



Innovation, Science and
Economic Development Canada
Canadian Intellectual Property Office

Innovation, Sciences et
Développement économique Canada
Office de la propriété intellectuelle du Canada



DOING BUSINESS ABROAD

Protecting your IP in the United States



Canada

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DOING BUSINESS ABROAD

Protecting your IP in the United States

Intellectual property (IP) is a valuable asset that can support your business expansion abroad. A Canadian patent, trademark or industrial design does not secure your rights outside of Canada. You should consider obtaining IP protection in the countries where you plan on doing business, including selling products over the Internet and/or manufacturing products overseas.

Canada and the United States (U.S.) are among the world's largest trading partners. More than CAD\$1.5 billion in goods and services are exchanged between the countries each day. It is important to know how to recognize, register and enforce your IP rights in the U.S. For the most part, the protection and registration process for IP in the U.S. is similar to that in Canada.

In the U.S., you can apply for trademark, patent and copyright protection.







Where is IP registered?

The United States Patent and Trademark Office (USPTO)

is the U.S. federal agency responsible for granting patents and registering trademarks. Copyright registration is administered by the United States Copyright Office.

Applications for patents and trademarks can be filed electronically at [uspto.gov](https://www.uspto.gov), and copyright applications can be filed at [copyright.gov](https://www.copyright.gov). Both organizations' websites also have online searchable databases. A good first step is to search existing IP to check whether your anticipated IP use may conflict with or infringe on someone's prior rights.

Trademarks

- In the U.S., as in Canada, a trademark is a combination of letters, words, symbols and/or designs that distinguishes your company's goods and services from those of others in the marketplace.
- Trademarks must be filed directly through the USPTO. The USPTO also accepts applications for non-traditional trademarks such as scent and sound.
- The U.S., like Canada, follows a "first-to-use" system for trademark rights. This means that whoever used the mark first in the U.S. marketplace will own the rights to it even if the mark is not registered. However, you should still consider registering your trademark with the USPTO as registered trademarks are easier to enforce and have a number of other important advantages over trademarks that are not registered.
- A trademark is registered for 10 years and can be renewed every 10 years.
- If you are not regularly using your trademark in the U.S. marketplace it may be subject to a dispute or challenged for non-use.
- **For additional information** on trademarks and applying for trademark registration, visit [uspto.gov](https://www.uspto.gov).

Patents

- The USPTO issues and publishes patents. There are three different types of patents:
 - Utility patent—granted to anyone who invents or discovers any new and useful product, process or machine, or any new and useful improvement thereof. The term of a utility patent is 20 years from the date of application.
 - Design patent—granted to anyone who creates a new, original and ornamental design for a product. A design patent is similar to an industrial design in Canada. The term of a design patent is 15 years from the date the patent was granted.
 - Plant patent—granted to anyone who creates or discovers and asexually reproduces a previously unknown plant variety. The term of a plant patent is 20 years from the date of application.
- The U.S. has a “first-inventor-to-file” system which provides patent protection to the first person to file an application on an invention.
- If an inventor publicly discloses his/her invention, there is a one-year grace period to apply for a patent on that invention.
- The USPTO provides the option of filing a provisional application for a patent. As in Canada, a provisional application offers a quicker and cost-effective means for securing an early filing date. A provisional application is considered abandoned after 12 months so steps must be taken within this timeframe to convert it into or file a non-provisional application.
- The Patent Prosecution Highway (PPH) may be used by Canadian applicants to speed up the examination process for corresponding patent applications filed in the U.S.
- The Patent Cooperation Treaty (PCT) makes it possible to secure the rights to an invention in a large number of countries by filing a single “international” application instead of filing several separate applications. However, the granting of a patent in the U.S. remains the responsibility of the USPTO.
- **For additional information** on patents and applying for patent protection, visit uspto.gov.

Copyright

- In the U.S., as in Canada, copyright protects original works such as literary, dramatic, musical and artistic works.
- Applications for copyright registration are submitted to the United States Copyright Office.
- Most commonly, the term for copyright protection in the U.S. is the life of the author plus 70 years after the author’s death. However, the law dealing with the term of protection for copyright is complex. For more details on copyright term and copyright registration, please see the United States Copyright Office website.
- As in Canada, the registration of copyright is not required. However, a copyright registration is needed in order to initiate a lawsuit for infringement.





IP enforcement

There are several ways to enforce your rights against unauthorized use of your IP in the U.S.:

- The U.S. Customs and Border Protection (CBP), a bureau of the Department of Homeland Security, helps prevent counterfeit and pirated goods from entering the U.S. The CBP can seize and detain imported goods which violate U.S. IP rights.

Registered trademarks and copyright can be recorded electronically with the CBP. This is a quick, easy and cost-effective way to protect and enforce IP rights. CBP officers can access a database of recorded IP and monitor imports to prevent the transport of counterfeit goods and goods bearing infringing trademarks. For more information regarding IP recording and enforcement by the CBP, please visit cbp.gov.

- A “notice-and-takedown” process may be initiated by copyright holders by sending a takedown notice to an Internet service provider, search engine, host or other type of site owner/manager to remove from a website material that is infringing their copyright. Once a takedown notice is received, the alleged infringing material must be quickly removed.
 - Legal proceedings can be started. Mediation and arbitration, which are generally more informal, less adversarial, cheaper and settlement-focused, can be used as alternatives to going to court.
- Counterfeiting, piracy and other potential contraventions of IP rights can also be reported to the National Intellectual Property Rights Coordination Center, which investigates sources of goods that violate IP rights to identify and prosecute organizations and individuals that produce, smuggle or distribute such goods.



Tips: Important notes

- IP rights are important—take the time to identify your IP to determine what can be registered and/or enforced.
- Align your IP strategy with your business strategy. Identify business goals, protectable IP, regional requirements, potential partners and capacity to expand into your target markets.
- Routinely monitor the marketplace for any unauthorized use of your IP.
- Prior to proceeding with any of the enforcement methods outlined above, consider contacting a qualified legal representative to discuss options including a “cease and desist” letter.

For additional help:

- For information about IP protection in the U.S., please see the USPTO website at uspto.gov.
- For material relating to the export of goods to the U.S., please see the Canadian Trade Commissioner Service website at tradecommissioner.gc.ca.
- Visit the Global Affairs Canada website at international.gc.ca, for more information about doing business in the U.S.
- For IP tools, resources and information for business, visit Canada.ca/ip-for-business.
- For more information on going global with your IP, visit Canada.ca/export-ip.
- Find more programs and support for Canadian businesses and innovators at innovation.canada.ca.

* The information provided above is meant as an educational resource only and should not be construed as legal advice.



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