



IP – Myths and Misconceptions

Kate Hickinson – Partner – Patent Attorney

Joanne Goodchild – Senior Associate – Trademark Attorney

Appleyard Lees[®]
European Patent & Trade Mark Attorneys

Patent attorneys

- Patent attorneys bridge the gap between the legal and the scientific
 - At least a first degree in science/engineering
 - Trained in patent law
- Not going to have same depth of knowledge as inventor, but can quickly understand the invention



Trade Mark attorneys

- Specialists in the field of law related to branding

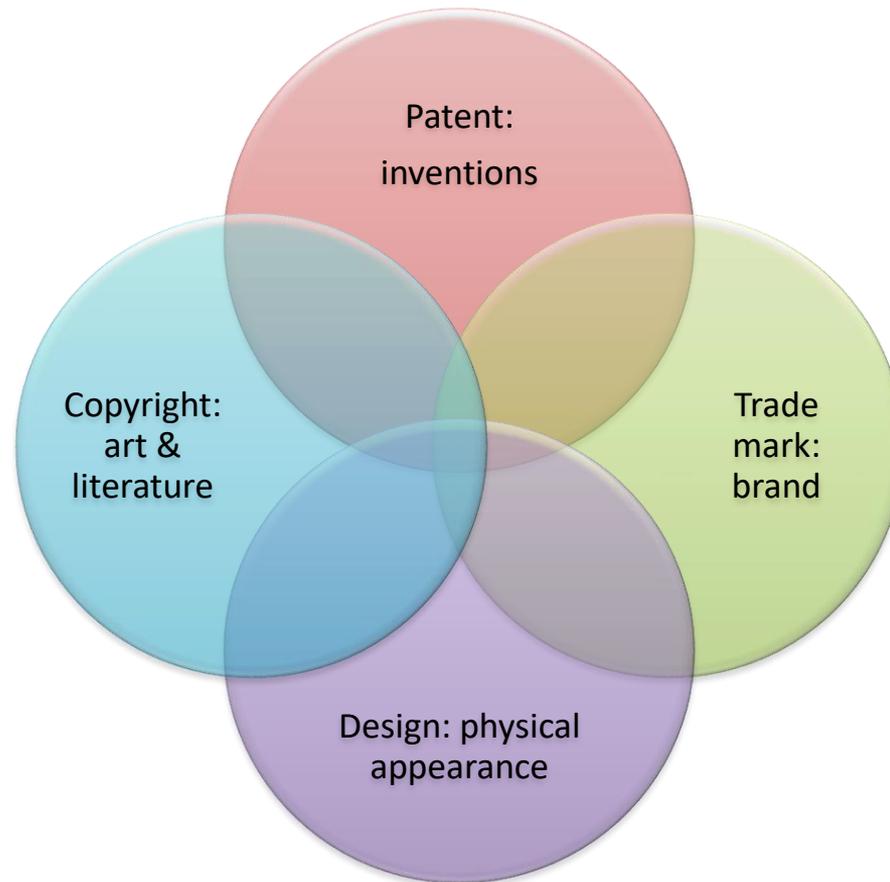
Often have a law degree

Trained in trade mark law

- Work closely with marketing departments



Different protection for different types of ideas



A word on Trade Secrets or Know How

- A key part of the patent process is **disclosing** the invention
- Other option is to simply keep the idea secret!
- ‘Protected’ by virtue of being confidential



Myth #1

- I have paid an external consultant to invent something for me. Because I have paid for it, I own all the rights and can do what I want with them.

Mixture of true and false

- For patents, the inventor is usually the first owner, so if you commission work which leads to a patentable invention, you may not own any resulting IP.
- It is therefore vital to get agreement in writing in such cases.



Myth #2

- I have formed a limited company and registered my company name with Companies House so no one else can trade using my company name.

False

- It is true that no one else can register the same name at Companies House, but that has no effect on someone attempting to trade using the same or similar trade mark. Registering a trade mark will allow you to prevent others from trading using the same or similar mark for the same or similar goods/services.

Myth #3

- If I make 4 or more changes to a picture/photograph from the Internet, then I have done enough to avoid infringing copyright.

False

- The test for copyright infringement is whether a “substantial” piece of the work has been taken, but it is the quality of the taking rather than the *quantity*.



Myth #4

- If I invent something in my own time, using my own resources, I don't have to tell my boss, and I automatically own it?
 - **Mixture of true and false**
 - If you are employed in a position where you are likely to invent something or it is a normal part of your duties, your employer will usually have first claim to any invention you make. The same applies if you are a director (or possibly in a senior management position).
 - If you are not employed in such a position (e.g. sales or marketing), it is likely that you will own the invention yourself.
-

Myth #5

- If I have a patent for my invention in the UK, I can stop someone else making the same invention in China and exporting it to the US
- **False**
- Patents are territorial and only offer protection in countries where they are in force. By not pursuing patent protection in a particular country, you are effectively giving up your potential monopoly rights in that country. It is therefore important that you select countries where you require protection carefully.

Myth #6

- I have registered a word as a trade mark, but I have no plans to use it in the near future, but that's ok as no one else will be able to use it as long as I maintain the registration.
 - **False**
 - After a period of 5 years has elapsed from registration, a trade mark can be revoked for non-use.
 - In some jurisdictions e.g the US, it is necessary to file evidence of use during the lifetime of the registration.
 - Bad faith could be a basis for invalidity.
-

Myth #7

- I have noticed that a competitor is selling a product very similar to my invention, for which I have just filed a patent application. I can write to him and tell him to stop selling his product.
 - **False**
 - You should be wary of making “unjustified threats”. These can complicate any future legal proceedings and any contact with a possible infringer should be managed carefully. In any event, it could well be that the competitor has his own patent/application which could affect your right to sell your product, or he may have publicised his product which could affect the scope of any patent you eventually get granted.
-

Myth #8

- I have a granted patent for my invention, so I can now go ahead and commercialise it with no problems.
 - **False**
 - A patent gives you the right to prevent others from exploiting the invention, but gives you no absolute right to exploit it yourself, since you may still be infringing other patents. For this reason, a patent is sometimes called a negative right.
 - You may want to consider undertaking a Freedom to Operate (FTO) analysis before selling any new product/service.
-

Myth #9

- If I write details of my invention down and send them to myself by recorded mail, I can use this to prevent people stealing my idea.
- **False**
- As appealing as this sounds, this pervasive idea is totally untrue. It may be useful to prove authorship of a copyright work, but good written records will do the same. If you wish to protect an invention, this can only be done via a patent application.

Myth #10

- I never copy anyone else's products, so I don't need to worry about patents.
 - **False**
 - There is no requirement for a patent holder to show copying in order to prove infringement. All that is required is that the alleged infringement falls within the claims of the patent in question.
 - In this respect, patents differ from the rights granted by copyright, where copying needs to be shown to prove infringement.
-

Myth #11

- I've been using my trade mark for a few months already without any problems and I'm not bothered about anyone else using something similar so there's no need to register it.
 - **False**
 - The use might be too low key to come to anyone's attention.
 - Registration can be used as a shield and not just a sword as it preserves your space for you.
 - Unregistered rights take a while to become established – it is not simply a case of “first use”.
-

Myth #12

- My competitor has a patent to a new antibiotic compound and I have found that it treats cancer but I cannot get protection for that because the compound is known
 - **False**
 - It would be possible to protect the new use of the compound, i.e. to treat cancer
 - It would be necessary to assess FTO with respect to the new use
-

Myth #13

- I have combined two well known biocidal compositions A and B and found that when they are used in combination they produce a much improved biocidal effect. This cannot be an invention because the two compositions A and B are already well known.
- **False**
- A combination of two or more known compositions may be patentable, for example if their use together surprisingly produces a much improved biocidal effect. This combination could be patentable as a “kit” of separately packaged compositions A and B.

Copyright infringement



Trade mark infringement



Frank Industries PTY Ltd v Nike Retail BV [2018] [EWHC 1893 \(Ch\)](#)

‘Collaboration’



Brexit Myth #1

- Brexit means that the granted patents that I've obtained in the UK, via a European filing at the European Patent Office, will have no effect
- **False**
- The European Patent Office is a completely separate body to the EU
- Leaving the EU does not impact upon granted patents that you've obtained in the UK, via a European filing at the European Patent Office
- **Business as usual**

Brexit Myth #2

- Brexit means that we will have to consider drastic changes to our European patent filing strategy
- **False**
- The European Patent Office is a completely separate body to the EU
- Leaving the EU does not impact upon your European filing strategy
- **Business as usual**, at the present time

Brexit Myth #3

- Brexit means that the long-proposed Unitary Patent and Unified Patent Court will now not come in to force
- **False**
- Although there have been delays, the Unitary Patent and Unified Patent Court are in advanced stages of coming in to force
- If the UK leaves the EU, there is much discussion as to how the UK will remain involved...

Brexit Myth #4

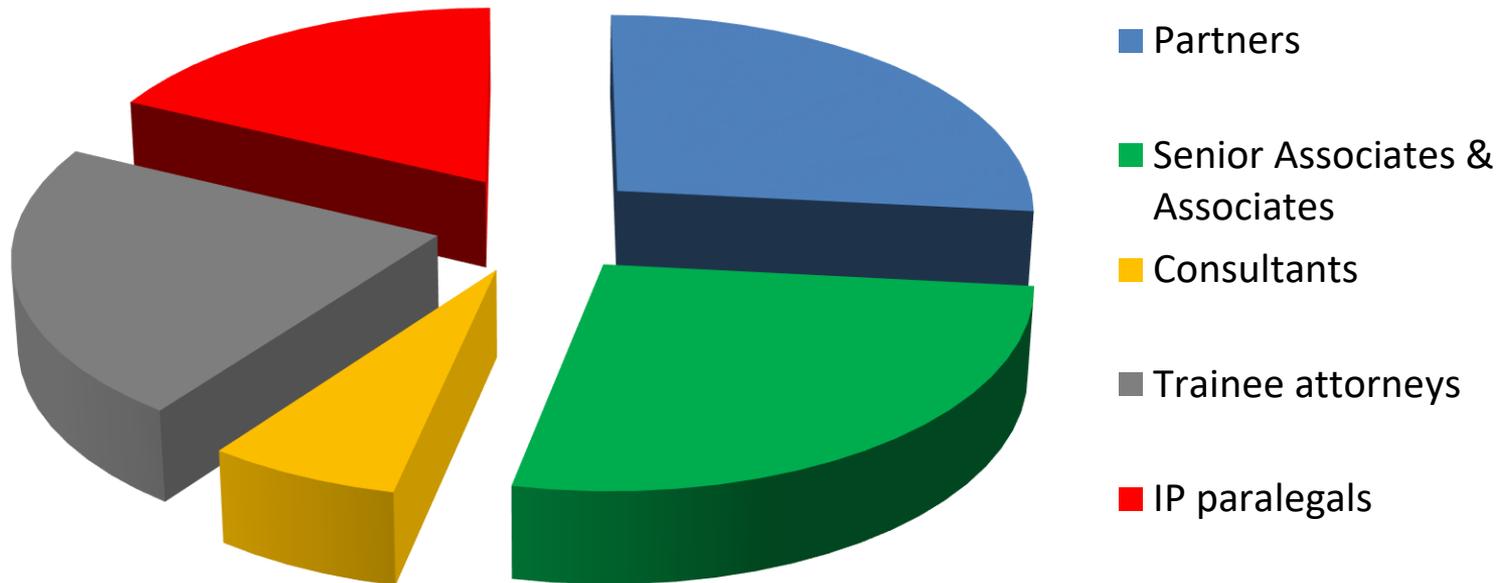
- Brexit means that my EU Trade Mark or EU Registered Design, will have no effect in the UK
- When the UK leaves the EU, it is likely that the rights granted by the EUIPO (trade marks and designs) will continue to be honoured under UK laws. The UK has a history of flexibility in dovetailing national laws to fit with the EU.
- It is not certain so new filings should be considered in the UK first and rolled out e.g. to the EU using the IR or Hague systems. National rights should be the basis to avoid uncertainty of qualification e.g. International Trade Mark Registration based on an EUTM.



Our Firm

- Offices in Manchester, Leeds, Halifax, Cambridge and Alderley Park
 - Clients throughout the UK, mainland Europe and worldwide
 - Clients range from individuals to multinational companies
 - Flexible, client focussed approach to our work
-

Our professionals (51 attorneys and growing)



Sectors of expertise for patents



Life Sciences &
Biotechnology



Chemistry &
Pharmaceuticals



Electronics
& Software



Engineering
& Physics

50 | 50

Contact

- Kate Hickinson

kate.hickinson@appleyardlees.com

- Joanne Goodchild

joanne.goodchild@appleyardlees.com

Thank you for listening
www.appleyardlees.com
