

# IPR and Exports Trademark and Copyright Principles

David M. Abrahams  
Webster, Chamberlain & Bean, LLP

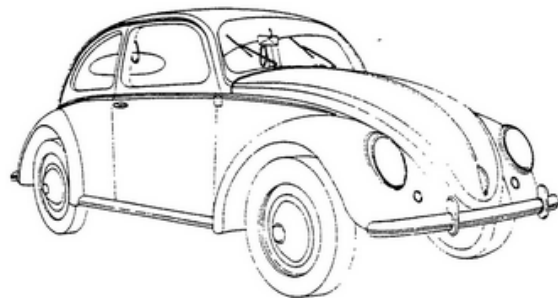


# Trademarks

- \* Brand Identifiers
- \* Identify a seller's goods and distinguishes them from others
- \* Signify that all goods bearing that mark come from a single producer
- \* Communicate that goods bearing that mark will be of a certain quality.

# What Can Serve as Trademarks?

- \* Words, names, symbols, and designs.
- \* Configurations



# What Can Serve as Trademarks?

- \* Colors



- \* Sound – e.g. NBC Chime, AAMCO



- \* Scent

- \* Product Features



# Why Protect Marks Overseas?

- \* Trademarks are national in scope.
- \* Prevents others from using and registering infringing marks overseas.
- \* Prevents prospective business partners from running away with your trademarks.
- \* If another party “takes” your trademark in a foreign country, it could cause numerous problems.

# Why Register Your Marks?

- \* In the U.S., use is the touchstone for trademark rights, not registration.
- \* Registration aids in the enforcement of U.S. trademark rights:
  - Right to use ®.
  - Proof of ownership and exclusive right to use nationwide.
  - Ability to bring infringement actions in federal court.
  - Ability to file registration with U.S. Customs and Border Protection to prevent importation of infringing foreign goods.
  - Use of registration as basis to obtain registration in foreign countries.

# Registration Outside of U.S.

- \* In countries outside of U.S., national registration is the only way to have enforceable trademark rights.
- \* In most countries around the world, the first to file gets superior trademark rights.
- \* Two options – Madrid Protocol Treaty filings and National Applications in individual countries

# Madrid Protocol

- \* Administered through the World Intellectual Property Organization.
- \* Permits filing of a single application in all countries designated by the applicant.
- \* Currently over 100 countries participate, including U.S., Canada, Mexico and all EU countries.



# Madrid Protocol Pros & Cons

## Pros

- \* Single filing can cover a lot of ground.
- \* Potential savings on the front end – applications can be filed by your U.S. attorneys.
- \* Retaining foreign counsel is only necessary if a refusal is issued.

## Cons

- \* Application must be based off of home application or registration and limited to goods and services in the home registration/application.
- \* Vulnerable to central attack. If home registration/application is refused or successfully challenged, the Madrid Registration falls.

# National Applications

- \* File directly with the individual trademark offices of choice using local attorneys.
- \* Each application stands independently on its own.
- \* Applications can have a greater scope of goods or services than the home registration/application.

# National Applications - EUTMs

- \* Can register for protection in all countries of the European Union through a single trademark filing.
- \* Provides protection in all EU countries and scope can expand as other countries join the EU (e.g. Turkey, Serbia, Montenegro pending membership).
- \* Must be filed by an attorney licensed to practice in an EU country.
- \* With Brexit, UK must be applied for separately.

# Protection by Agreement

- \* Enter into agreements with prospective and existing business partners where they promise not to adopt, register or use similar marks or take any detrimental action.
- \* Language can be placed in license agreements, sales agreements or pre-business relationship agreements like NDAs.
- \* If you have no trademark rights in a given country, an agreement at least provides a contractual basis for legal relief.

# Where to File? – Key Considerations

- \* Countries with sizeable revenue streams or consumer bases for your company.
- \* Places where your company has business operations.
- \* Countries where your company's relevant market or targeted need for product is growing.
- \* Places where you anticipate expansion.
- \* Defensive filings in countries with high rates of counterfeiting, e.g., China, Brazil, India.

# Trademark Searches

- \* Not required, but recommended as a due diligence tool.
- \* Typical searches review a country's trademark registers to identify potential conflicts that could bar registration. They can also reveal unregistered trademarks that owners can use as a basis to challenge rights.
- \* May not uncover 100% of conflicts, but provide a pretty good picture.

# Copyright

- \* The exclusive right of a creator of a creative work (e.g. book, article, photograph, painting, sculpture) to exploit that work.
- \* Copyrights are created as soon as pen is put to paper.
- \* Copyrights are finite in nature. Length varies by country.

# Elements of a Copyright

- \* **Originality** – The work must have some minimal degree of creativity and independently created by the author.
  
- \* **Work of Authorship** – U.S. Copyright Act recognizes the following:
  - Literary works (includes books and software)
  - Musical works, including accompanying words
  - Dramatic works, including accompanying music
  - Pantomimes and choreographic works
  - Pictorial, graphic and sculptural works (e.g. certain ornamental features of automobiles)
  - Motion pictures and other audiovisual works
  - Sound recordings
  - Architectural works



# Elements of Copyright

- \* **Tangible Medium** – A copyrighted work must be captured on a permanent medium such as paper, canvass, hard drive, etc. Copyrighted works cannot be ephemeral.
- \* Mere ideas are not protected by copyright.

# Copyright Ownership

- \* General Rule – “She/He who creates, owns.”
- \* Works Made for Hire – Works created by employees in the scope of their employment are owned by the employer.
- \* Copyright ownership can also be secured through written agreement.

# Exclusive Rights of Copyright Ownership

- \* **The Right to Reproduce** – only the copyright owner can make copies.
- \* **The Right to Distribute Copies to the Public** – only the copyright owner can make a work available to the public.
- \* **The Right to Publicly Perform the Work** – this gives the copyright owner the ability to control the public performance of the work
- \* **The Right to Publicly Display the Work** – only the copyright owner can publicly display their work, including online displays.
- \* **The Right to Create Derivative Works** – only the copyright owner can create adaptations of the original work such as translations, dramatizations, sound recordings, abridgments or any other forms which the original work can be recast, transformed or adapted.

# Copyright Registration

- \* Copyright registration in the U.S. provides the owner with additional rights to aid in enforcement, including:
  - The right to pursue infringement claims in federal court.
  - Presumption of ownership and validity of copyright.
  - The ability to collect statutory damages of up to \$30,000 per infringement (\$150,000 if intentional) without the need to prove damages.
  - The ability to collect attorney's fees.
  - Ability to record registration with U.S. Customs and Border Protection to prevent importation of infringing copies.

# Copyright – International Considerations

- \* Generally, there is no “international copyright” that provides universal protection throughout the world.
- \* Copyright protection abroad depends on national law.
- \* Many countries offer protection to foreign works through a latticework of international treaties and agreements such as the Berne Convention and the World Trade Organization TRIPS Agreement.
- \* Under these treaties, foreign nationals will get the same protections as nationals under their local copyright laws.
- \* Some countries offer little to no protection to foreign works.

# Copyright – International Considerations

- \* Before publishing a work anywhere, investigate the scope of protection available and well as the specific legal requirements for copyright protection in the country where protection is desired.
- \* If you intend to do business overseas, it is advisable to register your works with the U.S. Copyright Office, at the very least.
- \* Like trademarks, you can also protect copyrights through contract. When in the pre-business relationship phase, enter into NDA's in which your prospective business partner acknowledges your copyrights and agrees not to take infringing actions.

## SEMA Export Webinar - Patents

June 17, 2020

Curt Dosier, Partner



# Topics for Discussion

---

Timing of Patent Application Filing

What is a Patent?

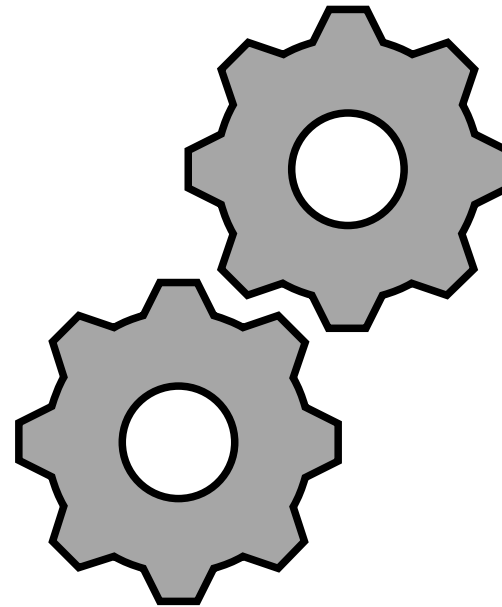
Types of Patents

Basic Patent Process Steps

Pathways to Foreign Patent Protection

Where to File?

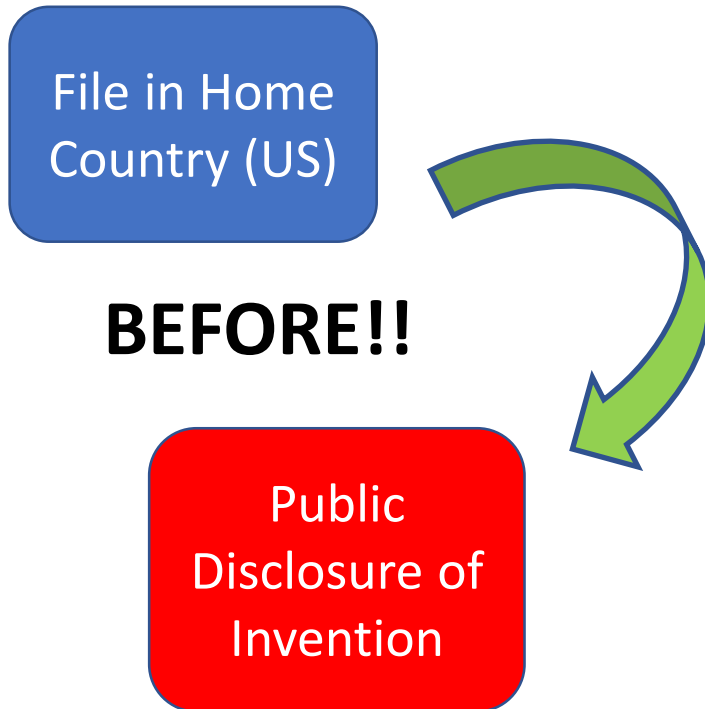
Example Filing Scenarios





# Timing of Patent Application Filing

---



## To Preserve Foreign Patent Opportunities:

**Determine Patent Strategy Prior to Public Disclosure of Invention.**

1. Speak to your IP Attorney
2. File in Home Country (if desired)
3. Disclose Only After Desired Home Country Application(s) Are Filed
4. Foreign Patent Filings with Priority Claim



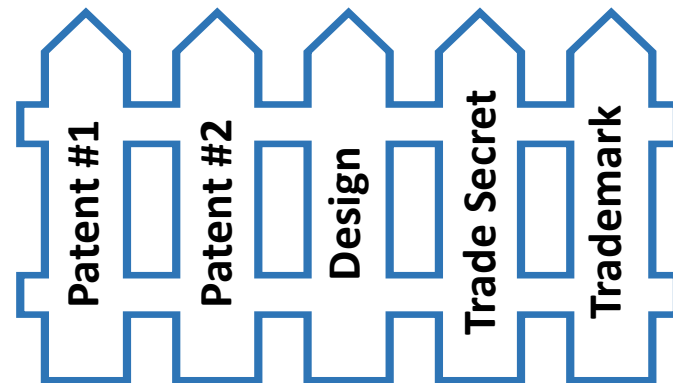
# What is a Patent?

---

- Right to Exclude Others from Making/Using/Selling *Patented Invention*
- Not a Right to Make/Use/Sell a *Product* Embodying the Patented Invention

Your product can infringe an earlier unexpired Patent.

## Patent/IP “Picket Fence”



# Types of Patents

---

## Utility (Invention) Patent

- Protects Functional Features
- 20 year term (from filing)
- Examined for Patentability
- Can be Invalidated Post-Issuance
- **Provisional (US)\***

## Utility Model

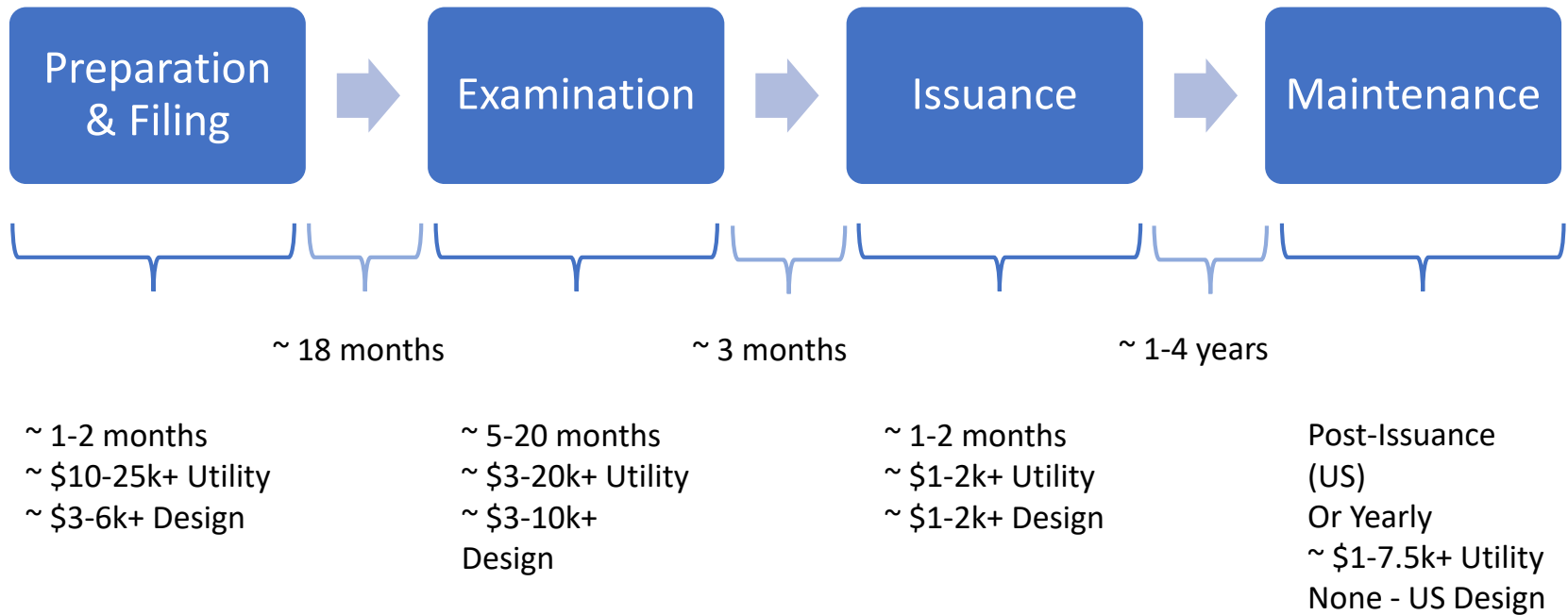
- Protects Functional Features
- 6-15 year term (from filing)
- Usually Examined for Formal Issues
- Examined for Patentability upon Enforcement
- Can be Invalidated Post-Issuance

## Design Patent

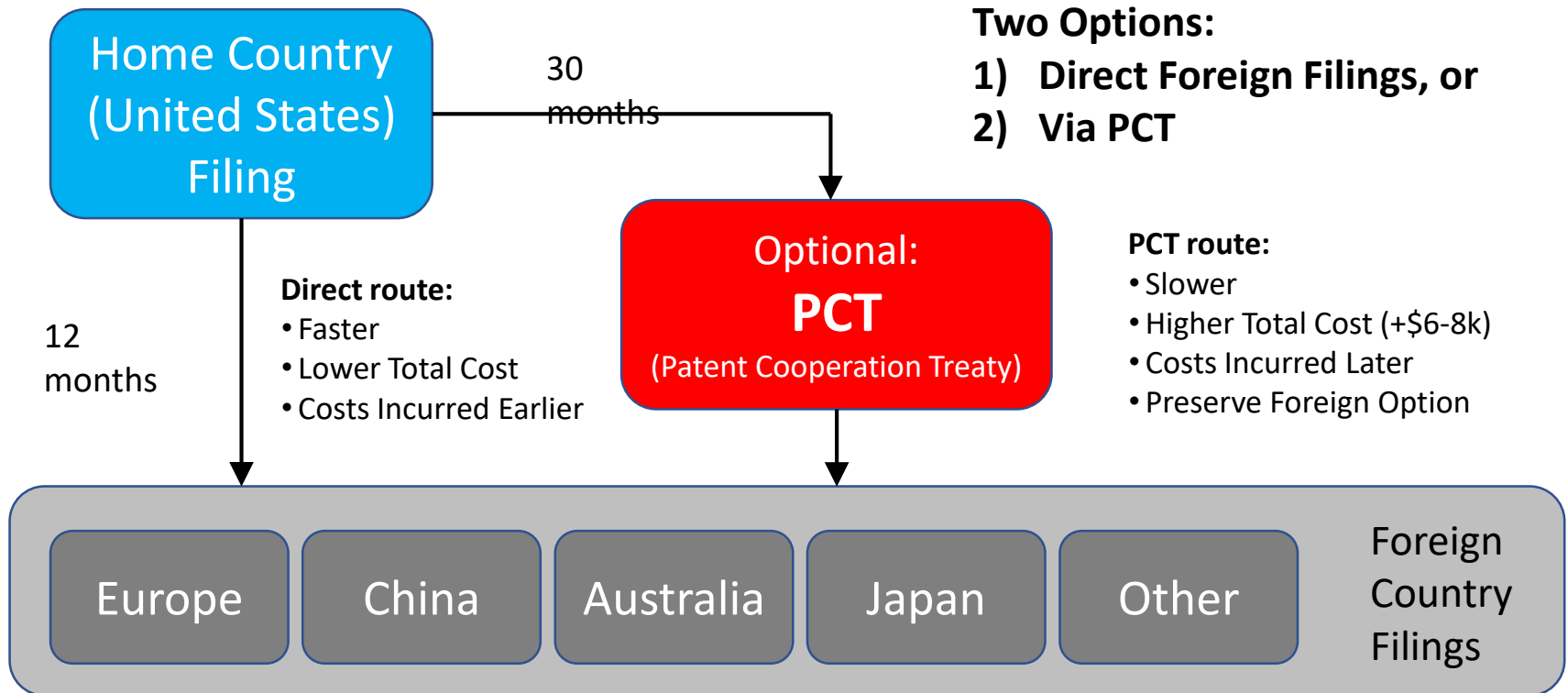
- Protects Ornamental Features (Appearance)
- 15-25 year term (from filing)
- Patentability Exam or Formality Review depending on Country
- Can be Invalidated Post-Issuance



# Basic Patent Process Steps



# Pathways to Foreign Patent Protection



## Two Options:

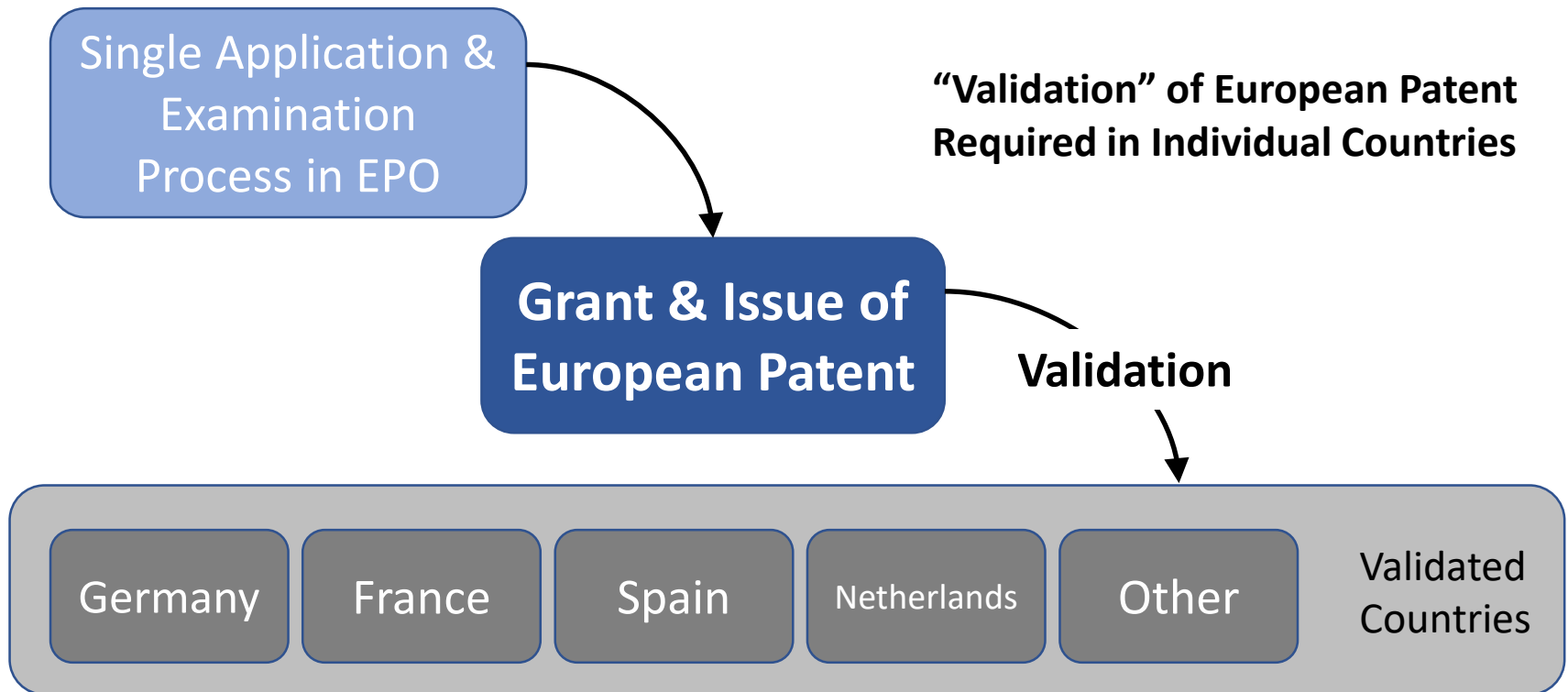
- 1) Direct Foreign Filings, or
- 2) Via PCT

### PCT route:

- Slower
- Higher Total Cost (+\$6-8k)
- Costs Incurred Later
- Preserve Foreign Option

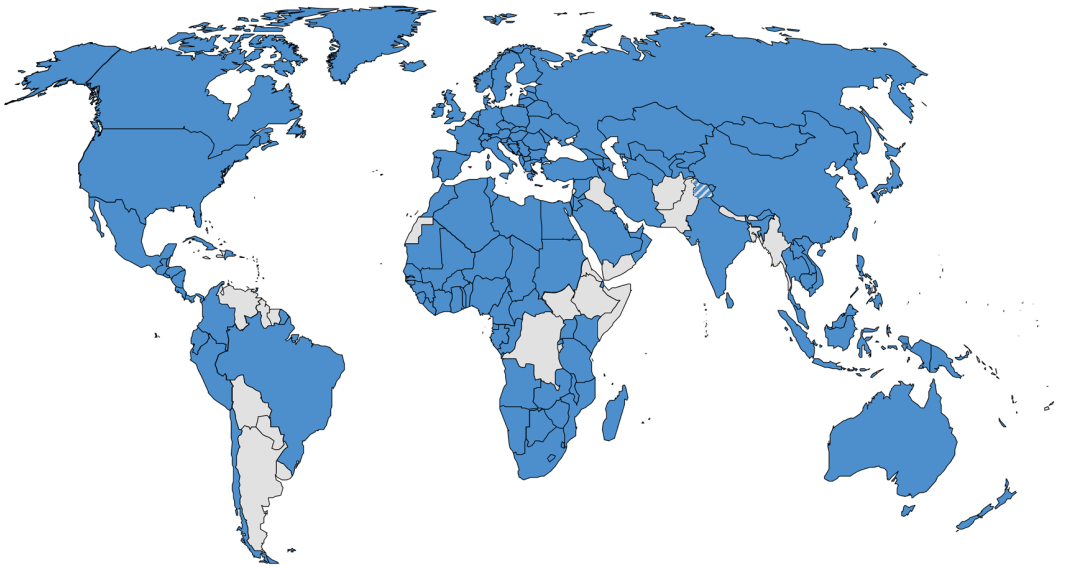


# Pathways to Foreign Patent Protection – European Patent Office (EPO)



# Where to File?

---

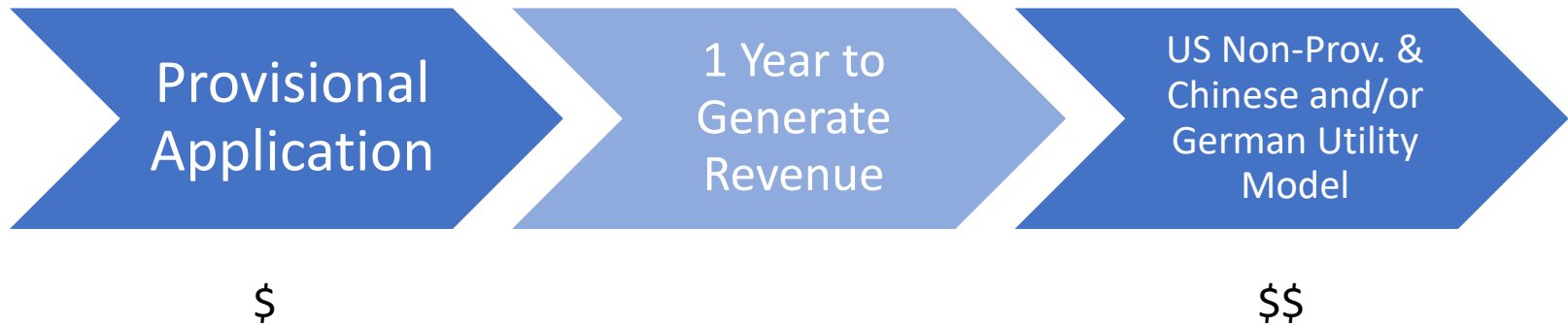


- Commercial Market
- Location of Manufacture
- Country of Importation
  - (e.g., The Netherlands)
- Ease of Enforcement
  - (e.g., Germany)



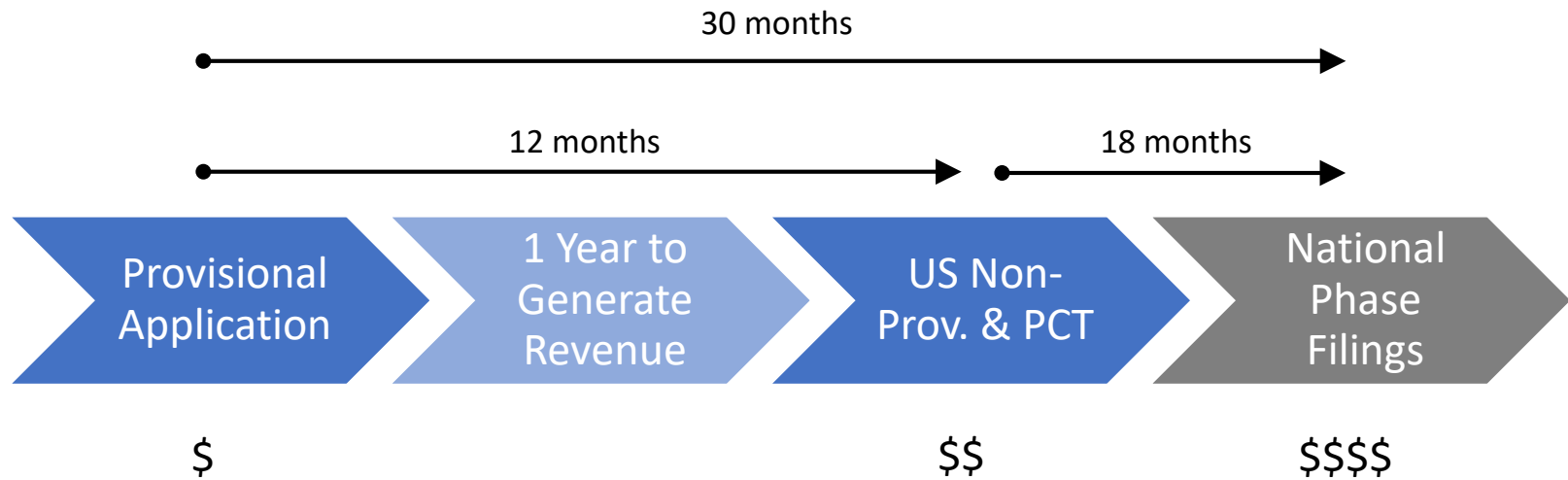
# Example Filing Scenario #1

---





# Example Filing Scenario #2



# Knobbe Martens

Curt Dosier, Partner  
Irvine, CA Office

[Curtiss.Dosier@knobbe.com](mailto:Curtiss.Dosier@knobbe.com)

949-721-7613

