



Managing Intellectual Property

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Disclaimer

- *The information contained in this presentation is of a general nature. It is not legal advice and should not be construed as such.*

▼ IP Management Overview

- Four pillars of intellectual property
 - Copyrights
 - Trademarks
 - Trade secrets
 - Patents
- We will focus on
 - Identification
 - ownership
 - protection

▼ What is Intellectual Property?

- “intellectual”
 - represents intellectual efforts and achievements:
 - writing of software, books, screen plays
 - brands, logos, product or company names
 - business plans, formulae, recipes, business processes
 - inventions, such as new drugs, electronics goods, manufacturing processes

▼ What is Intellectual Property?

- “property”
 - usually has commercial value
 - gives a bundle of rights to the owner:
 - right to sell a product or service
 - right to prevent others from doing so
 - right to license others to use your rights

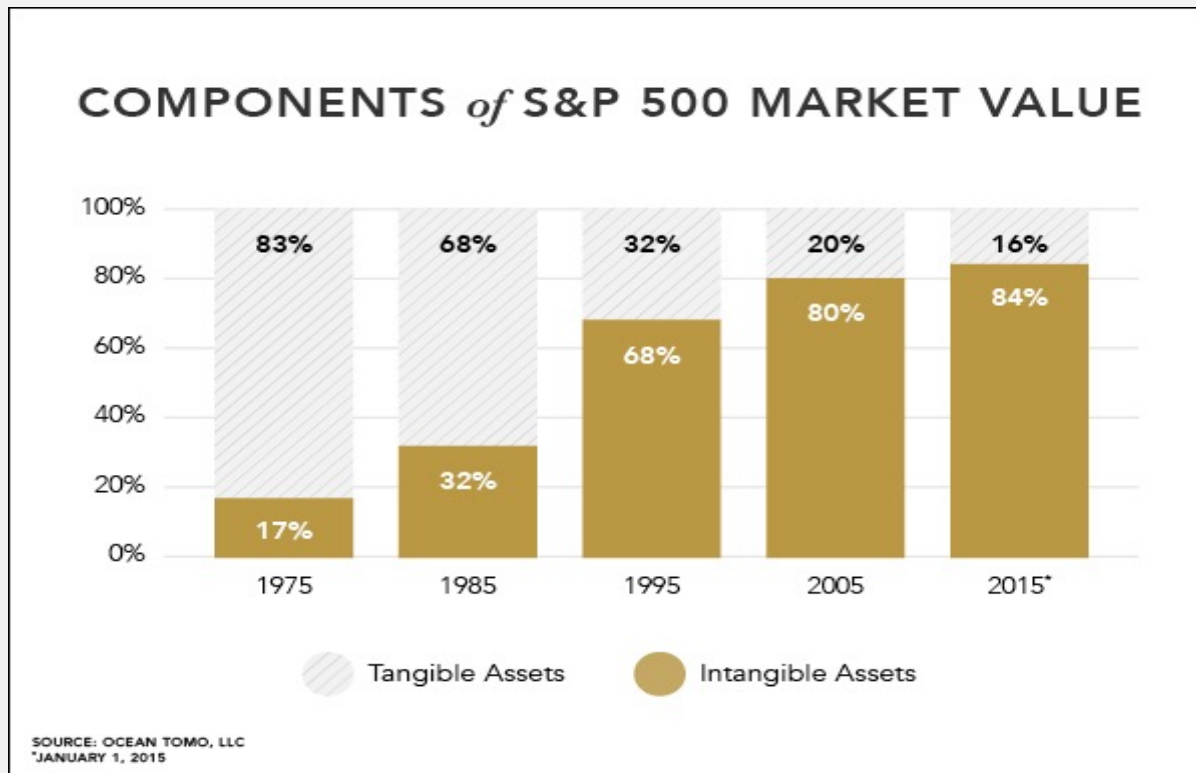
▼ Why IP Protection is Important

- IP is a valuable commercial asset – the most valuable asset for many companies
- Provides a competitive advantage (better products)
- Shields you from competition (OLED tv's)
- Investors, acquirors and customers care about IP (diligence)

- however -

- IP is vulnerable – ^{EASKEEN}easy to copy, steal, counterfeit

▼ Intangible Assets-Relative Value



Intellectual Property

- What types of IP protect software?
- There are many ways IP can protect your goods and services



Copyright

- Copyright is the sole right to produce or reproduce a work, or a substantial part of a work
- Protects the expression of idea, not the ideas themselves

Copyright

- “Work” includes articles, photographs, graphic designs, study protocols, data, computer programs, website designs



▼ Requirements

- Originality: more than a copy of another work, reflecting the exercise of skill and judgment, but not necessarily creativity
- Fixation: must be expressed in some material form



▼ Moral Rights

- Give the author of a work the right to prohibit modification of a work and to limit how it is used
- Can only belong to people
- Moral rights cannot be assigned, only waived

“the employee shall and does hereby waive all of his or her moral rights in the Work Product”



▼ Copyright

Ownership

- As a general rule, the author (or creator) of a work is the first owner of copyright
- Employment is an exception to the general rule
- Freelancers or independent contractors are considered the “author” of their creations and own it

Copyright Protection

- Arises automatically
- © notices should be used
- Registration enhances rights
 - Simple and inexpensive to register
 - Some registrations occur before commencing litigation

▼ Copyright Management

- Focus on ownership and rights
- How are works developed?
- What do your contracts say about copyright?
- Magic sentence:

“Contractor shall and does hereby assign to Customer all rights, title and interest in and to the Deliverables and shall ensure that each author of the Deliverables waives all of his or her moral rights in and to the Deliverables.”

Trademarks

Interbrand's most valuable brands (2018):



\$214B



\$60B



\$155B



\$53B



\$100B



\$48B



\$92B



\$45B



\$66B



\$43B

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Trademarks

Interbrand's most valuable brands (2015):

	\$170B		\$49B
	\$120B		\$45B
	\$78B		\$42B
	\$67B		\$40B
	\$65B		\$38B



Trademarks

- Why are trademarks important
 - The goodwill associated with products and companies reside in their respective trademarks
 - Consumers make decisions based on trademarks

Trademarks

Ownership

- Owned by first user or person that registers or uses the trade-mark
- Use is most important
 - Goods: “use” means on the goods, packaging or in any other manner so associated with the goods that notice of the association is given
 - Services: “use” means use or display in the performance or advertising of those services



Trademarks management

- A. Picking a good trademark
 - I. Distinctiveness
 - II. Searching and Clearance
- B. Registration
- C. Enforcement

▼ A. Picking a good trademark

I. Distinctiveness

- The key to choosing an effective trademark
- The purpose is to distinguish your goods and services from competitors.
- Distinctiveness requires that your trademark:
 1. Does not describe your goods and services
 2. Is not confusingly similar to your competitors trademarks
- Distinctive marks: GOOGLE, APPLE (for computers)

▼ Trademarks

Descriptiveness

- trademarks law generally prohibits obtaining rights to and registering trademarks that describe the character or quality of the goods and services with which they are used
- Reason: trademark owners should not monopolize words that describe goods or services
 - E.g. “safe” cars, “fresh” bread
- It is tempting to choose trademarks that are somewhat descriptive
- However, the more descriptive your trademark is, the less you will be able to claim rights to it and protect it

Trademarks

Confusion

- You are not allowed to use and register trademarks that are confusingly similar with those of your competitors because:
 - it creates confusion in the marketplace
 - It infringes the rights of others
- It is tempting to choose marks that are somewhat confusing with established marks or that contain common elements

▼ Trademarks



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▼ Foreign markets? Consider connotation...

Nike – 1997

Air Flame Logo = Allah?



Nike – Deja Vu – Jan. 2019

Air Max 270 Logo = Allah?



Trademarks

II. Searching and Clearance

- Prior to choosing a trademark, search the trademarks **register** and **marketplace** to ensure that no identical or confusingly similar marks are already used, registered or applied to be registered for the same goods or services
- **Tip: come up with more than one potential trademark at the start of the searching process and rank according to preference**

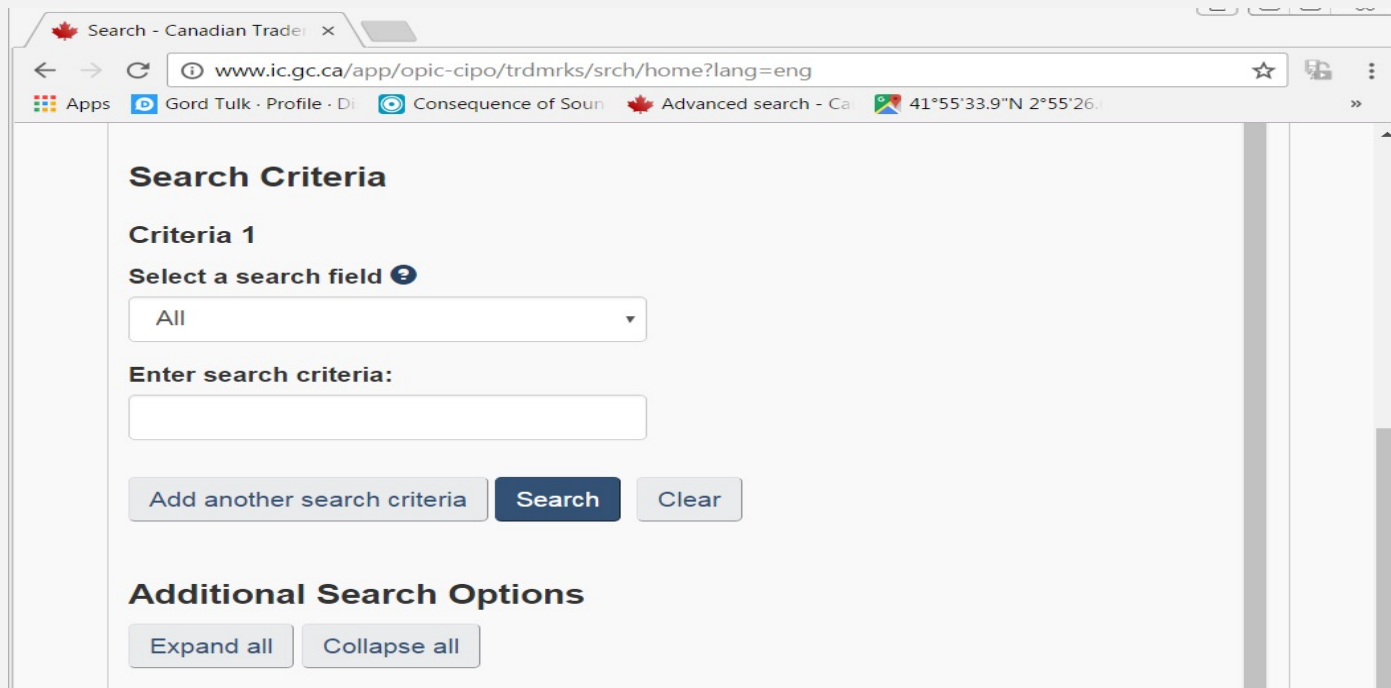
Trademarks

- Two types of trademark rights to search for:
 - Statutory rights
 - arise from registering or applying to register a trade-mark
 - need to search the CIPO Trademarks Registry to find them
 - Common law rights
 - arise from use of a trademark in the marketplace
 - need to search the marketplace to find them
 - more limited than statutory rights

Trademarks

- Trademark search tools
- The main search tools are:
 - Knock-out searches
 - Full availability searches
 - Investigations

▼ Knock-out Searches - Canada




The screenshot shows a web browser window with the URL www.ic.gc.ca/app/opic-cipo/trdmrks/srch/home?lang=eng. The page is titled "Search - Canadian Trade" and features a search interface with the following elements:

- Search Criteria**
 - Criteria 1**
 - Select a search field** (dropdown menu): All
 - Enter search criteria:** (text input field)
 - Buttons:** Add another search criteria, Search, Clear
- Additional Search Options**
 - Buttons:** Expand all, Collapse all

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Knock-out Searches - US

 **United States Patent and Trademark Office**

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[Trademarks](#) > **Trademark Electronic Search System (TESS)**

TESS was last updated on Mon Apr 30 05:21:01 EDT 2018

[TESS HOME](#) | [STRUCTURED](#) | [FREE FORM](#) | [BROWSE DICT](#) | [SEARCH OG](#) | [BOTTOM](#) | [HELP](#)

WARNING: AFTER [SEARCHING](#) THE USPTO DATABASE, EVEN IF **YOU** THINK THE RESULTS ARE "O.K.," DO **NOT** ASSUME THAT YOUR MARK CAN BE REGISTERED AT THE USPTO. AFTER YOU FILE AN APPLICATION, THE USPTO MUST DO ITS OWN SEARCH AND OTHER REVIEW, AND MIGHT [REFUSE TO REGISTER](#) YOUR MARK.

[View Search History:](#)

☒ Plural and Singular ☐ Singular
☒ Live and Dead ☐ Live ☐ Dead

Search Term:

Field:

Result Must Contain:

Please logout when you are done to release system resources allocated for you.

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▼ Trademarks

B. Registration

- Registration is by country (except EU)
- Canada:
 - Three years average for registration
 - \$2,200 (no objections, oppositions)
 - 10 year renewable registration period
- **Tip: prioritize countries by value of market and likelihood of sales**

Trademarks

C. Enforcement

- Watch out for infringement of your rights
- Take action against infringements and potential infringements
 - Cease and desist letters
 - Litigation
 - Opposition
- Failure to act can weaken your trademark rights

▼ Trademark Management

- Pick the right trademark
 - Consider more than one potential trademark
 - Avoid trademarks that are descriptive or similar to other trademarks used in your industry
 - Search the marketplace
 - Assess risks before proceeding
- Register trademarks
- Use it or lose it
- Keep an eye out for infringers
- **Bonus tip: use fewer trademarks**