

IP Attachés: Providing Services around the World to IP Practitioners and Their Clients

By Dominic Keating

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The United States Patent and Trademark Office's (USPTO's) intellectual property (IP) attachés serve as a valuable resource in today's globalized world. IP attachés are US diplomats with IP expertise assigned to US embassies and consulates throughout the world. Their expertise and experience facilitate their success by allowing them to address numerous topics, from broad policy issues to specific problems, on behalf of practitioners and US stakeholders. Consequently, the IP attachés can be a valuable resource—to US rights holders, practitioners, and their clients—by virtue of their unique knowledge, connections, and ability to assist US stakeholders who are facing IP-related challenges throughout the world.

IP attachés have a wealth of information available to them. They are not limited to their own IP knowledge, but can draw upon the USPTO's resources and expertise. There is a constant line of communication between the attachés and the USPTO. The USPTO Office of Policy and International Affairs, within which the IP Attaché Program operates, has teams of specialized patent, trademark, copyright, and enforcement attorneys who provide additional support and guidance to the attachés. The attachés also work closely with other US agencies in their regions.

Information, Assistance, On-the-Ground Counsel

IP attachés can provide information to practitioners and their clients regarding the protection, enforcement, licensing, and understanding of IP rights throughout the world. Attachés can assist practitioners and their clients in many ways, whether the client is already in a foreign market or wishes to enter a new area of the world. US stakeholders can benefit from the attaché's knowledge of the IP environment in a host country or region. Attachés can assist rights holders in navigating foreign legal landscapes, and may be able to provide direct assistance with specific IP-related problems located in the attaché's region of responsibility.

Attachés are resources who often listen and respond to questions or concerns that US stakeholders have about pursuing an investment in a particular area of the world. For example, recently in Brazil, a major US fashion label that manufactures shoes for export to the United States wished to open retail stores in Brazil and make its brand available to Brazilian consumers. However, the US company was concerned about the possibility of counterfeit products being sold locally in Brazil. The IP attaché in Rio de Janeiro met with the company's import-export director to provide information and guidance on how the company could enforce its IP rights under Brazilian law. The attaché's information allayed the company's concerns about counterfeiting, and it subsequently undertook the successful launch of its retail stores in Brazil.

IP attachés are also there to counsel rights holders on options for enforcing IP rights in each country or region. Every government has its own approach to stakeholder engagement and enforcement. Certain governments prefer that rights holders work through local counsel, while other governments are eager to engage with international companies directly.

This on-the-ground knowledge worked to the advantage of another US firm, a Tennessee-based furniture company that manufactured its products in China. The company's former original equipment manufacturer in China had obtained 13 Chinese design patents, and used them to block the company's other manufacturers from making and exporting products for the US company. The IP attaché in Guangzhou, China, met with the company's CEO and provided information and guidance on China's patent invalidation process and the workings of its IP judicial system. The attaché also provided suggestions on how the company could work with relevant government authorities. One week after the client discussed the situation with the attaché, three containers of furniture were released for export by Chinese customs officers. The company then took steps to invalidate the Chinese design patents and to fulfill an additional \$3.5 million in orders.

Many US companies encounter legal obstacles when attempting to expand their business overseas. If a client's business is hindered by foreign laws and regulations in a specific country, an attaché may be able to help. One of the attaché's roles is to advocate for changes in policies, laws, and regulations relating to intellectual property that are advantageous to US stakeholders. US stakeholders can help attachés to better understand the legal and regulatory issues they are facing. Thus, the attachés wish to hear about the specific challenges that US businesses and practitioners face, and to discuss with them possible solutions for the future.

While many practitioners and companies employ foreign counsel throughout the world, the local foreign counsel often do not have the same in-depth knowledge about the host government, nor access to it, as does an attaché. They also do not have the support and resources of other US government agencies. Unlike some local foreign counsel, the attachés often have a direct line of communication with the host government and can directly approach its officials regarding problems US stakeholders are facing. The IP attaché can also raise specific situations with foreign government officials when there appears to be a systematic flaw in the host country's IP protection and enforcement regime.

Sometimes, such a direct approach will bring a reasonably quick resolution. An example is the case of a US apparel maker that was working with a factory in the Pearl River Delta region of southern China. When the manufacturing facility abruptly shut down and the owners disappeared, the US company became entangled in the Chinese company's bankruptcy proceedings, and much of the US company's IP-protected equipment—including tooling and dies—was locked inside the shuttered factory. The IP attaché in Guangzhou worked with the State Department's economic officers and the US Consulate's Chinese staff to reach out to local authorities in China, explaining the US company's predicament. After a lengthy series of discussions, the municipal leaders eventually agreed to allow the US company to retrieve its proprietary items.

Counterfeiting: Often a Concern

Counterfeiting is an issue that the IP attachés encounter frequently. If a practitioner has a client that is having difficulties with counterfeiting and piracy and is unable to enforce its IP rights in various countries, an attaché may be able to help educate host-government officials on IP matters. This includes providing training to judges, prosecutors, patent and trademark examiners, customs officials, police officers, and policy makers. Such training can provide a better understanding of the US government's experience with IP matters, increase awareness of accepted world standards and practices, and, ultimately, enhance the effectiveness of IP protection in a given country or region. Also, by training officials of a host country, issues that clients may face can be alleviated or better understood.

Because the attachés participate in regular meetings with, and training programs for, IP enforcement officials in many regions, the attachés know exactly who to contact in a variety of situations. For example, if a US company obtains detailed information about counterfeit shipments entering a country, the IP attaché can often direct the company to the officials it needs to contact if it wishes to stop the shipment.

In one instance, a California-based electronics manufacturer known for its high-performance audiovisual products ran into a counterfeiting problem when the company's popular headphones were being produced and sold illicitly in Thailand. The IP attaché in Bangkok explained the potential remedies under Thai law to the company, and introduced the company's security officials to Thai customs officers and economic crime police. Thanks to the attaché's help, shipments of the counterfeit headphones were successfully seized by Thai officials.

Educating the Public

Another role of an attaché is to educate the public on intellectual property. Attachés are available to assist with, and develop, grassroots support for US policy positions by conducting public awareness programs on intellectual property. The programs might include professors, local officials, businesspeople, and students. Such information programs have been successful and well received throughout the world.

These public awareness programs can bring changes to the ways that intellectual property is protected and enforced. For example, in Guangzhou, China, the attaché organized a program on the importance of intellectual property in advancing a nation's economy. It included a presentation by the attaché as well as speakers from the provincial and local courts, the provincial IP office, Chinese academics and IP

practitioners, and Chinese and foreign rights holders. It also featured a mock US IP trial, with presentations by two federal jurists—one a trial judge, the other an appellate judge. All of the participants emphasized the critical role that intellectual property plays in national development and economic growth. Following the awareness program, China has begun to implement, on a limited-time basis, some long-standing remedies and litigation tools of the US legal system. These include issuance of temporary injunctions and evidentiary preservation orders, and publishing redacted opinions that prevent disclosure of sensitive or proprietary information to the public.

To learn more about the USPTO's IP Attaché Program and how you can contact an IP attaché, visit the program's website at www.uspto.gov/ipattache.

History of the USPTO IP Attaché Program

The start of the USPTO's IP Attaché Program goes back to 1992. During the Uruguay Round negotiations that established the World Trade Organization (WTO), the Japanese Patent Office posted an IP attaché to Geneva, leveraging the attaché's technical expertise in negotiating the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS). In 1993, the USPTO followed suit by posting an attaché to the US Mission to the WTO. Almost 10 years later, because of the importance of IP matters in China, the USPTO posted an IP attaché to the US Embassy in Beijing.

Based on the success of these initial postings, and new congressional funding for international outreach efforts, the USPTO expanded the attaché program in 2006 to include positions in major trade areas and IP "hot-spots" around the world, including Brazil, Russia, India, Thailand, Egypt, and their respective geographic regions. Today, IP attachés are based in 13 locations around the globe (see table).

The IP Attaché Program is funded and directed by the USPTO, which works closely with the Office of the US Trade Representative (USTR), the Department of State, and the Department of Commerce's US and Foreign Commercial Service. Because the USPTO does not have statutory authority to directly assign officers to embassies, it enters into agreements with other agencies to do so. For example, one of the attachés in Geneva is detailed to the State Department to serve at the US Mission to the United Nations (UN). The other attaché in Geneva is detailed to the USTR to serve at the US Mission to the WTO. The remaining attachés have been assigned to the US and Foreign Commercial Service under limited appointments. All attachés must commit to an initial two-year term, extendable in one-year increments, to a maximum of five years. After their terms expire, those attachés who were formerly USPTO employees have the option to return to work at the USPTO.

The IP attachés have a high-profile diplomatic position, with the opportunity to directly impact foreign IP policy. Any IP practitioner interested in becoming an IP attaché should note that vacancies for IP attaché positions are announced through USAjobs.gov by the International Trade Administration (keywords "Attorney Advisor (Intellectual Property)").

USPTO IP Attachés around the World

Currently, the USPTO has 13 attaché positions stationed throughout the world available to assist practitioners and US stakeholders (see table). Most of the attachés cover a wider region than just the country in which they are posted. Consequently, the attaché's knowledge and connections can benefit US stakeholders in multiple countries.

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IP Attaché Post	Countries/Regions Covered
Belgium	European Union, European Commission, and Turkey
Brazil	Argentina, Brazil, French Guiana, Guyana, Paraguay, Suriname, Uruguay, and Venezuela
China (Beijing)	Beijing
China (Guangzhou)	Most of southeastern China, including Fujian, Guangdong, Guangxi Provinces, and Hainan Island
China (Shanghai)	East China and Shanghai consular area provinces (Jiangsu, Zhejiang, and Anhui)
India	South Asia (India, Pakistan, Bangladesh, Nepal, Bhutan, Sri Lanka, and Maldives)
Kuwait	Middle East and North Africa
Mexico	Mexico, Central America, and the Caribbean
Peru	Bolivia, Chile, Colombia, Ecuador, and Peru
Switzerland (WTO)	World Trade Organization (WTO)
Switzerland (UN)	World Intellectual Property Organization (WIPO) and the United Nations (UN)
Thailand	Southeast Asia and ASEAN (Brunei, Burma, Cambodia, Indonesia, Laos, Malaysia, the Philippines, Singapore, Thailand, and Vietnam)
Ukraine	Commonwealth of Independent States (Azerbaijan, Armenia, Belarus, Georgia, Kazakhstan, Kyrgyzstan, Moldova, Tajikistan, Turkmenistan, Uzbekistan, and Ukraine) as well as the region of Eastern Europe outside of the EU (Serbia, Montenegro, Bosnia and Herzegovina, Albania, Kosovo, and Macedonia)