

THE IP HANDBOOK



OFFICE FOR HARMONIZATION
IN THE INTERNAL MARKET
TRADE MARKS AND DESIGNS

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The time and effort put into creating, developing, designing or inventing something deserves to be rewarded.

So what is IP and why is it important?

IP is the abbreviation for both **Intellectual Property** and **Industrial Property**.

If you do not protect your IP, you might not be able to profit from it.

In this handbook you will find some explanations on the most common types of IP that you will come across as a designer, what your rights are, and how and where you can protect these rights.

THE DIFFERENT IP RIGHTS

IP rights are the legal rights which creations of the human mind can give rise to.

What is protected:

Innovative products or processes
The appearance of the products
Brands
Microchips
Goods from specific regions
Confidential commercial information
Artistic and literary works
New types of plants
Traditional methods and knowledge

Name of IP right:

Patents or utility models
Design protection
Trade mark protection
Topographies protection
Geographical indications
Trade secrets
Copyright protection
Plant varieties protection
Traditional knowledge

Intellectual Property: Intellectual property refers to the legal rights protecting the creativity of enterprises and individuals such as inventions, designs, trade marks, artistic and literary works.

Industrial Property: Industrial property is slightly narrower since it doesn't include artistic and literary works.



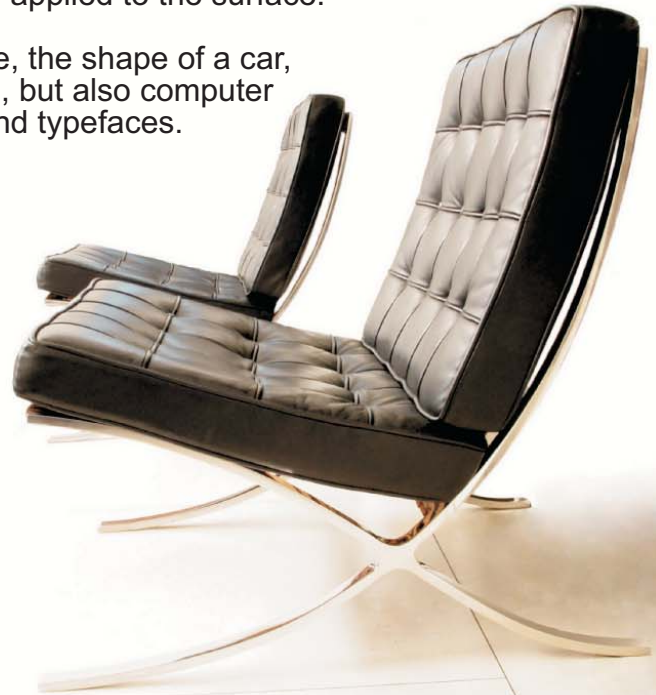
DESIGNS

The outward **appearance** of a **product** may be protected as a **design** if:

- it is **novel**;and
- has individual character; and
- the look is not solely dictated by the function; and
- it is not against morality and public order.

This can be a 3D shape or a 2D pattern applied to the surface.

The term "product" includes for example, the shape of a car, design of jewellery, toys, ornamentation, but also computer icons, graphic displays on computers and typefaces.



COPYRIGHT

Copyright grants authors, artists and other creative people protection for their literary and artistic works.

It is the expression of the idea and not the idea itself that is protected, so a concrete 'version' is necessary.

Copyright extends to almost everything, published and unpublished, for example:

- Literary and dramatic works
- Musical works and artistic works
- Film and sound recordings
- Typography of published books and music
- Broadcasts and cable programmes
- Performer's rights and recording rights
- Rental rights and public lending rights

appearance: outward or visible aspect.
product: an industrial or handcraft item.
novel: a design shall be considered to be new if no identical design has been made available to the public.



TRADE MARKS

A **trade mark** is a sign, or a combination of signs, which distinguishes the goods or services of one enterprise from those of another.

Such signs may, for example, use words, letters, numerals, pictures, shapes and colours, as well as any combination of the above.

Occasionally, an applicant may protect the same item both as a trade mark and as a design.

The main difference between choosing to register an item as a trade mark or as a design lies in what is being protected.

A trade mark is a distinctive sign used to distinguish products and services of one enterprise from those of another, and the aim of a registration is to protect this.

The registration of a design, however, just protects the **appearance** of a product, regardless of the fact that it can be distinctive of a particular enterprise.

PATENTS

A **patent** will be granted to an invention either for a completely new product or process or (more frequently) for something which is an improvement in the way something works or is made. But it must be:

- New
- Have an inventive step
- Be capable of being applied industrially

TOPOGRAPHIES

Topographies – this is the configuration or design of semiconductor products or “chips”, which is usually the result of vast investment of both expertise and financial resources.

The high cost and the relative ease of copying are the main reasons why layout designs need protection.

Integrated circuits are neither protected as industrial designs (not determining the external appearance) nor as patents (no inventive step) but can be protected by copyright, depending on the jurisdiction.

GEOGRAPHICAL INDICATIONS

Products with a **geographical indication** (GI) often have specific characteristics which are closely linked to their place of origin and may indicate a high level of quality.

So, for instance, sparkling wine must come from the Champagne region of France in order to be called Champagne otherwise it may only be referred to as sparkling wine.

Some examples of GIs: Roquefort (cheese), Parma (ham), Champagne (sparkling wine).



TRADITIONAL KNOWLEDGE

Traditional knowledge (TK) is the information that people in a given community, based on experience and adaptation to a local culture and environment, have developed over time, and continue to develop.

This knowledge is used to sustain the community and its culture and to maintain the genetic resources necessary for the continued survival of the community.

An example would be: the use of a particular plant to cure a certain disease etc.



PLANT VARIETIES

Also called a “**plant breeder’s right**”, this is a form of IP right granted to the breeder of a new plant variety in relation to certain acts concerning the exploitation of the protected variety which require the prior authorization of the breeder.

As in the case of patents, trade marks and industrial designs, prior examination and granting by the relevant authority is required to establish the breeder’s right.

In the EU the relevant authority is the Community Plant Variety Office (CPVO) in Angers, France.



UTILITY MODELS

The expression “**utility model**” is simply a name given to a title of protection for certain inventions, such as inventions in the mechanical field.

Only certain countries have this. Essentially there is a lower degree of inventive step necessary for these than for patents.

The procedure for obtaining protection for a utility model is usually shorter, simpler and less expensive than for obtaining a patent.

However, the possibility of registering a utility model only exists in some countries, so the first thing you should find out is if your chosen country grants protection.

There is no common Community protection for utility models.

TRADE SECRETS

A **trade secret** is a confidential formula, practice, process, design, instrument, pattern, or compilation of information used by an enterprise to obtain an advantage over competitors within the same industry or profession.

In some jurisdictions such secrets are referred to as "confidential information", while in others they are a subset or example of confidential information.

An example of this would be the formula or recipe of a product e.g. Coca Cola.

Confidentiality agreements and **non-compete clauses** are invaluable in protecting trade secrets.

non-compete clause: is a term used in under which one party agrees to not pursue a similar profession or trade in competition against another party.



WHAT ARE MY RIGHTS?

In general, **IP rights give the “exclusive” or sole right to do something with your creation:** your design, invention, artistic expression, trade mark etc.

Most rights need registration, but some, like copyright for example, often do not, depending on the local law.

IP rights give you the legal means or ammunition to stop other people from doing something with your work without your permission.



PROTECTING DESIGNS

Designs can be registered nationally through a national office, or in the EU through **the OHIM**. There are two types of Community Design protection, both covering all of the 27 EU member states.

There is the Unregistered Community Design which is valid for three years after disclosure, and which protects against bad faith copies.

Then there is the Registered Community Design which is valid for 5 years, and can be renewed in blocks of five years up to a maximum of 25 years. The fact that the right is registered constitutes an important feature as it gives it greater certainty and solidity in case of **infringements**.

The scope of the protection will be for the design and is not tied to a specific product so if you designed a new car you may stop people copying that design even if they are making a toy car or a key ring or even using the image on a T-shirt.

Do not forget the importance of the **novelty** of a design!

In many national registration systems you can no longer register a design after disclosure. It will have lost its novelty.

The Community Design system is different. Within the first year after disclosure, you can still apply for registration. This so-called “Grace Period” exists in order to allow the design owner to test the market before spending money on registration.

It is a good idea to contact an IP agent for professional advice.

- Novelty:** a design shall be considered to be new if no identical design has been made available to the public.
- Infringement:** someone is using your IP without your permission.
- The OHIM:** The Office for Harmonization in the Internal Market is a Community Agency responsible for the registered Community Design and the registered Community Trade Mark.

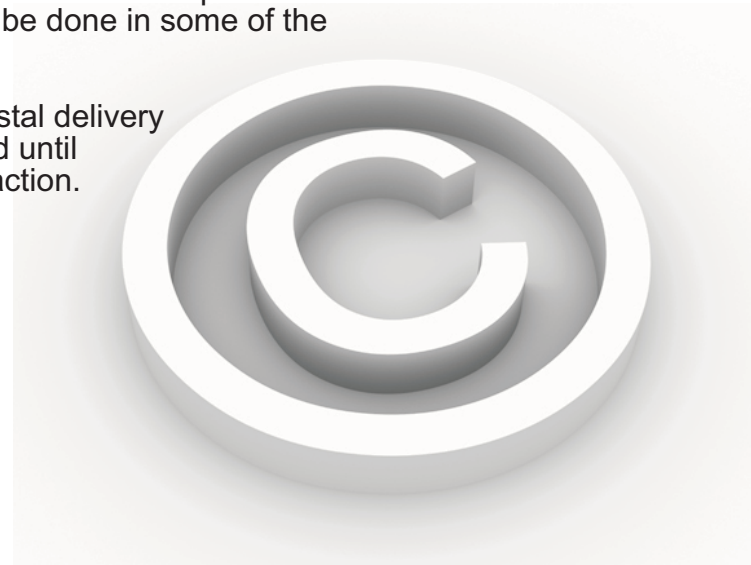


PROTECTING COPYRIGHT

As there is normally no formal procedure for registration of **copyright** proving copying can be difficult.

However, there are a number of ways to ensure that your date of creation can be verified more easily, e.g.:

- depositing your sealed original work with a **solicitor** or specialised rights management service. This can also be done in some of the national IP offices;
- sending the original work by registered postal delivery to yourself but leaving the envelope sealed until when or if it is needed in an infringement action.



PROTECTING TRADE MARKS

Registering a **trade mark** gives you the exclusive right to use it.

Trade marks can be registered nationally through a national office, regionally in the EU through the OHIM and in a number of countries over the world through the WIPO.

The term of protection is normally for 10 years, renewable indefinitely.

A trade mark is intended to act as a “guarantee of origin” for the customer. However, an owner of a trade mark also wants to be sure that customers are not misled regarding his product. In fact, trade marks can often be the most valuable part of a business.

solicitor: a type of whose traditional role is to offer legal services to clients apart from acting as their advocate in court.



PROTECTING PATENTS

Just having a good idea is not enough; it must be “**capable of industrial application**”.

It is possible to get a patent through either a national system or through a supranational system, such as the European Patent Office in Munich.

It is important that the description and claims for the invention are drafted in a very precise way so it is advisable to seek professional advice from a Patent Agent who has experience in these matters.



LICENSING

Having protected your IP, one of the most effective ways of exploiting it is the grant of a **licence**, which means that you allow someone to use your rights in return for a payment often in a lump sum or by way of a **royalty** on each product sold.

The licence terms and the amount to be charged are negotiated between the owner of the right and the licensee.

For those who do not want (or cannot afford) to manufacture their product themselves, this is the normal way to make money – particularly with a patent.



Royalty: payment to the holder of an IP right for the right to use their property.

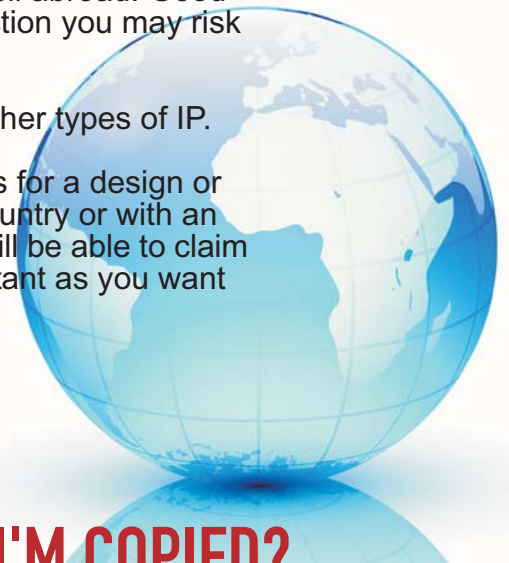
NATIONAL PROTECTION OR MORE?

National IP offices exist alongside European and international systems.

Your business strategy paves the way for your IP strategy - you may wish to test the local market before investing in a broader cover. You should be careful, even if you initially think your product will not sell abroad! Good design knows no boundaries and with a national protection you may risk being copied in a neighbouring country.

The risk is there as well for trade marks, patents and other types of IP.

Remember if you make a second filing (within 6 months for a design or trade mark and 1 year for a patent) in either another country or with an international authority such as OHIM or the EPO, you will be able to claim your earlier filing date as a “priority date”. This is important as you want to be the first to have filed for protection.



WHAT HAPPENS IF I'M COPIED? THAT IS, IF SOMEONE COPIES MY CREATION.

Most IP rights have a limited lifespan (e.g. 20 years for patents, 25 years for registered Community designs) but if in that time you find that someone is infringing (using your IP without your permission) you can enforce the right by applying to a Court for an infringement action.

If successful, you can obtain an “**injunction**” against the infringer which means they will have to stop. You may also get compensation – this could be in the form of damages according to any detriment that has been caused to your business or it may be possible to have the profits made by the infringer paid over to you.

This is a very complicated area and it is always advisable to take legal advice! Even though there will be an initial cost for you, it may well mean a more successful outcome!



injunction: a judicial remedy issued in order to prohibit a party from doing or continuing to do a certain activity.

WHERE TO FIND OUT MORE

On the webpage of www.handsoffmydesign.com you will find links that lead to more information on all types of IP rights and where to go to register.

Also don't forget, always consult a professional!

