



IP Instruments for a European Strategy

I. The Importance of Intellectual Property Rights

- Economic success is based on intellectual property.
- Intellectual property and intangible assets are considered the cornerstone of the value and growth of companies.
- The global economy is based on trade in intellectual (property) rights.

Problems:

- Awareness
- Classification
- Protection
- Evaluation



II. AWARENESS

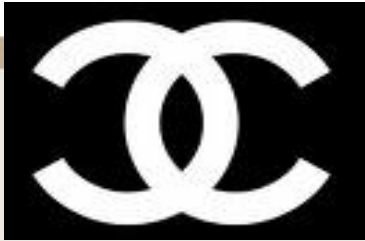
IP rights are important because they :

- Protect your inventions (and investments)
- Facilitate market penetration
- Protect your market share
- Avoid disputes
- ...

III. CLASSIFICATION

1. Types of rights

- Regulated – unregulated rights
- Traditional – new rights
- Registered – unregistered rights
- National (or Benelux) - Community rights
- Harmonized - unharmonized rights



2. List of intellectual property rights*

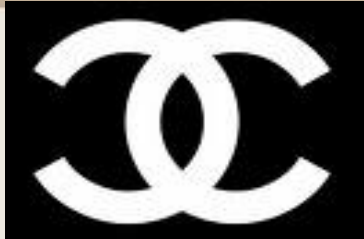
2.1 National (or Benelux) and Community trade marks

- Applicable legislation: national laws or the Benelux Convention on Intellectual Property (Trademarks and Designs) of 25 February 2005 (harmonised by Directive 2008/95/EC of 22 October 2008 to approximate the laws of the Member States relating to trade marks) as well as Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark
- Object of protection: sign used to distinguish goods or services as originating from a given entity.
- Conditions for protection: able to be represented graphically– capable of distinguishing goods or services

* Note: this list constitutes only a brief summary of certain basic principles and in no way purports to cover all of the applicable rules and exceptions, which are often complex.



● *NautaDutilh*

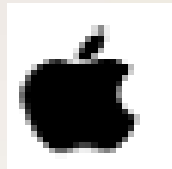


- Mandatory formality: registration with the competent national (or Benelux) office or with the Office of Harmonisation for the Internal Market (OHIM)
- Term of protection: unlimited, provided the registration is renewed
- Particular characteristic: principle of speciality (a mark is only protected for its specific use)
- Special precautions: verify availability of the sign before using it as a trade mark, use the registered mark, monitor potential infringements



- Numerous types of signs can be used and protected as trade marks:
 - Word marks: words with or without meaning but which are both visually and aurally significant to the relevant public (e.g. Dior, Chanel N° 5, Quick, the slogan "Jupiler, men know why").

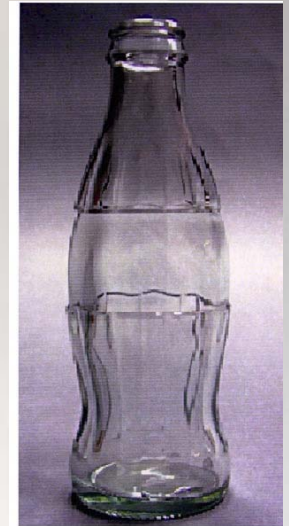
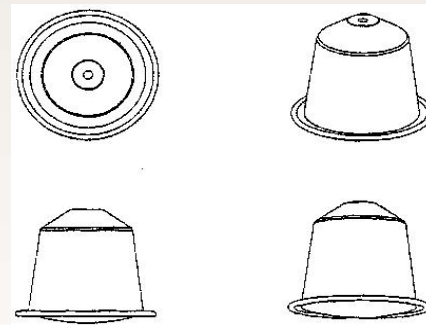
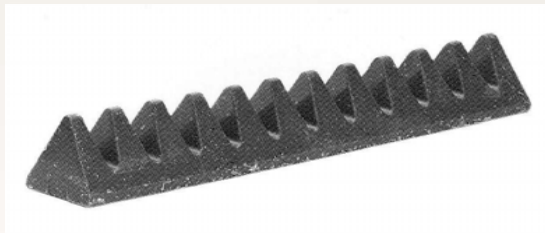
- Figurative or graphic marks (logos): trade marks with a visual aspect only



- Complex trade marks : trade marks that combine words with figurative elements



- Sounds
- Three-dimensional signs



- Colours or combinations of colours

Signs which cannot be protected as trade marks:

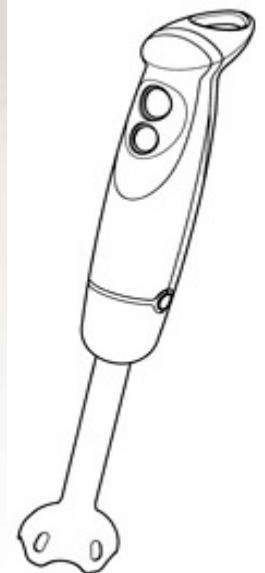
- Signs required by the very nature of the product (e.g. an octagonally shaped box for cheese or a crate for beer)
- Signs that give substantial value to the product (e.g. a shell shape for children's swimming pools and sand boxes)
- Signs necessary to obtain a technical result (e.g. the shape of the Philips' razor head)

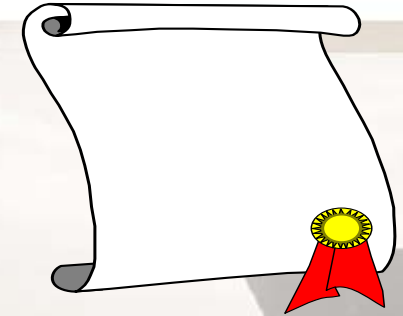


2.2 National (or Benelux) and Community designs & models

- Applicable legislation: national laws or the Benelux Convention on Intellectual Property (Trademarks and Designs) of 25 February 2005 (harmonised by Directive 98/71/EC of 13 October 1998 on the legal protection of designs) as well as Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs.
- Object of protection: the appearance of the whole or a part of a product
- Conditions for protection: new (no identical design or model has previously been disclosed to the public) and individual character (the overall impression it produces on an informed user differs from that produced by any other design or model made public before the registration date)
- Mandatory formality: registration (exception: unregistered Community design or model)
- Term of protection: the unregistered Community model three years as from the date on which the design was first made available to the public within the community
- Special precaution: take steps to avoid copying

1.1





2.3 National and European patents

- Applicable legislation: National Patent Laws, Regulation (EC) No 469/2009 of 6 May 2009 concerning the supplementary protection certificate for medicinal products, the Patent Cooperation Treaty (19 June 1970), and the European Patent Convention (14th edition, 2010).
- Object of protection: a new invention
- Conditions for protection: an exclusive and temporary right of use is granted for any invention that is novel, entails an inventive step and is capable of industrial application.
- Mandatory formality: registration at national or at European level
- Term of protection: 20 years
- Special precautions: never disclose an invention before filing the patent application; if communication with a third party is necessary, have that party sign a confidentiality clause.



2.4 Copyright

- Applicable legislation: national laws (partially harmonised) and various international treaties
- Object of protection: the form of an original literary or artistic work
- Conditions for protection: originality and fixation
- No formalities
- Term of protection: 70 years from the author's death
- Right holder: the natural person that created the work
- Special precautions:
 - conserve proof of the date of creation of the work
 - organise assignments of copyright vis-à-vis employees and service providers (advertising agency, etc.)
 - take steps to avoid copying



2.5 Designation of origin

- Applicable legislation: national laws and Regulation (EC) of 20 March 2006 on the protection of geographic indications and designations of origin for agricultural products and foodstuffs
- Object of protection: name that characterises products from a given region that display certain precise features and that are dependant on the region and the land. Such designations are determined per Member State and can only be used for products that strictly meet the conditions for use



BRIE DE MEAUX

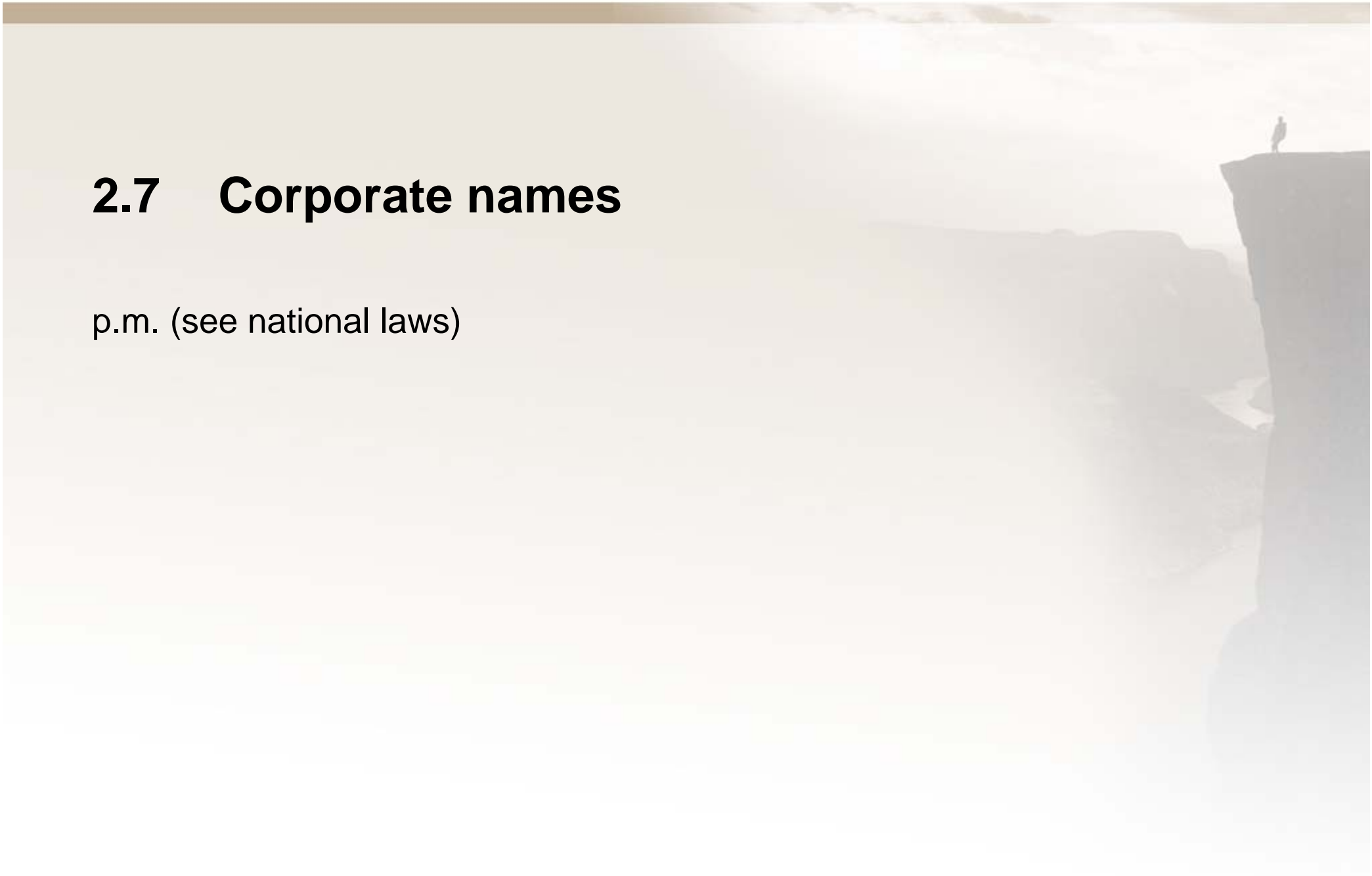


2.6 Trade names

- Applicable legislation: national laws
- Object of protection: name under which a person carries on a trade. A trade name has both an *identifying* function (i.e., it serves to distinguish the company from others) and a *publicity* function.
- The right arises from the first public use made of the name.
- No formal registration requirement.
- Scope of geographic protection: area in which the company is known
- Special precaution: check the availability of a given trade name against existing trade names, company names and trade marks.

2.7 Corporate names

p.m. (see national laws)





2.8 Semi-conductor chips

- Applicable legislation: national laws, Directive 87/54/EEC of the Council of 16 December 1986, WIPO Treaty on Intellectual Property in Respect of Integrated Circuits of 26 May 1989
- Object of protection: the specific design - the topography – of the chip, that is the three-dimensional model obtained through the superposition of the different layers
- Rights conferred: exclusive right to reproduce and exploit commercially and to prevent any other person from doing so without consent.
- The right arises when the topography is fixed or encoded for the first time.
- Possibility of copyright protection if the conditions are met.

- Conditions: an intellectual effort by the creator and not commonplace in the semi-conductor industry.
- Formalities: none
- Term: ten years from the end of the calendar year in the course of which the topography is commercially exploited for the first time, anywhere in the world. Such use must occur within 15 years following creation of the right.



2.9 Computer programs

- Applicable legislation: national laws transposing Directive 91/250/EEC of 14 May 1991 on the legal protection of computer programs
- Object of protection: computer programs, including preparatory design work, are protected by copyright and treated as literary works
- Conditions for protection: originality and fixation (any form of expression is covered)
- Registration is not required.
- Term of protection : 70 years from the author's death
- The employer shall be entitled to exercise all economic rights in computer programs created by its employees.
- Note: under certain conditions, patent protection is also possible
- Special precaution: take steps to avoid copying



2.10 Databases

- Applicable legislation: national laws transposing Directive 96/98/EC of 11 March 1996 on the legal protection of databases.
- Object of protection: possibility of twofold protection
 - 1) the content of the database (*sui generis* right);
 - 2) the structure of the database, the manner in which the data are selected and arranged (copyright)
- Rights conferred:
 - 1) right to prevent another from using or copying the contents of the database
 - 2) application of copyright rules
- Conditions:
 - 1) a substantial qualitative or quantitative investment
 - 2) the database must be original

- Formalities: none
- Term of protection:
 - 1) 15 years from 1st January of the year that follows the date of completion of the making of the database; renewable if the contents are substantially modified in a way that indicates a new substantial investment
 - 2) 70 years from the author's death.
- Special precaution: take steps to avoid copying

2.11 Trade secrets

p.m. (see national laws)



2.12 Know-how

p.m. (see national laws)



Questions to be asked:

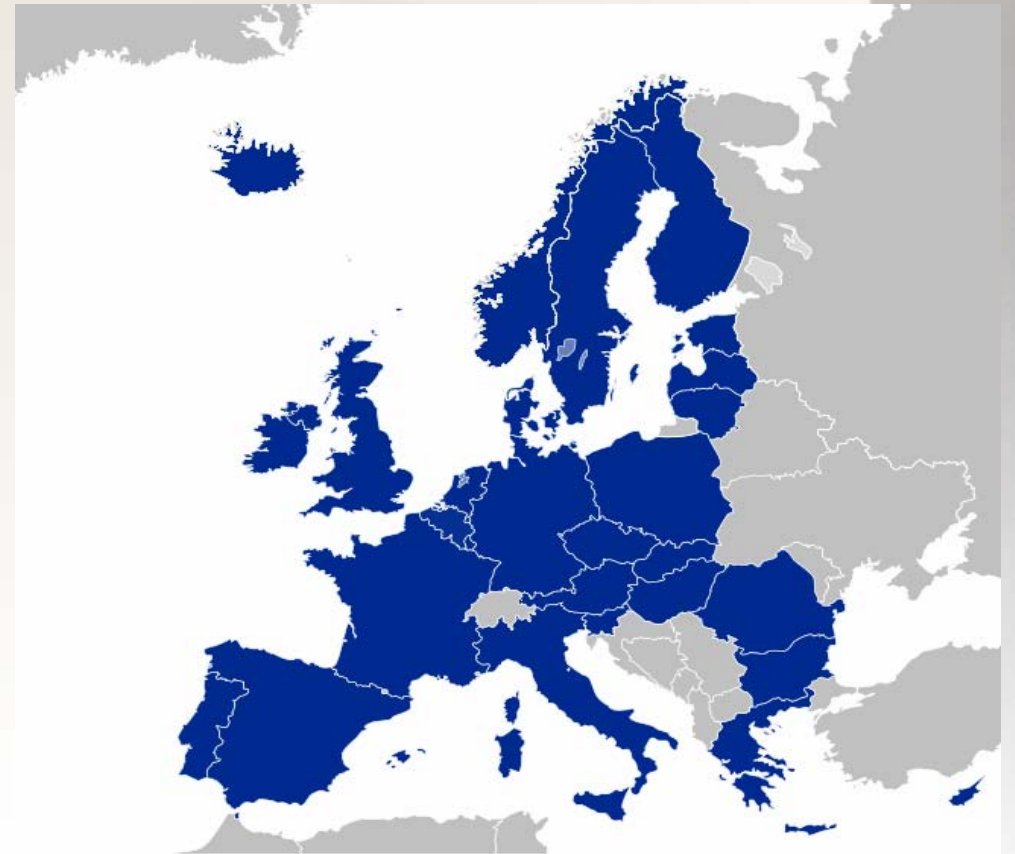
- Does the company use this IP right?
- Is this IP right protected? If so, how?
- Is this IP right registered?
- Who is the holder of this IP right?
- Does the company have IP rights which it does not currently use?
- Is there a possibility to make these IP rights profitable by granting licences to third parties?
- Is there a risk of litigation: threats by third parties or infringements committed by third parties?
- What is the importance of this IP right for the company? Is the investment justified?
- Is it necessary to evaluate this IP right?

IV. SPECIFIC ISSUE ABOUT PROTECTION

Parallel import and exhaustion of IP Rights

Exhaustion

- EFTA Court, 08.07.2008
E-9/07 (L'Oréal)
- EEA = 30 States



Parallel import and exhaustion of IP Rights

- Principle of exhaustion (Silhouette (16/07/1998), C-355/96 : Community, not international)
- Goods for which consent is requested (Sebago (01/07/1999), C-173/98: consent must relate to each individual item)
- Forms of consent (Davidoff, Levi Strauss (20/11/2001), C-414-416/99 : no implied consent, unless unequivocal facts demonstrate waiver of right to oppose placement of the goods on the market)
- Burden of proof re. consent (Van Doren (08/04/2003), C-244/00 : in principle parallel importer)

Parallel import and exhaustion of IP Rights

- Notion of putting on the market (Peak Holding (13/11/2004), C-16/03 : No 'putting on the market' if the TM holder has imported the goods into the EEA with a view to selling them there or if they have been offered for sale in the TM holder's own shops or those of an associated company, without actually selling them. The stipulation in a contract of sale concluded between the TM holder and an operator established within the EEA, of a prohibition of reselling in the EEA, does not mean that there is no 'putting on the market')
- Notion of transit
 - *Class International (18/10/05), C-405/03 (original goods bearing the mark which had not already been put on the market in the Community previously by the trademark proprietor or with his consent, placed under the external transit procedure or the customs warehousing procedure are not 'offered' or 'put on the market' in the Community, unless it necessarily entails the putting of those goods on the market)

Parallel import and exhaustion of IP Rights

**Montex* (09/11/2006) - C-281/05

Poland → Germany → Ireland
TM no TM
seizure

EC Reg 1383/03

A trade mark proprietor can prohibit the transit through a Member State [in which its mark is protected] of unauthentic goods IF they are subject to the act of a third party while they are placed under the external transit procedure which necessarily entails their being put on the market in the Member State of transit” (para. 23)

It is in that regard, in principle, irrelevant whether goods whose destination is a Member State come from an associated State or a third country, or whether those goods have been manufactured in the country of origin lawfully or in infringement of the existing trade mark rights of the proprietor in that country.

Parallel import and exhaustion of IP Rights

*Antwerp Court of First Instance, 4 November 2009, 02/7600/A (*Philips*) (C-446/09)

Does Article 6(2)(b) of Regulation (EC) No 3295/94 of 22 December 1994 (the old Customs Regulation) constitute a uniform rule of Community law which must be taken into account by the court of the Member State which, in accordance with Article 7 of the Regulation, has been approached by the holder of an intellectual-property right, and does that rule imply that, in making its decision, the court may not take into account the temporary storage status/transit status and must apply the fiction that the goods were manufactured in that same Member State, and must then decide, by applying the law of that Member State, whether those goods infringe the intellectual-property right in question?

Parallel import and exhaustion of IP Rights

*UK Court of Appeal, November 2009 (*Nokia*) (C-495/09)

Are non-Community goods bearing a Community trade mark which are subject to customs supervision in a Member State and in transit from a non-Member State to another non-Member State capable of constituting "counterfeit goods" within the meaning of Article 2(1)(a) of Regulation 1383/2003/EC if there is no evidence to suggest that those goods will be put on the market in the EC, either in conformity with a customs procedure or by means of an illicit diversion

Thank you for your attention

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