

Facts and Fallacies

Patents

A Patent is Necessary to Market an Invention

The inventor inherently has all the rights to do as he pleases with his invention. Without the protection of a patent, however, everyone else also has the same rights to the invention.

A Patent Will Stop or Prohibit Others

A patent is not a magic wand, which will automatically make others go away. A Patent grants the holder the “right to exclude others...”. This generally requires some type of positive action on the part of the patent holder. Enforcing patent rights may ultimately involve legal action.

A Foreign Patent is Necessary to Prevent Importation into the United States

A United States patent grants the holder “the right to exclude others from the use, sale or manufacture of the patented invention within the United States”. Any one of these three activities constitutes patent infringement.

I'm Protected

The law is very specific in that the only protection for an invention is an issued patent. All other activities and measures are simply partial safeguards.

Confidential Disclosure Form Provides Limited Protection

A confidential disclosure form simply impresses the recipient with the fact that proprietary information is being received. If the recipient discloses to others, the recourse is civil action. No protection is afforded the invention and, indeed patent rights may be lost.

A Registered Letter is Proof of Invention

An envelope with a dated postmark is not sufficient to prove date of conception. It cannot be proven when the disclosure was placed with in the envelope. The dated signature of the inventor and of two reliable, impartial witnesses upon a disclosure document can provide viable testimony.

Notarized Disclosure Document Not Sufficient

Notarization certifies the signature of the signer. It has no bearing upon the disclosure. Further, the inventor is considered a poor witness in his own behalf.

United States Patent Office Document Disclosure Program

The program records the date of receiving the document as a form of establishing the date of conception. Conception is only the initial stage of making an invention and pursuing protection. Documents are retained for a period of two years. Without further action on the part of the inventor, patent rights can still be lost.

Legal Inventorship

Inventorship is established when one has conceived an idea and reduced it to practice. Both activities are necessary to establish inventorship. Reduction to practice can be either actual, such as making a prototype; or constructive, such as filing a patent application.

Establishing First Right

The United States Patent and Trademark Office will grant priority to the inventor who “first conceived and reduced to practice with diligence to the filing of an application.” It is, therefore, recommended that the inventor keep good records.

Test Marketing

United States Patent Law provides that an application can be filed within a twelve-month period from first public disclosure. However, marketing a product without a notation indicating patent pending status is an invitation for others to copy or engage in parallel development.

Public Disclosure

In general, a public disclosure is one in which the inventor is seeking gain from the invention. This can be monetary from the sale of the product; or, intangible where no product in fact exists. Even a gift qualifies under law as “known or used by others.” One year from the date of public disclosure, if no application has been filed, the invention is considered to be dedicated to the public.

Confidential Disclosure

Broadly interpreted, a confidential disclosure is one in which the inventor is seeking help. This help may be in the form of assistance in product development, financial backing, conferring with a patent practitioner or other similar activities. An executed confidential disclosure form is recommended to guard against implications of public disclosure.

A Patent is Necessary for Legal Protection

Usually, a patent is necessary only for the enforcement of rights. Statistically, less than one-half of one percent of all patents are infringed. During the pending stage of an application it may held in secrecy, thereby keeping others in a state of suspense while maintaining a flexible position for the inventor. An issued patent is a public document and can provide a target for others to design around. Therefore, it is critical to consider all alternate embodiments and include them in the patent application in order to build a “defensive perimeter” around the invention.

Inventorship

Inventorship pertains to anyone who has had inventive input into the invention. This is distinguished from the input of an ordinary technician. Each inventor, no more – no less, must execute the patent application or serious consequences, such as the resulting patent being held invalid, can result.

Ownership

A portion or all of the right, title and interest in a patent or application can be assigned to another in exchange for consideration. Consideration can be anything of value, such as money, assistance or love.

Beneficial Interest

All or a portion of the gains from a patent can be assigned to another without effecting ownership of the patent rights.

Invented Something New or Improved

The system allows for patenting of improvements. The current space shuttle is a continuing series of one-at-a-time improvements over the Wright Brothers flying machine, patented in 1906.

My Inventions Uses Known Components

The ordinary household scissors consists of two knives and a screw. Both components were old and well known. Yet, the scissors, at time of invention, was patentable. The inventor knew which components to select and where to drill the hole for the screw.

Patenting an Idea

Ideas are simply thoughts. As such they are not patentable. The idea must be reduced to a physical embodiment that the inventor can teach to another. Section 112 of the Patent Law states, in part, "...in such clear and precise terms as to enable one skilled in the art to understand and practice..."

Structure – Function

Structure is what it is. Function is what it does. Patents are granted for structure. Function serves as the supporting argument that the structure is patentable. A coffee cup is structure used for a specific function. In reality, a coffee cup is an upstanding, continuous sidewall with a closed bottom and an open top. It can also function as a flowerpot, a piggy bank or any other imaginative purpose.

Patented Products on Market

Just because it is patented does not mean it is on the market. Over 6,000,000 patents have been issued. The Patent Office estimates that approximately 600,000 products have resulted. In other words, one in ten patented inventions have been commercially successful. For every product seen, nine more exist only as a description in a patent lying idly in the Patent Office.

The Invention is Too Simple

Simplicity is not a criteria for patentability. Neither does it imply that the invention comprises a part of the known state of the art. It all depends upon the creative thought process.

No Minimum Percent Change is Necessary for Patentability

Mathematically, the percent of something can be determined by weight, volume, size or other standard. No such criteria exists within the patent system. The standard is “what would have been obvious to one of ordinary skill in the art at the time the invention was made.”

An Improvement to Something Old and Well Known May Be Patentable

In a sense, every invention is similar to something that came before. If the invention, no matter how minor, involves a structural change and enhances the function or utility of the prior art, it may be patentable and commercially valuable.

Is a Patent Search Necessary

The law does not require that an inventor conduct a patentability search prior to filing a patent application. In fact, under certain circumstances, it is recommended that a search not be conducted. This is dictated by the inventor’s intended route to commercializing the invention. It is suggested that the inventor consult with a professional patent practitioner to determine the desirability of conducting a search.

Filing a Patent Application Need Not Be Exceedingly Expensive

As the result of a new law, which took effect in 1995, the inventor can file a simplified patent application. With minimum guidance, the inventor can write his own application. The government filing fee is \$100. This is what is known as a Provisional Application for Patent. It establishes a priority date in the United States Patent and Trademark Office and bestows the legal use of the “patent pending” label. Within a year it must be converted to a regular patent application. For a little of his time and a \$100 filing fee, the inventor has a year to test the marketability of his invention.

Manufacturers Will Pay Only for Patent Rights

Manufacturers reward inventors – enter into license agreements - in exchange for patent rights, whereby the manufacturer has a monopoly to produce and market a product which cannot then be produced by the competition. If no patent exists or an application has not been filed, then no monopoly exists and the invention belongs to whomever it has been disclosed. A company will not compensate an inventor for that which is already known and in which the inventor has no rights.

Contacting a Manufacturer

It is general policy that most manufactures will not accept confidential disclosures. In fact, most utilize a company submission document to be executed by the inventor and emphasizing the fact that if an application has not been filed, submission is denied. This also protects from conflicts where the company is concurrently working on a similar product. Before submitting your invention, contact the company for a copy of any submission policy.

Will a Big Company Will Rip Me Off

Not likely. Statistically, one-half of one percent of all patents are involved in litigation. Usually, this is one large company beating up on another large company. Both

are generally respectful of the rights of individuals and small companies. Neither wishes to alienate the customer base. Also, as a practical matter, consider the perspective of a jury of common folks deciding the outcome of a trial between a big, monster company and a poor, hapless little inventor.

Invention Marketing Organizations

Radio and television frequently broadcast commercials which ask, “Do you have an idea for a new product, or even an idea for improving an existing product?” The commercial then offers assistance in “presenting the idea to manufacturers.” The cost for such service ranges from approximately \$5000 to over \$20,000. These companies cannot do anything that the individual inventor cannot do for him/herself. In fact, with little guidance from a licensed patent professional, the inventor can do an infinitely better job for usually less than \$300.00.

Foreign Rights

Most foreign countries have an “absolute novelty” requirement. Any public disclosure prior to the filing of an application results in the loss of rights. However, because of certain treaty agreements, an inventor can claim priority to the filing date of the United States application if the foreign application is filed within one year thereafter. A public disclosure made in the interim is superseded by the priority date.

Trademarks

What is a Trademark

A trademark is identification of a product, which can be a word, phrase, symbol, design, or a combination thereof, which is used to distinguish the goods and/or services of one party from those of other parties. A trademark can also be a color, a smell, the shape of a product, and even a sound.

What is a Service Mark

A service mark, which may be referred to simply as a trademark, is used in conjunction with services, rather than goods. For instance, a trademark is used in conjunction with packaged potato chips, whereas a service mark is used in conjunction with retail services offering the potato chips for sale.

Difference among Trademarks, Patents and Copyrights

A trademark is a brand that identifies the source and original of goods and/or services. A patent protects an invention. A copyright protects an original work of an author or artist.

Obtaining a Trademark

A trademark is obtained by either establishing legitimate use of the trademark, or obtaining a federal trademark registration. A trademark that is used in commerce and not registered with the U.S. Trademark Office is a common law mark. A trademark that is registered with the U.S. Trademark Office is a registered trademark.

Registering a Trademark with the U.S. Trademark Office

Registering a mark is not necessary. However, federal registration provides several important advantages, including 1) constructive notice to the public of the registrant's claim of ownership of the mark, 2) a legal presumption of the registrant's ownership of the trademark and use of the trademark throughout the United States, 3) the ability to bring a trademark infringement action in federal court, 4) the use of the U.S. registration as a basis for obtaining registration of the trademark in foreign countries, and 5) the ability to file the registration with the U.S. Customs service to prevent the importation of counterfeit goods.

Life of a Trademark

If a trademark registration is properly renewed at the required times, the life span is indefinite.

U.S. Trademark Office Enforcement of Trademarks

The U.S. Trademark Office reviews trademark applications for federal registration. After a trademark is registered, it is the responsibility of the trademark owner to enforce the trademark. The U.S. Trademark Office does not conduct trademark searches for the public, comment on the validity of trademarks or whether a particular trademark is eligible for registration, or offer legal opinions about trademarks and trademark infringement claims.

Trademark search before using a trademark or registration

A search is not necessary but it is a prudent step to take so that it can be determined whether a trademark is available to be taken. A trademark search is an important step in not only the proper acquisition of a trademark, but also the eventual enforceability of a trademark. A good trademark search clears potential marks for use or registration, reveals state and unregistered common law trademarks in addition to pending and registered federal trademarks, supports trademark litigation involving third party usage and provides a meaningful determination of the potential strength of a mark.

Register a Domain Name

A domain name can be registered with the U.S. Trademark Office after it has achieved secondary meaning. This means that the general consuming has associated the name with a particular goods or services.

Importation of Infringing Material

After the work is registered with the U.S Trademark Office, it can registered with the U.S. Customs Service for protection against importation of infringing material.

Copyright

Copyright an Idea

Copyright does not protect ideas, concepts or methods of doing something. For copyright protection the original work of authorship must be fixed in a tangible medium of expression.

Poor Man's Copyright

The practice of mailing a copy of your work to yourself is often referred to as "poor man's copyright." There is no provision in copyright law regarding any such protection.

Copyright or Trademark

Copyright protects original works of authorship or artistry. Trademark protects words, phrases, symbols or designs identifying the source of goods or services.

Register to Have Protection

Original works are protected by copyright immediately upon being created and fixed in a tangible form. The author or artist may immediately affix the copyright notice.

Registration is Necessary

It is not necessary to register a work of authorship or artistry. Registration is necessary, however, before bringing suit for infringement. Registration also provides public notice and is considered *prima facie* evidence in a court of law.

Only the Creator of a Work Can Register a Copyright

Where the creation was a work for hire or is otherwise legally owned, the owner is considered the author for purposes of registration.

Ten Percent Change and the New Work is Mine

Any work which carries forward the flavor, theme or ambience of a prior work is considered to be a derivative work. A derivative work is an infringement of a prior work unless owned by the same author. A stature resembling a figure in a prior painting is considered a derivative work.

Copyright the Title of My Book

Copyright does not protect names, titles, slogans or short phrases.

Copyright My Website

The items of original authorship, such as writings, artwork and photographs, appearing on a website may be protected by copyright.

Copyright My Domain Name

Copyright law does not protect domain names.

Protect a Building

Copyright protection extends to any architectural work including the design of a building, the building, architectural plans and drawings.

Copyright Must be Periodically Renewed

A copyright lasts for the life of the author plus an additional seventy years and may be renewable.

Importation of Infringing Works

After the work is registered with the Copyright Office, it can be registered with the U.S. Customs Service for protection against importation of infringing copies.

Use Without Permission

Under the *fair use* doctrine of the U.S. Copyright statute, it is permissible to use limited portions of a work including quotes, for purposes of teaching, commentary, criticism, news reporting and scholarly reports.