



The WSA series of features dealing with aspects of international legal protection for copyright, trademarks, and patent rights – and the remedies that may be obtained – continues. Author Trent Baker is an avid outdoor enthusiast who actively participates in climbing, mountain biking, snowboarding and trail running. For the day job he is an engineer and registered patent attorney with the US law firm of Baker and Associates PLLC in Salt Lake City, Utah.

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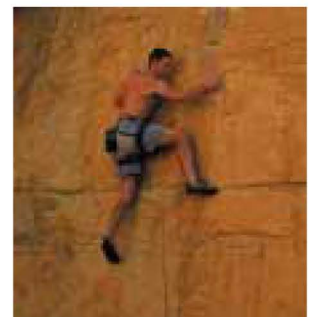


# Protecting intellectual property rights in the United States

**B**efore discussing the nuances of US intellectual property, it is first key to understand the basic concepts of intellectual property and why it is important. The term “intellectual property” (IP) refers to patents, copyrights, trademarks, and other forms of intangible property rights. Ownership of IP is analogous to owning a piece of real estate or land. The main difference between the two is that real property is tangible and has well defined borders, whereas intellectual property has neither. IP cannot be

physically seen nor touched in the way that a car or a house can, and the boundaries of intellectual property cannot always be clearly drawn. Professionally prepared IP documents often extend far beyond the initial product described so as to prevent slightly different ‘knock-offs’ that utilise the same concepts as the original product. It is important to note, however, that improperly prepared intellectual property rights might leave you with little or no protection, just as a small piece of land can be worth much less than a sprawling, large ranch. The different forms of intellectual property

*Above and below: Trent Baker in off-duty mode.*



must be used thoughtfully to build a successful business. The most difficult aspect of managing IP protection is balancing cost with the decision of which forms to use for each particular product. Imagine the different forms of IP as tools – you must pick the right set of tools to build your business in the most efficient manner. If you were building a wooden house, you most likely would need a hammer, but you would not necessarily need a wrench.

Worldwide, the activewear industry is a rapidly growing and evolving market with myriad new products, improvements on existing ones, and increasingly creative marketing campaigns. In order to succeed in such a large market, a company must set itself apart from the rest of the pack by being unique. But if the vehicle that makes your business unique is not legally protected as intellectual property, other companies will quickly copy it when it is proven to be successful. This distinction can be a revolutionary product, or it can be something as ethereal as a business culture or a marketing strategy. For example, Patagonia has an entire marketing campaign and culture centered on environmentalism and simplicity, whereas WL Gore produces a unique set of fabrics. Various forms of IP can protect both of these distinctions in order to prevent infringement by competitors.

In the age of Internet business and global communication, activewear markets are no longer isolated across continents. Thus, any IP strategy for internationally consumed goods should include US IP coverage. Outlined below are the primary forms of US intellectual property, how they can be used to protect unique aspects of an activewear business, approximate costs, and the laws pertaining to each type of protection.

## Patents

Patents are the broadest form of intellectual property because they allow an inventor to seek protection of a concept rather than a single embodiment of an invention. If a company designs a more efficient method of manufacturing textiles, it can patent that technology as an underlying concept without limiting the protection to the company's particular, intended use of the process. A patent is a fair exchange between the government and an inventor in which the inventor thoroughly describes the details of an invention to the public (in the form of the patent document). In exchange for this disclosure, the inventor receives the exclusive right to prevent others from making, using, or selling the subject matter of the patent. This protection lasts for a period of 20 years from the date of filing. While the invention is under patent protection, other companies are free to utilize the technology described in order to further technology, but they cannot make, use, or sell a product that includes the protected IP without permission. After the 20-year period,

the IP claimed in the patent is no longer protected and becomes part of the "public domain".

A common misconception about patents is that they can only be used to protect mechanical gadgets or products. Patents can protect almost anything created or influenced by a human being. Fabrics, articles of clothing, manufacturing processes, materials, business methods, computer programs, chemical compositions, etc., can all be considered inventions and therefore can be patented in some form. In order to obtain a US patent, the invention must meet the following requirements:

- 1) *New/novel* – The invention must not already exist anywhere in the world. A patent cannot be used to protect an invention that already exists, even if the inventor was not aware of its existence.
- 2) *Useful* – The invention must be useful in some way. This is generally a very easy requirement to fulfill, as it can be met by almost any invention. The only time this requirement may be an issue is when someone tries to patent an invention that has no conceivable known use in the hopes that one day it will have a use.
- 3) *Non-obvious* – The invention must not be obvious to someone skilled in the particular field in which the invention is applicable. Therefore, the invention cannot be a simple combination of existing known products.

In addition to satisfying the above requirements, particular steps must be taken before filing the patent to ensure that the invention is not improperly disclosed to the public. 'Disclosure' can refer to selling the invention, offering to sell the invention, displaying the invention at a tradeshow, or writing an article about the invention for a trade journal such as this one. Ignoring these steps could result in forfeiture of all patent rights. In all countries outside of the US, patent rights are immediately lost if the invention is disclosed in any way to the public. However, in the US, an inventor has one year after disclosing the invention within which to file for a US patent. Since the US is the only country that follows this rule, it is still generally advisable to not disclose an invention to the public until after filing a patent in at least one country in order to preserve the right to file in multiple countries. Under the Patent Cooperation Treaty, the filing date for a patent in one country can also be used for subsequently filing the patent in other countries. For example, if a US patent is filed in July 2003 and then disclosed to the public, a German patent could be filed at a later date because it will relate back to the US patent filing date, thereby avoiding the forfeiture rule of disclosure.

Meeting the requirements for patentability and ensuring the correct timing of disclosure for global markets are only part of the story – at the heart of patent protection are the claims. The



claims of a patent determine its scope of protection by mapping out the borders of the IP in the same way a fence maps out the amount of real estate that a person might own. Unfortunately, the intangible IP cannot be mapped out as simply as a piece of land; therefore, the scope of protection claimed in a patent can have unclear borders. Despite this confusion, it is still possible to distinguish between very narrow claims and very broad claims. A general rule of thumb is that a general claim containing fewer words is broader than a long claim containing many words. Assuming that a simple jacket was a patentable invention, two possible claims could be:

An over-garment comprising:

- a tubular body portion having a small top opening, a large bottom opening, and a releasable front opening;
- two tubular elongated members located on opposite sides of the body spaced equally apart from the releasable opening;

Or

A waterproof breathable shell jacket comprising:

- a hollow body portion shaped to fit around the upper torso of an adult male, having a top opening approximately 20 centimetres in diameter, a bottom opening approximately 90 centimetres, and a zippered front opening extending between the top opening and the bottom opening;
- a hood attached to the top opening of the body such that it can be used to cover the head of an adult male;
- a pair of zippered air vents spaced approximately 15 centimetres laterally away from the zippered front opening;
- a pair of tubular arms having a circumference of 20 centimetres and located approximately 15 centimetres from the zippered front opening;
- a plurality of differently shaped pockets configured to securely house objects within the shell jacket.

The first claim is very short and consequently extremely broad; while the second claim is contrastingly narrow. Arguably, the first claim protects significantly more than a jacket; it could be describing

almost any garment having a releasable front opening and two arms, such as an anorak, a polo shirt, etc. The second claim has many limitations and therefore only protects a limited particular type of jacket. The front opening must use a zipper, there must be a hood, and there are specific measurements for the jacket. A competitor could very easily make a jacket with one difference from this and still not infringe on the jacket invention. Although this is an exaggerated example of the difference between broad and narrow claims, it illustrates that a patent is not a magical document that protects a company from all infringement by competitors. A patent is instead a complex legal document that only protects a finite amount of intellectual property.

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# Copyright© trademarks™ patents

Costs for the independent preparation of a US patent by a registered patent attorney generally start at about \$5,000 for the attorney time alone. Other fees include attorney expenses, drafting fees for professional drawings, filing fees with the United States Patent and Trademark Office (PTO), and subsequent prosecution of the patent with the PTO. On average, a company can expect to spend about \$10,000 to independently file a US patent. If a patent is first filed in a country other than the US, it is generally less expensive to then file an additional patent in the US under the Patent Cooperation Treaty (PCT).

## Trademarks

Trademarks are used to ensure that customers can correctly identify the source of a particular product or service. In other words, trademarks prevent competitors from improperly capitalising on the goodwill established between a particular company and its customers. Unlike patents, trademarks can provide protection for an unlimited amount of time.

A common misconception about trademark protection is that it can only be used to protect the name of a business. Trademarks can protect almost any aspect of a business that customers will associate with the business itself. For example, if The North Face was to market a yellow shell jacket with a red stripe across the shoulders, it may be able to seek trademark protection over the mere appearance of the jacket if the design is sufficiently distinctive such that customers will believe The North Face also makes all similar jackets. Moreover, while the North Face has trademark protection over its company name and logo, it could also protect the name of the jacket, its distinctive red stripe, and any distinctive symbols placed on the jacket. In order to obtain a US trademark, the following requirements must be met:

1) *Use* – The mark must be used in a way that customers associate the source of the product with the product itself. Marks must

generally be in use before trademark protection can be obtained.

2) *Distinctiveness* – The mark must possess a particular level of distinctiveness in order to qualify for protection. A generic term can never be protected as a trademark because customers will never associate the word with a particular product. For example, the word JACKET cannot be trademarked as the name for a specific jacket design. In contrast, naming the jacket GRAPEFRUIT would constitute an immediately protectable mark because it is an arbitrary name that is not usually associated with jackets. Some descriptive terms can become protectable trademarks after some time has passed in order for the mark to become sufficiently distinctive. For example, SUPER DRY could be a protectable trademark only after there is sufficient time for customers to believe that the term represents a particular manufacturer's design.

Similar to patents, the scope of trademark protection generally extends beyond the actual mark itself. If a new company were launched by the name of The North Cliff, it would most likely infringe The North Face's trademark. Customers might be confused into assuming that the new company's products were in some way related to or endorsed by The North Face. Likewise, a product by the name of G-TEX would probably infringe on the Gore-Tex trademark. Trademarks are meant to protect customers from confusion; therefore, if there is no confusion, there is generally no infringement of a particular mark. This means that the mark COBRA may be used to protect a particular type of car alarm and a type of waterfall ice axe without confusing consumers.

The scope of a trademark also pertains to the geographic region in which the trademark can be enforced. If company A successfully registers a trademark through the US federal system, it is generally granted protection throughout the US. However, if a particular company B was using the mark before company A and yet never



registered the mark, company A could not prevent company B from using the mark within the geographical area where B had already put it to use. Company A could, however, prevent company B from using the mark outside that limited geographical region. In this sense, US trademark law is said to follow the phrase "first in time equals first in right". This example also illustrates the importance of registering trademarks under the US federal system as soon as possible to prevent competitors from obtaining "first in time" unregistered trademark rights.

The cost for the independent preparation of a federal trademark application in the US will generally cost about \$1,000 in attorney time. Other fees include attorney expenses, drafting fees for the professional drawings (if required), filing fees with the PTO, and the subsequent prosecution of the trademark application with the PTO. On average, a company can expect to spend about \$1,500 total to independently file a US trademark in a single category. Some companies may wish to file within multiple categories in order to expand their protection; this would increase the cost. The PTO has established numerous categories in which trademarks can be filed independently of one another.

### Copyrights

Copyrights are one of the narrowest forms of US intellectual property, but they are also the least expensive. Copyright protection can only be used to prevent others from creating a substantially similar work. Copyright is often used to protect books, articles, music, art, photography, architecture, etc. In order to obtain a copyright over a particular work, the following two requirements must be met:

- 1) *Original* – The work must be an original work of authorship, meaning that it was not created as a copy of another work.
- 2) *Fixed* – The work must be fixed in a tangible form before it can be copyrighted. For example, a speaker cannot copyright a speech unless someone transcribes the speech or records it on a tape recorder.

The scope of protection granted with a copyright only applies to the work itself and not the concepts within the work. The author of a copyrighted book about sewing with waterproof breathable fabrics cannot prevent a reader from making his or her own waterproof breathable piece of clothing. Likewise, the author cannot prevent someone else from reading the book, substantially rewording it, and then publishing a new book on how to sew waterproof breathable activewear. Despite this limited scope, copyright law has become increasingly important in the age of Internet business due to the ease at which articles or pictures from one website can be copied to another.

A US federal copyright registration typically costs about \$30 when filed personally by the author or creator of the work. When a work meets the requirements of copyright protection, it is automatically protected by US common law copyright. Unfortunately, common law copyright provides less protection than federal copyright laws, and therefore it is generally advisable to seek federal copyright protection on all-important copyrightable works of authorship. 🌐

***The writer specializes in acquiring and managing intellectual property rights for large and small companies. He may be contacted at the email address [trent@bakeriplaw.com](mailto:trent@bakeriplaw.com) or via phone at 801-553-4095***

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