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Protect Your Investment: Don't Miss Out on the Benefits of Early Registration.

Many businesses fear losing their financial investment and future profits in their intellectual property if their competitors beat them to the market with the same or similar concepts. This can occur through legitimate competition, but often is the result of a breach of trust by an employee, partner, confidant, or co-creator. Many businesses do not realize that the three federal statutory schemes for protecting intellectual property—patent, trademark, and copyright—contain provisions to protect intellectual property owners against these threats by allowing “early” or “pre” registration of intellectual property. You should consider whether your business could benefit from the protections of the early registration procedures discussed below.

Patents

The “early” registration procedure for protecting a patentable invention is the provisional patent application. The United States Patent and Trademark Office (PTO) accepts provisional patent applications pursuant to 35 U.S.C. § 111(b). A provisional patent application is a short form patent application enabling the inventor to claim the filing date of the provisional application in a later nonprovisional patent application. In other words, the inventor can preserve a date for protection of the invention up to a year in advance of the nonprovisional application date by filing the simpler, and less expensive, provisional patent application. A provisional application must include a specification, a drawing and the payment of a fee (which is considerably less than the fee for a nonprovisional application). A subsequent, nonprovisional patent application must be submitted within one-year of the provisional application to protect the invention.

There are several potential benefits to submitting a provisional patent application. First, a provisional patent application does not count against the twenty-year term of a subsequently filed nonprovisional application, thereby extending the term of your patent by one year. This is particularly helpful for those patents that continue to generate revenue until the patent expires. Second, patent owners have an extra year to test the marketability of their invention, prior to filing an expensive nonprovisional patent application, without risking their patent protection rights. Third, a provisional patent is evidence of ownership. This is important because in the United States the first to invent retains patent protection rights and the filing of a provisional patent is unequivocal evidence establishing the date of invention. Provisional patent applications also can be used as the basis for priority in some foreign countries where the earliest filing date is entitled to patent protection.

There are risks which must be considered when choosing whether to file a provisional patent application. While filing a provisional patent application is less expensive, it only defers the costs for one year until the inventor must file a nonprovisional patent application. Additionally, the inventor is only entitled to protection for those claims made in the provisional application. Therefore, if another use of the invention is discovered after the filing of the patent application, the inventor must file a related nonprovisional patent for any new matter requiring payment of additional fees and costs.

Trademarks

As with patents, there is an early registration process for trademarks through an “intent-to-use” application under 15 U.S.C. § 1051(b). An intent-to-use application is an application to register a mark based on a bona fide intention to use the trademark in commerce. Therefore, the trademark owner can seek protection for its trademark prior to actually using the trademark in the course of doing business. The benefit of an intent-to-use application is that it reserves a mark for use by a business when the business is in development of a product and/or lacks certainty regarding the marketability of a product. An applicant must show that he or she is entitled to use the mark, has a bona fide intention to use the mark in commerce and that the mark is not likely to cause confusion with another person’s mark. After an intent-to-use application is submitted, the PTO issues a notice of allowance. The applicant then has six months to show that the mark is being used in commerce. The applicant may be granted extensions of time of up to three-years to show that the mark is being used in commerce (although the applicant must show good cause to receive an extension past one year). The key advantage to the “intent-to-use” registration is the earlier protection of the mark which could defeat a competing claim to the same or confusingly similar mark.

Copyrights

In a relatively recent development, the United States Copyright Office has begun accepting preregistration applications for unfinished works. Preregistration allows the owner of an unfinished work to protect the work from copyright infringement prior to the release of the work. You may preregister your work only if your work is unpublished, the creation of your work has begun, and your work is being prepared for commercial distribution. Preregistration is only accepted for the following categories of material: motion picture, musical work, sound recording, computer program, book, or advertising photograph. Preregistration requires an application and a nonrefundable \$100 filing fee. To preserve the legal benefits of preregistration, a person who has preregistered a work is required to register the work within one month after the copyright owner becomes aware of an infringement and no later than three months after first publication. The impetus for the creation of the preregistration process was the increasing number of commercially distributed videos and books that were “bootlegged” and published by infringers prior to the commercial debut of the work. Therefore, the key advantage to preregistration is that it allows the work to gain copyright protection before its release for commercial distribution and makes available statutory damages and attorney’s fees for preregistration infringement upon full registration.

Conclusion

Early registration of your intellectual property is an important tool for your intellectual property protection toolbox. Attorneys in Babst, Calland, Clements and Zomnir, P.C.’s Intellectual Property Services Group are equipped to help you weigh the benefits and risks of early registration and will help you devise a plan to best protect your intellectual property. If you have any questions about early registration or for more information, contact Christopher S. Channel at (412)394-6556 or cchannel@bccz.com or any of the attorneys in BCCZ’s Intellectual Property Services Group.

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