

**ESTABLISHING A BUSINESS IN THE U.S.
INTELLECTUAL PROPERTY PROTECTION
DO'S AND DON'TS:
TRADEMARKS
COPYRIGHTS
PATENTS**

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Intellectual Property

- European businesses expanding to the United States will need to arrange for U.S. protection of their valuable intellectual property.
- Primarily:
 - Trademarks.
 - Patents.
 - Copyrights.

Trademarks

- A word, name, symbol or device used to distinguish one person's goods or services from others.
- Indication of origin—even if unknown.
 - Brand Name
 - Slogan
 - Logo
- Protectable indefinitely as long as used.

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Trademarks (...cont'd)

- Four Ways to Expand Protection To the United States:
 1. An individual trademark registration application filed with the United States Patent & Trademark Office based on:
 - a. intent-to-use the trademark in interstate commerce in the U.S.
 - b. actual use of the trademark in the U.S.
 - c. a translated home country registration.
 2. An international application for extension of protection of a home country registration to the United States—made through the Madrid Protocol administered by WIPO in Geneva.
 - Only available if home country is a treaty signatory.

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Trademarks (...cont'd)

- Methods 1 a, b & c require U.S. counsel.
- Method 2 can, in theory, be done by home country counsel, but, in practice, U.S. counsel must be involved 90% of the time because the U.S. insists on more specific goods and services descriptions than most of the rest of the world.
- Method 2 is most useful as part of a more general effort to extend trademark protection to a group of treaty signatory countries.

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Trademarks (...cont'd)

PRACTICE POINTER:

Where home country registration identifies many goods & services not actually being offered or that will not be offered in the U.S., limit the U.S. application to goods or services offered or contemplated within 5 years:

- A. Even though actual U.S. use not initially required for methods 1 a, c or 2, proof of actual use must be filed by 6 years after registration;
- B. Inclusion of unused goods or services invites costly petitions for cancellation.

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Patents

- Limited monopoly to an inventor.
- Gives the right to exclude others from making, using or selling.
- Requires full disclosure of invention.
- Granted for relatively short period—
20 years from filing in U.S.

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Patents (...cont'd)

On sale bar may make patent protection unavailable if not sought in U.S. within 1 year of making invention public;

Filing under the Patent Cooperation Treaty and designating the U.S. can extend the time in which a U.S. patent application can be initiated.

The PCT offers certain other advantages. See Materials at 17-19.

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Copyrights

- Protects original works of authorship fixed in a tangible medium:
 - Textual
 - Audio-Visual
 - Graphic
 - Software
- Bundle of exclusive rights:
 - Make and distribute copies
 - Perform
 - Display
- Typically long duration—up to 90 years in U.S. for businesses and life of the author plus 75 years for individuals.

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Copyrights (...cont'd)

- Berne Convention automatically extends protection of non-U.S. author's copyrights to the U.S. whether registered or unregistered.
- Registration in the U.S. is generally available and, although not required, may be necessary to sue for infringement and may enhance the potential recovery.
- The term "copyrighted" can be confusing with respect to the U.S.:
 - Can refer to the copyright having been registered, or
 - Can mean protected by copyright law, which does not require registration in the U.S.
- Where a business seeking to expand to the U.S. is heavily dependent on works of authorship, best practice to consult competent U.S. copyright counsel. There are many quirks in the Copyright Law.
- Use of a copyright notice—© 2019 XYZ Inc.—is not required but has benefits and is a recommended best practice.

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