



# **IP/Licensing Awareness**

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# Plan

## # Intellectual property

- Copyright
- Designs
- Patents
- Trade Marks
- Domain Names
- Confidentiality

## # Commercialisation

# # Copyright



# What really is it?

- # An automatic protection of the form of expression of ideas in any medium
- # Does not protect the idea itself – protects original literary, dramatic, musical and artistic works, sound recordings, films, broadcasts and typographical arrangements
- # Not a monopoly right
- # A work may contain more than one copyright



# Copyright: Ownership

- ⌘ Owner = first author of any copyright work i.e. the person who creates it
- ⌘ When a work is made by an employee **in the course of his employment** his employer is the first owner of the copyright in the work, [subject to any agreement to the contrary]



# WARNING: Commissioned works

- # Works commissioned, even where for money or money's worth, will belong to the person creating the work **unless** agreed otherwise!
- # Ensure that ownership of the work is assigned to your or your business AND the author waives his/her moral rights
- # Areas of risk: web design, graphics, consultants carrying out work for your business i.e. software designers!!!



# Copyright: Life

- # LDMA: author's lifetime + 70 years
- # Films: 70 years after death of last director
- # Sound recordings: 50 years from first recording or, if published during 50 year period, 70 years from publication
- # Broadcasts: 50 years from first broadcast
- # Typographical arrangements: 25 years



# Copyright: Infringement

- Infringement occurs when somebody:
  - ✦ Copies a copyright work
  - ✦ Issues copies of the copyright work to the public
  - ✦ Rents or lends the work to the public
  - ✦ Performs, shows or plays a copyright work in public
  - ✦ Communicates a work to the public
  - ✦ Makes an adaptation of a copyright work or doing any of the acts listed above in relation to an adaptation





# Copyright: Copyright Notices

- Warnings
- Evidence
- Assist in criminal prosecutions for copyright infringement
- Presumed to be the author
- Copyright protection abroad:

**Copyright © [name of copyright owner]**

**[year of first publication].**

- Website: ensure © notices are displayed prominently on website (ideally above the fold)

# Database Rights (of extraction and re-utilisation)

- # Protects databases, i.e. collections of independent works, data or other materials which are arranged in a systematic or methodical way and are individually accessible by electronic or other means
- # Automatic protection upon creation
- # Requires originality and substantial investment (technical and financial) in obtaining, verifying or presenting the contents of the database
- # Protection lasts for 15 years from creation, publication or substantial update
- # GDPR considerations?



# Designs



# Design right (unregistered)

- Protects shapes and configurations
  - Internal and external
- Shapes and configurations must be 3-D
- An automatic right
- Original (not new) design protected against copying
- Not original if it is commonplace in the design field in question



# Design right

- Design protected for 10 years from first marketing or 15 years from first creation, whichever is shorter
- In the first 5 years the owner has a right against copying
- In the last 5 years the owner cannot refuse to sell a licence to others (Licence of Right)



# No Design Right protection available for:

- A method or principle of construction
- Features of shape or configuration which:
  - enable the article to be connected to, or placed in, around or against, another article so that either article may perform its function, or
  - are dependent upon the appearance of another article of which the article is intended by the designer to form an integral part
- Surface decoration



# Design: Ownership

- Owner = first author of any design i.e. the person who creates it
- When a work is made by an **employee in the course of his employment** his employer is the first owner of the design [subject to any agreement to the contrary]



# Warning: Commissioned Designs

- ⌘ Designs commissioned, even where for money or money's worth, will belong to the person creating the design **unless** agreed otherwise!
- ⌘ Ensure that ownership of the design is assigned to your or your business





# Registered designs

- # Design means the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture or materials of the product or its ornamentation
- # A design shall be protection by a right in a registered design to the extent that the design is new and has individual character
- # Initial registration – 5 years
- # Renewal fees every 5 years
- # Maximum term is 25 years
- # Applies to 2-D and 3-D shapes and configurations



# Patents



# Patentable inventions

For an invention to be patentable, it **must not have been made public** anywhere in the world before the date on which the application is filed. It must **involve an inventive step** when compared with what is already known and it must be **capable of industrial application**



# Patents: Confidentiality is key

**IT MUST NOT HAVE BEEN MADE PUBLIC, ANYWHERE IN THE WORLD, BEFORE THE DATE ON WHICH THE APPLICATION IS FILED**

Do not disclose your invention to anybody unless it is under a confidentiality agreement or where the relationship itself creates confidentiality i.e. solicitor, patent agent



# Patent: Ownership

- Owner = first author of any invention work i.e. the person who creates it
- When a work is made by an employee **in the course of his employment** his employer is the first owner of the invention in the work, [subject to any agreement to the contrary]
- Maximum term is 20 years
- Renewal fees payable each year after 4<sup>th</sup> anniversary of filing date.



# Patents: Infringement

Infringement occurs when a party manufactures, uses, sells or imports a patented product or process without the patent owner's permission

Defences:

- what you are doing does not infringe their patent claims, or
- the patent is invalid - you can take legal action to challenge the validity of the patent. If you win, their patent may be cancelled



# Trade Marks



# Trade Marks

- Any sign which is capable of being represented graphically
- Any sign which is capable of distinguishing the goods or services of one undertaking from another
- A “badge of origin” and marketing tool
- Unregistered or registered





# Registered Trade Marks

- # Must not be descriptive of the goods or services to which they relate
- # Classes 1-34 (goods) and classes 35-45 (services)
- # Registrations must be renewed every 10 years
- # Cancellation for non-use



# Trade Marks: Infringement – what not to do

- “If you use an identical or similar trade mark for identical or similar goods and services to a registered trade mark - you may be infringing the registered mark if your use of the mark creates a likelihood of confusion on the part of the public. This includes the case where because of the similarities between the marks the public are led to the mistaken belief that the trade marks, although different, identify the goods or services of one and the same trader.”

# IPO

# Trade Marks: Infringement – what not to do

- “Where the registered mark has a significant reputation, infringement may also arise from the use of the same or a similar mark which, although not causing confusion, damages or takes unfair advantage of the reputation of the registered mark. This can occasionally arise from the use of the same or similar mark for goods or services which are dissimilar to those covered by the registration of the registered mark.”

✦ IPO



# Trade Marks: Launching a new business or product

- If you are considering launching a new business name or a new product carry out trade mark searches – time and money invested at this stage could save a lot of money in the future!
- Search:
  - [www.ipo.gov.uk](http://www.ipo.gov.uk)
  - [www.oami.europa.eu/](http://www.oami.europa.eu/)
  - [www.wipo.int](http://www.wipo.int)
  - GOOGLE!

# Trade Marks: Use of TM and ®

The ® can only be used where:

- you own a registered trade mark; or
- you are licensed to use a registered trade mark

**DO NOT USE THE ® SYMBOL UNTIL THE MARK IS REGISTERED.**

You may be subject to a criminal conviction for misuse of the ® symbol



# Form:

[Mark][Registered trade mark or ®]

Or

[Mark][Trade mark or TM] [Name of trade mark owner]

i.e. Gillette ®, The Best a Man can Get TM



# Trade Marks: Why use of TM and ®

No requirement to use but, it will:

- # put people on notice of your rights;
- # act as a deterrent to potential infringers; and
- # enhance the marks distinctiveness

If the mark is not registered, still use the TM symbol as it denotes that the mark is used as a trade mark and may assist in a claim for passing off

# Domain Names





# Domain Names

- # Not an intellectual property right per se
- # Contractual right to use domain name
- # .co.uk registry = NOMINET
- # .com = ICANN
- # Can still be an infringement of third party's trade mark rights
- # Subject to abusive registration procedures



# Domain Names: Trade Mark Infringement

- # Ownership of a domain name does not give rise to any registered trade mark protection
- # The use of domain names can amount to trade mark infringement
- # Do not think that just because you have purchased the domain name, that you have the right to freely use the domain name



# Domain Names: Abusive Registration

- Abusive Registration
- If a complainant is successful in proving that there has been an abusive registration, the Nominet Dispute Resolution Service have the power to:
  - ✦ Suspend the domain;
  - ✦ Cancel the domain; or
  - ✦ Transfer the domain to the complainant (most common)



# Domain Names: Tips

- Before registering a domain name:
  - Carry out a 'google' search of the name – this will give you an idea of whether a trade mark for that name may already exist;
  - Carry out a search of the trade mark registries, i.e. UK Intellectual Property Office, OHIM and WIPO
  - Be aware the websites have international reach and could have international repercussions
- Website terms and conditions



# Confidentiality



# What to do

- Need to know basis
- Restrict access to areas
- Keep a contemporaneous record
- Stagger disclosure
- Disclose hard (numbered) copies
- Clear confidentiality provisions in contracts



# Use of confidential information

Where disclosure is for a specific, limited purpose, confidentiality may be preserved for all other purposes

Nonetheless it should be made clear that use of confidential information for any other purpose is not permitted



# Duration and other limits

- Confidential information can be protected indefinitely
- Out of date and of no commercial value
- Agreements limited by time
- Ex-employee restrictive covenants
- Technical information supplied to public bodies





# Is an NDA necessary?

- NDA's have a stigma attached to them, to extent that some people consider that they are not worth the paper that they are written on.
- We would always advise that you get an NDA in place when discussing any commercially sensitive information:
  - They preserve the confidentiality of patentable inventions, without an NDA you may lose the right to patent your product/process
  - They allow you to freely negotiate the terms of a contractual relationship, without fear of your sensitive information becoming public information
  - In the event there is a breach of confidentiality, they provide you with a contractual right to recover the loss that you suffer as a result



# Commercialisation



# Commercial Exploitation

- Ensure a confidentiality agreement is put in place prior to the disclosure to any third party of any confidential information, know-how or trade secrets during any discussions over commercial exploitation of your or your company's IP rights.
- Key consideration is how best to protect your IP/confidential information in the context of any proposed commercial exploitation and on the terms of any agreement governing such exploitation.
- Commercial exploitation of any IP tends to take the form of either an outright assignment or, more commonly, a licence in its various guises



# Commercial Exploitation

- In relation to licensing “out” any IP there are the following considerations:
  - what rights attaching to the ownership of such IP are to be (a) licensed and (b) reserved;
  - what will be the nature of licence grant (exclusive, sole or non-exclusive) in respect of such rights and will there be any minimum royalty/sales obligations imposed on the licensee;
  - what will be the geographic scope and duration of the licence grant, and what other use permissions and restrictions will attach to the licence grant (e.g. field of use);
  - will there be any right to sub-licence any of the licensed rights;
  - will any developments, enhancements or improvements to the IP be subject to the licence grant or licensed separately (resist any ownership claims from licensee);

# Commercial Exploitation

- what quality controls will apply to products generated from permitted use of the licensed rights;
  - what licence/royalty fees apply to commercial dealings with those products and/or the licensed rights;
  - what IP warranties/indemnities will be given by the licensor; and
  - what events will trigger termination of the licence.
- Licensing “in” IP
  - Ownership/licensing of IP in collaborations
  - Look to avoid joint ownership if at all possible

# Any questions?

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