Think Ahead: Know the Nuances of International Intellectual Property Law

Companies planning to do business in the United States should study up on international intellectual property and copyright laws to ensure the protections they've enjoyed in their home countries and regions extend to the United States. Be forewarned: in many cases they don't.

Just as a United States patent or trademark offers no protection in other countries, such a designation from other countries carry little weight for foreign companies and individuals bringing their products and ideas to U.S. markets.

"What someone planning to do business in U.S. markets needs to ask is, 'Does my intellectual property constitute copyright, trademark, or trade secret material?'," explains Eric Ludwig, ESQ, an experienced, US-based trial lawyer with an extensive background in intellectual property and business litigation. "If so, he or she then needs to determine if the product or service from a foreign jurisdiction is covered by a foreign patent or a US patent? In most cases, the answer is no."

That said, individuals or companies entering U.S. markets need to understand what intellectual property of theirs will be placed in U.S markets and how. Only then will they know whether they need to apply for a trademark or patent with the U.S. Patent and Trademark Office (USPTO) to protect their invention, creative work, design, or idea . . . or if they need to seek copyright protection.

Copyright protection, which protects works of authorship including literary, dramatic, musical, and artistic works such as poetry, novels, movies, songs, computer software, and architecture, is an entirely different—and seemingly easier to navigate—story than patents and trademarks. While there is no such thing as 100 percent international copyright protection, the United States and most other countries in the world offer protection according to international copyright treaties and conventions. Some 148 countries currently participate, offering certain base levels of protection.

As for Intellectual Property, the Patent Cooperation Treaty (PCT) offers a level of patent protection for inventions in more than 150 nations using just one international

application. Essentially, an inventor or company can file an international patent application with one or more contracting states and, once approved, enjoy protection in multiple countries. Of course, to ensure maximum protection, countries doing business in the United States who are concerned about their Intellectual Property should file with the USPTO.

Intellectual Property Checklist

When determining the need to apply for copyright, patent, and/or trademark protection, non-US entities need to weigh the following:

1. First and foremost, is the product or service from a foreign (non-USA) jurisdiction already covered by a foreign patent or a US patent? If there are foreign patent rights, was a US patent application filed? (Without a US patent, the foreign patent has no effect.)
2. Does the intellectual property in question constitute copyright, trademark, or trade secret material?

   Pertaining to Copyright:

   Copyright equals some form of creative expression that's fixed in a tangible medium, such as non-open source software code, art, text, books, photos, videos, movies, songs, recordings, drawings, etc.

   - Under US and applicable foreign jurisdiction, is the question of ownership of the copyright settled?
   - Has the work been registered with the US copyright office? (Although copyright registration is not required to claim ownership, it is a prerequisite to asserting rights and stopping someone from infringing.)

   Pertaining to Trademarks:

   A trademark is a symbol, word, phrase, sound, color, or other unique identifier of specific goods or services from a specific source.

   - If using a foreign mark or brand in the US, was the foreign mark previously registered with the USPTO?
   - Is the foreign mark potentially in conflict with an existing US trademark or service mark?

   Pertaining to Trade Secrets:

   A trade secret is any confidential, non-public formula, practice, design, method, compilation, device, or other information that has economic value and is used in business.

- Was secrecy properly maintained?
- Is there a risk of inadvertent disclosure by introducing the product/service into the US market that is based upon or includes trade secret material?

Due Diligence Pays Off

When entering the US market, it's imperative for non-US companies and individuals to understand whether and/or how their products or services might infringe upon intellectual property rights in the United States. They need to do due diligence on applicable intellectual properties, to include a freedom to operate analysis (an assessment to determine whether a product, technology, or invention infringes on existing patent claims or another's intellectual property rights), and ensure they have sufficient insurance to cover claims of intellectual property infringement and/or product defect for liability claims arising in the U.S. market.

To mitigate concerns and legal exposure in all of these areas, any foreign/overseas company or individual considering doing business in the United States should retain competent US-based legal counsel to advise on various legal issues, especially in the area of intellectual property laws.

Protect Your Product. Your Business. Your Dreams.

Contact Eric Ludwig today for a free, one-hour consultation to discuss whether you need to apply for copyright, patent, and/or trademark protection in the United States.
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