



or outside the United States, or which is in public use, used in products already on sale, or otherwise available to the public. However, the Patent Cooperation Treaty creates a procedure for filing patent applications in several countries, including the United States, for the same invention. This treaty involves complicated timing requirements for seeking patent protection in the United States. You should therefore work with a competent IP attorney early in the process to avoid losing the opportunity to obtain U.S. patent protection.

Trade secrets. U.S. trade secret laws assign the related IP rights to the persons who possess the relevant knowledge, provided that the holder continue to protect the knowledge.

Copyright. Works which may be protected by copyright will benefit from such protection within the United States simply by virtue of their existence. The United States is a signatory to the Berne Convention, and therefore recognizes copyrights from other signatory countries the same way as it recognizes copyrights under its own law. For example, United States copyright law applies to anything published or performed in the United States, even if the work was created in France. However, to facilitate possible legal action in the United States to enforce the copyright, it is advisable to register the work with the U.S. Copyright Office.

Trademarks. Lastly, trademark rights

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are established in the United States by their use in commerce. As a result, even if you currently benefit from brand recognition outside the United States, you will not benefit from protection of the trademark in the United States until you have used the mark in the United States in connection with your goods or services. Advertising through the Internet usually does not qualify as a “use” in the United States, unless the website provides means for purchasing the product or services from within the United States. Also, it is necessary to register a trademark in the United States to enforce it in U.S. federal courts. Under the Madrid Protocol, a mark owner may register a trademark in multiple countries.

+ photo <http://www.istockphoto.com/photo/page-of-printed-brand-names-18212727?st=4a602dd>

› **Does it matter if company IP has been obtained through contract or license?**

To claim protection in the United States, your company’s IP must normally be owned by or assigned to the company. Ideally, your company will have a clear title or documentary proof of ownership, which may include an assignment of ownership or the right

to the IP. Otherwise, it may be difficult to enforce the IP right in a United States federal court. If an inventor leaves your employment before executing an assignment, for example, proof of your company’s ownership or right to apply for a patent must be established by other means in order to obtain protection in the United States. If the IP is licensed to your company, your ability to obtain IP protection in the United States will depend on the scope of your rights under the applicable license. Furthermore, if your products or services use in-licensed technology which includes third-party

company trade secrets? Are your employees aware of the importance of secrecy, and their non-disclosure obligation? These questions help to identify possible weaknesses in your current position, and plan for a strong foundation for maintaining trade secret protection in the United States.

› **How long will my company’s IP rights last?** A United States patent will be enforceable for 20 years from the filing date of the earliest U.S. priority application, but may be longer if the Patent Office delays examination of the application. Copyrights generally have a duration of 70 years after the author’s death. Protection of a trademark or trade secret will exist under U.S. law as long as the owner adequately protects and maintains those rights.

Step 3: Identify and protect any IP requiring specific measures for protection in the United States

The due diligence conducted under Step 2 above should enable you to identify any company IP that would be exposed or unprotected in the United States. Your U.S. intellectual property attorney will then be able to define the options available for protecting such IP. For example:

› **Patents.** You may choose to file a patent application in the United States. The patent application will be published after 18 months unless you request non-disclosure and pay a Patent Office fee. As a result of such disclosure, the decision to seek patent protection often precludes using trade secret protection for the same subject matter. It generally takes between two and five years to process a patent application in the United States, and not all applications will issue as patents.

Note that a patent pending in the United States does not grant its owner the right to exclude others from using the claimed invention. However, if a patent issues on the application, and the issued claims are substantially the same as the published application, then you may be able to claim damages as far back as the publication date.



› **Trade secrets.** You may choose to strengthen your company's trade secret strategy to ensure protection under U.S. law.

› **Copyright and trademarks.** You may choose to register certain copyrightable IP or trademarks.

Step 4: Identify any limitations imposed by third-party IP

› **Avoiding violations of third-party IP:** In the United States, there is a constant risk of litigation based on alleged violations of third-party IP. Such litigation is common and expensive. You should thus remain vigilant to

ensure that your products and services avoid violating third-party IP.

Your intellectual property attorney can work with you to identify possibly relevant third-party IP rights and determine any limitations on your "freedom to operate". Based on the search results, you may be able to modify your products and services to reduce your potential infringement exposure. Alternatively, you may choose to seek a license to use the third-party IP. Your attorney can also assist you with analyzing the validity and enforceability of the third-party IP, and advise you on possible strategies for challenging it.

› **Avoiding violations of third-party IP licensed to your company**

If important IP used by your company includes third-party IP used under license, you need to confirm whether the license must be modified to include the expansion of your business into the United States. In addition, you may wish to increase the duration of the license to have sufficient time to establish your business in the United States, or you may be required to negotiate an additional royalty or fee. Also, if you rely on third party technology – especially software – you must ensure that your end user license agreement permits its use in the United States (see the second bullet point under Step 2 above).

Step 5: Going Forward:

› **Ensuring IP security:**

To ensure the security of your company's IP as you go forward, you should assess the processes for capturing and protecting any new IP generated by your employees, development partners or licensees. You should also ensure that adequate procedures are in place to monitor unauthorized IP disclosure or leaks, intrusions by competitors, and employee access to trade secrets. The security of your IT network should also be verified.

It is also highly advisable to monitor competitors' products and services for IP infringement. Failing to timely

protect IP can result in a loss of more than just your rights – if you are not vigilant, your competitors can take steal both your technology and your market share.

› **Protecting your company as a licensor of IP**

If your company licenses IP to a U.S. counterparty to offer goods or services in the United States, you should carefully consider, in addition to the payment structure or royalty model, the scope of rights provided and how you will limit your potential liability as a technology licensor. For example, will you indemnify your licensee in the event of litigation claiming damages from the use of your technology, or infringement of third-party IP? You should also ensure that the IP license granted to your U.S. counterparty does not inadvertently limit your company's own ability to use its technology and expand its business.

In conclusion

A well-defended IP portfolio is vital to successfully enter and build a competitive position in United States markets. By following the five steps described above, you should be able to take effective measures to ensure IP security both as regards your current IP portfolio and technology developments going forward.

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