

Protect your IP investment abroad

Suppose you have a great new product that you know you can sell outside the U.S.

You have a patent application pending and a registered trademark. Your company is becoming known in Canada and Europe.

At the same time, your leading competitor is a German company with widespread distribution in the European Union and with a presence in North America.

How can you make sure your product is protected against your competition?

The bottom line is that protecting intellectual property rights abroad – patents, trademarks and copyrights – is an important investment for your business.

There is no such thing as a “world patent” or “world trademark.” U.S. rights will not protect you in other countries. Intellectual property rights must be secured and enforced country-by-country.

Laws and regulations governing the granting of intellectual property protection vary by nation. Once you obtain a patent, or register a trademark, in a foreign jurisdiction, you have the burden of enforcing your newly granted right (this is something we will talk about more in subsequent columns).

Sometimes the investment actually doesn’t make sense. But the scenario of foreign expansion laid out above is not uncommon, even for smaller companies. So it’s important to understand and exercise your options for obtaining intellectual property protection.

All companies – smaller- and middle-market firms especially – should focus resources on countries that will provide the best return on their IP investment. Factors to consider include the rights that can be secured, available enforcement mechanisms, and opportunity for competitive advantage.

The first step is usually to file a patent or trademark application in the U.S. Most countries, the U.S. included, have entered into treat-

ties that make it easier to file patent and trademark applications internationally after filing in your own country. These treaties usually provide a period of time for foreign filing: generally 12 months for patents and six months for trademarks.

As with any legal procedure, there are potential pitfalls to filing foreign trademark and patent applications. In the U.S., you have a year after the public disclosure of an invention to file an application. However, most other countries bar you from filing the patent application once the invention has been publicly disclosed.

Similarly, in the U.S., a trademark application must generally be accompanied by evidence you intend to use the trademark. Many other countries don’t have such a requirement.

Pitfalls like this explain why consultation with legal counsel is essential as soon as you think you may want to protect IP rights.



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Definitions

Intellectual property: Classic categories of this include patents, trademarks, copyrights and trade secrets. It is often helpful to think of intellectual property in contrast to tangible and concrete “real” property, such as land, cars, trucks and boats. IP includes ideas, words and images that may be embodied in real property.

Patent: Grant of the right by a government to exclude others from practicing a claimed invention within the government’s territory.

Priority date: The date according to which an intellectual property right, as reflected in a patent or trademark application, is given priority over intellectual property that may conflict with the intellectual property right.

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