

# Intellectual Property for Business Competitiveness, an Overview

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# Startups and small innovative businesses

- Usually trying to do something innovative whether it is a breakthrough product or service or improving an existing product in an innovative or creative way.
- It is also likely that this is the only thing of value. As in they don't have buildings and inventory and other such assets.
- They are also likely to be young and few in number.
- They also have very little money.
- They are usually not aware of IP and even if they did they don't think it is important.

# IP IN THE BUSINESS JOURNEY

Expand to other countries

Grow your business

Protect creations and innovations

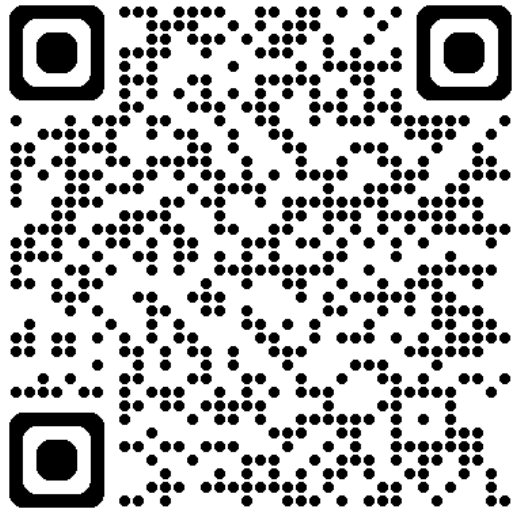
Market appeal

Innovative product or service

Manage risk

# Risks of not paying attention to the IP system

- Failing to protect means that you are vulnerable to being copied and, worse, others may acquire rights and prevent you from doing business
- Find out too late that your idea is not new, that your brand name/image is not new, and a lot of money would have been spent and which would now be lost having to go back to the drawing board.
- Disclosing things when you shouldn't.
- Assuming that you have rights that you don't, that if you pay for it, you own it, that IP rights are global.
- Not doing the paperwork with partners, collaborators and even the founders of the company that could result in your company not having the rights you thought it had.
- The IP system is a system of laws; there are deadlines to be managed, procedures to be followed, agreements to be signed and if you don't do these things again the consequences could be fatal for a young company.



# ENTERPRISING IDEAS

The success of a company can often be traced back to a single good idea.



## NAVIGATING INTELLECTUAL PROPERTY AS A STARTUP



SCAN ME

**WIPO IP**  
Diagnostics



# Copyright Management

Oscar Benito



### Patents

Protect technical inventions that improve the bicycle's performance

### Industrial Designs

Protect the overall appearance of a bicycle, or parts of it

### Trade marks

Protect bicycle brand names and logos

### Copyright

Protects the website and the user manual





# What is copyright

## Creative expression

- Original – independently created (by a human author)

## Fixed in a tangible form of expression

## No registration required

- USA and China – registration is possible

# What is not covered under copyright?

Ideas, procedures, methods, mathematical concepts

Facts and data

News

Names, short phrases or slogans [generally]

Official legal documents (laws, judicial judgements) [generally]

# Benefits of Copyright protection

Protection from the moment of creation

Granting exclusive rights:

- Reproduce/distribute the work or prepare derivative works based upon the work (for a limited period of time)
  - In other words, the possibility to prohibit others from use without permission
  - Receiving revenues/royalties from the use with permission
  - Licensing, transfer of rights, assignment
- Moral rights (for an unlimited period of time in most countries)
  - Right to be Named
  - Right of the work's integrity

# Who is the copyright owner?

Author ≠ Owner

- The ownership question may be regulated differently in different countries in cases of:
  - Work created by employees as part of their job
  - Work commissioned
  - Work created by several authors
  - Derivative works

Author = human?

# Work created by Employees

Work created as part of the employment. In some countries:

- an employer will automatically own copyright, unless otherwise agreed, or
- the transfer of rights to employer (the company) should be specified in an employment contract', or
- the employer gets automatically an exclusive licence to the work and the employee retains ownership

# Work commissioned

“A client goes to an advertising agency and pays them to design a new logo. The agency employs a freelance designer to produce the design. Nothing is said about copyright. Who gets the copyright in the logo?”

This is what happened in 2003 when Doc Martens asked an agency to create a new logo combining their existing Dr Martens and AirWare logos. The combined logo has continued to appear on Dr Martens footwear ever since.

# Work created by several authors

Joint authors, but all being employed by same company

Joint authors employed by different companies

# Derivative work

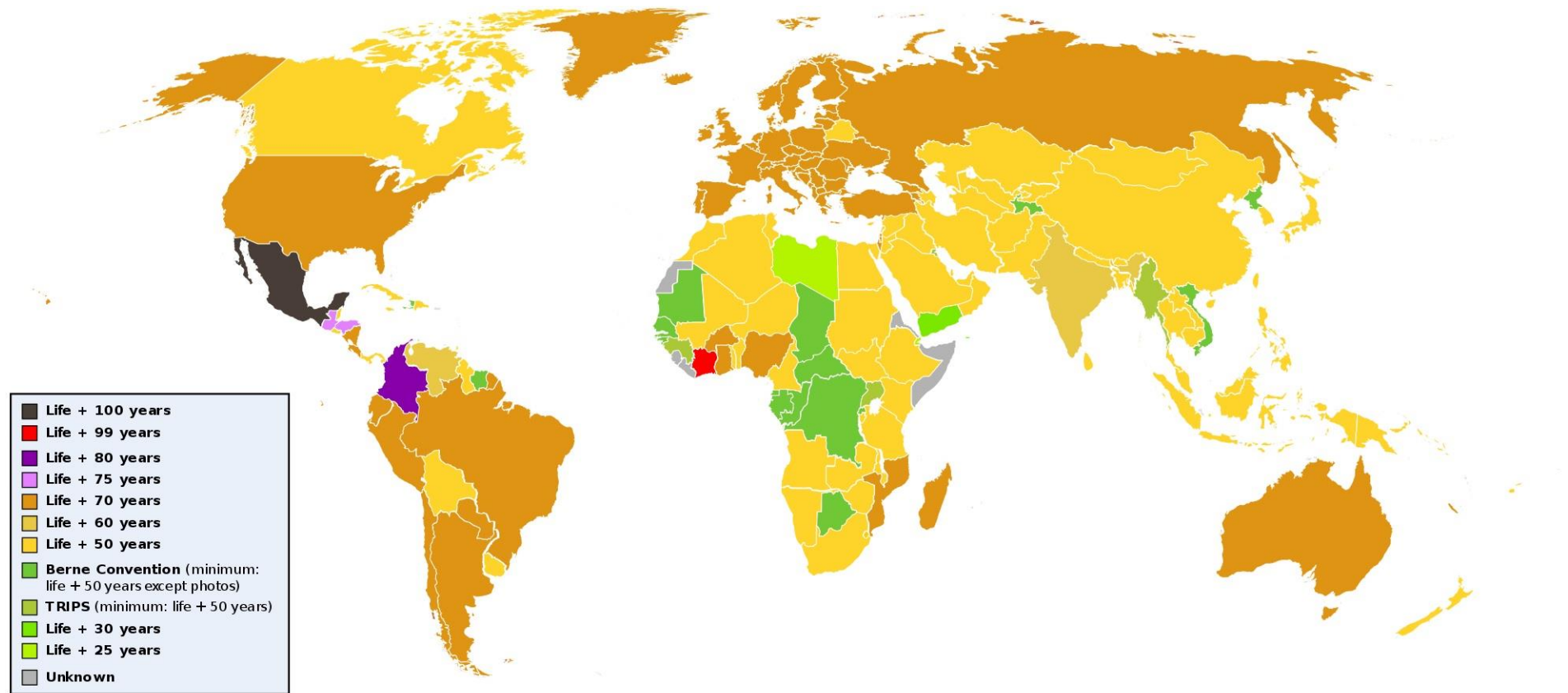
Is 'derivative work' if a substantial part of the original work was used

Consent is required from the owner of the original work

Derivative work attract copyright protection



# How long does copyright protection last?



**Moral rights:** In some countries perpetual, in others expire together with economic rights

# When can I use copyright work that is not mine?

‘It is on the internet, so I can copy it, right?’

‘Hyperlinks are surely fine, right?’

‘I am only copying it for internal use in my company, is that OK?’

**Rule of thumb: prior consent (permission) is required**

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Buying, licensing

Exceptions and limitations

Public domain

# Exceptions and limitations (“fair use” concept)

Vary from one country to another

- Scientific, teaching, research
- Citation
- Parodies or criticism
- non-commercial private use
- Certain reproduction in libraries and archives
- Making accessible copies for use by people with a disability
- Temporary digital copying exception

# Public domain

Work that was never protected by copyright (like facts or discoveries)

Work whose term of protection has ended either because it expired or the owner did not satisfy a previously required formality

# Creative Common Licences



Creative Commons is a non-profit organization

Developed a set of licenses intended to allow creators to indicate which rights they wish their works to carry and which they wish to relinquish

most widely used public copyright licenses

Not all 'open access' licenses are the same – always check

# Checklist when using Copyright Works of Others

## Step 1: Clarification if a work is protected under copyright

- Checking copyright notices, if any
- Searching in the register, if any
- Contacting Collective Management Organizations
- Contacting agencies/agents

## Step 2: Identification of copyright owner

- Contacting publishers, record producers, agents, distributors, legal representatives, etc.

## Step 3: Negotiating and concluding licensing agreement

- Terms and conditions, scope of right being used, remuneration, a term, etc. should be clearly defined

# What should you do if your copyrights are being used by others without your authorization?

Recommended to engage a copyright/trademark lawyer from the outset

Send a letter known as a “cease and desist letter” to the alleged infringer

Trigger a takedown notice

Negotiate a licence

Alternative dispute resolution out of court (mediation and/or arbitration)

Court proceedings

# Patent Management

Professor Jay Erstling





# Innovation

## Why encourage innovation

- What is it
  - Ideas/solutions that bring about change?
- Innovation programs
  - What is the purpose
  - What are you hoping to achieve
    - Solving customer problems
    - Winning new customers
    - Entering new markets
    - Creating new products
    - Improving internal processes
    - Improving efficiency
    - Raising brand awareness
    - Repositioning image
    - Developing a global product/presence
  - IP is a byproduct of innovation and innovation programs

# What is a patent?

A document that grants exclusive rights to the inventor or owner of an invention for a limited period of time

- Invention: a technical solution to a specific problem in a field of technology
  - Product or process
- Exclusive rights: right to exclude others from making, using, selling, offering for sale or importing
  - Granted in exchange for the obligation to *disclose* the invention

# Patenting Essentials

## Requirements for getting a patent

- Novelty (not disclosed)
- Inventive step (non-obviousness)
- Industrial applicability (useful)

## Not every invention is patentable

- Varies by country
- Discoveries of things already existing in nature
- Scientific theories or mathematical methods and formulas
- ....

# Patents

## Non-patentable subject matter (cont'd)

- Plants or animals (other than microorganisms)
- Methods or rules for doing business, playing games or performing purely mental acts
- Methods of treatment for humans and animals and diagnostic methods
- Inventions that are contrary to public order or morality

# Patents

## Applying for a patent

- Disclosure: a patent application must sufficiently disclose and describe an invention for it be “carried out” by a “person skilled in the art”
- Applying in more than a single country
  - Right of priority

## Elements of a patent application

- Title, abstract, background, description (with “embodiments”), drawings, and CLAIMS
  - Claims define the scope of the exclusive right

# Patenting Essentials

## Exclusive rights

- Right to make, use, sell, offer to sell, import
- If a process, right to make the product from the patented process

## Limitations

- Prior user rights, experimentation, working requirement, invalidation of the patent

## Enforcement – a private obligation

- To stop *infringement* (violation of an exclusive right)
  - Willful, unintentional

# To file or not to file

How different is the invention from the state of the art?

How much of a market disrupter/game changer is the invention likely to be

How financially sensible would it be to implement the invention

How easy is it to detect the invention

How long is the invention likely to be used

Will customers/clients have a better experience because of the invention

What is the size of the market likely to be?

Important to keep in mind that patents are a long-term investment

- Alternatives: publication or trade secret
- Similar questions apply to filing internationally

# Developing an IP Strategy

An IP strategy needs to be directly linked to, and dependent on, the business strategy

## Steps to an IP strategy

- Understand the business
- Establish a strategic direction
- Define the goals
- Share the strategy

Need to know why IP is important to the business and what you are trying to achieve

- Is it: increasing profit, market share, growth, liquidity, improving exit strategy, helping the business survive



# Developing an IP strategy

Need to know the current IP position

- Does it exist? Is so, what is it?
- Role of IP audit
  - Internal and external
  - Strengths and weaknesses
  - Business context – products, geographic markets, financial position, risks, organizational culture

# Establishing a strategic direction

Should develop an IP mission, principles, vision, goals, operating principles

- The mission: why does IP matter to a business
  - To increase value, protect investments, ensure freedom to operate, generate competitive advantage
- Principles: how does the business want to operate
  - Respecting third-party rights, willingness to assert rights, encouraging open source and collaboration
- Vision: the long-term goals
  - Largest patent portfolio, SEPs, strong licensing presence, international presence?

# Defining the goals – goal setting

What do you need to succeed

- SMART criteria: specific, measurable, achievable, realistic, time-bound
- Infrastructure, policies, systems
- Financial (generating revenue), defensive (reducing risk), strategic (increasing market share, reputation), enterprise (increasing value of the business)
- Prioritize goals
- Get buy-in and support

# Portfolio management

An IP portfolio is an integral part of the business environment and should be managed to benefit the business

- Goal is to create value and manage costs
  - Short- and long-term
- Portfolio needs to be aligned with the business strategy
  - Needs to be able to evolve as the business strategy evolves
  - Should be influenced by level of sophistication and activity of the business
    - How important are patents, trademarks, designs...
    - What role can licensing in/out play
    - What is the industry IP environment like

# Portfolio management

- Typical roles of portfolio management
  - Managing IP budget
  - Invention selection and evaluation (invention harvesting)
    - IP review committee
    - Deciding what to file
  - Foreign filing decisions
  - Brand management
    - Use, renewal, competitive watching
  - Portfolio maintenance and portfolio reviews
  - Monitoring competition (analytics) and IP environment
  - Mapping and landscaping (filling gaps and blocking competitors)
  - Managing IP acquisitions (evaluating, integrating, divesting)

# Patent protection

Goal of patenting: to generate value by

- Securing market position
- Blocking competition
- Generating licensing income
- Securing financing
- Introducing new product lines into the market
- Expanding geographic scope
- Advancing the public good

If you cannot identify a goal, you should question whether patenting is worthwhile

# Essential role of the claims

Rights are defined by the claims

- The description, drawings, and abstract are used to interpret the claims

Example: “Solar-Reflective Infrared-Emissive Paint”

- Inventors created an ultra-white paint that is the whitest white paint ever made. The paint reflects 98.1% of sunlight while emitting infrared heat. Because the paint absorbs less heat than it emits, a surface coated with the paint is cooled below the surrounding temperature without consuming power, reducing reliance on air conditioning, cooling down buildings, and helping to curb climate change.

Claim:

1. A solar-reflective infrared-emissive paint comprising a particle-polymer composite containing particles in a polymeric matrix, wherein the particles are nanoparticles or microparticles, the paint does not contain a metallic component, and the paint exhibits high reflectance for the solar spectrum wavelengths of 0.3 to 3 micrometers and high emissivity for wavelengths of 8 to 13 micrometers.

# Trade Secret Management

Professor Jay Erstling





# What is a trade secret?

Virtually any technical or business information that is secret, and that imparts value to your business because it is secret

Three elements

- **Confidential** business information not generally known in the trade
- Has **commercial** value to the business
- The business owner has maintained **reasonable efforts** to maintain secrecy

In Sri Lanka, referred to as “undisclosed information” in the Intellectual Property Act

Think the secret formula for Coca Cola

# Why protect trade secrets?

You have information that competitors would want to know to better compete against you

It can be a valuable asset and source of income

It can help to maintain competitive advantage

You are developing technology with the goal of patenting, and you need to prevent disclosure

The value of your product is in NOT disclosing it

Allows the owner of the information to take legal action if the information is misappropriated

# What types of information may be protected?

## Technical and scientific information

- Product/manufacturing/development information
- Test/research results
- Computer technology
- Quality control methods

## Strategic information

- Business/marketing/advertising/investment strategies
- Business methods
- Market research and competitive intelligence reports

# What types of information may be protected?

## Financial information

- Financial forecasts
- Sales data
- Pricing information

## Commercial information

- Supplier/customer lists
- Databases/data compilations

# How are trade secrets protected?

By taking **affirmative steps** that are **reasonable under the circumstances** to maintain the secrecy of the information

- Generally a combination of physical, technical, and contractual steps
- Protection arises automatically if the criteria are fulfilled
  - No requirement to register
  - Protection can last forever as long as the information remains secret and no one else has independently created and disclosed the same information
  - No right to prevent others from developing the information independently
- Employees/business partners/third parties who have access to a trade secret must enter into non-disclosure/confidentiality agreements

# How does a trade secret qualify for protection?

The information must not be generally known or readily ascertainable by others

- If it would be difficult or costly for others to acquire the information without resorting to lawful conduct

The information must give the business a demonstrated competitive advantage because it is secret

The business must have implemented reasonable security measures

- Facility access controls; computer system protections; firewalls
- Limiting access to the information to only those “who have a need to know”
- Consistent use of non-disclosure/confidentiality agreements and employee training

# Limitations on trade secret protection

Independent development

Reverse engineering

Information becomes generally known

Leakage

# Brand Management (the role of trademarks and designs in creating a brand presence)

Oscar Benito







# What is a trademark?

- A **sign** that identifies and distinguishes the products (goods or services) of one enterprise from those of others
- Such a sign could consist of words, names, letters, numerals, drawings, pictures, shapes, colors, labels, or any combination of these. Taglines, advertising slogans and titles may also constitute trademarks
- In some countries, non-traditional trademarks are allowed such as single colors, three dimensional signs, moving images, holograms, sounds, smells, gestures, tactile marks and fluid/mutating trademarks

# Examples of trademarks

Purely figurative trademarks



**“HELLO KITTY®”** a character owned by the Japanese company Sanrio Company, Ltd.

Trademarks that include both figurative elements and words



**MCDONALD'S®**  
Used with permission from McDonald's Corporation

Non-traditional trademarks



**KRAFT®** Foods has a registered trademark for the Lilac Color per se for chocolate and chocolate products in numerous countries. (Single-color trademark)

# Relationship between trademarks, collective marks and certification marks

- **Trademarks:** Indicates commercial origin of goods
- **Collective and certification marks:** Indicate the association or certification of the goods
- **Geographical Indications (GI):** Indicates a specific geographical origin

# Why use trademarks?

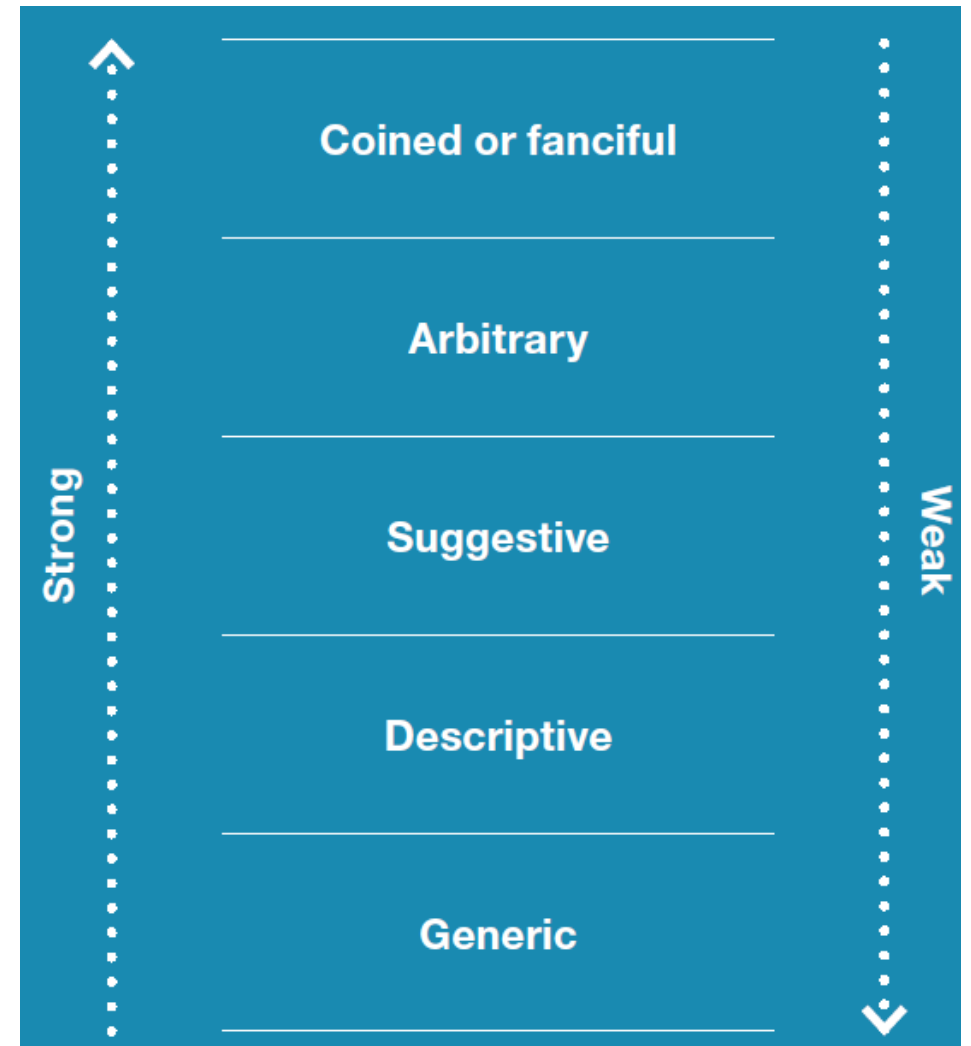
- Makes it easy for consumers to find your products
- An efficient marketing and communication tool
- The basis for building brand image and reputation
- Helps prevent consumer confusion
- A valuable and enduring business asset
- Attracts talented employees

# Most frequent mistake when selecting a trademark?

Selecting a name that cannot be protected with a trademark registration because it simply describes what they are offering.

Consequence: not being able to maximize the IP for your business and stop competitors imitating you

Ideally, a name implies, but does not describe, what your company offers





**Marc Randolph** · Following  
Netflix Co-Founder, Entrepreneur, Mentor  
& Investor  
2h · 🌐

Naming is always a challenge.

You need to find something that is memorable. That's sellable. That is evocative of what you are trying to do. That is available. And that doesn't mean something obscene in Lithuanian.

We didn't really like the name Netflix. It sounds like we were doing X-rated films. But it was the best we could do.

	Taken	Used	Notes
Take one	Y		
Take two	Y		
Scene One			
Scene Two			
Flix.com	Y	Utranet ISP	willing to deal
Fastforward	Y	404	available \$35k
Nowshowing	Y	NO	billings, but hard to m
<u>Directpix</u>	N		
Videopix	Y	NOT FOUND	

# Checklist for selecting a trademark

- Make sure the trademark is **easy to read, write, spell and remember**
- **Avoid imitating existing trademarks** (always carry out a search)
- Do your best to select a **strong trademark**
- Ensure that the trademark does not have any **undesired connotations**
- Check whether **domain names** and **social media accounts** are available



# Don't overspend in creating a logo

- Logo will help create a connection with customers, but will not alone sell products
- While you want it to be unique and have meaning, it is very easy to overspend on creative agencies
- Do you know how much Nike paid for the "swoosh" logo? \$35 - Check YouTube  
Creator of Nike's famed 'swoosh' honored in 1983

# What should you register?

- Plain block caps are best for word marks - protect your mark in any form
- Separate application for your logo, if you have one
- Do you have a strapline or slogan?
- What else? Packaging design, colours or shapes of products

# Protection of trademarks

Legal protection for a trademark is obtained through registration and/or, in some countries, through use

Even in countries where trademark rights are available through use it is advisable to register

# Why to register trademarks?

Not required to have a trademark registration to use a trademark, launch a product, or carry on your business

- Protection against misuse by others
- Easier to enforce than unregistered rights
- Best tool to deal with counterfeit goods
- An asset to earn you revenue and often essential to prospective investors

# Exclusivity provided by trademark registration

A registered trademark allows you to prevent others from marketing **identical or similar products** under an **identical or confusingly similar trademark**.

So, you will be able to prohibit competitors from:

- Affixing the trademark to goods or their packaging;
- Stocking or selling goods bearing the trademark or supplying services under the service mark;
- Importing or exporting goods under the trademark;
- Using the trademark on business papers, websites and in advertising.

# Can identical trademarks coexist?

Identical trademarks used for identical goods or services can coexist without any risk of infringing another's rights in **different countries**, provided the trademark is not considered to be a well-known mark.

Identical or similar trademarks may also coexist in the same country, provided there is **no likelihood of confusion** in the marketplace because they are used for **different goods or services**

# Do you need to register all small modifications to your trademark?

Many trademarks have changed slightly over the years in order to modernize the image of a business or adapt to new advertising media.

You will have to consult with the trademark office(s) concerned or a trademark agent as to whether a specific change will require the submission of a new application and payment of relevant fees.



**The SHELL® logo is property of the Royal Dutch Shell group of companies.**

# Can I use trademark for a different product?

When filling in your trademark application form, in most countries you are required to indicate the goods and services for which you wish to register your trademark, and to group them according to **classes**.

These refer to the classes in the **trademark classification system**.

If you have registered a trademark for a particular product and want to use it for a product in a different class, then you should file a new trademark application.



# Can you register a trademark without having used it?

You may apply for registration before you have used the trademark but some countries will not officially register it until you have shown **proof of use**.

In these countries, the concept of use is very important and use is a **requirement for registration** or a prerequisite for filing an opposition or a court case claiming infringement.

# Dos and Don'ts for proper trademark use

- Distinguish the trademark from surrounding text
- Use your trademark consistently
- Don't use the trademark as a noun
- Don't use the trademark as a verb
- Don't use the trademark as a plural
- Establish clear and cogent trademark best practices and guidelines

# Why is it important how you use your trademark?

Protection may get lost if your trademark is not properly used.

A trademark may become **generic** if it becomes so widely used that it becomes a common name to designate the relevant good or service. Lead by example and not use your trademark in a generic way.

Trampoline has been ruled generic in the US, so other companies may use that name for an athletic jumping apparatus as well – Check YouTube ‘Don’t say VELCRO video’

# Should you use TM or ®?

In most jurisdictions, ® denotes a registered trademark, whereas ™ can be used for a trademark that is in the process of being registered

## WARNING:

- Incorrect use of ® in a country where the mark is not registered amounts to a criminal offence in most countries
- Incorrect use of the TM symbol in a country where the mark is unregistered might trigger unfair competition claims in some countries

In order to avoid these risks, you might decide not to use the ® and TM symbols

You can also use phrases like 'ABC is a registered trademark of XYZ Limited', which you often see at the foot of websites or on printed material

# Can you use a competitor's trademark in your advertising?

Consult a local lawyer about the laws and regulations that apply to **comparative advertising** in that country.

Use a competitor's trademark in your advertising **fairly and properly**.

**Do not take unfair advantage** of the reputation of a competitor's trademark to promote your own business.

Be careful **not to alter** a competitor's trademark.

Obtain authorization from the trademark and copyright owner before using the **graphic** elements in your advertising (logo, label, design, three-dimensional figure). All such elements are likely to be protected by copyright law.

# Can other businesses resell your trademarked products without authorization?

Another business can normally resell trademark-protected goods bought from your business within the same country without having to seek your consent.

However, re-selling trademark-protected goods abroad is a different issue and depends on the local laws and whether the country of import has international or regional exhaustion of rights.

While developing your enforcement strategy, you should verify how parallel imports are handled, preferably by consulting a legal expert.

# Why is it important to detect infringements?

A competitor can take advantage of your reputation and take away your **sales**.

A competitor might harm your **reputation** by selling products of an inferior quality.

So, it is important to monitor the market:

- Monitor trademark applications
- Monitoring the Internet and your usual marketplaces
- Educating your employees about trademark rights and encouraging them to be on the lookout for infringements
- Customs watches

# When does another trademark infringe your rights?

When a competitor uses the *same* or a *confusingly similar* trademark for the *same* or *similar* products, in a country where your trademark is protected.

Advisable to engage a trademark lawyer. You may choose to send a letter known as a “cease and desist letter” to the alleged infringer. If not settled amicably, you would have to consider initiating court proceedings.



# How to handle counterfeits

- Contact an IP lawyer to advise you on how best to proceed
- Record your trademark(s) with the customs office
- Provide as much information as possible and cooperate with customs officials to make it easier for them to recognize infringing goods
- Upgrade packaging and security features on your product using sophisticated authentication technologies
- Carry out spot checks online with distributors that might be selling mixed genuine and non genuine stock
- Pursue online takedowns
- Dedicate a page on your website to educate customers where to buy genuine products and how to report suspicious items

# Portfolio management

- Renewals
- Change of address of trademark owner
- Change of name of trademark owner
- Change of owner

# Industrial Designs

The ornamental (aesthetic) appearance of a useful article

- Industrial design registration does not protect the product; rather provides exclusive rights for the artistic elements of the product
  - Shape, configuration, ornamentation, patterning
- An industrial design cannot be protected if the design is dictated by function or if the design itself is functional



Fabric patterns – DM/094167 IPEKER  
TEKSTIL

# Requirements for registration as an industrial design

## New (novel)

- Sometimes universal novelty; sometimes local novelty

## Original

- Not original if they don't significantly differ from known designs or combination of known design features

## Individual character

- When the overall impression on an informed user differs from the overall impression produced on such an informed user by any other design already available to the public.  
The degree of freedom of the designer shall be taken into account

# Features of Industrial Designs

Possible to also get protection for an unregistered design

- EU protection for both registered and unregistered designs

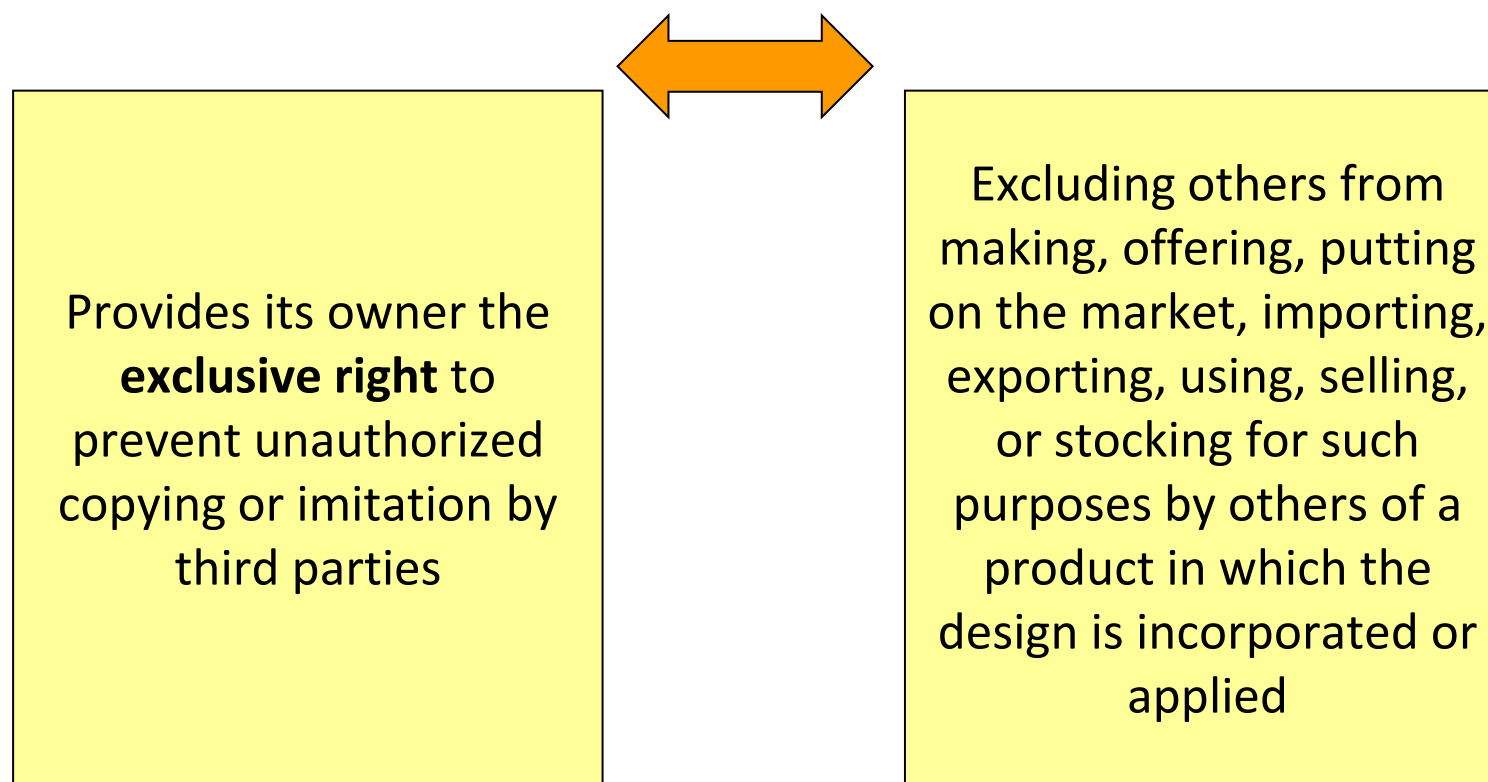
Duration of protection

- Ranges from 10 to 25 years
  - Most often 10 years but may be renewed once (total = 20)

An application for the registration of an industrial design consists primarily of drawings (or photos) of the top, bottom, and all sides of the article embodying the design

Designs created by employees hired to create designs are usually owned by the employer

# Scope of Protection of Industrial Designs



# Designs that cannot be protected

- Designs dictated solely by merely technical or functional considerations
- Designs featuring graphics which is against public order or morality
- Designs containing official state symbols, also their imitations
- Designs which infringe IPRs of other persons
- “Must-fit” designs (designs of interconnections)

# Licensing IP Rights – Technology Licensing

Professor Jay Erstling





# Licensing and Technology Transfer

Provides for the transfer and acquisition of intellectual property (technology)

- Principal methods are assignment and licensing
  - Both are contractual arrangements

## Terminology

- **Assignor**, **Licensor**, **Transferor**, **Franchisor** = the person or entity who owns the intellectual property and grants rights
- **Assignee**, **Licensee**, **Transferee**, **Franchisee** = the recipient of the rights

# Licensing and Tech Transfer (2)

## Assignment

- The sale by the owner of all exclusive rights in a patented invention and the purchase of those rights by another person or business
  - An assignor transfers to an assignee
    - When an assignment takes place, the assignor no longer has any exclusive rights; all exclusive rights now belong to and can be exercised by the assignee
    - If the invention is patented in more than one country, rights can be assigned on a country-by-country basis and to different assignees
  - The assignment takes place through the execution of an assignment agreement (a type of contract)
    - Assignments are filed in the national patent office

# Licensing and Tech Transfer (3)

## Licence agreement (licensing)

- A licence is the grant of permission by the owner of a patented invention to another person or business to perform one or more of the acts which are covered by the exclusive rights to the patented invention
  - A licensor grants permission to a licensee
    - The licensor remains the owner of the patent
  - A licence is limited to the country or countries where the licensor has a patent
  - The duration of a licence is generally limited to the duration of the patent
    - Because you cannot grant rights that you do not (or no longer) own
- You can license in or license out

# Licensing (4)

## Conditions that may be placed on the licence

- May be exclusive (the licensee is the only licensee) or non-exclusive (there can be multiple licensees)
- The scope of the licensee may be limited
  - Geographically
    - Can be limited to one country, a number of countries, or can be worldwide
  - Field of use
    - Can be limited to producing only certain products or using only certain processes (pharmaceutical product for the treatment of the coronavirus only)
  - Compensation
    - The type of payment that the licensor is to receive
      - Can be royalty, lump sum payment, or any combination
  - Warranties
    - Promises that each party must make to uphold the license, and defend it (or the patent) if challenged

Licence agreements are generally recorded with the national patent office and are part of the patent's “file history”

# Licensing (5)

## Know-how contract

- May be integrated into or separate from a licence agreement
  - Could include technical instructions, documents, photographs, blueprints, computer software, specifications for processes or machinery
  - May also include training

## Franchise agreement

- A business arrangement that combines the reputation, technical information and expertise of one party with the investment of another to sell goods and services
  - Based on licensing of trademark rights and “look and feel” of the business, but often entails licensed use of patented technology
    - Quality control is essential

## Joint venture or joint invention agreement

# Licensing (6)

## Compulsory licensing

- Licensing in the government interest to meet public need

## Ensuring equity in licensing (unfair licensing)

- Terms that may render a license agreement unenforceable
  - To require the importation of technology that is available locally
  - To require disproportionate payments
  - To extend the duration of a license beyond the duration of the patent
  - To require the licensee to transfer back to the licensor any improvements that the licensee makes
  - To impose restrictions on research
  - To exempt the licensor from liability

Despite possible hazards, licensing is a very effective means to maximize the value of intellectual property

# Licensing

## Grammar quandary

- In American English, “license” is both a noun and a verb. The spelling “licence” does not exist
  - I am going to negotiate a license agreement to license my IP.
- In the rest of the English-speaking world (I think), “licence” is the noun but “license” is the verb.
  - I am going to negotiate a licence agreement to license my IP.

# Why license

Raise revenue

- License out

Avoid risk

- Cross license
- License in

Disseminate the IP

Need a third party to exploit the IP

- Licensor lacks the capacity to exploit it

Allows new uses of the IP



# Key to licensing

- Defining the scope of the authorization and the scope of the limitations on that authorization to the mutual benefit of the licensor and licensee
- Important to have a clear sense of the purpose of the licensing arrangement
  - What is the desired outcome
    - Should be shared by both parties
  - What is being licensed
    - Including its value
  - Well defined and mutually acceptable terms of remuneration

A license arrangement should not be adversarial

- Should be an opportunity for both licensor and licensee to benefit

# Scope of the licence

## Questions to ask in negotiating a license agreement

- Who are the licensor and licensee
  - Corporation, subsidiary, division, tech transfer office, IP holding company, university?
- What is being licensed?
- Are there restrictions?
- What is the territory?
- What activities are included (manufacture, sale, distribution, all)?
- Are rights reserved?
- Is sub-licensing permitted?

# Scope of the license

## Questions (cont'd)

- What is the duration of the licence?
  - The life of the patent, or shorter?
- What is the remuneration?
  - Royalty
  - Lump sum payment
    - Upfront or periodic
  - Combination lump sum/royalty
  - Cross licence – an exchange of licenses
- How are conflicts resolved?

# Licensing IP Rights - Brand Licensing, Franchising and Merchandising

Oscar Benito



# Trademark licensing

- Owner continues to be the owner of the licensed trademark
- One or more other businesses are allowed to use the trademark

# Exclusive, Sole & Non-Exclusive licenses

**Exclusive license:** a single licensee has the right to use the trademark, which cannot even be used by the trademark owner

**Sole license:** a single licensee and the trademark owner have the right to use the trademark

**Non-exclusive license:** several licensees and the trademark owner have the right to use the trademark

# Quality control

- Owner to set guidelines and directions of use to licensees
- Owner to check compliance
- Risk of not setting in place quality controls:
  - if licensee mis-use your trademark, your reputation will suffer.
  - Without control, the mark will lose its function as origin of goods and potentially become vulnerable to revocation.

# Franchising

Franchisor has developed a particular way of doing business and expands the business by giving others (franchisees) the right to use the franchisor's proven business model in another location for a defined period of time in exchange for payment of initial and ongoing fees

The intellectual property rights involved:

- almost always include trademarks and copyright, and
- often include trade secrets, industrial designs and patents



# Merchandising

**Merchandising** is a form of marketing whereby an IP right (typically a trademark, industrial design and/or copyright) is used on a product to enhance the attractiveness of the product.

- Licensing out. For businesses that own famous trademarks (such as sports teams, universities, character/animation properties), licensing out trademarks to potential merchandisers can generate lucrative license fees and royalties.
- Licensing in. A business that manufactures low-priced, mass-produced goods, such as coffee mugs, candies or T-shirts, may make its products more attractive by using a famous logo or trademark on them.

# IP Issues in Managing a Digital Presence

Oscar Benito



# REMINDER Checklist for selecting a trademark

- Make sure the trademark is **easy to read, write, spell and remember**
- **Avoid imitating existing trademarks** (always carry out a search)
- Do your best to select a **strong trademark**
- Ensure that the trademark does not have any **undesired connotations**
- **Check whether domain names and social media accounts are available**

Website address is an important business identifier because customers use them to find and review businesses and products on the Internet. Same is applicable to social media platforms.

# Domain names – terminology

- **TLD - Top-level domain** refers to the characters after the last dot of the domain name (for example, the “.int” in www.wipo.int).
- **gTLDs - Generic TLDs** include “.com,” “.org,” and “.net.”
- **Newer gTLDs** include “.online,” “.life,” and “.app.”
- **ccTLDs - Country code top-level domains** denote countries: examples include “.lk” for Sri Lanka and “.us” for the United States of America
- **Second level domain** - the part of the name that precedes the dot
- **ICANN** - Internet Corporation for Assigned Names and Numbers (ICANN) is responsible for technical management of the domain name system

# Domain names – gTLDs and ccTLDs

- Most popular gTLDs is **.com**
- Fair assumption that all dictionary English words are registered as **.com**
- If desired domain name is already registered, then explore possibility to acquire **.com**
- **ccTLDs** are potentially less relevant for an international business
- All customers in countries where you operate might expect you own the relevant **ccTLD** – if not registered by you, then competitors or fraudsters might take them and potentially damage your business and reputation

# Domain names – most expensive recorded sales

Domain	Price	Sale date	Domain	Price	Sale date	Domain	Price	Sale date
Voice.com	\$30 million	2019	Z.com	\$6.8 million	2014	Ice.com	\$3.5 million	2018
<a href="#">360.com</a>	\$17 million	2015	Casino.com	\$5.5 million	2003	<a href="#">AltaVista.com</a>	\$3.3 million	1998
NFTs.com	\$15 million	2022	Slots.com	\$5.5 million	2010	Wine.com	\$3.3 million	2003
<a href="#">Sex.com</a>	\$13 million	2010	AsSeenOnTv.com	\$5.1 million	2000	Software.com	\$3.2 million	2005
<a href="#">Fund.com</a>	\$12 million	2008	<a href="#">Toys.com</a>	\$5.1 million	2009	Whisky.com	\$3.1 million	2014
<a href="#">Hotels.com</a>	\$11 million	2001	Korea.com	\$5 million	2000	<a href="#">Loans.com</a>	\$3.0 million	2000
<a href="#">Tesla.com</a>	\$11 million	2014	Clothes.com	\$4.9 million	2008	<a href="#">Vodka.com</a>	\$3.0 million	2006
AI.com	\$11 million	2023	Medicare.com	\$4.8 million	2014	Candy.com	\$3.0 million	2009
Connect.com	\$10 million	2022	<a href="#">IG.com</a>	\$4.6 million	2013	California.com	\$3.0 million	2019
Porno.com	\$8.8 million	2015	<a href="#">iCloud.com</a>	\$4.5 million	2011	Place.com	\$3.0 million	2021
<a href="#">Fb.com</a>	\$8.5 million	2010	GiftCard.com	\$4 million	2012	Help.com	\$3.0 million	2023
HealthInsurance.com	\$8.13 million	2019	<a href="#">Yp.com</a>	\$3.8 million	2008			
We.com	\$8 million	2015	HG.com	\$3.77 million	2016			
Diamond.com	\$7.5 million	2006	<a href="#">Mi.com</a>	\$3.6 million	2014			
Beer.com	\$7 million	2004	Shop.com	\$3.55 million	2003			

[https://en.wikipedia.org/wiki/List\\_of\\_most\\_expensive\\_domain\\_names](https://en.wikipedia.org/wiki/List_of_most_expensive_domain_names)

# Domain names – Cybersquatting

“Cybersquatting” is the practice of registering a domain name that is or includes a registered trademark for the purpose of blocking its use by the trademark holder, extorting money from the trademark holder or harming the brand

The Uniform Domain Name Dispute Resolution Policy (UDRP), designed by WIPO to address the bad faith registration and use of domain names. There are other providers besides WIPO providing similar services.

# Social media – are they important for your business?

Facebook

TikTok

X (formerly Twitter)

YouTube

LinkedIn



# Social media – terminology

- **Account** is not unique and it might be different from the handle
- **Handle** is unique and refers to the characters after @



# Digital - monitoring and takedowns

- Read your customers reviews
- Set up strategy on priorities for your business and when to act
- Engage with a monitoring service
- Trigger takedown requests (TM registrations and copyright)

# Marketplaces












Amazon

eBay

Facebook marketplace

## E commerce websites in Sri Lanka

From sources across the web

 Daraz	 Kapruka Holdings	 Wasi.lk
 Abans	 Takas	 SINGER
 Ikman.lk	 Nanotech Solutions	 Shopify
 Zigzag.lk	 Wow.lk	

Source: search on Google for 'e commerce platforms in Sri Lanka'

# International Filing Systems – Madrid and Hague Systems

Oscar Benito



# Registration of a trademark abroad

You can register your trademark abroad at any time. Take advantage of the Paris Convention priority – you have **six months** from the date on which you applied for protection in the first country to claim the right of **priority** for trademark protection in other countries

- **national route**
- **regional route** (e.g. EU trademarks)
- **WIPO international route - Madrid System** facilitates the registration and management of trademarks in multiple countries

# WIPO – Madrid system - Who can file an application?

- national of a Contracting Party, or
  - have a domicile, business establishment or habitual residence in the territory of a Contracting Party
- International application must be based on a national or regional trademark application or registration (aka basic mark)
- 115 Contracting Parties. Sri Lanka is **not** a Contracting Party



# WIPO – Madrid system – main advantages

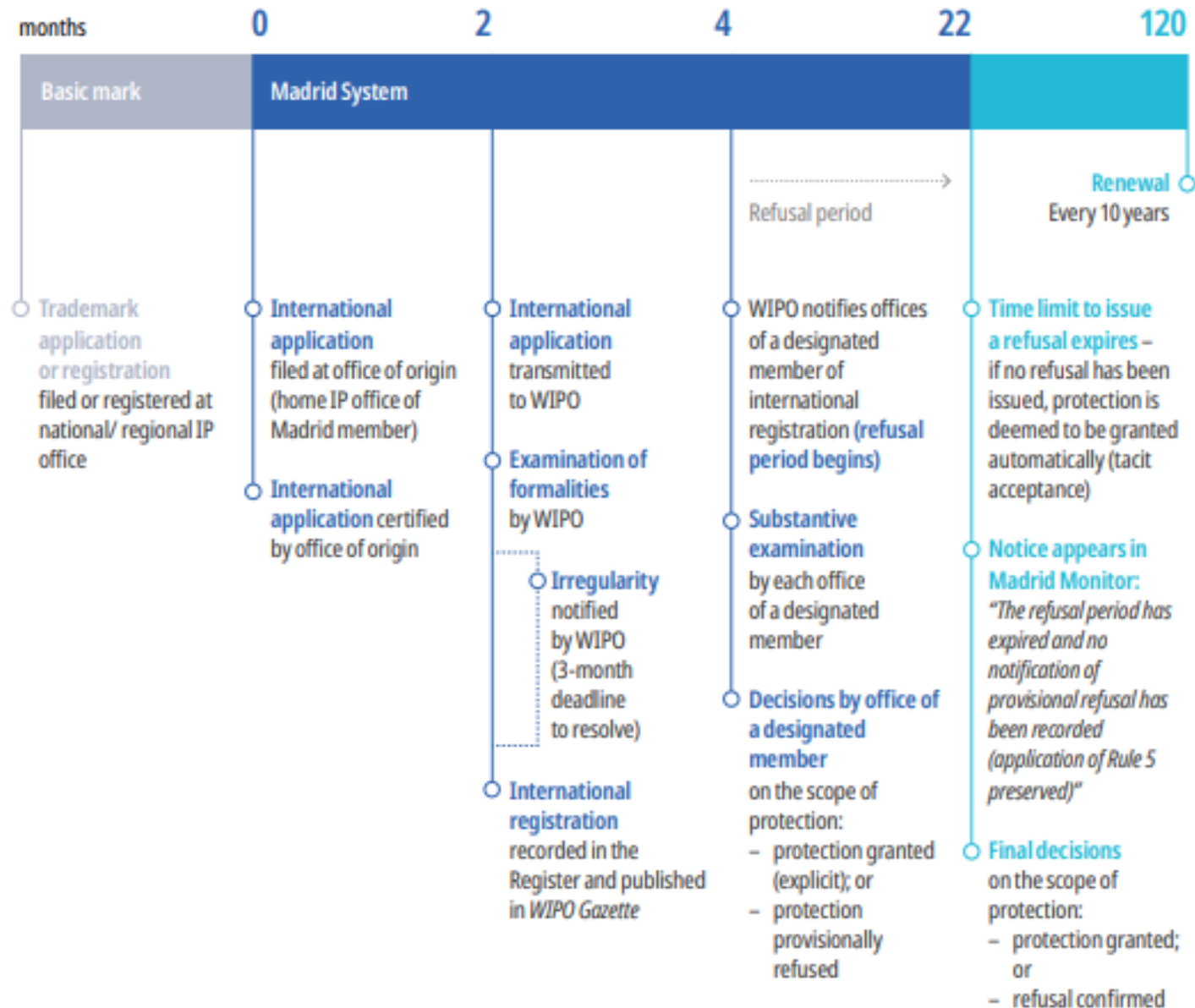
- one application
  - in one language
  - one set of fees in a single currency
- 
- ❑ Manage renewals and changes through a single central system
  - ❑ Flexible - expand your trademark to other countries through subsequent designation



# WIPO – Madrid system – main disadvantages

- **Central attack** - if within five years from the date of the International Registration the applicant's home application or registration ceases to have effect either in whole or in part, then the International Registration will be cancelled to the same extent. It would then be possible to convert into nationals claiming a date back to that of the International Registration.
- **Timings** - some countries/regions still do not advise that they have accepted a designation and so it has to be assumed that it is protected if the relevant time for advising of refusal has expired and no refusal has been advised
- **Enforceability** - Some countries have not yet enacted domestic legislation. It is therefore doubtful that designations will be enforceable

# WIPO – Madrid system – procedure



# Tools available

**Insert your list of goods and services in the IA (MM2) by choosing pre-classified terms from**

**TMclass**

<http://euipo.europa.eu/ec2/>  
and  
Madrid Goods & Services (MGS)  
<https://webaccess.wipo.int/mgs/>

**Use Madrid Monitor to check the steps of your IA up to registration and publication by WIPO**

<https://www.wipo.int/madrid/monitor/>

**Check how much you will have to pay for your international application (IA)**

**TIP**

Check in advance how much you will have to pay by using the Fee Calculator at:

<http://www.wipo.int/madrid/en/fees/calculator.jsp>



Find out about procedures and practices in Madrid Union members in the Madrid Member Profiles Database at

<http://www.wipo.int/madrid/memberprofiles/#/>

# International Registrations owned by Sri Lanka companies

Trademark	Image	Status	Or	Holder	Req. No	Req. Date	Nice Cl.	Vienna Cl.
AB AKBAR PREMIUM QUALITY 1969		 Active	TR	AKBAR BROTHERS LIMITED	1757251	2023-08-23	30	26.01, 26.04, 27.05
Stassen		 Active	HU	Stassen Exports (Pvt) Ltd.	1619965	2021-07-09	30	26.01, 26.04, 26.13, 27.05, 29.01
P&S PERERA AND SONS		 Active	AU	Perera and Sons Bakers (Pvt) Ltd	1590736	2021-04-12	30	24.03, 24.17, 27.05, 29.01
P & S		 Active	AU	Perera and Sons Bakers (Pvt) Ltd	1590358	2021-04-12	30	
JAF TEA		 Active	RU	Company «Jafferjee Brothers»	1484975	2019-06-21	30	05.03, 27.05
VR VERITÉ RESEARCH Strategic Analysis for Asia		 Active	SG	Verité Research Private Limited	1465666	2018-10-26	35	26.04, 27.05, 29.01
Acteav life		 Active	RU	Hiran Ajith Karunaratne	1393831	2017-10-09	30	27.05
Zylanica CEYLON TEA		 Active	UA	Ceylon Fresh Teas (PVT) LTD	1349649	2017-03-01	30	03.02, 24.09, 25.01, 27.05

# International Registrations owned by Sri Lanka companies

Susan.tea		 Active	UA	Dodampe Gamage Susantha	1315116	2016-06-15	30	05.03, 26.01
AYURVEDA LANKA		 Active	AT	Sumendra Hatthimuni Huber	1229735	2014-09-19	3, 5, 35, 41, 43, 44	05.05, 29.01
ELEMENT		 Active	RU	Femrich Lanka (Pvt) Limited	1167650	2013-06-07	30	27.05, 28.05
SebaSTea		 Active	RU	CAMELIA SCINENSIS (PRIVATE) LIMITED	1143677	2012-06-19	30	29.01
JAF TEA		 Active	RU	JAFFERJEE BROTHERS	1122116	2011-12-26	30	
Margo Tea		 Active	RU	Femrich Lanka (Pvt) Ltd	1084292	2011-06-16	30	01.15, 11.03, 25.01, 29.01
TARLTON		 Active	RU	VENTURE TEA (PVT) LTD.	1072104	2010-11-29	30, 35	
FemRich		 Active	RU	"Femrich Lanka" (Pvt) Ltd	1051682	2010-07-14	30	05.03, 27.05, 29.01
LOTUS-VILLA		 Active	AT	Sushan Sulochana HUBER	835165	2004-07-19	35, 43, 44	
N Noyon Calais		 Active	FR	NOYON LANKA (PRIVATE) LIMITED	833269	2004-06-24	26	26.04, 27.01, 27.05
No Verbal Elements		 Active	RU	KARUNARATNE HIRAN AJITH	803700	2003-04-11	30	28.05
HYLEYS		 Active	RU	KARUNARATNE HIRAN AJITH	803144	2003-04-11	30	

# Registration of an Industrial Design abroad

You can register your design abroad **within 6 months** from the date on which you applied for protection in the first country (aka Paris Convention priority), but not later because then your design will no longer be 'novel'

- **national route**
- **regional route** (e.g. EU Designs)
- **WIPO international route - Hague System** facilitates the registration and management of industrial designs in multiple countries

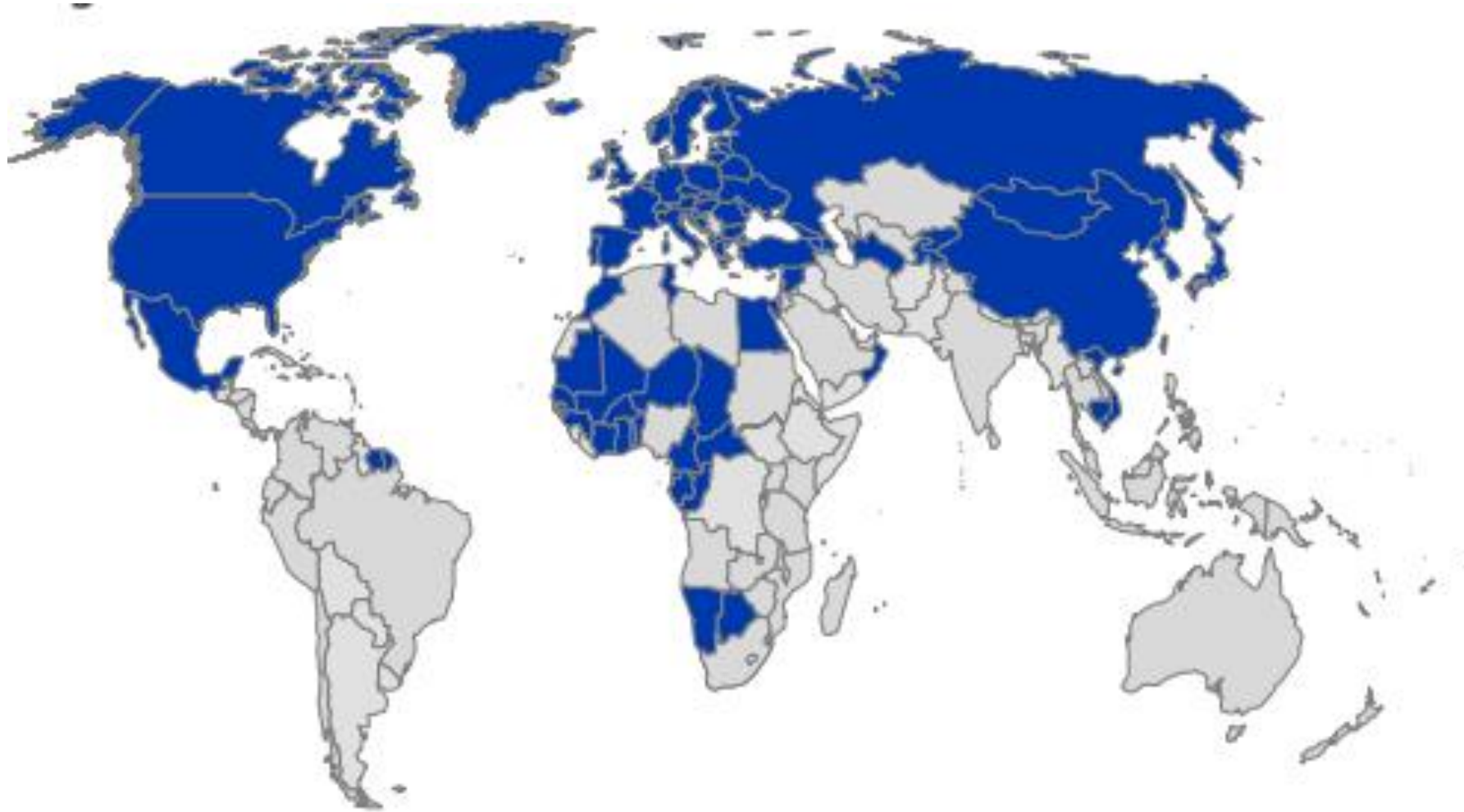
# WIPO – Hague system - Who can file an application?

- national of a Contracting Party, or
- have a domicile, business establishment or habitual residence in the territory of a Contracting Party

❑ Unlike the Madrid system, no prior national or regional design application or registration is required

❑ 79 Contracting Party. Sri Lanka is **not** a Contracting Party

# WIPO – Hague system – 115 Contracting Parties



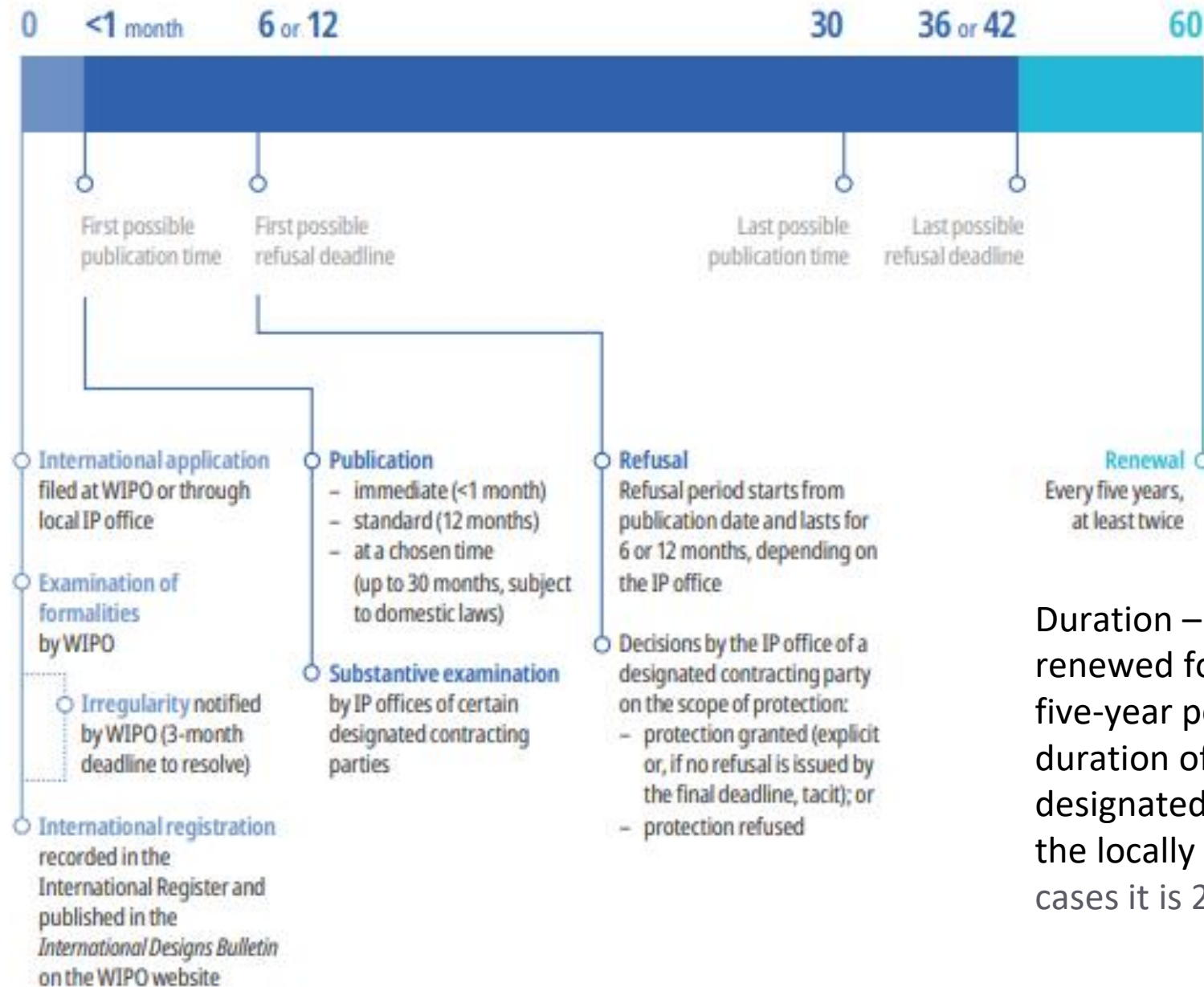
<https://www.wipo.int/edocs/pubdocs/en/wipo-pub-930-2024-en-hague-yearly-review-2024.pdf>



# WIPO – Hague system – main advantages

- one application of up to a 100 industrial designs
  - in one language
  - one set of fees in a single currency
- 
- Manage renewals and changes through a single central system
  - Time the publication of your registration to fit your business strategy

# WIPO – Hague system – procedure



Duration – valid for five years, may be renewed for at least two additional five-year periods. The maximum duration of protection afforded by each designated Hague member depends on the locally applicable legislation - most cases it is 25 years

# International Designs owned by Sri Lanka companies

The Hague Express Database – updated weekly – provides the status of and historical information regarding international design registrations governed by the 1999 and/or 1960 Acts of the Hague Agreement. Note: Information on international registrations published before 1999 is provided on a best effort basis.

**SEARCH BY** Design Names Numbers Dates Country

Designated contracting party =

Entitlement =

Applicant's contracting party =

Holder country =

search

**FILTER BY** Designation Locarno class Reg. Year \* Contracting party \* Expiration \* Holder \*

Display: List Sort: Count - desc filter

**CURRENT SEARCH**

HOLC:ES HOLC:LK LK

No documents match your query

# International Filing Systems – Patent Cooperation Treaty (PCT)

Professor Jay Erstling



# Patent Cooperation Treaty

The cornerstone of the international patent system

- Provides a worldwide system for simplified filing and processing of patent application
- Treaty established in 1970; entered into force in 1978 among 18 countries
  - Fewer than 500 applications in its first year
- Today: 157 countries, 277,500 applications and 664,700 national phase entries
- 2<sup>nd</sup> multilateral treaty in the field of patents
  - The system is governed by the treaty and a complex, evolving set of rules
  - Administered by “the International Bureau” of WIPO

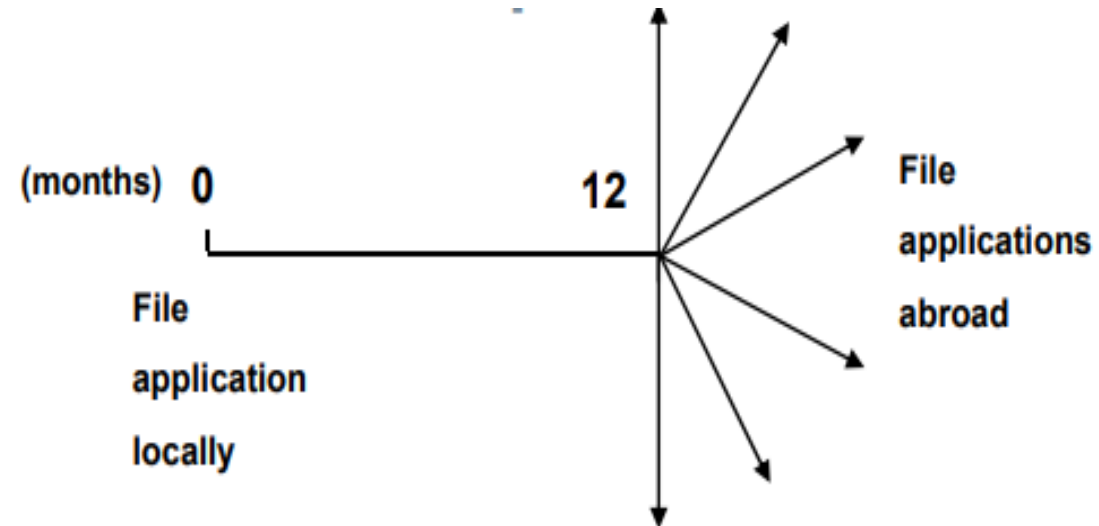
# PCT

## Advantages

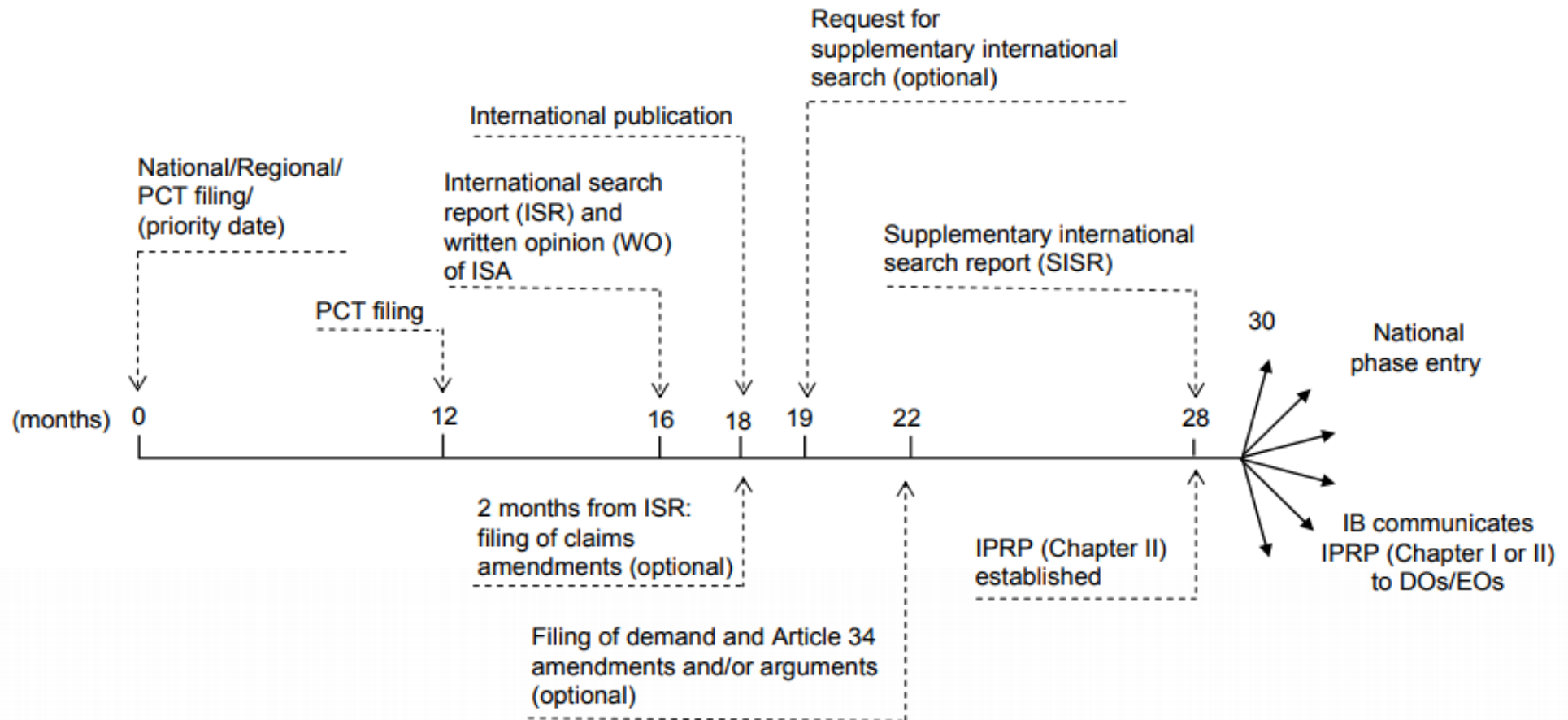
- Delays the major costs associated with internationalizing a patent application
  - Applicants get an additional 18 months before having to pay
    - Translation costs
    - Filing and examination fees
    - Cost of hiring foreign attorneys
- Gives applicants 18 additional months for deciding in which countries they want to pursue patent protection
- Provides important information for making sound patenting decisions
  - International search report and written opinion indicate the strength of the application and help strategize patent “prosecution”
- Harmonizes formal requirements
  - One application and one set of rules for 157 countries
- Protects applicants from certain inadvertent errors
  - Missing the priority date or other filing dates

## Paris Convention priority timeline

The traditional international filing route



# PCT Timeline





# When should you use the PCT?

## When does the PCT make sense?

- You need more time (an additional 18+ months)
- You are interested in licensing your invention
- You need/want to defer costs
- You want the additional benefits of an International Search Report and Written Opinion

## When does the PCT not make sense?

- You want protection in only 1 or 2 other countries
- You have the budget and don't need to defer costs
- You know that your invention merits foreign filing
- You don't need the additional information provided by an ISR and WO

# The PCT in Sri Lanka

Applicants file their applications electronically with WIPO in Geneva, Switzerland

- For purposes of the PCT, WIPO is called the “Receiving Office of the International Bureau, or RO/IB
- Applications must be filed in English
- Electronic filing minimizes filing mistakes

Applicants choose one of the following patent offices to serve as the International Searching Authority:

- IP Australia, European Patent Office, Korean Intellectual Property Office, or Swedish Intellectual Property Office

# International search and publication

Applicant selects an International Searching Authority (ISA) when filing the application

## The ISA

- Checks for unity of invention
  - A PCT application must relate to one invention or to a group of inventions that are linked together so that they form a single general inventive concept
- Searches for relevant prior art
  - Art made available to the public anywhere in the world by means of written disclosure prior to the international filing date (for the ISR) or the priority date (for the WO)
- Prepares an international search report (ISR) and written opinion (WO) of the ISA
  - Provides vital information on the likely fate of the patent application and provides an opportunity to amend the application to overcome defects
- Provides a non-binding opinion on the patentability of the invention

The application is published in PATENTSCOPE at about 18 months from the priority date

- Your application is now part of the world's body of prior art

# National phase: converting an international application into national applications

Some factors in selecting national phase countries

- Protect local manufacture
- Patent where competitors are located, especially where they manufacture
- Patent in major markets/major hubs
- Patent in export markets
- Effectiveness of enforcement

Start planning early

Think long term

# PCT website

<https://www.wipo.int/pct/en/>

- Check it out

# Using IP Databases - Patent and Technology Information

Professor Jay Erstling



# Why use patent information?

Avoid duplicating R&D

Assess the patentability of your invention

Avoid infringement

Exploit technology from patents that are not valid in Sri Lanka, were never granted, or are no longer in force

Identify technology trends and new directions

Find potential licensing or joint development partners

# WIPO's database: PATENTSCOPE

## Access to

- Published PCT applications and related documents
- Patent documents from cooperating national and regional offices

## PATENTSCOPE links

- <https://patentscope.wipo.int/search/en/search.jsf>
- Solar-reflective paint:  
[https://patentscope.wipo.int/search/en/detail.jsf?docId=WO2020072818&\\_cid=P20-LYNAAL-23064-1](https://patentscope.wipo.int/search/en/detail.jsf?docId=WO2020072818&_cid=P20-LYNAAL-23064-1)
- Solar-reflective paint search (solar-reflective AND paint):  
[https://patentscope.wipo.int/search/en/result.jsf?\\_vid=P20-LYNACL-24296](https://patentscope.wipo.int/search/en/result.jsf?_vid=P20-LYNACL-24296)



# PATENTSCOPE

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PCT publication 28/2024 (July 11, 2024) is now available [here](#). The next PCT publication 29/2024 is scheduled for Thursday, July 18, 2024. [More](#)

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Field	▼	Search terms...	
Front Page		WO2020072818	
			<a href="#">Query Examples</a>

# 1. WO2020072818 - METAL-FREE SOLAR-REFLECTIVE INFRARED-EMISSIVE PAINTS AND METHODS OF PRODUCING THE SAME



PCT Biblio. Data Description Claims Drawings ISR/WOSA/A17I2[a] National Phase Patent Family Notices Documents

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B05D 1/28 2006.1 C08K 3/36 2006.1  
C08K 3/30 2006.1 C08K 3/26 2006.1

## CPC

B05D 1/28 B05D 5/06 C08K 2003/2206  
C08K 2003/222 C08K 2003/2227  
C08K 2003/2241

[View more classifications](#)

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62/760,281 13.11.2018 US

## Publication Language

English [en]

## Filing Language

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## Designated States

[View all](#)

[Latest bibliographic data on file with the International Bureau](#)

## Title

[EN] METAL-FREE SOLAR-REFLECTIVE INFRARED-EMISSIVE PAINTS AND METHODS OF PRODUCING THE SAME  
[FR] PEINTURES À ÉMISSION INFRAROUGE ET RÉFLEXION SOLAIRE SANS MÉTAL ET LEURS PROCÉDÉS DE PRODUCTION

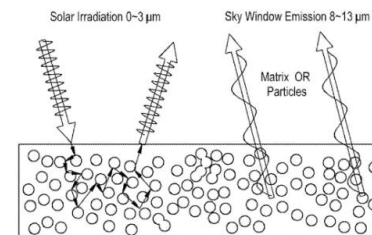


FIG. 2A

## Abstract

[EN] Metal-free compositions for solar-reflective infrared-emissive coatings and methods of producing the same. The paints are suitable for reducing the temperatures of objects below ambient temperatures between sunset and sunrise (nighttime) and part or full daytime (between sunrise and sunset) when such objects are subjected to direct sunlight. Such a solar-reflective infrared-emissive paint may include a particle-polymer composite containing particles in a polymeric matrix, wherein the particles are nanoparticles or microparticles, the paint does not contain a metallic component, and the paint exhibits high reflectance for the solar spectrum wavelengths of 0.3 to 3 micrometers and high emissivity for wavelengths of 8 to 13 micrometers.

[FR] L'invention concerne des compositions sans métal pour des revêtements à émission infrarouge et réflexion solaire et leurs procédés de production. Les peintures sont appropriées pour réduire les températures d'objets au-dessous des températures ambiantes entre le coucher du soleil et le lever du soleil (nuit) et durant une partie ou la totalité du jour (entre le lever du soleil et le coucher du soleil) lorsque ces objets sont soumis à une lumière solaire directe. Une telle peinture à émission infrarouge et réflexion solaire peut comprendre un composite à base de polymère particulaire contenant des particules dans une matrice polymère, les particules étant des nanoparticules ou des microparticules, la peinture ne contient aucun constituant métallique, et la peinture présente une réflectance élevée concernant les longueurs d'onde du spectre solaire de 0,3 à 3 micromètres et une émissivité élevée pour des longueurs d'onde de 8 à 13 micromètres.

## Related patent documents

[AU2019355035](#) [CN113015769](#) [EP3861076](#) [US20210403726](#)

# Other free, publicly-available databases

Google patents

Espacenet

USPTO Public Patent Search

DEPATISnet

# Patent mapping

Patent mapping is a visual representation of patent information

- Allows you to assess large sets of patent data – your own, a competitor's, or an industry's
  - What is the overall state of a technology, which areas of technology are covered with patents, which are ripe for further growth, where the growth areas are taking place, in what areas of technology are competitors filing, how patent filing patterns are changing, in which countries are competitors filing...

# Patent mapping : how to create a patent map

## Step 1: gather

- Define the data to include in the analysis
- Choose a database that covers the required information
- Define your query (dates, IPC, keywords, etc.)
- Collect data; remove noise, i.e. irrelevant or insufficient information
- Harmonize applicants' names

## Step 2: analyze

- Carry out a statistical analysis of structured information such as bibliographic data, inventors' names, titles of inventions, etc. Do text mining on unstructured information such as abstracts, descriptions and claims
  - Export the data (full data set) to a spreadsheet
  - Define the purpose of analysis (e.g. technologies, application)
  - Add categories of information to documents
  - Run a statistical analysis
  - Check results

## Step 3: visualize

- Visualize the results of your statistical analysis by creating your patent map. There are many different kinds of patent maps for various purposes and users. You can use various graphs to show the results of your statistical analysis, for example simple bar or line charts, area graphs or bubble charts. These are all forms of patent maps. (from the EPO website)

# Making a patent map: analyzing patterns of patenting of massage chairs

- Whole chair    seat    back    legs    arms    controls
- Strength
- Comfort
- Stability
- Portability
- Posture
- Weight
- Adaptability
- Country of filing
- <https://patentscope.wipo.int/search/en/result.jsf? vid=P20-LYN9V0-14797>

# PATENTSCOPE Simple Search

Using PATENTSCOPE you can search 117.6 million patent documents including 4.9 million published international patent applications (PCT). [Detailed coverage information](#)

PCT publication 28/2024 (July 11, 2024) is now available [here](#). The next PCT publication 29/2024 is scheduled for Thursday, July 18, 2024. [More](#)

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Search terms...  
massage AND chair



[Query Examples](#)



1. [206867397](#) [MESSAGE CHAIR](#)

CN - 12.01.2018

Int.Class [A61H 1/00](#) ⓘ Appl.No 201621356690.5 Applicant SUZHOU SPRING [MESSAGE CHAIR](#) CO., LTD. Inventor ZHAO XIN

The utility model discloses a [massage chair](#), including frame and the [massage chair](#) core of setting in the frame, its characterized in that: the frame includes the base and sets up the ARC support frame on the base, and this ARC support frame includes cushion portion and back portion, the both sides of cushion portion are equipped with a first axis of rotation respectively, and the one end of this first axis of rotation is articulated with cushion portion, and the other end is articulated with the base, the both sides of back portion are equipped with a second axis of rotation respectively, and the one end of this second axis of rotation is articulated with back portion, and the other end is articulated with the base, two second axis of rotation between connect through the connecting rod, be connected through the telescopic link between this connecting rod and the base. The utility model provides a [massage chair](#) uses linear motor, through the back of the [chair](#) that pushes away, draws [massage chair](#), realizes the back of the [chair](#) and lies down backward, when the back of the [chair](#) is lied down backward, through the whole mechanism of wobbling pivot forward of the back of the [chair](#), realizes back of the [chair](#) move along, dodges out the wall, has practiced thrift the space.

2. [204363484](#) [WAIST AND NECK PROTECTING MESSAGE CHAIR](#)

CN - 03.06.2015

Int.Class [A47C 9/00](#) ⓘ Appl.No 201520009796.7 Applicant AMASS [MESSAGE CHAIR](#) (SHANGHAI) CO., LTD. Inventor WANG CHUN

The utility model provides a waist and neck protecting [massage chair](#) which comprises a [chair](#) board, armrests and an S-shaped backrest attached to the back of the human body. A telescopic support is connected to the center of the bottom end of the [chair](#) board. The backrest is arranged behind the [chair](#) board. A first air bag is arranged in the backrest corresponding to the waist of the human body. An air box is arranged at the rear end of the backrest. A vertically-arranged push plate is arranged in the air box. A rotary handle penetrating through the outer wall of the air box is arranged behind the push plate and in threaded connection with the outer wall of the air box. A second air bag is arranged in the portion, between the push plate and the backrest, of the air box, the second air bag is communicated with the first air bag through a communicating pipe arranged on the backrest, the armrests are arranged on the two sides of the middle of the backrest, a [massage](#) head is arranged on the surface of the front side of the backrest, a neck rest is arranged at the upper end of the backrest, and a neck [massage](#) device is arranged on the front side wall of the neck rest. The waist and neck protecting [massage chair](#) is simple in structure, reasonable in design, capable of adjusting the radian of the waist and being attached to the waists of different crowds, and good in waist and neck nursing [massage](#) effect.



254 results

Offices WO

Languages en

Stemming true

Single Family Member false

Include NPL false



## Refine Options

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Africa

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Argentina

Brazil

Chile

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Cuba

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Ecuador

El Salvador

Guatemala

Honduras

Mexico

Nicaragua

Panama

Peru

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Australia

Austria

Bahrain

Belgium

Bulgaria

China

Czech Republic

Czechoslovakia

Denmark

**1. WO/2002/045550 COMPACT FOLDABLE MASSAGE CHAIR**

WO - 13.06.2002

**Int.Class** A47C 9/00 **Appl.No** PCT/US2001/045331 **Applicant** EARTHLITE MASSAGE TABLES, INC. **Inventor** ROLEDER, Jon, W.

An improved **massage chair** [10] is provided herein. The **massage chair** [10] includes (i) a front lower support [12] including a front attachment section [14], (ii) a rear lower support [16] including a rear attachment section [18], (iii) a seat [48] secured to the rear lower support [12], (iv) a front upper support [22] including an upper attachment section [24], (v) a chest rest [26] secured to the front upper support [22], and (vi) a connector [28]. Importantly, the connector [28] connects the front attachment section [14], the rear attachment section [18] and the upper attachment section [24] and allows for relative motion of the front lower support [12], the rear lower support [16] and the front upper support [22] about the connector [28]. As a result of this design, the **massage chair** [10] easily moves between a transport position [32] and an upright position [30]. Further, as a result of this design, the profile of the **massage chair** [10] in the transport position [32] is relatively small.

**2. WO/2012/077842 MASSAGE CHAIR**

WO - 14.06.2012

**Int.Class** A61H 7/00 **Appl.No** PCT/KR2010/008797 **Applicant** SILVERTECH CO., LTD. **Inventor** KIM, Kyu Hyun

The present invention provides a **massage chair** capable of automatically controlling **massage** intensity in levels according to the physical characteristics of users. According to the present invention, the **massage chair** comprises: a back **massage** portion for supporting the back of a user; a hip **massage** portion for supporting the hips of a user, connected to said back support; a leg **massage** portion connected to said seat portion to encompass at least a part of each of the left and right legs of a user; a sensor portion attached to one or more portions among the back **massage** portion, the hip **massage** portion and the leg **massage** portion; and a control portion for resetting a **massage** intensity standard according to the body shape of a sitting user recognized through the sensor portion. It is thereby possible to automatically control **massage** intensity in levels according to the physical characteristics of users to provide optimal **massage** conditions by considering the physical characteristics of a user merely from the act of the user sitting on the **massage chair**, and thus the user can receive a **massage** conveniently and comfortably without additional input.

# IP due diligence

IP due diligence is an audit of a company's IP portfolio, typically before the company is acquired, merged, or the subject of some financial investment

- Purpose is to make sure that everything is in order before the transaction takes place
  - Sale of a business, business division, product line; initial public offering; significant stock purchase; before taking a security interest in IP; transfer or assignment of IP; launching new product line; licensing
- Questions that the due diligence audit needs to determine
  - The complete inventory of all IP?
  - All rights are properly secured and are properly being maintained
    - Pending applications are properly being processed
  - All rights are properly owned
    - Where assignments are needed, they have been properly executed
  - There are no infringement issues
    - If there are, they are properly being handled

# Ownership of IP

## Patents

- Initial ownership in the name of the inventor or the applicant (varies by country)
  - Employee inventors – in most countries, the employer owns the IP, but in some (e.g., US), the inventor has to assign rights to the employer
    - Creates complexity in the case of international patenting
  - Joint ownership – varies by country
    - In many countries, joint owners must act together
    - In some countries, each joint owner can act independently
  - Transfers of ownership and recordals
    - In most countries, assignments are not valid unless they are recorded
  - Inventor compensation and other incentives for IP producers
- Ownership and joint collaboration agreements
  - Challenge of apportioning ownership
    - Additional complexity of transnational collaboration
- Foreign filing licenses and first filing issues

# Using IP Databases - Brand and Design Information

Oscar Benito



# Why are searches critical?

RISK: being challenged by another party and having to withdraw, rebrand and pay damages

- Is the strategy to 'file & wait if registered' enough to flash out potential conflicts?
- Could you get a challenge after registration once your product or company starts getting popular?
- Are searches on Google or Companies House enough?
- Are WHOIS domain names searches enough?
- Is your knowledge of the market enough?

# Scope of searches

- Identical and confusing similar trademarks, company names, domain names and unregistered trademarks
- ‘Similar’ marks might be as troublesome as ‘identical’
- Look beyond identical goods and consider neighboring or complementary goods and services



# Why use trademark and design databases?

- Assess the registrability of your trademark and design
- Avoid infringement
- Competitive intelligence
- Note: common law searches importance in some specific countries

Assess risk early as much as possible and consider engaging professional searches - compared with costs to rebrand and pay damages, any costs to carry out professional searches is a good business investment

# WIPO's database: Global Brand Database

Access to:

- International trademarks under the Madrid System
- Appellations of origin and Geographical Indications under the Lisbon system
- Emblems under 6ter
- INNs of the World Health Organization
- Trademarks from participating national and regional offices - <https://branddb.wipo.int/en/coverage> (includes Sri Lanka)

LINK: <https://www.wipo.int/reference/en/branddb/>

# Global Brand Database

BRAND NAME BRAND LOGO ADVANCED SEARCH EXPLORE VIENNA ASSISTANT G&S EXPLORER REPORTS

Searching Trademark applications, appellations of origin, emblems and international non-proprietary names. Covering 65,860,376 records from 82 data sources. [Check our data coverage](#)

Search

Brand name	Search strategy Embedded (results contain entered term)
Owner name	Application / Registration Number
IP office	Designation country
Nice classification	Goods and services

# Global Brand Database

BRAND NAME BRAND LOGO ADVANCED SEARCH EXPLORE VIENNA ASSISTANT G&S EXPLORER REPORTS

Brand name: contains the word

Type Brand name Search strategy contains the word Brand name

+ ADD A ROW

- contains the word
- is matching exact expression
- contains word that resembles
- contains word that sounds like**
- contains word with the same radical as

## SORT BY

- Image / logo similarity
- Most relevant first
- Least relevant first
- Recent first
- Oldest first
- ST13 descending
- ST13 ascending

# Global Brand Database

BRAND NAME BRAND LOGO ADVANCED SEARCH EXPLORE VIENNA ASSISTANT G&S EXPLORER REPORTS

To classify images with Vienna codes, you can use our AI-based tool [Vienna Classification Assistant](#).

Search

Drag & drop your image here, or

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# Global Brand Database

[BRAND NAME](#) [BRAND LOGO](#) [ADVANCED SEARCH](#) [EXPLORE](#) [VIENNA ASSISTANT](#) [G&S EXPLORER](#) [REPORTS](#)

Brand name: contains the word 'wipo'

[Edit your search](#) [TMview](#)

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Filters ↓	<input type="checkbox"/> Select all		
	<input type="checkbox"/> <a href="#">WIPO</a>		<input type="checkbox"/> <a href="#">WIPO</a>
	Owner World Intellectual Property Organization, Organisation Mondiale de la ProprieteIntellectuelle (...) IPR National Trademark Country of filing USA Status  Unknown Number 89001619	Owner World Intellectual Property Organization, Organisation Mondiale de la ProprieteIntellectuelle (...) IPR National Trademark Country of filing USA Status  Unknown Number 89001640	Owner Paper Partners LLC (USA) IPR National Trademark Application Country of filing USA Status  Ended (October 26, 2012) Number 76327046 Nice class 3
	<input type="checkbox"/> <a href="#">WIPO</a>		<input type="checkbox"/> <a href="#">WIPO</a>
	Owner UNICO KEMI INDUSTRIES SDN.BHD. (Malaysia) IPR National Trademark Application Country of filing Malaysia Status  Ended (October 18, 1993) Number 88006761 Nice class 3	Owner CAREWELL INDUSTRIES, INC. (USA) IPR National Trademark Application Country of filing USA Status  Ended (September 27, 1997) Number 74530126 Nice class 16	Owner PAPER PARTNERS, L.L.C (USA) IPR National Trademark Application Country of filing USA Status  Ended (July 11, 2009) Number 75412367 Nice class 16
	<input type="checkbox"/> <a href="#">wipo</a>		<input type="checkbox"/> <a href="#">WIPO</a>

# Other free, publicly-available databases

TMview - [www.tmdn.org](http://www.tmdn.org)

# WIPO's database: Global Design Database

Access to:

- international designs under the Hague system
- designs from participating national and regional offices

<https://designdb.wipo.int/designdb/en/designdb-help.jsp#db> (not including Sri Lanka)

Link: <https://designdb.wipo.int/designdb/en/index.jsp>



# Global Design Database

A world-wide collection of designs data; including WIPO Hague registrations and information from participating offices.

searches records

## SEARCH BY

Design Names Numbers Dates Country Priority

Indication of product =

Design class =

Description =

search

## FILTER BY

Source Status Designation Locarno class Reg. Year \* Expi

AL Designs	325	BG Designs	19,458
BN Designs	191	BW Designs	203
CA Designs	202,616	CH Designs	138,108
CN Designs	8,043,152	CR Designs	1,676
CU Designs	772	DE Designs	1,313,347
EG Designs	9,687	EM Designs	1,658,091
ES Designs	107,211	EP Designs	222,150

Display: List

Sort: Value - asc

filter

A world-wide collection of designs data; including W

# Global Design Database

## SEARCH BY

Design Names Numbers Dates Country Priority

Indication of product =

Design class =

Design class

Locarno class

Design Class (CA)

Design Class (JP)

Design Class (US)

1 - 10 / 16,276,735

DESIGN view

search

Display:



# Locarno search

LINK - <https://locpub.wipo.int/enfr/?lang=en&menulang=en&mode=loc&notion=search&version=20230101>



Home > Locarno Classification > LOCPUB

[LOCARNO HOME PAGE](#)

[DOWNLOAD](#)

**EDITION**

LOC (14)

**OTHERS**

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**LANGUAGE**

- English
- French
- English/French
- French/English

[LINKS TO DESIGN OFFICES](#)

**VIEW MODE**

LOC

**SHOW**

- Note(s)
- ID No.

Classes    Alphabetical    Class And Subclass Headings    General Remarks    Recommendations    Modifications    **Search**

ID No. or Search Terms:

Operator:     OR     AND

Exact search:   

Select Classes: [All](#) [None](#)

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21	22	23	24	25	26	27	28	29	30
<input checked="" type="checkbox"/>	<input checked="" type="checkbox"/>								
31	32								

# Other free, publicly-available databases

DESIGNview - <https://www.tmdn.org/tmdsview-web/#/dsview>

# IP due diligence & Competitor's intelligence

These databases are good resources to help you keep your own portfolio in order:

- To check whether all rights are properly secured and are properly being maintained/renewed
  - Pending applications are properly being processed
- To check all rights are properly owned
  - Where assignments are needed (or changes of address/name of owner), they have been properly recorded at different IPOs

These databases are also good resources of information to learn what your competitors are up to

# Risk Management

Professor Jay Erstling



# General measures

Maintain confidentiality

Make sure employee contracts and contracts with third parties are appropriate and in place

Ensure that employees are aware of IP basics

Keep careful documentation

If you have trade secrets, make sure that they are properly maintained

# Pre-filing measures

Identify potential intellectual property early

Carry out freedom-to-operate exercises

Keep careful documentation

Carry out prior-art searches and trademark searches

Act promptly

Consider how you plan to exploit the intellectual property



# Filing measures

Carefully prepare applications

Respond promptly to IP office communications

Respect deadlines

Examine whether you wish to obtain international protection

If you decide in the affirmative, make sure to meet priority deadlines

# Measures after grant or registration

Have in place a good docketing (record-tracking) system

Make sure to pay fees on time

Make sure to meet use requirements

Be aware of competitors' actions (competitive intelligence)

Consider options and be prepared to act in case of alleged infringement

Carry out IP audits

Consider abandoning or assigning IP rights that no longer add value

# Resources

Enterprising Ideas, A Guide to Intellectual Property for Startups <https://www.wipo.int/publications/en/details.jsp?id=4545&plang=EN> its infographic <https://www.wipo.int/sme/en/enterprising-ideas/>

WIPO IP Diagnostics <https://www.wipo.int/en/web/wipo-ip-diagnostics>

Creative Expression: An Introduction to Copyright and Related Rights for Small and Medium-sized Enterprises <https://www.wipo.int/publications/en/details.jsp?id=4640&plang=EN>

Inventing the Future, An Introduction to Patents for Small and Medium-sized Enterprises <https://www.wipo.int/publications/en/details.jsp?id=4350&plang=EN>

Making a Mark: An Introduction to Trademarks for Small and Medium-Sized Enterprises <https://www.wipo.int/publications/en/details.jsp?id=4208&plang=EN>

Looking Good: An Introduction to Industrial Designs for Small and Medium-sized Enterprises <https://www.wipo.int/publications/en/details.jsp?id=4388&plang=EN>

Exchanging Value - Negotiating Technology Licensing Agreements: A Training Manual <https://www.wipo.int/publications/en/details.jsp?id=291&plang=EN>

Successful Technology Licensing [https://www.wipo.int/edocs/pubdocs/en/licensing/903/wipo\\_pub\\_903.pdf](https://www.wipo.int/edocs/pubdocs/en/licensing/903/wipo_pub_903.pdf)

In Good Company: Managing Intellectual Property Issues in Franchising <https://www.wipo.int/publications/en/details.jsp?id=271&plang=EN>

Madrid System – The International Trademark System <https://www.wipo.int/en/web/madrid-system>

Hague System – The International Design System <https://www.wipo.int/hague/en/>

PCT – The International Patent System <https://www.wipo.int/pct/en/https://www.wipo.int/patents/en/patent-information.html>

WIPO Guide to Using Patent Information <https://www.wipo.int/edocs/pubdocs/en/wipo-pub-rn2021-1e-en-wipo-guide-to-using-patent-information.pdf>