

Intellectual Property Rights (IPRs)

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The modern concept of patents dates to 1421, Florence, Italy, when the city-state granted the first recorded patent to Filippo Brunelleschi, for the design and use of a ship, the Badalone ("seagoing monster"). The Badalone was intended to ferry supplies up the Arno river to the city for the building of the Florentine cathedral dome, which Brunelleschi was the designer of. Alas, the Badalone sank during delivery of a load of white marble intended for use in constructing the dome. The Venetian Senate passed the first patent law in 1474, granting limited duration monopoly for original devices. This law embodied the principles of patent protection as we know them

- Registration required
 - Patents
 - Trade Marks
 - Registered Designs
 - Domain Names
- Registration not Needed
 - Copyright
 - Unregistered Trade Marks
 - Unregistered Design rights
 - Confidential Information
- IP systems

Implemented as a two-tier system:

A national patent office: responsible for accepting, processing and granting patent, trade mark and registered design applications: <http://www.patentsoffice.ie/en/homepage.aspx> National courts: which provide a forum for IPR infringement to be enforced and for IPR validity to be contested

Confidential information

Patents

- A monopoly right in an invention.
- Covers how things work, what they do, how they do it, what they are made from or how they are made.

3.1 Background

The origins of patents for invention are obscure and no one country can claim to have been the first in the field with a patent system

Today's patents remain a bargain between the state and an inventor. A monopoly of 20 years is granted in return for teaching the invention to the public.

3.2 Monopoly

Provides a monopoly that can be used to restrict others from making, selling or using an invention without permission.

An Irish patent only restrains commercial activity in Ireland: To restrain activity abroad, you must have a patent in the relevant country

3.3 What is patentable?

Determined by national law.

Generally, all patent systems require:

novelty

inventive step

industrial applicability.

3.4 Novelty

An invention must be novel and involve an inventive step at the time of filing

3.5 Inventive step

An invention must involve an inventive step at the time of filing.

For an invention to have an inventive step, it must not be obvious to a skilled person having regard to the state of the art. In other words, to be patentable, an invention must not be obvious to someone who is skilled in the particular technology of the invention in the light of everything that was publicly known before the date on which the patent application was filed.

3.6 Industrial applicability

This criterion is usually used to exclude 'impossible' inventions such as perpetual motion machines.

The term 'industry' includes agriculture.

3.7 Exclusions Patent law specifically excludes the following from being patentable:

a discovery, scientific theory or mathematical method

a literary, dramatic, musical or artistic work or any other aesthetic creation

a scheme, rule or method for performing a mental act, playing a game or doing business, or a program for a computer

the presentation of information — copyright protection will apply

any variety of animal or plant or any essentially biological process for the production of animals or plants, not being a micro biological process or the product of such a process

methods of treatment of the human or animal body by surgery or therapy and diagnostic methods practiced on the human or animal body — products, substances or compositions for use in any such methods are patentable

inventions where the commercial exploitation of which would be contrary to public policy or morality — e.g. a letter-bomb, method for refining cocaine.

3.8 Computer implemented inventions

3.8.1 **Examples

Take, for example, the following examples of patents granted for software inventions. Borderline between what is and is not allowable. There are many granted patents for inventions that include software components where problems are not even encountered.

Data Processing System (GB 1274768): This patent was granted under the previous version of the UK Patents Act and in fact covered spreadsheets. It was dressed up to look like hardware — a dodge that patent examiners are now very aware of and does not work. It is unlikely that such a patent would have been granted under the current laws.

3.8.2 New Directive

Patent applications are more likely to be rejected for lacking novelty or inventive step than because they are directed to excluded subject matter.

For example, EP0390041 — directed to a system in which a cursor could be moved diagonally using a single keystroke — was rejected for lacking inventive step

Steps in obtaining a patent

Applicants are strongly advised to obtain professional advice since patent procedure is not simple and mistakes can result in not getting the best protection for an invention. Many applicants who do not employ professional advice find that their granted rights are not adequate for their needs or that it is too easy for a competitor to design around them.

A patent application must include:

a technical description — called the specification — of the invention that is clear and complete enough for the invention to be reproduced by a person skilled in the technology of the invention. The description does not limit the scope of protection and is merely illustrative and

one or more claims that define, in words, the matter for which protection is sought. The claims are what limit the scope of protection and determine whether someone infringes or not. The claims are also what are evaluated for novelty and inventive step. If claims are too broad, they will not be novel or inventive — if they are too narrow, a patent would be granted for something that is easily designed around and therefore has limited value.

Then a search is undertaken: Based on the claims filed and identifies any prior art published prior to the date of filing the patent application that the Patent Office considers falls within the scope of the claims. At approximately 18 months from filing the application, it is published by the Patent Office (copies are available at <http://ie.espacenet.com>) along with the results of the search. This is the first time the contents of the patent application are available to the public. From this point onwards, details of the prosecution of a patent application are publicly available.

The applicant has six months from publication to request examination. During examination, a Patent Office official examines whether or not the application meets all the requirements of the law for example, is it new? Is it inventive? Is there sufficient disclosure? The applicant is advised of any objections and is given the opportunity to amend the application to address them. At the end of this process and, assuming all has gone well, a patent is granted

Paris Convention and priority rights

The Paris Convention was drawn up to make the absolute novelty requirements that these countries apply compatible with the possibility of filing for patent protection in multiple territories.

Priority date

The Paris Convention provides priority rights to an applicant that enable him or her to file subsequent patent applications within 12 months of his or her first patent application for that invention and yet benefit from the filing date of the first application. In this way, all applications for that invention benefit from the first filing date for novelty and inventive step purposes. Disclosures made in the first 12 months can be discounted and it is even possible to have the first application searched within the 12 months to determine whether expenditure on other applications is worthwhile.

3.11 Patent systems

Collective patent systems that can be used for filing patent applications covering more than one country.

Keep prosecution central and in some cases keep costs down.

European Patent Convention(EPC):

Do not ultimately result in a collective patent. A patent application can be filed and prosecuted at the European Patent Office covering most European countries — and some others. However, upon grant, the European Patent breaks down into a bundle of national patents, just as if a patent application had been filed and prosecuted in each country.

3.12 Third-party interaction

Public may observe aspects of the prosecution of a patent application after publication at 18 months from the priority date, however, they are not normally able to take part in the prosecution proceedings.

Before grant of a patent application in Ireland, it is possible for the public to submit third-party observations on the novelty, inventive step or other aspects of a patent application.

These will be taken into account by the Patent Office examiner when deciding whether or not to grant the application.

After grant, it is possible to request revocation of a patent at the Patent Office or via the courts.

Revocation is often requested during infringement proceedings and grounds for revocation are discussed in the section dealing with infringement.

Some patent offices, including the EPO and USPTO, have a post-grant opposition procedure in which interested parties can oppose the grant of a patent without having to resort to the costs involved in going to court.

3.13 Petty patents

Similar to the patent system except that there are typically lower costs, a lower duration for protection and limited or no examination — typically validity is assessed upon attempted enforcement.

3.14 US patent differences

Although the US patent system shares a number of concepts with the Irish system including novelty and inventive step, there are also significant differences. It is worth noting that there are slight differences in terminology too. In the USA, patents are called 'Utility Patents' and registered designs are called 'Design Patents'

3.14.1 Entitlement to a patent

Entitlement is determined on a first-to-invent basis rather than first to file.

In the US it is possible to 'swear back' and establish an earlier filing date to overcome prior art or actually take over another person's application or patent through interference proceedings.

Outside the US, as long as the applicant is entitled to grant of a patent, the first to file for a patent is awarded grant.

3.14.2 One-year grace period

3.14.3 Excluded subject matter

3.14.4 US national security provisions

4 Copyright

Automatically protects original works.

Extends over a wide range of artistic & business fields: books and other literary works, plays, paintings, music, sculptures, broadcasts and photography etc.

Does not protect an idea — it simply protects the expression of the idea is expressed

Where the text of a short story, say, is protected by copyright, it is not an infringement to write a story with the same 'twist' provided different words are used.

Legislation: <http://www.irishstatutebook.ie/2000/en/act/pub/0028/index.html>

4.1 Background

Dates back to Ancient Greece and Rome, though, limited number of people able to read and write.

Brehon law also recognised copyright "to every cow it's calf, to every book it's copy"

4.2 Works protected

Original literary, dramatic, musical and artistic works, published editions of works, sound recordings, films and broadcasts.

4.3 Requirements

Registration not required,

should keep carefully signed and dated evidence of original work.

4.4 exclusions

No copyright in:

name,

slogan

or phrase/jingle - e.g. "I'm luvin it" - (may be eligible for trade mark)

4.5 Protection provided

4.6 Software - extra rights

4.7 Non-literal copying:

4.8 Moral rights

Include:

the right to be identified as the author or director of the work, for example when copies are issued to the public

the right to object to derogatory treatment of the work and

the right not to have a work falsely attributed to them.

Moral rights are concerned with protecting the personality and reputation of authors. The right to be identified must be asserted, i.e. the author or director must indicate their wish to exercise the right by giving notice to this effect.

The right to be identified and the right to object to derogatory treatment can be waived by the author or director.

Moral rights do not apply:

in computer programs

where ownership of a work was originally vested in an author's employer

where material is used in newspapers or magazines and

in reference works such as encyclopedias or dictionaries.

4.9 Duration/ Shelf-life Protection

5 Database right

A database may be protected by two copyright-based IP right:

copyright

database right (Sui Generis)

5.1 Copyright

For copyright protection: the database must have originality in the selection or arrangement of the contents.

5.2 Sui Generis

A special additional right - to protect databases, particularly where they lack originality

The database must be the result of substantial investment.

Rights:

control extraction

re-utilization of the contents

Infringement: extraction or reutilization of a substantial part.

5.2.1 Caution

Ordinarily, databases are themselves a collection of copyright works

5.3 British Horseracing Board (BHB) v William Hill

6 Trade marks

Trade marks protect the way in which goods and services are identified.

Widely recognized as very valuable company assets.

E.g. worldwide recognition achieved by such marks as Guinness, Nike, Kodak and Coca-Cola.

6.1 Background

The marking of goods to identify their crafter can be traced back to ancient times.

C19th - trade mark registration began - First mark? A Former Taoiseach's tippie

Trade mark can be registered or unregistered.

6.1.1 Passing off

A disadvantage of unregistered use is that it is much more difficult to prevent competitors from appropriating the goodwill in the mark.

Must resort to the common law and to a legal action known as 'passing-off'. Protects the reputation associated with products and services on the market.

6.2 Registered trade marks

A trade mark or service mark can be registered by filing an application at the Irish Patent Office.

Applies to one or more classes of goods or services. Class list:

<http://www.wipo.int/classifications/nivilo/nice/index.htm#>

Then has exclusive right to the use of mark in the territory in which the mark is registered.

6.3 Monopoly provided

Exclusive rights to use the trade mark for the goods or services for which it is registered.

A major part of the value attributed to trade marks is due to their association with goodwill for a brand.

Help customers and traders to recognize a business and identify it with the quality of product or service.

6.4 What can be a trade mark?

Almost anything! are made up words, shapes, logos or combinations

6.5 What cannot be a trade mark?

Should not be misleading nor should it be descriptive of the goods or services covered

Surnames and geographical names can be difficult to register.

An official check is made to ensure that a proposed mark is not confusingly similar to an existing registration in respect of similar goods or services.

6.6 Trade mark systems

In addition to national trade mark registration systems, there are various collective systems through which trade marks can be registered.

Unlike with patents, the European trade mark remains a single right that covers the whole of the EU and only one renewal fee is payable

7 Domain names

Strictly not an intellectual property right.

Simply an internet address that is leased from a generic domain register operator — such as .com, .org or .net — or a country-level domain register (.ie).

1 Cybersquatting.

Registering names of trade marks, famous people or businesses with which you have no connection.

7.2 .eu domain

Registries have specific dispute resolution policies at start-up, 'sunrise', phase.

".eu" domain,

7.3 Dispute resolution

Either thru court action or dispute resolution procedure

UDRP (Uniform Domain Name Dispute Resolution Policy) provided by ICANN

UDRP is limited to certain domain types ☐ only for abusive registrations (cybersquatting) where a trade mark is involved.

7.4 Cases

Prince v Prince:

A British computer consultancy company had registered www.prince.com in good faith and were using it.

US company Prince, who manufacture sports equipment had a US trade mark for, among other things, sports goods.

7.5 Distinction from TMs

Trade marks	Domain names
<ul style="list-style-type: none">• national protection• not necessarily unique as same mark<ul style="list-style-type: none">▪ different classes▪ different countries• registered for anything "represented graphically",<ul style="list-style-type: none">▪ shapes▪ Smells	<ul style="list-style-type: none">• global resource• Unique• only words & numbers• commercial intellectual property that are typically only registered for between 1 and 10 years• owner must defend against infringement.

8 Designs

A monopoly right for the appearance of the whole or part of a product, resulting particularly from the features of lines, contours, colours, shape, texture and materials of a product or its ornamentation.

Protection can also be obtained for the 'get-up' of a product, for graphic symbols — such as computer icons — and typographical typefaces.

8.1 Background

Laws protecting designs originated in the 18th century

8.2 Registered designs

Protect the appearance of a design.

8.3 Monopoly provided

Registration gives the owner a monopoly on their product design.

8.4 What designs can be registered?

a monopoly right for the appearance of the whole or part of a product

8.5 Registered design systems

European Union operates a European registered design system through which a European design registration can be obtained.

Unlike with patents, the European registered design remains a single right that covers the whole of the EU and only one renewal fee is payable

8.6 Unregistered design right

Unregistered designs are a version of copyright that protects any original aspect of the shape or configuration of the whole or a part of an article.

As with copyright, copying of the design or a substantial part of it must be proven for infringement.

Independent production of a similar design is not an infringement.

9 1st Owner of IP

Is usually its author or creator ☐ If employed and the creation of the IP is in the course of their employment then the first owner will be the employer.

If an employee's duties do not include anything that would be expected to result in the creation of IP — for example if the employee was a cleaner — any IP created would be owned by the employee.

In the case of directors, a greater duty to the company is expected and it is quite likely that the company will own IP created by its directors.

A contractor normally retains the copyright in any commissioned work unless their contract is explicit to the contrary.

10 Licensing & Assignment

Licences and assignments are merely contracts and can contain whatever provisions the parties are willing and able to include.

In every case, general provisions in law about what contractual terms are acceptable need to be considered carefully as well as the nature of the IP that is the subject of the contract.

Competition law and company law may be relevant.

Assignment:

is typically an outright transfer of rights by the holder of the rights (the assignor) to another party (the assignee).

Licence:

involves a continuing relationship between the rights holder (the licensor) and the organization wishing to exploit the rights (the licensee)

10.1 Assignments

Specific formal requirements for IP assignments:

Patent assignments must be in writing and require the signature of the assignor,

10.2 Licence

Gives the right to do something that would otherwise be an infringement of rights.

It is a permission to do something, which the law says is the exclusive right of the owner of the IPR, which is licensed.

Only the owner of the IPR can grant a licence — if there is more than one owner then all must agree

10.2.1 Reasons for grant

May be the easiest way to gain entry to a particular market. The licensee may be well established in a particular market with marketing and distribution resources, customer base and reputation needed to exploit the IP and product(s).

10.2.2 Negotiating a licence

Both parties should have a common understanding of everything that is involved.

Do not assume that one party's understanding of a particular technical or legal term is the same as that of the other party

10.2.3 S/W and Databases

Additional provisions may be included such as:

Can the software be transferred to another machine or is it tied to a single machine?

What rights does the licensee have in respect of data migration?

Do they have sufficient rights to obtain information on database, program or data structure and format?

10.2.4 Open source

A variety of OS licences exist.

The GNU General Public License (GPL) most popular.

0.2.5 Shrink-wrap

User acceptance of terms by opening the shrink-wrap/other packaging or by use of the software

Terms usually include:

restrictions of s/w use

governing jurisdiction

disclaim implied warranties

and capped monetary damages. Courts have declared such licences valid

10.2.6 Click-wrap and browse-wrap

10.2.7 Freeware and shareware

Freeware:

Though free, it is still copyrighted and will include some form of licence agreement in which its modification and usage are limited or prohibited.

Shareware:

Terms typically stipulate that a licence must be purchased for commercial use or use beyond a set trial period.

11 Infringement

Restrictions depend on the IP right

Much available material will be protected by multiple IP rights.

11.1 Exclusions

Restricted use that may not require the permission.

doing something for private or experimental purposes relating to the subject matter of an invention may not infringe.

11.2 Compulsory licence

Generally granted in the situation where the rights holder fails to 'work' the invention.

E.g.: if a company obtains rights to an invention and then fails to work the invention - i.e. sell the patented article, use the patented method, etc. - and refuses to license the patent rights to another company to work the invention, then a compulsory licence may be applied for through the courts. The court will also set reasonable licence terms where agreement cannot be reached

12 Internet

12.1 Menashe case

The use of the internet to position servers offshore does not always avoid infringement.

12.2 Copyright

13 Enforcement

Typically slow, expensive and complex.

Can end up on appeal in High Court

Requiring team including a barister, solicitor or patent attorney.

13.1 Copyright

13.2 Patent

13.3 Registered trade mark

13.4 Registered design

13.5 Remedies

13.5.1 Injunctions

An interlocutory or interim injunction is granted to stop the defendant performing certain acts before the case reaches full trial to stop large and irrecoverable damage.

13.5.2 Damages and account of profits

Damages represent the monetary value of the damage incurred.

13.5.3 Costs

Legal costs incurred in bringing the action.

Court will grant the winning party its costs, which would have to be paid by the losing party.

13.5.4 3rd party assistance

For cases involving pirated or counterfeit goods

14 Counter Enforcement

14.1 Unjustified threats

For false infringement claims of patents, trade marks and registered designs,

14.2 Avoiding a finding of infringement

If accused of infringement, you should check the following.

Has the patent/trade mark/registered design been granted?

14.3 Request for revocation

Revocation of registered rights can be requested at any time