



LMAPR 2648

Intellectual Property

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April 2019

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What covers Intellectual Property?

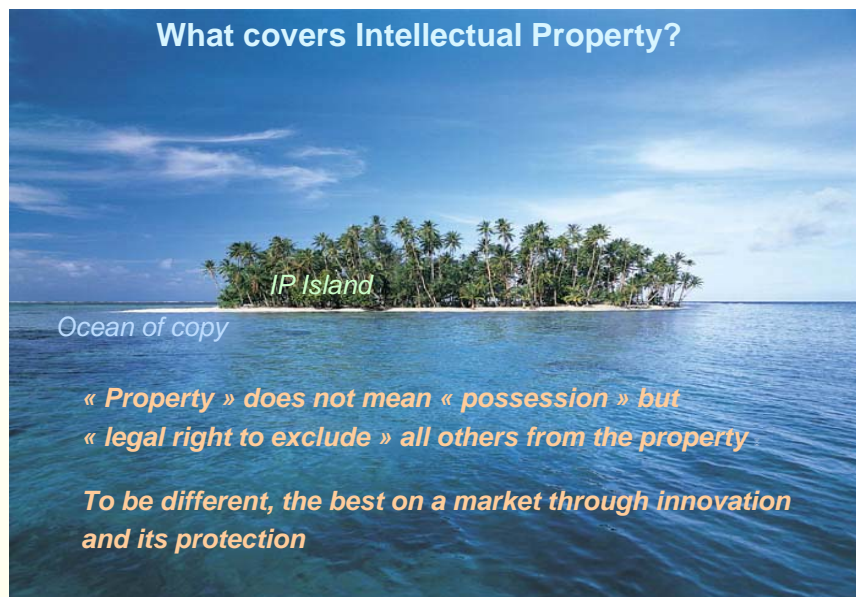
General rule = free copy = public domain



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What covers Intellectual Property?



Ocean of copy

*« Property » does not mean « possession » but
« legal right to exclude » all others from the property*

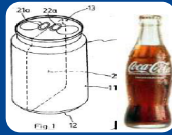
*To be different, the best on a market through innovation
and its protection*

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What covers Intellectual Property?



Creations

- **Patents** for technical inventions
- Industrial **designs** for aesthetic aspect + useful/original



Distinctive signs

- **Trademarks**
- Identify products, services or actors in the market



Copyrights and related rights

- Author's right, Editors' right
- **No formal filing** – up to 70 years after author death

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What is ? Industrial design



➤ What is it?

Time limited exclusive right 2-D or 3-D **Aesthetic ornamental creations** (aspect) to prevent copy or imitation

➤ Conditions to protect?

- ✓ **Novelty (50 years)**
- ✓ **Originality - individual character**
- ✓ **Have useful function** - purpose is to be used or is a working tool
Benelux, Canada, the United States of America, Brazil or Mexico

➤ How to protect?

Registration needed (most often), by country
1 year to test - 6 months priority : no exam, certificate

➤ How long?




- ✓ **5 years (OHMI - EC)**
- ✓ **Renewable up to 4 times (fees – 25 years max. in total)**



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What is a registered trademark?

- A trademark which is **protected** by an intellectual property right
- Specific sign which makes your good unique
- It can be
 - a **word** : Apple
 - a **picto** :  
 - a mix of word and picto 
 - color(s), sound(s), a shape, letters, a name or tridimensional
- It must be **distinctive** and **non descriptive**
⇒ Avoid confusion

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How to register a trademark?

1. Choose a name convenient in many languages
2. Check if the trademark is still available with similarity search
3. Choose the class(es) and the countries/region of registration
4. Customize the definition of the class(es)
5. Apply for registration in the trademark office(s)
6. Defend the trademark during the registration process and after in case of opposition

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The classes – Nice classification

The Nice Agreement establishes a classification of goods and services

1. 145 states use it
2. Trademark has to be registered in the appropriate class(es)
3. Class is linked to the nature and function of the product/service
4. 45 classes : 34 for the products and 11 for the services

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Where to register?

Depends of the targeted market

- **International level - Madrid System**
1 application - 1 language - 1 set of fees - 116 countries.
+ Validation in each chosen country.
- **Regional level - European Union TradeMark (EUTM)**
1 application — 1 language — 1 fee - 28 EU Member States
- **National level**
Only in the territory of registration. Brazil, for eg.

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What is the duration of a registration?



- Basically 10 years
- Can be renewed indefinitely for 10 years period
- But a trademark must be used to remain valid
 - If you do not use your trademarks or if you do not use these properly, you weaken our right and possibly can loose it.



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How to maintain a registration ?

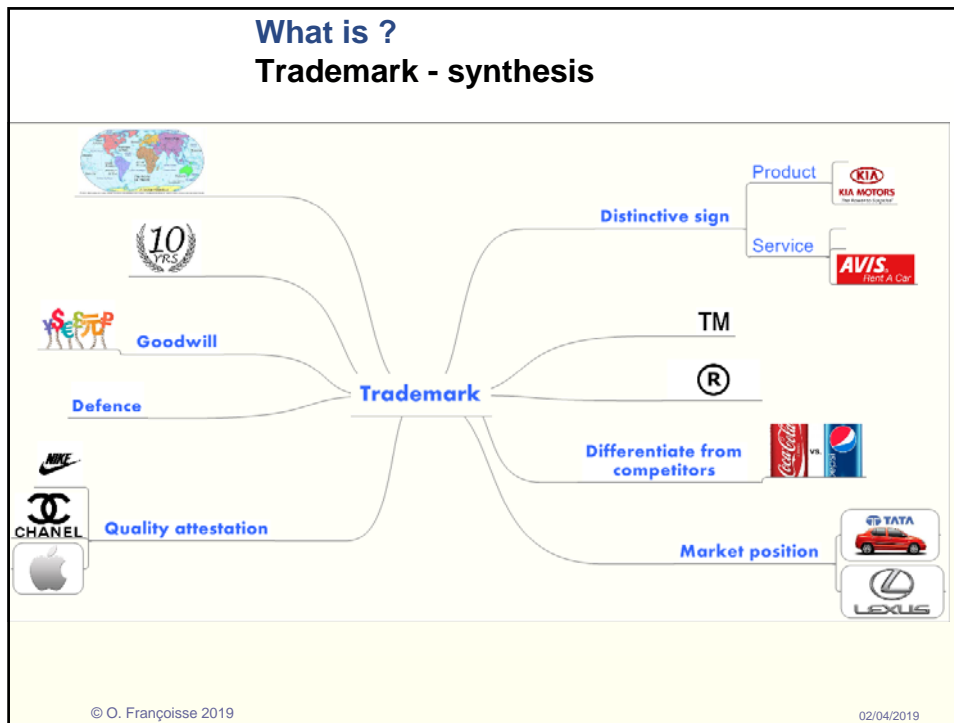
- Use the trademark properly and actively
- Mark the trademark with ®
- Protect the trademark from misuse by others
- Renew the registration each 10 years
 - Some countries might have shorter or longer validity period (ex : 15 years in Canada)
- Do not use nick names or abbreviations

This will avoid to weaken our protection and give the right to exclude others to use it.

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What is ? Trademark - synthesis



What is a patent ?

- Right to forbid someone else what is claimed (Territorial right – 20 years).
- **→ NOT A RIGHT TO DO THE INVENTION**
- Invention = Technical solution to a technical problem

NEW

*Never been disclosed
anywhere, in any language,
by anyone (even by the
inventor!!!)*

INVENTIVE

*not obvious for "the man
skilled in the art" →
obvious for you is not
necessary obvious in
patents...*

**APPLICABLE
INDUSTRIALLY**

*unless you invent
perpetual movement, it
is always true*

CLEAR

*i.e. high specific
surface, what
means « high » ?
How to measure?*

**SUFFICIENCY
OF
DISCLOSURE**

*Man skilled in
the art should be
able to
REPRODUCE the
invention and to
obtain the **SAME
TECHNICAL
EFFECT***

« Contract » : monopoly in exchange of
disclosure of what people cannot do

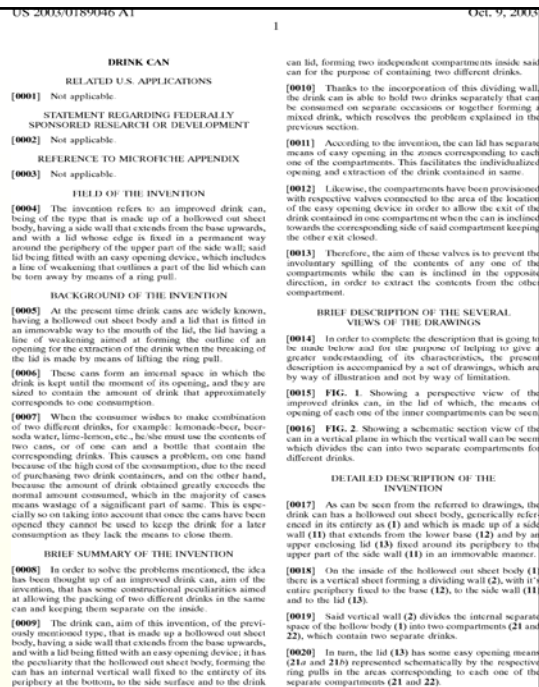
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What is a patent?

➤ Patent ≡ Document

- ✓ Number
- ✓ Bibliographic information
- ✓ Abstract (database purpose)
- ✓ Description (specification)
 - ❖ Field
 - ❖ Prior art
 - ❖ Invention
 - ❖ Examples
- ✓ Drawings
- ✓ Claims

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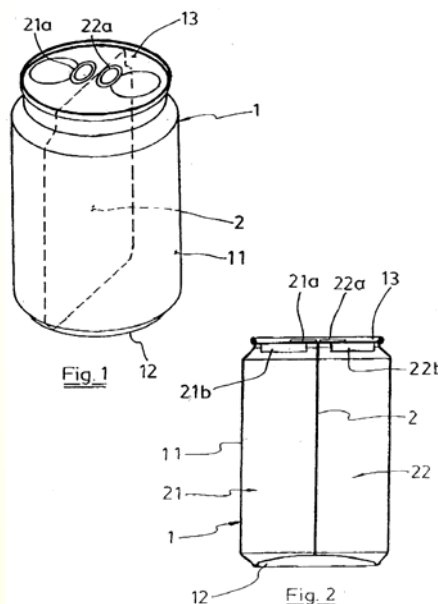
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What is a patent?

➤ Patent ≡ Document

- ✓ Number
- ✓ Bibliographic information
- ✓ Abstract
- ✓ Description (specification)
- ✓ Drawings
- ✓ **Claims ≡ legal part of the patent**
 - ❖ Must be fully supported by the description (no new matter)
 - ❖ Will define the right to exclude
 - ❖ Will be the object of the patentability examination
 - ❖ Appear after 2d world war



I claim:

1. Drinks can, of the type that is made up of a hollowed out sheet body (1), having a side wall (11) that extends from the base upwards (1), and with a lid (13) whose periphery is fixed in a permanent way around the periphery of the upper part of the side wall (31); said lid (13) being fitted with an easy opening device, which includes a line of weakening that outlines a part of the lid which can be torn away by means of a ring pull and characterised in that the hollowed sheet body (1) has a dividing wall (2) on its inside that is fixed along the entirety of its periphery to the base (12), to the side surface (11) and to the lid (13) of the drinks can; this arrangement forms two separate compartments (21 and 22) on the inside of said can for the purpose of containing two separate drinks; and in that the lid (13) has some easy opening means (21a and 22a) connected to the respective compartments at the areas corresponding to each one of the compartments (21 and 22) for their individualized opening and the separate extraction of the drinks contained in same.

2. Drinks Can, according to the previous claim, characterised in that the compartments (21 and 22) have connected to the areas of location of the opening means (21a and 22a) corresponding valves (21b and 22b) that only allow the drink contained in one compartment (21 and 22) to exit when the can is tilted sideways towards the corresponding said compartment (21 and 22).

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What is a patent

The claims : define the scope of protection

Current situation:

Problem: not easy to handle
when beverage is hot



Invention :

Solve the
technical problem



→ Claim this
invention to be
as broad as
possible

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What is a patent?

Invention



Recipient



Recipient + handle



Recipient + handle for containing hot liquids

Recipient with thick walls



Recipient made of ceramics + handle



Recipient sized for drinking + handle

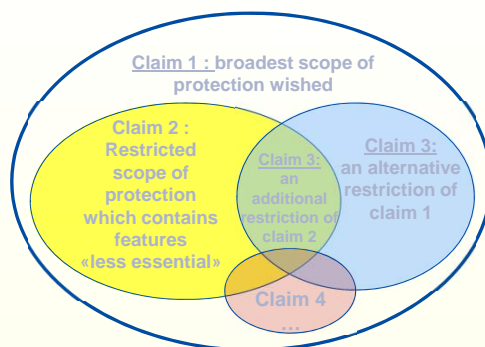
* Precise in description
« sized for drinking »

Essential feature : sized for drinking
Characterizing feature of the invention : handle

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What is a patent ? The claims

Invention



Claim 1 : Recipient sized for drinking + handle

Claim 2 : position of handle

Claim 3 (1): materials

Claim 3 (2) : position of handle + materials

Claim 4 (1): fixation means of the handle
...

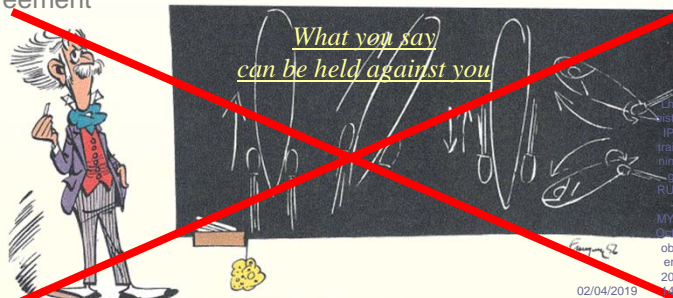
Dependent claims are optional but can serve as fall back position for novelty and inventive step during the examination proceedings
Claims are examined independently

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How to obtain a grant?

What you must **NOT** do before filing?

- NOVELTY - Before filing, the invention may not be
 - ✓ Disclosed by a written or even an oral description
 - ✓ Produced, offered for sale, distributed, imported, stored or used for industrial or commercial purposes by third parties
- **Never disclose any information before the first filing**
- Never discuss, sell, deliver sample or present visual materials to client/external people... before first filing or sign a confidentiality agreement



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How to file on an international level?

Is there a worldwide patent ?

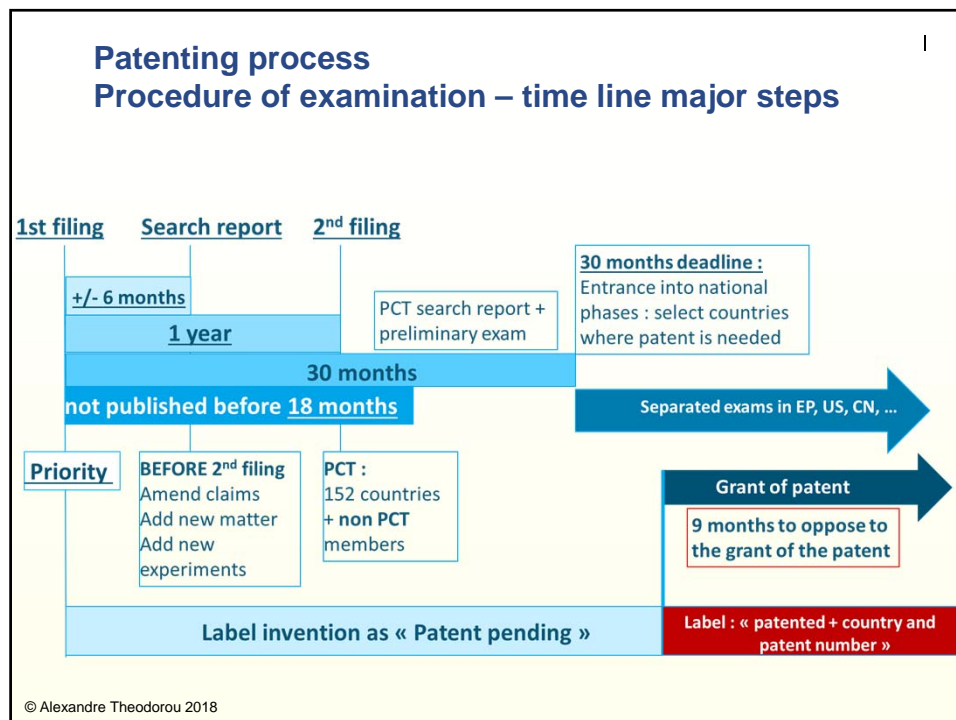
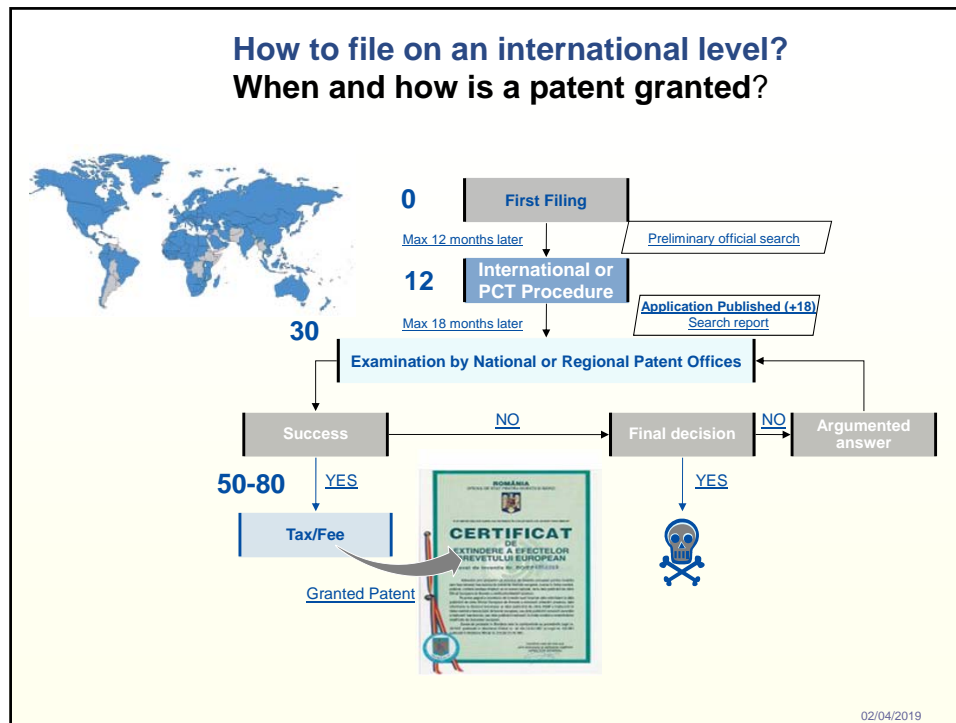
NO but

- First filing in any country of the Paris Convention (174) gives one year of priority to file in these countries
- Within the 12 months after first filing, possibility to use the PCT (Patent Cooperation Treaty) filing
 - ✓ In one step the same effects as national applications filed in the 152 contracting countries
 - ✓ Cheaper
 - ✓ Useful to delay your final decision with respect to those countries in order to :
 - ❖ achieve market studies (economical test)
 - ❖ fine tune the patent description (technical test)
 - ❖ first evaluate the patentability of the invention on the basis of the PCT Search Report (legal test)

PCT is a « reservation system »

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Typical problems

➤ In terms of business

CONFIDENTIALITY

- › Disclosure outside the company before patent filing...
- › No NDA signed with external partners
- › Sales & Marketing : they talk « too much »
- › People not enough aware of IP

COMPETITION

- › Doing R&D, commercialization without « Freedom to operate »
- › No freedom to operate? → Observation* of 3rd party / opposition* / License/Invalidation? Way to get around the blocking patent?
- › Opposition against our patents
- › Bad news? → **anything you write will be used against us in court**

INFRINGEMENT?

- › How do you follow the market?
- › How can you prove a competitor product is infringing?
- › Patented? Patent pending? No patent?
- › Importance of accurate marking of the products

* observations of 3rd party : **during examination**, a.o. US maxi. 9 months after publication

* opposition/post grant review : a.o. in Europe/US maxi. 9 months **after grant**

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Typical problems

➤ In term of patent quality / opportunities

Novelty – Inventive step

- › What are you doing?
- › Which solutions are already existing? Why you don't do that?
- › What are you doing better?
- › Something new?

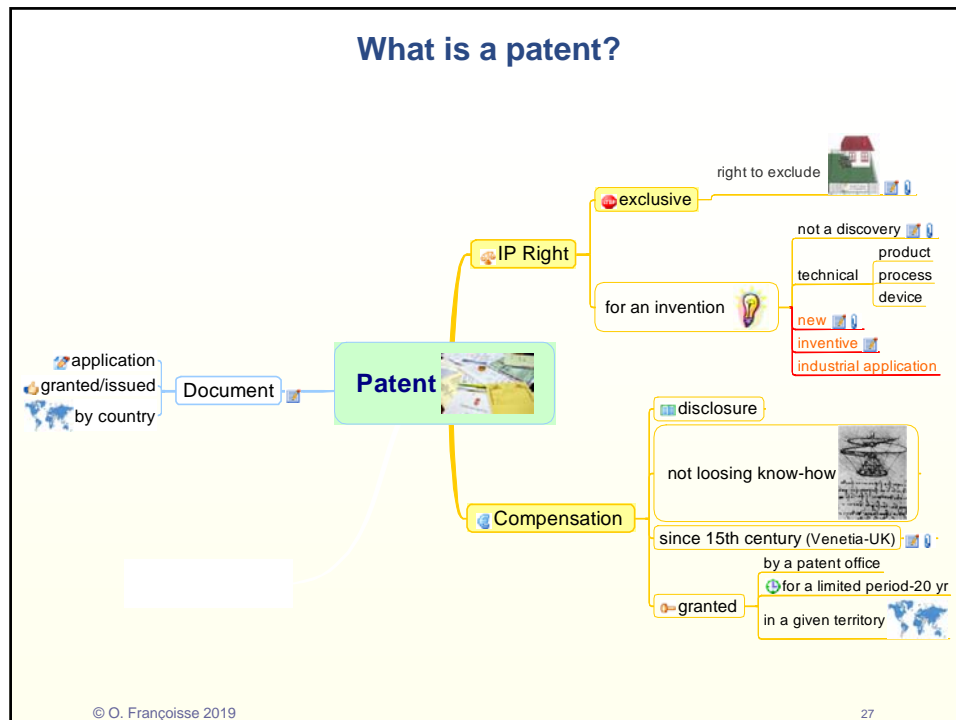
Technical effect

- › Why do you do that? What is the technical effect?
- › Which problem have we solved?
- › Any disclosure solved the same problem in the same way?
- › Which benefit for clients?

Characterization

- › What are the essential features to provide the technical effect?
- › If you change some parameters/design, still the same technical effect?
- › How to characterize essential features?
- › Which analysis can provide evidence of any counterfeiting product?
- › Which test/experiment can provide evidence that there is a technical effect?

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Thank you