OHIO STATE BAR ASSOCIATION

LAW FACTS

Connect. Advance. Succeed.

Intellectual Property

U.S. Constitution - Article I, Section 8, Clause 8: *"The Congress shall have power . . . to promote the progress of science and useful arts, by securing for a limited time to authors and inventors the exclusive right to their respective writings and discoveries."*

What is a patent?
A patent is a grant given to an inventor by the U.S. Patent and Trademark Office (PTO). The PTO issues the grant after considering and approving the inventor's patent application. A patent grants the right to exclude others, for a period of up to 20 years after filing an application, from making, using, offering to sell, selling or importing an invention.

The United States issues three kinds of patents. Most common are *utility* patents for new processes, machines, articles of manufacture or compositions of matter, or improvements to such processes or articles. *Design* patents protect the aesthetic or ornamental external appearance of articles of manufacture. Design patents are issued for a term of 14 years. *Plant* patents may be granted to anyone who invents or discovers and asexually reproduces any new variety of plant, including trees, shrubs and flowers. Exceptions to this general rule are tuber-propagated plants and plants that are found in an uncultivated state.

How do I obtain a patent?
To apply for a patent, you must file an application with the PTO. The subject matter of a patent must be new, useful and not obvious to a person of ordinary skill in the art. Your application must contain a detailed, written *description* of the invention; one or more *claims* that define the invention; and *drawings* of the invention when the subject matter can be drawn. Ordinarily, a novelty or prior art search is recommended to determine whether the invention has already been patented, described in a printed publication (e.g., a magazine, journal article, brochure, etc.) or used by someone else before a complete patent application is prepared.

Before March 16, 2013, to obtain patent protection within the United States, your application must be filed with the PTO within one year of the date the invention is first offered for sale, is first in public use or is first described in a printed publication. This is sometimes called the "one-year grace period." The law changes on March 16, 2013, and the "grace period" becomes much more limited. It is best to file a patent application as soon as possible, and advisable to file the application before public disclosure of the invention.

To obtain patent protection outside the U.S., you should recognize that foreign countries generally will not grant a patent if the invention was made public or described in a publication at any time before the date of the application. In short, most foreign countries do not have a grace period, so you must be sure to file your application before any of these public events. Eventually, you will have to file an application in each country or territory where patent protection is desired, although the Patent Cooperation Treaty can be used to facilitate the filing of applications in multiple countries.

How long will it take and how much will it cost to obtain a patent?
Answers to both questions vary widely depending on the technology or art involved, and on the complexity of the invention. The PTO's website at www.uspto.gov provides detailed information about the patenting process. Generally, you will need to wait at least two years to get a patent.

There are various costs associated with patents, including the cost of drawings, PTO filing fees, attorney fees, and maintenance fees to keep the patent in effect after it has been issued. Total costs vary widely, so you may wish to consult a patent attorney who can provide estimates after reviewing your invention and the art describing it.

What is a trademark?
A trademark is a word or words, an emblem, logo, symbol, slogan or other device that identifies goods or services from a single source. Many are famous, such as "Pampers®," a mark that identifies a disposable diaper coming from a single source to assure a customer of uniform quality.

The value of a trademark to its owner lies in the good will associated with the mark, such as consumer recognition and loyalty. Trademarks identify the source of goods, whether or not the source is known. "Tide®" is a trademark for detergent, although many people may not realize that the product's source is Proctor & Gamble.

When a mark is used in conjunction with services, it is referred to as a *service mark*. Unless otherwise indicated, the information about trademarks in this pamphlet also applies to service marks.

In the U.S, trademark rights are based on use (although it is possible to file a federal trademark registration application before use begins). If a mark is first used in connection with certain goods or services to promote sales, some trademark rights are automatically acquired, but only in the geographical area in which the mark is used. The resolution of disputes about who may use a particular trademark often depends on the date of the first use of the mark for similar goods in the same area, and the "priority date" giving "priority rights" to the first user.

Although not required, obtaining a federal registration through the PTO offers several advantages. For example, it provides a trademark owner with nationwide priority rights from the application filing date, provided that a registration is ultimately obtained.

How can I obtain a trademark registration?
You can obtain a federal trademark registration by filing an application with the PTO based upon actual use or an intent to use the trademark. You may file an application after the goods bearing the mark or services associated with the mark have been sold or transported in interstate or foreign commerce. Also, you may file an *intent to use* application for registration with the PTO even before the mark is in use, but registration will not be granted until the mark is shown to be in actual use. The owner of a registered mark is entitled to place the notice, "Reg. U.S. Pat. & TM Off." or "®" adjacent to the mark to indicate such registration. Federal trademark registrations are granted for a fixed period of years, but generally, trademark rights last indefinitely, since you can renew the registration as long as the mark remains in use.

Before you use a mark or file an application to register the mark, you should perform a search to determine whether the mark is available. The process is quicker and cheaper than that for obtaining a patent, but you may want to get an estimate of both time and expense from an attorney with expertise in trademark registrations.

Because of their nature, some words or phrases, such as generic or merely descriptive, obscene, and deceptively misdescriptive words, cannot be registered or protected as trademarks. Thus, businesses should not select marks that merely describe the goods ("Honey Roast" for honey roasted nuts) or generic terms ("Bananas" for bananas). Instead, businesses should select marks that are arbitrary or fanciful.

For example, “White Castle®” for fast food, “Irish Spring®” for soap, and “Gold Wing®” for motorcycles are strong marks providing broad protection, because they do not describe the goods.

In addition to the federal registration of marks discussed above, most states, including Ohio, provide for state registration of marks. State registrations do not provide the same rights and benefits as federal registrations.

To obtain trademark protection outside the U.S., you may file for registration in any country where you want to use your mark, or you can use a U.S. federal application or registration to help in obtaining trademark protection in the many countries that are members of an international agreement known as the Madrid Protocol. Every country has its own system for protecting marks and does not recognize the intellectual property rights granted in other countries. Even so, under various treaties, if an applicant has already filed a U.S. application to register a trademark and then seeks to file an application for the same trademark in a foreign country, some foreign countries will apply the U.S. application’s filing date to the foreign application if the U.S. application was filed in the last six months. This at least allows the foreign application to be given the same priority date as the U.S. application.

How does a trade name differ from a trademark?
Unlike a trademark or a service mark, a trade name is used to identify a business rather than any particular goods or services. If you register a trade name with the Ohio Secretary of State, your company can “do business” under that name within Ohio, but you still must make sure the name does not infringe another’s trade name, trademark or service mark. Registering a trade name is not a guarantee that you can use the name in connection with goods or services.

What are copyright rights?
Copyright rights protect the particular fixed expression of an original work of authorship. It protects, for example, an artist’s specific painting of a sunset scene, not the broad concept of sunset scenes. The owner of a copyrighted work has the exclusive right to reproduce, modify, distribute, perform or display the copyrighted work and to authorize others to do the same. This right exists from the moment the work is created and is fixed on some type of tangible media, such as paper, film, tape, computer disk, etc. No further action is required to obtain copyright rights. However, further action is needed to register copyright rights.

Many different types of works of authorship may be protected by copyright. Some examples are books, movies, television shows and even software (computer programs).

How can I register my copyright rights?
Federal registration of copyright rights provides advantages, including the ability to bring a copyright infringement lawsuit in federal court. In contrast with patent and trademark applications, which are both filed in the PTO, copyright registration applications are submitted to the Copyright Office, which is part of the Library of Congress. The Copyright Office website at www.copyright.gov provides detailed information about the registration process. With your application, you usually need to send a specified number of copies of your work along with material identifying the work and a minimal fee. The copyright registration process is generally far less expensive than the trademark or patent process.

How long does copyright protection last?
Copyright protection extends for many years. U.S. copyright rights for works created after Jan. 1, 1978 (effective date of the current Copyright Act), will last until 70 years after the author’s death. For “works made for hire” and for certain anonymous and pseudonymous works, copyright protection lasts for 95 years from first publication or 120 years from creation, whichever is shorter. Works created before 1978 are subject to different rules, including rules which effect the duration of the copyright protection.

Do I need to use a copyright notice?
For works created after 1977, the copyright notice is not mandatory. However, it is a good idea to use a copyright notice on your work to let everyone know that the work should not be copied without permission. For most works, an example of copyright notice is “©Jane J. Doe 2012”; or in the case of sound recording, “℗Doe Records, Inc. 2012.”

Are works on the Internet protected by copyright?
In a short answer, yes. Copyrighted works cannot be copied without authorization. Posting a copyrighted work itself is prohibited unless authorized (such as posting a copyrighted movie on YouTube or hosting/downloading songs on Torrent sites). The Digital Millennium Copyright Act of 1998 (DMCA) includes take-down provisions that may force operators of websites to take down content from a website if the copyright owner notifies the website operator. The website host also must advise the person posting the content that the content has been taken down as a result of this notification. The poster can, however, refute the take-down notice if he or she believes, in good faith, that it was improper. If the web poster refutes the take-down notice, the website host must advise the copyright owner, and the copyright owner must then file suit against the web poster in order for the content to remain offline. If the copyright owner does not file suit, then the website host must restore the posted content.

Can “inventor assistance” or “invention development” organizations help?
There are many companies, usually with toll-free numbers, that offer to evaluate, develop or market inventions for a fee. You should carefully investigate such organizations before doing business with them. For assistance, visit the websites of the PTO, Federal Trade Commission, and consult with an attorney with expertise in intellectual property law.

Attorneys who work with patents, trademarks and copyrights help people protect their rights in intellectual property. Ohio attorneys are licensed to practice law by the Supreme Court of Ohio. Patent attorneys are also licensed by the PTO. They are subject to strict ethical rules.

Are patent, trademark and copyright attorneys available locally?
Yes. Numerous patent, trademark and copyright attorneys practice in Ohio, including those who focus on litigation in these practice areas. To locate an intellectual property attorney, contact the Ohio State Bar Association at 800-282-6556 or www.ohiobar.org.

03/10/2012

Funding from the Ohio State Bar Foundation

This is one of a series of LawFacts public information pamphlets. Others may be obtained through www.ohiobar.org/LegalHelp

The information contained in this pamphlet is general and should not be applied to specific legal problems without first consulting your own attorney.