

# United States

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## PATENTS

### 1. What are the legal requirements to obtain a patent?

- **Utility patents.** Granted for processes, machines, manufactures, compositions of matter, and improvements thereof that are new, useful, non-obvious, and enabled through a written description.
- **Design patents.** Granted for designs of articles of manufacture that are new, original and ornamental.
- **Plant patents.** Granted for plants that are distinct, new and asexually reproduced.

### 2. What categories are excluded from patent protection?

- **Utility patents.** Laws of nature, physical phenomena, abstract ideas, algorithms or mathematical formulas, and collections of data.
- **Design patents.** Surface ornamentation separate from the article, primarily functional design, and designs simulating a well-known or naturally occurring object/person.
- **Plant patents.** Tuber-propagated plants, plants found in an uncultivated state and bacteria.

### 3. Which authority registers patents? Does its website provide guidance on the application procedure? If not, please give brief details of this.

The United States Patent and Trademark Office (USPTO) (see *box, The regulatory authorities*). Its website, [www.uspto.gov](http://www.uspto.gov), provides guidance on the application procedure.

### 4. On what grounds and when can third parties oppose a patent application?

- **Pending applications.** If two or more applications are filed by different inventors claiming substantially the same subject matter, either applicant can request an interference proceeding to determine who was the first to invent the commonly claimed subject matter.
- **Issued patents.** Any third party can request an *ex parte* or *inter partes* patent re-examination to re-assess patentability. An *inter partes* re-examination involves the person request-

ing the re-examination throughout the proceedings and may have an estoppel effect, if the patent is asserted in court.

### 5. When does patent protection start and how long does it last?

Protection begins on the date of issuance for the following terms:

- **Utility and Plant Patents:**
  - 20 years from filing, if filed on or after 8 June 1995;
  - the longer of 17 years from issue or 20 years from filing, if pending or in force before 8 June 1995.
- **Design Patents:** 14 years from issue.

### 6. On what grounds can a patent infringement action be made?

The following acts, if unauthorised, are grounds for an infringement action:

- Making, using, offering to sell, or selling a patented invention within the US.
- Importing a patented invention into the US.
- Actively inducing another to infringe.
- Contributorily infringing (selling or offering to sell within the US or importing into the US a component of a patented invention knowing it to be specifically made or adapted for an infringing use).
- Filing a request with the US Food and Drug Administration for approval to market a patented drug before expiration of the patent(s) claiming the drug or its use.
- Supplying or exporting from the US all or a substantial portion of the components of a patented invention knowing that they will be combined into the patented invention outside the US.
- Importing into the US or offering to sell, selling, or using within the US a product made by a process patented in the US.

### 7. Which courts deal with patent infringement actions?

The US federal courts and the US International Trade Commission (ITC). The Court of Appeals for the Federal Circuit deals with appeals. The US Supreme Court can conduct a discretionary review of appeals from the Federal Circuit.

## 8. What are the defences to patent infringement actions?

- Non-infringement.
- Invalidity of the patent.
- Unenforceability.
- Exhaustion of rights.
- Licence.
- Laches/estoppel.
- Manufacture, use or sale solely for purposes related to obtaining information in support of a federal application for approval to market a drug or medical device.
- Patent misuse.
- Anti-trust violation (bad faith enforcement).

## 9. What are the remedies for patent infringement actions?

- Damages (lost profits, reasonable royalty, interest and costs).
- Enhanced damages (for wilful infringement).
- Reasonable attorney's fees (in exceptional circumstances).
- Injunctions.
- Exclusion and/or cease and desist orders (ITC).

## TRADE MARKS

### 10. What are the legal requirements to obtain a trade mark?

A trade mark must:

- Be used in commerce to identify the source of a product or a service.
- Be a distinctive word, name, symbol, device or design, or combination of these. A product's design, packaging, colour, sounds, smell, or other trade dress can also be registered as a trade mark, if distinctive and non-functional.
- Have acquired distinctiveness through secondary meaning, if merely descriptive.

### 11. Is it necessary or advisable to register trade marks? If yes, please state why. If not, please briefly outline the protection given and available for unregistered trade marks.

Registration is advisable, but not necessary. Unregistered marks are limited geographically to the area of use. Federal registration provides nationwide protection as well as other advantages such as the presumption of ownership and validity. A federally registered trade mark can also be recorded with US Customs to prevent importation of infringing goods.

### 12. Which authority registers trade marks? Does its website provide guidance on the application procedure? If not, please give brief details of this.

The USPTO registers federal marks. Its website, [www.uspto.gov](http://www.uspto.gov), provides guidance on the application procedure. State registration authorities vary depending on the state.

### 13. On what grounds can the regulatory authority refuse to register a trade mark?

The USPTO can refuse registration if the application is incomplete or improperly filed, or if the mark is:

- Confusingly similar to a previously registered or used mark.
- Descriptive or deceptively misdescriptive.
- Primarily geographically descriptive or misdescriptive.
- Primarily a surname or generic.
- Primarily functional.
- Immoral, deceptive, scandalous or disparaging.
- A flag or other insignia of any state, municipality or country.
- Unauthorised use of a name, portrait, or signature identifying a particular living individual or a deceased US president.

### 14. On what grounds and when can third parties oppose a trade mark application?

A third party that believes it would be damaged by the registration of the mark may oppose the mark within 30 days after its publication in the USPTO *Official Gazette*.

### 15. When does trade mark protection start and how long does it last?

Trade mark protection starts when the mark is first used in commerce. A trade mark can be maintained in perpetuity as long as it remains in use.

### 16. On what grounds can a trade mark infringement action be made?

A trade mark infringement action can be brought against another's use in commerce of a confusingly similar mark. Famous marks can also be enforced on grounds of dilution by blurring or tarnishment.

### 17. Which courts deal with trade mark infringement actions?

The US federal and state courts.

**18. What are the defences to trade mark infringement actions?**

- Prior rights.
- Fraudulent procurement.
- A mark is descriptive without secondary meaning.
- There is no likelihood of confusion.
- Abandonment.
- The mark is generic.
- Fair use.
- Licence.
- Estoppel/laches/acquiescence.
- Free speech/parody.

**19. What are the remedies for trade mark infringement actions?**

- Injunctions.
- Infringer's profits.
- Destruction of infringing goods and materials used to produce them.
- Actual damages (for example, lost profits sustained and costs).
- Enhanced damages (for wilful infringement).
- Attorney's fees (in exceptional circumstances).
- Statutory damages (for counterfeit marks).

**COPYRIGHT****20. What are the legal requirements to obtain copyright protection?**

Copyright protection subsists in original works of authorship fixed in a tangible medium of expression.

**21. Can copyright be registered? If yes, please state which authority registers copyright and the advantages of registering it. Does its website provide guidance on the application procedure? If not, please give brief details of this.**

The US Copyright Office (*see box, The regulatory authorities*) registers copyrights. Its website, [www.copyright.gov](http://www.copyright.gov), provides guidance on the application procedure. Registration is not required, but is advantageous, as it:

- Confers standing to sue in the federal courts.
- Provides *prima facie* evidence of copyright ownership.
- Allows for attorney's fees and statutory damages.

In addition, registered copyrights can be recorded with US Customs to prevent importation of infringing goods.

**22. When does copyright protection start and how long does it last?**

The start of copyright protection differs, depending on the date of creation:

- For works created after 1 January 1978, or created before that date but not registered or in the public domain as of that date, copyright protection starts on the date of creation. If the author is a person(s), the length of protection is the longest surviving author's lifetime plus 70 years. For works created anonymously, under pseudonym, or by a corporation, the length of protection is the shorter of 95 years from publication or 120 years from creation.
- For works created and registered or published before 1 January 1978, copyright protection starts on the date of publication with copyright notice or the date of registration. Depending on the date of creation, publication, registration and renewal of these works, protection can last up to 95 years.

**23. On what grounds can a copyright infringement action be made?**

A copyright action can be brought for violation of one of the owner's exclusive rights, for example:

- Unauthorised copying or distribution of a work.
- Preparation of a derivative work.
- Public performance, broadcast, display of the entire or a substantial part of the work.

**24. Which courts deal with copyright infringement actions?**

The US federal courts. State courts have jurisdiction over copyrights but only to the extent they provide copyright protection for non-protected categories of works (for example, sound recordings created before 15 February 1972).

**25. What are the defences to copyright infringement actions?**

- Fair use (for example, parody, criticism, comment, news reporting, teaching and research).
- Independent creation.
- No access.
- Not substantially similar.
- *De minimis* use.
- Licence.
- Joint ownership.
- Estoppel/laches/acquiescence.
- Copyright misuse.

**26. What are the remedies for copyright infringement actions?**

- Injunctions.
- Destruction of infringing goods and materials used to produce them.
- Statutory or actual damages.
- Attorney's fees if the plaintiff qualifies for statutory damages.

**REGISTERED DESIGNS****27. What are the legal conditions to obtain a registered design right?**

See *Question 1, Design patents.*

**28. Which authority registers designs? Does its website provide guidance on the application procedure? If not, please give brief details of this.**

See *Question 3.*

**29. On what grounds and when can third parties oppose a registered design application?**

See *Question 4.*

**30. When does registered design protection start and how long does it last?**

See *Question 5, Design patents.*

**31. On what grounds can a registered design infringement action be made?**

See *Question 6.*

**32. Which courts deal with registered design infringement actions?**

See *Question 7.*

**33. What are the defences to registered design infringement actions?**

See *Question 8.*

**THE REGULATORY AUTHORITIES****United States Patent and Trademark Office (USPTO)**

**W** [www.uspto.gov](http://www.uspto.gov)

**Main areas of responsibility.** The USPTO issues patents and registers trade marks.

**Guidance on application procedure.** The USPTO website provides detailed instructions on application procedures.

**US Copyright Office**

**W** [www.copyright.gov](http://www.copyright.gov)

**Main areas of responsibility.** The US Copyright Office registers copyrights.

**Guidance on application procedure.** Detailed information is provided on its website.

**34. What are the remedies for registered design infringement actions?**

See *Question 9.* Additionally, a plaintiff can recover an infringer's profits.

**UNREGISTERED DESIGNS****35. What are the legal conditions for unregistered design rights to arise?**

There is no express protection for unregistered designs in the US. Protection can be sought under the trade mark, copyright or unfair competition laws, provided the requisite conditions are met.

**36. When does unregistered design protection start and how long does it last?**

See *Question 35.*

**37. On what grounds can an unregistered design infringement action be made?**

See *Question 35.*

**38. What are the defences to unregistered design infringement actions?**

See *Question 35.*

### 39. What are the remedies for unregistered design infringement actions?

See *Question 35*.

### CONFIDENTIAL INFORMATION

### 40. What are the legal conditions for rights in confidential information to arise?

Confidential information may be protected by trade secret and unfair competition law. Trade secrets are usually protected under state common law and protection varies from state to state. Generally, confidential information is protectable if:

- It is information that:
  - is not generally known or ascertainable; and
  - provides an economic advantage to the owner.
- The owner has taken substantial steps to maintain its secrecy.

### 41. On what grounds can an action for unauthorised use of confidential information be made?

Generally, a trade secret misappropriation action can be brought against a party who has:

- Acquired the information through improper means or with knowledge that it was acquired through improper means.
- Divulged or used the information in violation of a duty not to disclose or use it.

### 42. Which courts deal with actions for unauthorised use of confidential information?

State courts. Federal courts may also hear trade secret cases, if the requirements for federal jurisdiction are met. However, they would still be applying state law.

### 43. What are the defences to actions for unauthorised use of confidential information?

- No misappropriation of information.
- The information is not a trade secret.
- Reverse engineering.
- Independent creation.

### 44. What are the remedies in actions for unauthorised use of confidential information?

- Injunctions.
- Damages (actual loss and unjust enrichment).
- Special damages/attorney's fees (for wilful or malicious misappropriation).

#### CONTRIBUTOR DETAILS

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