

Patent and Trademark Basics: A Guide for Small Businesses

Presented by:

Pina M. Campagna, Esq.

Carter, DeLuca, Farrell & Schmidt, LLP

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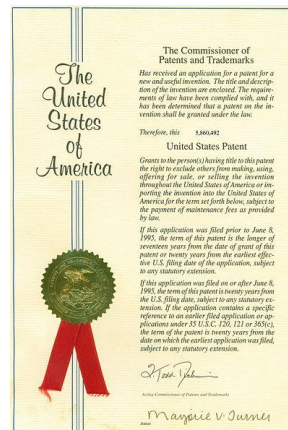
Intellectual Property Counsel

Overview

- Key points to consider regarding patents
- Key points to consider regarding trademarks
- Questions?

What is a Patent?

- The right to exclude others from making, using or selling a particular invention
- Any “process, machine, manufacture, or composition of matter” may be patentable
- Inventions must be useful (industrial applicability), novel, non-obvious (inventive step)



Benefits of Patents

- Protect/increase market share
- Increases the value of your company
- Enforceable when granted
- Attracts private investment
- Opens up licensing opportunities

Obtaining Patent Rights

- Patent rights are only enforceable where they are granted
- Must obtain patent protection in each individual country (different ways)
- To obtain patent protection outside the U.S., you must file an application before public disclosure (absolute novelty)

Options for Obtaining Patent Rights

- File an application under the Patent Cooperation Treaty (PCT), which covers about 180 countries.
- File an application in a regional patent office (e.g., EPO)
- File an application directly in the patent office of each country where patent protection is desired (e.g., US, DE, UK, FR, AU, CN)

Factors to Consider

- Time
- Cost
- Where would patent protection provide value?
 - Where manufactured and sold?
 - Where are competitors?
 - What is the technology?

What is a Trademark/Service mark?

- Word, name, symbol or device (or any combination thereof)
- Identifies the source of goods and services to consumers
- Protects consumers from confusion
- Establishes market recognition for owners



What is a Trademark/Service mark?

- Examples:

- BIG MAC®
- Shell Design
- THE ULTIMATE DRIVING MACHINE®
- COCA-COLA bottle
- AMERICAN EXPRESS®



- Non-traditional marks

- Sounds, smells, colors, color combinations or shapes
 - What can BROWN do for you?
 - NBC® chimes 

Selecting a Trademark

- What works?

- Arbitrary



SUN

- Fanciful

Canon **Kodak**

- Suggestive



Selecting a Trademark

- What doesn't work?
 - Descriptive- PATENTS.COM
 - Geographic- KUBA KUBA
 - Surnames- SMITH
 - Generic- ELEVATOR
- Acquired Distinctiveness/ Secondary Meaning
 - FORD®, BLUE RIBBON®, GOLD MEDAL®

Selecting a Trademark/ Clearing a Mark

- Preliminary clearance/ Knock out search-
At the very least
- Extensive searches
- Lack of knowledge is not a defense

Establishing Rights in a Trademark

- Use/ Common law rights

TM

SM

- Federal registration



Benefits of Federal Trademark Registration

- Exclusive nationwide ownership of the trademark
- Notice and Deterrence
- Presumption of validity
- “Incontestability”
- Potential to recover treble damages and attorneys’ fees in infringement suit
- US Bureau of Customs and Border Protection

Protecting Trademarks Internationally

- Protection of trademark limited to country obtained
 - United States- Rights based on use
 - Outside the US- First to file gets rights

Two options:

- File directly in each country (e.g., US, DE, AU)
- File in multiple countries with a single international application
 - Madrid Agreement/Protocol
 - Regional (e.g., CTM)

Conclusion

Patents

Consider pursuing patents for the key technologies of your company

At the very least, perform a patentability and/or freedom to operate search

Trademarks

Consider pursuing trademark registrations for key brands of your company

At the very least, perform a clearance search

The difference between investigating your patent and trademark exposure and opportunity before launching an international campaign could mean the difference between enhanced profits and unnecessary legal hassles.

Thank You

"I have been impressed with the urgency of doing. Knowing is not enough; we must apply. Being willing is not enough; we must do." – Leonardo da Vinci

Pina M. Campagna

Carter, DeLuca, Farrell & Schmidt LLP

pcampagna@cdfsllaw.com

631-501-5716