A Trademark is Not a Copyright or a Patent

By William M. Borchard
with Deborah K. Squiers

Cowan, Liebowitz & Latman, P.C.
New York, New York

2026 Edition

Although trademarks, copyrights, patents, and trade secrets all concern intangible property rights and overlap to some extent, they differ from each other significantly. If you know the attributes of each, you can take full advantage of them to weave a fabric of intellectual property protection. And the failure to get appropriate protection is an invitation to pirate. Competent legal advice often is advisable because all four areas of law are changing, especially as applied to new technology. It may help to distinguish them by remembering that:

- **Trademarks** protect source identifications (marks of trade);
- **Copyrights** protect original creative expressions;
- **Patents** protect new and useful inventions; and
- **Trade Secrets** protect valuable secret information.

This pamphlet summarizes the principal attributes of these various types of protection.

Note: Official Federal Trademark and Patent fee increases and additions are effective January 18 and 19, 2025.

While originally part of the radiator cap, the Rolls-Royce "Flying Lady" mascot hood ornament has features suitable for simultaneous protection as a registered trademark, a copyrighted sculptural work and a patented design.

What is a Trademark? 3
What is a Copyright? 8
What is a Patent? 12
Summary Table 16

The illustrations are used with the permission of their owners: *Dole and Sun Design* is a registered trademark of Dole Packaged Foods, LLC. *Coca-Cola* and the *contour bottle design* are registered trademarks of The Coca-Cola Company. *McDonald's* and the *"Golden Arches" logo* are registered service marks of McDonald's Corporation. The *"Woolmark" logo* is a registered certification mark of Woolmark Americas, Inc. *The International Game Fish Association and logo* is a registered collective membership mark of International Game Fish Association, Inc. The *"Flying Lady" mascot* is a registered trademark of Bayerische Motoren Werke AG. *Gillette* and *SensorExcel* are registered trademarks of The Gillette Company LLC.

This reflects information available as of January 15, 2026.

© 2026 Cowan, Liebowitz & Latman, P.C.

Production: Alexander Fidelibus

What is a Trademark?

A **trademark** is a brand name, logo or package design, or a combination of them, used by a manufacturer or merchant to identify its goods or services and to distinguish them from others. Trademarks include **brand names** identifying goods (*Dole* for canned pineapple) and **trade dress** consisting of the graphics, color or shape of packaging or, after sufficient use, of goods (*Coca-Cola Bottle* for a soft drink); **service marks** identifying services (*McDonald's* for a restaurant service); **certification marks** identifying goods or services meeting specified qualifications (*Woolmark* for apparel made of 100% wool); and **collective marks** identifying goods, services or members of a collective organization (*The International Game Fish Association* for a game fishing organization). The same legal principles generally apply to all of these terms, often simply called "marks."

How to obtain trademark rights.

You need not register a trademark to have protectible exclusive rights in it and reserving a corporate name in one or more states is irrelevant to trademark rights. Simply by using a mark on or in connection with goods, or by displaying the mark in the sale or advertising of services, you can automatically acquire trademark rights in the geographic areas of use and natural expansion.

You can stake out nationwide trademark rights by applying to register the mark in the U.S. Patent and Trademark Office (USPTO). (One reason why people confuse trademarks with patents seems to be that both are handled by the same office, but the trademark and patent operations are completely separate.) A non-U.S. trademark applicant, except for Canadians, must be represented by a U.S. attorney.

Federal trademark registration.

Registration of a mark is not mandatory, and rights will be protected without registration if you have actually used the mark. But it may be advisable to establish your rights by applying to register the mark in the USPTO even before use. You can base an application on one or more of the following:

- actual use of the mark in commerce;
- a bona fide intention to use the mark in federally regulated commerce (but the mark subsequently must be used in the ordinary course of trade, and not merely to reserve a right in the mark, before the registration will be issued);
- a non-U.S. owner's country of origin application filed during the previous 6 months, or its country of origin registration, in either case with a statement of a bona fide intention to use the mark in U.S. commerce (although use before registration is not required);
- an extension to the U.S. of an international registration issued by the World Intellectual Property Organization in Geneva, based on a country of origin application or registration, with a declaration of a bona fide intention to use the mark in U.S. commerce (which extension is examined as a U.S. application, although use before registration is not required).

Registration will be refused if the mark, among other things:

- is not capable of distinguishing the applicant's goods or services from those of others;
- may falsely suggest a connection with a person or institution;
- consists of a flag or coat of arms of the United States or other governmental entity;
- consists of the name, portrait or signature of a living individual without that person's consent;
- so resembles another registered trademark, or a mark or trade name previously used by another and not abandoned, as to be likely to cause confusion, mistake or deception when applied to the applicant's goods or services;
- is merely descriptive or deceptively misdescriptive of applicant's goods or services and has not become recognized as an indication of source;
- is deceptive or geographically deceptively misdescriptive of applicant's goods or services; or
- comprises matter that, as a whole, is functional.

You also must file a specimen showing the mark as actually used in commerce, such as on labels or packaging or point of sale materials (including a website that accepts orders) for goods, or online or print advertisements for services, either at the time you file the application, or at least before registration, if the application is not based solely on a foreign application or registration.

Validity challenges.

Trademark applications and registrations may be challenged in various ways, which include the following:

- *During the examination of a pending application,* a third party may file a protest with evidence rel-

evant to any ground for refusal. The Director of the USPTO has absolute discretion whether or not to include this evidence in the record of that application for consideration by the examining attorney.

- *During the opposition period or after registration.* Anyone with a commercial interest may file an "Opposition" to the application, or file a petition for "Cancellation" of the registration, in the TTAB or a court, claiming one of the grounds stated above, or that the mark is likely to cause confusion with a previously used mark, or is likely to dilute the distinctiveness of a famous mark. The losing party may appeal to a higher tribunal.
- *Within 5 years after registration*, any person may petition the Director of the USPTO for an "Ex Parte Reexamination" of the registration for deletion of some or all of the recited goods or services on the basis that the mark was not in use in commerce on or in connection with them when the application was filed (if use-based,) or when an amendment to allege use was filed or the filing period expired (if intent-to-use-based).
- *Between 3 and 10 years after registration,* any person may petition the Director of the USPTO for "Ex Parte Expungement" of the registration for some or all of the recited goods or services on the basis that the mark has never been used in commerce on or in connection with them.

In petitioning for a Reexamination or Expungement proceeding, the petitioner must verify the elements of a reasonable investigation the petitioner conducted. The Director has absolute discretion whether or not to institute a Reexamination or an Expungement proceeding, and may do so on the Director's own initiative. The registrant may appeal an adverse decision in such a proceeding to the TTAB, and if affirmed, to a higher tribunal.

State trademark registration.

Although a federal trademark registration provides nationwide protection, a state trademark registration also can be useful (for any or all of the following reasons):

- it is available to purely local businesses that cannot qualify for a federal registration;
- it is issued almost automatically, quickly and inexpensively;
- it will be listed in search reports obtained by others; and
- it can be more persuasive to other local businesses and to state court judges than a federal registration.

Federal registration rights generally take precedence over state registration rights and normally can provide superior procedural advantages, however.

Advantages of federal trademark registration.

When issued, which normally takes over one year, a federal registration on the Principal Register has substantial advantages:

- it confers nationwide priority rights effective from the U.S. application's filing date (or the foreign application's filing date for U.S. registrations based on a foreign country of origin application filed during the previous 6 months);
- it will be listed on search reports obtained by others;
- it is evidence, albeit rebuttable, of the registrant's exclusive ownership rights, shifting the burden of proof to anyone challenging those rights, and after 5 years the grounds for attacking the registration are limited;
- it is required for increased remedies against counterfeiters;
- it gives federal courts jurisdiction to hear infringement claims, counterfeiting claims, and related claims of unfair competition under state law;
- it precludes states from requiring modifications in the display of registered marks and from applying their own dilution laws;
- it precludes claims against the owner under federal and state dilution laws;
- you can use it as a basis for registration in some foreign countries;
- you can record it with U.S. Customs and Border Protection to prevent importation of foreign goods by third party infringers or even by foreign licensees not under common corporate ownership with you; and
- you can register it with the Trademark Clearinghouse to get advantages regarding expanded top level domains.

A term that is being used and is capable of indicating source but is not yet there (like a merely descriptive term or a geographically descriptive term or a surname) can be registered on the Supplemental Register. Among its advantages, it is not subject to opposition, will prevent anyone else from registering the mark on the Principal Register, and will be listed on search reports obtained by others. But this registration does not carry a presumption of validity, ownership, or exclusive rights and cannot be recorded with U.S. Customs and Border Protection or the Trademark Clearinghouse. After the mark has acquired distinctiveness through use and advertising, you can file a new application to register it on the Principal Register.

Notice of trademark registration.

It is inappropriate to use a trademark registration notice before you actually have registered the mark, and such

inappropriate use also may prevent you from obtaining relief against an infringer. You can use the informal symbol TM (for trademark) or SM (for service mark) with an unregistered mark to indicate that you claim common law trademark rights.

After federal registration on either the Principal Register or the Supplemental Register, you can use a statutory trademark registration notice in one of the following forms: the symbol ®, the phrase "Registered U.S. Patent and Trademark Office," or the abbreviation "Reg. U.S. Pat. & Tm. Off." This notice is not mandatory, but you must use it to get damages from an infringer under some circumstances.

How long trademark rights last.

Trademark rights continue indefinitely as long as you neither abandon the mark nor permit it to lose its trademark significance by becoming a generic term. On the other hand, you must maintain a federal trademark registration by filing a declaration, during the year before the sixth and each tenth anniversary after issuance (plus a six-month grace period for an extra fee), that the mark is in bona fide use in commerce in the ordinary course of trade and not merely to reserve a right in the mark. You must also renew the registration every 10 years. The federal law provides that non-use of a mark for 3 consecutive years is ordinarily considered proof of an intention to abandon it, opening the way for someone else to claim exclusive rights in the mark.

Who owns a trademark.

In the U.S., unlike many other countries, if you are the first user of a mark, you normally are considered its owner even if someone else has been the first to apply to register the same mark (unless the application was based on a bona fide intention to use the mark and was filed before your use, or the application has the priority of a foreign country of origin application filed during the previous 6 months and before your use).

As the owner of a trademark, you may license another to use it but you must control the nature and quality of the licensee's goods or services under the mark. Similarly, you may assign the mark to another party, but the assignment must include the good will of the business symbolized by the mark as well as any existing registrations or pending applications, except that you can assign pending intent-to-use applications only to a successor to an ongoing and existing business.

What infringes a trademark.

Federal and state trademark law protects a mark whether or not it is registered. It is an infringement for someone else to use the same or a confusingly similar term or design as a mark, on the same or closely related goods or services, in the same geographical area or an area of natural expansion.

Trademark "fair use" is a defense if an individual's name or a descriptive mark is used, otherwise than as a mark, fairly and in good faith only to describe goods, services, or their geographic origin. Sometimes "nominative fair use" of another's mark is permitted if it is necessary to refer to the owner's product or service, as in comparative advertising or parody. "Expressive use" of a trademark or service mark in an expressive work, such as a movie, play or book, also may be a defense to an infringement claim.

Unfair competition.

Trademark infringement is one form of unfair competition. The federal trademark law protects against a likelihood of confusion, mistake or deception about the source, affiliation, sponsorship or approval of goods or services or commercial activities of another. It also protects against the use of any false or misleading statement of fact in commercial advertising or promotion which contains a misrepresentation about that person's or another's goods, services or commercial activities.

Dilution.

The federal law, and many states, also protect the owner of a famous and distinctive mark against a likelihood of dilution by the blurring of its distinctiveness or the tarnishment of its reputation even if there is no likelihood of confusion, actual competition or actual economic injury.

Trademark searches.

If you wish to adopt a new trademark, you should first do a knockout search of the Internet and the U.S. Patent and Trademark Office records to learn whether someone else may already have rights. For important marks, your attorney can order a more comprehensive search from a reputable searching company, and can interpret the report for you.

Remedies for trademark infringement and dilution.

Some states have criminal penalties for certain forms of trademark infringement. Civil remedies are also available under the federal law and most state laws:

- an injunction against future infringement (which is the only remedy against printers, publishers of periodicals, and television and radio broadcasters who print or transmit infringing advertisements but prove they are innocent infringers);
- the infringer's profits;
- damages for past infringement suffered by the owner of the mark during a period determined by state law (which may be trebled under the federal law);
- destruction of all materials bearing the infringing mark and sometimes the recall of infringing goods from the market; and
- the costs of the action, and in exceptional cases, reasonable attorney's fees.

You cannot recover profits or damages under the federal law unless either the infringer had actual notice of the registration or you used a trademark registration notice.

Dilution remedies are an injunction and, for willful activities, the other remedies mentioned above.

Remedies for trademark cybersquatting.

The federal law provides civil remedies against a person who has a bad faith intent to profit by registering, trafficking in or using a domain name that is identical or confusingly similar to a distinctive mark or living person's name or is dilutive of a famous mark. In addition to the usual remedies for infringement, there are special remedies:

- cancellation or transfer of the domain name to the plaintiff; and
- instead of actual damages and profits, at the election of the plaintiff, statutory damages from $1,000 to $100,000 per domain name.

Remedies for trademark counterfeiting.

There are criminal penalties and stiffer civil remedies under federal law (and some state laws) for intentionally dealing in goods or services knowingly using a counterfeit mark or an Olympic designation.

The federal criminal penalties, which also apply to intentionally trafficking in labels or other packaging or documentation knowing that a counterfeit mark has been applied without authorization, are:

- a fine for individuals of not more than $2 million (or $5 million for a second or subsequent offense), or imprisonment not exceeding 10 years (or 20 years for a second or subsequent offense), or both; and a fine for corporations or partnerships of not more than $5 million (or $15 million for a second or subsequent offense). The maximum prison term is longer for knowingly or recklessly causing or attempting to cause bodily injury (up to 20 years in prison) or death (up to life in prison);
- seizure of the enterprise's vehicles, equipment and storage facilities; and
- destruction of articles bearing the infringing marks.

The federal civil remedies are:

- seizure, without notice, of the goods, counterfeit marks, means of making the marks, and relevant business records;
- mandatory treble damages, possible prejudgment interest and attorney's fees (including investigator's fees); and
- instead of actual damages and profits, at the trademark owner's election, statutory damages of $1,000 to $200,000 for each type of goods or services for which each counterfeit mark is used (subject to increase to $2 million for willfulness).

International trademark protection.

There are three ways that a U.S. business or citizen can register a trademark outside the U.S., but it takes careful analysis to design an international protection program since each approach has advantages and disadvantages:

- under national laws, apply for a registration in individual countries (or for a **Benelux registration** covering Belgium, Netherlands and Luxembourg; or for an **OAPI registration** covering 17 African countries).
- under the **European Union Trade Mark** (EUTM) central registration system, apply in Alicante, Spain for a single registration covering all current member countries of the European Union (27 countries). EUTM registrations were automatically deemed registered in the UK after it exited the EU.
- under the **Madrid Protocol** central filing system, apply in the U.S. Patent and Trademark Office, based on a U.S. application or registration on the Principal Register, for an international registration issued by the World Intellectual Property Organization in Geneva, Switzerland. The international registration can be extended as a local application filed in each country you designate among about 116 Protocol members, covering 132 countries.

No matter which of these filing methods you use, you normally can claim the priority of the filing date of the first application you filed during the previous six months in a country that is a signatory to the **Paris Convention**, such as the U.S., in which you have a real and effective industrial or commercial establishment or of which you are a national or domiciliary.

Almost all trademark registrations can be attacked for invalidity if you do not use the registered mark in the country or region covered by the registration within three to five years after issuance.

Trademark licensing is an important aspect of international trade. Some countries require you to record licenses or to register permitted users, and failure to do so can invalidate the trademark. Recording registered trademarks with U.S. Customs and Border Protection can help you to keep infringing goods from being imported, transshipped or exported.

Industrial design protection.

You can protect a two or three-dimensional design, even if it constitutes the appearance of a useful article, under the industrial design laws of many non-U.S. countries if the design has novelty and distinctiveness. You can file a single design application covering one or more of the 92 member countries of the **Hague Agreement Concerning the International Registration of Industrial Designs.** The European Union has a dual system which protects an unregistered design for 3 years after initial public disclosure, and protects a registered design for 5 years, renewable for up to 25 years, after initial public disclosure if the application was filed within 12 months after initial public disclosure. You can get a design registration much faster than a trademark registration covering the same design, although the term of a design registration is limited.

Domain name protection.

A domain name is a word followed by a suffix such as .com, .org, .net, .info, .biz, or a number of other similar elements, or a country code. It is a computer address that you can use either as a world wide website locator (www.cll.com) or as an email address (law@cll.com), or both. You register a domain name in one of the registries that is part of the Internet system. And if you use all or part of a domain name prominently as a source identification on a web page or in advertising, you also can register and protect that identification as a trademark.

If a cybersquatter, in bad faith, registers a domain name that includes your registered trademark, you may be able to get that domain name transferred to you. You can start either a quick and inexpensive international arbitration (called a UDRP or URS proceeding) or a federal lawsuit under a section of the U.S. trademark law (called an ACPA proceeding) which, although slower and more expensive, also can result in statutory damages of between $1,000 and $100,000. Additional proceedings may be possible regarding the expanded top level domains.

What is a Copyright?

A **copyright** seeks to promote literary and artistic creativity by protecting, for a limited time, what the U.S. Constitution broadly calls the "writings" of "authors." Copyrightable works include:

- literary, musical and dramatic works;
- pantomimes and choreographic works;
- pictorial, graphic and sculptural works (including the nonutilitarian design features of useful articles);
- motion pictures and other audiovisual works;
- sound recordings;
- computer programs;
- certain architectural works; and
- compilations of works and derivative works.

Copyright only protects particular expressions of ideas, not the ideas themselves. And a protectible work must be "original," i.e., not copied from another source (although two separately protectible works theoretically could be identical by coincidence). The work also must not be so elementary that it lacks sufficient creativity to be copyrightable (such as a common shape or a short phrase).

AI-generated works.

Copyright does not extend to a work purely generated by artificial intelligence, or a work with insufficient human control over the expressive elements. Human authors may use AI to modify their creative works, but copyright will not extend to any new elements added to the original work by the AI model. Prompting an AI model multiple times to generate desired outputs does not, under the current state of the technology, vest those outputs with copyright protection.

Copyright owner's rights.

The creator basically has the exclusive rights to reproduce the work, to distribute the reproductions, to display and perform the work publicly, to make derivative works, and to authorize others to do any of these things. The creator of certain works of fine art also may have rights to control their attribution or modification. The performance right in a sound recording is limited to digital transmissions, such as webcasting, with lower royalty rates for small webcasters.

How to obtain copyright rights.

The moment you have created and fixed a copyrightable work in a tangible form, such as by writing it down or recording it, it automatically enjoys copyright protection whether or not it has been published or registered. There is no state copyright protection, although states still can redress violations of rights outside the scope of copyright, such as breaches of contract, acts of unfair competition or defamations. Unfixed works, such as extemporaneous speeches or unrecorded live performances, may be protected by state law because they are not covered by the federal statute.

Notice of claim to copyright.

No copyright notice is required or even prescribed for an unpublished work. However, you may affix a statutory copyright notice to all publicly distributed copies of a work in a manner and location giving reasonable notice. The copyright notice consists of all three of the following elements:

- the symbol ©, or the word "Copyright," or the abbreviation "Copr." (except that for sound recordings the symbol ℗ is used);
- the year of first publication (which may be omitted on greeting cards, postcards, stationery, jewelry, dolls, toys, and useful articles); and
- the name of the owner of copyright, or a recognizable abbreviation of the name, or a generally known alternative designation of the owner.

On copies distributed before 1978, an omission of the notice, or an error in it, could have thrown the work into the public domain. A change in the law in 1978 made it possible to cure the defect on copies distributed on or after that date. And on works created on or after March 1, 1989, a copyright notice is no longer mandatory. However, you should use a copyright notice anyway because an innocent infringer, relying on the absence of notice, is not liable for actual or statutory damages before receiving actual notice of the copyright. Furthermore, a court may even grant the infringer the right to continue the infringing activity provided it pays a reasonable license fee to the copyright owner.

Any person who uses or removes a copyright notice with fraudulent intent is subject to a fine.

Library of Congress deposit.

Within 3 months after your work is first published in the United States, you are required to deposit in the Copyright Office two complete copies of the best edition of the work for the use or disposition of the Library of Congress. Failure to make this deposit does not invalidate the copyright, but if the Register of Copyrights makes a written demand for the deposit, failure to make the deposit within 3 months after this demand can result in a fine plus other penalties.

Copyright Registration.

You can register the copyright in any published or unpublished work at any time during the period of copyright by

depositing in the Copyright Office two complete copies of the best edition of the work (one is enough in some cases) together with an application and a small fee. The copies accompanying your application satisfy the Library of Congress deposit requirement.

Failure to register the copyright does not invalidate it, but prompt registration is a good idea because:

- It is a prerequisite to suing an infringer (except for works originating in a Berne Convention state other than the U.S.);
- You cannot recover statutory damages or attorney's fees for infringement of a published or unpublished work commenced before its registration unless you registered the copyright within 3 months after first publication of the work;
- A certificate of a copyright registered before or within 5 years after first publication is prima facie evidence of the validity of the copyright and the facts stated in the certificate;
- You can record the certificate with U.S. Customs and Border Protection to protect against the importation of infringing works; and
- Registration is the best way to preserve the necessary copyright information about the work.

You also can preregister certain types of works, while they are being created for commercial release, that have a history of prerelease infringement: motion pictures, sound recordings, musical compositions, literary works for book publication, computer programs and advertising or marketing photographs.

How long a copyright lasts.

This is a complex area because the term of copyright largely depends upon when and where the work was first published and whether or not the U.S. copyright was federally registered or renewed.

- A general rule of thumb is that an authorized work published in the U.S. in or before 1930 is public domain in the U.S.
- A work published with a proper copyright notice between 1931 and 1964 could still be in copyright if, during the 28th year after publication, a renewal was filed for another 67 years.
- A copyright secured from 1964 through 1977 is deemed automatically renewed for a total of 95 years.
- A work not published or registered for copyright before January 1, 1978 is protected for the author's (or surviving joint author's) lifetime plus 70 years, unless it was published before the end of 2002 in which case the copyright will not expire before 2047, even if the life-plus-70 term would expire before that date.
- The general rule for a work created on or after January 1, 1978 is that the copyright lasts for the author's (or surviving joint author's) lifetime plus 70 years. But the copyright in a "work made for hire," or in an anonymous or pseudonymous work, lasts for 95 years from publication or 120 years from creation, whichever is shorter.

Sound recordings, as distinguished from the musical compositions they embody, have unique terms:

- If first published before 1923, the recording is in the public domain.
- If first published between 1923 and 1946, the recording could still be in copyright for 100 years from publication.
- If first published between 1947 and 1956, the recording could still be in copyright for 110 years.
- If fixed between 1957 and February 15, 1972, the recording could still be in copyright until February 15, 2067.
- If fixed after February 15, 1972, the recording's copyright status is covered by the general copyright rules.

Libraries and archives may reproduce, distribute, display or perform in facsimile or digital form copies or phono records of works for purposes of preservation, scholarship or research during the last 20 years of the copyright if reasonable investigation shows that the work is not the subject of normal commercial exploitation and cannot be obtained at a reasonable price. And some works first published abroad may have their U.S. copyrights, which were forfeited for failure to comply with formalities, reinstated in accordance with the GATT Agreement.

Finally, a work may be protected in other countries even though its U.S. copyright protection has ended, and *vice versa.*

Who owns a copyright.

The individual author of a work initially owns the copyright. But the employer or party commissioning a work automatically is deemed to be the "author" of a "work made for hire" if (for a work created on or after January 1, 1978) either:

- the work was prepared by an employee within the scope of employment; or
- the work was specially ordered or commissioned, and is one of 9 specific types of works, and most importantly, is expressly agreed to be a "work made for hire" in a written instrument signed by both parties.

Joint authors, who each intend to be a joint author and that their copyrightable contributions be merged into inseparable or interdependent parts of a unitary whole, share ownership of the entire work as tenants in common. In the absence of a contract, they are equal owners, and each is

entitled to authorship credit, can assign or bequeath his or her ownership share, and may use the work, or grant non-exclusive licenses for use of the work, subject to a duty only to account to each co-owner for a share of the profits.

A copyright is divisible, so the recipient of any exclusive grant or license of rights becomes the owner of the copyright for those rights. All transfers must be in writing. Although it is not mandatory to record an instrument of transfer in the Copyright Office, recording it gives constructive notice of the transfer to possible subsequent transferees of the same rights.

Under various circumstances, the author, or specified heirs after the author's death, can terminate exclusive and non-exclusive transfers or licenses of any right in any work other than a "work made for hire," but rights in then existing derivative works are not affected by the termination.

What constitutes copyright infringement.

Copyright infringement generally is the unauthorized use or copying of the work. Also, the law provides that those who facilitate or profit from the infringing conduct of another may be liable as vicarious or contributory infringers. It usually is difficult to prove copying, so the copyright owner normally tries to prove that the alleged infringer had "access" to the work and that the copyrightable elements of the two works have "substantial similarity" from the viewpoint of an ordinary observer, after which the burden of proving independent creation shifts to the alleged infringer.

The unauthorized rental of a phonorecord or computer program for commercial advantage, and the unauthorized importation of a copy or phonorecord, also constitute infringement but not if the imported copy was lawfully made and first sold abroad.

Some of the many specified activities not considered copyright infringements by the federal law include:

- the use of the basic idea expressed in the work;
- the independent creation of an identical work without copying;
- the sale or limited public display of a work by the owner of the physical copy or phonorecord;
- "fair use" of the work;
- use under one of the "compulsory licenses;"
- transitory digital communications by an online service provider;
- certain distance education transmissions;
- making a copy of a computer program solely for purposes of maintaining or repairing a computer containing it;
- radio or television performances by certain retailers and restaurants; and
- filters that mute or skip program content in a private household.

What is fair use.

The Copyright Law provides for the defense of "fair use" of a copyrighted work for purposes such as criticism, comment, news reporting, teaching, scholarship, or research. This involves weighing (1) the purpose and character of the use (including whether the use is commercial or nonprofit educational), (2) the nature of the copyrighted work (factual or creative; unpublished or published), (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole (quantitatively and qualitatively), and (4) the effect of the use upon the potential market for or value of the copyrighted work (harm to sales and potential licensing). Caselaw has added, under the first factor, the extent to which the use is transformative (with a new meaning, message or expression).

Remedies for copyright infringement.

The federal law makes willful copyright infringement for profit a felony, the penalties for which depend on both the number of copies produced or distributed during a given period of time, and whether it is a first or subsequent offense.

Criminal penalties range from a fine of not more than $25,000, or imprisonment not exceeding 1 year, or both, for first offenses infringing any type of work; and up to $250,000 for individuals and $500,000 for organizations, or 10 years, or both, for a second or subsequent offense of certain types. Additional penalties apply, among other things, to making an unauthorized copy or transmission of a movie in a theatre; trafficking in or importing "bootleg" recordings or videos of live musical performances; willfully putting someone else's work on the Internet without authorization; or reproducing or distributing within a 180-day period works whose total value exceeds $1,000. Federal felony charges may be brought against a digital service willfully streaming copyrighted works without authorization, for monetary gain, and with no other commercially significant purpose.

The following civil remedies are also available to the holder of any exclusive rights in the copyrighted work under the federal law:

- an injunction against future infringement;
- seizure, forfeiture, destruction, restitution or other disposition of all infringing reproductions and the articles used to make them;
- seizure of records and information (subject to a protective order as to their discovery and use);
- the actual damages suffered by the copyright owner during the 3 years before commencement of the infringement action;
- any additional profits of the infringer within that time period;

COPY

- instead of actual damages and profits, at the copyright owner's election, statutory damages for all infringements of any one work from $750 to $30,000 (subject to reduction to $200 in some instances, or to increase to $150,000 for willful infringement);
- full costs including a reasonable attorney's fee; and
- a civil fine imposed by Customs against the importers of counterfeit goods.

The Copyright Office's Copyright Claims Board is a voluntary small-claims alternative to adjudicate claims for copyright infringement or noninfringement, or for abuse of takedown procedures, brought within 3 years of the claim's accrual, and to award actual damages, profits, or statutory damages not to exceed $15,000 per work or a total of $30,000 in any proceeding.

International copyright protection.

First publication anywhere in the world of a literary or artistic work may affect its copyright status elsewhere. So international treaties are particularly important in the copyright field. The U.S. has copyright relations with many jurisdictions, about 181 of which (including the U.S.) are members of the **Berne Convention** which provides for copyright protection meeting certain minimum standards without formalities.

Many commercially important countries (including the U.S.) have ratified the **Universal Copyright Convention** which requires foreign works to have the same copyright protection as domestic works. Berne Convention protection has no formal requirements, but in the few countries which are members of the UCC but are not members of Berne, a published work must bear a copyright notice consisting of ©, the name of the copyright proprietor and the year date of first publication, in order to be considered to have complied automatically with any local formal requirements in each other UCC member country.

A multilateral treaty against the piracy of sound recordings (ratified by the U.S.) is similar to the UCC, except that the prescribed copyright notice includes a ℗. The U.S. also is a member of the **Buenos Aires Convention** which requires use of a notice such as "All Rights Reserved."

Copyright management protection.

The U.S. has implemented international copyright treaties sponsored by the World Intellectual Property Organization (a) prohibiting the direct or indirect circumvention of technological measures to control access to a copyrighted work, and (b) prohibiting the knowing provision of copyright management information that is false, the intentional removal or alteration of such information, or the distribution, importation or public performance of works knowing that copyright management information has been removed or altered.

Criminal penalties, for proceedings commenced within 5 years from the offense, range from a fine of not more than $500,000, or imprisonment not exceeding 5 years, or both, for the first offense; and up to $1 million, or 10 years, or both, for any subsequent offense. The civil remedies are substantially the same as those for copyright infringement, except that the statutory damages range from $200 to $2,500 for each act of technology circumvention, and from $2,500 to $25,000 for each copyright management information violation, subject to trebling for repeated acts or violations committed within 3 years after a final judgment.

Related laws.

Various related laws protect particular items:

- **Semiconductor chips**. The owner of an original mask work can prevent and get statutory damages for its unauthorized reproduction, importation, or distribution for 10 years if the work is registered in the Copyright Office within 2 years of its first commercial exploitation.
- **Vessel hull designs.** The owner of an original boat hull or deck design, distinguishable from others and not the subject of a design patent, can prevent and get statutory damages for its unauthorized making, having made, or importation for 10 years if the design is registered in the Copyright Office within 2 years of its first commercial exploitation.
- **Counterfeit or illicit labels.** It is a federal crime knowingly to traffic in a label designed to be used for a copyrighted sound recording, computer program, motion picture or other audiovisual work, literary work, a pictorial, graphic or sculptural work, a work of visual art, or its documentation or packaging. Penalties are a fine of up to $250,000, imprisonment not exceeding 5 years, or both, as well as civil remedies including possible statutory and punitive damages.

What is a Patent?

A **patent** gives the patentee (patent owner) the right to exclude others from making, using, offering for sale or selling an invention within the U.S. or importing it into the U.S. It does not carry the affirmative right to make, use, sell or offer an item covered by the patent since one or more other patents may cover aspects of the same invention.

You can obtain a **utility patent** for the following statutory classes of new and useful inventions:

- processes (a chemical, mechanical or electrical procedure, such as a method for refining petroleum; or a business method of processing or displaying data or making calculations if it uses computer assisted implementation or it physically transforms an article and is not directed to a law of nature, physical phenomenon, or abstract idea);
- machines (mechanisms with moving or interactive parts, such as a motor or computer system);
- articles of manufacture (man-made products, such as a hand tool); and
- compositions of matter (chemical compounds, combinations or mixtures, such as a plastic).

In addition, you can obtain a **design patent** for a new, original and ornamental (that is, non-functional) design for an article of manufacture, or a **plant patent** for a new variety of seed or plant or any of its parts. No patents can be issued for (1) tax avoidance strategies, or (2) human organisms.

Whether an invention is made by a flash of genius or painstaking research, to be patentable it also must meet all of the following hard-to-satisfy criteria:

- "novelty" in that it was neither previously known to the public, nor in public use, nor patented, nor described in a printed publication, anywhere;
- "non-obviousness" to a person having ordinary skill in the relevant art; and
- "utility" in that it has a useful purpose and is operable.

AI-assisted inventions.

Artificial intelligence systems cannot be listed as inventors on patent applications or patents. However, a natural person can be listed as the inventor or joint inventor if the natural person contributes significantly to the AI-assisted invention.

Trade Secrets.

Federal and state laws protect information that has been kept secret, and that provides economic value to the owner by virtue of being kept secret, against unauthorized use or disclosure by anyone who is under an obligation of confidentiality to the owner. But this protection requires you to take reasonable measures to maintain the information's secrecy. Moreover, it does not prevent independent development, or apply to parties learning the information without any confidentiality obligation. Of course, trade secret protection ends for the aspects of an invention that are disclosed in a patent or published patent application. The trade-off between patents and trade secrets is that a patent protects against independent development but has a limited term, while trade secret protection lasts as long as the information is kept secret but does not protect against independent development.

A patent application is typically published 18 months after it is filed. While most patent applications are published, you can request that your application not be published (and thus be kept secret until a patent issues) if: (a) an application has not been filed in a country that publishes them; and (b) the request is made when the U.S. application is filed. Thus, you do not immediately destroy trade secret rights merely by filing a patent application.

How to obtain a patent.

In the United States, you can obtain a patent only by a grant from the U.S. Patent & Trademark Office (USPTO).

Unless an invention can be kept secret for many years (like the Coca-Cola soft drink formula), often it is desirable to file a patent application without undue delay because:

- the U.S. changed to a "first-inventor-to-file" system for applications filed on or after March 16, 2013. This means that the patent is granted to the first inventor to file an application even if someone else had an earlier date of independent invention. However, if you believe someone else learned of the invention from you and filed a U.S. patent application for that invention without your authorization, you can file your own patent application and then request that the USPTO commence a "Derivation Proceeding" in order to prevent the other person or entity from acquiring a U.S. patent on your invention.
- a patent cannot be obtained if, before the patent application is filed, the invention was publicly disclosed in any manner by someone else who did not learn of the invention from you;
- a patent cannot be obtained if the invention was publicly disclosed by you, or if you publicly sold a product embodying the invention even if the details were kept secret, more than a year before you filed the patent application;
- a patent protects against even innocent infringements,

not just infringements by those breaching a confidentiality obligation to the owner; and

- a patent is the only way to protect an invention after it is no longer secret.

You can get an early filing date by filing an informal **provisional application** that describes the utility invention in any language sufficiently to enable someone to practice it, but need not have claims or formal drawings. A formal **non-provisional application**, claiming the priority of the provisional application, must be filed within the following 12 months, and must contain a set of patent claims. If the application is not in English, an English-language translation must be filed within a prescribed period after receiving a notice of missing parts from the USPTO.

It often takes a couple of years for a patent to be examined, but you may request "Expedited Examination" upon payment of a substantial additional filing fee. A "Small Entity" (an individual, multiple individuals, a company with 500 or fewer employees inclusive of employees of all related entities, a not-for-profit entity, or a university) and a "Micro Entity" (a Small Entity not named in more than 4 previously filed applications, each owner having the prior year's gross income of less than about $212,000) can get a discount of 60% for a Small Entity, or 80% for a Micro Entity, from this and most other official fees.

Validity Challenges.

A preliminary patentability search generally is desirable in order to help determine whether the invention is novel. It also aids in the proper drafting of the patent application.

The validity of a patent may be challenged in the USPTO by anyone other than the government in various ways, which include the following:

- *During the examination of a pending application,* anyone may anonymously submit to the USPTO relevant prior art as evidence that the invention is either not novel or is obvious to prevent the issuance of a patent or at least to reduce its scope.
- *Within 9 months from patent grant,* anyone may request a "Post-Grant Review" (PGR) in which patent validity may be challenged on a wide variety of bases, including lack of novelty, obviousness, lack of enablement (that is, the patent does not properly teach how to practice the invention), or indefiniteness (that is, it is legally unclear what the patent covers).
- *After 9 months from patent grant,* anyone may request an "Inter-Partes Review" (IPR) in which patent validity may be challenged only on the basis that the invention is either not novel or is obvious in light of published prior art.
- *At any time after patent grant,* anyone may request an "Ex Parte Reexamination" in which, similar to the IPR proceeding, patent validity may be challenged only in light of published prior art. However, once commenced, the requestor of the Ex Parte Reexamination no longer actively participates in the proceeding.

Generally, post-grant proceedings are decided by the Patent Trial and Appeal Board (PTAB) within 12 months from initiation, extendable to 18 months for good cause. Appeals go only to the Court of Appeals for the Federal Circuit (CAFC). Any pending federal court action may be stayed during a PTAB or CAFC proceeding. Typically, any ground for invalidity that was raised, or could reasonably have been raised, in a PTAB proceeding cannot be raised later.

Correction of Patents.

At any time after grant, the patent owner may request "Supplemental Examination" to consider, reconsider or correct information possibly affecting the enforceability of the patent. For minor and generally non-substantive corrections, such as to correct a typographical error, a patent owner may request a "Certificate of Correction."

Notice of Patent Rights.

While a patent application is pending, you may use the informal legend "patent applied for" or "patent pending" on devices or processes and in advertisements for them.

After a patent has been issued, you may use the following patent notice: the word "patent" or "pat." and either the number of the patent or a direction to a free website showing it. This notice is not mandatory, but it may be necessary to get damages from an infringer.

On the other hand, use of an improper patent notice is punishable by a fine (which only the U.S. Government may seek) or by compensatory damages (which only a competitor harmed by the improper patent notice may seek).

How long patent rights last.

A utility patent or plant patent generally lasts 20 years from the filing date of the non-provisional patent application (with certain exceptions described below). A design patent lasts 15 years from the issue date (14 years for applications filed before May 13, 2015).

If priority of an earlier non-provisional application is claimed, the 20-year term is measured from the filing date of the earlier application. The term can expire earlier if you do not pay specified maintenance fees 3½ years, 7½ years and 11½ years after the grant (there is a 6-month grace period for each payment). You can get the term extended for up to 5 years for certain patents if issuance is delayed for various reasons, such as delayed action by the USPTO, secrecy orders, successful appeals or pre-market regulatory review.

Once you sell a patented item anywhere in the world, you cannot place restrictions on that item. You cannot renew a patent, and anyone can make, use, sell or offer in the U.S. devices or processes embodying the formerly patented invention after the patent has expired or been declared invalid.

PATENT

Who owns a patent.

Unless a patent application or patent is assigned, the inventors are the owners. Employees and officers of a company may have contractual or fiduciary obligations to assign their patent rights to the company. A U.S. patent application may be signed by the inventor's assignee, or by anyone to whom there is an obligation to assign the invention.

What constitutes patent infringement.

A patent protects against the unauthorized manufacture, use, sale or offer for sale in the U.S. of all devices or processes (except for pure medical or surgical procedures) embodying the claimed invention (but not components intended for assembly abroad into such devices), whether copied from authorized devices or independently invented. It also protects against the importation, use or sale in the U.S. of a product made from a patented process without authorization, although there are limitations to protect innocent infringers.

A design patent is infringed if the patented design and the accused design would appear to be substantially the same to the ordinary observer familiar with the prior art.

An accused infringer can assert a "Prior Use" defense if, in good faith, it began commercially using the invention at least 1 year before the earlier of: (1) the effective filing date of the patent; or (2) the date the patented invention was first publicly disclosed by the patent owner. An accused infringer also may defeat a claim by establishing that the patent is invalid, or that the owner misused it or engaged in inequitable conduct with respect to it.

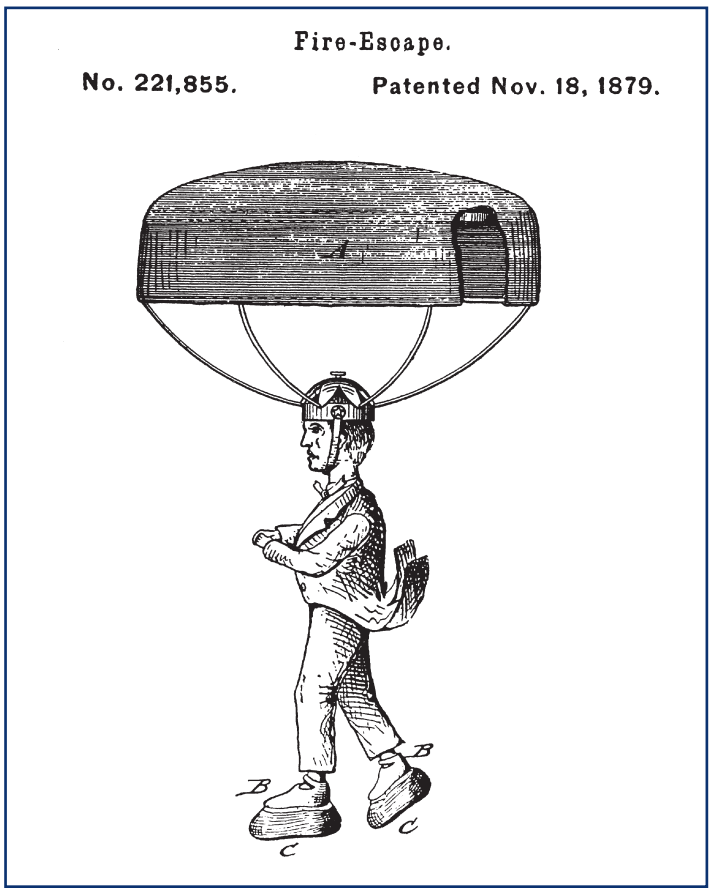
Remedies for trade secret infringement.

Most states (not including New York) and a federal law protect trade secrets from misappropriation. Federal criminal penalties are a fine of up to the greater of $5 million or 3 times the value of the trade secret, or up to 10 years imprisonment, or both. If a federal civil action is brought within 3 years from the date the misappropriation was, or should have been, discovered civil remedies include an injunction (or in exceptional circumstances a reasonable royalty), damages (up to double for willful and malicious misappropriation), and in some cases attorneys fees and seizure.

Remedies for patent infringement.

There are no criminal penalties for patent infringement. The following civil remedies are available under U.S. law:

- an injunction against future infringement (usually obtainable only by a patent owner who competes in the same market); and
- compensatory damages, in no event less than a reasonable royalty, which may be trebled if the infringement is willful (and additionally, for infringing a design patent, the infringer's profits, but not less than $250).



Damages begin to accrue after the earlier of actual notice (such as by a letter or by service of an infringement action) or first marking with a patent notice. Damages may only be recovered for patent infringements occurring during the 6 years prior to the commencement of the infringement action.

A U.S. patent owner may start an International Trade Commission expedited proceeding to exclude infringing products from the U.S. if a domestic industry exists or is being established.

International Patent Protection.

You generally can patent inventions only on a country-by-country basis. However, there are four regional patent systems: (1) the **European regional patent,** which is obtained by filing an application with the European Patent Office (EPO), covers most countries throughout western and central Europe; (2) the **Eurasian regional patent** covers Russia and other countries throughout eastern Europe; (3) the **ARIPO regional patent** covers countries throughout mostly eastern Africa; and (4) the **OAPI regional patent** covers countries throughout mostly western and central Africa.

While regional patents can be cost-effective in securing patent protection in multiple countries, particularly in Europe, costs still can be high due to the need to pay an annual annuity (which is a government tax) in each country in which the patent is enforceable. Annual annuities also are required for most country patents. In addition, after a European patent is obtained, the European patent must be "validated" (that is, recorded) in each country of interest, and many European countries require that a translation of the patent into the local language be filed at the time of validation which adds further costs.

While you have 1 year from your publication or other public disclosure of the invention in which to file a patent application in the U.S., most other countries have no such grace period. Those countries require "absolute novelty" and the prior publication of your invention before filing in one of these countries results in a loss of patent rights in that country.

However, there are two international treaties that enable patent applicants to defer filings without risking a loss of patent rights: (1) under the **Paris Convention for the Protection of Industrial Property,** of which almost all countries are members, if you file an application in one country, and then you file that application within 1 year (6 months for a design application) in another country (or patent region), the effective filing date of the second application is the filing date of the first application; and (2) under the **Patent Cooperation Treaty** (PCT), you can file an international utility patent application (also commonly called a PCT application) which itself does not become a patent, but which can be filed in any member country (or patent region) within as much as 30 months in most countries (and 31 months in patent regions), and the effective date of the later filings is the date on which the PCT application was filed.

A common international strategy is to file a utility patent application first in the U.S. Then, under the Paris Convention, you have 12 months in which to file a PCT application with the effective date of the U.S. filing. This gives you an additional 18 months in which to file the PCT application in other member countries with the effective date of the PCT filing which is the same as the effective date of the U.S. filing. This allows you to begin selling the invention, or otherwise publicly disclosing it, without risking the loss of patent rights in those countries that have an "absolute novelty" requirement.

Utility model protection.

In a number of non-U.S. countries, you can protect as a utility model (also called a "petty patent" or "innovation patent") an incremental invention that might not qualify for a utility patent. This protection generally is only for 7 to 10 years, but you can get it much faster and less expensively because there generally is little or no examination before issuance, and the infringement remedies are the same as for a utility patent.

Uncommon packaging which bears notices of patent, trademark and copyright protection.

Summary Table

	Trademarks	Copyrights	Patents
Nature	Commercial identifications of source such as words, designs, slogans, symbols, trade dress, sounds or scents.	Original literary and artistic expressions such as books, paintings, music, records, plays, movies, software, buildings (built on or after Dec. 11, 1990).	New and useful inventions and configurations of useful articles.
Scope	Protects against creating a likelihood of confusion; or diluting a famous mark.	Protects against unauthorized use or copying.	Excludes others from making, using, offering for sale or selling the invention in the U.S. or by importation into the U.S.
Purpose	Protects owners and public from unfair competition.	Encourages and rewards creative expression.	Encourages and rewards innovation.
How to Obtain Rights	Use mark in commerce or apply for federal registration.	Create work and fix it in tangible form. Registration confirms rights.	Be first-inventor-to-file.
Principal Advantages of Registration	Nationwide priority rights; possibly conclusive evidence of validity and ownership; U.S. Customs and Border Protection recordation; increased anti-counterfeiting remedies.	Statutory damages and attorney's fees; prima facie evidence of validity; U.S. Customs and Border Protection recordation.	Protection for non-secret inventions. May complement know-how that is a trade secret.
Basis for Registration	(1) Bona fide intention to use in commerce followed by actual use; (2) Non-U.S. owner's country of origin registration or application filed within 6 months prior to U.S. application, or extension to the U.S. of international registration, plus bona fide intention to use in commerce; or (3) Actual use in commerce.	Originality.	Novelty, non-obviousness, utility.
Notice Requirements	Optional. "TM" or "SM" if unregistered; "®" or "Reg. U.S. Pat. & Tm. Off." if registered on either the Principal Register or the Supplemental Register.	Optional. ©, "Copr." or "Copyright" with year of first publication and name of owner.	Optional. "Patent applied for" or "Pat. Pending" after application; "Patent" or "Pat." plus patent number, or website reference, after grant.
Term of Rights	As long as used; registrations must be maintained by filing use declaration before the 6th and each 10th anniversary and by renewing before each 10th anniversary (plus 6 month grace period for each filing).	Creations after January 1, 1978: author's lifetime plus 70 years, or if anonymous or work made for hire, earlier of 95 years from publication or 120 years from creation. Earlier works have varying terms.	20 years from filing date (or sometimes 17 years from grant) for utility or plant patents, subject to periodic maintenance fees; 15 years from registration for design patents (14 years if filed before May 13, 2015).
Infringement Prerequisites	Registration optional.	Registration required for U.S. nationals; optional for foreign nationals.	Issued patent required.
Infringement Standard	Likelihood of confusion, mistake or deception as to source or sponsorship; or dilution by blurring or tarnishment, subject to fair use defense.	Unauthorized use or copying (access plus substantial similarity), subject to fair use defense.	Unauthorized manufacture, use, sale, or offer for sale in the U.S. of devices or processes embodying the invention.
International Protection	(1) Individual countries or regions; (2) European Union Trade Mark registration; or (3) Madrid Protocol centralized filing.	Usually protected without registration through international treaties.	Usually granted on a country-by-country basis with centralized filing available through international treaties.

This summary is highly simplified and should only be used for a general comparison. • © 2026 Cowan, Liebowitz & Latman, P.C.

COWAN LIEBOWITZ & LATMAN
Attorneys at Law

114 West 47th Street
New York, NY 10036-1525
(212) 790-9200 • www.cll.com

CLL

TM