

INTELLECTUAL PROPERTY TRAINING

Adv. Yves SANGANO

Tel: 0788679086, sanysay@gmail.com

WHAT IS INTELLECTUAL PROPERTY?

- **Intellectual Property (IP)** refers to “creations of the mind: inventions, literary and artistic works, and symbols, names, images, and designs.
- **Intellectual Property Rights (IPR)** are legal titles to which the IP Owner applies to get the right of preventing others from using and exploring said intellectual property.
- The **rights** concerned are related and not limited to: Literary artistic and scientific works; performances of performing artists, phonograms, and broadcasts; inventions in all fields of human endeavor; scientific discoveries; industrial designs; trademarks, service marks, and commercial names and designations; protection against unfair competition; and "all other rights resulting from intellectual activity in the industrial, scientific, literary or artistic fields.
- **Outstanding Feature of the Property:** The owner of the property is free to use it as she/he wishes, provided the use is not against the law, and to exclude others from so using that owned item of property.

THE ROLE OF IP SYSTEM

- Provide incentives to owners by offering them recognition for their creativity and the possibility of obtaining financial rewards.
- Promote dynamic competition by encouraging investment in the development of new or improved products or processes, and by encouraging research and development.
- Encourage the dissemination of information about new inventions that may be of benefit to society, because the information disclosed in patents is published (EPO, Teaching Kit, IP Advanced I, Google Patent).



LEGAL & INSTITUTIONAL FRAMEWORK

- National IP system
- Regional IP system
- International IP system

National System

Old system

- copyright law of 1948 and 1983,
- Industrial Property by the Law of 25 February 1963;

Current system

- National IP Policy
- IP Law N° 31/2009 of 26/10/2009 as modified and complemented to date
- Law No. 19/2010 of 09/06/2010 on the Organization of the Craft Sector
- Laws Establishing institutions: RDB, RSB, RRA, NIRDA, etc...
- Ministerial Orders on: Tariffs; opposition period; compulsory license and power of attorney, Appeal Commission

Regional system

- Lusaka Agreement on the Creation of the African Regional Intellectual Property Organization (ARIPO);
- The Harare protocol on Patents and Industrial Designs;
- Etc....

International system

- The WIPO Convention which is the multilateral treaty that established the World Intellectual Property Organization (WIPO);
- The Paris Convention for the Protection of Industrial Property;
- The Berne Convention dealing with the protection of works and the rights of their authors;
- TRIPS: Members of the WTO's Trade Related Intellectual Property Aspects Agreement since May 1996;
- Patent Cooperation Treaty (PCT) which is an agreement for international cooperation in the filing, searching and examination of patent applications;
- Hague Agreement governs the international registration of industrial designs;
- Madrid Agreement Concerning the International Registration of Marks (1891) as well as the Protocol Relating to the Madrid Agreement (1989).
- Arusha Protocol on the Protection of Plants Varieties;
- Universal Copyright Convention; Etc.

IP Institutional framework in Rwanda

POLICY AND REGULATORY

- Ministry of Trade and Industry/ Ministry of ICT and Innovation
 - Formulating IP policy and regulatory framework for industrial property
- Ministry of youth & Culture
 - Formulating copyright policy issues.

ADMINISTRATION

- Rwanda Development Board
 - IP administration (receiving granting or refusing applications, processing renewals, addressing opposition applications, maintaining IP register, managing fee collection)
 - IP promotion (training and public awareness)
 - Settling IP disputes-mediation.
- Collective Management Society (CMO)
- Appeal Committee

ENFORCEMENT

- Rwanda National Police,
- RIB
- Rwanda Revenue Authority,
- Rwanda Standards Board,
- Commercial Courts.

RESEARCH AND DEVELOPMENT

- NIRDA
- RAB
- Universities & Technical vocation Training Institutions.

MAIN BRANCHES OF THE IP

A) Industrial property

- which applies to the exclusive right to use inventions, utility models, marks, industrial designs or models,, GIs, layout designs of integrated circuits and
- The right to request the elimination of acts of unfair competition;

B) Copyrights and related rights

- which apply to literary, artistic and scientific works, to performances of performing artists as well as phonograms and wireless broadcasting .

INDUSTRIAL PROPERTY

What is industrial property?

- Patent of inventions (BREVET D'INVENTION);
- Utility models (MODELE D'UTILITE);
- Protection of industrial designs (DESSINS OU MODELES INDUSTRIELS);
- Protection of trademarks (LES MARQUES);
- Protection of geographical indications (INDICATIONS GEOGRAPHIQUES);
- Protection of layout designs (SCHEMAS DE CONFIGURATION DE CIRCUITS INTEGRES)
- Protection of trade names (business names) (LES NONS COMMERCIALES);
- Trade secrets;
- Elimination of Unfair competition.

Patent protection (art 14- 55)

- A patent is an exclusive right to exploit an invention, i.e. a technical solution to a problem.
- The right to a patent shall belong to the inventor except in case of employment contract.
- A patent can be valid for a maximum of 20 years.
- In order to maintain the patent or patent application in force, an annual fee shall be paid by the patent owner or the depositor in advance.
- Description of the invention in a manner sufficiently clear, complete and intelligible.
- Any interested person may request the competent court to invalidate a patent.
- A Patent can be assigned or the inventor can grant a contractual license.

Conditions for patentability

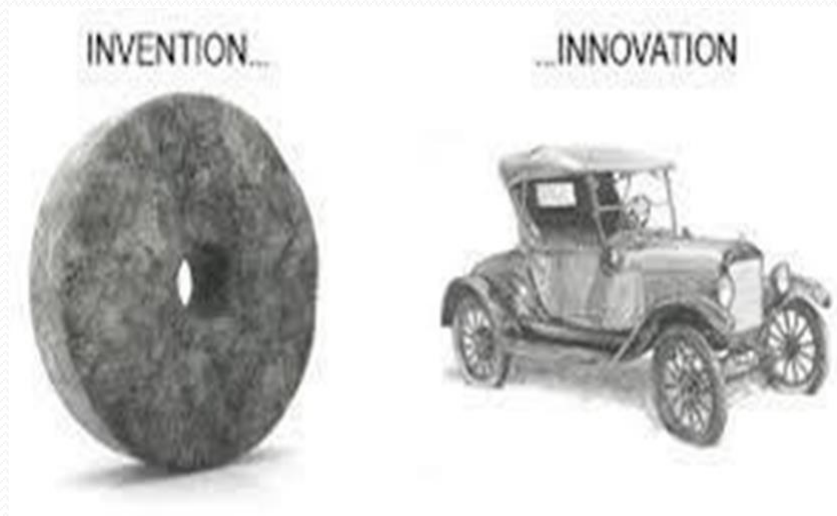
James Puckle's 1718 early auto cannon was one of the first inventions required to provide a specification for a patent

The Patent must be:

- new
- inventive
- industrially applicable



Innovation vs Invention



<https://www.novaidfct.pt/knowledge-valorization/invention/>

- **Invention** belongs to the realm of research and discovery, basic science and the development of new ideas and knowledge.
- **Innovation** is the new and successful application of those ideas to address issues.
- In other words, Innovation only exists when Inventions are **Exploited** generating social and economic **Impact**.
- The concept of Intellectual Property has to be understood in the context of Innovation

Process of patent application

- Filing the application with required documents; and get the filing number;
- Process with Formal examination and Correction of errors within 7 days if exist;
- Substantive examination,
- Granting of a patent right,
- Publication;
- Amendment: assignment; invalidation; license contract; compulsory license;

Exclusion for patentability (Art. 18)

- Scientific theories and mathematical methods;
- schemes, rules or methods for doing business,
- methods for treatment of the human or animal body by surgery or therapy,
- plants and animals, plant varieties,
- pharmaceutical products, for the purposes of international conventions to which Rwanda is party.
- inventions whose commercial use is contrary to public order and to morality.

Patent Drafting

- **Sufficiency of disclosure:** (1) complete and accurate public description of the invention, (2) enable others to use that information to invent further, (3) pushing technology forward for the benefit of the society
- **Quid Pro quo:** The patent is payment for the invention and the knowledge that comes with it.
- **Clarity of Disclosure** (Clear, precise, honest and open).
- **Skill based** (Techno-legal Expertise).
- **Careful drafting** (Not allowed to add forgotten/missed out details later/ No protection for not described properly).

Patent search

- Discovery or learn, Planning, development, enforcement;
- Determine the Purpose of Search (What kind of search to perform, what is the purpose of the search, who will get the results, ...);
- Categories of patent searches (Landscape search, patentability or Novelty Search, Prior Art Search, validity search, Clearance search, Infringement Search, etc.....);
- Determine which databases need to be searched;
- Develop a Search Strategy;
- Search, Evaluate, Modify and Repeat;
- Analyze & Summarize Results.

Search Database

- **Patent Databases – International**

- WIPO Patent Scope: <http://patentscope.wipo.int>
- www.google.com/patents

- **Patent Database – Europe**

- EPO: <http://worldwide.espacenet.com/advancedSearch?locale=en> EP

- **Patent Databases – US**

- USPTO <http://patft.uspto.gov/>
- Free Patents On-Line <http://www.freepatentsonline.com/>
- Patent Lens <http://www.patentlens.net> <http://www.lens.org>
- Thomson Innovation <http://www.thomsoninnovation.com>
- Pat Base <http://www.patbase.com>

- **Directories of International Offices**

- <http://members.pcug.org.au/~arhen/>
- <http://www.wipo.int/directory/en/urls.jsp>

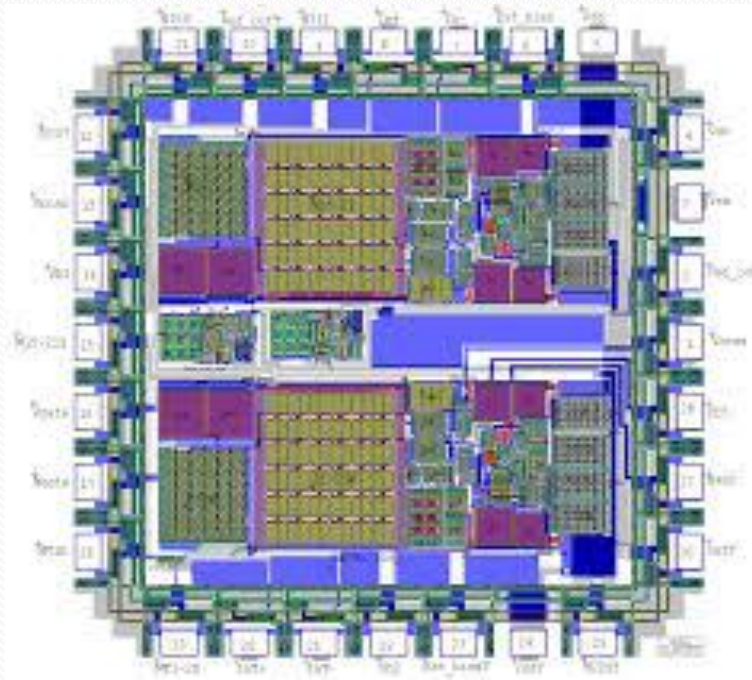
Utility Model (art. 56- 88)

- **Designed to allow:**
 - an inventor to protect small improvements to devices quickly.
 - Protection of the inventions relating to minor technical progress
- **Conditions:**
 - New invention
 - Industrially applicable innovation.
- The right to utility model certificate is a personal property and may be assigned or transferred by means of succession.
- The protection is for 10 years no- renewable and annual renewal fees are paid from the anniversary of 5 years of filling.
- Control of anti-competitive practices in contractual licenses before granting the protection.
- Others conditions and exclusions from protection are the same with the Patent.

Industrial design (art. 89 – 107)

- An industrial design constitutes the ornamental or aesthetic aspect of an article rather than its technical features.
- To be protected a design has to be new and should have all features which allow to identify the innovation.
- Industrial designs and models contrary to public order or morality may not be registered (exclusion from protection).
- The right to an industrial design or model shall belong to the inventor.
- The Industrial Design may be assigned or transferred by means of succession. It may be subject to a security.
- The protection is for 15 years and renewed for two periods of five (5) years each.

Layout – Designs of Integrated circuits (Art. 108- 132



- Electronic device
- Incorporated within a single integrated platform of semiconductor material,
- Configured to perform a complex electronic function.
- Generally classified into microprocessor and memories.

Protection Process of layout-design of an integrated circuit

- **Conditions:**
 - Original
 - not common place
- **Requirements:**
 - Not been used for commercial purpose before or,
 - Being subject of commercial purpose for 2 years max.
- The right to protection belong to the creator.
- The right may be assigned or transmitted by means of succession.
- Protection is for 10 years from the date it takes effect.
- Compulsory license - ex officio compulsory license.

PROTECTION OF DISTINCTIVE SIGNS (Art. 133 – 176)



Types:

- Trade Marks
- Trade Names
- Collective Marks
- Certification Marks
- Geographical Indication

Registration of Trademarks

- Requirements: It is distinctive; not imitative; not confusing and not descriptive;
- Cancellation of Mark not validly registered in case of bad faith;
- Quid in case the mark has acquired secondary meaning or distinctiveness through continued use?
- The exclusive right to a mark by registration and being entitled for undertaking Civil proceedings against rights infringement.
- Any interested person may request the competent court to invalidate the registration of a mark.
- Protection is 10 years renewable from the filing date.
- Removal of trade mark on grounds of non-use after an uninterrupted period of three years (3) or more.
- Non payment of renewable fees, the mark is considered as withdrawn.
- The mark may be assigned or licensed.

Opposition to Registration

- Filing a Trademark Registration.
- Publication of a trademark registration
- Opposition is made within sixty (60) days from the date of publication.
- Form of opposition provide for by the MO No 25 of 17/03/2016.
- 14 days from the reception - The applicant for a trademark registration to provide written response.

Exclusion from Mark Registration

- Contrary to public order or to morality,
- Reproduces, imitates or contains among its features:
 - a coat of arms or armorial bearing, flags or other emblems.
 - Name or abbreviation or initials of the name of official sign.
 - hallmark and guarantee of a State or intergovernmental organization set up by an international convention.
- Exception: authorization by the competent authority of such State or organization.

Collective Marks

- **General Definition:** A collective mark is a form of trademark or service mark owned by a collective, whose members use the collective mark to identify their goods and services and to distinguish their goods and services from those of non-members, and to indicate membership in the group.
- Can also be used by the collective itself to promote the interests of the members.
- The “**collective**” itself typically does not sell goods under the mark, but instead advertises or promotes the goods of its members under the mark.

Certification Marks

- **General Definition:** A certification mark is a form of trademark used to identify goods and/or services that meet certain standards or specifications.
- The owner of a certification mark exercises control over the use of the mark and ensures the standards have been met.



Protection of Collective – certification Marks

- **Collective Marks**

- Registration subject to the copy of the regulations determining the conditions of use.
- Invalidity in case one person use it or is used contravention of the regulations
- It can be assigned but not be subject to license contract.

- **Certification marks**

- Registration subject to the sign designating the mark and rules governing it.
- Others provisions for a mark are applied to certification marks
- Invalidity in case one person use it or is used contravention of the rules

Geographic Indication

- A **geographical indication (GI)**: is a name or sign used on certain products which corresponds to a specific geographical location or origin (e.g. a town, region, or country)
- **Types:**
 - Protected designations of origin (PDO): *Characteristics resulting solely from the terrain and abilities of producers in the region of production with which they are associated.*
 - Protected geographic indications (PGI): *Characteristic or reputation associating them with a given area, and at least one stage in the production process must be carried out in that area, while the raw materials used in production may come from another region.*
- **Examples:** “Champagne’, ‘Havana’, ‘Tequila’, ‘Scotch Whisky’, ‘Bordeaux’, ‘Bourgogne’, ‘Irish Whisky’, ‘Porto’, ‘Cognac’.

Protection of GI

- **International General Standards of Protection:**
 - Paris Convention: (Article 10 and 10ter) False indications of the source of goods
 - Madrid Agreement: Repression of False or deceptive indication of source of goods.
- **International System for GI Registration:**
 - Lisbon Agreement for the Protection of Appellations of Origin and their International Registration.
 - Madrid Agreement Concerning the International Registration of Marks.
 - Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (which also provides for the international registration of certification marks).
- GI is protected under Rwandan IP Law from art. 165 – 176.

Geographical indications and trademarks

- GIs are closely related to trademarks; both indicate product origin
- GIs and trademarks differ in two ways:
 - A trademark belongs to a particular company; it distinguishes that company's products. GIs are shared by all producers in the region identified by the GI.
 - GIs attach to a location; trademarks don't.

Protection against unfair competition (Art 177- 185)

- Any act or Practice that is, in the course of industrial or commercial activities, unlawful.
- Any person harmed by an act of unfair competition can start Civil proceedings in the competent court.
- **Conditions:**
 - Being in business
 - Damages his/credibility ,
 - Or takes away his/her customers
 - Or harms his/her capacity for competition

Acts of unfair competition

- Causing confusion in another's enterprise or his/her activities
- Discrediting another person's enterprise or his/her activities (Any false or fallacious allegation)
- Misleading the public.
- Damaging another's goodwill or reputation.
- Unauthorized use of technical know-how.
- Act of unfair competition in respect of secret information

IP Agents (art. 188)

- Mandatory for the Receivability of foreign applications.
- Should carry out its business in Rwanda.
- Prior authorization by the ORG.
- Power of attorney justifying his/her accreditation

Appeal Committee

- M.O No 07/10/MINICOM of 25/08/2010
- Rejection of IP registration
- Composed by experts from MINICOM, MINISPOC, MINIJUST, ORG, RSB, PSF, RRA.
- Decision has to be taken within 30 days from the reception of the appeal.
- Duration may be extended in case particular knowledge and research have be conducted abroad.
- The committee can seek the advise from experts.
- Appeal committee report to ORG but chaired by MINICOM

Appeal channel (art. 192 -194)

- Be heard before the ORG
- Administrative appeal before the Appeal Commission (within 30 days).
- Court Appeal within 3 months from the date the decision was taken.
- Decision of the Court is subject to appeal in accordance with the Rwandan Laws.



COPYRIGHT

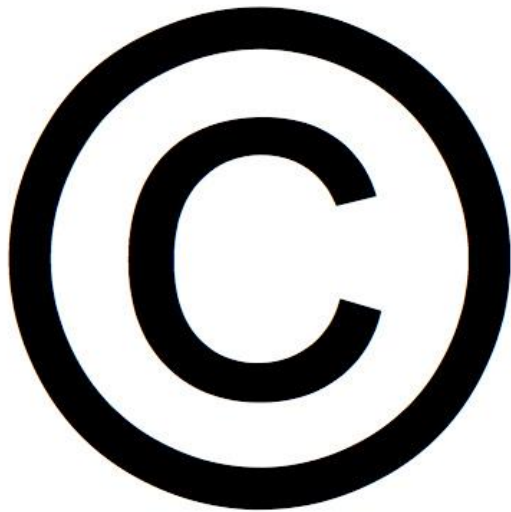


Keys points for Copyright

- ▶ What is copyright and related rights ?
- ▶ What are the procedures of copyright registration?
- ▶ What are the procedures of copyright enforcement?

What is a Copyright?

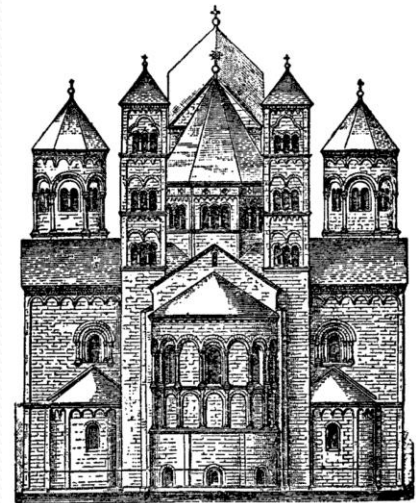
A copyright is a form of protection given to authors or creators of original works.



Concept of Copyright

- Copyright creates a system whereby the copyright owner is granted the exclusive right to use or exploit his work in order to:
 - Firstly to compensate and reward him for his effort and creativity and
 - Secondly, to act as an incentive for further creativity.
- It protects the expression of the ideas.

What does a copyright protect (art 195)?



The Category of works

- **Original works:**
 - **Literature Works** (Books, speeches, etc. ...)
 - **Artistic** (Films, musical, choreographic, etc.)
 - **Scientific Works** (Maps, topography, architecture, etc.)
 - **National folklore** (story, legend, myth, proverb, narrative, and performances dances, etc.)
- **Derivative works:**
 - Translation, adaptation, arrangement or modifications of works and the works of expression of folklore;
- **Collection of works:**
 - Collection of works, simple facts or mere data like encyclopedia, anthologies, collection of data



Works not protected Article 198

- any official texts of a legislative, administrative or judiciary nature including translations
- Published daily news or news communicated to the public;
- Any idea, procedure, system, methods of operation, concepts, principles, discovery or mere data

When is your work protected?

- Protection is not subject to any prior administrative formalities.
- Protection by registration is an option.
- A work shall be deemed to be created, irrespective of its disclosure
- A Work shall be protected by the sole fact of their creation, even if it is not fully accomplished and during the time it is designed by its author.
- Protection shall be provided to works, irrespective of their mode or form of expression, as well as of their content, quality and purpose.

Rights Granted

- **Moral Rights**

- Right to claim the authorship,
- Right to object to any distortion, mutilation or other modification,
- Right to not have his/her name known or to use a pseudonym..

- **Economic Rights**

Exclusive right to:

- Reproduction, translation of work;
- Adaptation, arrangement or other transformation of the work;
- Public performance of the work;
- Communication to the Public of the work;
- Sell, distribution and rental the work

- **Economic rights of work derivative from folklore:**

- Payment of royalties
- 25% of the paid amount is reserved for promotion of creative works

Limitations to economic rights

The exercise of the exclusive rights granted is subject to specific exceptions and limitations:

- Private use
- Temporary reproduction
- Reproduction for purposes of quotation
- Reproduction for teaching
- Reproduction and adoption for visually impaired persons
- Free public performance
- Reproduction for Libraries and Archives
- Reproduction for judicial and administrative purposes
- Free use of works information purposes
- Free use of pictures permanently located in a public place
- Free reproduction and adoption of computer programs

Term of protection

- **Moral rights:**
 - no limitation of time, not subject to extinction, inalienability and transmissible to third persons by testamentary disposition;
- **Economic rights:**
 - protected during the life of the author and 50 years after his death;
 - In the case of a work of joint authorship: protected during the life of the last surviving author and for 50 years after his/ her death.
 - anonymous work, a pseudonymous work or collective work : 50 years from the date of completion of work, publication or communicate to public,
 - Works of applied art, the term is 25 years from the date the work was made.

Public domain

- Works will fall into public domain where:
 - The term of copyright has expired
 - the works come from a country that is not party to the international laws to which Rwanda is party to or do not protect copyright
 - The owner has waived the copyright

Assignment and Licensing

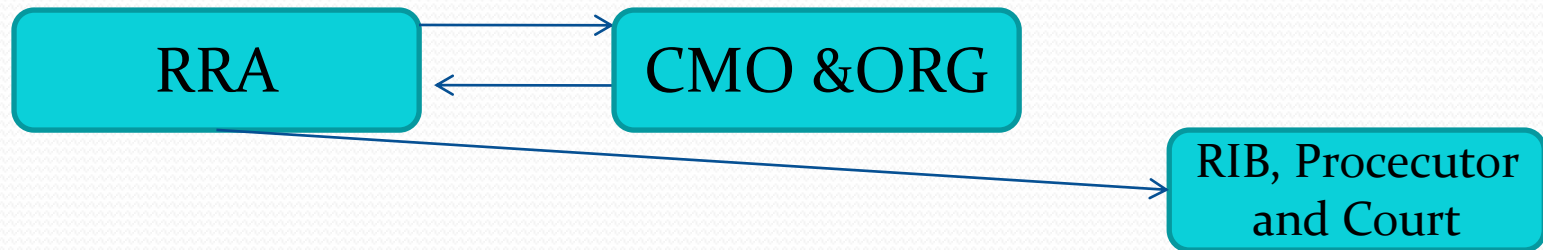
- Copyright like any other moveable property can be licensed, assigned or transferred by testamentary disposition or operation by law
- This only applies to the economic rights which can be transferred in part or in whole
- Moral rights cannot be assigned or transferred

Infringement

- IP infringement occurs where the exclusive rights are exploited by a third party without the consent of the author.
- Acts of infringement are clearly set out in the law and include unauthorised reproduction, distribution, communication to the public, adaptation and translation, importation etc.
- The rights holder has legal redress against the infringer through civil, or criminal or administrative action.

The mechanism of copyright enforcement

1. Piracy product from outside



2. Piracy product in the country



Collective Management Of Copyright

- Management of rights collectively within the music, book publishing and visual arts sectors
- Require licences or assignments for the rights holders
- Monitoring Public Performance, broadcasting and making available of the works
- Royalties are collected and distributed to the rights holders

Types of collecting societies

- **Public or semi-public institutions** enjoying a legal or *de facto* monopoly and pursuing cultural and solidarity goals beyond the main purpose of copyright management
- **Fully private entities** acting in a (supposedly) free market for licensing services with the exclusive objective to maximize their members' revenues and without pursuing any social or solidarity goals

Challenges of Collective Management Societies

- Lack of Awareness on existence.
- Lack of Financial resources.
- Increase of Competition between the Collective Management Society and other Organization of authors.
- Collective Management Society need to improve their services in order to obtain clients
- Limited capacity to collect royalties
- Limited means to enforce the rights of Authors.



Intellectual Property Management

INTELLECTUAL PROPERTY FOR BUSINESS

- If you found a new way to make something or discovered a new product you'd like to take to market, you would want to first patent the idea so no one can take the idea and claim it as their own.
- Word, phrase, symbol, or design, or a combination thereof, that identifies and distinguishes the source of the goods of one party from those of others. It is important to protect these business assets, as trademarks give business owners the tools to prevent competitors from taking advantage of the goodwill that one's brand has accumulated over the years.
- Sales methods, consumer information, ad campaigns and strategies, list of vendors, list of clients, and production processes, etc... (corporate confidential information) which give any business a competitive advantage can be considered a trade secret.
- If you wrote something, or created a piece of work that you don't want people to reuse without your permission, you have the right to copyright that work

IP VALUE TO ORGANIZATION

- **Defensive Value:** Intellectual property provides a shield to protect a company from litigation.
- **Cost Control:** The cost control element of intellectual property management has to do with the reduction and minimization of costs to obtain and maintain intellectual property.
- **Profit Center:** The profit center element is focused on the proactive strategies of creating additional revenue for the organization.
- **IP Integration:** Intellectual property becomes increasingly valuable when an organization uses it to serve the greater purposes of the organization rather than a single department.
- **Visionary IP Development and Management:** Obtaining intellectual property protection strategically as a result of trends in the relevant industry and Developing performance measurement and reporting systems.

IP COMMERCIALISATION

- **Different forms of IP exploitation/Utilization:**
 - **Use the IP or IPR itself:** The business can make the product, perform the process or offer the service itself through traditional means or through e commerce tools.
 - **Licence agreements** allow one party to exploit the IP rights of another party against the payment of a royalty. There are three main forms of licences, namely exclusive, non-exclusive and sole.
 - **Public/private collaboration agreements** outline the specific contributions of different parties who work toward a mutual goal (for example where a university and a private company are working on a joint R&D project).
 - **Assignment agreements** provide for the transfer of IP rights from the IP owner to a third party.
 - **Confidentiality agreements** facilitate transfer of confidential information in a protected manner so that the disclosing party's confidential information is protected from disclosure to third parties.
 - **Materials transfer agreements (MTAs)** or Sample confidentiality agreements protect samples (tangible property) from unauthorized distribution to third parties (for example where one party agrees to transfer biological material for use by the other party).
- **Preparing for commercialization transactions and activities:**
 - Ownership;
 - Due Diligence

DRAFTING A LICENCE AGREEMENT

- Whereas clause and background statement.
- Definitions
- License grant
- Sub-licensing
- Consideration, audit and reports.
- Confidentiality
- Commencement, termination and consequences of termination
- Limitation of liability, indemnification, warranties and disclaimers
- Mediation & Dispute resolution.
- Rights to publication of research results in case of R&D contracts

IP STRATEGY

- IP strategy is an integral part of an overall business strategy.
- An IP Strategy must address the management of IP internally as well as externally.
- Formulating the IP Strategy requires to respond to the following common questions:
 - What will be the focus of our IP resources and activities?
 - What roles will IP play for our business? (Legal roles ,Commercial roles)
 - What capabilities do we need? (For creating IP? For administering IP? For managing the commercial roles for our IP? For managing the legal roles for our IP?)
 - How will we approach managing our IP? (What will be our mix of commercial vs. defensive activity? What will be our “rules of the game”?)
 - What will be our sequencing and speed of IP activities? (Sequencing of initiatives, Speed of each)
 - How will we measure our success? (What are the elements of “success” for our IP strategy? What are some units of measurement for these elements?)

ELEMENTS OF IP STRATEGY

An Internal IP Strategy is comprised of:

- the IP Audit,
- the IP Policy and
- the IP Acquisition & Maintenance Strategies.

An External IP Strategy is comprised of:

- The Enforcement Strategy,
- The Competitive Intelligence Strategy and
- The Public-Policy Issues.

IP AUDIT

- IP audit is a systematic review of the IP owned, used or acquired by a business so as to assess and manage risk, remedy problems and implement best practices in IP asset management.
- IP audit involves undertaking a comprehensive review of a company's IP assets, related agreements, relevant policies and compliance procedures.
- An IP audit helps a business to make an inventory of its IP assets or update.
- An IP audit seeks to uncover unused or under-utilized assets, to identify any threats to a company's bottom line, and to enable business managers to devise informed business and IP strategies that help maintain and improve its competitive position in the relevant market(s).



Q& A



Thanks