



HK

Intellectual Property

LAW AND PRACTICE

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WHAT IS INTELLECTUAL PROPERTY (IP)

Intellectual Property Rights	Protection
Copyright	This protects your work and stops third parties using it without your permission by copying, adapting, distributing, renting, lending, performing, showing, or putting your work on the internet.
Publication Right	A type of Copyright granted to the person who first publishes a previously unpublished Copyright work.
Passing Off	Where one party passes off another party's goods or services as if they are their own. The law of Passing Off protects the goodwill of a business from misappropriation.
Design Right	This protects the appearance of a functional product. To be protected, a design must comprise the shape or configuration (internal or external) of the whole or part of an article.
Database Rights	This protects a collection of independent works, data or other materials which: (a) are arranged in a systematic or methodical way, and (b) are individually accessible by electronic or other means.
Registered Design	This protects both 3D and 2D designs and can be a one-off.
Registered Trade Marks	This protects anything which distinguishes the goods or services between proprietors and can take many forms; including words, slogans, logos, colours and smells.
Registered Patent	<p>A licence giving the holder exclusive rights to a process, design or new invention for a set period of time. Patents are available for most industrially applicable processes and devices such as:</p> <ul style="list-style-type: none">• Mechanical devices• Methods for doing things• Chemical compounds• Mixtures of compounds <p>A Patent will only be granted if it is new, inventive and capable of industrial application.</p>

WHY IS IP IMPORTANT?

Protecting IP through registration (where applicable) or through unregistered rights, can stop third parties from using your IP such as the name (or other valuable aspects of a business identity), or copying the design of your products. Protecting your IP helps you to exploit it and thereby generate income from it.

UNREGISTERED RIGHTS

Copyright

Copyright protection arises automatically when you produce original work including:

- Literary, dramatic, musical, and artistic work including illustration and photography;
- Sound and music recordings;
- Film and television recordings;
- Broadcasts;
- Non-literary written work, e.g. software, web content, and databases;
- Layout of published editions of written, dramatic, and musical works

Copyright Work	Duration
Literary, dramatic, musical, or artistic works	70 years from the end of the calendar year in which the author dies. For joint authorship or co-authorship - this is from the end of the calendar year in which the last known author dies.
Computer-generated literary, dramatic, musical, or artistic works	50 years from the end of the calendar year in which the work was made.
Sound recordings	50 years from the end of the calendar year in which the recording is made; or if published during that period 70 years from the end of the calendar year in which it was first published.
Films	70 years from the end of the calendar year following the death of the principal director, screen play author, dialogue author, or music composer occurs ('Specified Persons') or from the end of the calendar year in which the last known Specified Person dies if one or more are unknown.
Broadcasts	50 years from the end of the calendar year in which the broadcast was made.
Typographical arrangement of published editions	25 years from the end of the calendar year in which the edition was first published.

Moral Right

The right of the artist or author of a copyright work:

- (a) to be identified as the author of the work;
- (b) to object to derogatory treatment of the work.

An author may waive their Moral Rights but cannot assign it to others.

Passing Off

A trader can take out an injunction and sue for damages in the event that somebody 'passes off' his goods or services. Passing Off usually occurs by a third party using or imitating his trade name or brand or doing another act which appropriates the goodwill or injures the reputation of another, causing actual damage (e.g. the financial cost of lost sales).

Design Right

Protects only 3D items; an original design of any aspect of the shape/configuration of an article will confer automatic Design Right the protection of which is similar to Copyright. Generally, designs created by an employee belong to the employer. The commissioner of the design will receive a licence to use the work - the same as Copyright.

This is an unregistered right and therefore not capable of registration and has duration of 10-15 years.

A similar EU Design Right will arise automatically but has a duration of three years.

Database Rights

Arise automatically on the creation of the Database.

The majority of database owners tend to exploit databases by way of licencing rather than selling, which allow them to be reproduced infinitely and effortlessly and to be accessed by many users at once.

This is an unregistered right and therefore not capable of registration.

- The duration period is **15** years from the end of the calendar year in which the database was completed; or
- if the database is made available to the public before the database was completed, **15** years from the end of the calendar year in which the database was first made available to the public; or
- **15** years from a substantial change to the database.

Confidential Information

Sensitive business information can be protected as Confidential Information through the use of non disclosure agreements or through provisions in commercial contracts which include employment contracts.

The law will sometimes impose a duty of confidentiality to protect information if it is confidential in nature and disclosed in circumstances where an obligation of confidence is considered appropriate.

REGISTERED RIGHTS

Registered Design Rights

A UK or EU Registered Design protects the visual appearance of a product or part of a product. This might be a pattern or the lines/contours of the design or even the shape or texture of the article.

A Registered Design confers total rights of ownership over the appearance.

A Registered Design will allow you to protect both 2D and 3D features of a design.

Registration	Duration
Registered Designs are territorial rights and can be registered through the Intellectual Property Office (UK), European Intellectual Property Office (EU), World Intellectual Property Office or direct at national Intellectual Property Offices.	Generally 25 years for UK registrations from the date of registration (you must renew the registration every 5 years).

Trade Marks Rights

A registration confers upon its proprietor the statutory right to the exclusive use of the Trade Mark in connection with the goods and/or services for which the Trade Mark is registered.

Registration gives the proprietor a right to take out an injunction or sue third parties for Trade Mark infringement.

The proprietor of a registered Trade Mark may authorise or licence others to use the Trade Mark in exchange for royalties or other form of payment.

Registration	Duration
Trade Marks are territorial rights and can be registered through the Intellectual Property Office (UK), European Intellectual Property Office (EU), World Intellectual Property Office or direct at national/regional Intellectual Property Offices.	There is no limit for a UK registration but it has to be renewed every 10 years - other countries have different terms.

Infringement

Infringement usually occurs:

- Where a third party who uses an identical or similar mark in the course of trade in connection with identical or similar goods/services without authorisation.

If the Trade Mark is similar but not identical in either form or use:

- The proprietor must also show that the use of the mark has caused or is likely to cause confusion to the public.

REGISTERED RIGHTS CONTINUED

Patent Rights

A Patent, when granted, confers the exclusive use of an invention which is capable of industrial application.

Upon applying for a Patent, an inventor will get interim protection (Patent Pending).

A UK Patent application can be used as a basis for overseas patent applications (including applications filed at the European Patents Office) under a series of international conventions.

NB: It is important to get a patent application right from the outset otherwise rights may be unduly constrained. Any disclosure of the invention prior to application for patent protection must always be protected by a non disclosure agreement. Professional assistance is recommended.

Registration

Patents can be registered:

- in the UK
- in Europe through the EU Patent Convention
- internationally through the Patent Co-operation Treaty
- direct at National Patent Offices

Duration

The UK grant is for a period of **20** years but third parties can claim a licence of the Patent after **10** years if it is not being exploited.

OWNERSHIP OF IP

Ownership

The general rule is that ownership of the Intellectual Property usually remains with the author/creator of the work.

Freelancer/ consultant

First owner of the IP and which will only pass if the rights in the work have been assigned to the person who commissioned it.

Employee/ Employer

The rights in any Intellectual Property will automatically belong to the employer on creation.

Joint authorship

The Intellectual Property will be owned jointly by the authors who created it where the contribution of each author is not distinct from that of the other author or authors.

Commissioned work

Rights in the work will usually remain with the author/creator unless expressly agreed that the ownership rights will pass to the person who commissioned the work.

Assignment

An agreement between the creator and the other party that the Intellectual Property rights will pass to the other party usually on payment of a fee.

IP USAGE BY THIRD PARTIES

Type of third party use

Licence

Where you retain ownership but allow a third party to use your Intellectual Property for a particular purpose and usually for a set period. The terms of this usage should be set out in a written agreement but may be implied in certain circumstances.

Transfer of IP

Where Intellectual Property ownership is transferred to a third party in return for payment.

OFFICIAL REGISTRATION FEES FOR THE UK IPO*

Intellectual Property	Fee
Trade Mark	From £170 per application (for one class)
Registered Design	£50 for one design £70 for up to 10 designs £20 for up to (and including) 10 subsequent designs
Patent	From £280 for the initial stage of the application **

* These are correct as at November 2018 and do not include any legal fees.

** This is for the initial fee only without professional assistance in drafting and preparing the application, and does not include further fees which will be due and payable as the application proceeds.

ORGANISATIONS

Organisation	What they do
(IPO) Intellectual Property Office	Is the government body responsible for managing Intellectual Property rights including patents, designs, trade marks and copyright in the UK.
(EUIPO) European Intellectual Property Office	Is the organisation responsible for managing EU Trade Marks and registered Community designs.
(WIPO) World Intellectual Property Office	Is the global forum for Intellectual Property services, policy, information and cooperation. It is a self-funded agency of the United Nations, with 191 member states.

CHECKLIST FOR MANAGING IP

Identifying IP	Identifying and maintaining a register of IP in the business. Carry out checks (of registers and in the market place) to ensure new IP does not conflict with third party rights.
Ownership of IP	Ensure that IP belongs to the business or that required licence rights are obtained.
Registration of IP	Consider if the business IP is capable of being registered.
Rights over IP	Consider if the IP is covered by a mortgage or charge over business assets. Record any licences that are granted over your IP to third parties.
Protecting IP	<ul style="list-style-type: none">• Assert rights over IP (i.e. 'Copyright ©2018 Humphries Kirk LLP')• Maintain evidence of creation of new IP• Register IP as appropriate• Periodic checks for infringement (domain names, company names, trade marks)• Take professional advice as required.

Useful Sites

Intellectual Property Office:

www.gov.uk/government/organisations/intellectual-property-office

European Intellectual Property Office:

www.euipo.europa.eu

World Intellectual Property Office:

www.wipo.int/portal/en/index.html

- **Dorchester**
01305 251007
hklaw.eu/dorchester
- **Bournemouth**
01202 421111
- **London**
Meeting Rooms
020 7269 9020
hklaw.eu/london
By appointment only
- **Crewkerne**
01460 279100
- **Poole**
01202 725400
hklaw.eu/poole
- **Parkstone**
01202 715815
- **Swanage**
01929 423301
- **Wareham**
01929 552141



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This short summary of some aspects of Intellectual Property is correct at November 2018 but will be subject to change. This is for general guidance only and does not constitute professional advice. Readers should always take appropriate professional advice before taking any action.