

Select 2020

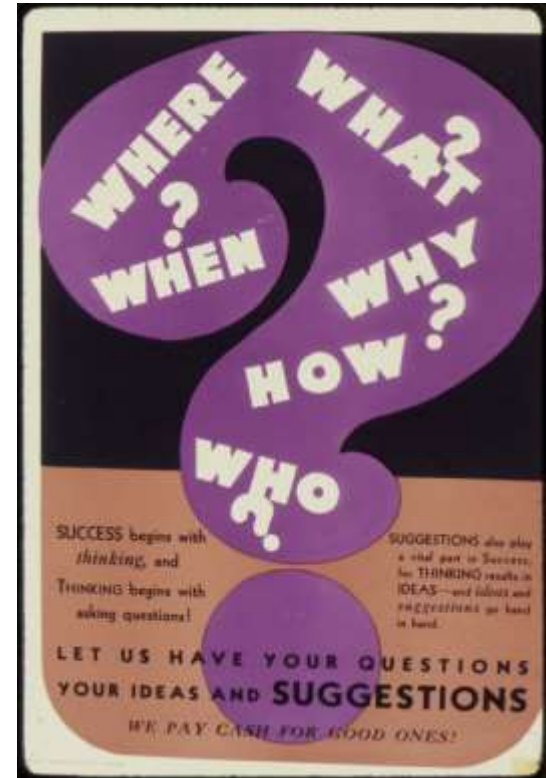
Educating your Business on IP: The Whys, the Whats and the Hows

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4 March 2020

What will we cover?

- The Whys
 - Overview of IP
 - Why is it so important?
- The Whats
 - What does your business need to know?
 - Create, protect, enforce, commercialise your IP
 - Using third party IP
- The Hows
 - How to train your business effectively
- Discussion





The Whys

What is “Intellectual Property” or “IP”?

Common forms:



Patents



Trade Marks

Registered / Unregistered



Copyright



Designs

Registered / Unregistered



Moral Rights /
Database
Rights



Trade
Secrets



Domain
Names



Company
Names

Why are we talking about IP?

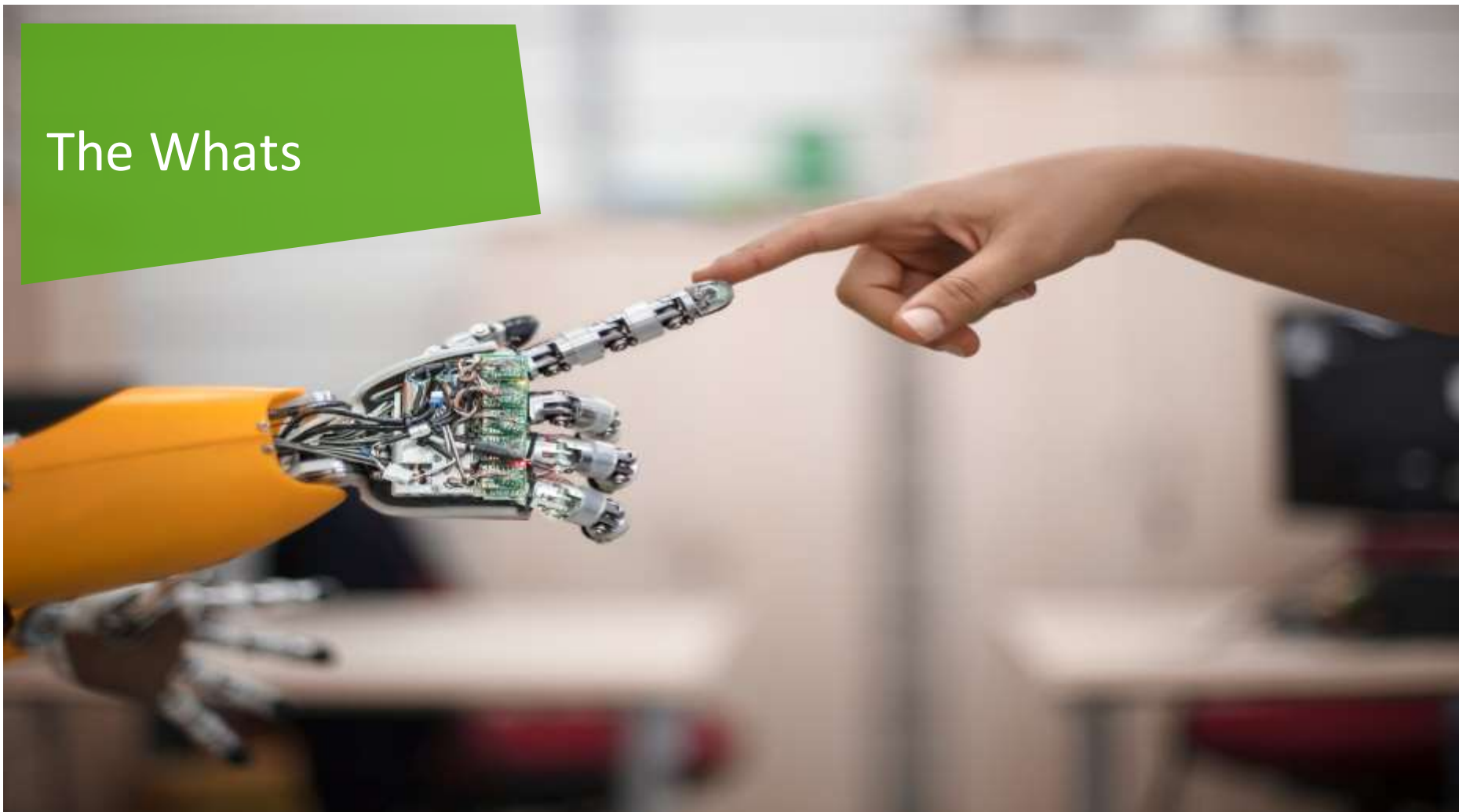
A teal-colored rounded square with the text "Enhance Value" in white.

Enhance Value

A magenta-colored rounded square with the text "Mitigate Risk" in white.

Mitigate Risk

The Whats



Identifying IP

How many types of IP exist in this smart phone?

Patents

- Data processing method
- Operating system
- Operation of user interface

Designs

- Form of overall phone arrangement
- Shape of buttons
- Position and shape of screen



Confidential Info

- Technical know-how

Trade marks

- iPhone
- 

Copyright

- Software
- User manuals
- Ringtones
- Images
- Product packaging text

The Whats

Key Issues



Create

Create

Ownership

- Valuable asset – important to establish ownership from creation
- Author/inventor is first owner
- Unless IPR is created in the course of employment - employer is first owner
- Take note:
 - Consultants or commissioned parties will be first owners, unless otherwise agreed



Create



Confidentiality

Keep good records

- Keep clear records of innovation related activities
 - Detail relevant research, meetings, designs, use, plans etc.
 - Date and sign entries, witness key entries (evidence of ownership, originality, novelty etc)

Trade secrets

- Contracts/NDAs
- Educate employees
- Review physical and IT security

Confidentiality Policy

- Put in place a confidentiality policy
- Educate the business
- Review regularly
- Carry out regular IP audits

Patents

- File patent application before publicly disclosing details of an invention
- Contracts/NDAs
- Watch out for "prior use"

Contracts/licences

- All contracts (including employment contracts) should have clear IP clauses
- Use appropriate licences

Registered Designs

- Avoid disclosing important designs prior to filing

Create

Clearance / Freedom to Operate

- Important to avoid conflict with existing rights
 - Especially relevant to trade marks, patents and registered designs
- Significant risk to business - financial and reputational
- Clearance searches (TMs); Freedom to operate (Patents)
- Cost vs benefit exercise



Protect

Protect

Registration

- Register key IP and review registrations regularly
- Territories?
- Cost benefit analysis

Patents

- Requirements – novel, inventive, industrial application
- Timing – when to file?
- Life cycle of product/process?

Registered Designs

- Requirements – Product design
- Deferred publication

Trade Marks

- Requirements – Distinctive, not descriptive
- Use of ®/™ - Puts third parties on notice



Copyright

- Can't register in the UK
- Comes into existence automatically
- Use of © - Puts third parties on notice

Protect

Maintenance



Patents

- Term – 20 years
- Annual maintenance fees (per country / MS)
- Lapse (Note: grace period of 6 months)
- Monitoring infringement?
- Defend against revocation?

Registered Designs

- Term – 25 years
- 5 year renewal fees

Trade Marks

- Term – Can be renewed every 10 years
- Renewal fees
- Use it or lose it!

Copyright

- Depends on the copyright – generally life of author + x years
- No maintenance required (in the UK)

Commercialise

Commercialise

Licensing

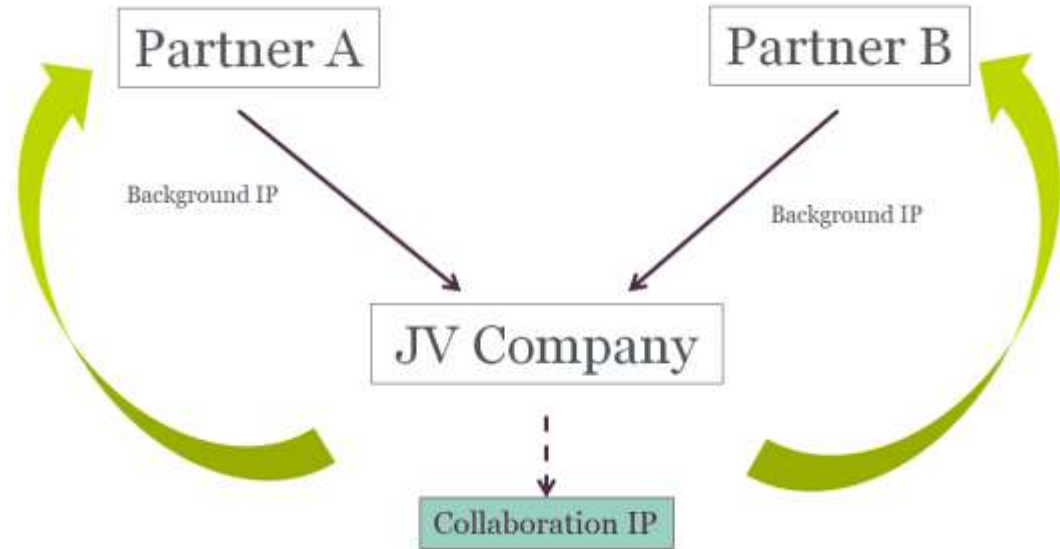
- Realise the value of the asset
- Key considerations
 - Restrictions/controls on use of the IPR
 - Quality control and audit
 - Territorial/market scope
 - Term of licence
 - Termination and breach provisions key
 - Licence fees – royalties, lump sums



Commercialise

Joint Ventures

- Purpose of JV
 - Territory of operation
 - How long is it expected to last?
- Background IP
 - Scope of use
 - Improvements
- Collaboration / Foreground IP
 - Ownership (avoid joint ownership)
 - Licences / Rights to use
 - Royalty payments?



Commercialise

Joint Ventures

- **Termination:**

Mechanisms:

- Fixed term
- For cause (breach, change of control etc)
- Business decision – i.e. upon notice

Considerations:

- Who owns the IP of the JV?
 - ❑ Background IP (and improvements)
 - ❑ Collaboration IP

- **Exit (JV business continues):**

Mechanisms:

- Sale of entire JV / IPO
- One party buys out other

Considerations:

- Will one party continue to operate business?
- Will the exiting partner still be required to provide background IP?
- New non-compete restrictions?
- Confidentiality?

Enforce

Enforce

Why enforce and monitoring

- Why?
 - Valuable asset to protect
 - Prevent competitors taking advantage
 - Avoid damage to reputation, e.g. by poor quality rip-offs
- Monitoring
 - Customs watches
 - Online monitoring services
 - Registry watch notices
 - Licensee/ distributor reporting obligations
 - Competitor due diligence



Enforce Strategy



THIS CHANGE OF NAME DEED made by me the undersigned Hugo BOSS of [REDACTED]
[REDACTED] now or lately known as Joe Harry LYCETT born 05/07/1958 and a
British citizen

1. I absolutely and entirely renounce, relinquish and abandon the use of my said former name of Joe Harry LYCETT and assume, adopt and determine to take and use from the date hereof the name of Hugo BOSS in substitution for my former name of Joe Harry LYCETT

2. I shall at all times hereafter in all records, deeds, documents and other writings and in all actions and proceedings as well as in all dealings and transactions and on all occasions whatsoever use and subscribe the said name of Hugo BOSS as my name in substitution for my former name of Joe Harry LYCETT so relinquished as aforesaid to the intent that I may hereafter be called, known or distinguished not by the former name of Joe Harry LYCETT but by the new name of Hugo BOSS only

3. I authorise and require all persons at all times to designate, describe and address me by the adopted name of Hugo BOSS

IN WITNESS whereof I have hereunto subscribed my adopted and substituted name of Hugo BOSS and also my said former name of Joe Harry LYCETT

By the above-named
Hugo BOSS

New Signatures

Formerly known as
Joe Harry LYCETT

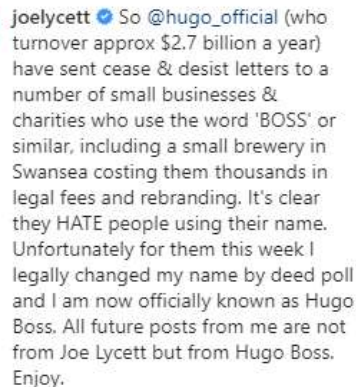
Old Signature _____

In the presence of

Witness' Signature:

Witness' Name:

Witness' Address: _____



18h



Liked by [REDACTED] and 91,991 others

18 HOURS AGO

Add a comment...

Enforce

How to enforce

- Letter before action:
 - Compliance with pre-action protocols
 - Threats
- Settlement discussions
- Issuing proceedings
 - Choice of jurisdiction / venue
- NB - counterclaims?
- Remedies
- Costs



Third Party IPR

Third Party IPR

Using Third Party IPR

- Get a licence and comply!
- Design around - Inspiration vs copying
- Using without Consent:
 - Infringement risk
 - Reputational damage
 - Costs
 - Challenge validity of IPR



The background of the slide is a photograph of a bookshelf. The books are arranged in a way that their spines and pages create a strong sense of perspective, leading towards the center. The books have various colored covers, including green, blue, yellow, and orange. A blue triangular overlay is positioned in the top right corner, containing the text 'The Hows'.

The Hows

The Hows

External education

- Tailor to the business unit
 - Innovation teams, procurement, marketing
- Business relevance is key
- No legalese
- E-learning
 - Desktop presentations
 - Interactive webinars
- Workshops
- Live Presentations



The Hows

Internal education

- Principles
- Procedures
- Policies
- Tailor to the business unit
- Bolt-on to external education?



Key Takeaways

- IP is critical to all businesses, both in terms of creating their own IP and using third parties' IP
- Your business needs to be aware of the opportunities and risks IP creates
- A little education will go a long way
- Keep the training short, business/sector relevant, accessible, and tailor it to individual business units



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