



WELCOME

***To the Advanced CBA
ReadyTalk Webinar Training
Intellectual Property: Enforcement
November 14, 2006
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Enforcement of IP Rights – Private Responsibilities and Government Solutions



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FAKES
.GOV/
SMALLBUSINESS**



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- John covers Eastern Europe and Central Asia issues. Prior to joining the USPTO, he was mobilized for several years on active duty in the U.S. Coast Guard, where he served as Deputy Chief of Regulations for the U.S. Coast Guard, and as a strategic operational planner. From 1999 to 2002, he worked at the Office of Chief Counsel for Import Administration, U.S. Department of Commerce, specializing in antidumping /countervailing duty litigation in U.S. courts, before NAFTA panels, and the World Trade Organization. From 1984 until 1998, Mr. Koeppen served on regular active duty in various assignments with the U.S. Coast Guard, including at sea in the Caribbean, as an intelligence officer, and Judge Advocate, practicing in the areas of international maritime law and military justice. Mr. Koeppen received a J.D. in 1991 from the College of William and Mary, Williamsburg, VA, and a B.S. (Marine Science) in 1984 from the U.S. Coast Guard Academy, New London, CT.



Protecting Your Intellectual Property Rights

*How do you protect 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?*



Identifying Your Intellectual Property

- Conducting an Internal IP Audit
 - Trademarks:
 - *Registered Marks (Foreign and Domestic)*
 - *Business Names (Registered, DBA)*
 - *Words, Slogans*
 - *Logos, Icons, Graphics*
 - *Domain Names*
 - *Product Packaging/Configuration*
 - *Website Design*
 - *Sound, Color, Scent*
 - Trade Dress:
 - *Packaging*
 - *Point-of-sale Displays*
 - *Website Design*



Identifying Your Intellectual Property

- Conducting an Internal IP Audit
 - **Copyrights:**
 - *Registered Copyrights*
 - *Written Materials (Books, 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

– Register IP / File for Protection

- U.S. Patent and Trademark Office
- Foreign patent and trademark office
- State-level trademark office
- U.S. Copyright Office
- Domain name registrar
- No filing requirements for trade secrets



Securing Your Intellectual Property

- Maintain IP
 - Pay maintenance and renewal fees
 - Safeguard your trade secrets
 - Internal Measures (inside your business)
 - External Measures (dealing with 3rd parties)



Securing Your Intellectual Property

- Safeguard Trade Secrets

- **Internal Measures:**

- Mark all trade secret and confidential documents "CONFIDENTIAL."
 - Limit access and distribution of confidential documents to necessary employees.
 - Retrieve and shred any distributed documents.
 - Restrict physical access, lock premises, file cabinets, etc.
 - Use computer encryption, password protection, network security, esp. with laptop users.



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

- External Measures to Safeguard IP
 - Conduct IP Review of Transaction:
 - Identify the IP
 - Verify Ownership/Proper Chain of Title
 - Review Underlying Documents
 - (e.g. assignments, licenses, registrations, applications, financing agreements)
 - Assess the 3rd Party
 - Lawsuits/Threatened Claims



Securing Your Intellectual Property

- External Measures to Safeguard IP
 - Conduct IP Review of Transaction:
 - Confidentiality/Non-Disclosure Agreement
 - Exclusivity
 - Territoriality
 - Field of use
 - Quality control
 - Inspections/Audits
 - Indemnification



Securing Your Intellectual Property

- External Measures to Safeguard IP:
 - Review market
 - Monitor competitor's filings
 - Risk assessment
 - Maintain internal controls
 - Audit licensees
 - Private investigators
 - Take action to enforce when necessary



Protecting Your Intellectual Property Rights

STEP 3) Enforce your IP

– Legal Options:

- Civil
- Criminal
- Administrative



Enforcing Your Intellectual Property Rights

- Legal Options:
 1. Civil
 - State and Federal
 - Alternative Dispute Resolution (ADR)
 2. Criminal
 - U.S. Department of Justice
 3. Administrative
 - U.S. Customs (Border Enforcement)



Enforcing Your Intellectual Property Rights

Enforcing IP Rights Through Civil System:

1. Determine if IP infringed
2. Send cease and desist letter
3. Negotiate or enter into licensing agreement
4. File claim



Enforcing Your Intellectual Property Rights: Civil

If Your IP Rights Have Been Infringed?

Methods of Resolving IP Disputes:

- Negotiate/Enter into Licensing Agreement
- Cease and Desist Letter
- File Lawsuit
- Alternative Dispute Resolution



Enforcing Your Intellectual Property Rights: Criminal

Enforcing IP Through the Criminal System:

- U.S. Department of Justice
 - Criminal Division: Computer Crime & Intellectual Property Section (CCIPS)
 - U.S. Attorney's Office: Computer Hacking and Intellectual Property Units (CHIPS)
 - Federal Bureau of Investigation
- U.S. Immigration & Customs Enforcement (ICE)
 - Online IP complaint form at: <http://www.ice.gov>



Enforcing Your Intellectual Property Rights: Criminal vs. Civil

- Majority of IP enforcement actions in U.S. is civil not criminal
- Criminal cases = Higher burden of proof
 - (beyond reasonable doubt vs. preponderance of the evidence)
- Criminal cases = Higher thresholds for penalties
- Criminal remedies can include prison term
- Factors evaluating whether to charge criminally:
 - Organized crime involvement
 - Public health and safety concerns
 - Commercial nature
 - Amount of loss and harm



Enforcing Your Intellectual Property Rights: Administrative

- Enforcing IP Rights Through the Administrative System
 - **U.S. Customs and Border Protection:**
 - Protects federally registered copyrights and trademarks that are recorded.
 - Detention, seizure and forfeiture of merchandise.
 - Enforce U.S. International Trade Commission exclusion orders.
 - Right to act on its own (*ex officio* authority).



Enforcing Your Intellectual Property Rights: Administrative

- U.S. Customs Recordation Procedure:
 - Record registered trademark and copyrights for protection:
 - Must first be registered with USPTO or Copyright Office.
 - Patents not covered.



Enforcing Your Intellectual Property Rights: Administrative

- U.S. Customs Recordation Procedure:
 - At any time, owners may provide U.S. Customs with information on suspected infringers:
 - Importers
 - Manufacturers
 - Country of origin
 - Transport mode
 - Entry port
 - Suspected dates



Enforcing Your Intellectual Property Rights: Administrative

- U.S. Customs Recordation Procedure:
 - Trademarks recordation = as long as trademark is registered.
 - Copyrights recordation = 20 years, unless the copyright expires before that time.



Enforcing Your Intellectual Property Rights: Administrative

- U.S. Customs Recordation Procedure:
 - File Recordation Application electronically, at:
<https://apps.cbp.gov/e-recordations>
 - Application in hard-copy available at:
<http://www.cbp.gov>



Enforcing Your Intellectual Property Rights: Administrative

- U.S. Customs and Section 337 Investigations:
 - U.S. Customs enforces International Trade Commission (ITC) exclusion orders that bar the importation of infringing goods.
 - Right-holder can initiate process by filing complaint of infringement or unfair practices with ITC.
 - Usually involves patent rights, since Customs has no authority to make patent infringement determinations.



Enforcing Your Intellectual Property Rights: Abroad

- Office of the U.S. Trade Representative (USTR)
 - **“Special 301” Process:**
 - Procedure used to identify countries that deny adequate protection for intellectual property rights.
 - Countries may be designated “Priority Foreign Country”, or placed on the “Watch List” depending on level of IP protection.
 - May be subject to sanctions.
 - Review conducted each year, but may also be initiated at any time.



Enforcing Your Intellectual Property Rights: Abroad

- Seek local support to enforce your IP rights:
 - Contact the local trade associations for your industry
 - Contact local American Chamber of Commerce
 - Contact local officials who enforce IP rights
- Hire a lawyer in the foreign market:
 - Should work jointly with your U.S. lawyer providing local expertise
 - Protect and enforce IP rights based on local law



Strategy Targeting Organized Piracy (STOP!) Initiative

- Most comprehensive initiative ever advanced to combat piracy and counterfeiting.
- Dismantle criminal enterprises that steal IP.
- Help companies establish their rights in the U.S. and abroad.
- Reach out to our trading partners and build an international coalition to block fake goods.
- Maintains a telephone hotline to contact an IPR legal expert:

1-866-999-HALT



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