

# UNDERSTANDING AND PROTECTING YOUR START-UP'S INTELLECTUAL PROPERTY ASSETS WHEN WORKING WITH THIRD PARTIES



## PATENT CRITERIA

### PROTECTS TECHNICAL INVENTIONS

- NOVELTY
- INVENTIVE STEP/NON-OBVIOUSNESS
- CAPABLE OF INDUSTRIAL APPLICATION

### ✓ PATENTABLE INVENTIONS

- New things (product)
- New process
- New uses
- New purposes for old things used the same way
- Selection Patent (for chemical groups)

### ✗ NOT PATENTABLE

- Immoral Inventions
- Plant/ animal varieties
- Methods for treatment of the human or animal body by surgery or therapy and diagnostic methods



### PROCESS OF PATENT REGISTRATION

File an application: <https://www.gov.uk/apply-for-a-patent>

Regular IP clinics: <http://www.cipa.org.uk/find-a-patent-attorney/>



**DURATION** = 20 years from date of application



### RIGHTS OF A PATENT OWNER

MAKE | USE | LICENSE | ASSIGN | EXCLUDE



### EXCEPTIONS = DEFENCES

- Private & non-commercial use
- Experimental use
- Compulsory Licensing & government use



## TRADE SECRETS CRITERIA

### ✓ USED TO PROTECT

- **Technical information:** manufacturing processes, software algorithms
- **Commercial information:** distribution methods, list of suppliers and clients
- **Recipes**

- **Commercially Valuable** because it is a secret
- Known only to a **Limited group** of persons
- Has been subject to **reasonable steps** to keep it secret



**PROTECT USING** • Contract

- Non-Disclosure Agreement (NDA)



Registration not required



## DESIGN RIGHTS CRITERIA

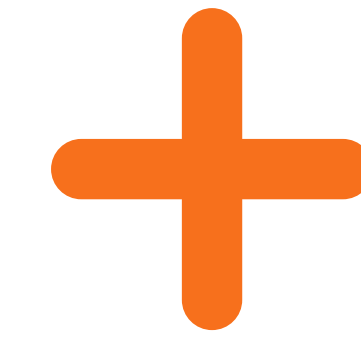
### THE CONCEPT OF EU DESIGN LAW

- MARKETING TOOL OF EVER-INCREASING IMPORTANCE
- SIGNIFICANT ASPECT OF MODERN CULTURE

### HOW TO REGISTER YOUR DESIGN

- Apply for registration **within 12 months** of the design being made available to the public.
- Initial duration of protection will be **5 years**, and it is **renewable**.
- **International registration:** file an application with **WIPO** directly or through any of the 67 contracting parties, to obtain protection in one or more than one jurisdiction

- NOVELTY
- INDIVIDUAL CHARACTER
- DISCLOSURE PROVISIO



- EXCLUDED SUBJECT MATTER
- Functionality
- Interoperability
- Morality & public policy exclusions

### Registered

25 years

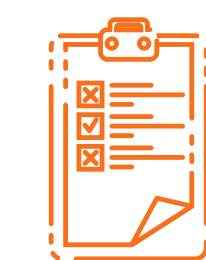
Exclusive protection



### Unregistered

3 years

Anti-copying Right



## TRADE MARK CRITERIA

### BENEFITS OF TM REGISTRATION

- Prevent third party from using your registered TM.
- Can sue third parties for TM infringement and claim damages.



### ✓ RIGHTS OF A TM OWNER

- Licence
- Assign
- Sue

- SIGN
- REPRESENTATION
- DISTINCTIVENESS

### Attributes of TM

- Non-descriptive
- Non-generic
- Unique

### ELEMENTS THAT CAN BE TM

WORDS | DESIGNS | LETTERS | COLOURS  
NUMERALS | SOUNDS | PACKAGING  
SHAPE OF GOODS



### PROCESS OF TM REGISTRATION

File an application on <https://www.gov.uk/how-to-register-a-trade-mark>

### VALIDITY



- 10 years from date of application
- Renewal every 10 years



# UNDERSTANDING AND PROTECTING YOUR START-UP'S INTELLECTUAL PROPERTY ASSETS WHEN WORKING WITH THIRD PARTIES



## COPYRIGHT EXPRESSION OF IDEAS CRITERIA

### BENEFICIARIES OF PROTECTION

- AUTHORSHIP/OWNERSHIP
- JOINT OWNERSHIP
- EMPLOYEE WORKS IN EMPLOYMENT = EMPLOYER
- COMMISSIONED WORKS = CREATOR

### RIGHTS OF A © OWNER

#### ECONOMIC RIGHTS

- REPRODUCTION
- DISTRIBUTION
- ADAPTATION & TRANSLATION
- LICENSE - LEND/RENT
- ASSIGN - SALE

#### MORAL RIGHTS

- ATTRIBUTION



### EXCEPTIONS = FAIR DEALING

PRIVATE STUDY | RESEARCH | PARODY | CRITICISM/REVIEW

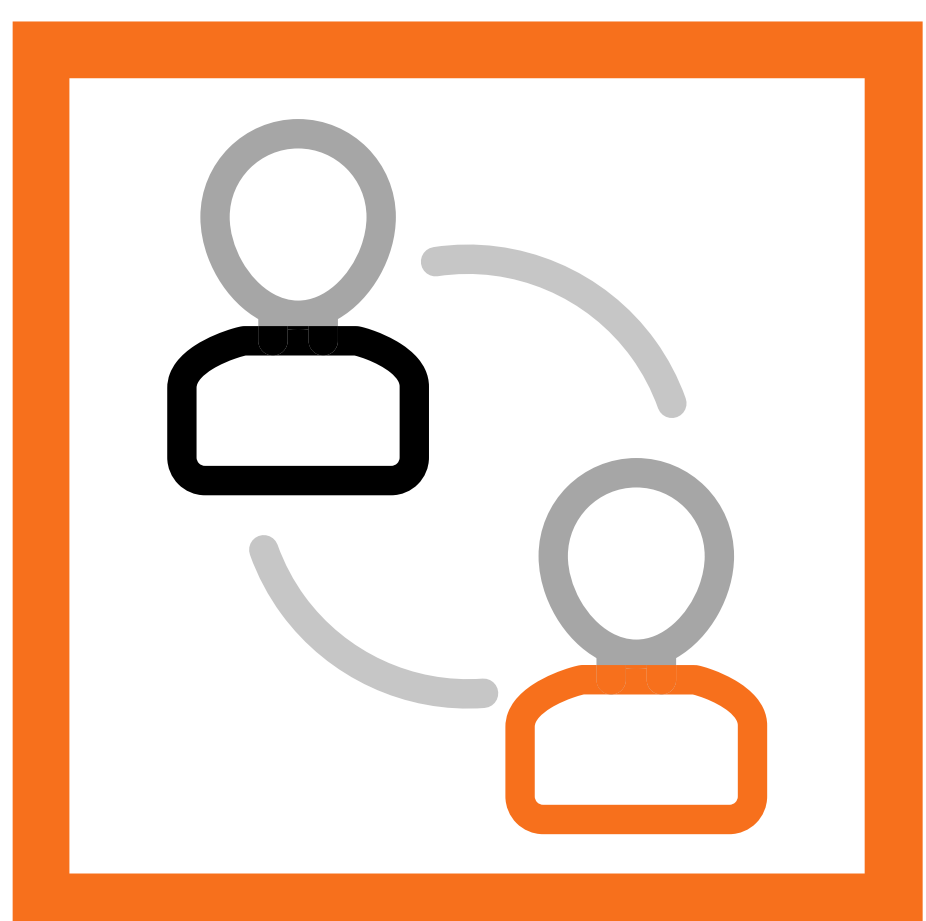
- **Literary Works:** novels, computer programs (software), databases
- **Dramatic Works:** plays
- **Artistic Works:** drawings, paintings sculptures, photographs, architecture
- **Broadcasts:** sound recordings
- **Published editions:** typographical works

+ ✓ ORIGINAL – your work  
RECORDED IN A MATERIAL FORM (not applicable to films and dramatic works)

⌚ DURATION = Life of author + 70 years.

📄 REGISTRATION NOT REQUIRED. Best practice to include copyright notice e.g. ©, qLegal, 2022

## Protect IP Rights



### INVESTORS

- Contract
- NDA



### EMPLOYEES

- Contract
- NDA



### CONTRACTORS/CONSULTANTS

- Contract
- NDA
- Agree to assign rights



### JOINT OWNERS

- Contract
- NDA



STIPULATE RIGHT IN CONTRACT  
NON-DISCLOSURE AGREEMENTS TO PROTECT TRADE SECRETS AND CONFIDENTIAL INFORMATION



## Commercialisation of IP

This is the process of making money from your IP

### Assignment

- The process of selling IP
- Like selling a house
- Requires documentation to be effective in law.
- Engage in **due diligence** before selling.
- Consider consulting a lawyer before engaging in assignment for full maximisation.
- Once sold cannot be recovered.



### Licence

- The process of leasing IP
- Like renting a house
- Does not requires documentation to be effective in law, but best practice to keep in writing for certainty.
- Engage in **due diligence** before licensing.
- Consider consulting a lawyer before engaging in licensing agreement for full maximisation.

#### Types of licence

**Exclusive** = a licence to one party. This exclusivity excludes owner of IP.  
**Sole** = a single licence to one party. IP owner reserves right to use the IP rights.

**Non-exclusive** = a licence to multiple parties and IP owner can use IP.  
**Sub-license** = a licensee can grant a third party right to the IP.





# UNDERSTANDING AND PROTECTING YOUR START-UP'S INTELLECTUAL PROPERTY ASSETS WHEN WORKING WITH THIRD PARTIES



## Registering/Protecting your IP



### PROS

- A property right.
- Enhances company value.
- Commercialisation of IP.
- Gain exclusivity and monopoly. Stop others from using the right without rights holder's permission.
- Gives company/business competitive edge.
- Protects creativity and innovation developed by the business.
- Need not be expensive. For example, a UK trade mark cost £170.



### CONS

- **Costly:** official fees, professional fees, renewal fees can add up. For example, a patent application is a very technical document and requires professionals to file the application.
- Third parties can file an **invalidity action to have your IP right revoked**. This is particularly the case with UK registered design as they are not examined at the point of registration.
- **Registration is not always available.** In the case of copyright registration is not possible as it exists automatically upon creation and cannot be registered.



## PRACTICAL TIPS/CONSIDERATIONS

Make an individual assessment whether getting your IP registered is a priority for your business.

Treat your business as if it is protected.

## REFERENCES

**To apply for individual legal advice from qLegal -**

<http://www.qlegal.qmul.ac.uk/advice/>

**UK Patent Application -** <https://www.gov.uk/apply-for-a-patent>

**UK Trade mark Application -** <https://www.gov.uk/how-to-register-a-trade-mark>

**UK Design Right Registration -** <https://www.gov.uk/register-a-design>

**UK Design Right Unregistered design -** <https://www.gov.uk/unregistered-designs>

**Sui Generis Database Rights -** <https://www.gov.uk/guidance/sui-generis-database-rights>

**WIPO (World Intellectual Property Organisation) -**

<https://www.wipo.int/portal/en/>

**More on Copyright -** <https://www.loganpartners.com/protecting-your-work-with-copyright/>

**More on non-disclosure agreements:**

<https://www.gov.uk/government/publications/non-disclosure-agreements>