

Intellectual Property issues in Commercial Transactions and Litigation

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Types of intellectual property: registered

■ registered rights

- **patents (PA 1977, EPC 2000, Reg №. 1257/2012) [SPCs / plant varieties]**
- **trade marks (TMA 1994, Reg №. 207/2009)**
- **registered designs (RDA 1949, Reg №. 6/2002)**

Types of intellectual property: unregistered

■ unregistered rights

- confidential information (equitable and contract)
- passing-off / goodwill (common law)
- design right (CDPA 1988, Reg №. 6/2002)
- copyright (CDPA 1988)
- miscellaneous: *e.g.* performance rights, moral rights, database rights (all statutory), malicious falsehood (common law)

UK, EU or worldwide

- UK rights – territorially limited
- some EU community rights, *e.g.* trade marks and designs
 - beware of European Patents
 - EP (UK) patent
 - Unitary Patent
- no such thing as a world-wide right, but
 - reciprocal arrangements, *e.g.* copyright
 - international conventions, *e.g.* Madrid, PCT

Often multiple potential forms of protection



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Often many IPRs present



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Commercial Scenarios where IPRs may arise

- articles and books written by employees (*e.g.* automatic transfer of copyright, with limited back licence)
- real property deals/competitive tendering: copyright in the drawings (even layout of roads/services); goodwill associated with premises
- insolvency: automatic termination of licence agreements, issues of sell-off of licensed products, can rights devolve to new purchasers
- mergers and acquisitions: who should own the rights (questions of *locus standii* if need to sue, and ability to claim damages), validity of assignments (*e.g.* goodwill)
- securitization of rights (*e.g.* performance rights/copyright for artists/musicians)

Litigation Scenarios where IPRs may arise

- **classical IP disputes: patents, trade marks, passing-off, designs/copyright, *e.g.***
 - securing registered rights to deter others
 - infringement
 - “cancellation”
- **pre-action correspondence and “threats”**
- **general commercial: who owns the IPRs (directors, employees, ex-employees, joint ventures); conflicts between companies (*e.g.* over names: TMs, PO)**
- **professional negligence**

Things to bear in mind

- **type of IPR: registered / unregistered**
- **ownership (who, why, where, when)**
- **licences (to / from; termination - insolvency)**
- **infringement (by / of)**
- **“cancellation” / “freedom to operate”**
- **competition issues**

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■ MA (Natural Sciences) (Cantab), DPhil (Biophysics) (Oxon)

- All areas of IP law and practice, in particular patents, trade marks, copyright and designs. 100 reported cases since 2000, of which two thirds were appeals or judicial reviews. Appeared often before the CJEU and the GC (Luxembourg) in appeals from OHIM and Article 267 references (over 40 cases), and in the EPO (Legal and Technical BoA and Opposition Division). Appeared in over 275 matters before the TM registry, and over 50 appeals before the Appointed Person.
- Acted for the UK government, Comptroller-General of Patents, Registrar of Trade Marks, CIPA, ITMA and AIPPI UK.