



# Protecting Intangible Assets & Bird & Bird

Intellectual Property Overview

Wouter Pors

# Subject of protection - overview

## •Innovation

- Technology developed by the company
- Incorporated in products or services

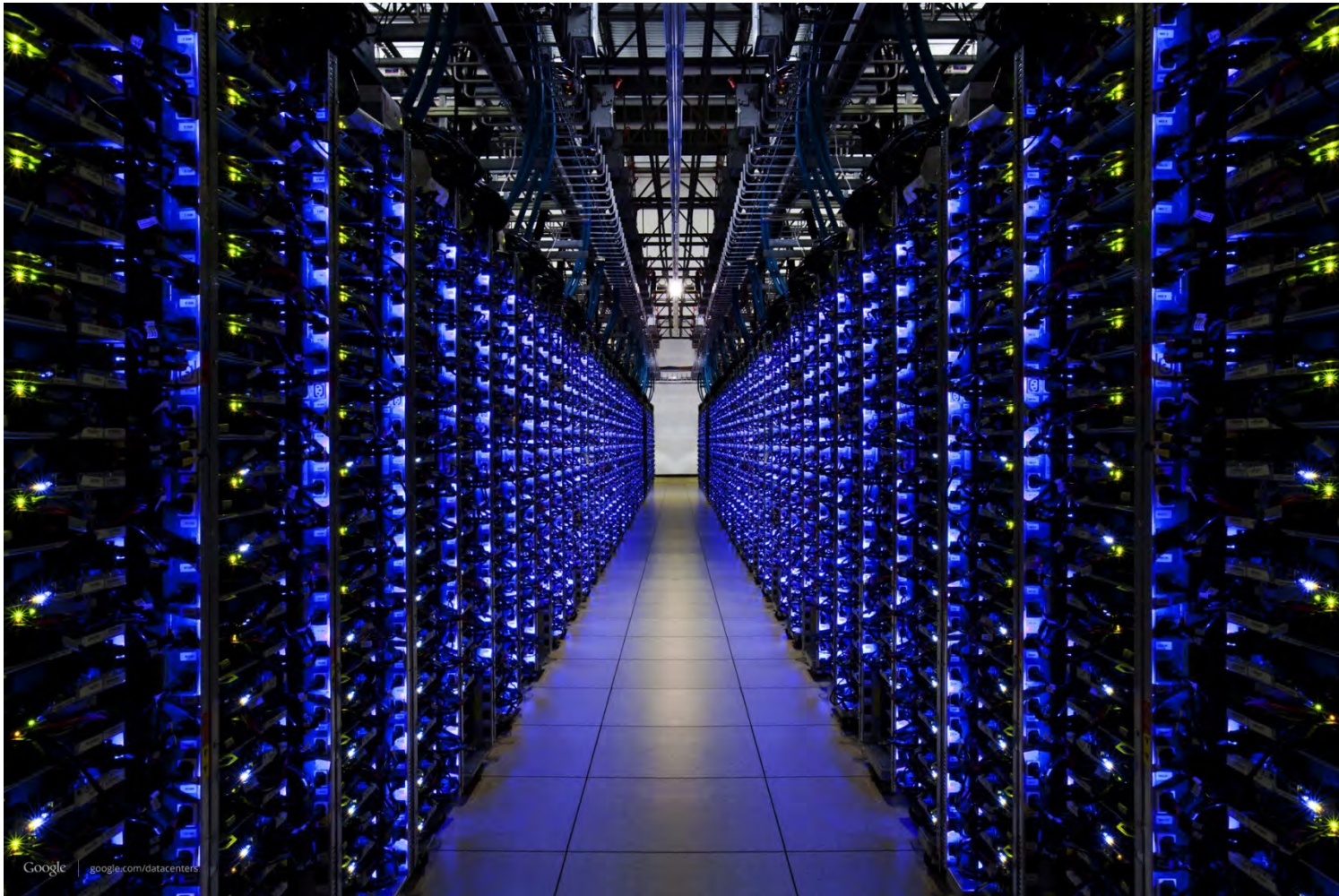
## •Corporate identity

- Company or division as such

## •Product and service look and feel

- Product or service as such
- Many different looks and feels?
- Is the message still clear?

# Protecting innovation



# Subject of protection - innovation

## •Purpose

- Protecting developments
- Others will not block you from use
- Licensing portfolio
- Cross-licensing
- Create value
- Attract investors

## •Means

- Patents - obtained by application and grant
- Copyright - ensues from act of creation
- Know how - dependent on confidentiality

# Scope of protection

## •Patents

- Protection of the invention, not just the actual use
- Idea behind the invention, but legal certainty for third parties
- Expires after 20 years
- New in 2015: Unitary Patent & Unified Patent Court
- 47(2) UPC Agreement: exclusive licensee can bring action (unless)

## •Copyright

- Limited to the actual product or format and
- Others that make the same overall impression
- Assessed on case by case basis; national law still varies
- Expires 70 years after death of the maker

## •Know how

- Scope hard to determine
- Real problem lies in proof of copying
- EU may create new legislation in near future
- Trade secrets are a hot topic



# The company, the services

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Seminar: Het ontslagrecht praktisch belicht

Hoe wordt een arbeidsovereenkomst op de juiste wijze beëindigd? Tijdens dit seminar worden, aan de hand van...

More on the regime

Bird & Bird is delighted to announce the arrival of Helen Loose to our International Energy and Utilities...

More on Laurence Clot

Bird & Bird's Automotive Group would like to invite you to a seminar titled 'Key legal issues in the...'

More on the seminar

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# Subject of protection

- **Innovation**
- **Corporate identity**
  - Identifying your company
  - Marketing your company
  - Creating goodwill (value)
  - Separate from competition
- **Product and service look and feel**

# Subject of protection

- **Innovation**
- **Corporate identity**
- **Product and service look and feel**
  - Identifying your company's products and services
  - Marketing your company's products and services
  - Creating goodwill (value)
  - Separate from competition



# Means of protection

- **Innovation**

- **Corporate identity**

- Indication of origin - collectively, granted by law
- Trade name - through use in the course of trade
- Trade mark - application and registration
- Copyright - ensues from act of creation

- **Product and service look and feel**

# Means of protection

- Innovation

- Corporate identity

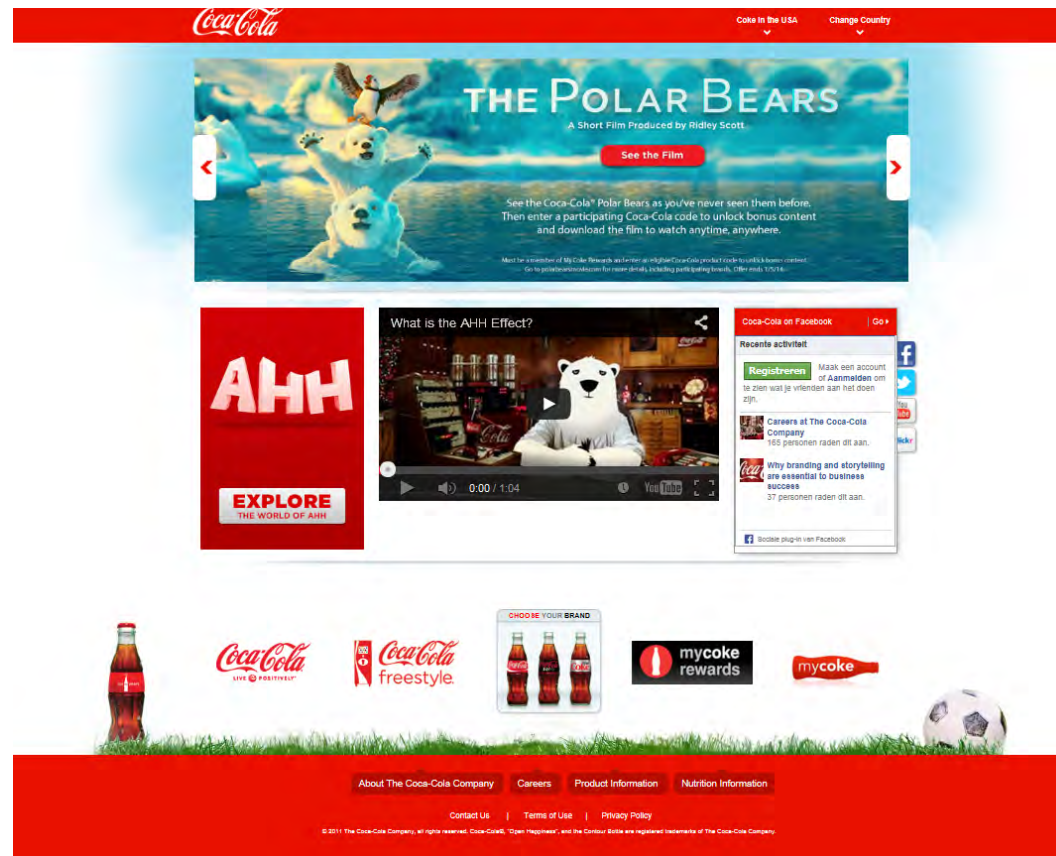
- Product and service look and feel

- Indication of origin
  - collectively, granted by law
- Trade mark
  - application and registration
- Design right
  - application and registration
  - unregistered design rights
- Copyright
  - ensues from act of creation

# Distinguishing yourself

## Company, products, services

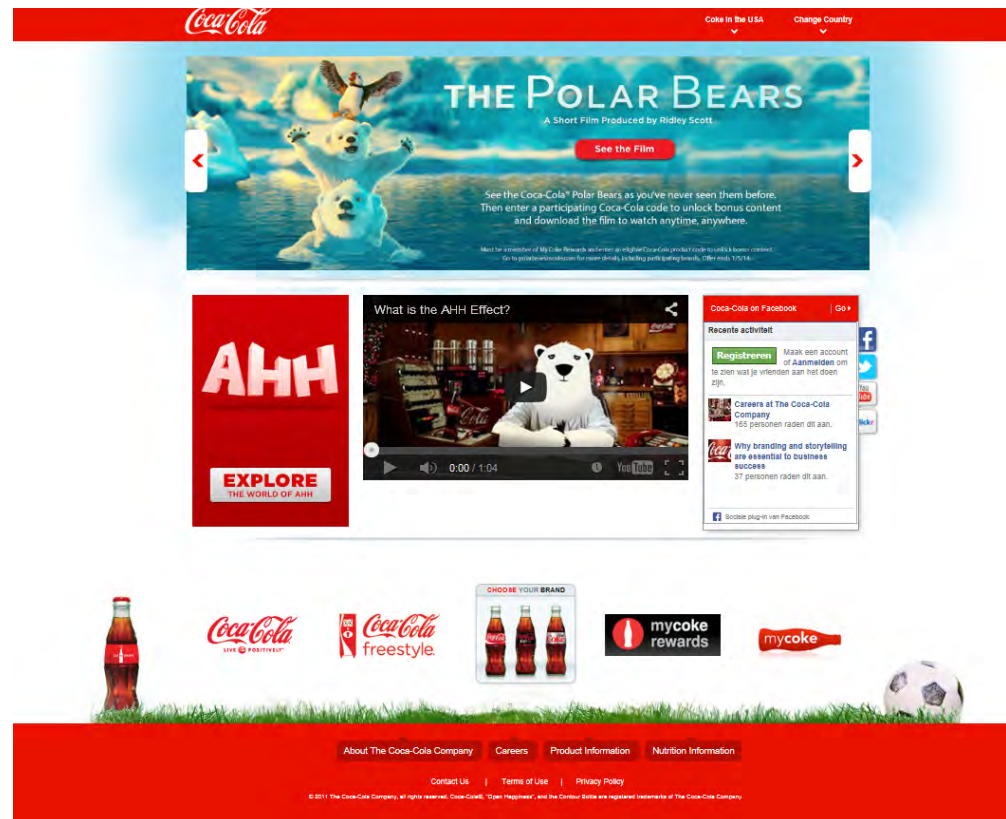
- Trade name
- Trade mark
- Design right
- Copyright
- Trade dress
- Format



# Trade mark

Any distinctive sign identifying you and your products and services for your public

- Name
- Logo
- Colour
- Sound



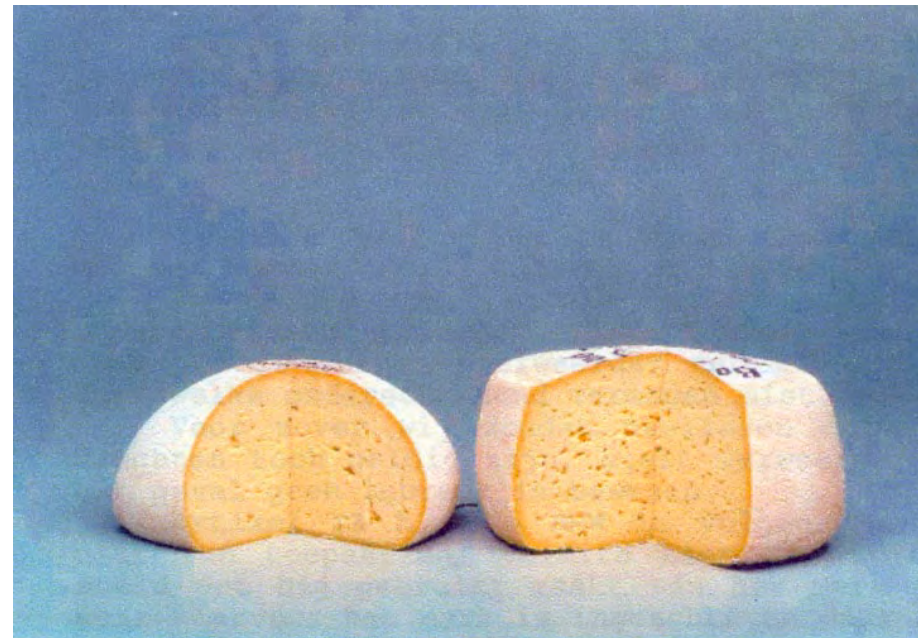
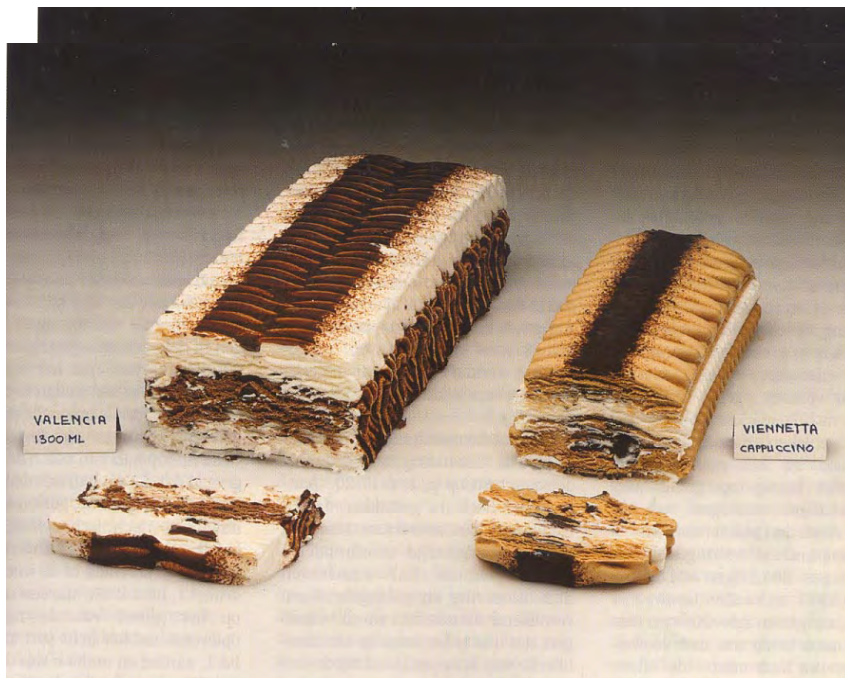
# Trade marks

- Monopoly on **distinctive** sign for products or services
- Harmonised European law
- Acquired by registration (first come)
- Choice between National and European Community
- International: bundle of national rights
- Must have distinctiveness (not descriptive)
- Words, logo's, shapes, colours, sounds
- Perpetual, if renewed regularly
- Works against confusingly similar younger signs





# Many uses for trade mark rights



# Many uses for trade mark rights



## *Name and address of the applicant*

G-STAR INTERNATIONAL B.V., besloten vennootschap  
Keienbergweg 100  
1101 GH Amsterdam,  
Nederland.

## *Name and address of the attorney or postal address of the applicant*

Markmatters B.V.  
Gustav Mahlerplein 50  
1082 MA Amsterdam,  
Nederland.

## *Mark*



## *Figurative elements*

CFE 9.3.3-25;9.5.16  
- Vormmerk.

- De onderscheidende elementen van het merk bestaan uit de vorm, naden, stiksels en inkepingen van het kniestuk van de broek; het kniestuk bolt enigszins. De afbeelding links is het vooraanzicht van het merk, de afbeelding rechts het zij-aanzicht van het merk.

## *Goods and services' list*

Kl 25 Spijkerbroeken en andere broeken, gemaakt van stof.

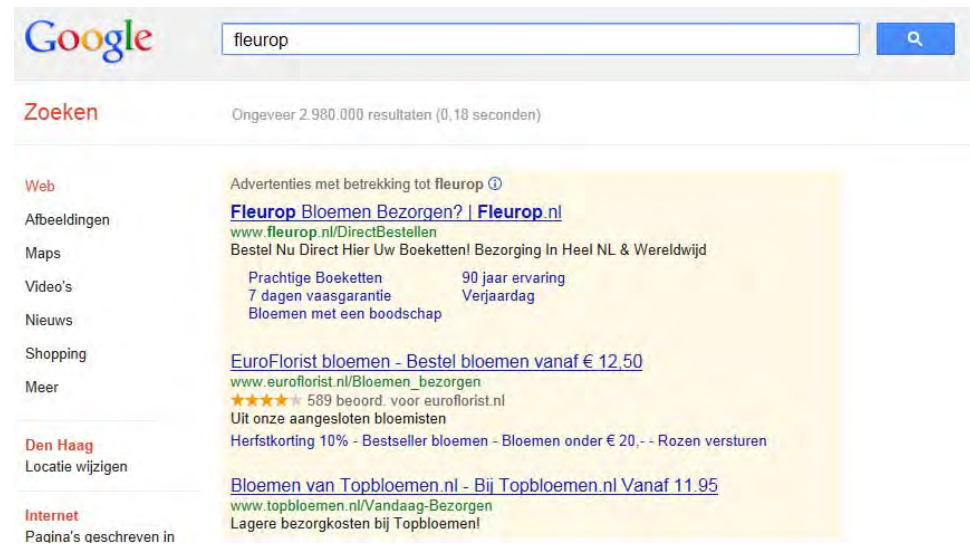
CJEU 20-09-2007, C-371/06, Benetton vs G-Star: a shape that gives value to a trademark cannot acquire distinctiveness through extensive use



# New approach

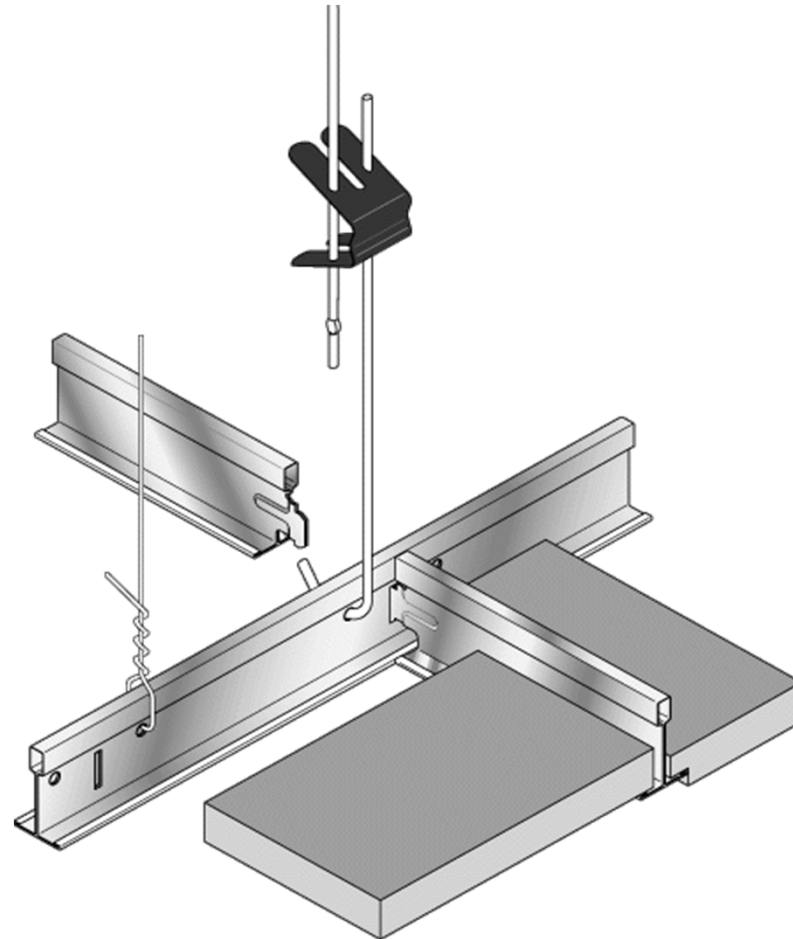
- Protection for the functions of the trademark

- The essential function is to guarantee to consumers the origin of the goods or services,
- Other functions:
  - Guaranteeing the quality
  - Communication
  - Investment
  - Advertising
  - Other?



CJEU 18-6-2009, L'Oréal vs Bellure; 23-3-2010, Google vs Louis Vuitton

# Design

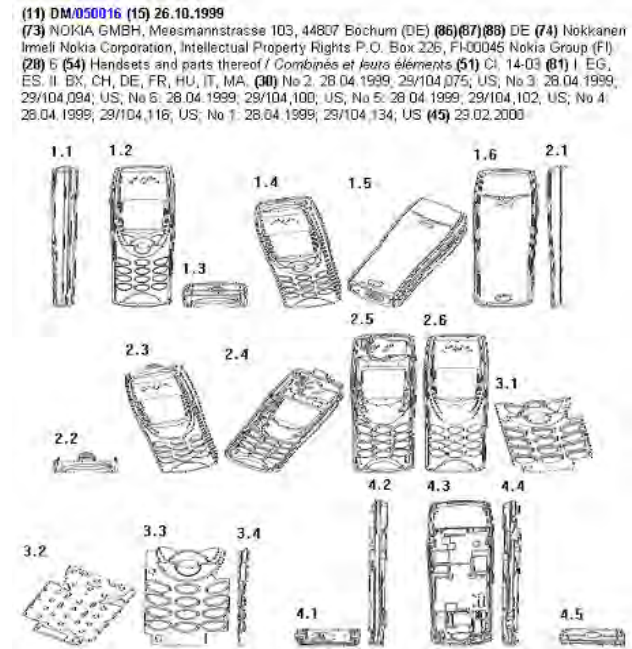


# Design

- Monopoly on shape of product or pattern on product
- Harmonised European law
- Acquired by registration (first come)
- Choice between National and European Community
- Must be novel
- Maximum protection 25 years
- Works against confusingly similar designs
- Unregistered design right
  - Protection for 3 years
  - Less certainty
  - Fall-back where no copyright can be invoked

# Design

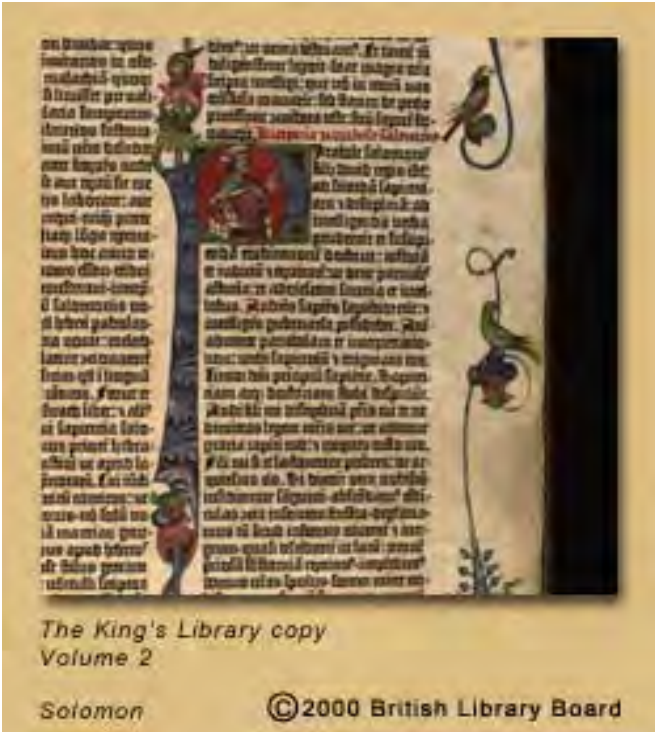
- Scope of protection
  - Multiple design registration to protect all features
- Limitations on design rights: pitfalls
  - Registering new version of product only protects the changes
  - Technical features are not protected (trademark case before the ECJ: Philips v. Remington)
  - Must fit exception for parts
- Way out: copyright
  - On the design as a whole
  - On specific elements of the design



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# Copyright



# Copyright

- Monopoly on “a work”: text, design, lay-out, format
- National law, partly European and world-wide harmonisation
  - Copyrights for non-artistic works not accepted everywhere
  - Same goes for technical works
- Automatic creation by making “a work” (proof of priority needed!)
- Must be original and bearing the mark of it’s maker
- World-wide protection if recognised (creative level)
- Protection 70 years after death of the maker
- Very broad possibilities
- Works against copies and look-alikes



# Court of Justice: copyright protected work

## •16-7-2009, C-5/08, *Infopaq*

- Datacapture process
- Reproduction of press articles by means of an automated process in which these articles are scanned and converted into a numerical file, which can then be processed electronically
- Electronic collection of newspaper clippings
- Fragments of 11 words from an article are reproduced
- Elements which are the expression of the intellectual creation of the author of the work, may be just 11 words



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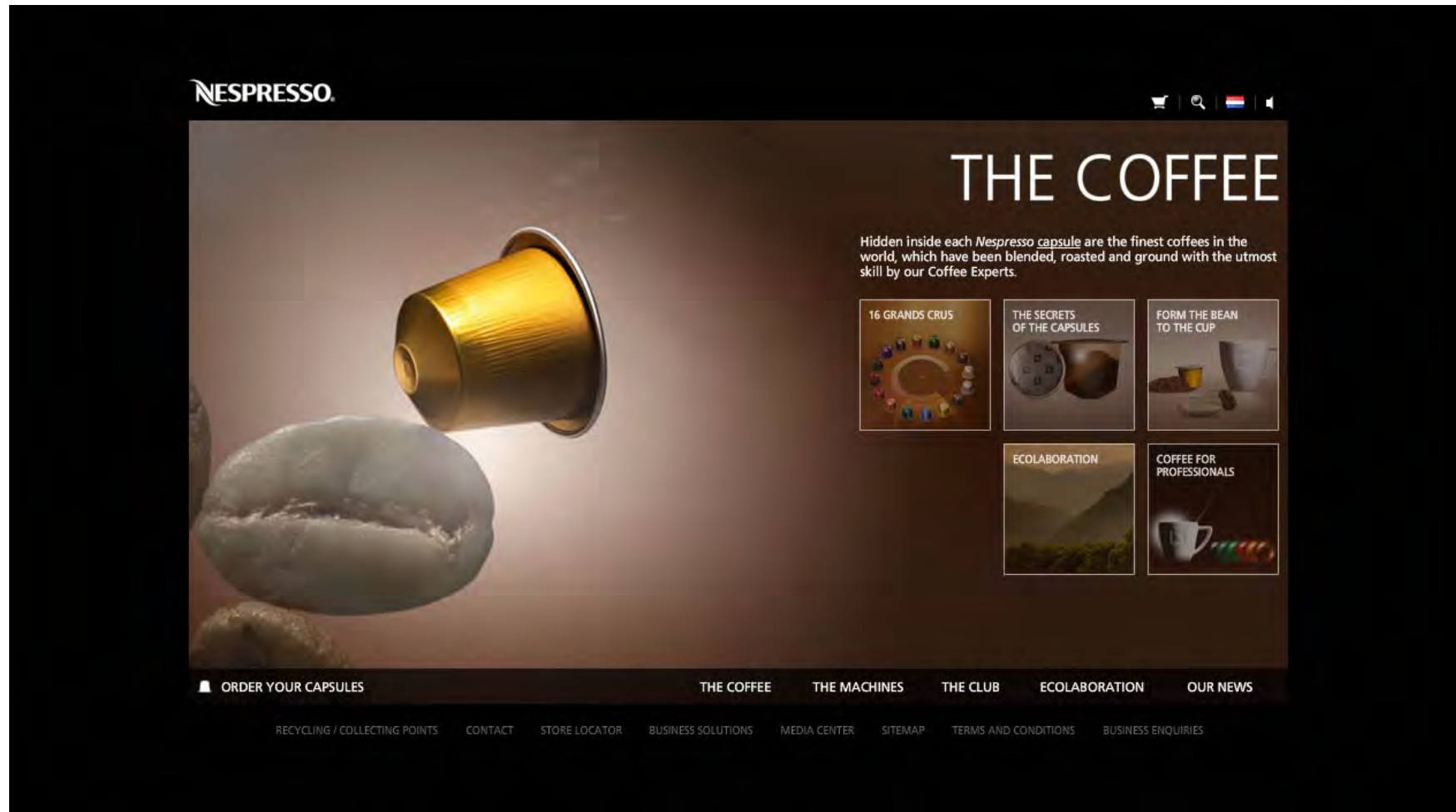
# Copyright works

- Traditional: text, music, theatre, film

- New types of works

- Trade dress
- Software
- Designs
- Objects for everyday use
- TV programme formats
- Business method formats

# Copyright: trade dress



# Design vs copyright



**CARS**  
Cars t-shirt boys  
In diverse kleuren en prints.  
Mt. 104-176.  
Van 15.- voor **10.-**

**Radio controlled  
Formule 1 auto**  
Tot minstens 50 meter afstand te bedienen.  
Ook in zwart, met andere frequentie, om  
tegen elkaar te racen. Rijdt 35 km per uur.  
Van 69.- voor **39.-**

# Patents vs copyright: technology

- Exception for technology as such
- Dutch Supreme Court 24-2-2006 Technip
  - Kinetic scheme of chemical equations as part of computer simulation program for petrochemical industry
  - Selection relates to objective scientific data and laws of nature, scientific or technical purpose
  - Original and expression of intellectual creation of the maker
  - Selection base on scientific or technical knowledge of the maker, insights and experience
  - Court of Appeal: protection
- Scope of exception is limited



# Patents vs copyright: business methods

- US: anything under the sun made by man is patentable
  - But: in re Bilski, 30 October 2008
- Europe: only technical inventions, no business methods
- Copyright: once again the solution to provide equality of investment protection between US and Europe?
- However: does not protect the purely technical solution, “look and feel” have to be added

|   |   |
|---|---|
| <p><b>United States Patent</b> [19]</p> <p><b>Boes</b></p> <hr/> <p>[54] <b>DATA PROCESSING SYSTEM FOR HUB AND SPOKE FINANCIAL SERVICES CONFIGURATION</b></p> <p>[75] Inventor: <b>R. Todd Boes</b>, Boston, Mass.</p> <p>[73] Assignee: <b>Signature Financial Group Inc.</b>, Boston, Mass.</p> <p>[21] Appl. No.: <b>667,777</b></p> <p>[22] Filed: <b>Mar. 11, 1991</b></p> <p>[51] Int. Cl.<sup>5</sup> ..... <b>G06F 15/21; G06F 15/30</b></p> <p>[52] U.S. Cl. .... <b>364/408</b></p> <p>[58] Field of Search ..... <b>364/401, 408</b></p> <p>[56] <b>References Cited</b></p> | <p style="text-align: right;">US005193056A</p> <p>[11] <b>Patent Number:</b> <b>5,193,056</b></p> <p>[45] <b>Date of Patent:</b> <b>Mar. 9, 1993</b></p> <hr/> <p>Groups Structure Funds as Partnerships”, p. 25, column 3 (Eastern Edition).<br/>Data Sources, Computer Associates International, Inc., 1989, pp. J-416 to J-426.</p> <p><i>Primary Examiner</i>—Roy N. Envall, Jr.<br/><i>Assistant Examiner</i>—David Huntley<br/><i>Attorney, Agent, or Firm</i>—Pennie &amp; Edmonds</p> <p>[57] <b>ABSTRACT</b></p> <p>A data processing system is provided for monitoring and recording the information flow and data, and making all calculations, necessary for maintaining a partnership portfolio and partner fund (Hub and Spoke) financial services configuration. In particular, the data processing system makes a daily allocation of assets of two</p> |
|---|---|



# Copyright: format protection

The screenshot shows the BBC One website interface. At the top, there is a navigation bar with 'BBC' logo, 'Sign in', and menu items for News, Sport, Weather, Capital, Culture, Autos, TV, Radio, and More... A search bar is also present. Below the navigation, a large banner features the 'one' logo and the 'The Voice UK' logo. A text box below the banner reads: 'Home Episodes Clips Ne... Four superstar coaches search for The Vo... of their voice.' Below this, there is a video thumbnail for 'Coach Announcement' featuring 'Kylie Minogue, will.i.am, Sir Tom Jones an...'. The overall layout is clean and professional, typical of a major broadcast network's website.

The screenshot shows the RTBF website interface. At the top, there is a navigation bar with 'RTBF.BE', 'INFO', 'SPORT', 'CULTURE', 'OUFTIVI', 'TV', 'RADIO', and 'VIDÉO'. Below the navigation, there is a search bar and a 'Google' search box. The main content area features a large video player for 'BATTLE: MITCHELL - STEVEN' from 'The Voice Belgique'. The video player includes a play button, a title, and a description: 'Nogmaals genieten van The Battle tussen Mitchell en Steven. Ze zingen 'It Will Rain' van Bruno Mars.' Below the video player, there are four smaller video thumbnails: 'ZOOM BOB MARI FY BFI T', 'The Voice Holland concert', 'BACKSTAGE MFT', and 'PLAATS NU EEN OPTIE OP DE WINNAAR SEIZOEN 4!'. The overall layout is dynamic and engaging, with a focus on video content.



# Copyright: format protection business methods



| ReferendumWijzer                         |   |         |                   | Verantwoording |  |
|--|---|---------|-------------------|----------------|--|
| Terug                                    | Resultaat Referendumwijzer  | Thema's | Scores Stellingen |                |  |
| <b>Thema: Europese instellingen</b>      |   |         |                   |                |  |
| 1  | Eén miljoen Europese burgers moeten samen het recht hebben een onderwerp op de Europese agenda te zetten.           | +       | +                 |                |  |
| 2  | Het Europees Parlement moet op meer Europese beleidsterreinen over wetten kunnen besluiten.                         | -       | +                 |                |  |
| 3  | Het Nederlandse parlement moet samen met een aantal andere parlementen een voorstel van de Uniekunnen terug sturen. | +       | +                 |                |  |
| 4  | Het vetorecht van de lidstaten moet op alle terreinen behouden blijven.   | +       | -                 |                |  |
| 5  | De Raad van Ministers moet achter gesloten deuren vergaderen.   | -       | -                 |                |  |
| 6  | Elke lidstaat moet het recht hebben het lidmaatschap van de Europese Unie op te zeggen.                             | +       | +                 |                |  |
| 7  | Het tussen lidstaten roulerende voorzitterschap van de Europese Unie moet behouden blijven.                         | o       | -                 |                |  |
| 8  | De Europese Unie moet regelmatig overleg voeren met kerken.   | -       | +                 |                |  |
| <b>Thema: Sociaal beleid en economie</b> |   |         |                   |                |  |
| 9  | De Europese Unie moet grondrechten voor haar burgers vastleggen.  | +       | +                 |                |  |
| 10                                       | Het Europees Parlement moet kunnen meebeslissen over wetten tegen discriminatie.                                    | +       | +                 |                |  |
| 11                                       | Wetgeving over kunst en cultuur is alleen een zaak van de lidstaten.  | +       | -                 |                |  |

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Justitie

Stelling 21

Lidstaten moeten uitspraken van rechters van andere lidstaten erkennen.

eens

niet eens / niet oneens

oneens

<< 1 2 3 4 5 6 7 8 9 10 11 12 13 14 15 16 17 18 19 20 21 22 23 24 25 >>

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Verantwoording

Terug
Resultaat Referendumwijzer
Thema's
Scores Stellingen

**Resultaat**

Uw opvattingen komen voor

## 68%

overeen met de Grondwet.

**Mate van overeenkomst met de grondwet per thema**

|                                |      |
|--------------------------------|------|
| Europese instellingen          | 56%  |
| Sociaal beleid en economie     | 80%  |
| Milieu en landbouw             | 100% |
| Justitie                       | 62%  |
| Defensie en Buitenlands beleid | 50%  |

**Peiling**

Meedoen aan de peiling voor het Referendum Grondwet Europa?

> klik dan hier

**Waardering Europese Unie**

U heeft de stellingen voor de Waardering Europese Unie niet beantwoord. U krijgt geen resultaat te zien.

[Klik hier wanneer u alsnog deze stellingen wilt beantwoorden.](#)

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# Copyright: format protection

- **Well established: TV-programmes**

- Dutch Supreme Court: Una voce particolare

- **New: business methods**

- District Court The Hague 27 April 2005 Referendumwijzer

- **What is the strategy?**

- Situation unclear
- Case law still developing
- Completely accepted in business in media sector
- Might fill the gap for investors
- Prepare in case this confirmed in the courts
- File evidence of the creation of the format and its priority

# Develop a strategy

- What exactly are your assets?
- What are their distinctive features?
- Which rights should you invoke to protect those?
- What actions need to be taken for protection?
- What is your market and where will it go?
- Don't take a national approach, rights may vary!
- Which competing rights are surrounding your assets?
- What can you afford to invest?
- How can you postpone investments?

# Exploiting your protection

- Building a licensing strategy
- What about transfer pricing and taxation of royalties?
- Which legal entity should be the right owner and where should it be?
- Allocate the investments to the right owner!
- Beware of competition law issues



Thank you **& Bird & Bird**

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