

Patents, Trade Marks and Copyright

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Millbank Edge LLP



- ▶ Specialist corporate and commercial law firm
- ▶ Established 3 years ago by a group of partners from large international law firms
- ▶ Provide a partner-led service and build long term relationships with clients
- ▶ Advise UK and international businesses and support growth strategies

Intellectual Property

- ▶ Trade Marks
- ▶ Copyright
- ▶ Patents

Trade Marks

- ▶ A sign which can distinguish your goods and services from competitors
- ▶ Logos, words or a combination of both
- ▶ Distinctive for the goods and services
- ▶ Not registrable if:
 - customary
 - not distinctive
 - descriptive
 - illegal
 - deceptive
 - three dimensional shapes

Territory

- ▶ UK
- ▶ Community Trade Mark
(blanket protection of all EU territories)
- ▶ National (overseas)
(country by country)
- ▶ Madrid Protocol
(based on prior “home” registration and extended to member territories)

Registration

- ▶ Pre-requisites
- ▶ Is the Mark capable of registration?
- ▶ Clearance Search
- ▶ List of goods and/or services
- ▶ Name and address of Applicant
- ▶ *Bona fide* intent to use (UK)


Registration Process (UK)

- ▶ Filing
- ▶ Issuance of official filing number and date
- ▶ Examination
- ▶ Advertisement for Opposition (2 months)
- ▶ Registration
(Registered rights go back to the date of filing)
- ▶ Renewal every ten years

Benefits of Registration

- ▶ Easily enforceable against unauthorised use of a Mark
- ▶ Exploitation of the Mark, i.e. licensing etc
- ▶ Transferable Asset
- ▶ Ability to use [®]


Trade Mark Maintenance

- ▶ Mark should be used as registered within 5 years from issue of Registration or within a continuous period of 5 years
 - ▶ Failure to use could render the Registration vulnerable to attack (revocation) on the grounds of non-use
 - ▶ Logo/Device Marks should be used as registered
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Community Trade Mark

- ▶ Covers all 27 territories of the European Union
- ▶ Similar to the UK, but with a 3 month opposition period
- ▶ No *bona fide* intent to use requirement

National (Overseas)

- ▶ Registration can be effected in almost every world territory
 - ▶ Process is generally similar to UK and Registrations are valid for 10 years and renewable for like periods
 - ▶ Non-use period is generally 5 years but this can vary
 - ▶ Generally, no *bona fide* intent to use requirement
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Costs

- ▶ In addition to Trade Mark Agent Fees, £200 for one class of goods or services plus £50 for each additional class with a £30 discount for filing online

Copyright

- ▶ No specific Register
 - ▶ Copyright automatically created and applies to original works including software and databases
 - ▶ Proof of date of creation
 - ▶ Marking
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Ownership

- ▶ Creator of copyright is usually the first owner
- ▶ Employer owns work created by employee in course of employment
- ▶ Commission of works
- ▶ Copyright ownership and transfer (only in writing)
- ▶ Copyright last for life of creator plus 70 years in UK – could be shorter overseas

Protection

- ▶ Berne Convention applies Western Europe, USA, Russia
- ▶ TRIPS agreement
- ▶ USA – Official Register of Copyrights (not compulsory)

Patents

- ▶ Protects new inventions and covers how things work, what they do, how they do it, what they are made of and how they are made
- ▶ Registration prevents third party from making, using, importing or selling invention without permission enforceable by legal action
- ▶ Secrecy important – protection through NDAs
- ▶ Patenting protects new inventions containing an inventive step and capable of having an industrial use

Patents

- ▶ Cannot get a patent for scientific or mathematical drawing, theory or method, or presentation of information or some computer programs
- ▶ Cost £230 to £280
- ▶ Creator is usually the owner. If creator is an employee in course of normal duties then invention belongs to the employer
- ▶ Territorial rights
 - protection overseas either may extend UK in certain countries; or
 - apply for separate registration
- ▶ European Patent Convention (EPC) processes as a single application and if granted, separate patents

Patent Box

- ▶ Allows companies to apply a lower rate of corporation tax on income earned from patents after April 2013. Reduces Corporation tax rate to 10% over 4 years
- ▶ Qualifying criteria – own or exclusively licence, relevant patents and involved in qualifying development of them
- ▶ Applies to UK and European granted patents and some additional countries in EEA
- ▶ Qualifying income includes selling or licensing patent rights

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