a general rule, for works created after Jan. 1, 1978, copyright protection lasts for the life of the author plus an additional 70 years.

For an anonymous work, a pseudonymous work, or a work made for hire, the copyright endures for a term of 95 years from the year of its first publication or a term of 120 years from the year of its creation, whichever expires first. For works first published prior to 1978, the term will vary depending on several factors.

May a copyright be transferred?

A copyright is like personal property and some or all rights may be assigned to another and the assignment must be in writing. A copyright may also be conveyed by operation of law, may be bequeathed by a will or pass under the law when a person dies without a will, although there are rules which give certain designated heirs rights which may not be varied by a will.

An author or anyone who owns one or more of the rights in a copyright may transfer that right by a written contract. While the transfer may be recorded in the Copyright Office, it is not required to make the transfer valid. It may be desirable to record the transfer in order to protect rights against third parties or to show legal title for enforcement of the copyright.

This pamphlet is published as a public service by the Intellectual Property Law Section of the State Bar of Georgia. It has been issued to inform, not to advise, and is based on laws in effect at the time of publication. For your specific situation, you should always seek counsel from an attorney.



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