

Mentor Guide

Session 2:

Understanding IP and its Applicability to Mentee's Invention

 1 HOUR



INNOVATION COUNCIL

Session Objective

The objective of this session is to review the different types of IP rights and the considerations for their use, and to explore which IP rights may make sense for your mentee and why.

To facilitate this objective, during this session, you will discuss the subject matter protected by different IP rights and generally the legal protection afforded by each of them. Further, the session should conclude with the mentee having a good understanding of which IP rights apply to her invention/creation.

Discussion and Suggested Questions

Provide an overview of different IP rights, namely, patents, trademarks, copyrights and trade secrets

Patents

Patents are intended to protect any new and useful process, machine, article of manufacture, or composition of matter, or any new and useful improvement thereof. They allow the patent owners to exclude others from making, using, selling or importing products or using processes that are covered by the patents. They provide 20 years of protection from the filing date of a patent application. Patent owners can seek injunctive relief and damages for infringement of their patents. A separate category of design patents may be used to protect the ornamental aspects of a product.

It is important to note that patent protection and legal enforcement is limited to the country or region in which the patent is granted, and that countries may require the first patent application to be filed in the country where the invention was made.

For commercialization purposes, patents may be used for product exclusivity, licensing to others who desire to include the patented invention in their products, an outright sale to another party, or even as collateral for financing R&D activities.

After a brief patent tutorial, the mentor should pause and ask the mentee if she has any questions regarding patent protection. Bear in mind that the mentees may have already received WIPO training about the basics of patents and other IP rights.

Trademarks

A trademark is a word, name, symbol, or device that is used to indicate the source of the goods, to distinguish them from the goods of others and create goodwill for the manufacturer of products that bear the trademark. Trademark rights may be used to prevent others from using a confusingly similar mark, but not to prevent others from making the same goods or from selling the same goods or services under a clearly different mark. Like patents, trademark owners may seek injunctive relief and damages for infringement of their trademarks.

As is the case with patents, trademark protection and legal enforcement is limited to the country or region for which it is granted.

For commercialization purposes, the trademark is applied to products sold by the trademark owner, or licensed to others to use on their products. A good example of trademark licensing is in franchise businesses, which in many cases are independently owned. However, when licensing a trademark, it is important to participate in the quality control of the licensed product.

After the tutorial on trademarks, the mentor should pause and ask the mentee if she has any questions regarding trademark protection.

Copyright

Copyright is a form of protection provided to the authors of "original works of authorship" including literary, dramatic, musical, artistic, and certain other intellectual works, both published and unpublished. Copyright protection generally gives the owner of copyright the exclusive right to reproduce the copyrighted work, to prepare derivative works, to distribute copies or phono-records of the copyrighted work, to perform the copyrighted work publicly, or to display the copyrighted work publicly. Copyright may also be used to protect the source code and object code forms of software.

It is important to note that the copyright vests upon creation of an original work, but it is important to include a copyright notice on each such work to inform the public that the work is protected by copyright law. Generally, it is not necessary to register the work for which copyright protection is desired although some jurisdictions may require registration before pursuing legal enforcement of the copyright or prompt registration to collect statutory damages and attorney fees.

Injunctive relief and damages are available for infringement of a copyright. There are international treaties that provide for recognition of copyright protection among the countries that are signatories to the treaties. Thus legal enforcement may be pursued in any of the signatory countries.

Copyrighted materials may be sold or licensed depending on the nature of the materials themselves. Software applications are good examples of copyrighted works that are typically distributed under a license. The license typically limits transfer to, and use by, others to increase the potential customer base and maximize profit. Books are good examples of copyrighted works that are sold. The purchaser has no restrictions on the use or transfer of the book other than it cannot be copied.

After the tutorial on trademarks, the mentor should pause and ask the mentee if she has any questions regarding trademark protection.

Trade Secret

A trade secret is information that has either actual or potential independent economic value by virtue of not being generally known, has value to others who cannot legitimately obtain the information, and is subject to reasonable efforts to maintain its secrecy. All three elements are required; if any element ceases to exist, then the trade secret will also cease to exist. Otherwise, there is no limit on the amount of time a trade secret is protected.

Trade secrets may comprise formulae, practices, processes, designs, instruments, patterns, or compilations of information. They can protect any business information that provides an advantage over competitors.

There are no registration requirements for trade secrets. However, it is critical to keep the trade secret information confidential and not allow disclosure of that information outside of your organization. It is important to note that the ease of reverse engineering a product that contains any technical elements being considered for trade secret protection should be evaluated before making a final decision on how to treat that technical element. If that element is easily discernable by way of reverse engineering, then patent protection might be a more viable option.

Injunctive relief and damages are available for theft of the trade secret, and even criminal remedies are available in some countries. Legal enforcement is typically available in the country where the trade secret theft occurs.

Like other IP rights, trade secrets may be sold or licensed, but confidentiality provisions must be included in such transactions to preserve the trade secret.

After the tutorial on trade secrets, the mentor should pause and ask the mentee if she has any questions regarding trade secret protection.

Discuss the legal enforcement of IP rights

An important consideration in seeking IP rights is the legal environment in any given country or region. Countries with more mature court and administrative systems regarding IP litigation make it easier for IP rights holders to assess the likelihood of success to enforce their IP rights. In certain countries, there may be uncertainty in assessing the likelihood of success in enforcing IP rights. So, it is important to decide, especially with regard to patent protection, if it is worth it to incur the cost of procuring an IP right if there is high uncertainty as to if it can be adequately enforced in the relevant jurisdiction. This should be discussed further when discussing procurement of IP rights in session 3, and at the end of the mentoring program during session 4.

Based on session 1 information, discuss the applicability of each IP right to the mentee's invention

Determine which IP right(s) apply to protecting the mentee's invention and are best suited to accomplish the business plan of the mentee. The following questions may help the mentee to think through the different types of IP rights and how each may apply to her invention/creation.

- Based on your understanding of patent rights, do you think patent protection is a good way to protect your invention?
- If so, how do you think patent protection might help you achieve your business goals?
- Based on your understanding of trademark rights, do you think trademark protection is a good way to cover your product that includes your invention?
- If so, how do you think trademark protection will help you achieve your business plan?
- Based on your understanding of copyrights, do you think copyright protection is a good way to help protect your invention?
- If so, what written materials related to your invention do you think should be protected by copyright?
- Based on your understanding of trade secret rights, do you think trade secret protection is a good way to protect any confidential information related to your invention?
- If so, you should identify the information that you think can be maintained in confidence and mark them appropriately.
- In session 3, we will discuss in more detail how to seek IP protection for your invention and how to appropriately mark written materials and documents you wish to protect with copyrights and trade secrets.