

IRDG

HOW TO IDENTIFY, PROTECT AND BENEFIT FROM YOUR INTELLECTUAL PROPERTY

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WHAT IS INTELLECTUAL PROPERTY (“IP”)?

- Patents, copyright, registered and unregistered trade marks, registered and unregistered design rights, trade secrets, confidential information and know-how.
- Registered intellectual property and unregistered intellectual property.
- Patents are monopoly rights in an invention which can be enforced against third parties and are protected in Ireland by the Patents Act 1992 (as amended).

WHAT IS INTELLECTUAL PROPERTY (“IP”)? (cont.)

- Copyright is the exclusive right to do or authorise others to do certain acts in relation to original literary (which is defined as including software), musical, dramatic or artistic works. Copyright is given statutory protection in Ireland in the Copyright and Related Rights Acts 2000 (as amended).

WHAT IS INTELLECTUAL PROPERTY (“IP”)? (cont.)

- Trade Marks are signs capable of being represented graphically which can distinguish the goods or services of one undertaking from those of another. They are given statutory protection in Ireland under the Trade Marks Act 1996 (as amended).

WHAT IS INTELLECTUAL PROPERTY (“IP”)? (cont.)

- Designs are protected by the Industrial Designs Act 2001 (as amended) which protects the appearance of articles, both 3 dimensional (shape) and two dimensional (surface decoration).
- Trade secrets are information in relation to commercial processes, e.g. manufacturing or production, which, if disclosed, would constitute breach of confidence or of contract.

WHAT IS INTELLECTUAL PROPERTY (“IP”)? (cont.)

- Confidential Information is information which parties to a contract or arrangement require not to be made public or disclosed to third parties.
- Know-How is information and techniques likely to assist in the manufacture or production of goods, etc.

WHY SHOULD IP BE PROTECTED?

- Valuable asset
- Leveraged to raise finance
- Exploitation – licence or sell
- Gain advantage over competitors
- Distinctive appeal to customers
- Enforceability

HOW DO YOU PROTECT YOUR IP?

- By registration
- By management
- By defence
- By exploitation

INTELLECTUAL PROPERTY MANAGEMENT (cont.)

- Intellectual Property Management Strategy
- Outlines business' approach to protecting, defending and exploiting its IP
- Who is in charge of the strategy – internal or external personnel?

INTELLECTUAL PROPERTY MANAGEMENT (cont.)

- IP Audit
 - Identify all IP
 - Establish who owns it
 - Ascertain does business have permission to use it
 - How is it protected and is it adequately protected

INTELLECTUAL PROPERTY MANAGEMENT (cont.)

- Assess importance of IP and its value
- Ascertain whether business is infringing third party IP rights
- Identify any unexploited IP

INTELLECTUAL PROPERTY RIGHTS

- Patents
 - Inventions
 - Patent searches
 - Watch service
 - Possibility of a new patent if the invention is modified or varied

INTELLECTUAL PROPERTY RIGHTS (cont.)

- Trade Marks
 - The way goods and services are represented
 - Badge of origin
 - Common law protection – Passing Off
 - Trade Mark Searches

INTELLECTUAL PROPERTY RIGHTS (cont.)

- Watch Service
- Use of a modified trade mark
- Regular monitoring of the goods and services specification
- Where house brand - register a company name
- Register a domain name

INTELLECTUAL PROPERTY RIGHTS (cont.)

- Design Rights
 - Protects the physical appearance of items
 - Can form essential part of business branding
 - Can be registered or unregistered

INTELLECTUAL PROPERTY RIGHTS (cont.)

- Copyright
 - Automatic protection
 - Literary, Artistic, Musical or Dramatic Works
 - Difficulty establishing proof of right

INTELLECTUAL PROPERTY RIGHTS (cont.)

- Insert copyright symbol and date
- Establish date of creation by depositing hard copy with solicitor or post to yourself and leave unopened

INTELLECTUAL PROPERTY RIGHTS (cont.)

- Trade Secrets
 - Items that are secret to the particular business
 - Should be clearly defined
 - Should only be revealed under strict obligations of confidentiality

INTELLECTUAL PROPERTY RIGHTS (cont.)

- Confidential Information
 - Includes items such as trade secrets but is also much broader in that it could cover business plans, customers lists, etc.
 - Should be clearly marked as confidential information
 - Should not be disclosed to anyone unless they have signed a Confidentiality Agreement

INTELLECTUAL PROPERTY RIGHTS (cont.)

- Know-How
 - In someone's head

INTELLECTUAL PROPERTY RIGHTS (cont.)

- Territoriality
 - IP is generally territorial
 - Identify countries of interest to business and protect IP in the relevant jurisdictions
 - Ensure IP is protected when the business enters into new markets

INFRINGEMENT

- Enforce your IP – or risk losing it or reducing its value
- Remember infringer could be potential licensee
- ADR may resolve dispute – Mediation and Arbitration
- IP matters can be heard in Commercial Court regardless of value
- Respect the IP rights of third parties

INFRINGEMENT (cont.)

- Defences to a Patent Infringement Claim
- Consent
- Invalidity
- Earlier rights
- Private use or use for non commercial or experimental purposes

EMPLOYMENT/CONTRACTORS

- Who owns the IP?
 - Generally employers own any IP created by their employees
 - BUT employers should nevertheless state the position clearly, unequivocally and explicitly in the contract of employment

EMPLOYMENT/CONTRACTORS (cont.)

- Recordal of Information
 - Research notes, designs or discussions should be noted in a logbook
 - Where necessary entries should be witnessed and dated
 - Logbooks should be kept in a secure place
 - Include provision in contract making the recordal of information obligatory

EMPLOYMENT/CONTRACTORS (cont.)

- Moral Rights
 - Paternity Right
 - Integrity Right
 - False attribution of a work
 - Right to privacy in photographs and films
 - May be waived but not assigned

EMPLOYMENT/CONTRACTORS (CONT.)

- Confidential Information
 - Includes trade secrets, customer lists, marketing plans etc.
 - Common law implies a duty of fidelity on the employee
 - BUT nevertheless include a confidentiality provision in the contract of employment as it is easier to enforce

EMPLOYMENT/CONTRACTORS (cont.)

- Independent Contractors
 - Not employees of the business e.g. website designer
 - IP does not belong to the business
 - IP needs to be specifically assigned to the business so that it may be exploited

SECURITY

- Practical measures to secure IP materials:
- Store materials in a secure place
- Access password protected
- Limit access to password on “need to know” basis
- Good antivirus software

SECURITY (cont.)

- Implementation of firewalls on all systems
- Regular back-ups
- Store back-ups securely
- Risk strategy to deal with computer failure, flooding etc.

LICENSING OF INTELLECTUAL PROPERTY

- Why Licence?
 - May not have the resources to exploit the IP – marketing, reputation, finances and knowhow
 - Generate a revenue stream

LICENSING OF INTELLECTUAL PROPERTY (cont.)

- Terms of the Licence Agreement
 - Consideration
 - Subject matter of licence
 - Termination provisions
 - Exclusive or non exclusive
 - Territory

UNITARY PATENT AND UNIFIED PATENT COURT

- Unitary Patent will mean one patent registration with pan-European effect
- Different from current European Patent which is essentially a bundle of national patent rights
- Currently each national court decides whether a patent has been infringed in that particular State or if a patent is valid in that particular State
- Unified Patent Court decisions will have pan-European effect
- Court of First Instance in Paris (with sections in London and Munich) and Court of Appeal in Luxembourg
- Irish Government announced that it had decided to host a local division but a Referendum to amend the Constitution will be necessary.

Thank You
Any Questions ?