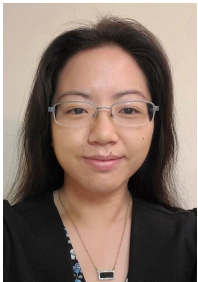


EXPERT OPINION

Patents, trademarks and copyrights, oh my! Choosing the right form of intellectual property protection

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Have you invented a new and useful product?

Consider protecting it by applying for a patent application or keeping it a trade secret.

Are you starting a business and building a brand?

Consider protecting your brand with a trademark.

Do you create art for yourself and/or others?

Consider copyright protection and carefully review legal agreements before accepting commissions.

Understanding the differences between patents, trademarks, and copyrights is essential for protecting your intellectual property ("IP") (additional forms of IP include design patents, trade secrets, trade dress, etc.). This article discusses the basics of patents, trademarks, and copyrights, including certain myths associated with each one.

COPYRIGHT

What is copyright? A U.S. copyright protects original works of

authorship. A work is original if it is independently created by the author and has a minimal degree of creativity. This protection applies as soon as an author fixes the work in a tangible form of expression. A work is fixed when it is sufficiently permanent to permit it to be perceived, reproduced, or communicated for more than a short time. For example, a book, musical composition, play, photograph, illustration, painting, movie, sound recording, architectural work, etc.

Who owns the copyright? Generally, the author of a work is also the copyright owner. However, works created by an employee within the scope of employment, i.e., "works made for hire," are owned by the employer. Additionally, copyright can be transferred by an assignment, will, bequest, etc.

Does the copyright need to be registered? A copyright must be registered in order to file a federal lawsuit for infringement. Otherwise, registration is not mandatory, e.g., the copyright symbol © can be used even if the work is not registered.

Copyright Myths:

- Educational use is always fair use. False; there is no blanket exemption.
- If I'm not making money, it's not copyright infringement. False; non-commercial use can still infringe copyright.
- I gave credit, so I can use it. False; Attribution does not equate to permission.

TRADEMARK

What is a trademark? A U.S. federal trademark, or service mark, can be a word, phrase, symbol, design, sound, color, or combination that identifies the source of goods or services and is used in connection with those goods or services in interstate commerce. Trademarks can be used to build consumer trust, promote brand recognition, and prevent consumer confusion as to the source of the goods or services.

How do I choose a trademark? Generally, trademarks are classified by their distinctiveness into five categories:

- Fanciful, Fanciful marks are very strong; they are made-up words created solely as a trademark, such as "Kodak" or "Xerox."

- Arbitrary marks are strong; they use a common word in an unrelated context. Think “Apple” for computers.
- Suggestive marks are moderate; they suggest a quality or characteristic but require some imagination to connect it to the goods or services such as “Coppertone” for sunscreen and tanning products.
- Descriptive marks describe an ingredient, quality, characteristic, function, feature, purpose, or use of the goods or services and can be registered with the United States Patent and Trademark Office if it is capable of being a source identified and if there are no other conflicting marks – e.g., “American Airlines” for air transport of passengers and freight.
- Generic marks are common names for goods or services and cannot function as a trademark.

When can I use the trademark symbol? The TM and SM symbols can be used for goods and services, respectively, even if you haven’t filed an application to register your trademark. The ® symbol can be used once you have a federal registration for your trademark or servicemark.

Trademark Myths:

- I have to register my trademark before I have any rights – False; trademark rights in the U.S. can arise from using a mark in interstate commerce.
- Adding a disclaimer avoids trademark infringement – False; disclaimers do not automatically eliminate consumer confusion.
- I registered my trademark, so nobody else can use it – False; a trademark gives the owner the ex-

clusive right to use that word (or other mark) as a trademark for the specified goods or services; the word (or other mark) may be used by another for different goods or services as long as such use is unlikely to cause confusion.

PATENT

What is a patent? A U.S. patent can be used to protect novel and useful inventions (utility patent), plants (plant patent), and designs of products (design patents). A patent gives the patent owner a right to exclude others from making, using, offering for sale, or selling an invention or importing it into the U.S.

How do I know if my invention is patentable? Generally, a patentability search will help inform an inventor if their invention is patentable. An invention must be directed to patent-eligible subject matter (e.g., a machine, a process or method, a manufactured article, a composition of matter, or an improvement to one of these), novel (e.g., it cannot have been publicly disclosed before the filing date of your application), non-obvious (e.g., a combination of public disclosures that pre-date the filing date of your application must not render your invention obvious to a person having ordinary skill in the field of your invention), and it must be useful (e.g., it must have a specific, credible, and practical use).

When should I apply for a patent? Before any public disclosure is made to ensure patent rights are preserved. Although the U.S. has a one-year grace period, meaning you may make a public disclosure within 1 year before the filing date of your application and such disclosure cannot be used against you, several jurisdictions

around the world operate on an absolute novelty basis, i.e., any public disclosure will destroy novelty and render the invention unpatentable.

Patent Myths:

- I have a patent; therefore I can make, use, sell, etc. my invention. False; a patent does not give the patent owner a right to practice, rather, it gives a right to exclude others from practicing.
- Patenting is only for large companies – False; patents can be very useful to individual inventors, startups, universities, small businesses, etc.

KEY TAKEAWAY

Strategies to protect your intellectual property will often include a combination of the different types of IP discussed above, as well as other types of IP. For example, an entity may apply for a federal trademark to protect their name and build their brand while simultaneously applying for a copyright for a logo design and filing a patent application if the product is a new invention. There is no one-size fits all approach to a comprehensive IP protection strategy.

IP (including ownership of the same) can sometimes be overlooked by individuals, in the early stages of forming a business, etc. However, it is crucial to develop an IP strategy early on to preserve the appropriate IP rights.

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