

A photograph of a modern, multi-story building with a glass facade and a metal roof, partially obscured by lush green trees. A paved walkway leads towards the building entrance. In the foreground, there is a sign for the Intellectual Property Office.

# **Understanding Intellectual Property**

**Jane Lambert**

 INTELLECTUAL  
PROPERTY OFFICE



# Agenda

What is intellectual property?

Why is IP important?

10 How to protect investment in different types of intellectual assets

How to obtain IP rights

How to enforce them

Where to get more information and assistance





# What is Intellectual Property?

Intellectual property is a collective term for the bundle of laws that protect investment in branding, design, technology and creativity.



# What is Intellectual Property?

Examples of those laws include patents for inventions, trade mark registrations for distinctive signs, design registrations for the appearance of products and copyrights for the arts and literature.



# What is Intellectual Property?

Those laws are the results of a bargain between artists, designers, entrepreneurs and innovators and the general public.



# **What is Intellectual Property?**

In return for investing in branding, design, entertainment, publishing, research and development those artists, designers, entrepreneurs and innovators are granted time limited monopolies or exclusive rights to recoup their investment and maybe a little more.

# What is Intellectual Property?



# Why is IP important?

It fortifies the competitive advantage that a business acquires over its competitors through investment in branding, design, technology and creativity.





# Why is IP important?

On the other hand IP can represent an existential threat to a business since the penalties and remedies for infringement are draconian and can leave that business in the wilderness.

# Why IP is important?





# How to protect a brand

- Trade Mark Registration
- Law of Passing-off
- Geographical Indications



# Trade Mark Registration





# Trade Mark Registration

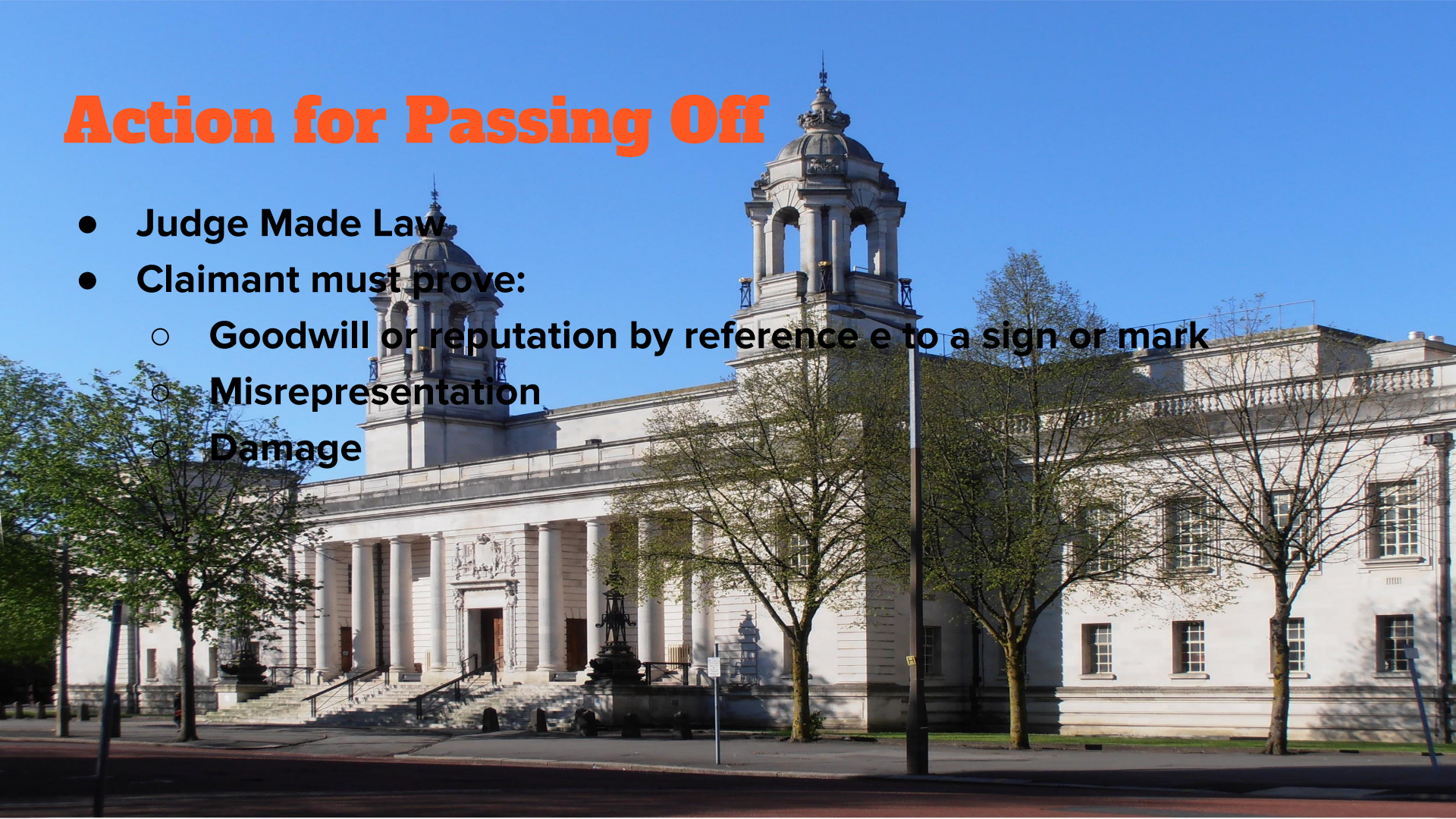
- United Kingdom: Intellectual Property Office, Newport
- European Union: EU Intellectual Property Office, Alicante
- Other Countries: Madrid Protocol or Direct Patent Offices





# Action for Passing Off

- Judge Made Law
- Claimant must prove:
  - Goodwill or reputation by reference to a sign or mark
  - Misrepresentation
  - Damage





# Geographical Indications



# Geographical Indications





# What is a Design?

Two kinds of designs:

- **Functional Designs:** shape or configuration (whether internal or external) of the whole or part of an article.
- **Ornamental Design:** appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture or materials of the product or its ornamentation.

# How is a Design protected?

**Functional designs:** Unregistered design right

**Ornamental designs:** Design registration in UK and EU, unregistered Community designs, unregistered design right and copyright



# Design Registration



# Unregistered Design Right

- Part 3 Copyright Designs and Patents Act 1988
- Subsists automatically in original designs made by UK citizens and residents or citizens and residents of other countries
- 10 of 15 year term
- Licences of right in the last 5 years
- Very few countries offer a similar type of protection for designs



# Unregistered Community Design

- Established by Community Design Regulation
- Subsists automatically in designs that could be registered
- Protection throughout EU and until the UK until 31 Dec 2020
- Equivalent protection in UK after 1 Jan 2021 to be known as supplementary unregistered design

# Copyright

- Protects artwork for fabrics, wall coverings or other surface decoration
- Protects works of artistic craftsmanship like Flos lamps





# Technology

New products, processes and services

- Electrical and mechanical products
- Pharmaceuticals
- Software
- Business methods
- Plant varieties

# How is Technology protected?

- Trade secrecy
- Patents
- Unregistered design right
- Semiconductor topographies
- Copyright
- Database Rights
- Plant breeders' rights



# Trade Secrecy

- Every invention starts as a trade secret
- Law of confidence
- Trade secrets directive
- No protection against reverse engineering or discovery by parallel research and development
- Can last much longer than a patent

# Patents





# Works of Art and Literature

Arts fall into two categories:

- **Literary and Graphic Arts:** architecture, drawings, films, novels and sound recordings;
- **Performing Arts:** concerts, dance, drama, opera, poetry reading
- **Copyright** derives from Part I of Copyright Designs and Patents Act 1988 whereas rights in performances derive from Part II.

# Copyright





# Obtaining Legal Protection

**Some IP rights come into being automatically:**

- Copyrights, unregistered design rights, rights in performances, right to bring an action for passing off.
- Others such as patents, trade marks and registered designs have to be registered.

# Applying for Registered Rights

- Usually necessary to make thorough searches of UK and sometimes overseas registries;
- Specifications have to be drafted carefully;
- Often necessary to conduct lengthy correspondence with examiners and others;
- Patent or TM Attorneys can be helpful

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# Working with a Patent Attorney



# Working with a Trade Mark Attorney

Find out what a Chartered Trade Mark Attorney  
could do for your business



The diagram illustrates the interconnected nature of different types of intellectual property protection. It features three central elements: 'TM' (Trade Mark), 'Registered Designs', and 'R' (Registered Trademark). Each element is enclosed in a set of parentheses. These elements are arranged horizontally and connected by a series of curved arrows, indicating a cyclical or interrelated relationship between them. The 'TM' and 'Registered Designs' are grouped together, while the 'R' is separate but also part of the cycle.

CITMA The Chartered  
Institute of Trade  
Mark Attorneys

[www.citma.org.uk](http://www.citma.org.uk)



# Typical Prosecution Costs

## Patent for

- **UK alone:** £5,000
- **UK, France, Germany, Netherlands, Italy, Switzerland, Sweden:** £30,000
- **UK, France, Germany, USA, China, India, Japan, Korea etc:** £100,000

**UK Trade Mark:** £500

**Registered Design:** £200

# Enforcement



**Although some IP infringements are criminal offences, the IP owner is primarily responsible for enforcement of his or her rights.**

# Enforcement

Unless the parties agree otherwise, claims are brought in civil courts:

- High Court: unlimited claims but costs over £1 million
- Intellectual Property Enterprise Court: claims up to £500,000 but costs limited to £50,000
- Small IP Claims Track: claims limited to £10,000 and costs limited to a few hundred pounds



# ADR

- IP Office mediation
- Domain name dispute resolution policies for domain name disputes
- IP Office examiners' opinions on patent disputes



# Litigation Funding Options

- Before the event IP insurance
- Third party litigation funding
- Collecting societies
- Contingency fee litigation in the USA

# Obtaining Further Information

- UK Intellectual Property Office  
[www.gov.uk/government/organisations/intellectual-property-office](http://www.gov.uk/government/organisations/intellectual-property-office);
- WIPO: [www.wipo.int](http://www.wipo.int);
- European Patent Office: [www.epo.org](http://www.epo.org);
- EU IP Office: [euipo.europa.eu](http://euipo.europa.eu)
- British Library Business and IP Centre:  
[www.bl.uk/business-and-ip-centre](http://www.bl.uk/business-and-ip-centre);
- NIPC Law: [www.nipclaw.com](http://www.nipclaw.com)
- NIPC Wales: [www.nipcwales.co.uk](http://www.nipcwales.co.uk)



# British Library Business and IP Centre



# Liverpool Business and IP Centre



# Menai Science Park IP Network

- **Barrister:** Jane Lambert
- **Commercial Solicitor:** Andrea Knox
- **Innovation Consultant:** Huw Watkins
- **IP Tax Specialist:** Steve Livingston
- **Patent Attorney:** Sean Thomas
- **Specialist IP Solicitor:** Jonty Gordon

# **Any Questions?**

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