

Intellectual Property Protection Around the World



Susan Anthony, Acting Director,
Global Intellectual Property Academy
Susan.Anthony@uspto.gov or 571-272-1500



Definitions – What Are We Trying to Protect?

Intellectual Property, simply stated, is “property of the mind”:

- **TRADEMARK** -> any word, name, symbol, or device (or any combination thereof) used to identify and distinguish goods or services and to indicate their source. (Term “*counterfeiting*” refers to trademark.)
- **COPYRIGHT** -> an original artistic or literary work (Term “*piracy*” refers to copyright.)
- **PATENT** -> an invention.
- **TRADE SECRET** -> confidential commercial information.



Definitions – What Are We Trying to Protect?

- **These IP rights are often confused.**
 - There are some similarities, but these IP rights are different, and they serve different purposes.
- **But these IP rights are not mutually exclusive.**
 - For any one product, more than one form of IP protection may apply, as long as it meets the requirements of the laws that govern that form of protection.



Overlapping IP Protection

The types of IP – patents, trademarks, trademarks, copyrights, trade secrets – need not be mutually exclusive. So...

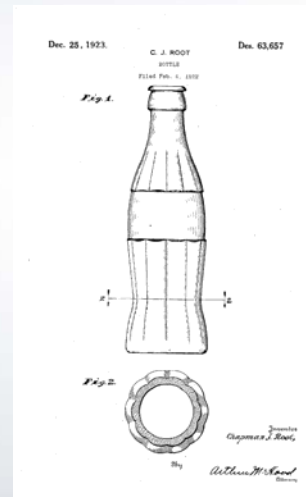
for a CLASSIC example of overlapping IP protection....



Overlapping IP Protection: The Coca-Cola Contour Bottle

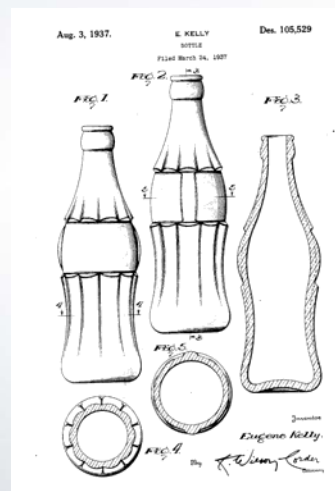
In 1915, the Root Glass Company won a Coca-Cola Company contest for a bottle design that would be recognizable to everyone, even by touch in the dark.

The first **design patent** on the “hobble skirt” contour bottle was granted on Dec. 25, 1923, to the bottle manufacturer (known as “the Christmas bottle”).



Overlapping IP Protection: The Coca-Cola Contour Bottle

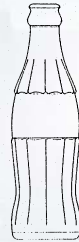
The second **design patent** for the contour bottle was granted to the Coca-Cola Company on August 3, 1937, preventing imitation of the bottle for another 14 years.





Overlapping IP Protection: The Coca-Cola Contour Bottle

- The **bottle shape** became so well known that it became synonymous with the Coca-Cola product.



- The Coca-Cola Company sought and obtained a federal **trademark registration** for its contour bottle shape on April 12, 1960.



Overlapping IP Protection: The Coca-Cola Contour Bottle

- **Patent:** shape of bottle
- **Trademark:** COCA-COLA, COKE, shape of bottle
- **Copyright:** advertising and promotion
- **Trade Secret:** the formula (*SHHH! It's a secret!*)

This slide has a dark blue header band at the top. On the left side of the band is the same USPTO seal as seen in the first slide. To the right of the seal, the title "The Very First Step: The Needs Assessment" is written in a white, sans-serif font. Below the header, the main content area has a light gray background with a faint image of a building. It contains a bulleted list of three points:

- Small businesses often fail to identify their business assets that may be protected by one or more types of IP.
- Too often, small businesses opt for a piecemeal, after-the-fact, approach to IP after the product has been introduced into the marketplace – when it often is too late.
- The very first step for any small business, in terms of IP, is to figure out what they have. This is called a “needs assessment” or “IP audit.”



The Needs Assessment or IP Audit: The Mechanics

For assets that your business owns, you should determine:

1. The type(s) of IP protection that may be available;
2. The countries, regions or markets where each IP asset needs protection;
3. Whether, and to what extent, the type(s) of IP protection identified are available in that country;
4. The duration, or “life,” of each type of IP;
5. The costs of protecting the IP asset in a particular country (and of failing to protect); and
6. The value of each IP asset to the company and whether it merits protection in a particular country.



TYPES OF IP: PATENTS



What is a Patent?

- Property Right
 - right to exclude others from making, using, selling, offering for sale or importing the claimed invention
 - limited term
 - territorial – protection only where patent granted
- Exchange
 - inventor discloses the invention in exchange for the opportunity to receive the patent grant and its associated rights



Types of U.S. Patents

- Utility
 - Inventions
 - 20 year term from **filing date**
- Plant
 - New variety of asexually reproduced plant
 - 20 year term from **filing date**
- Design
 - Ornamental design described and shown
 - 14 year term from **grant date**
 - for design applications filed before 13 May 2015
 - 15 year term from **grant date**
 - for design applications filed on/after 13 May 2015



U.S. Standards of Patentability

Design patent --

- Must be **NOVEL** (new) or different from all prior inventions or “prior art”
- Must be **NON-OBVIOUS** - invention sought to be patented is not obvious "to one of ordinary skill in the art“

Utility Patent also --

- Must have a **USEFUL** purpose and work, at least in theory



Why Obtain Patents?

- Patents can restrict your competitors.
- A patent on a product can give your product credibility.
- A patent may help provide revenue through licensing or sale.
- A patent can be used to get additional capital for your business.
- Design patent protection can be fairly inexpensive to acquire, compared to utility patent protection, but effective in protecting products.
- Increasingly, sales and competition are based on the appearance and feel of products when they have similar functions.



Whether to Patent General Considerations

- Conduct cost/benefit analysis by considering
 - the shelf life of a product, e.g., changes in technology, style
 - how the patent will be used, e.g. licensing, to exclude competitors
 - whether the product can be used outside your market
- Determine patentability
 - searching yourself vs. engaging a professional searcher
- Choose right patent attorney/agent
- Preparation of a thorough and accurate application
- Manage expense
 - background work can help to keep attorney fees lower
- Pay maintenance fees



Options for Foreign Filing

- File a patent application directly in a national or regional patent office
 - Paris Convention
- File an international patent application under the Patent Cooperation Treaty (PCT)
 - with a Receiving Office



PCT Benefits for Applicants

For the utility patent --

- Simplifies the process of filing foreign applications
 - one set of formality requirements
 - establishes a filing date in all PCT Contracting States
- Postpones costs
 - filing fees, translation fees, attorney fees
- Provides
 - an early indication of prior art and
 - a written opinion as to the novelty, inventive step and industrial applicability of the claimed invention
- Gives extra time for assessment of commercial viability in designated States



Hague System for International Registration of Industrial Designs

For the design patent --

- Single international design application capable of being registered in 64* countries
 - *U.S. will become a Contracting Party on 13 May 2015
- Register up to 100 industrial designs with a single application



What are Designs?

- U.S. issues a “Design Patent”
- Ornamental design for an article of manufacture
- Protects only the appearance of an article, not structural or functional features
- Subject matter of an application may relate to:
 - Configuration or shape of article
 - Surface ornamentation applied to an article

4/20/2015

21



Hague System: Basic Concept

- The centralized acquisition and maintenance of industrial design rights
 - by filing a single international application
 - for a single international registration
 - with effect in one or more designated Contracting Parties.

4/20/2015

22



What is the Hague System?

- A single international application for a single international registration (IR) in which one or more Contracting Parties (CP) are designated
- If no refusal, the resulting international registration has the effect of a grant of protection in each designated Contracting Party

4/20/2015

23



...And What it is Not

- Since the Hague System is primarily a procedural arrangement, it does not determine:
 - the conditions for protection;
 - the refusal procedure to be applied when deciding whether a design may be protected; or
 - the rights which result from protection.
- Such issues are governed by the law of each Contracting Party designated in an international registration.

4/20/2015

24



TYPES OF IP: TRADEMARKS



What is a Trademark?

- **What is a trademark?**
 - Word, slogan, symbol, design or combination thereof used to **identify or distinguish goods of one party from those of others.**
- **What is “trade dress”?**
 - Design of a product (shape), packaging in which a product is sold (“dressing”), color of product or packaging, “almost anything at all that is capable of carrying meaning.”





Top Global Brands

Interbrand ■■■

Rankings

01 Apple +21% 188,963 \$m	02 Google +18% 127,439 \$m	03 Coca-Cola +3% 21,563 \$m	04 IBM -8% 72,244 \$m	05 Microsoft +3% 61,134 \$m	06 GE -3% 45,460 \$m	07 Lexus +15% 45,462 \$m	08 Toyota +20% 42,352 \$m
09 McDonald's +1% 42,254 \$m	10 Mercedes-Benz +8% 34,338 \$m	11 BMW +7% 34,214 \$m	12 Intel -8% 34,133 \$m	13 Disney +14% 32,223 \$m	14 Alibaba +6% 30,306 \$m	15 Amazon +25% 29,478 \$m	
16 Oracle +8% 25,300 \$m	17 HP -8% 23,758 \$m	18 Gillette -9% 22,845 \$m	19 Lexus -9% 22,552 \$m	20 Honda +17% 21,673 \$m	21 H&M +15% 21,083 \$m	22 Nike +15% 19,275 \$m	
23 Microsoft +11% 19,510 \$m	24 PepsiCo +7% 18,119 \$m	25 SAP +4% 17,340 \$m	26 Tesla +15% 15,595 \$m	27 UPS +3% 14,470 \$m	28 eBay +8% 14,358 \$m	29 Facebook +8% 14,078 \$m	
30 Pfizer +8% 14,078 \$m		31 Volkswagen +4% 13,442 \$m		32 Allegro +4% 13,442 \$m	33 HSBC +8% 13,142 \$m	34 JPMorgan +3% 13,024 \$m	35 JPMorgan +9% 12,456 \$m
36 ZARA +4% 12,456 \$m		37 Canon +3% 12,456 \$m		38 Nissan +3% 12,456 \$m	39 Ford +3% 12,456 \$m		



Types of Trademarks

Word Mark

COCA-COLA

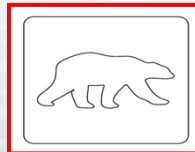
Special Form Mark

Coca-Cola

Composite Mark






Design Mark



Slogan



Unusual Trademarks in the U.S.

- Shape: Bottle shape for beverage 
- Color: Red color for beverage 
- Sound: Mystery sound mark: Can you identify it? 



Select Strong Trademarks!

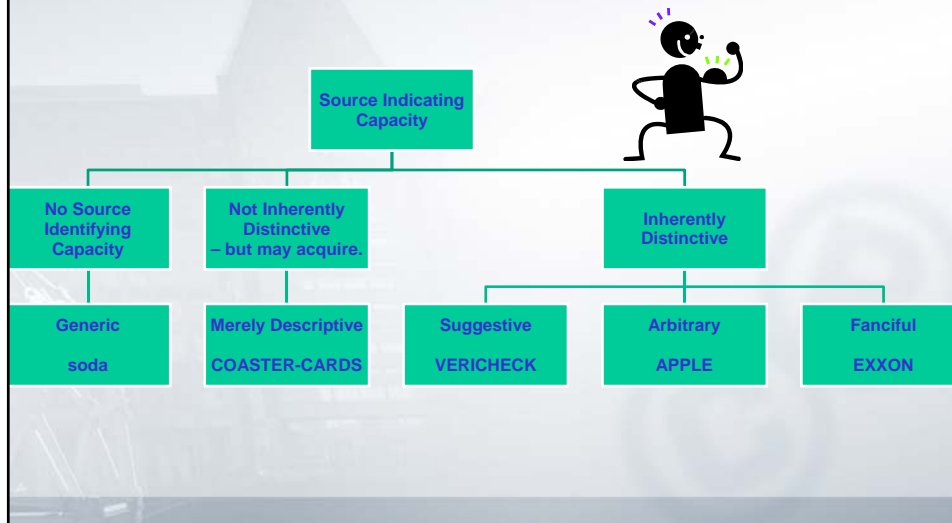
In general, the more “**distinctive**” a mark is, the **stronger** it is and the **greater the scope of protection** the mark will receive in court against uses of the same or similar marks.

Because all trademarks do not receive or deserve the same scope of protection, the type of mark a business selects will have a direct effect on its ability to protect the mark.





Trademark Continuum



Why Protect Trademarks?

- Trademarks create identity in a product (or service).
- Trademarks foster trust in a product (or service).
- Like patents, trademarks may help provide revenue through licensing or sale.
- Like patents, trademarks can be used to get additional capital for your business.
- Unlike patents, trademarks are less expensive to acquire.



Does a Company Need to Register its Mark in the U.S.?

- Not required, because trademark rights (in the U.S.) arise from **use** on or in connection with goods or services, **BUT...**
 - There are significant **advantages** to having a federal trademark registration.



Advantages of Federal Registration on Principal Register

- Public notice of your claim of ownership of the mark;
- A legal presumption of your ownership of the mark and your exclusive right to use the mark nationwide on or in connection with the goods/services listed in the registration;
- The ability to bring an action concerning the mark in federal court;
- The use of the U.S. registration as a basis to obtain registration in foreign countries;
- The right to use the federal registration symbol ®;
- Listing in the USPTO online databases; and
- Registration may be recorded with U.S. Customs and Border Protection to prevent importation of infringing foreign goods.



The Concept of Territoriality

- **Many business fail to understand that patents and trademarks are “territorial.”**
 - Research conducted in the spring of 2005 by the USPTO indicates that only 15 percent of small businesses that do business overseas know that a U.S. patent or trademark provides protection only in the United States.

4/20/2015

35



Failure to register can be very expensive!

If you export your goods to another country and have not protected your mark;

- Another “business” may apply in that country to register “your” mark.
- If that “business” successfully registers “your” mark, then you could be forced to pay licensing fees for use of the mark or
- Even be put out of business!

This is because in many countries trademark rights arise only through registration of that mark. If you haven’t registered or applied for registration, you have no legal rights in the mark.

36



Can a US business get trademark protection abroad through a website?

There are two avenues for using a US trademark registration (and in some cases an application) to obtain rights in other countries:

- The Paris Convention
- The Madrid Protocol

And that website is: www.uspto.gov

37



Principal Advantages of the Protocol

- Almost immediate filing date in countries where extension is sought. US basic application can often be used to make a claim of priority.
- May save costs of appointing local counsel.
- Saves translation costs.
- Provides for very inexpensive and simple maintenance procedures, such as change of name, change of address, assignments and renewal, of multiple rights.

38



TYPES OF IP: COPYRIGHTS



What is Copyright?

Copyright is a legal protection for the authors of “original works of authorship,” including literary, dramatic, musical, artistic, and certain other intellectual works.



Copyright: A Bundle of Rights

- Make copies
- Prepare derivative works
- Distribute copies
- Perform the work publicly
- Display the work publicly



Types of Copyrighted Works

- When we think of “copyrights,” we generally think of movies, music, books, videogames, software.
- But “copyright” also may protect many assets that every business has, such as, logos, materials to educate employees or consumers about a business or product, product drawings, designs and packaging, advertising and promotional materials, and websites.



What Works are Protected?

- Work must be **fixed** in a tangible form of expression.
- The fixation need not be directly perceptible so long as it may be communicated with the aid of a machine or device.



What Works are Protected?

- Must be an **original** work of authorship, meaning that the work must be independently created by the author (as opposed to copied from other works).
- The U.S.' required level of originality is very low. Other countries' laws may differ in this respect.



Criteria For Protection

- Protection is “automatic,” in that registration is not required for protection, in the U.S. or other countries.
- Some countries, like the U.S., do have registration systems. But registration is not required to confer rights in those countries.



Why Register?

Even though protection is automatic, there are several good reasons for registration of the copyright in the work:

- *To maintain a record of works*
- *To publicize the rights of owners*
- *To give evidence of ownership and authentication of intellectual property.*

<http://copyright.gov/help/faq/faq-general.html#automatic>

Also, having registrations for copyrighted works may make it easier to license works, collect royalties, and enforce rights outside of court.



Developing the IP Portfolio



Failure to Understand the Concept of “Territoriality”

- **Failure to understand that trademark registration is required to have effective rights in almost all countries of the world and failure to understand that a patent is required in any country where a company wants to enforce its patent rights.**
 - Use of a trademark on goods or services without registration does not provide trademark protection, except in a handful of countries (like the U.S.).
 - The concept of “prior art” may not protect a patent holder against issuance of an infringing patent; the patent holder must have a patent in that country to enforce against the infringing patent.



Where to Patent: Patent Law Considerations

- Standards of patentability in country/region
 - patentable subject matter differences
 - prior art differences
 - some countries have only a registration system
 - no substantive examination
- Types of protection differ
 - patent, inventor's certificate, utility certificate, utility model, petty patent, patent of addition, certificate of addition, inventor's certificate of addition, utility certificate of addition, industrial design



Where to Patent: Business Considerations

- Market size and potential of country/region
- Manufacturing potential
- Industry size and growth
- Competition activity
- Patent procurement costs



Where to Patent: Enforcement Considerations

- Enforceability of patents
- Enforcement requires patent owner action
- Competitor products should be monitored
- Licensing may be beneficial



Where to Register Trademarks

- Your goods or services are **marketed**;
- Products or parts for your products are **manufactured**;
- **Research and development facilities** are located;
- Your products are **trans-shipped**;
- You **might expand your business** in the future;
- **Counterfeiting** is likely to be a problem; and
- Where your **competitors** are.



Where to Register Domain Names

- Country-code top-level domains
 - .gh, .ng, .ci, .sn
 - Regional domains
 - .eu; .africa (not yet launched)
 - Current generic top-level domains (gTLDs), e.g., .com, .org
 - Recently launched and soon-to-be launched gTLDs
- Resource: <http://www.icann.org>



When Do I Need an Attorney?

- Not required to file a U.S. patent application, but advisable;
- Not required to file for U.S. trademark registration, but advisable;
- Not required to file for U.S. copyright registration, but advisable;
- For filings outside the U.S., working with your U.S. attorney – who will have networks of patent and trademark attorneys and agents – is imperative;
- For disputes, whether in the U.S. or elsewhere, securing an attorney's services is imperative.

Questions?



Susan Anthony, Esquire, Acting Director,
Global Intellectual Property Academy,
Office of Policy and International Affairs, USPTO
Susan.Anthony@uspto.gov or (571) 272-1500