

IMPERIAL COLLEGE: INTELLECTUAL PROPERTY RIGHTS A-Z OF PROTECTING YOUR INVENTIONS

BY

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A-Z OF PROTECTING YOUR INVENTIONS

- Overview of Intellectual Property Rights
- Protection of IPRs
- Importance of IPRs
- IPRs – copyright, trade marks, designs and patents
- Test for Patentability
- General Rule on Disclosure –patents, know-how and registered designs
- Confidentiality
- IPR Insurance

OVERVIEW OF IPRs

REGISTERED RIGHTS

- ❖ Patents - inventions
- ❖ Trade marks - badge of business, logos, names, smells, sound
- ❖ Registered designs - “look” of product for industrial designs

QUASI-REGISTERED RIGHTS

- ❖ Domain names

UNREGISTERED RIGHTS

- ❖ Know-how - trade secrets
- ❖ Copyright - literary, including digital work, research notes, software
- ❖ Design rights - product shape and configuration
- ❖ Brands - goodwill and reputation

WHY IPR PROTECTION?

Start-ups

Attract funding easier if :
IPR protection adequate;
Safeguarding your assets;
Brand maintenance and
reputation.

Investors

Companies must be seen to
be mitigating the risk of
failure !!!

Importance of IPRs: IPR from the Investor's Viewpoint

- **Barriers to entry**
- **Market share**
- **Increase in 'switching costs'**
- **Mitigating risk for the funds invested**
- **Adequate IP protection**

IPR: Copyright

→ Ownership

→ Originality

→ Copyright Infringement

IPR: Designs

→ Ownership

→ Is the design commonplace?

→ Is the design original?

→ Design Infringement

IPR: Trade Marks

- Clearance Searches
 - Conflicting Marks
(Trade Mark Infringement/Passing-off)
 - Registrability
 - Filing Strategy
 - Brand Reputation/Protection

Test for Patentability

What is a patentable invention? - An invention must satisfy each of the following conditions:

- ✦ it must be **novel**;
- ✦ it must involve an **inventive step**;
- ✦ it must be **capable of industrial application**; and
- ✦ it cannot fall within an **excluded category**, ie. discovery, literary work, mathematical model

For an invention to be novel

- ✦ the invention must **not** form part of the **“state of the art”** ie. all matters, including any product, process, information in any form which could be oral, written or by use or in any way whatsoever which was **“made available to the public”** anywhere in the world before the priority date

Inventive step

- ✦ must not be an obvious invention so that **a person skilled in the art** (eg. a skilled scientist) would have found it an obvious invention to make at the priority date

Capable of Industrial Application

- ✦ covers all industries

Disclosure

General Rule:

Patents - Invention disclosed before filing patent application – loss of patentability e.g. publication of an invention in a journal

Registered designs - Design disclosed before filing registered design application – loss of right to obtain a registered design e.g. showing the design to a third party without a NDA

Know-how - unauthorised disclosure can destroy know-how e.g. an employee passing on details

Disclosure: Patents

Researcher synthesises new drug (“invention”) in China and files a UK patent application

- One or two researchers know about this invention and are carrying out the work in private?
- The invention is published in an obscure journal in China?
- The invention is published on the Internet?
- The invention is exhibited at an international exhibition?
- The parties have entered into a confidentiality agreement before researcher discloses invention?
- Oral disclosure of the invention?
- Researcher has found a new use for existing drug?

Which of the disclosures lead to the invention losing patentability and becoming part of the prior art?

Disclosure: What type can destroy novelty?

Destruction of novelty means the invention is not patentable i.e. the invention is not novel. (*Note:* Not every disclosure is novelty destroying)

✦ disclosure at an international *conference* ?

- YES

✦ publication of a patent application in the UK? - YES

(If in USA “first to invent” - 12 months from filing date)

✦ disclosure under an obligation of confidence? - NO

Disclosure: What type can destroy novelty?

- The use or disclosure of invention made available to the public before priority date, the necessary information to allow the public to practice the invention? -Yes

Test for Patentability: Novelty

RECAP:

- ✦ To be patentable, an invention must be *novel*;
- ✦ Must not form part of the “prior art” - means any product, process, information located in whatever form (oral, written, in use) anywhere in the world which is “made available to the public”;
- ✦ “Made available to the public” - means published or capable of inspection in the UK or any member of the public is free to use without breaching confidence or the public is given enough information to perform the invention

Note: Disclosure of a patentable invention can destroy novelty.

Confidentiality

To be protected by the law of confidential information, the information must be:

- ✦ confidential in nature - i.e. it must have the necessary quality of confidence;
- ✦ disclosure must be made in circumstances imparting an obligation of confidence

Crucial to enter into a confidentiality agreement at the outset of negotiations:

- ✦ specify what information to be kept confidential;
- ✦ how long for?
- ✦ the limits on use and disclosure of confidential information

e.g. In an R&D collaboration agreement, state how the confidential information is going to be used by the parties

Confidentiality

Why is confidentiality important?

- ✦ protects material **not capable** of IP protection, e.g. patenting of business methods in the UK;
- ✦ protects an invention before filing a patent or a design application;
- ✦ protects confidential information disclosed during negotiations, e.g. secret processes or other know-how.

What types of information can be protected?

- ✦ know-how (commercial information); formulae; recipes; processes; improvements to products or processes, etc.

Confidentiality

Disclosure of confidential information

- What if information already in the public domain?
- What if information disclosed at a seminar?
- What if information disclosed by employee who has left the University?
- What if work commences before agreement signed?
- What if confidential information disclosed and the parties have signed confidentiality agreement?

Confidential information remains protected as long as information remains confidential

Confidentiality

Breach of confidence

- ✦ Receiving party discloses or uses confidential information for other purpose than agreed;
- ✦ Obtain an injunction (Interlocutory Injunction)
Note: there can be no delay in obtaining an interlocutory injunction

Remedies: damages, account of profit, delivery up or destruction

Specialist IPR Insurance

Specialist types of legal expenses insurance for safeguarding and defending against:

- Infringement of IPRs; or
- Actual or alleged breach of contract; or
- Defending a challenge to the validity of the insured's IPRs e.g. the validity of a patent.

Premiums vary widely - policy limit.

Some insurers may only insure companies with established businesses and may require an IP Audit to obtain an independent opinion on the validity and scope of the IPRs and the value of the market covered by IPRs.



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