

Intellectual Property Protection and Management in Asia

David A. Jakopin, Esq.
djakopin@pillsburywinthrop.com
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Cultural Considerations

- **Take time to learn the culture**
 - **missteps and costly misunderstandings can be avoided**
- **Hire or associate with native representatives, which includes:**
 - **Employees and consultants**
 - **In-house lawyers**
 - **Outside law firm**
 - **Need firms that can work with other firms**



CHOICE OF LAW AND FORUM CONSIDERATIONS

- **Big issue in the relationship between Your Company, Inc. and Asian Co., Inc.**
 - **What law applies in interpreting agreements?**
 - **What law applies if a dispute?**
 - **What forum if a lawsuit?**



Patent and Trademark Procurement

- **For Patents:**
 - **Not all Asian Countries are PCT (Patent Cooperation Treaty) member countries (i.e. Taiwan), therefore need to be aware of priority filing requirements in each country of interest**
 - **Asian Countries are first-to-file, not first-to-invent, and typically require “absolute novelty”**
- **For Trademarks:**
 - **Consider applying before others apply for the same mark, as it can be difficult to get “your” mark back**



Copyright Procurement

- **No need to file (at least initially) to obtain protection**
- **Systematic procedures needed for applying copyright notice to:**
 - **Manuals**
 - **Software**
 - **Web Sites**
 - **White papers**
- **Consider adding further explanatory language, i.e.:**
 - **"Copyright 2003 Your Company, Inc. These coded instructions, statements, and computer programs are Confidential Proprietary Information of Your Company, Inc. and may not be disclosed to third parties or copied in any form, in whole or in part, without the prior written consent of Your Company, Inc."**



Trade Secrets

- **Generally speaking, trade secrets are not easily protected in Asian Countries as in the United States**
- **Accordingly, need to devise strategies to keep confidential that which should be confidential, knowing that much information will be written in a language you cannot read. Be practical:**
 - **minimize distribution on a “need to know” basis**
 - **establish guidelines and monitor, using native employees**
- **Also, can state trade secret law apply?**



Litigation Enforcement

- **Litigation practice in Asian Countries differs from country to country, but certain “similar differences” as compared to the U.S. exist:**
 - Minimal or no discovery
 - Civil instead of common law
 - Monetary awards typically less, but preliminary injunctions can be easier to obtain
 - Stricter statutes of limitations
- **Examples:**
 - Taiwan, until recently, had criminal penalties for patent infringement
 - In China, burden of proof can be on alleged infringer to show that a different process is used than the patented method

