Protecting Your Intellectual Property in the United States and Abroad

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What is Intellectual Property?

- **Patents**
  - New and non-obvious products and processes

- **Trademarks**
  - Indicators of source

- **Copyrights**
  - Original works of authorship
Patents
Patents

- Patent gives its owner an absolute monopoly in the invention.
- The invention is defined by the claims.
What is claimed is:

1. An improved fire extinguisher comprising: a tank; a pressurized cartridge supported and retained within said tank; a puncturing mechanism sealably coupled to said tank in position for manual puncturing of said cartridge; a normally closed check valve communicating through and connected to the bottom of said tank; an outlet hose connected to the outlet of said check valve; and, a U-shaped carrying handle having the terminal ends thereof connected, respectively, to opposite sides of said tank, said handle having its arcuate base portion of U-shaped cross section to retain a portion of said hose, whereby the remainder of the hose may extend upwardly along one side and downwardly along the other side of said tank.
Universal novelty: The invention must be new and non-obvious at the effective “priority” date of the application.

The U.S. has a 12-month grace period, but it does not protect foreign applications.
Patents are Regional in Scope
Regional Systems for Patents

- **Patents**
  - European Patent
  - Single Patent Office
    - Examines application
    - Approves patent claims
    - Patents effective in elected member countries after translation and confirmation
  - ARIPO Havre Protocol
    - Botswana
    - Gambia
    - Ghana
    - Kenya
    - Lesotho
    - Malawi
    - Mozambique
    - Sierra Leone
    - Sudan
    - Swaziland
    - Uganda
    - Zambia
    - Zimbabwe
Regional Systems for Patents

- **Patents**
  - **Eurasian Patent Convention**
    - Armenia
    - Azerbaijan
    - Belarus
    - Kazakhstan
    - Kyrgyzstan
  - **OAPI Agreement**
    - Benin
    - Burkina Faso
    - Cameroon
    - Central African Republic
    - Congo
    - Ivory Coast
    - Mauritania
    - Moldova
    - Russian Federation
    - Tajikistan
    - Turkmenistan
    - Niger
    - Senegal
    - Tchad
    - Togo
    - Mali Republic
    - Guinea
Supra-National Applications for Patents

- PCT
  - A filing procedure effective for over 140 countries
  - Delays national filings by approximately 18 months
  - Phase I - filing at U.S. Patent and Trademark Office in English
    - International Search Report
  - Phase II - “opinion” from World Intellectual Property Office on patentability
  - After Phase I or Phase II
    - Entry into national phase
PCT Application

- Single application with same effect as national applications in designated countries
- File at U.S. Patent and Trademark Office
- File in English
- No translation costs
- No foreign associates’ fees
- Can claim priority under Paris Convention
PCT Statistics

Filings:  
About 20,000 in 1990  
About 90,000 in 2000  
About 155,000 in 2009  
About 194,000 in 2012
What is a Trademark?

- **Word**: APPLE
- **Symbol**: 🚗
- **Slogan**: JUST DO IT.
- **Product or Packaging**: 🍬
- **Sound**
- **Color**: 🦓
What is a Trademark?

- Fragrance
- Design of a Business Establishment
- Motion
What is the Purpose of a Trademark?

- Indicator of source of the goods or services
- Assures consumers of the quality of the goods or services associated with the mark
- Creates goodwill and brand awareness
Is There a Difference Between a Trademark and a Trade Name?

- Trademark identifies the goods or services of a business
  
  Coca-Cola

- Trade or Business Name identifies the company or business
  
  The Coca-Cola Company
Trademark Rights: How Do I Get Them?

- By registration at the appropriate government office and/or
- By use (common law used-based rights)
Is Trademark Registration Necessary?

- United States and other common law countries determine entitlement by the first to use the mark
- Registration prima facie proof of ownership of mark and the burden of proof is lessened in contentious proceedings
- Civil law countries only registration creates substantive rights
Where Should My Trademark be Registered?

- Countries where your goods are sold and/or services provided
- Trademark rights are territorial - use in the United States or registration in the United States does not protect your mark in Canada
Can I Obtain a Worldwide Trademark Registration?

- No
- Registration is usually on a country by country basis with some exceptions
Can I Obtain a Worldwide Trademark Registration?

European Community Trademark (OHIM)
One registration covers 27 countries of EC

Austria
Belgium
Bulgaria
Croatia
Cyprus
Czech Republic
Denmark
Estonia
Finland
France
Germany
Greece
Hungary
Ireland
Italy
Latvia
Lithuania
Luxembourg
Malta
Netherlands
Poland
Portugal
Romania
Slovak Republic
Slovenia
Spain
Sweden
United Kingdom
Can I Obtain a Worldwide Trademark Registration?

International Registration (Madrid - World Intellectual Property Organization)

- Must have national application or registration
- Can list all or any of the 92 countries party to the agreement
- Dependent on national registration for first five years
- Acceptance/rejection by national trademark offices
Can I Obtain a Worldwide Trademark Registration?

International Registration (Madrid - World Intellectual Property Organization)

Albania, Albania
Algeria, Algeria
Antigua & Barbuda, Antigua & Barbuda
Armenia, Armenia
Australia, Australia
Austria, Austria
Azerbaijan, Azerbaijan
Bahrain, Bahrain
Belarus, Belarus
Belgium, Belgium
Bhutan, Bhutan
Bosnia & Herzegovina, Bosnia & Herzegovina
Botswana, Botswana
Bulgaria, Bulgaria
China, China
Colombia, Colombia
Croatia, Croatia
Cuba, Cuba
Cyprus, Cyprus
Czech Republic, Czech Republic
Democratic People’s Republic of Korea, Democratic People’s Republic of Korea
Denmark, Denmark
Egypt, Egypt
Estonia, Estonia
European Union, European Union
France, France
Georgia, Georgia
Germany, Germany
Ghana, Ghana
Greece, Greece
Hungary, Hungary
Iceland, Iceland
India, India
Iran, Iran
Ireland, Ireland
Israel, Israel
Italy, Italy
Japan, Japan
Kazakhstan, Kazakhstan
Kenya, Kenya
Kyrgyzstan, Kyrgyzstan
Latvia, Latvia
Lesotho, Lesotho
Liberia, Liberia
Liechtenstein, Liechtenstein
Lithuania, Lithuania
Luxembourg, Luxembourg
Madagascar, Madagascar
Mexico, Mexico
Monaco, Monaco
Mongolia, Mongolia
Montenegro, Montenegro
Morocco, Morocco
Namibia, Namibia
Netherlands, Netherlands
New Zealand, New Zealand
Norway, Norway
Oman, Oman
Philippines, Philippines
Poland, Poland
Portugal, Portugal
Republic of Korea, Republic of Korea
Republic of Moldova, Republic of Moldova
Romania, Romania
Russian Federation, Russian Federation
Rwanda, Rwanda
San Marino, San Marino
Sao Tome and Principe, Sao Tome and Principe
Serbia, Serbia
Sierra Leone, Sierra Leone
Singapore, Singapore
Slovakia, Slovakia
Slovenia, Slovenia
Spain, Spain
Sudan, Sudan
Swaziland, Swaziland
Sweden, Sweden
Switzerland, Switzerland
Syrian Arab Republic, Syrian Arab Republic
Tajikistan, Tajikistan
Republic of Macedonia, Republic of Macedonia
Tunisia, Tunisia
Turkey, Turkey
Turkmenistan, Turkmenistan
Ukraine, Ukraine
United Kingdom, United Kingdom
United States of America, United States of America
Uzbekistan, Uzbekistan
Viet Nam, Viet Nam
Zambia, Zambia
Can I Obtain a Worldwide Trademark Registration?

Benelux
- One registration covers Belgium, Netherlands, Luxembourg

OAPI (Organisation Africaine de la Propriété Intellectuelle)
- One registration covers Benin, Burkina Faso, Cameroon, Central African Republic, Chad, Congo Republic, Equatorial Guinea, Gabon, Guinea, Guinea-Bissau, Ivory Coast, Mali, Mauritania, Niger, Senegal, and Togo
What is the Procedure to Registration a Trademark?

- File application at appropriate office
- Application will be examined by an official as to
  - (i) availability - is the mark confusingly similar to a mark previously registered or applied for
  - (ii) registrability - is the mark generic, immoral, descriptive, deceptively misdescriptive, indicative of origin
- Once accepted, applications are typically published in an Official journal or gazette so interested parties have the opportunity to oppose
- If no opposition, the registration is granted
- Once registered proper to use ®
- If mark is not registered use ™ or SM
Copyrights

- Protects against copying of original works of authorship
  - Movies
  - Books
  - Music
  - Computer Programs
  - Instructional Manuals
  - Websites
Important Websites

- U.S. Patent and Trademark Office is at: http://www.uspto.gov
- Canadian Patent and Trademark Office is at: http://www.cipo.gc.ca
- European Patent Office is at: http://www.epo.org
- European Trademark Office (OHIM) is at: https://oami.europa.eu/ohimportal/en/
- PCT Patent countries are at: http://wipo.int/treaties/en/ShowResults.jsp?treaty_id=6
- A European Trademark Registration is effective in every country of the European Union. A map showing those countries is at: http://europa.eu/abc/european_countries/index_en.htm
- The European Patent Application provides a route to national patents in 38 countries. A list of the member states is at: http://www.epo.org/about-us/organization/member-states.html
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