

## Introduction to Patents

### What is a patent?

*A patent is a legal right granted by a government that confers upon the creator of an invention the sole right to make, use, and sell that invention for a set period of time (usually 20 years).*

Patents are considered personal property of the inventor and may be sold, licensed, or otherwise transferred. Patents are territorial and will only give the inventor rights in the country a patent is granted. For example, an Irish patent is only enforceable in the Republic of Ireland.

### What can be patented?

*Patents are intended to protect inventions, i.e. products or processes that comprise new and non-obvious functional or technical aspects. Patents are therefore concerned with, for example, how things work, what they do, how they do it, what they are made of or how they are made.*

There are some exclusions as to what is patentable in Ireland or Europe: for example, a discovery; scientific theory; mathematical method; aesthetic creation; a scheme, rule or method for performing a mental act, playing a game or doing business; a computer program (as such); the presentation of information; a method of treatment or a method of diagnosis of the human or animal body by surgery or therapy; a new animal or plant variety.

However, despite these exclusions many patents are granted in these fields of activity so it is imperative to get professional advice before ruling out patent protection for an invention.

### What rights does a patent give to me?

*If a patent has been granted for your invention, you have an exclusive right to:*

- Prevent anyone else from using your invention – thereby keeping a monopoly in the field of the invention, or
- Allow others to use your invention in return for a financial payment to you, or
- Sell the exclusive right to the invention to another for a one-off payment.

A patent also allows you to take legal action against anyone who is using (making, using, selling, or importing) your invention without permission.

It is important to note that a government does not take action against others on your behalf, nor does it financially reward you directly for your idea, regardless of its merit. The patent office simply gives you rights to take actions (to stop others, to sell, to licence for a royalty), which may (or may not) result in financial gain.

## How do I get a patent?

The process starts by writing a patent specification and then filing an application for a patent at a government-run Patents Office. A specification contains one or more statements known as “Claims” which define the invention in terms of protection sought. The specification includes a detailed technical description of the invention and usually one or more drawings.

What happens after filing an application?

Nearly all patent applications are officially searched and vigorously examined to check whether the invention fulfils the following requirements for patentability:

- Novelty – The invention must never have been made public anywhere before the date on which an application for a patent is filed.
- Inventive Step – The invention must be sufficiently different from existing products or processes in a non-obvious way.
- Industrial application – It must be possible for the invention to be actually made or used.

A patent application is allocated a filing date from which novelty and inventive step of the invention is judged during an examination on patentability carried out by the various Patent Offices at a later date. Not all patents are examined in this way.

A patent will generally only be granted if the invention (defined by the claims) fulfils all of the above requirements. During examination, the applicant may be invited to amend their patent specification if they do not fulfil the above requirements.

## When to file?

It is absolutely vital that a patent application is filed for an invention before it is used in public, a description of it is published, or before it is discussed in a non-confidential manner. Any public disclosure prior to filing an application can destroy the novelty of an invention, thus potentially invalidating any later filed patent application.

## How to file?

There are three types of patent applications:

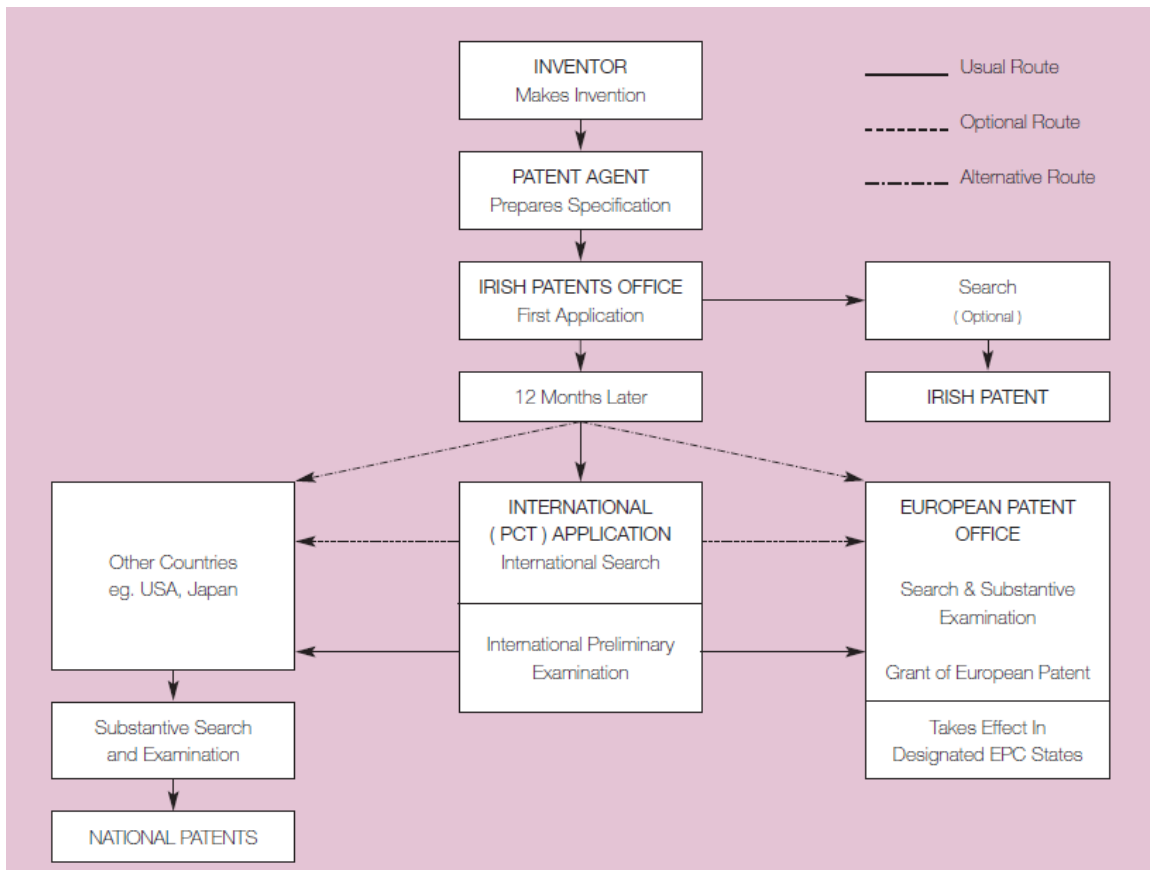
- National Patent application (e.g. an Irish Patent application),
- Regional Patent application (e.g. a European application) and
- International (PCT) application.

As patents are territorial, it is generally necessary to apply for patent protection in each individual country of interest. However, regional and International applications offer economical alternatives to a bundle of individual national applications.

During the first 12-month “priority” period from the filing date of the initial application, corresponding national/regional/international applications can be filed for the same invention with the benefit of the date of the initial application. This priority period gives the applicant an opportunity to find out whether and where the invention has commercial potential before additional filing expenses are incurred.

When considering where to seek patent protection, there are two important considerations: protection in a given market and protection in a place a competitor is based.

The diagram below shows an example of a filing procedure:



### Irish Patents

Ireland has two types of patents, full term (20 year) patents and short term (10 year) patents.

### European Patents

A single patent application lodged at the European Patent Office can lead to the grant of national patents in some, or all, of the 31 member countries, including all EU states.

## International (PCT) Patent Applications

*The PCT system significantly simplifies the process for simultaneously seeking patent protection in over 125 countries worldwide. Rather than filing national applications in many languages, the PCT system enables an inventor to file a single application, in one language, and to pay one application fee. Although an International granted patent does not exist (the application eventually becomes a series of national patents) national filing costs are deferred for 30/31 months from the filing of the first patent application.*

### Benefits of Patent Protection:

- Obtain an exclusive right to the invention.
- Corner off a niche area of technology.
- Transfer knowledge/idea into a tangible asset capable of Transfer, Licensing, and Security.
- Obtain Royalty income from licensing.
- Obtain Tax Relief on royalty income in Ireland.
- Provides an opportunity to cross-licence with other innovators.

### What Tomkins can do to help

When you engage our services you will be assigned a Patent Attorney who is qualified to represent you before the Irish, UK and European Patent Offices. All our Patent Attorneys are experienced engineers and scientists in their own right, a number of whom have higher qualifications, such as Master's Degrees and PhDs, taken from the fields of Engineering, Computing/Software, Physical sciences, Chemistry, Biotechnology, and Pharmacology. Tomkins is currently in the unique position, in Ireland, to boast no fewer than five attorneys qualified to the doctorate level, all of whom have published in peer reviewed international technical journals and actively sought positions with our firm.

In addition to acting on your behalf before the relevant patent office(s), we offer the following services:

- **Preliminary Novelty Searches:** Before incurring the cost of filing a patent application is a good idea to have some indication as to whether the invention is new. The best way to do this is for us to carry out a preliminary novelty search of published patent applications to see if the invention already exists.
- **Patent Specification Drafting:** Although it is possible to prepare and file a patent application yourself, it is strongly advised to engage the services of a patent attorney who will have the necessary technical and legal skills to prepare the specification. As the claims define the invention in terms of the protection sought, they also define what an unauthorized party would have to do in order to infringe the patent. DIY drafts often contain loopholes for competitors to exploit.
- **Free Patentability Opinions and Filing Strategy Advice:** Tomkins provide an initial indication of the potential patentability of potential inventions their potential applications. We provide sound filing strategies based on the client's needs, potential commercial markets and product development stage.
- **Deadline Monitoring:** We utilise the best of IP Management software to ensure best practices in monitoring and alerting critical and significant deadlines.

- **Renewal fee monitoring and payment:** We provide our clients with a comprehensive annuities service, to provide them with peace of mind, by adhering to reliable procedures for ensuring annuities are paid in a timely manner.
- **Infringement and Validity advice:** With the long established track record in IP excellence, Tomkins are ideally positioned to provide advice and guidance on potential IP infringement and validity of existing IP rights. We are frequently involved in both defence and attack of granted IP rights, including defensive and offensive European Patent Oppositions and National Court challenges, with decades of experience in this regard. Tomkins have successfully acted on behalf of many multinational (including pharmaceutical) clients and national clients, both at home and on the international stage. Additionally, Tomkins have well-established relationships with some of the most eminent IP solicitors and barristers in the field.
- **Licensing and Assignment Advice:** Tomkins advise on IP licensing, IP assignment and stamp duties issues, according to our clients needs and prepare suitable licence and assignment deeds accordingly.
- **IP Due Diligence:** The nature of our business and IP experience ideally positions Tomkins to evaluate potential IP investments or purchases, where the evaluation involves a verification of all the material facts relevant to the IP rights relating to the investment or purchase.
- **IP Education & Training Services:** Tomkins is committed to increasing IP awareness to the business and academic sectors and to the general public. We provide tailored education and training seminars, workshops according to clients' needs.

#### **Further Information & Advice**

The advice provided in this note is for general information only, and is not intended to be legal or professional advice. For further advice, please contact a member of our patent team directly or enquiry to [post@tomkins.com](mailto:post@tomkins.com).



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## Introduction to Trade Marks

### What is a Trade Mark?

A Trade Mark is a “sign”, usually a brand name or logo, which distinguishes the goods or services of one trader from those of others. No modern business can afford to ignore the importance of registering their brand names/logos as Trade Marks to obtain legal protection and exclusivity of use.

### Types of Trade Marks

A Trade Mark is usually a word (or words), a symbol, or a combination of the two. Trade Marks can also be logos, numbers, acronyms, slogans, shapes, labels, colours or packaging. Smells and sounds can be Trade Marks, but in reality they are very difficult to successfully register.

In practice, the majority of Trade Marks are a word, or words. To be registrable the word or words must be distinctive of the goods or services of the business and also not descriptive of those goods or services. Generic names in the industry are not registrable. An invented word (or words) makes a good Trade Mark. Dictionary words are also registrable provided they are distinctive and are not descriptive of the business concerned. Examples of registrable Trade Marks include HARP (for beer), DIESEL (for clothing), WEETABIX (for cereals), ZANTAC (for pharmaceuticals), MONDEO (for cars), MICROSOFT (for computers and software), AIRBUS (for aircraft) and LEMSIP (for pharmaceuticals).

Slogans and taglines may be registrable depending on their distinctiveness. Geographic names may also be registrable depending on their circumstances and their distinctiveness.

Personal names may also be registrable, but in practical terms they often do not make strong Trade Marks unless they have been in use for a long period of time, for example JAMESON or GUINNESS.

Word Trade Marks may also be registered in script, or together with a symbol, or design or picture elements. Symbols or pictures may be registered separately on their own, for example the Nike swoosh.

Unlike in the case of patents, there is no automatic restriction on registering Trade Marks which are already in the public domain by your business in the marketplace, therefore existing brands may also be registered. Every business should conduct an audit of its brands to check that it has adequate Trade Mark registration protection.

If you have an idea for a new word Trade Mark or another type of Trade Mark, or if you wish to audit your existing brands, please contact one of our Trade Mark advisors in strictest confidence to discuss how best to obtain registered Trade Mark protection.

## Why Register your Trade Marks?

While it is possible to obtain common law user rights just by trading under an unregistered brand name over time, these rights can take years to obtain and can be very difficult to identify and to enforce.

The best way to protect a brand is to **register** it as a Trade Mark in the country or countries where you trade or intend to trade. The advantages of Trade Mark registration include:

- Creation of an enforceable property right
- Legal exclusivity in your product field
- The best way to protect a startup name
- Renewable on an ongoing basis
- Can be transferred or licensed
- Provide a return on brand investment
- Can become a very strong asset

## Company Names and Domain Names

Registration of names at the Companies Office, or as internet domain names, does not of itself provide marketplace exclusivity in the names. The primary and effective way to obtain marketplace exclusivity is by Trade Mark registration.

## Earlier Rights – Clearance Searching

Before using a new brand in the marketplace or applying to register it as a Trade Mark, clearance searches are strongly recommended. This is because your company's use, or registration, of a particular name or brand may already be barred by earlier Trade Marks. You could be exposed to the risk of an opposition against your Trade Mark application or, more seriously, the risk of being prevented from using the selected brand name or logo because of another party's Trade Mark rights. Re-branding may be necessary and expensive.

## Protection of Trade Marks Abroad

If you only intend to trade in Ireland, an Irish Trade Mark registration may suffice. However, if you are an exporter, or may export in the future, protection in other countries will be required. Trade Marks may be registered on a country by country basis. However, there are two useful international systems available, the (European) Community Trade Mark system and the International Registration (Madrid Protocol) system.

## Community Trade Marks

A Community Trade Mark is a single Trade Mark registration covering all of the 25 EU states. A single application is filed and one pan-European registration obtained. If you are interested in trading in Europe a Community Trade Mark is normally the best option. An objection to your application can arise from any part of the EU (this happens in a small proportion of

cases), although there is a conversion option to national applications without loss of filing date. The system is undoubtedly the best option for traders in the EU and is used extensively.

### **International Registrations (Madrid Protocol)**

Irish businesses, which have an existing Irish or Community Trade Mark application or registration, can opt to file an “International Registration” designating one or more of around 75 countries. This system tends to suit companies with more global interests, and can provide a cost-effective option. Careful consideration must be given to the pros and cons of using this system.

### **After Registration**

In general, Trade Marks are registered for a 10 year period (this can vary depending on the country) and can be renewed on an ongoing basis on payment of fees. To ensure you receive renewal reminders from us make sure you notify us of any changes in name and/or address contacts.

Your Trade Mark registration provides strong exclusive rights. It is advisable to monitor subsequent Trade Mark applications which might conflict. For this purpose a Trade Mark *watching service* is highly recommended. We can set one up for you on a cost-effective basis. It is also essential to monitor the marketplace and act against look-alike names or infringers in your product field.

In most countries it is necessary to use your Trade Mark within a certain period of time, otherwise it may be cancelled. It is also necessary to use your Trade Mark in the correct format. Trade Mark owners should not allow their Trade Mark to become generic or descriptive, otherwise there may be a risk of cancellation.

Proper marking of goods or services is recommended, for example using the symbol “®” or the words “Registered Trade Mark.” However, if these are used when the Trade Mark is unregistered or still a pending application, this constitutes a criminal offence in many countries. Check with your Trade Mark advisor before adopting any markings.

### **Further Advice**

The information provided in this note is general only, and is not intended to be legal or professional advice. For further advice please contact one of our attorneys at [brands@tomkins.com](mailto:brands@tomkins.com).

## Introduction to Designs

### Design Protection

In today's brand-orientated marketplace, the appearance of a product can be of great commercial significance, and the risk of copying or close imitation increases with the success of the product. A Registered Design grants the proprietor the exclusive rights to the appearance of a design and can act as a deterrent to counterfeiters and as a powerful tool against infringers.

### What is a Design?

A design is the outward appearance of a product, or part of it, resulting from the lines, contours, colours, shape, texture, materials and/or its ornamentation. Design protection is generally for parts of the product that are visible during normal use. Aspects of the design that are solely dictated by technical function are generally not protectable. The owner of a registered design has the exclusive right to prevent third parties from applying the same (or similar) design to a product. These exclusive rights extend not only to the design when applied to the product for which the design was originally contemplated but also to any other product to which the same or similar design is applied. This confers important protection on the Design Registration owner.

### What is required for Design Registration?

In order to obtain protection for a design, it must be *new* and have *individual character*. In general, a design is considered to be new if no identical design is in the public arena before the date of the application for registration. In order to have individual character, a design must create a different overall impression than that created by a design that was previously available to the public. In simple terms it must look different in a way, which is not insignificant. However, within the EU, a grace period of one year applies, whereby a valid design registration can still be obtained if filed within 12 months of a non-confidential disclosure of the design by the designer or someone authorized by him to do so. As this grace period does not apply in all jurisdictions in which design protection may be important we strongly advise filing for design protection before any non-confidential disclosure whatsoever.

### How can I obtain a Registered Design?

Design registrations can be filed nationally on a country-by-country basis, for example in Ireland or the UK, or filed on a regional basis covering more than one country, for example, an EU Registered Community Design that covers all 25-member states of the EU can be obtained at a similar cost to a single national registration. Up to 100 designs may be included in one EU registered design application, further reducing costs.

*A registered design has an initial term of 5 years from the date of filing, and this term can be extended to a total of 25 years upon payment of renewal fees every 5 years.*

### **Unregistered design rights**

Unregistered design rights apply automatically to a design for a period of 3 years if it is first made available to the public in the EU. Unregistered design rights are best seen as a form of copyright, in that to enforce unregistered design rights, it must be proven that the alleged infringer has copied the design, rather than arrived at it independently. It is best to consider the much stronger and longer protection available with registered designs before seeking to rely on unregistered design rights.

### **Relationship with patent and trademark protection**

Design protection is separate to other notable forms of intellectual property, such as patents and trademarks yet complements the overall protection. A patent protects a product's composition, mechanism, or technical function and, while trademarks can protect the branding of the product, it can be difficult in some circumstances to obtain trademark protection for 3-D products. Design protection dovetails neatly with both patents and trademarks in that the appearance, and not function or composition, of a 2-D or 3-D design is protected.

### **Information required for filing a registered design**

- Up to 7 separate drawings or photos of each design
- Indication of the use of the design or the product to which it is intended to be applied
- Name and addresses of the owner for the design registration
- Name and addresses of the designers
- Indication of countries where protection is of interest
- Details of any prior non-confidential disclosure

## Introduction to Copyright

### What is Copyright?

Copyright is the legal term given to the rights of authors or creators of certain types of “artistic” work. Examples of creative endeavour which derive protection under the Copyright and Related Rights Act 2000 are: original literary, dramatic, musical or artistic works, sound recordings, broadcasts, cable programmes, typographical arrangements of published editions, computer programmes and original databases. Copyright is a property right protected by statute and case-law, which together provide substantial protection for such works.

The owner of copyright can retain control over commercial exploitation of their work. The owner has the exclusive right to prohibit or authorise others to copy the work, perform the work, make the work available to the public through broadcasting or recordings or make an adaptation of the work. Copyright is effected once the work is captured in any reproducible form for example on paper, film, CD-ROM, DVD, Internet etc.

No protection is provided for ideas, which have not been so captured. Therefore, before relating potential copyright material idea, it would be important to capture the idea in reproducible form and to keep date records. Furthermore we would strongly recommend the use of a Confidentiality Agreement to bind the person to whom it is disclosed by confidentiality. This will provide additional protection against copying of the idea. Although it is possible that another person may come up with the same idea, it is important that all available tools be used to protect your work.

### Who is the owner of copyright?

In general, the creator of the work is the owner of copyright, though the copyright in the work may be transferred to others. Such transfer may occur by way of a contract, (employment contract being quite a common occurrence) by assignment (a document signing over ownership), by licencing or on death by a will or intestacy.

### Protection or Registration of Copyright?

There is no registration procedure for owners of a copyright work in Ireland. The act of recording the “work” by itself creates an automatic right. In order to claim protection for “work” created, under the Act, it is essential that the creator or author can show when the work and the consequential copyright was created. There are many ways of “evidencing” the creation of “works”, two of which are as follows:

- (1) lodging a copy with an independent third party who can document or record the date and time of deposit by signing or notarising the work; and
- (2) sending the work by registered post to oneself and retaining the original postal receipt and leaving the envelope containing the work unopened.

Works should be clearly marked to show who the copyright owner is and the date from which copyright is claimed, along with the recognised symbol ©.

### **Duration of Copyright Protection**

The duration of copyright protection varies according to the work in question. Copyright protection usually expires 70 years after the death of the author or creator/ originator in relation to literary, dramatic, musical and artistic works. In respect of films, the period of protection is generally 70 years after the death of the last of the director, author of the screenplay or dialogue of the film or the author of the music composed for use in the film. A computer program has a term of life of the author plus 70 years while a computer-generated works has copyright of 70 years from first making the work available to the public. Other periods apply to other types of work also.

### **Collecting Agencies**

There are various agencies, which collect royalties on behalf of authors whether it is broadcasts, sound recordings or other performances.

### **Why Not Register Domain Names or Brands as Trade Marks**

Domain Names are important assets, often based on brands and logos and should be protected. Registering domain names prevents another party from registering the exact domain name registered. Best protection for brand names (and logos) is obtained by registering the name or logo as a trade mark. Registered trade marks give legal protection for names or logos that are identical or similar to that registered. Thus registering trade marks in addition to registering domain names is important.

There are of course many different types of domain names for example .ie, .co.uk, .com, .net, .org and more recently .eu and .mobi (for mobile devices). If you are interested in any of these Top Level Domains (TLDs) we would be only too happy to discuss the matter with you.

If your company has a presence in Ireland, the UK or EU it is important to register your domain names in order that customers can locate your organisation on the Internet.

Registering a domain name is an inexpensive and speedy process and domain names are renewable every year upon payment of a renewal fee.