Intellectual Property Rights

-

How to protect your intangible assets

VO Entrepreneurship

TU Wien

Dr. Rainer Beetz, LL.M.
Patentanwalt

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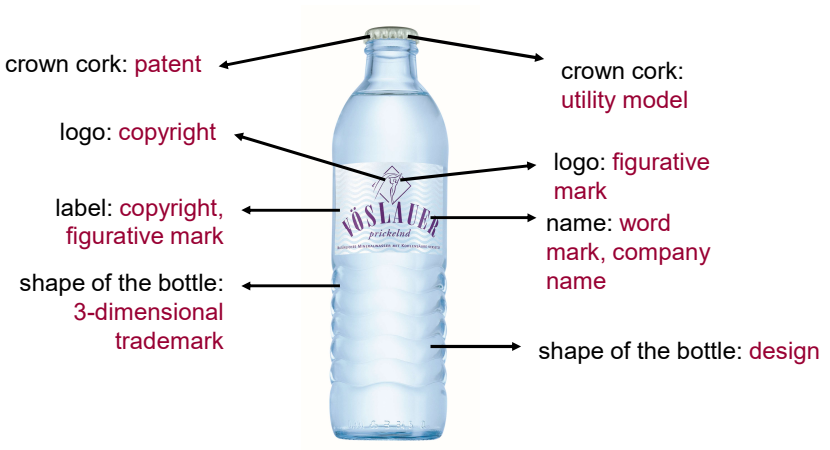
IP Rights



IP Rights

- Patents
- Utility Models
- Trade Marks
- Designs
- Copyright
- Supplementary Protection Certificates (SPC)
- Semiconductor Protection Rights
- Plant Variety Rights

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IP Rights

Most important IP rights:

- **patents, utility model** – technical inventions
- **trade marks** – origin of a product or service
- **designs** - outer apperance of a product

➡ applications must be filed to get protection by **IP rights – otherwise, imitating is generally allowed!**

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Why getting IP protection ?

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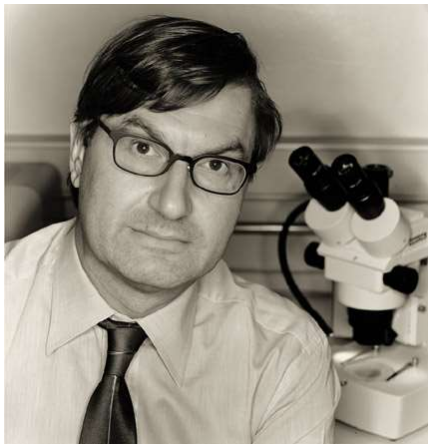
…an example



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…an example

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…an example

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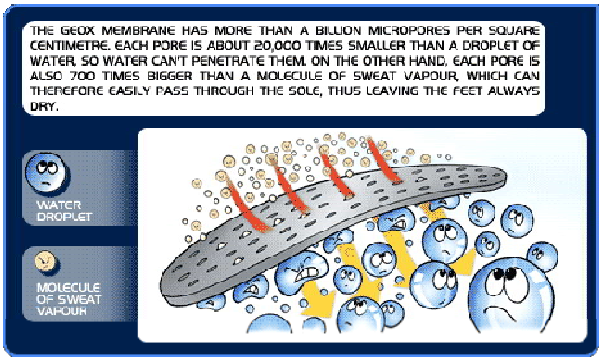
…an example



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(19) Europäisches Patentamt
European Patent Office
Office européen des brevets

(11) Publication number: **0 382 904 B1**

(12) **EUROPEAN PATENT SPECIFICATION**

(45) Date of publication of patent specification: **18.05.94** (51) Int. Cl.5: **A43B 13/12**

(21) Application number: **89121612.9**

(22) Date of filing: **23.11.89**

(54) **Sole structure for footwear.**

(30) Priority: **17.02.89 IT 4152589**

(43) Date of publication of application:
22.08.90 Bulletin 90/34

(45) Publication of the grant of the patent:
18.05.94 Bulletin 94/20

(84) Designated Contracting States:
AT BE CH DE ES FR GB GR LI LU NL

(56) References cited:
GB-A- 1 407 372

(73) Proprietor: **POL SCARPE SPORTIVE S.r.l.**
Via Feltrina Sud 6/B
I-31030 Biadene di Montebelluna
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(72) Inventor: **Polegato, Mario**
Via Antonini
I-31035 Crocetta Del Montello (Treviso)(IT)

(74) Representative: **Modiano, Guido, Dr.-ing. et al**
Modiano & Associati S.r.l.
Via Meravigli, 16
I-20123 Milano (IT)

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…an example

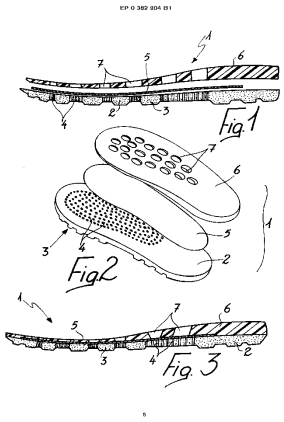
Claims

1. Sole structure for footwear, comprising at least one lower part (2) having a thread (3) and at least one upper part (6) attached to said lower part (2), characterized in that said lower part (2) has a plurality of micro-pores (4) traversing its thickness and is covered by at least one membrane (5) made of microporous waterproof material capable of permitting transpiration, and said upper part (6) is attached to said lower part (2) and has through holes (7) which traverse its thickness.

2. Sole structure according to claim 1, characterized in that said micro-pores extend on the entire extension of said lower part or only on a part thereof.

3. Sole structure according to claim 1, characterized in that the material which constitutes said membrane is preferably of the kind commonly termed "Gore-Tex" or of another equivalent kind of material.

4. Sole structure according to claim 1, characterized in that said through holes are arranged on the entire extension of the upper part or only on a part thereof.



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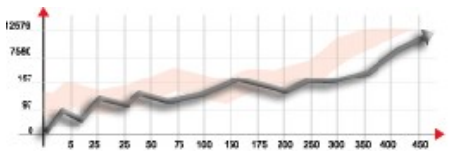
…an example

- Patents basis for commercial success
- Founded 1995
- Turn-over 2006: 612,3 million €
- Employees: > 5000



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…an example

esp@cenet results view - Mozilla Firefox

Datei Bearbeiten Ansicht Gehe Lesezeichen Extras Hilfe

http://v3.espacenet.com/results?sf=a&DB=EPODOC&PA=GEOX&PGS=10&CY=ep&LG=en&ST=advanced

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Classification Search
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Quick Help
» Why is the list limited to 500 results?
» Why is the number of results sometimes approximate?
» Why could it be that a certain patent document is not displayed in the results list?
» Why do I sometimes get results having a title which is not in English?
» Why do I sometimes get results which may not match my query?

Compact | Print 1 2 3 4 5 next

RESULT LIST
Approximately **229** results found in the Worldwide database for:
GEOX as the applicant
(Results are sorted by date of upload in database)
The result is not what you expected? Get assistance

Refine search

1 Shoe with permeable and breathable upper that covers at least partially an impermeable sole that is rendered breathable — in my patents list
Inventor: POLEGATO MORETTI MARIO (IT) — Applicant: GEOX S P A (IT)
EC: A43B7/06; A43B7/12B; (+1) — IPC: *A43B3/14; A43B7/06; A43B7/12* (+6)
Publication info: **DK1369048T** - 2007-02-05

2 WATERPROOF VAPOR-PERMEABLE SHOE — in my patents list
Inventor: POLEGATO MORETTI MARIO (IT) — Applicant: GEOX S P A (IT); POLEGATO MORETTI MARIO (IT)
EC: A43B7/08; A43B7/12B; (+1) — IPC: *A43B7/12; A43B7/08; A43B9/00* (+2)
Publication info: **WO2007012415** - 2007-02-01

3 Vapor-permeabel and waterproof sole for shoes, particularly but not exclusively for open shoes such as sandals, sabots and the like, and shoe provided with the sole — in my patents list
Inventor: POLEGATO MORETTI MARIO (IT) — Applicant: GEOX S P A (IT)
EC: — IPC: *A43B7/06; A43C13/08*; **A43B7/00** (+1)
Publication info: **US2007011907** - 2007-01-18

4 MID-SOLE FOR WATERPROOF BREATHABLE SOLES FOR SHOES, AND WATERPROOF BREATHABLE SOLE COMPRISING SAID MID-SOLE — in my patents list
Inventor: POLEGATO MORETTI MARIO (IT) — Applicant: GEOX S P A (IT)

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Patents

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Why patenting ?

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A Patent is….

- an exclusive right to exclude others from the economical benefits of the invention

A Patent is not….

- a positive right that allows the owner to make use of the invention

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Why granting patents ?

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Why granting patents ?

Copying of a new product

costs usually

1/10 - 1/100

of development costs

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Why granting patents ?

Innovation is expensive

and it is much cheaper to copy !

➡ Incentives must be provided for to invest into Research and Development

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Why granting patents ?

- Offering incentives to:
  - invest in R&D for getting a monopoly granted (factually und timely limited) and for earning monopoly profits
  - disclose the invention in order to enhance further inventions (=circumventing)

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Effect of a Patent (§22 Patents Act)

Patent = right to exclude others from industrially

- producing
- putting on the market
- offering for sale
- using
- importing
- possessing (for the above purposes)

the subject matter of the invention

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A Patent is….

…. a territorially limited exclusion right, thus…

- an Austrian Patent has only legal effect in Austria
- in order to acquire also protection in others countries, it must be applied for patents in foreign countries within 1 year (priority term - Paris Convention)
- a patent in one country is independent from a patent in another country
- in countries without patent protection the invention may be freely exploited

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What is patentable ?

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Requirements for getting a Patent….

…the subject matter must be:

- new
- inventive
- industrially applicable
- sufficiently disclosed
- not excluded from patentability

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Novelty

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Novelty (§3 APA, Art 54 EPC)

- invention shall be considered to be new if it does not form part of the state of the art
- state of the art: 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 patent application

→ `absolute novelty`

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Novelty

Non-Disclosure agreement

- may exclude public availabilty of the invention
- in case of infringement of the non-disclosure agreement usually only damages may be claimed

  (**exception**: a disclosure is non-prejudicial if it is a consequence of evident abuse in relation to the applicant and if an application is filed within 6 months from the disclosure)

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Inventive Step

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Inventive Step (§1 APA, Art 56 EPC)

= not obvious to a person skilled in the art regarding the state of the art

- person skilled in the art: presumed to be an ordinary practitioner aware of what was common general knowledge in the art at the relevant date
- Problem/Solution-Approach
- Could-Would-Approach

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Inventive Step (§1 APA, Art 56 EPC)

- problem-and-solution approach
  - main stages:

  (i) determining the "closest prior art“

  (ii) determining the differences between the closes prior art and the claim subject matter

  (iii) establishing the "objective technical problem" to be solved, and

  (iv) considering whether or not the claimed invention, starting from the closest prior art and the objective technical problem, would have been obvious to the skilled person.

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Indicative Evidence

- mere aggregation of known features
- non-functional modification
- arbitrary choice

+ ´*ex post facto*´-analysis
+ unexpected technical effect
+ bonus effect
+ long-felt need
+ commercial success

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Inventive Step (§1 APA, Art 56 EPC)

- Claimed subject matter

1. Ski having edges consting of aluminium

- Prior Art

Ski having eges constisting of iron

➢ Objective problem? – avoiding oxidation

➢ Is there any prior art document known according to which iron is subsituted by aluminium in order to avoid oxidation?

➢ Is there any teaching in the prior art as a whole that would (not simply could, but would) have prompted the skilled person, faced with the objective technical problem, to modify or adapt the closest prior art while taking account of that teaching, thereby arriving at something falling within the terms of the claims

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Industrial Application

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Industrial Application (§1 APA, Art 57 EPC)

- if it can be made or used in any kind of industry, including agriculture
- "Industry" should be understood in its broad sense as including any physical activity of `technical character`
- only of high importance for `Biotech` inventions: industrial application of a sequence or a partial sequence of a gene must be disclosed in the patent application
  - a mere nucleic acid sequence without indication of a function is not a patentable invention (EU Dir. 98/44/EC)

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Exclusions

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Exlusions (§2 APA, Art 52 § 2- 4 EPC)

- 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

as such

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International Patent Protection

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Foreign Patent Protection

➢ **Possible Routes:**

- Foreign National Applications
- International Application (PCT)
- European Patent Application

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Patent Cooperation Treaty (PCT)

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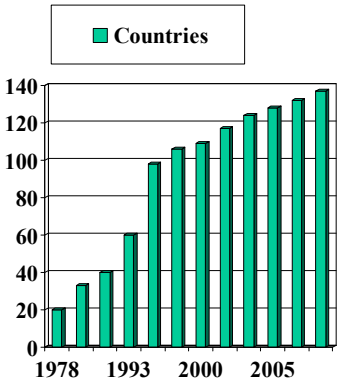
Patent Cooperation Treaty - PCT

- PCT offers a plurality of options

152 contracting states may be reached by a single PCT application (1 Jannuary 2017)



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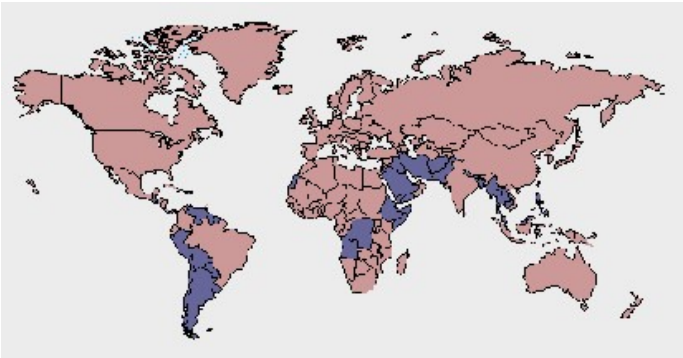
Patent Cooperation Treaty - PCT



PCT States

Non-PCT States

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Patent Cooperation Treaty - PCT

- PCT Application
  - international phase (up to 30 (31) months from priority date)
  - national/regional phase in every country, in which patent protection is wish to be gained

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Patent Cooperation Treaty - PCT

➢ international phase

- application (within 12 months from priority)
- formal examination
- search
- international search report
- publication of the application (18 months after application)
- international preliminary examination (request within 22 months; optional !!)
- international preliminary examination report (within 28 months)

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Patent Cooperation Treaty - PCT

➢ national/regional phase

- Initation: within 30/31 months from priority
  - translations,
  - requests,
  - attorneys,
  - fees,...
- national/regional examination procedure
- national/regional patent

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Patent Cooperation Treaty - PCT

- an international application does not lead to a unitary ´world patent´ , but a plurality of separate, independent national/regional patents (= patent family) emerge from a unitary application
- national/regional patents may provide e.g. different claims

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TOP PCT-Filers 2015

No	Company Name	Country	No of applications
1	HUAWEI TECHNOLOGIES CO., LTD.	CN	3898
2	QUALCOMM INCORPORATED	USA	2442
3	ZTE CORPORATION	CN	2155
4	SAMSUNG	KR	1683
5	MITSUBISHI ELECTRIC CORP.	JP	1593
6	TELEFONAKTIEBOLAGET LM ERICSSON (PUBL)	SE	1481
7	LG	KR	1457
8	SONY	JP	1381
9	KONINKLIJKE PHILIPS ELECTRONICS N.V.	NL	1378
10	HP	US	1310

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The European Patent Convention (EPC)

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The European Patent Convention (EPC)

- Since 1st June 1978 European Patents can be applied for
- 1979: Austria accedes to the EPC
- 2015: 38 member states +
  2 extension states

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The European Patent Convention (EPC)

38 Member States:

- Albania
- Austria
- Belgium
- Bulgaria
- Croatia
- Cyprus
- Czech Republic
- Denmark
- Estonia
- Finland
- France
- Germany
- Serbia
- Greece
- Hungary
- Iceland
- Ireland
- Italy
- Latvia
- Liechtenstein
- Lithuania
- Luxembourg
- Macedonia
- Malta
- Monaco
- Netherlands
- Norway
- Poland
- Portugal
- Romania
- San Marino
- Slovakia
- Slovenia
- Spain
- Sweden
- Switzerland
- Turkey
- United Kingdom

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The European Patent Convention (EPC)

- with a single application a unitary patent may be gained for a plurality of states
- examination procedure in German, English or French
- grant of an European Patent
- central attack via opposition proceedings
- validation in the member states (filing translation)

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Strategy for International Patent Protection

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Foreign Patent Protection

➢ **Possible Routes:**

- Foreign National Applications
- International Application (PCT)
- European Patent Application

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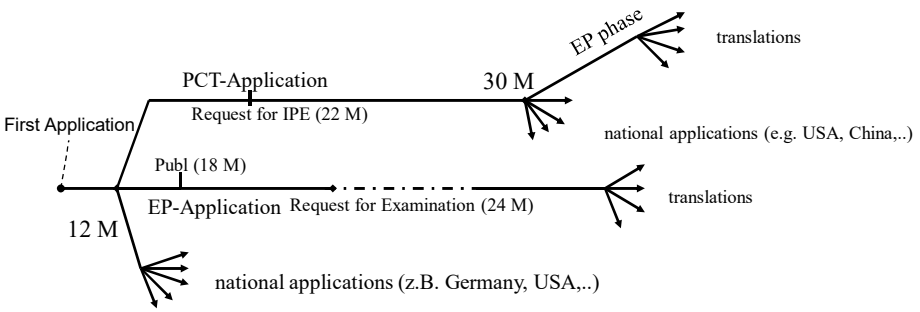
Foreign Patent Protection



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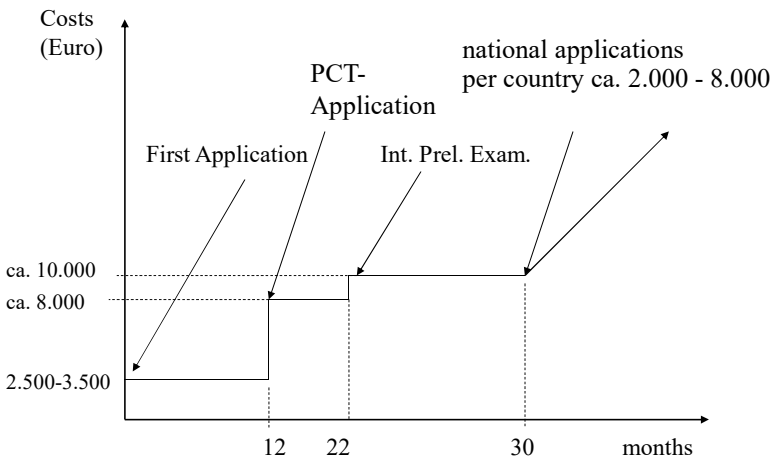
Foreign Patent Protection



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Foreign Patent Protection

- Where shall patent protection be applied for ?
  - for existing market places
  - where production facilities exist
  - countries providing effective patent protection
  - future markets
  - where do other rights exist
  - costs/potential benefits

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Patents as Information Source

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Patent Databases

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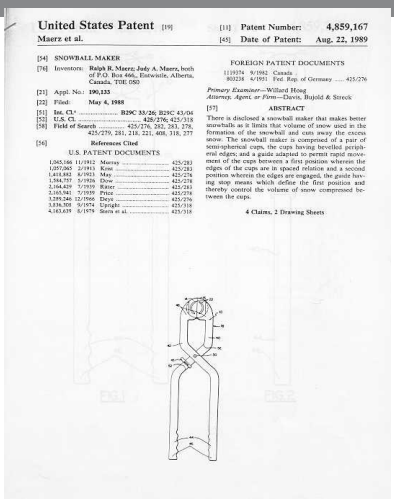
Patent Databases



United States Patent [19]
Maerz et al.

[11] Patent Number: 4,859,167
[45] Date of Patent: Aug. 22, 1989

[54] SNOWBALL MAKER

[76] Inventors: Ralph R. Maerz; Judy A. Maerz, both of P.O. Box 466, Entwistle, Alberta, Canada, T0E 0S0

[21] Appl. No.: 190,125

[22] Filed: May 4, 1988

[51] Int. Cl.[4] B29C 33/26; B29C 43/04
[52] U.S. Cl. 425/276; 425/318
[58] Field of Search 425/276, 202, 203, 278, 425/279, 281, 218, 221, 408, 318, 277

[56] References Cited

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1,584,757	5/1926	Dow	425/278
2,164,429	7/1939	Ritter	425/283
2,165,941	7/1939	Price	425/278
3,289,246	12/1966	Deye	425/276
3,834,509	9/1974	Upright	425/318
4,183,628	8/1979	Sears et al.	425/318

FOREIGN PATENT DOCUMENTS

1119374	9/1982	Canada
800238	4/1951	Fed. Rep. of Germany 425/276

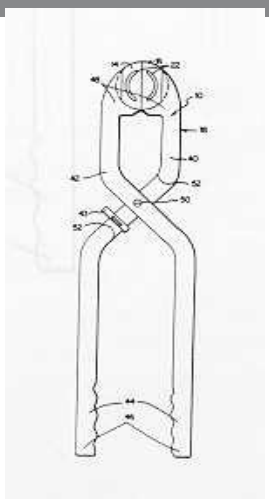
Primary Examiner—Willard Hoag
Attorney, Agent, or Firm—Davis, Bujold & Streck

ABSTRACT

[57]

There is disclosed a snowball maker that makes better snowballs as it limits that volume of snow used in the formation of the snowball and cuts away the excess snow. The snowball maker is comprised of a pair of semi-spherical cups, the cups having bevelled peripheral edges; and a guide adapted to permit rapid movement of the cups between a first position wherein the edges of the cups are in spaced relation and a second position wherein the edges are engaged, the guide having stop means which define the first position and thereby control the volume of snow compressed between the cups.

4 Claims, 2 Drawing Sheets



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Patent Databases

- **Freely available databases:**
  - http://ep.espacenet.com
  - https://depatisnet.dpma.de
  - http://www.uspto.gov
- **Official Search**
  - Austrian Patent Office
- **Patent Attorneys**

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Patent Databases

- **PATENT MONITORING**
  - **Who applies for colliding rights**
    - object:
      - defending its own legal position and market position
  - **What direction is R&D of competitors heading for?**
    - object:
      - not to miss trends
      - incentives for own R&D

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Seven deadly sins of the inventor

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Seven deadly sins of the inventor

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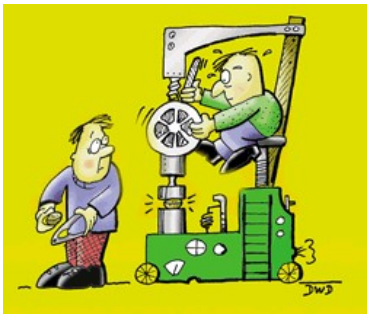
1. **The invention is more complex than the problem merits.**



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Seven deadly sins of the inventor

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2. The invention is not kept secret until the date of filing.

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3. The invention isn't new.

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4. The inventor hasn't fully considered the problem.

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5. No-one wants it.

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6. An invention is safer if it's kept secret

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7. The inventor has an unrealistic idea of the value of his invention.

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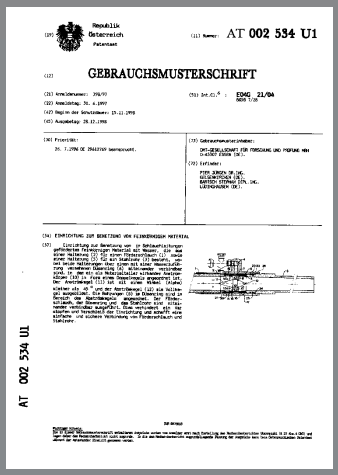
Utility Model Law


Republik Österreich
Patentamt

(11) Nummer: AT 002 534 U1

GEBRAUCHSMUSTERSCHRIFT

(51) Int.Cl.6 : E04G 21/04

(54) EINRICHTUNG ZUR BENETZUNG VON FLIESSFÄHIGEM MATERIAL

AT 002 534 U1

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Utility Model Law

- name misleading → due to historic reasons
- originally close to design law
- nowadays ´petty patent´
- rationality of the introduction in 1994:
  - quickly available and enforceable protection for inventive products having a short life time

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Utility Model Law

➢ Essential Differences to Patents

- No substantial examination:
  - Only formal examination
  - Publication of search report (within 6 months)
  - Possibilty to amend claims only once
  - Registration
  - Possibilty of accelerated registration

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Utility Model Law

➢ Essential Differences to Patents

- Shorter maximum duration
  - 10 years calculated from the application date
  - subject to maintenance fees

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Utility Model Law

➢ Essential Differences to Patents

- Inventive Step
  - According to the materials the requirements with respect to non-obviousness are lower than as for patents ➡
    - an invention which was not patentable (due to lack of inventive quality) coul be registered as utility model
  - Change in jurisprudence: Austrian Supreme Patent & Trademark Tribunal OPM, OGM-1/10:
    - Same inventiveness requirement in patent and utility model law!

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Utility Model Law

➢ Essential Differences to Patents

- Novelty Grace Period:
  - publication carried out within 6 months from the application date and which go back the inventor himself (directly or indirectly) are not considered as prior art
  - possibilty to get protection for inventions which are not patentable anymore

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Utility Model Law

- Essential Differences to Patents
  - Protection for the Logic of Computer Programs:
    - not patentable as such !
    - only country worldwide

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Utility Model Law

- utility models have the same legal effect as patents:
  - right to exclude others from industrially
    - producing
    - putting on the market
    - offering for sale
    - using
    - importing
    - possessing (for the above purposes)
- in case of an utility model infringement there are the same remedies available as in case of patent infringement

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Utility Model Law

- Interaction between Patents and Utility Models
  - Conversion:
    - Patent Application → Utility Model application
    - Utility Model application → Patent application
  - Branching Off:
    - utility model application may be branched off a patent application
    - of tactical importance, if first infringing acts and patent application is still pending
  - Parallel Applications:
    - independent of each other
    - advantages of both rights: promptly enforceable / long duration

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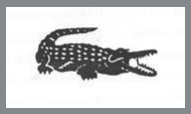
Trade Marks

ROLEX

Coca-Cola



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What is a trade mark?

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Trade Marks

- A trade mark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

(Art 2 EU Trademark Direective; § 1 MSchG; Art 4 CTMR)

➡ trade marks protects a source designations for goods and services

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Trade Marks

- Trade Mark Function
  - Designation of origin (principal function)
    - Enabling the consumer who acquired specific goods or services to repeat the experience, if it proves to be postive, or to avoid ot, if it proves to be negative

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Trade Marks

- Historcial background:
  - already in medieval ages marks of producers were put on their products – even obligation to mark products (today still for certain goods made from precious metals)
  - „trade“ marks of dealers came up only later
  - first Austrian trademark statute 1858

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What can be protected?

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Trade Marks

- any signs capable of being represented graphically, **particularly**
  - words, including personal names,
  - designs,
  - letters,
  - numerals,
  - the shape of goods or of their packaging

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Trade Marks

- Basic requirements:
  - must be a sign
  - must be capable of graphic representation
  - must be capable of distinguishing the goods or services of one undertaking from those of other undertakings

-> distinctiveness

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Trade Marks

- Words: NIKE, COCA-COLA
- Logos: NIKE Coca-Cola
- 3-dimensional marks:

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Trade Marks

- slogans:
  - „Have a break“ (CTM 002726925)
  - „Gives you wings“ (CTM 000839936)

Requirements:

- a sign ✓
- capable of graphic representation ✓
- distinctive ✓

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Trade Marks

- colors: C-104/01 – Libertel:
- three conditions
  - must be a sign:
    - „… a colour per se cannot be presumed to constitute a sign. Normally a colour is a simple property of things. Yet it may constitute a sign. That depends on the context in which the colour is used. None the less, a colour per se is capable“ ✓
  - must be capable of graphic representation
    - „must enable the sign to be represented visually, particularly by means of images, lines or characters, so that it can be precisely identified” ✓
    - “must be clear, precise, self-contained, easily accessible, intelligible, durable and objective“

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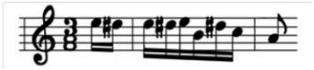
Trade Marks

- Sounds: C-283/01 – Shield Mark



„… a trade mark may consist of a sign which is not in itself capable of being perceived visually, provided that it can be represented graphically, particularly by means of images, lines or characters, and that its representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective.“

Requirements:

- a sign ✓
- capable of graphic representation ✓
- distinctive ✓

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Trade Marks

- Smells: C-273/00 – Sieckmann:
- graphical representation: chemical formula?
  - „currently no adequate graphical representation available“

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What cannot be protected?

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Trade Marks

- Bars to trademark protection:
  - not a trademark: e.g. not capable of graphical representation
  - lack of distinctive character:
    - Incapable of performing the essential function of a trademark
    - Signs which are commonly used in trade, for the presentation of the goods or services concerned
    - examples:

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Trade Marks

- descriptive signs:
  - „trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service“ *(Art 3(1) TM Directive)*

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Trade Marks

- descriptive signs:
  - Examples: C-191/01 – DOUBLEMINT (for chewing gum)
    - public interest that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all
    - it is not necessary that the sign is actually used in a discriptive manner at the time of the application – it is sufficient that it could be used for such purpose in one of its possible meanings

➡ **descriptive**

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Trade Marks

- descriptive signs:
  - Examples: C-383/99 P – BABY DRY (for diapers)
    - lexical invention bestowing distinctive power on the mark so formed

➡ **not descriptive**

Trade Marks

- Acquired distinctiveness
- *„A trade mark shall not be refused registration … [for lack of distinctiveness, descriptiveness or genericness] if, … following the use which has been made of it, it has acquired a distinctive character"*–
- Does a significant portion of the users of the goods identify the goods or services as originating from a particular undertaking?

Trade Marks

- Bars to trademark protection:
  - generic terms:
    - „exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade“
    - examples:
      - Walkman: OGH 29.1.2002, 4 Ob 269/01
        no alternative name for the product → **generic**
      - MEMORY: OGH 6.7.2004, 4 Ob 128/04h
        a range of alternative names is available → **not generic**

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Trade Marks

- Bars to trademark protection:
  - How to avoid trademarks becomming generic terms:
    - use of the ® to hint that the name is a registered trademark
      - careful: only allowed if trademark is registered,
      - if not: offense under the law against unfair competition due to misleading advertising (§ 2 UWG)
    - use of the ™ to hint that used name is a (unregistered) trademark
      - allowability in view of misleading charachter not decided in Austria
      - Germany: commonly considered as misleading
    - offering alternative name!

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Trade Marks

- Bars to trademark protection:
  - Functionality:
    - signs which consist exclusively of:
      - (i) the shape which results from the nature of the goods themselves; or
      - (ii) the shape of goods which is necessary to obtain a technical result; or
      - (iii) the shape which gives substantial value to the goods;

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Trade Marks

- Bars to trademark protection:
  - Functionality:
    - C-299/99 – Philips/Remington

    - Exhaustive list
    - rationale for exclusion of functional trademarks: to avoid granting the trademark proprietor a monopoly on technical solutions or functional characteristics of a product which a user is likely to seek in the products of competitors
    - functional features barred from trademark protection even if the technical result can be achieved by other shapes

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Trade Marks

- **Other bars** to trademark protection:
  - trade marks which are contrary to public policy or to accepted principles of morality;
  - trade marks which are of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or service;
  - trade marks which have not been authorized by the competent authorities and are to be refused pursuant to Article 6ter of the Paris Convention;
  - trade marks which include badges, emblems or escutcheons other than those covered by Article 6ter of the Paris Convention and which are of particular public interest, unless the consent of the appropriate authorities to their registration has been given.
  - trade marks for wines which contain or consist of a geographical indication identifying wines or for spirits which contain or consist of a geographical indication identifying spirits with respect to such wines or spirits not having that origin.

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Trade Marks

- **Summary of bars** to trademark protection:
  - lack of distinctiveness
  - descriptiveness
  - genericness
  - functionality
- except functionality, bars can be overcome by proof of acquired distinctiveness

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How to obtain trademark protection?

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Trade Marks

- How to obtain trademark protection?
  - Registration of a national Austrian trade mark (ÖPA)
  - Registration of a EU trade mark (EUIPO)
  - International Registration (WIPO)
  - Trough use under certain conditions

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Trade Marks

- older trademarks prevail over younger trademarks
- decisive date: date of filing or claimed priority (date of registration irrelevant)
- Art 4 Paris Convention:
  - priority of a first application with a contracting party can be used for application in other contracting party within 6 months

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Trade Marks

Advisable :

- clearance of a trademark before use or registration

- trademark search for prior similar rights registered for similar goods or services
  - Austrian PTO or private companies
  - for each jurisdiction of concern
  - no certainty – similarity to be judged on a case by case basis
- not searchable:
  - unpublished applications
  - unregistered rights
- famous marks enjoy protection also outside similar goods/services

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Trade Marks

- International Registration:
  - each national office can refuse protection if not registrable according to national law
    - within 18 months at the latest
    - if national office objects applications, a „provisional refusal“ in issued
    - possibility for applicant to file observations
    - grant of protection or final refusal
  - in all designated countries, where the applciation is not refused, the trademark ist protected as a national trademark

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Trade Marks

- International Registration
  - one Certificate of the International Registration is issued, showing protection (or refusal) for each designated country
  - IR application must be based on a national mark in country of origin of the applicant
- the IR registration dependeds during the initial 5 years on the base mark
  - If a „central attack“ against base mark is succesful within that period all rights included in the bundle are invalidated

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How long does trademark protection last?

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Trade Marks

- How long does trademark protection last?
  - trade marks may be renewed eternally
  - payment of registration fee for following 10 years
  - use required!

Trade Marks

- How long does trademark protection last?
  - use requirement:
    - cancellation of the registered trademark can be sought by third parties if:
      - the trademark has not been put to genuine use within 5 years
      - except legitimate reasons for non use can be proven

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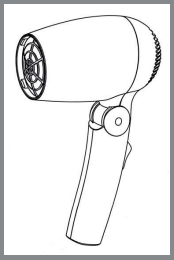
Designs



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What is a design?

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Designs

- ´design' means
  - the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation

(Art1a EU Design Directive, Art 1(2) MuSchG, Art3(a) CDR)

➡ designs protect the outer appearance of a product

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What can be protected?

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Designs

- Registrable ´products,:
  - industrial or handicraft item,
  - including inter alia
    - parts intended to be assembled into a complex product,
    - packaging,
    - get-up,
    - graphic symbols and
    - typographic typefaces,
  - but excluding computer programs;

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Designs

- Basic registrability requirements:
  - Novelty
    - a design shall be considered new if **no identical design** has been made available to the public before the date of filing of the application for registration
    - a design shall be deemed to have been made available to the public if it has been published following registration or otherwise, or exhibited, used in trade or otherwise disclosed, except where these events could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the EU, before the date of filing of the application for registration or, if priority is claimed, the date of priority

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Designs

- Basic registrability requirements:
  - Novelty Grace Period
    - A disclosure shall not be taken into consideration if the design has been made available to the public:
      - by the designer, his successor in title, or a third person as a result of information provided or action taken by the designer, or his successor in title; and
      - during the 12-month period preceding the date of filing of the application or, if priority is claimed, the date of priority

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Designs

- Basic registrability requirements:
  - Individual Character:
    - A design shall be considered to have individual character if
      - the **overall impression** it produces on the
      - **informed user** differs from the
      - **overall impression** produced on such a user by any design which has been made available to the public before the date of filing of the application for registration.

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How to obtain design protection?

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Designs

- How to obtain design protection?
  - Registration of a national Austrian design (ÖPA)
  - Registration of a EU Design (EUIPO)
  - International Registration (WIPO)
  - Unregistered EU Design

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How long does design protection last?

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Designs

- How long does design protection last?
  - Initial term of protection: 5 years
  - renewal:
    - Payment of renewal fee
    - Renewal term: 5 years
  - maximun duration:
    - 25 years

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Copyright

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What can be protected?

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Copyright

- Historical background of copyright protection
  - protection against copying of books (often only for works of the own nationals)
    - educational interests to allow free copying of foreign books
  - first Austrian copyright statute 1846

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Copyright

- original creations

Only individual creations differing from what is everday, conventional and usual, are protected. The author must reveal personal features.

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Copyright

- original creations

The threshold for originality is quite low:

Copyright protection does not require that a certain „creative level“ be achieved.

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Copyright

- Types of works:
  - literary works
    - including computer software, choreographic works, pantomimes and scientific or educational works
  - musical works
  - artistic works
    - including photographic works, architecture, works of applied arts
  - cinematographic works
  - database works

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How to obtain copyright protection?

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Copyright

- Different from other IP ritghs, there ist no registration necessary
  - Automatic protection upon creation of the work!
- Maximum duration of protection:
  - 70 years after the dead of the last surviving author
  - 70 years after creation of the work if the author is unknown
- only partly harmonized by several EU directives
  - protection in the territory of Austria
- foreign national laws
  - protection in foreign territories

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Copyright

- the copyright always vests in the author!
- joint authorship if several authors for one work
  - relationship between joint authors very critical (agreement!)
  - any exploitation or change of the work requires the consent of the other joint auhtors
  - each joint author is entitled to enforce the copyright against infringements
- presumption of authorship
  - who is named as the author on copies of a work or in connection with performance of a work is presumed to be the author subject to proof of the contrary
  - as long as no author is presumed according to the above, the editor or the
  - publisher is presumed to administer the copyright for the author

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Copyright

- Copyrights cannot be transferred as such, but only licenses granted.
  - licenses are to be interpreted narrowly and shall – in case of doubt – not exceed what appears to be necessary for the practical purpose of the intended use of the work.

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Thank you!

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