

Intellectual Property Protection

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- Law firm with offices in Brussels, London, Manchester, Paris, Hamburg, Düsseldorf, München, Shanghai and Palo Alto
- Full service but focus on intellectual property ("IP")
- All IP rights (patents, trademarks, copyright, design rights, etcetera)

Importance intellectual property protection

- Intellectual property fosters innovation
- New economy: intangible assets more important than tangible assets
- S&P 500:
 - In the 1970s S&P 500 companies had collective market cap in which 90% was attributable to tangible assets (land, physical infrastructure like industrial plants, equipment, ...)
 - Today, S&P 500 companies have a collective market cap in which 90% is attributable to intangible assets. (patented technology, trademarked brands, copyrighted software, ...)

Intellectual Property Rights (1)

- Many types of intellectual property rights
- Basically two main categories
 - Identifiers
 - Creations
- Identifiers
 - Trademarks
 - Tradenames
 - Domain names
 - Geographical indications
 - ...

Intellectual Property Rights (2)

- Creations
 - Copyright
 - Design rights
 - Neighbouring rights
 - Software
 - Patents
 - Chips
 - Databases
 - Plant varieties
 - ...

Intellectual Property Rights (3)

- Two types of protection
- IP rights which protect creations
 - Absolute
 - Prohibit reproductions
 - Protect creator
 - Limited in time
- IP rights which protect distinctive signs
 - Relative
 - Prohibit use distinctive sign in relation to determined products or services, on condition risk that consumer confused about origin goods or services
 - Protect consumer
 - Unlimited in time

Intellectual Property - Legislation

- No Belgian Code which defines and regulates all intellectual property rights
- Each of the IP rights is subject to a specific legislative regime which can be
 - Belgian (e.g. Belgian Copyright Act)
 - Benelux (e.g. Benelux Convention on IP)
 - EU (e.g. Regulation on Community Trademark)
 - International (e.g. European Patent Convention)

Intellectual Property - Trends

- More and more ad hoc protection regimes
 - Software, chips, databases, ...
- Harmonisation
 - International treaties (WIPO (Paris Convention, Berne Convention), WTO (TRIPS), EU Directives, ...)
- Important role European Court of Justice

Plan

- Introduction to the 'core' IP rights (copyright, trademark rights, patent rights)
- For each of these IP rights
 - Subject matter / Conditions of protection
 - Scope of protection
 - Examples and Practical tips

Copyright - Legal Framework

- National: Belgian Copyright Act (1994)
- Harmonisation:
 - Berne Convention
 - WIPO Copyright Treaty
 - TRIPS
 - 7 European Directives between 1991 and 2001

Copyright - Subject Matter

- “*Literary and artistic works*” (article 1 Copyright Act)
- No definition
- Non-exhaustive enumeration in Berne Convention:
“The expression ‘literary and artistic works’ shall include every production in the literary, scientific and artistic domain, whatever may be the mode or form of its expression, such as books, pamphlets and other writings; lectures, addresses, sermons and other works of the same nature; dramatic or dramatico-musical works; choreographic works and entertainments in dumb show; musical compositions ...; cinematographic works ...; works of drawing, painting, architecture, sculpture, engraving and lithography; photographic works ...; works of applied art; illustrations, maps, plans, sketches and three-dimensional works relative to geography, topography, architecture or science.”

Literary Works (1)

- Books



Literary Works (2)

- **Speeches**

I have a dream that one day the red hill of Georgia, sons of former slaves and sons of former slave-owners will be able to sit down together at the table of brotherhood.

I have a dream that one day, even the state of Mississippi, a state sweltering with the heat of injustice, sweltering with the heat of oppression, will be transformed into an oasis of freedom and justice.

I have a dream my four children will one day live in a nation where they will not be judged by the color of their skin but by the content of their character. I have a dream today”

(M. L. KING, Lincoln Memorial, Washington D.C., August 28, 1963)

Literary Works (3)

- **'characters'**



Literary Works (4)

- Titles and Slogans



Literary Works (5)

- **Formats**



Literary Works (6)

- Software

```
/**
 * Simple HelloButton() method.
 * @version 1.0
 * @author john doe <doe.j@example.com>
 */
HelloButton()
{
    JButton hello = new JButton( "Hello, wor
    hello.addActionListener( new HelloBtnList

    // use the JFrame type until support for t
    // new component is finished
    JFrame frame = new JFrame( "Hello Button"
    Container pane = frame.getContentPane();
    pane.add( hello );
    frame.pack();
    frame.show();           // display the fra
}
```

Autodesk



Artistic Works (1)

- **Paintings**



Artistic Works (2)

- **Sculptures**



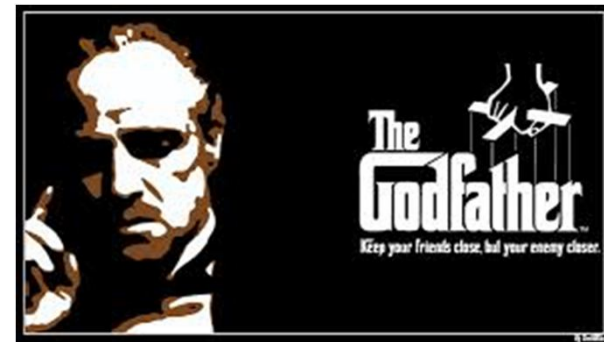
Artistic Works (3)

- **Photographic works**



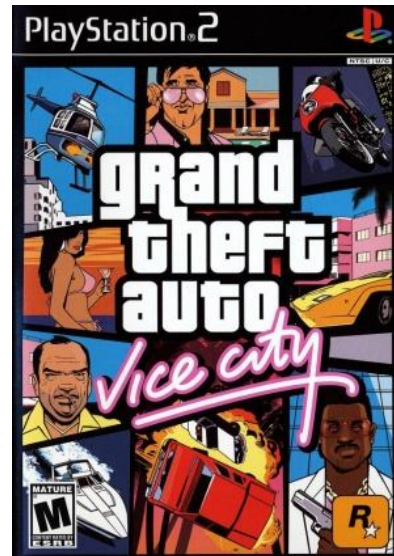
Artistic Works (4)

- Cinematographic works



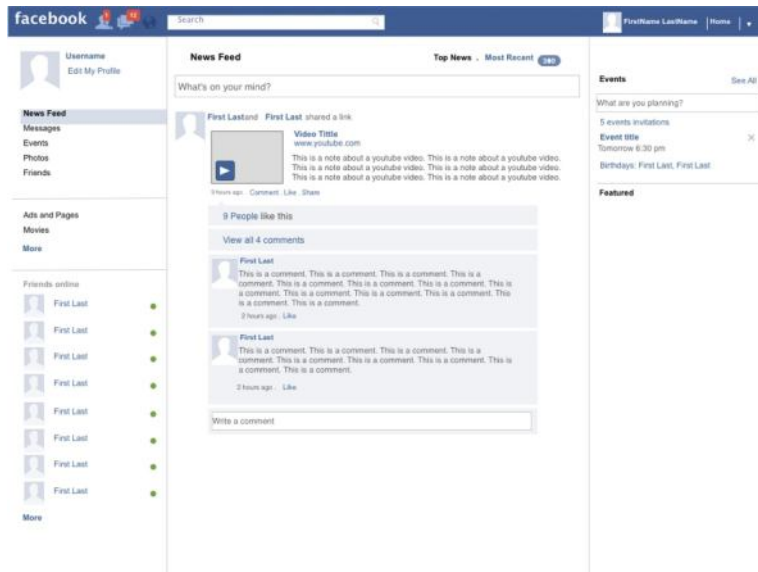
Artistic Works (5)

- Videogames



Artistic Works (6)

- Graphical User Interfaces



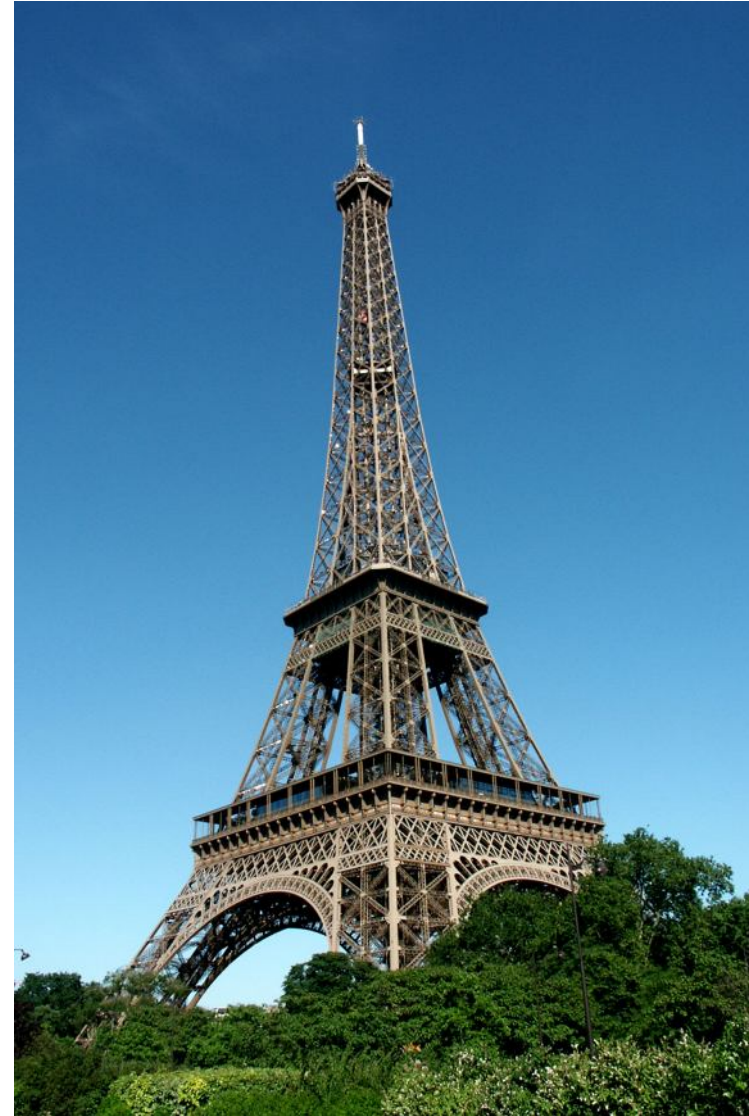
Artistic Works (7)

- **Musical works**



Artistic Works (8)

- **Architectural works**



Artistic Works (9)

- **Fashion**



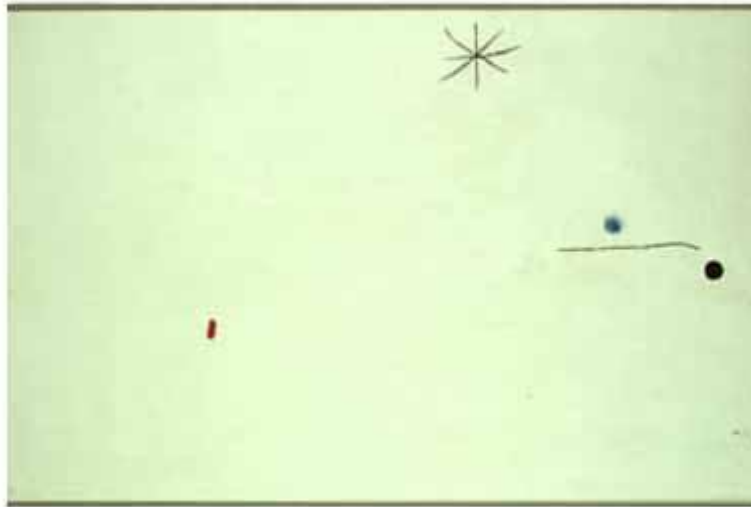
Artistic Works (10)

- **Industrial design**



Copyright – Conditions of Protection

- 2 conditions
 - Expression (No protection for ideas)
 - Originality (« *copyright is liable to apply only in relation to subject-matter which is original in the sense that is the author's own intellectual creation* » (ECJ, 16 July 2009, C-5/08, *Infopaq*)



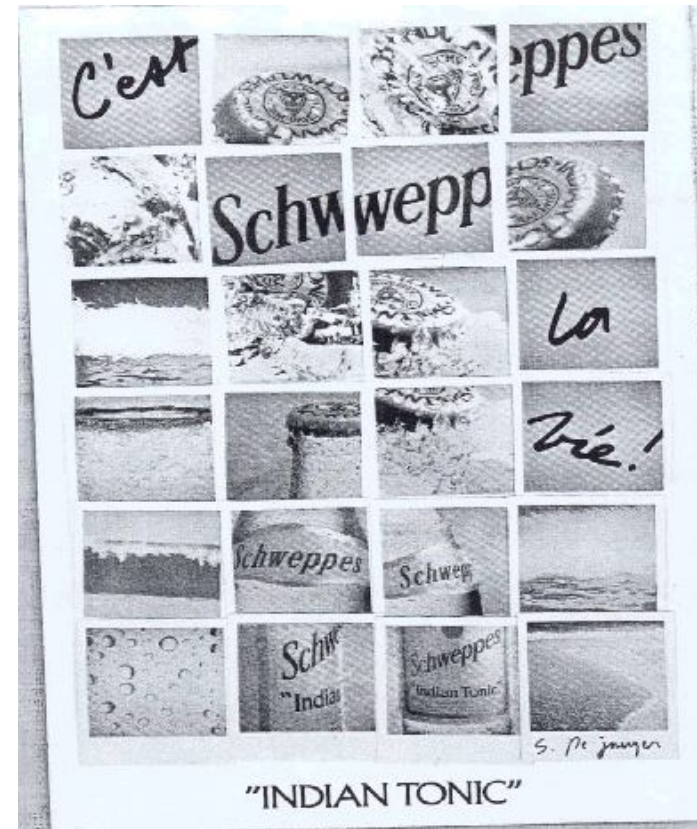
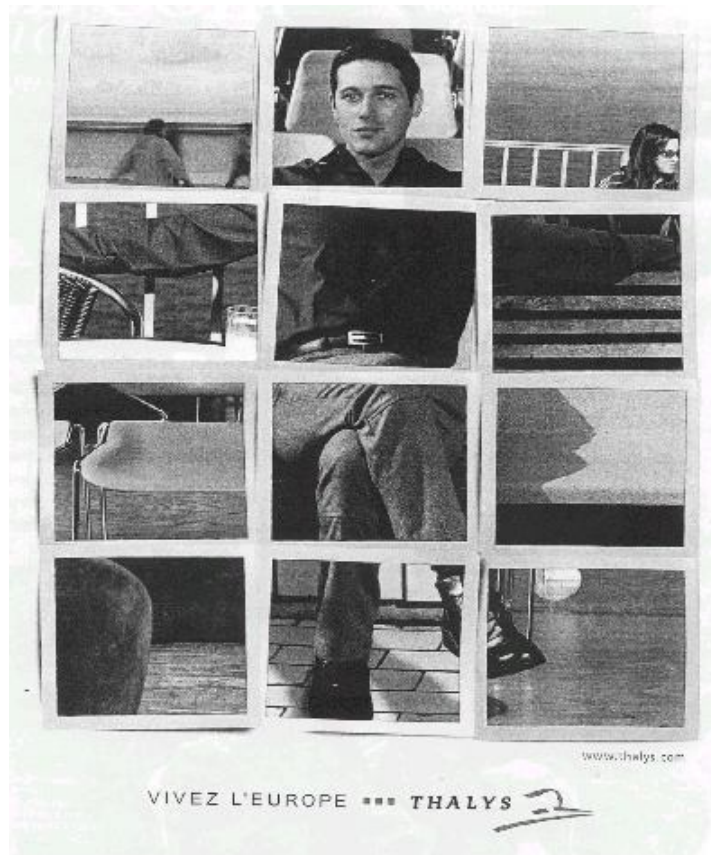
- No formalities

Copyright holder – which rights?

- Economic vs moral rights (paternity right, integrity right, ...)
- Economic rights:
 - Right to authorise or prohibit reproduction
 - Right to authorise or prohibit communication to the public
 - Right to authorise or prohibit distribution
- Economic rights are to be construed broadly (ECJ, 16 July 2009, C-5/08, *Infopaq* ; ECJ, 7 December 2006, C-306/05, *SGAE*)

Reproduction right (1)

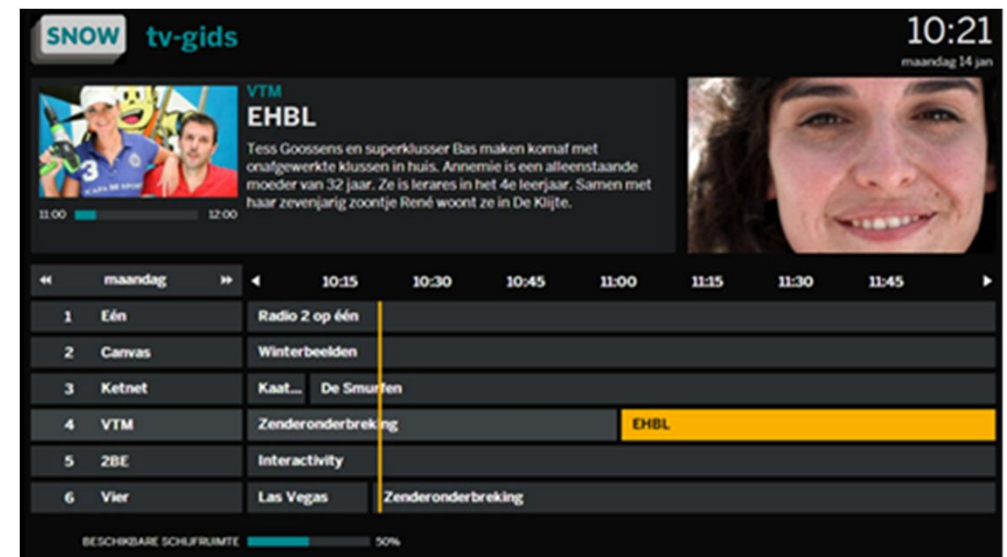
- Not only identical copies of the whole work
 - Part of work
 - Similar (copyright infringement if (some of) the elements which constitute originality of the work are copied)



Reproduction right (2)



Reproduction right (3)



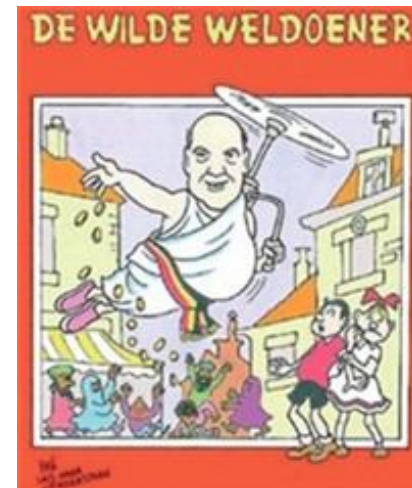
Exceptions (1)

- Citation (article 21, § 1 Copyright Act)

" Citations from a work which has been published in a legitimate way do not infringe upon the copyright if the citations are provided for criticism, review, educational, or scientific purposes and conform with the fair practices of the profession and are justified by the objective pursued. The citations must mention the source and the name of the author."

- Parody (article 22, § 1, 6° Copyright Act) (ECJ, 3 September 2014, C-201/13, *Deckmyn*)

" The authors of works cannot oppose use of their works for the purpose of caricature, parody or pastiche"



Exceptions (2)

- Copying for private use exception (articles 22, §1, 5° and 46, 4° of the Copyright Act)
"The authors of works and the owners of related rights in performances, phonograms, films and broadcasts cannot oppose reproductions of their works and creations which are made from a lawful source and which are made within a household and only destined for that household."



Term

- 70 years *post mortem* author (article 2, § 1 Copyright Act)
- US:



Copyright

- Positive:
 - Low threshold (originality)
 - Absolute right (any reproduction, any communication to the public)
 - No formalities / no registration (fees)
- Negative:
 - Not eternal, but still very longlasting protection
 - No protection against independent creation



Independent creation (1)

Engels en bengels

Hallo,

Dit is mijn winkeltje met allerlei voor de allerkleinsten. Neem gerust een kijkje en aarzel niet om mij te emailen als je vragen hebt. Alles is in nieuw of zo goed als (zonder vlekken of verkleuringen). Veel plezier!

Boeffies & (B)engeltjes

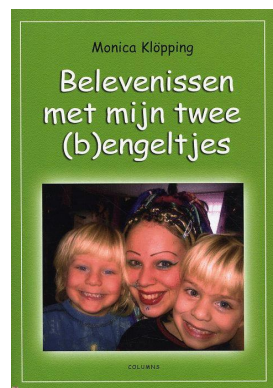


(b)engeltjes



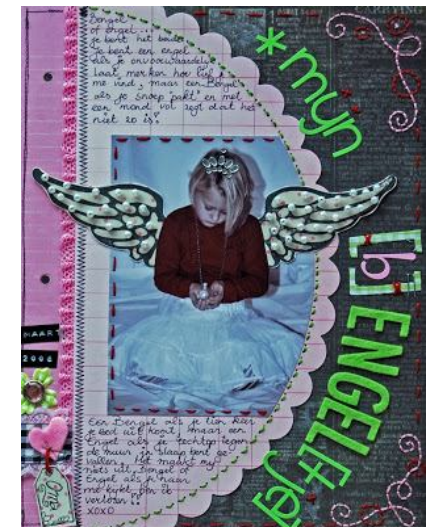
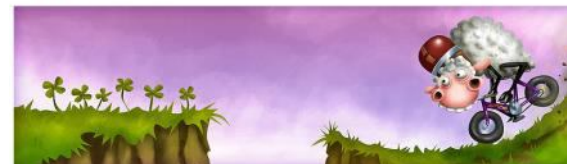
EngeltjeBengeltje.com

engels en bengels
kinderfotografie

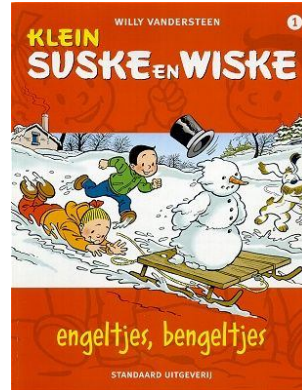


Engel & Bengel

Engeltjes-en-bengeltjes
Regelmatig een bengeltje meer



Independent creation (2)



Engeltjes
& Bengeltjes



Kinderkoor De zingende B'Engels

Bengeltjes of engeltjes?

Met (b)engeltje nr. 1 lopend in het rond verheugen wij ons op (b)engeltje nr. 2 die begin januari in ons leven komt.

KDV De B'Engeltjes

Engeltjes & Bengeltjes Tweedehands kinderkleding



(B)engeltjes

Trademarks – Legal Framework

- No Belgian trademarks
- Benelux trademarks (Benelux Treaty on IP) (harmonised by EU Directive)
- Community trademarks (Regulation on the Community trade mark)
- Important role European Court of Justice

Specialty

- Protection is limited to the goods and services for which the trade mark has been registered



Registration (1)

- Under trade mark law (contrary to copyright law), registration is required to be able to enforce trade mark rights
- Registration is important but not required to make use of the trade mark
- Too many registrations
- Registration should be the result of thought-out decisions because:
 - Registration (240 EUR Benelux; 900 EUR CTM)/Renewal/Monitoring are costly and timeconsuming
 - Each registration creates 'paper' conflicts that also take time and money to resolve
- Good management of trade mark portfolio includes:
 - No registration for signs which are not a trade mark
 - Think twice when registering signs which are also copyright protected
 - Think twice to register trade marks which have a very limited scope of protection (don't create false expectations)
 - Only register for limited number of goods and services

Registration (2)

- Classes

List of Goods and Services by Class Order

Goods

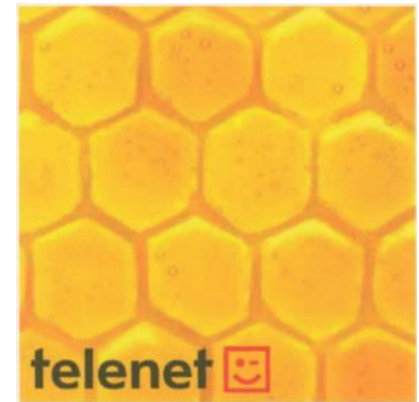
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Services

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Registration (3)



What is a trademark? (1)

- Any sign capable of distinguishing the goods or services of one undertaking from those of other undertakings
- All sorts of signs:
 - Words
 - Figurative signs
 - Combination of words and figurative elements
 - Packaging
 - Shapes
 - Sounds
 - Colors
 - ...

What is a trademark? (2)

- (invented or existing) Words, numbers, names, slogans, etc.
 - Apple
 - Mercedes
 - BMW
 - X3
 - 501
 - Eddy Merckx
 - Mannen Weten Waarom
 - ...

What is a trademark? (3)

- Logo's, pictures, designs, portraits



What is a trademark? (4)

- Combinations of words and figurative elements



What is a trademark? (5)

- Packaging

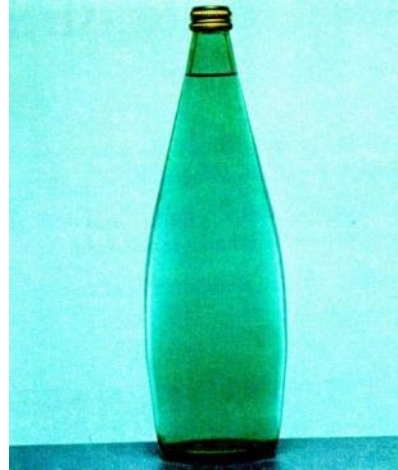


« Het merk bestaat uit het beeld van het geheel van een cilindrische verpakking, zoals afgebeeld, gezien vanuit verschillende hoeken, inclusief de vorm »



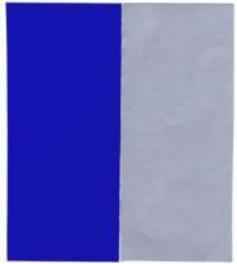
What is a trademark? (6)

- The shape of goods



What is a trademark? (7)

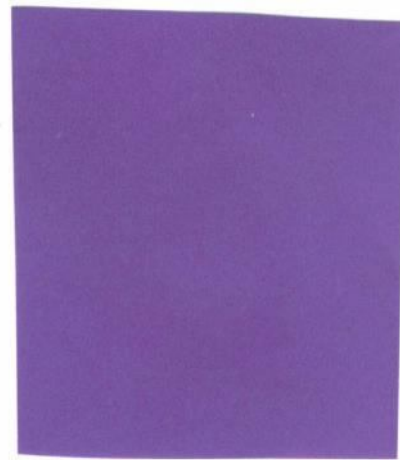
- Colors and color combinations



Red Bull



Deutsche Telekom



Kraft

What is a trademark? (8)

- Sounds, jingles



Nokia



Vodafone

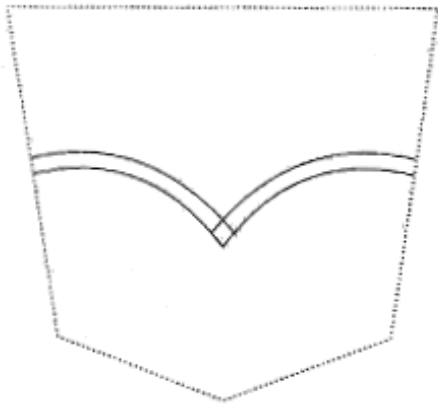


McDonald's



What is a trademark? (9)

- Position marks



The design of two curved lines positioned in the design of a pocket



The trademark consists of the colour red (Pantone 18.1663TP) applied to the sole of a shoe as shown (the outline of the shoe is therefore not part of the trademark but serves to show the positioning of the trademark)

What is a trademark? (10)

- Any sign capable of distinguishing the goods or services of one undertaking from those of other undertakings
- Some signs cannot function as a trade mark because they designate a characteristic of the goods/services concerned
- Is a relative concept: descriptive for certain goods or services but not for others



OK for computers

Not OK for fruit juice

What is a trademark? (11)

- Descriptive sign not OK – Suggestive sign OK (refers in an indirect way to a characteristic of the goods/services concerned).
- Difference? Descriptive for Benelux Trade Marks Office / Suggestive for Brussels Court of Appeal
 - « WIJ GAAN VOOR VERS » « CLEAR'INVOICE » « SUMMERSKIN »
- Suggestive trademarks can be registered but limited scope of protection because you cannot oppose descriptive uses



What is a trademark? (12)

- Fantasy names are easier to protect and have larger scope of protection (but – in the beginning – commercially less interesting)



What is a trademark? (13)

- If doubts whether trade mark will be accepted, one can add word/color/figurative element but:
 - *"However, merely presenting a descriptive term in coloured letters, inclined, in a frame, with standard ornaments or with other non-distinctive graphic elements cannot render the mark distinctive".*
 - By the same token protection will be decreased
 - No sense to add distinctive elements to descriptive words trying to obtain protection for descriptive words



What is a trademark? (14)

- Sign which is descriptive can become valid trade mark if it acquires secondary meaning

GAZET VAN ANTWERPEN

AIR FRANCE



BOER & TUINDER

What is a trademark? (15)

- Becoming generic term

Trampoline

Cornflakes

Aspirine

Nylon

Claxon

Yo Yo

Kerosone

What is a trademark? (16)

**There is
no such thing
as a
xerox.**

You can't make a xerox. You can't go to the xerox.
And you can't xerox anything. Ever.

You can make copies on the Xerox copier.

You can go to the Xerox copier or to a Xerox computer.

You can read a Xerox textbook.

It's taken us a lot of years to get our good name. And we
intend to keep it. So we thought we ought to tell you how to
use Xerox.

When referring to our trademark Xerox, it should always be
followed by the descriptive word for the particular product,
such as "Xerox copier" or "Xerox computer" or "Xerox textbook."

You know the old saying, "We don't care what you say
about us as long as you spell our name correctly?"

Well, we do care.

Spell it right. But please use it right, too.

XEROX

P. S. Please make copies of this.

Is my trademark available? (1)

- No similar earlier trade marks which have been registered/used for similar products/services
- Not only important for registration, but even more important for use

Is my trademark available? (2)

- Available to all:
 - Benelux (<http://register.boip.int/>): 3 registers (BX – International – CTM)
 - CTM (oami.europa.eu/CTMOnline/RequestManager/en_SearchBasic)
 - EU (<http://www.tmview.europa.eu/tmview/advancedSearch.html>): 37 countries
 - WIPO (<http://www.wipo.int/romarin>)
 - Company names (<http://kbopub.economie.fgov.be/kbopub/zoekwoordenform.html>)
 - Domain names (www.dns.be, www.eurid.eu, ...)
 - Search in Google!
- Professional databases (Saegis, Edital,...)
- Important: obligation to use after five years !

Is my trademark admissible?

- Not all shapes
- No flags / state emblems
- Not contrary to public policy or accepted principles of morality (BIN LADEN)
- Not misleading as to, for example, geographical origin goods



Term

- Potentially eternal (to be renewed every 10 years)

What can I do with my trademark?

- Different types of protection for trademarks
- Some provisions are concerned with the protection of the essential function of a trademark
 - The consumer could believe that the goods or services marketed under the infringing sign originate from the owner of the trademark or an undertaking economically linked to the trademark owner
- Other provisions are concerned with the protection of goodwill attached to a trademark
 - The use of the infringing sign takes unfair advantage of or is detrimental to the distinctive character or repute of the trademark

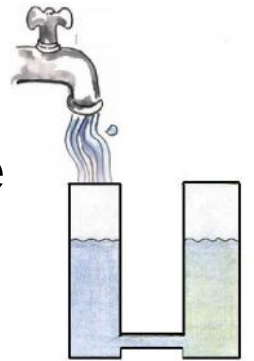
Protection of essential function (1)

- Scenario 1 (double identity):
 - Sign identical to trade mark
 - used in relation to goods or services which are identical with those for which the trademark is registered
- Coca-Cola registered for drinks and used against someone who uses Coca-Cola for drinks



Protection of essential function (2)

- Scenario 2 ('likelihood of confusion')
- The risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion
 - identity or similarity between the signs
 - identity or similarity of the goods or services
- Mobistar registered for telecommunication services pour des services de télécommunication
- against
- Mobitel for telecommunication services
- Mobistar for computers



Protection of goodwill

- Broader protection:
 - also protected against signs which are used for goods or services which are not similar
 - no likelihood of confusion required; association sufficient
- But only if:
 - trademark has a reputation
 - And use of the sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trademark

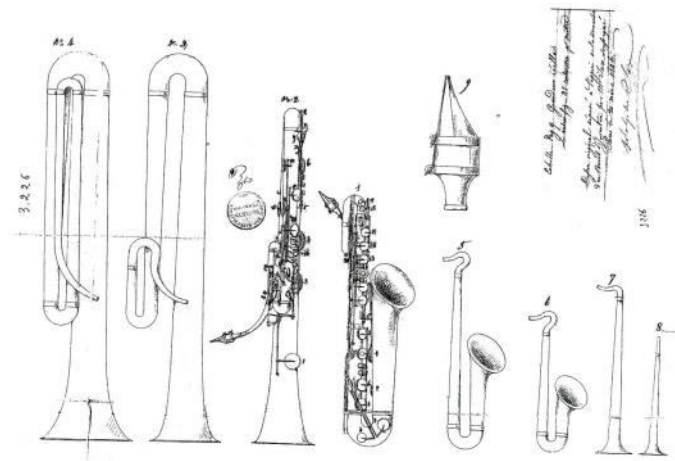
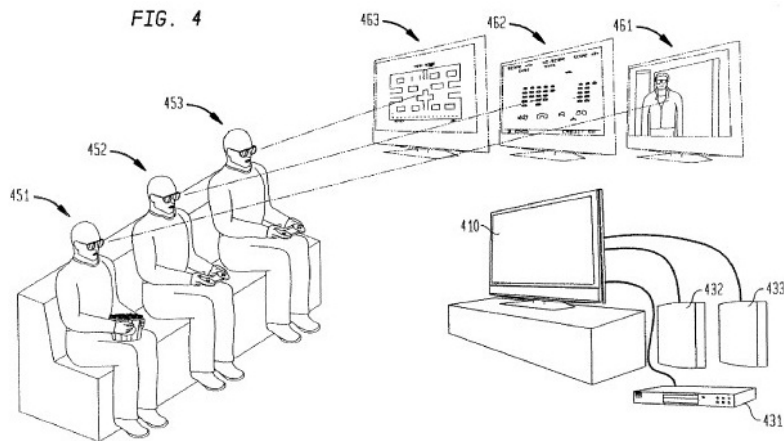


Patent Law – Legal Framework

- National: Belgian Patent Act (1984)
- Harmonisation / International
 - Patent Cooperation Treaty (PCT)
 - European Patent Convention

Subject matter (1)

- Subject matter
 - Inventions : technical solution to a technical problem
 - Process or product



Subject matter (2)

- Not considered inventions:
 - discoveries, scientific theories and mathematical methods;
 - aesthetic creations;
 - schemes, rules and methods for performing mental acts, playing games or doing business, and programs for computers;
 - presentations of information;
 - plant or animal varieties;
 - methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body; this provision shall not apply to products, in particular substances or compositions, for use in any of these methods.

Conditions (1)

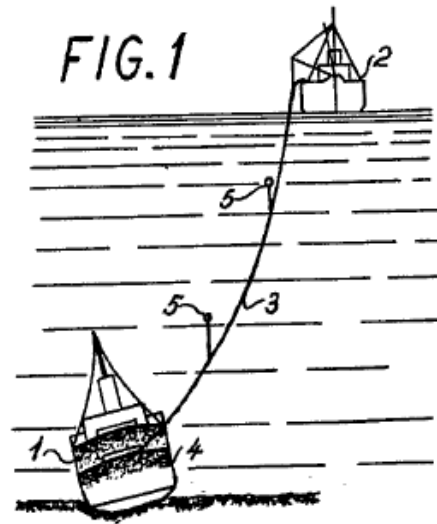
- Novelty: « *An invention shall be considered to be new if it does not form part of the state of the art. »*
- “ *The state of the art shall be held to comprise everything made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing of the European patent application. »*
- Absolute condition:
 - Wherever in the world
 - Whatever language
- Pay attention to your own disclosures!

Conditions (2)

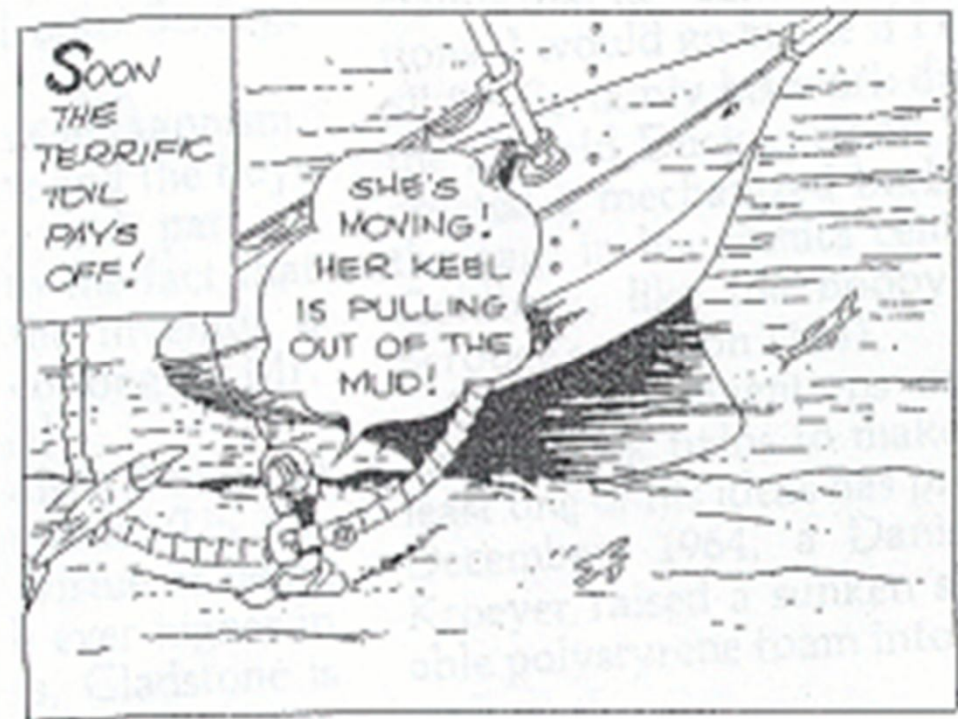
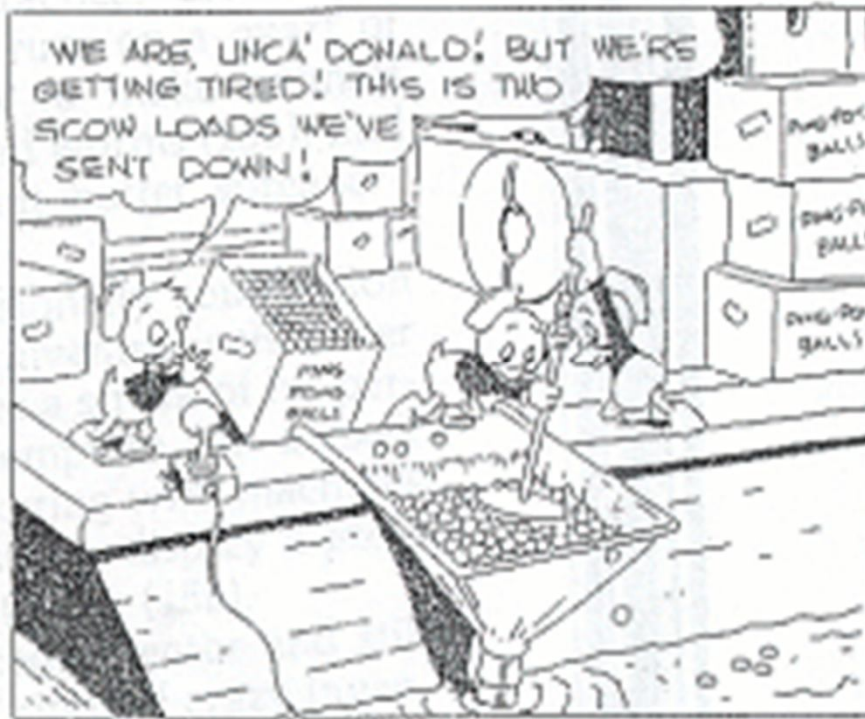
- Example

NL 6514306

“buoyant bodies 1 are inserted into a sunken vessel 4 through a tube 3 from a salvage ship 2.”



Conditions (3)



'The Sunken Yacht', © 1949 Walt Disney

Conditions (4)

- Inventive step (« tiens »): « *An invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art.* »
- Novelty « compact » : all elements in one and the same document
- Inventive step: elements can come from different documents if person skilled in the art would have combined them

Application

- Patent applications are examined by Patent Office (EPO, USPTO etc.)
- Filing Fee + annual fees
- Cost varies in function of territory
- Different ways

What can I do with my patent?

- Real monopoly:
- Patent gives you right to prevent third parties from:
 - Using your invention
 - Helping others to use your invention
- Term: 20 years as from filing of the application
- Thereafter: Public domain (longer term for medicinal products)
- Very few exceptions:
 - Private use;
 - Research;
 - Personal possession.

Patents

- Positive:
 - Strong monopoly
 - Stronger than copyright: also against independent creation
 - Interesting tax treatment (PID)
- Negative:
 - Costly
 - Complex
 - Rather short term

Common mistakes

- Failing to document ownership/assignment
- False impression of “Public domain”
- Missing out on opportunities for protection
- Taking granted patents for granted
- Choosing a bad name

Failing to document ownership/assignment (1)

- Problem:
 - IPR are always created by human minds
 - IPR most of the time belong to companies
- Solution: properly document assignment to the company
- Easy for some rights:
 - Trademarks: belong to the company who files
 - Patents: usually belongs to the employer by law (or proper assignments will be documented during the patent prosecution process)
- Copyright assignments must be documented in writing (except for software when created by an employee)



Failing to document ownership/assignment (2)

STAR WARS HELMET SAGA



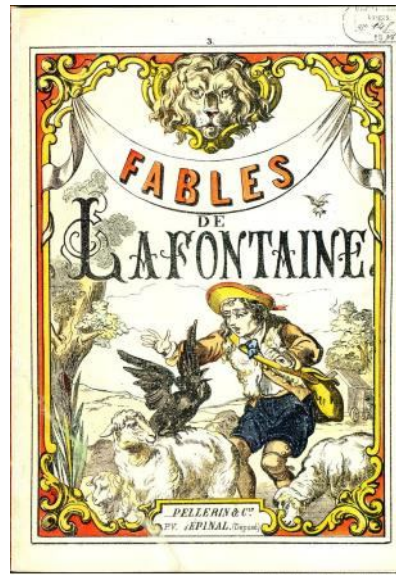
- Mr Ainsworth recalls: « *I made a prototype and Lucas said 'great, I'll have 50'.* »
- Legal battle in the US / UK

Failing to document ownership/assignment (3)

- Computer software
 - Employee deemed to assigned rights to employer
 - BUT : restrictive definition of “employee”
 - Cass 3 June 2010: 
 - DocToKeep : computer program assisting in archiving and retrieving critical information throughout his organisation
 - Created by Mr. H who was the manager (“gérant”) of Area Productions sprl
 - No agreement dealing with copyright between Mr. H en AP
 - Area Productions goes bankrupt
 - Receiver sells the software to 
 - Mr H claims that Dekimo infringes his copyrights
 - Mr H had not assigned his rights and the legal presumption does not apply

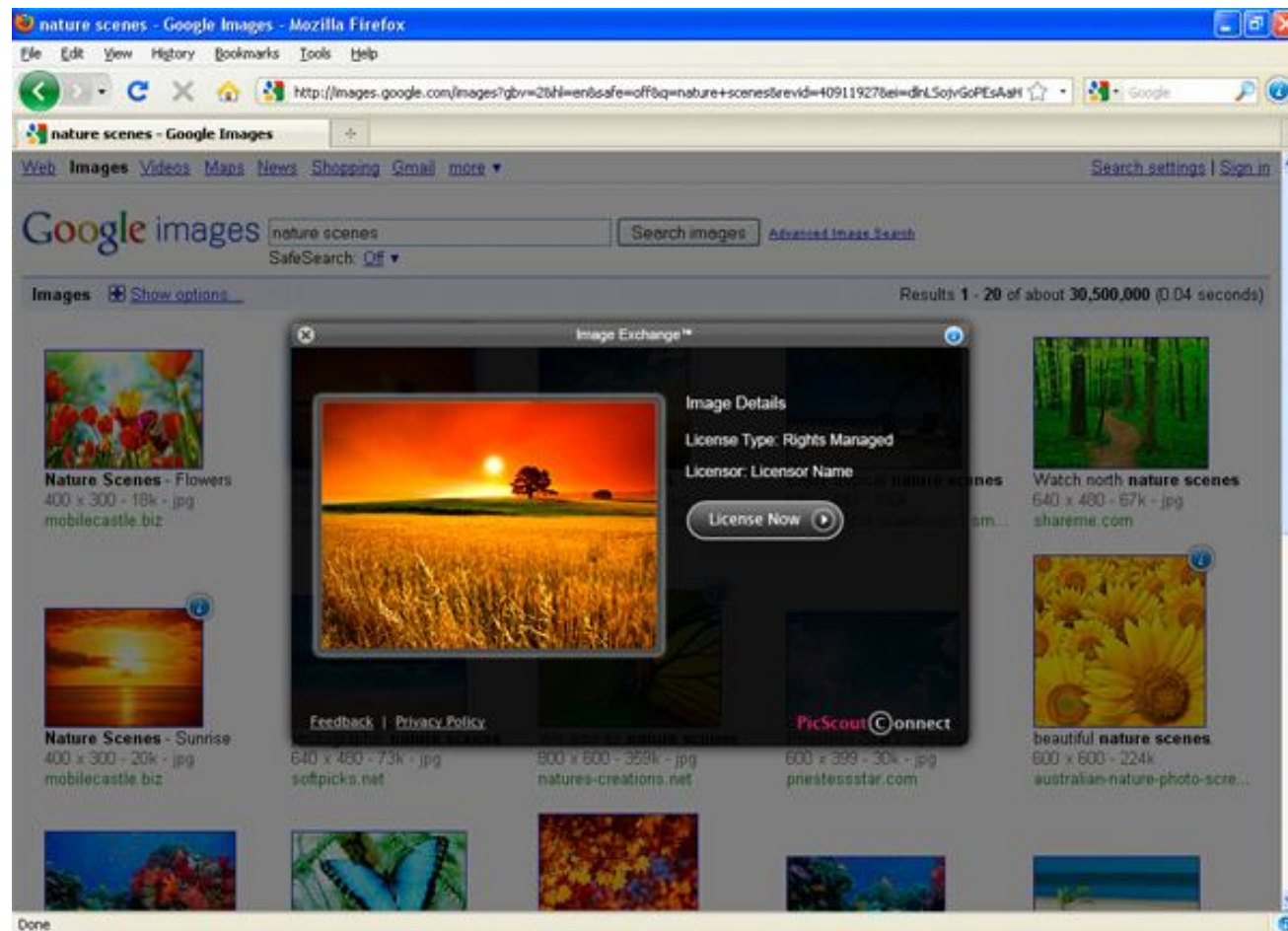
False impression of “Public domain” (1)

- What is public domain ?
 - Creations that are not original enough or that are too old (70 years post mortem)
 - So... very few things...



False impression of “Public domain” (2)

- Available on “Google Images” >< public domain
 - Getty Images:



Missing out on opportunities for protection

- Copyright or database rights :
 - never an issue because rights are acquired automatically
- But this is not true for other rights
 - Patents : invention must be new
 - Novelty is very strict (publication in any form, any language, any place)
 - Even your own publication !
 - >< 1 year “grace period” in the US
 - Patents : invention must be “inventive” (non-obvious)
 - Engineers perception of obviousness >< legal requirement
 - Create an “invention policy” (invention disclosure + patent board)

Taking granted patents for granted (1)

- The conditions for patentability (novelty and non-obviousness) are examined by the patent office (EPO)
- Natural tendency to accept them as “valid”
- BUT they can be revoked before courts
- Examiners often miss out on “prior art”
- Do not take them for valid unless you have independently investigated their validity !

Taking granted patents for granted (2)

Claims

1. A method of manufacturing a doughnut, comprising two spraying steps in which a proven yeast dough mixture product is coated with cooking fat, and an intervening baking step.

Taking granted patents for granted (3)

EASY BREAD MAKING FOR SPECIAL DIETS

Wheat-free, Milk- and Lactose-free,
Egg-free, Gluten-free, Yeast-free, Sugar-free,
Low Fat, High or Low Fiber, Low Sodium,
Diabetic, and Low Calorie

Use your bread machine,
food processor, or mixer to make the bread
YOU need quickly and easily

By
Nicolette M. Dumke

Taking granted patents for granted (4)

SWEET ROLLS AND DOUGHNUTS

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Heart Healthy Doughnuts

Ingredients:

1 batch of any sweet roll dough, pages 217 to 221
Cooking oil spray
1 batch of any doughnut topping or frosting,
pages 228 to 230 (optional)

Cycle: Dough cycle. When the cycle is finished, roll the dough out to about $\frac{1}{2}$ " thickness on a lightly oiled board with an oiled rolling pin. Cut into doughnuts with a floured doughnut cutter. Lightly oil a baking sheet or spray it with cooking oil spray. Transfer the doughnuts to the sheet with a spatula and spray them lightly with cooking oil spray. Let them rise in a warm place until double, about 30 to 40 minutes. Bake at 375°F for 10 to 15 minutes, or until the doughnuts are just beginning to brown. Spray both the top and bottom of each doughnut lightly with cooking oil spray and immediately shake them in one of the toppings below. Or, if you wish to frost them, allow them to cool before frosting them with one of the frostings below.

Nutritional Analysis: Essentially the same as for the dough used. Divide the whole batch values for the dough used by the number of doughnuts made to get the values for each doughnut.

Diabetic exchanges per doughnut: Divide the number of exchanges for a whole batch of the dough used by the number of doughnuts made to get the exchanges per serving.

Choosing a bad name

- Think about your brand in other languages
 - Chevy **Nova** → Chevy Caribe in Latin American countries
 - Mazda **Laputa**
 - “**Gerber**” for Baby Food
 - “**Gossamer**” for condoms