



An Overview of Intellectual Property Law

Fiona C Rodgers

Solicitor – Commercial/ IP Law

SILVERMAN SHERLIKER LLP

SOLICITORS



Agenda

1. What is Intellectual Property?
2. Why Protect Your I.P.?
3. Types of I.P.:
 - Copyright
 - Trade Marks
 - Patents
 - Design Rights (Reg. and Unreg.)



What Is Intellectual Property?

Intellectual + Property





What is Intellectual Property?

1. Artistic Products

- genuine artists could be ripped off by 3rd rate imitators.

2. Business Products

- genuine brand owners could have their world famous products ripped off.

3. Consumer Protection

- a genuine indication of the quality and origin of the goods or services.



What is Intellectual Property?

- a core asset.

‘Intellectual Property is a critical component of our present and future success in the global economy. Our economic competitiveness is increasingly driven by knowledge-based industries, especially in manufacturing, science-based sectors and the creative industries.’

Introduction on homepage of HM Treasury’s

Gower Review of Intellectual Property



What is Intellectual Property?

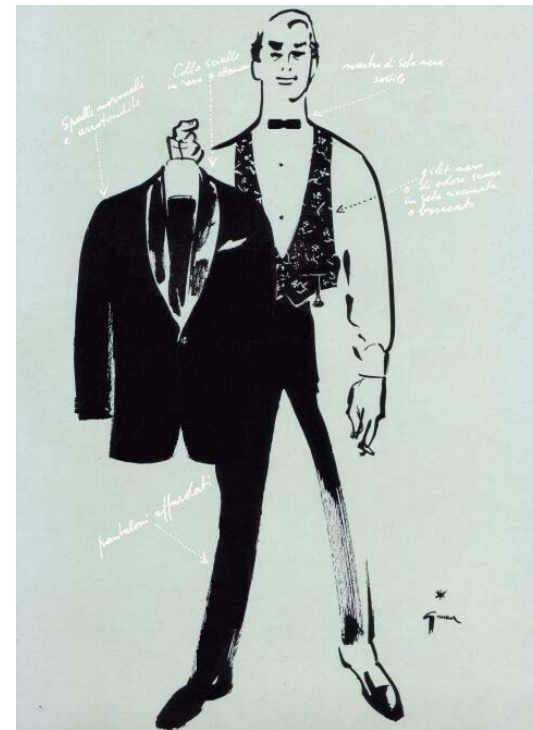
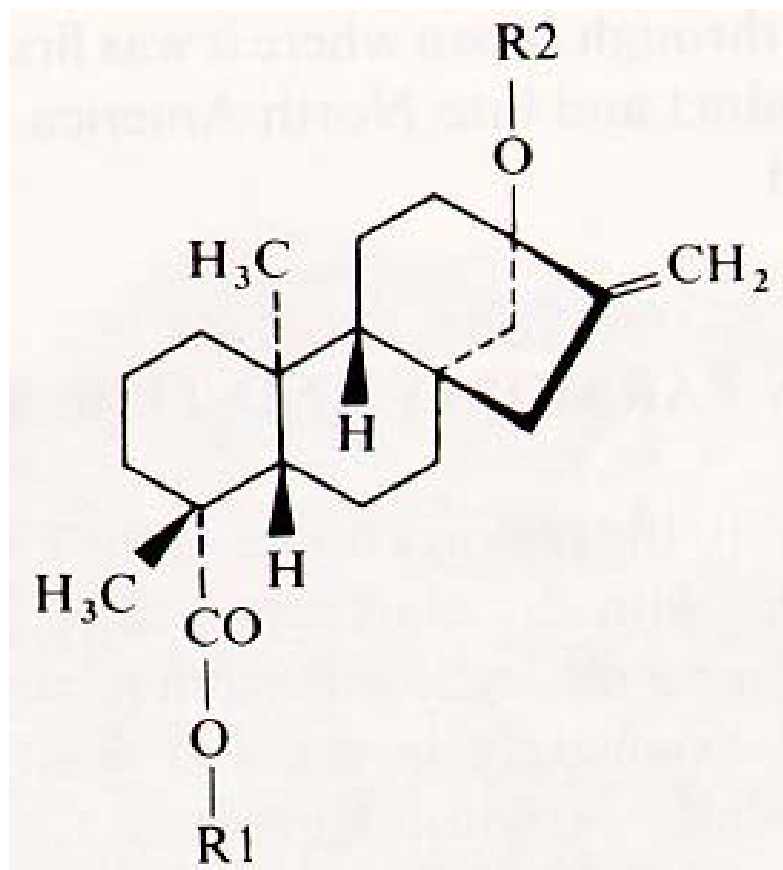
Examples





What is Intellectual Property?

Examples





What is Intellectual Property?

Examples





Why Protect Your IP?

Ways to exploit Intellectual Property:

- Use it yourself
- Sell it – Assignment/Transfer
- Allow others to use it – Licence



Why Protect Your IP?

Use It Yourself:

- Requires capital
- More exposure – pros and cons
- Keep all profits
- More control on public perception and impression



Why Protect Your IP?

Assignment v Licence

Assignment

Advantages

- no continuing obligations.
- One-off lump sum £££.

Disadvantages

- Relinquish control.
- Value of IP?



Why Protect Your IP?

Assignment v Licence

Licence

Advantages

- retain control
- Royalty stream of income
- Maximise exploitation

Disadvantages

- Relationship breaks down
- Continuing obligations



Why Protect Your IP?

Assignment v Licence

Other Considerations:

- Sole Owner?
- Conflicting dealings?



Types of I.P.

COPYRIGHT

- Copyright, Designs and Patents Act 1988 (CDPA)
- Types of work protected by ©
- Requirements for protection
- Duration of ©
- Ownership
- Primary and Secondary Infringement
- Permitted Acts (defences to infringement)
- Remedies



Types of I.P.: Copyright

Subsistence of ©

A work must:

- fall into one of the categories of work protected by © law
- Qualify for protection under © law
- The term of © must not have expired



Types of I.P.: Copyright

Subsistence of ©

Works Protected:

- Original literary, dramatic, musical or artistic works
- Sound recordings, films or broadcasts
- Typographical arrangement of published editions



Types of I.P.: Copyright

Ownership

General Rule:

- First owner of © is the author
- The author is the person who creates the work

BUT

- in the course of employment exception



Types of I.P.: Copyright

Duration of ©

Expiry Date:

LDMA = Life + 70 years

Sound recordings= 50 years from end of calendar year in which the recording is made/published/played or communicated in public



Types of I.P.: Copyright

Primary Infringement of ©

- copying a © work
- Issuing copies of a © work to the public
- Renting or lending the © work to the public
- Performing, showing or playing a © work in public
- Making an adaptation of the © work



Types of I.P.: Copyright

Secondary Infringement of ©



Types of I.P.: Copyright

Permitted Acts (Defences to © infringement)

- Making of temporary copies
- Fair dealing- criticism, review and news reporting
- Fair dealing – research and private study
- Incidental Inclusion
- Public Interest
- + others.....



Types of I.P.: Copyright

Other © Related Rights

E.g. Moral Rights

- Right of Paternity
- Right of Integrity
- Not to suffer false attribution
- Right to privacy



Types of I.P.

TRADE MARKS

A trade mark is essentially a brand.

“I MADE THIS”

Reassures Consumers as to:

- Origin
- Quality
- Luxury
- Economy



Types of I.P.: Trade Marks

- Top Ten Brands (Interbrand Corporation/ Business Week 2009)



NOKIA



Google





Types of I.P.: Trade Marks

Definition of a Trade Mark

Any sign which can be represented graphically and which is capable of distinguishing the goods and services of one u/t from those of another.

But

Absolute and Relative Grounds for refusal



Types of I.P.: Trade Marks

A trade mark may consist of any of the following:

- Words
- Slogans
- Designs
- Letters
- Numerals
- Internet Domain Names
- The shape of goods and their packaging



Types of I.P.: Trade Marks

- Sounds
- Colours
- Smells
- Gestures
- Moving Digital Images



Types of I.P.: Trade Marks

Benefits of Trade Mark Registration

A registered TM is:

- A valuable commercial asset
- Commercially exploitable
- Relatively easy to protect and enforce
- A deterrent to infringers
- Renewable indefinitely

Grants exclusive right statutory right to use the mark



Types of I.P.: Trade Marks

Absolute and relative grounds for refusal:

Absolute grounds – relate to the characteristics of the mark

Relative Grounds – relate to identical or similar trade marks that already exist.



Types of I.P.: Trade Marks

- **Owner** - the registered proprietor
- **Duration** – indefinite

BUT:

- misleading
- generic
- 5 years non-use



Types of I.P.: Trade Marks

Trade Mark Infringement

Identical sign + Identical goods

Identical sign + Similar goods + Likelihood of conf.

Similar sign + Id/Sim goods + Likelihood of conf.

Id or sim sign + Any goods + reg mark has
reputation & use is without cause & takes unfair
commercial adv/ is detrimental to distinctive
character/repute of mark



Types of I.P.: Trade Marks

Defences to TM Infringement

- the own name defence
- Use of indications concerning the kind, quality, geographical origin of goods
- Use of tm to indicate intended purpose of goods/ services

BUT – in accordance with honest practices in industrial/commercial matters.



Types of I.P.

PATENTS

- Inventions, industrial processes;
- Requirements:
 - Novelty;
 - Inventive step;
 - Industrial application;
- Owner – inventor, (employer);
- Duration – up to 20 years;
- Monopoly to exploit – *quid pro quo* justification;
- Registrable – highly specialised, territorial



Types of I.P.: Patents

Excluded from protection

- Discoveries; scientific theories; mathematical methods; aesthetic creations; schemes, rules and methods for performing mental acts; games or business methods; computer programs; plant and animal varieties;
- Inventions likely to encourage offensive, immoral or anti-social behaviour.



Types of IP

REGISTERED DESIGN

- Surface design of an article applied by any industrial process;
- Requirements – eye appeal, shape, configuration, pattern, ornament;
- Owner – designer, employer or commissioner;
- Duration – 25 years, in 5 year periods;
- Registrable – territorial;



Types of IP: Registered Design

- Examples of registrable designs:





Types of I.P.

UNREGISTERED DESIGN RIGHT

- Common law right / similarities with copyright;
- Functional elements, shape and configuration;
- Owner – designer, employer, commissioner, marketer;
- Duration:
 - 15 years from time it was created; or
 - 10 years from time it was made commercially available;
- Automatic, no need for registration;
- Costs – free.



Contact Details

Fiona C Rodgers

Email: fcr@silvermansherliker.co.uk

Tel: 020 7749 2700

SILVERMAN SHERLIKER LLP
SOLICITORS