



Rigorous empirical
research on
intellectual property



International
Trademark
Association



26th April 2021

How to protect your business and increase its value with trademarks and designs?

Host: Claudia Tapia, Chairperson, 4iP Council

Presenters:

- **Kate O'Rourke**, Partner and Head of Trade Marks at Mewburn Ellis LLP, England
- **Mascha Heidelberg**, Junior Partner and Certified IP Lawyer at Müller Schupfner & Partner, Hamburg, Germany
- **Sandra Sophia Redeker**, Partner in the Intellectual Property group at SKW Schwarz and co-managing partner Berlin office





Rigorous empirical research on intellectual property

STUDENT CONTRIBUTION



Patents to climate rescue: how intellectual property rights are fundamental to the development of renewable energy


Arielle Aberdeen

October 2020

The Value of Connectivity in the Automotive Sector

Prof. Bowman Heiden
Center for Intellectual Property (CIP), Chalmers University of Technology
The Hoover Institution, Stanford University

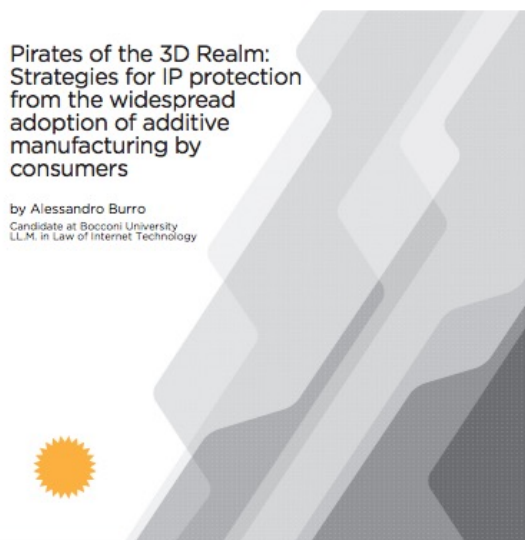
December 2019



4iP Council
Research Award Winner 2019

Pirates of the 3D Realm: Strategies for IP protection from the widespread adoption of additive manufacturing by consumers

by Alessandro Burro
Candidate at Bocconi University
LL.M. in Law of Internet Technology



Case Law post CJEU ruling *Huawei v ZTE*



4iP Council | Case law home | CJEU Huawei v ZTE | German court decisions | Italian court decisions | English court decisions | English/Irish court decisions | Romanian court decisions | French court decisions | Dutch court decisions | National Courts Guidance

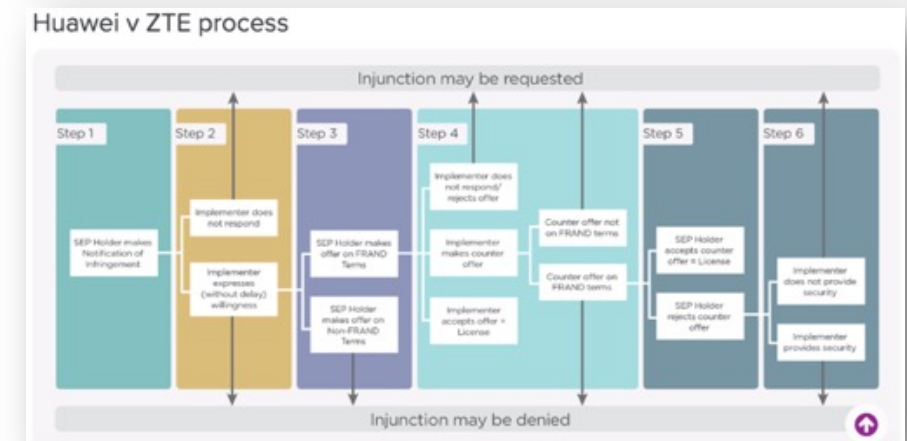
Authors & contributors

National Courts Guidance

Negotiating Licenses for Essential Patents in Europe

Increased clarity provided on the principles established by the Court of Justice of the European Union in *Huawei v ZTE*.

The Court of Justice of the European Union clarified, in *Huawei v ZTE* (Case No. C-170/13), European law relating to the availability of injunctive relief for infringements of FRAND-based standard essential patents. In doing so, the Court provided a legal framework focused on the good faith



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4iP Council Rigorous empirical research on intellectual property

4SMEs
Types of IP
Benefits of IP
IP for Business Growth
4 Reasons to Patent
4 Reasons 4 Copyright
4 Reasons 4 Design Rights
4 Reasons 4 Trademarks
SME Features
Research

EU Strategy
As Open As Possible, As Closed As Possible: Challenges Of The EU Strategy For Digital Future
By Geneva Bruzzone and Konrad Delackere

1. The 2020 Package on Shaping Europe's Digital Future
On February 19th, 2020, a few days before the outbreak of COVID-19, the European Commission published a package of four documents on the digital transformation in the EU: a general communication on shaping Europe's digital future, a European strategy for data, a white paper on artificial intelligence (AI) and a report on the safety of products and liability in the era of AI, Internet of Things and robotics.

When designing data access rules, policymakers should be aware of the potential risks to innovation. On the one hand, a fair share of the benefits of their innovation investments should be understood and balanced. Openness and exclusivity are two sides of a coin that must be managed carefully when shaping Europe's digital future.

■ Geneva Bruzzone, Senior Fellow, LUSS School of European Political Economy and Deputy Director of the Institute for Innovation and Entrepreneurship

Sion solar powered e-car

Alfonso Gambardella explores the function of patents in our societies

Slides now available

We will forge positive visibility of women in IP



Click 'Stay Informed' on www.4ipcouncil.com to discover our **research news** and **future webinars** topics. And why not sign up @4ipcouncil on twitter.

4 REASONS TO PATENT

- 1 - MARKET ACCESS
- 2 - NEGOTIATING
- 3 - FUNDING
- 4 - STRATEGIC VALUE

Explore how patents add value with our [interactive guide](#).

4 REASONS 4 COPYRIGHT

- 1 - COMPETITIVE EDGE
- 2 - REPUTATION
- 3 - COLLABORATION
- 4 - FUNDING

Explore the benefits of copyright with our [interactive guide](#).

4 REASONS 4 TRADEMARKS

- 1 - DIFFERENTIATION
- 2 - PROTECTION
- 3 - REPUTATION
- 4 - REVENUE

Explore the benefits of trademarks with our [interactive guide](#).

4 REASONS 4 DESIGN RIGHTS

- 1 - EXCLUSIVITY
- 2 - COMMERCIALISATION
- 3 - REPUTATION
- 4 - VALUE

Explore the benefits of design rights with our [interactive guide](#).

Which types of intellectual property do you need?

Filter table columns

	PATENTS	COPYRIGHTS	DESIGN	TRADEMARKS	TRADE SECRETS
What do they protect?	Inventions, ideas and processes in all areas of business. For examples of successful examples see here .	Any form of original intellectual creation. See also here .	Any form of original intellectual creation. See also here .	Any form of original intellectual creation. See also here .	Any form of original intellectual creation. See also here .
Examples of what is protected	Software products and processes in all areas of business. For examples of successful examples see here .	Audio-visual works, literary, graphic, architectural, databases, software, designs, literary, musical, graphic, and other creative works. See also here .	Any form of original intellectual creation. See also here .	Any form of original intellectual creation. See also here .	Any form of original intellectual creation. See also here .
How are my rights protected?	Prevents unauthorized making, using or selling of the patented invention.	Prevents the work being copied, distributed or made available online. Related rights: Public performance and display of the work. See also here .	Prevents the work being copied, distributed or made available online. See also here .	Prevents the work being copied, distributed or made available online. See also here .	Prevents the work being copied, distributed or made available online. See also here .
How long is my innovation protected?	Up to 20 years.	Life of the author plus 70 years after their death (depending on the country).	Up to 15 years.	Up to 10 years.	Up to 10 years.
Do I have to register it?	Yes, filing an application to a patent office is required. Have an patent applications on here .	No, copyright protection arises automatically with its creation. See also here .	Yes, filing an application to a design office is required. Have an design applications on here .	Yes, filing an application to a trademark office is required. Have an trademark applications on here .	Yes, filing an application to a trade secrets office is required. Have an trade secrets applications on here .



INTA, the International Trademark Association.

INTA a global association of brand owners and professionals dedicated to supporting trademarks and related intellectual property (IP) to foster consumer trust, economic growth, and innovation.

We organize education events, advocate for better legislation and practices on IPRs and provide resources.

Our membership comprises nearly 6,500 organizations from 185 countries. **The organizations represent more than 34,350 professionals, including brand owners from corporations of all sizes -major corporations and small- and medium-sized enterprises.**

We also have law firms, nonprofits, government agency members, professors, and law students.

More on <https://www.inta.org/resources/for-smes/> for practical information and tutorials tailored made for SMEs.



How to protect your business and increase its value with trademarks and designs?



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Partner, SKW Schwarz, Berlin

Member of the INTA Pro Bono Committee
Term 2018/19.

A brief introduction to Trademarks and other IP Rights

Why bother?

A well protected product increases company value and secures its future! *

*See: Stephen Key, Forbes, 2019
(<https://www.forbes.com/sites/stephenkey/2019/03/27/8-strategies-to-strengthen-your-business-using-intellectual-property/>)

Patents
(i.e. new brakes)

Designs
(i.e. «innovative»
car design)



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Trademarks
(i.e. Fiat logo)

Copyright
(i.e. manuals)

Kinds of IP – Without registration

- Some IP is created automatically
 - Confidential information (trade secrets)
 - Copyright
 - Unregistered design right
 - Unregistered trademark rights



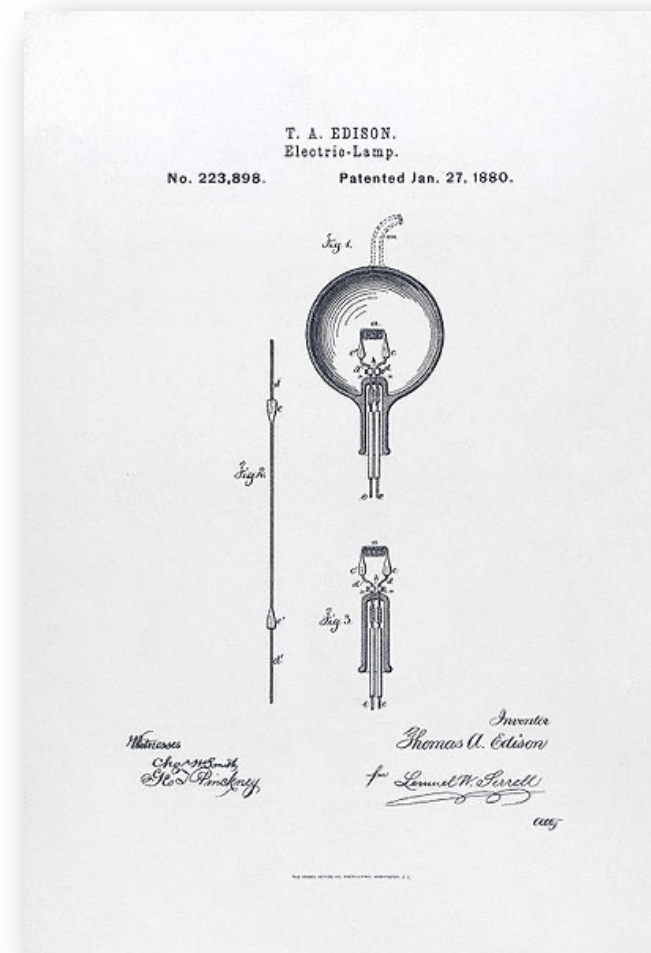
Kinds of IP - Registration

- For others, action is needed to bring them into existence

- Registered trademarks
- Registered designs
- Patents



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What may be protected?

Patents

- Protect how something works
- Novel, inventive, and industrially applicable inventions
- Absolute right to exploit commercially for 20 years in exchange for disclosure

Registered Trademarks

- Protect “designation of origin”, reputation – ‘brand’
- Any sign, capable of being graphically represented and of distinguishing goods & services
- Absolute protection, unlimited time

Registered Designs

- Protect how something looks
- New and individual appearances of a product
- Absolute protection for 25 years (community designs)

Copyright

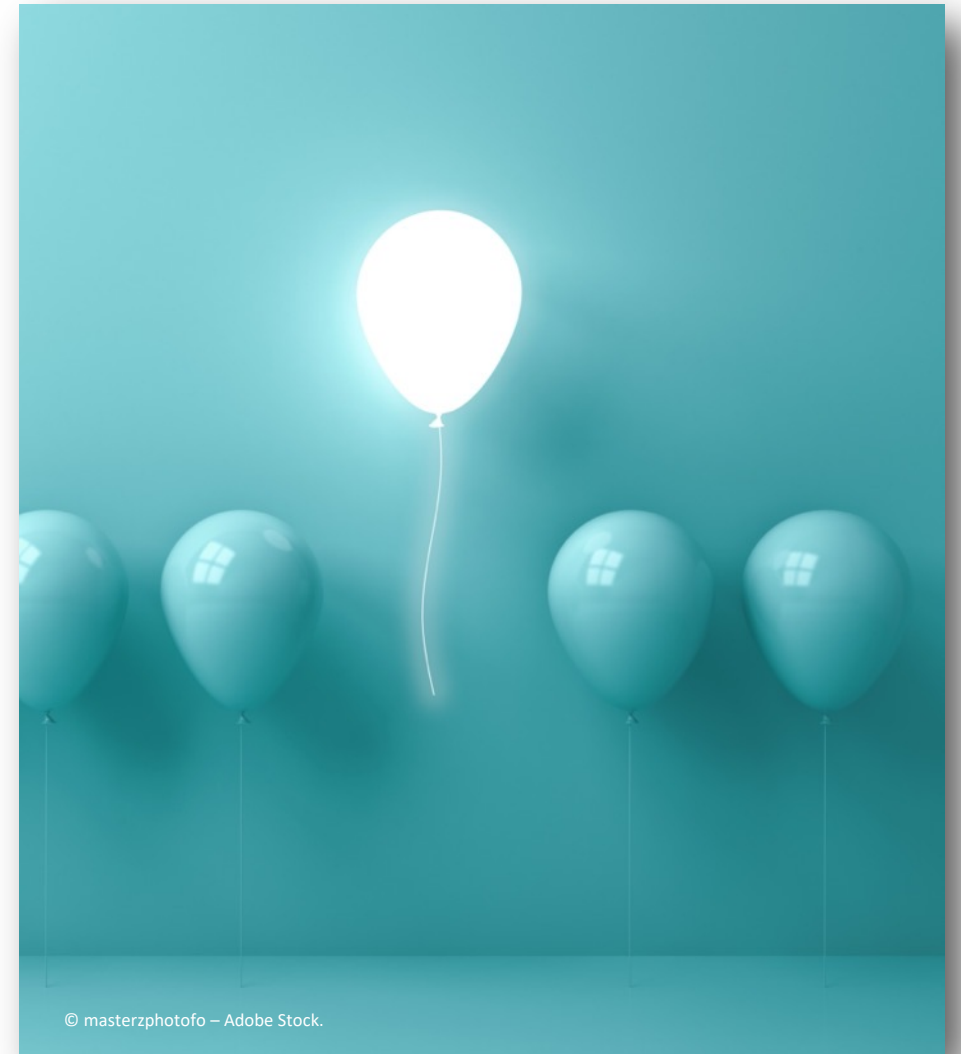
- Protects expression of ideas, literary works, computer programs
- (Fixed) original “literary and artistic works”
- Absolute protection for life of author + 70 years (EU)

Today's Focus: Trademarks & Designs

Trademark Functions

(Registered) Trademarks

- Distinguish you from competitors
- Enable your customers to identify your quality products
- Protect your reputation
- As a consequence, strengthen and boost your company!



Trademark (Definition)

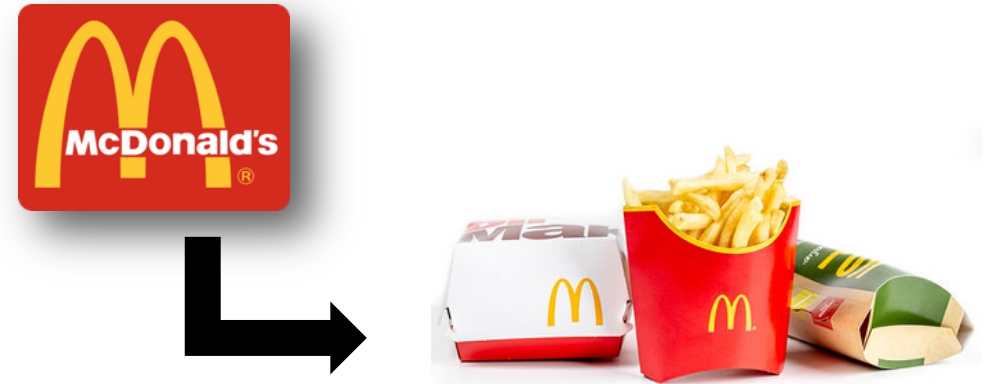
Exemplary Definition in Art. 3 Dir. (EU) 2015/2436:

A trademark may consist of **any signs, in particular words, including personal names, or designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds**, provided that such signs are capable of:

(a) **distinguishing the goods or services of one undertaking from those of other undertakings; and**

(b) being represented on the register in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.

→ No trademark without defined goods or services!

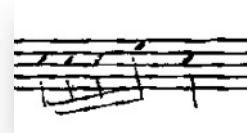
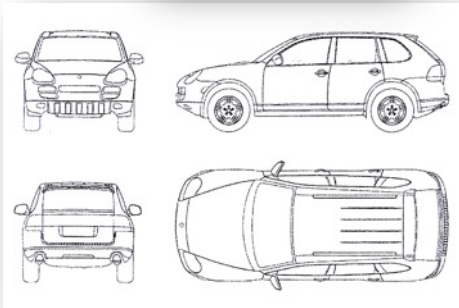


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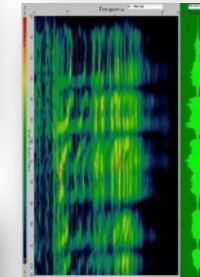


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Types & Forms of Trademarks



- Word/Figurative/Combination
- Slogans
- 3D Mark
- Color
- Sound
- Smell
- Hologram
- Tactile mark
- Movement Mark
- Other



Another option: Registered Designs

- Potential Trademarks and Registered Designs may have something in common and may be an addition/alternative to each other.
- ‘design’ may comprise 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;
- Must be new and individual
- Differences to trademark: Independent from goods & services, ends after term, does not identify “a source”
- Consideration: Narrow(er) scope of protection vs. lower costs



Designs: Forms & Types



**Technical
Designs**



Packaging



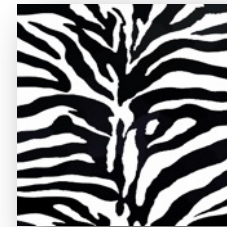
Logos



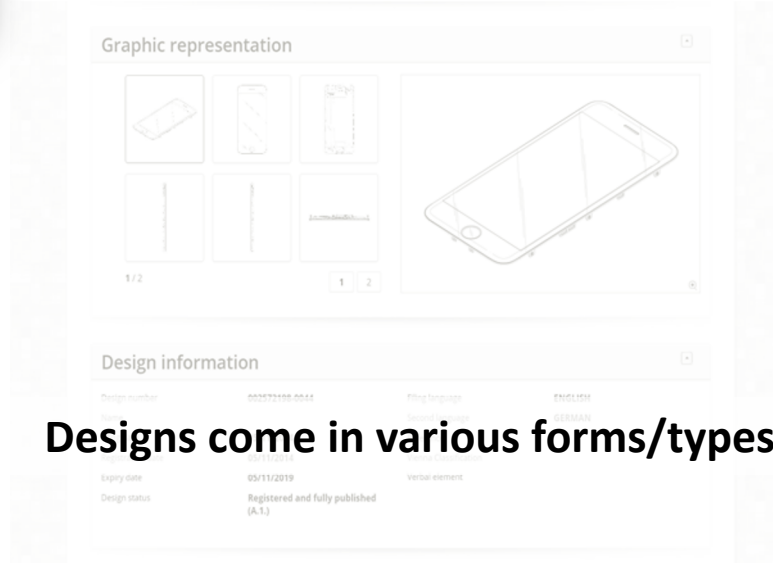
Clothing



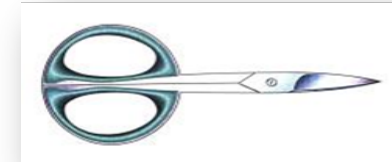
Jewellery



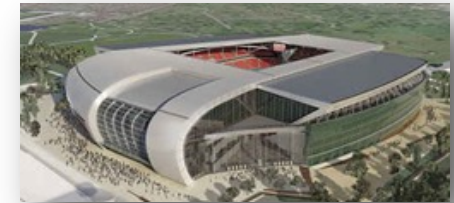
Patterns



Designs come in various forms/types:



**Functional and
ornamental items**



Buildings

Getting an IP right registered – Four Questions



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I. What?

Do I need a trademark or a design?

II. Any problems?

Make a clearance search!

III. Form?

Word/Figurative/Other Trademark?

IV. For what (Trademarks only)?

Define goods & services for protection.

V. Where?

- National
- International (Worldwide, EU)



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IP registered, what's next?

You are not done: A registered IP right needs maintenance!

- Should be used (“Use, don’t lose!”)
- Should be enforced against infringers
- May need market monitoring structures
- *Optional:* File customs application for effective anti-product-piracy measures





Pro Bono Clearinghouse



memberoperations@inta.org

What is the Pro Bono Clearinghouse?

- The goal of the Clearinghouse is to bolster the protection of trademarks by matching the formidable abilities of INTA's attorney members, acting on a pro bono basis, with the needs of low-income clients, small to medium enterprises, not-for-profit, and nonprofit or charitable organizations.
- The Clearinghouse is limited to trademark-related pro bono cases.

Who Are We?



Who is Eligible?

Individuals

Non-profit

Small to Medium
Enterprises

Not-for-profit

Pro Bono Virtual Legal Clinic: June 15, 2021

- The INTA Pro Bono Committee is pleased to announce that its upcoming virtual legal clinic will take place on **Tuesday, June 15, 2021** at 11AM EST. This online program is a single-day event, designed like a walk-in legal clinic where qualified applicants from anywhere in the world can consult with volunteer trademark attorneys on an individual pro bono basis with personalized advise.
- Attorney volunteers will be available to answer legal questions, explain the trademark registration process, and direct applicants to local services that might be able to further assist them at the conclusion. The one-hour clinic will be limited in scope to trademark clearance and prosecution matters.
- It is anticipated demand for this clinic will be high, so applicants must register in advance.

ssutton@inta.org



Learn More

Visit our Pro Bono Website

www.inta.org/resources/pro-bono-clearinghouse



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research on
intellectual property



Thank you

Q & A

Forthcoming webinars - registrations open on 4ipcouncil.com

18 May 2021, 16.00-17.00 CEST	As Open As Possible, As Closed As Needed: Challenges Of The EU Strategy For Data	<ul style="list-style-type: none">• Ginevra Bruzzone, Senior Fellow, LUISS School of European Political Economy and Deputy Director General Assonime• Prof. Koenraad Debackere, Department of Management, Strategy and Innovation & ECOOM Research Center, KU Leuven R&D
8 June 2021, 10.00-11.00 CEST	EUIPO-4iP webinar: IP licensing – Best practice and common pitfalls	<ul style="list-style-type: none">• Mark Snelgrove, Partner - IP Solicitor, Potter Clarkson + an SME representative (tbc)