



PROTECTION AND ENFORCEMENT OF THE ESSENTIAL IPRS: UNITED STATES

	Confidential information	Patents
<b>The right</b>		
<b>What legal conditions must be satisfied for the IPR to arise?</b>	<p>In the US, protected confidential information is generally referred to as a trade secret. A trade secret is information that derives independent economic value from not being generally known (<i>see Uniform Trade Secrets Act §1(4)</i>). It requires:</p> <ul style="list-style-type: none"> <li>■ Efforts to maintain confidentiality.</li> <li>■ To be conveyed in a way that the confidentiality is apparent to the listener.</li> </ul>	<ul style="list-style-type: none"> <li>■ Novelty.</li> <li>■ Not obvious.</li> <li>■ Patentable subject matter: any new and useful process, machine, manufacture, composition of matter, or improvement of these.</li> <li>■ Design patents (known as registered designs in some other jurisdictions) and plant patents are also available.</li> </ul>
<b>Protection</b>		
<b>Is an application necessary to protect the IPR?</b>	N/A.	Yes.
<b>To what authority does the application have to be made?</b>	N/A.	US Patent and Trademark Office.
<b>What fee is payable?</b>	N/A.	<ul style="list-style-type: none"> <li>■ Utility patents: US\$1,020/US\$510 (EUR787/EUR393).</li> <li>■ Design patents: US\$440/US\$220 (EUR339/EUR169).</li> <li>■ Plant patents: US\$680/US\$340 (EUR524/EUR262).</li> </ul> <p>All amounts include search and examination fees. Amounts are for large entity/small entity.</p>
<b>Is there a standard application form?</b>	N/A.	No. There are standard transmittal forms available.

Essential IPRs tables

Trade marks	Copyright
<ul style="list-style-type: none"> <li>■ Must be capable of distinguishing goods of one registrant from those of another (distinctive character).</li> <li>■ Must not be excluded from registration by statute.</li> <li>■ Must not be confusingly similar to any third parties' registered or unregistered mark.</li> <li>■ Must be used.</li> </ul>	<p>Original work of authorship created in a fixed form.</p>
<p>No, but registration provides benefits and presumptions for enforcement.</p>	<p>No, but if there is no registration US citizens and legal entities cannot file a copyright infringement suit.</p> <p>Early registration (within 3 months of publication) offers the holder advantages:</p> <ul style="list-style-type: none"> <li>■ Infringer may be liable for statutory damages up to US\$150,000 (EUR116,000) per infringement.</li> <li>■ Infringer may have to pay attorney's fees.</li> </ul>
<p>US Patent and Trademark Office.</p>	<p>US Copyright Office (branch of the Library of Congress).</p>
<ul style="list-style-type: none"> <li>■ Electronic filing: US\$325 (EUR251).</li> <li>■ Paper filing: US\$375 (EUR289).</li> </ul>	<ul style="list-style-type: none"> <li>■ Electronic filing: US\$35 (EUR27).</li> <li>■ Paper filing: US\$45 (EUR35).</li> </ul>
<p>Yes. Form PTO/TM/1478 is available online.</p>	<p>Yes, depending on the type of work:</p> <ul style="list-style-type: none"> <li>■ Form TX (non-dramatic literary works).</li> <li>■ Form PA (performing arts).</li> <li>■ Form SR (sound recordings).</li> <li>■ Form VA (visual arts).</li> <li>■ Form SE (serial publications, e.g. newspapers, magazines and annuals).</li> </ul>

	Confidential information	Patents
What documents/information must be filed with the application?	N/A.	<ul style="list-style-type: none"> <li>■ Written specification (including description of how to make and use the invention and description of the best method to practise the invention).</li> <li>■ A minimum of 1 claim (for utility patents).</li> <li>■ Drawings, if needed to describe the invention.</li> <li>■ Declaration or oath signed by each inventor.</li> <li>■ Filing fee.</li> </ul>
Do third parties have the right to contest the application?	N/A.	<p>Yes (but the third party's rights are limited):</p> <ul style="list-style-type: none"> <li>■ Third-party submission of prior art reference against a published application (<i>37 C.F.R. §1.99</i>). Must be done within 2 months from publication date and only 10 references are permitted. Fee: US\$180 (EUR139).</li> <li>■ File a protest (<i>37 C.F.R. §1.291</i>). Must be filed before date the application was published or date of mailing notice of allowance, whichever occurs first.</li> <li>■ Petition for a public-use proceeding (<i>37 C.F.R. §1.292</i>).</li> </ul>
What is the overall time frame for obtaining registration?	N/A.	Typically 2 to 4 years.
How long does protection last (whether registered or not)?	N/A.	<ul style="list-style-type: none"> <li>■ Utility patent: currently, 20 years from earliest filing date (subject to payment of maintenance fees due at: <ul style="list-style-type: none"> <li>□ 3.5 years: US\$900/US\$450 (EUR694/EUR347);</li> <li>□ 7.5 years: US\$2,300/US\$1,150 (EUR1,774/EUR887); and</li> <li>□ 11.5 years: US\$3,800/US\$1,900 (EUR2,931/EUR1,466).</li> </ul> </li> <li>■ Plant patents: 14 years.</li> <li>■ Design patents: 14 years.</li> <li>■ In some cases patent term extensions may be granted.</li> </ul>
From what date does the protection period run?	N/A.	Date of filing the application.

Trade marks	Copyright
<ul style="list-style-type: none"> <li>■ Details or representation of the mark.</li> <li>■ General information about applicant (name, address and other contact details).</li> <li>■ Filing basis (e.g., actual use, intent to use and foreign application registration).</li> <li>■ List of goods and services.</li> <li>■ Filing fee.</li> </ul>	<ul style="list-style-type: none"> <li>■ Appropriate application form.</li> <li>■ Required deposit copy.</li> <li>■ Filing fee.</li> </ul>
<p>Yes, by:</p> <ul style="list-style-type: none"> <li>■ A letter of protest (before publication of the application).</li> <li>■ Filing a notice of opposition (within 30 days after publication of the application).</li> </ul>	<p>No.</p>
<p>Typically 10 months to 4 years.</p>	<p>Typically 2 to 3 months.</p>
<p>10 years (renewable indefinitely for periods of 10 years).</p>	<ul style="list-style-type: none"> <li>■ For works created after 1 January 1978 up to the author's death plus additional 70 years.</li> <li>■ For works created before 1 January 1978 the term varies (although all works published before 1923 are in the public domain).</li> <li>■ For anonymous, pseudonymous works or works made for hire: either 95 years from the year of the initial publication or 120 years from the year of its creation (whichever period expires first).</li> </ul>
<p>Date of registration, or first use of trade mark if no registration.</p>	<p>Moment of creation.</p>

	Confidential information	Patents
Does protection grant exclusivity?	N/A.	Yes.
<b>Enforcement</b>		
In what circumstances and on what grounds can you bring an action for infringement?	If there is a disclosure of the trade secret against the background of contractual or other confidentiality commitments.	<ul style="list-style-type: none"> <li>Direct infringement (a person, without authority, makes, uses, offers to sell, or sells any patented invention within the US, or imports into the US any patented invention during the term of the patent (<i>35 U.S.C. § 271</i>)).</li> <li>Indirect infringement (contributory or induced).</li> </ul>
Which courts have jurisdiction?	<ul style="list-style-type: none"> <li>Generally State Court jurisdiction.</li> <li>Federal Court jurisdiction possible if the claimant and defendant are from different states and more than US\$75,000 (EUR58,000) is in dispute.</li> </ul>	Federal Court (exclusive jurisdiction).
What defences are available?	Lack of confidential nature of information.	<ul style="list-style-type: none"> <li>Fraud in procurement.</li> <li>Estoppel.</li> <li>Misuse.</li> <li>Invalidity of patent.</li> <li>Enforcement in bad faith.</li> <li>Non-infringement.</li> </ul>
What remedies are available?	<ul style="list-style-type: none"> <li>Injunctive relief.</li> <li>Damages (monetary damages or recovery of profits).</li> <li>Attorney's fees.</li> </ul>	<ul style="list-style-type: none"> <li>Injunctive relief.</li> <li>Damages (equivalent to reasonable royalty or infringer's profit).</li> <li>Attorneys' fees and costs (if infringement was wilful).</li> <li>Increased damages if infringement is wilful.</li> </ul>




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Peter Dawson, Partner, Russell-Cooke.

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Trade marks	Copyright
Yes, with respect to the goods and services covered by the registration.	Yes, with certain exceptions for fair-use (news reporting, research, criticism, and teaching).
Use of a trade mark without the owner's consent in any manner which is likely to cause confusion, mistake or deception among the relevant consumers with regard to: <ul style="list-style-type: none"> <li>■ The origin of the products or services.</li> <li>■ A connection between the products and services.</li> <li>■ A mistake of the source of a product or service with the registrant.</li> </ul>	If either the entire work or a significant portion of a protected copyright work is: <ul style="list-style-type: none"> <li>■ Reproduced.</li> <li>■ Distributed.</li> <li>■ Publicly performed.</li> <li>■ Publicly displayed.</li> <li>■ Made into a derivative work without the owner's permission.</li> </ul>
Federal and/or State Court.	Federal Court (exclusive jurisdiction).
<ul style="list-style-type: none"> <li>■ No likelihood of confusion with claimant's mark.</li> <li>■ Prior use by defendant.</li> <li>■ Non-use of trade mark (abandonment) by claimant.</li> <li>■ Claimant's mark is merely descriptive, functional, generic or not protectable.</li> <li>■ Fair use.</li> <li>■ Laches or estoppel.</li> </ul>	<ul style="list-style-type: none"> <li>■ No copyright (public domain or claimant is either not the author or the copyright holder).</li> <li>■ Use was permitted (fair use).</li> <li>■ The alleged infringement does not constitute an infringement (no substantial similarity).</li> <li>■ Laches.</li> </ul>
<ul style="list-style-type: none"> <li>■ Injunctive relief.</li> <li>■ Claimant's actual damages (must be proven by claimant).</li> <li>■ Defendant's profits (must be proven by claimant).</li> <li>■ Attorneys' fees and costs (exceptional cases).</li> <li>■ Disposition of infringing material.</li> <li>■ Corrective advertising.</li> </ul>	<ul style="list-style-type: none"> <li>■ Injunctive relief.</li> <li>■ Disposition of infringing material.</li> <li>■ Damages (statutory or actual).</li> <li>■ Attorneys' fees and costs.</li> </ul>

For further information on trade marks in the United States, see chapter, *Trade marks: United States*.  
 Jeffrey L Van Hoosear and Christian W Liedtke, *Knobbe Martens Olson & Bear LLP*



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