

# COMMONLY ASKED QUESTIONS CONCERNING INTELLECTUAL PROPERTY PROTECTION

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## **1. What is the difference between a design patent and a utility patent?**

A utility patent covers the concept or idea behind a device or process, whereas a design patent protects only the appearance of the article. After issuance, a utility patent has a term of 20 years from the date of filing. A design patent is good for 14 years from the date it issues. A design patent application consists primarily of a drawing, whereas a utility patent application includes drawings accompanied by a detailed text and carefully written claims.

## **2. What are the three requirements for patentability?**

The invention must be new, useful and non-obvious. Most patent applications are rejected on the ground that the invention would have been obvious to an imaginary person skilled in that particular area of technology who is aware of all printed material and patents that have ever been published relating to that particular field.

## **3. If I develop a new idea, must I apply for a patent before I begin selling my product?**

No. Although sales or other public disclosures of your invention prior to filing a U.S. patent application can

cause the loss of foreign patent rights, you may file a U.S. patent application within a year of your first sale, offer for sale, or other public disclosure, whichever occurs first.

**NOTE: The U.S. will change the underlying rule to a system rewarding the first to file in March 2013. Therefore, it is important that you consult with a knowledgeable patent attorney to discuss this issue if you plan to file an application around or after that date.**

#### **4. How long does it take to get a patent after I apply?**

Although some patents issue within a few months, a typical patent takes between 1 and 4 years to issue, assuming it is ever granted. Some patent applications have remained pending for decades (although the U.S. Patent Office is discouraging such practice).

#### **5. Can I apply for a patent without going through an attorney?**

Yes. Several publications exist to assist inventors in filing their own patent application, including “The Inventor’s Notebook” by Fred Grissom and David Pressman and “Patent It Yourself” by David Pressman. (Nolo Press Books, Berkeley, CA 94710.)

#### **6. Is it possible to obtain a patent for an improvement made on a device or process which has already been patented?**

Yes. The issues of patentability and infringement are entirely separate. Therefore, one may obtain patent protection for an improvement to a device, yet, to build the improvement and market it in conjunction with the original device would infringe the original patent.

**7. If I find out that someone is infringing my patent, what will the Patent Office do to protect my rights?**

Nothing. The Patent Office plays no role in discovering or prosecuting infringers of valid U.S. patents. The patent owner is entirely responsible for bearing the burden and expense of protecting his or her patent rights.

**8. If two people invent the same thing independently, does the first person to file a patent application receive the patent?**

Not necessarily. If two patent applications are filed claiming the same subject matter, the Patent Office begins a special proceeding, known as an “interference,” in order to determine who was the first actual inventor. Factors considered by the Patent Office in determining who receives the patent include (i) the first to conceive of the invention; (ii) the diligence with which each inventor attempted to reduce the idea to practice; and (iii) who was the first inventor to actually reduce the invention to practice.

NOTE: Interferences will be phased out as the U.S. changes to the first to file system in March 2013. After that date, the first person to file the application with the Patent Office will be granted the patent – subject to a limited grace period if the first inventor publicly discloses the invention.

**9. Do most people who receive patents end up making money on them?**

No. A patent is issued for any idea that is new, useful, and non-obvious. The issuance of a patent is not an indication that there is any reasonable commercial use for the invention and/or that the invention will be commercially successful.

- 10. If I develop a new product and begin selling it without applying for a patent, can't someone else obtain a patent on the idea and prevent me from making my own product?**

No. Only the original inventor may apply for a patent.

- 11. Can more than one person be named as the inventor in a patent?**

Yes. Multiple inventors are quite common, and indeed, it is a legal requirement that all contributors to the inventive concept claimed in the patent be named as inventors.

- 12. If one of my employees invents something in the course of his duties, can I apply for the patent?**

No. Only the true inventor can apply for a patent. However, if the employee develops the invention as part of his or her job duties, the employee generally has a legal duty to assign the entire right in the invention to the employer.

- 13. If I develop a new, useful and non-obvious method of making something that is already known, can I obtain a patent on the method only?**

Yes. Method or process patents are quite common, especially in the fields of chemistry, materials and data processing.

- 14. If I have a United States patent on some particular apparatus or device, can I prevent someone abroad from making the device and exporting it for sale in the United States?**

Your United States patent will not permit you to prevent someone from manufacturing or using your device abroad, but will prevent the device from being sold or used in the United States, regardless of where it is manufactured.

**15. Can I obtain trademark protection without registering the trademark?**

Yes. Trademark rights are based on the extent of actual use of a mark in commerce, but the federal trademark registration is prima facie evidence of use of the mark throughout the United States.

**16. Can I reserve a trademark that I intend to use in the future but have not yet actually begun using?**

Yes. By filing a federal trademark application along with the required “intent to use” statement.

**17. If I reserve a corporate name with the Secretary of State, does that give me trademark rights in that name?**

No. A corporate name can never take on trademark status until that name is used in association with specific goods and services.

**18. If I am using a trademark that is not identical to someone else’s trademark, can I still be guilty of trademark infringement?**

Yes. Trademark infringement occurs whenever two trademarks are “confusingly similar” to each other. Thus, if the two trademarks are similar enough to confuse the average consumer as to the origin of the products or services, then trademark infringement has probably occurred.

**19 If I obtain a state trademark registration, does that registration guarantee that I have exclusive rights to use the trademark in that state?**

No. State trademark laws vary from one state to another, but generally the state performs only a cursory examination to determine if your mark is similar to other marks registered in that state. Some states perform no examination whatsoever, and it is quite possible to obtain a state trademark registration for a trademark that is identical to an already existing federally registered trademark. In such a case, a state trademark registration is of little or no value.

**20. After I create some literary or artistic work, what do I have to do to obtain a copyright on my creation?**

Nothing. Copyright protection attaches at the moment the work is fixed in tangible form (e.g., written down). In order to preserve your copyright, you should (but are no longer required to) mark it with a copyright notice, which includes the word “copyright” and or the symbol ©, the year of creation, and your name. Therefore, an appropriate copyright notice could appear: © 1996 William Smith.

**21. Why would I want to register a copyright if copyright protection comes into being automatically when I create the work?**

Registering a copyright offers procedural advantages if you should ever attempt to prevent the unauthorized copying of your work. Copyright registration may be accomplished by filling out a form available from the register of copyrights, Library of Congress and submitting it along with appropriate specimens and official fees (usually \$35 - \$65).

**22. If I manufacture a product by a secret process and one of my customers discovers that process by analyzing the product, can I recover damages for the theft of my trade secret?**

No. A trade secret loses its status as a secret if it can be discovered by members of the public by inspection and analysis of the product. No action may be taken against anyone discovering the trade secret by such methods.

**23. What is the address, telephone number and website for the Copyright Office?**

Copyright Office Library of Congress  
101 Independence Avenue, S.E.  
Washington, D.C. 20559-6000  
(202) 707-3000  
[www.copyright.gov](http://www.copyright.gov)

**24. What is the address, telephone number and website for the U.S. Patent and Trademark Office?**

General mailing address for patents:  
U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

General mailing address for trademarks:  
Commissioner For Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

Current physical location:  
U.S. Patent and Trademark Office  
Randolph Building  
401 Dulany Street Alexandria, VA 22314  
[www.uspto.gov](http://www.uspto.gov)