

# Understanding the Intellectual Property Rights Protection



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# Protecting Your Intellectual Property Rights

How do you manage your IP rights? Take a Three-Step Approach!

- 1. Identify IP**
- 2. Secure IP**
- 3. Enforce IP**



# Protecting Your Intellectual Property Rights

## STEP 1) Identify IP

**Conduct an “Internal IP Audit”  
to identify:**

1. What is already protected?
2. What else can be protected?



# What is a Trademark?

A word, phrase, symbol or design, or a combination of words, phrases, symbols or designs that identifies and distinguishes the source of the goods or services of one party from those of others. Even colors, smells and sounds may be trademarks in the U.S. (and in some other countries).



# Life of a Trademark

- **Creation**
  - Choosing a trademark or service mark
- **Screening and Clearance**
  - Making sure the proposed mark is available
- **Protection**
  - Seeking protection, country-by-country
- **Maintenance**
  - Using trademarks properly and renewing registrations





# Why are Trademarks Important to Your Business?

- A trademark identifies a company and its goods/services to its customers.
- A trademark allows customers to distinguish a particular company from its competitors.



# Examples of Trademarks

Thai Airways: “Smooth as Silk”

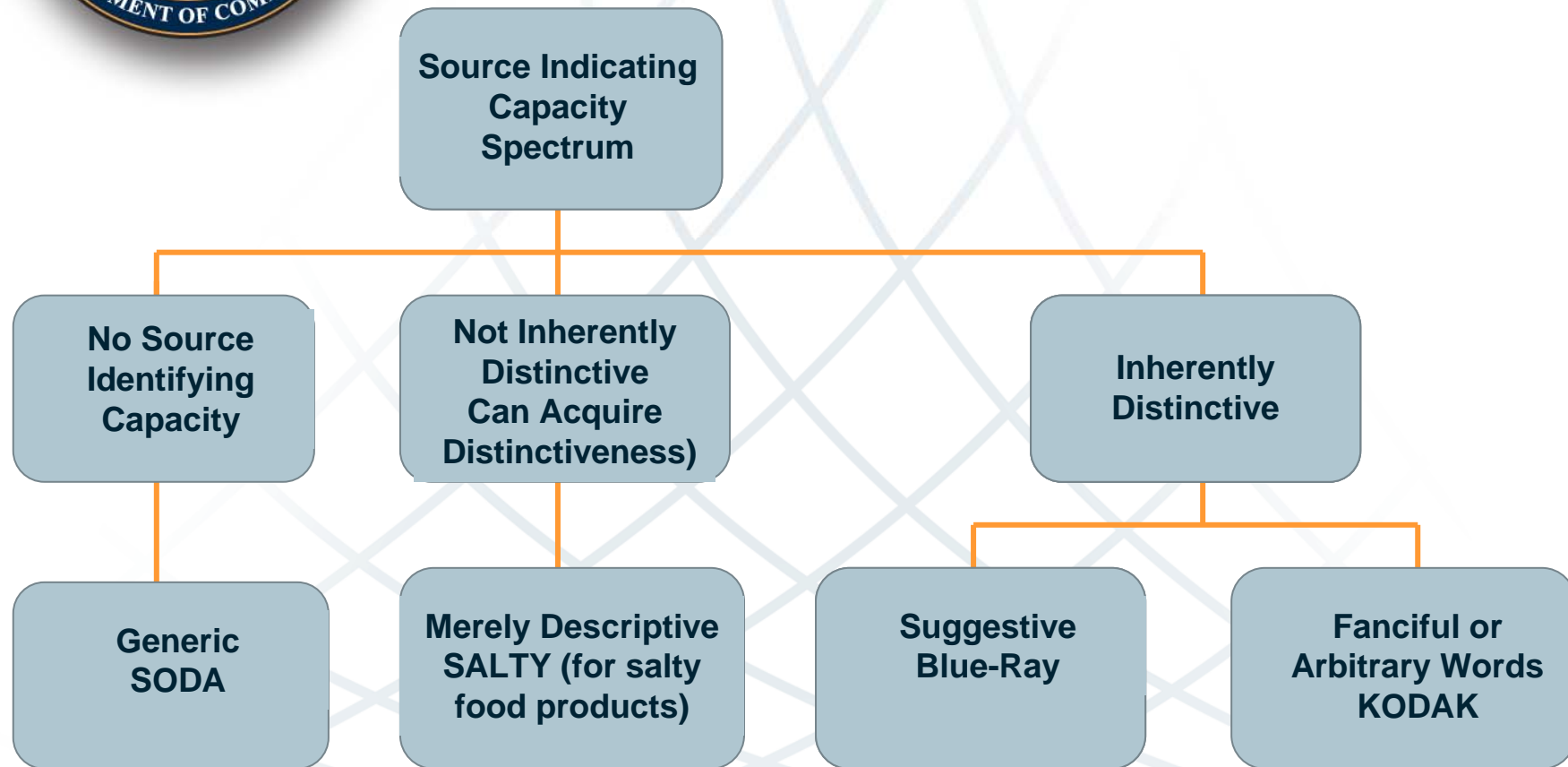


Red Bull





# Is Trademark Protection Available for Any Word, Phrase or Design? (No.)







# Trademark Protection is Territorial

- Trademark rights are territorial.
- Most countries follow a “first-to-file” rule:
  - Protection is granted to the first party who files an application and receives a registration.
  - Note: The United States is a “first-to-use” country.
- You must search and file in each country in which you wish to sell your goods or services.





# Why Should a Business do a Trademark Search Before Filing?

**Before beginning to use a trademark**, a business should determine whether another business already is using an **identical** or **similar** trademark, on or in connection with the **same** or **related** goods or services. By making that determination, a company **lessens the risk** associated with adopting a mark.



# Conducting a Search Can Save a Company Time, Money and Grief!

- Avoid being sued!
- Avoid having to change your mark – in every place it appears.
- Avoid having to destroy existing products with the infringing mark.
- Avoid having to recall existing products that bear the infringing mark.
- Avoid being held liable for damages to the owner of the mark – and possibly even for attorney's fees.
- And, finally, avoid the negative publicity that accompanies any lawsuit!



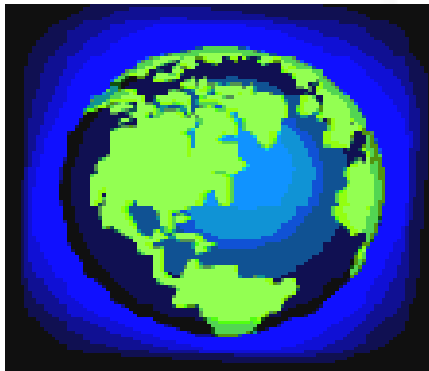
# Protecting Your Trademarks Internationally

- **Be proactive in protecting your trademark!**
- **Have you considered registering your mark in countries in which:**
  - Your goods or services are marketed;
  - Products or parts for your products are manufactured;
  - Research and development facilities are located;
  - Your products are transshipped;
  - You might expand your business in the future; or
  - Counterfeiting is likely to be a problem.



# Protecting Your Trademarks Abroad: The Madrid Protocol

- **What is the Madrid Protocol?**  
It is an international trademark **filing** treaty administered by the World Intellectual Property Organization, WIPO.







# Maintaining Your Trademarks: Tips on Proper Trademark Usage

- Distinguish your trademark from surrounding text, e.g., use capital letters or italics.
- Use your mark in its proper form; avoid pluralizing it or making it possessive.
- Use the mark as an adjective and couple it with a descriptive or generic term, e.g., a Xerox copy.
  - Not as a noun, e.g., use “copy”, not “Xerox”.
  - Not as a verb, e.g., use “photocopying”, not “xeroxing”.
- If your mark is registered at the USPTO, use the ® or other applicable symbol.



# Maintaining Your Trademarks: Don't Lose Your Rights!

- Register your marks and maintain the registrations.
- Use your mark, use your mark as a mark, and use your mark consistently. Use notices of prior right.
- License use of your marks, **in writing**, with your manufacturers, your distributors, and any other authorized third-party users, and exercise **quality control** over your licensees' products.
- Monitor the USPTO *Official Gazette* (and similar publications in other countries), monitor the marketplace, and stop unauthorized third-party uses.



# Patents

- Utility Patents
- Design Patents



# Patents

- Contract between State and Inventor: Full Disclosure of Invention for Exclusive Rights for Limited Time (20 years)
- Disclosure permits incremental innovation, design around, avoids duplication of research
- Must meet basic requirements: novelty, non-obviousness, and utility
- Permits limited exceptions



# What is a utility patent?

- Provides a right to exclude others from making, using, selling, offering for sale, or importing the claimed invention, in exchange for public disclosure of the technology described and shown in the patent specification, for a non-renewable period of 20 years from the filing date.





# Designs

- Protects shape or appearance of useful articles
- Protected by various means; minimum 10 year term of protection
  - Some countries (US, Japan, Korea) by design patent—US has a 14-year term.
  - Others (European countries) by copyright-like registration (no examination)



# 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.



# Categories of Protected Works

- Literary works (includes software)
- Musical works
- Sound recordings
- Dramatic works
- Choreographic works
- Pictorial, graphic and sculptural works
- Motion pictures
- Architectural works



# Copyright: A Bundle of Rights

- Reproduction
- Adaptation
- Distribution
- Public Performance
- Public Display



# Securing Protection

- Copyright protection is secured **automatically** upon creation (fixation).
- No publication or registration is required.
- Many countries (including Thailand and the United States) have optional registration or deposit systems.





# Identifying Your Intellectual Property

## Conducting an Internal IP Audit

### – Copyrights:

- Registered Copyrights
- Written Materials (Books, Product Catalogs, Manuals)
- Advertising
- Photographs
- Illustrations
- Computer Software
- Music
- Film/Video
- Website Content



# Identifying Your Intellectual Property

## Conducting an Internal IP Audit

### – Patents:

- Issued Patents (Foreign, Domestic)
- Pending Applications (Provisional, Non-Provisional)
- Invention Disclosure Statements
- Mechanical Devices
- Electronic Devices
- Medicine/Medical Devices
- Chemical Composition/Process
- Computer-Based Business Process (Software)



# Identifying Your Intellectual Property

## Conducting an Internal IP Audit

### – Trade Secrets:

- Customer Lists
- Pricing/Cost Data
- Customer Information and Sales Practices
- Business Plans
- Financial Data/Forecasts
- Manufacturing Techniques
- Design Manuals
- Production Processes/Specifications
- Survey/Research Data (including negative R&D)
- Computer Software (source code)
- Employee Knowledge



# Protecting Your Intellectual Property Rights

## **STEP 2) Secure IP**

1. Confirm Ownership
2. Register/File for Protection
3. Maintain IP



# Securing Your Intellectual Property

## Confirm Ownership of IP

- Employee Contracts
- Intellectual Property Assignments
- License Agreements (In-Licensing and Out-Licensing)
- Cooperative Research Agreements
- Financing Agreements
- Security Interests
- Public Filings
- Outside Contractor Agreements
- Work-for-Hire Doctrine





# Securing Your Intellectual Property

## Maintain IP

- Pay maintenance and renewal fees
- Safeguard your trade secrets
  - Internal Measures  
(inside your business)
  - External Measures  
(dealing with 3<sup>rd</sup> parties)



# What is a Trade Secret?

## Three fundamental concepts:

- 1) Information is secret; not known to the public or to those involved in the industry.
- 2) Has commercial value; used in business and gives the owner a competitive advantage.
- 3) The owner of a trade secret must take reasonable measures to maintain its secrecy.



# Securing Your Intellectual Property

## Safeguard Trade Secrets

### – Internal Measures:

- New Employees
  - Non-Disclosure/Confidentiality Agreements
  - Non-Compete Agreements
  - IP Assignments
- Employee Manual
  - Policy and procedures on treatment of confidential and trade secret information.
- Departing Employees
  - Return all confidential and trade secret materials.
  - Exit interviews to reconfirm non-disclosure and non-complete obligations.



# Securing Your Intellectual Property

## Licensing IP—Ask yourself:

- |        |  |
|--------|--|
| Who:   | Can use the IP?<br>-Is license exclusive?<br>-Is sublicensing permitted?<br>Owns the IP?<br>Can register the IP? |
| What:  | Identify the IP  |
| Where: | Territoriality, field of use   |
| When:  | Term of use  |
| How:   | Quality control  |



# Licensing Your Intellectual Property

- License in writing
- Payment of license fees
- What happens if licensee doesn't pay or otherwise infringes?
- Audit rights
- Warranties of Non-infringement
- Indemnification against cases arising out of false warranties
- As a licensee, maintain good records of your licenses (e.g., software) and check compliance.<sup>33</sup>





# Enforcing Your Intellectual Property

## What you can do when you discover infringement:

- Generally speaking, you should consult an attorney.
- Write a cease and desist letter
- On the Internet, ask the Internet Service Provider to take down the infringing materials
- Getting a search warrant
- Conduct a raid
- Ask Customs to interdict a particular shipment



# Enforcing Your Intellectual Property

## What you can do when you discover infringement:

- It is important to take action, even if you are unsuccessful.
- If too much time passes, you may lose your right to sue.
- If you do not enforce your rights, you may lose the right.



# Thank you



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