

CorporateLiveWire

INTELLECTUAL PROPERTY 2021 VIRTUAL ROUND TABLE

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Introduction & Contents

This roundtable discusses the key intellectual property implications regarding COVID-19 as well as highlighting the latest regulatory changes and landmark cases. Our featured experts also offer best practice advice regarding IP considerations during M&A transactions and managing large portfolios. Other topics include the role of IP in the automation and technology industries, challenges for the protection of human rights with regards to access to medicines, and the impact of Brexit.



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Meet The Experts



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Stacey is the founding partner of Kalamaras Law Office. She brings extensive big law experience to the firm, having started her career in Washington, DC, close to the United States Patent and Trademark Office, and more recently here in Chicago, where she worked for one the world's largest law firms, managing global trademark portfolios.

She has spent nearly 30 years working for some of the world's most beloved brands in more than 150 countries and for clients in diverse industries. In January 2018, with the founding of her eponymous firm, she now assists small and medium-sized businesses identify, register, protect and commercialize their brands both in the U.S. and abroad. Before going to law school, she was a brand manager and advertising director in the consumer-packaged goods industry, which gives her valuable insight into her clients' businesses on a practical level.



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Robert heads up the Pharmaceutical Chemistry team at Mewburn Ellis and has over 20 year's post-qualification experience. A leader in his field, he continues to receive recognition across the board for his technical expertise, the quality of his advice, including on licensing issues, and success in European opposition proceedings.

Robert's long-term perspective enables him to understand the strategic issues in taking drugs to market, and he enjoys being able to bring this perspective to clients just starting out on their journey. He takes great pleasure in knowing that the products he has worked on have resulted in products helping patients today.



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Andrew Sherman is a Partner in the Corporate Department of Seyfarth Shaw LLP. He focuses his practice on issues affecting business growth for companies at all stages, including developing strategies for licensing and leveraging intellectual property and technology assets, intellectual asset management and harvesting, as well as international corporate transactional and franchising matters.

He has served as a legal and strategic advisor to dozens of Fortune 500 companies and hundreds of emerging growth companies. He has represented U.S. and international clients from early stage, rapidly growing start-ups, to closely held franchisors and middle market companies, to multibillion dollar international conglomerates. He also counsels on issues such as franchising, licensing, joint ventures, strategic alliances, capital formation, distribution channels, technology development, and mergers and acquisitions.

Mr. Sherman has written nearly 30 books on the legal and strategic aspects of business growth, franchising, capital formation, and the leveraging of intellectual property, most of which can be found on Amazon. He also has published many articles on similar topics and is a frequent keynote speaker at business conferences, seminars, and webinars. He has appeared as a guest commentator on CNN, NPR, and CBS News Radio, among others, and has been interviewed on legal topics by The Wall Street Journal, USA Today, Forbes, U.S. News & World Report, and other publications.

Mr. Sherman serves as an adjunct professor in the M.B.A. programs at the University of Maryland and as well as the law school at Georgetown University and is a multiple recipient of the University of Maryland at College Park's Krowe Excellence in Teaching Award.

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Meet The Experts



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Jan draws on her professional corporate and IP law experience to inform her interdisciplinary research which involves intellectual property rights, finance and corporate governance law, broadly conceived. In 2008 Jan founded and leads the School's Intellectual Property Research Group. She is Deputy Director of the Centre for Business and Insolvency Law and a member of the NLS Centre for Legal Education.

Jan welcomes queries from potential students interested in pursuing PhD research in interdisciplinary intellectual property law, business strategy, corporate governance, data security, IP finance, sustainability and ethics.



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Cecilia is a proactive attorney; she practices law in Intellectual Property being her strengths copyrights, trademarks and geographical indications, ancestral knowledge and biodiversity. Cecilia participates constantly in an active manner in several working groups regarding trends for the industries and policy making; she is Ambassador of the ICC IP Commission for Ecuador, and participates with opinion constantly, she has also successfully conformed and chairs the ICC Ecuador IP Commission which is working on juridical criteria for several projects of law and regulations on IP rights. At ASIPI she has been quite active, leading ASIPI's Geographical Indications Committee for second period she is a constant and hard worker delivering impeccable work. At ECTA and INTA she has been admitted to the Anti-Counterfeit Commissions. Client testimonies are her best reference.



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Domestic and international trade mark registration, searches and renewals, domestic and international trade mark litigation, domestic and international copyright, advertising objections, unlawful competition, passing off, company name objections and domain name disputes. Louise is an experienced trade mark attorney who acts for a number of local and international blue-chip companies.



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Originally from Malaysia, Sumi qualified as a Barrister and subsequently a Solicitor in the UK, before moving to Ireland, where she has spent the last 15 years working in FRKelly's Dublin offices. Sumi counsels foreign and domestic clients in the selection, clearance, prosecution, monitoring and enforcement of Irish, UK and EU Trade Marks. She also coordinates the global IP portfolios of a number of leading Irish companies and represents the trade mark interests of a broad range of SMEs and private individuals, specialising in the food and beverage, FMCG and packaging sectors.



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Patricia McGovern is the Chairman and Head of the Intellectual Property Department at DFMG Solicitors in Dublin, Ireland. She is a Solicitor, Irish Trade Mark Agent and a European Trade Mark and Design Attorney.

She has practised in almost all areas of intellectual property law and advises on both contentious and non contentious matters involving trade marks, patents, copyrights and designs. She also advises on data protection, e-commerce and the internet, technology agreements, media contracts, advertising and sales promotions.

Patricia is a current member and former Chairman of both the Business Law Committee and the IP Committee of the Law Society of Ireland.

She was one of the three Government appointed members of the Copyright Review Group in Ireland which carried out an extensive review of copyright law and reported in 2013.



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Stephen has over 30 years experience in the patent profession. After formative years in corporate IP with ICI and Unilever and a London practice Stephen joined Peter as a co-director at Bawden and Associates in 2004. Stephen has extensive experience advising on all aspects of IP including patent portfolio generation, developing IP strategy, licensing, contentious matters and due-diligence in acquisitions and sales. He has extensive advocacy experience having appeared many times in the European Patent Office in opposition and appeal hearings and is highly experienced in infringement and validity opinion work and international patent litigation in the UK, USA, Japan, Germany, Italy, India and Australia. Stephen has visited India regularly for over 25 years, working with a diverse spread of clients.

He has prepared and successfully prosecuted patent applications in a wide range of technical fields in the life science, medical technology, chemistry, clean technology, engineering, internet-related and high technology fields. Stephen has particular experience in:

- Life sciences and Medical Devices: assays, biosensors, monoclonal antibodies, small molecules, peptide synthesis, biopolymers, scaffolds, oncology, drug delivery, RNAi and gene silencing, immune response, stem cells and functionality, blood products and separation, anaesthetics, analysis and instrumentation, nutraceuticals, histology, implants, replacement joints, catheter design, orthodontics and dental equipment
- Chemistry: polymers including polyurethanes, PE, PP and PET, colour-change chemistry, nanotechnology, cosmetic products including hair, metal recovery, fluorinating agents, CFC replacement refrigerants, synthetic lubricants, detergents, consumer goods and food products, agrochemicals, oil field chemicals, fuel additives, catalysts, films and dyestuffs, petrochemicals, adhesives, coatings, methanol production, mining technology, OLED, semiconductors
- Engineering and other fields: automotive, air separation, reactor and plant design, mixing technology, process automation and control, toroidal power transmissions, internet based-concepts, security systems, business methods

Stephen advises all types of organisations including multinational corporations, mid-size companies, SMEs and universities/ academics in the UK, US, India and Australia, other professional organisations e.g. banks and especially spin-out and start-up companies leveraging his real-world commercial experience in IP.

Q1. Have there been any recent regulatory changes?



Cecilia Falconi

Falconi: Assemblyman Héctor Muñoz presented before the National Assembly a project of law¹ reforming several legal bodies, including the IP Code², the Production Code³ and the Comprehensive Criminal Code⁴. The project was delivered to the Justice Commission which deals with legal reforms. Our firm had participated with criteria and recommendations; four partners were called to speak before the Commission and a few weeks ago by our request, Sasha Mandakovic was called to the plenary. ICC Ecuador and INTA strongly supported these efforts. On 4 May 2021, the Assemblymen at the plenary session approved the reforms by 107 votes. The President will observe per his right on a veto, but we trust the reforms will be maintained. The project then returns to the Assembly for instruction to the official registry for publication, the date on which the reforms will come into force.

Additionally, the customs authority has been tasked with upholding provisional border measures in relation to intellectual property. The relevant obligations that have been reassigned to the customs authority are:

- Exercise surveillance over merchandise of imported or exported products to or from Ecuadorian territory, which in any way violate intellectual property rights. For this purpose, the national intellectual property authority will interconnect its systems and records with the customs authority systems, in order to determine the holders of intellectual property rights that are allegedly violated.
- Alert by suitable means the owner of the registered intellectual property right, about the merchandise that allegedly violates their rights.
- Provide the owner of an intellectual property right with information regarding merchandise import or export operations that allegedly violate their right, without prejudice to taking the necessary measures to protect confidential information; and,
- Suspend for a maximum of five days all customs operations of merchandise containing products that in any way violate intellectual property rights and follow the corresponding notification actions.

This will allow rights holders to quickly find out about the existence of imports and exports of infringing merchandise. Therefore, they will be able to activate the other mechanisms provided by law to mitigate illicit trade and its negative effects.



Louise Myburgh

Myburgh: South Africa recently passed the Exchange Control Circular No.1\2021. The effect of this is that the word capital as found in Regulation 10(c) of the Foreign Exchange Regulations now includes intellectual property whether registered or unregistered.

Furthermore this regulation means that the sale of intellectual property in a loop structure is authorised provided that the foreign company involved is authorised to do so. The transaction is reported to an Authorised Dealer such as a bank, and then an annual report is sent to the Financial Surveillance Department through the Authorised Dealer. An Independent Auditor will also have to be appointed to confirm that the deal was concluded on an arm's length basis, that it was for a fair value, and at a market related price.

1. Draft Organic Law That Reforms Various Legal Bodies to Strengthen the Prevention and Combat Against Illegal Trade, Strengthen the National Industry and Promote Electronic Commerce
2. Organic Code for the Social Economy of Knowledge, Creativity and Innovation. Official Registry, Supplement 899 of December 09th, 2016.
3. Organic Code of Production, Trade and Investment. Official Registry, Supplement 351 of December 29th, 2010. Latest Reform: December 31st, 2019.
4. Organic Comprehensive Criminal Code. Official Registry, Supplement 180 of February 10th, 2014. Latest Reform: February 17th, 2021.



Stacey Kalamaras

Kalamaras: The Trademark Modernization Act of 2020 ("TMA") was passed by the U.S. Congress on 27 December 2020 as part of the huge COVID relief package. The changes will not be implemented at the USPTO until 27 December 2021. I wish to highlight a few of the most significant changes that are forthcoming.

In the United States, there is a three-year presumption of abandonment if a trademark owner does not use its mark in connection with its goods and services. The TMA imposes two new types of ex parte post-registration proceedings to cancel unused trademarks. The first is an expungement or removal proceeding which will be brought before the Trademark Trial and Appeal Board ("TTAB"). Under this proceeding, if the registrant never used the mark in connection with the goods or services in the registration, any third party can bring the expungement proceeding between three and nine years after the registration issues. This method will be particularly helpful in removing foreign owned registrations, so foreign trademark owners coming in under Sections 44 and 66 should be mindful to register only those goods and services that they intend to use in the U.S. The second way is to request re-examination. A third party can request that some or all of the goods or services be removed if they were not used in connection with the registered mark prior to a particular date. Re-examination must be brought within the first five years following registration and would apply only to applications that were filed based on use, or an intent to use basis.

Under the TMA, third parties will also have a new ground to bring a cancellation action before the TTAB. This is similar to the expungement action I mentioned above except in this proceeding the petitioner will allege the mark has never been used in commerce. This new cancellation can be instituted at any time three or more years after the registration issues.

Currently, Office Action response times are set at six months from the date of issue. The TMA would allow the USPTO flexibility in setting a shorter response time to no less than 60 days. Extensions would be available with payment of an additional fee. We do not yet know how this rule will be implemented and it could vary for different types of Office Actions. Trademark owners should prepare now to ensure they are organised and ready.



Robert Watson

Watson: Brexit has brought changes, mainly to the trade mark and design systems in the UK, although there has been a change to the rules for address for service at the UKIPO as well.

Separate trade mark and design registrations for the UK and EU are now needed – direct applications need to be filed with a UK address for service, which also applies to UK patents and SPCs (Supplementary Protection Certificates), and therefore working with a registered UK patent or trade mark attorney for all dealings with the UKIPO is strongly recommended.

For now, the law and practice for both the UK trade mark and design systems will broadly follow that of the EUIPO, although there are already some practical differences that should be taken into account (such as a different limit on the number of representations per design in a design application).

"Brexit has brought changes, mainly to the trade mark and design systems in the UK, although there has been a change to the rules for address for service at the UKIPO as well."
- Robert Watson -

Q1. Have there been any recent regulatory changes?



Sumi Nadarajah

Nadarajah: Unsurprisingly, Brexit has brought about the most significant regulatory changes in IP in recent times. 2020 saw the UK officially withdraw from the European Union on 1 February and become a third-party country after a transitional period that ended on 31 December. This event has multiple consequences for IP rights in the EU, particularly EU trademarks, depending on whether they were filed or registered as of 1 January 2021.

In short, IP rights in the EU have been replaced by a comparable national right in the UK for trade marks, registered and unregistered designs, plant variety rights, geographical indications and EEA sui generis database rights. Essentially, the UK has allowed the cloning of existing EU rights which are now recognised as national rights.

Even laws which were not completely harmonised across the EU, such as copyright law, have been impacted by Brexit. For instance, the EU legislative test to qualify for copyright protection is “author’s own intellectual creation” where an element of creativity is required whilst the old doctrine of UK courts was the “labour, skill and judgment” test – which is arguably easier to achieve. It remains to be seen which test the UK courts will adopt going forward.

The International Registration system administered by WIPO is also affected by Brexit-related regulations which have impacted trade marks and designs protected under the Madrid Protocol and Agreement. Patents are the least Brexit-affected IP right. The main impact of Brexit is on patent litigation due to the establishment of the Unified Patent Court (“UPC”). However, the UPC system which was initially ratified by the UK has subsequently been withdrawn.

In addition, there are new regulations for exhaustion of IP rights, parallel trade, customs, licensing, and dispute resolution all resulting from Brexit. The effects of Brexit are still yet to be fully seen for businesses, trade and consumers in the EU, UK and from a global perspective.



Stephen Geary

Geary: On 31 January 2020, the UK left the European Union and, as of 1 January 2021, the transition period following the UK’s departure from the EU expired. A number of consequences arise in the IP landscape in the UK from this constitutional change relating to registered trade marks and registered designs. An EU registered trade mark and an EU registered design provides a single right, effective for the whole territory of the EU. With the UK’s withdrawal, the territorial effect of EU trade marks and designs no longer extends to the UK. As a consequence, the UK IPO created duplicate or “cloned” UK rights to mirror the EU trade mark and design rights which came into force as the transition period expired. The underlying purpose of this approach has been to place trade mark and design rights holders in the same position of having EU (without the UK) plus “cloned” UK rights equivalent to the EU (prior to UK departure) rights.

With the UK departure from the EU, the Court of Justice of the European Union (ECJ) no longer has jurisdiction over UK IP rights and their interpretation and enforcement. As the UK courts now have jurisdiction, the UK courts are at liberty to diverge from the approach taken by the ECJ although, in practice, it remains likely that the UK courts will have regard to the decisions and jurisprudence of the ECJ.

On patents, the UK withdrawal from the EU has meant that the UK has now withdrawn from participation in the long-awaited EU-wide Unitary Patent system. This system comprises a Unified Patent Court (UPC) to handle patent litigation and a Unitary Patent (UP), providing a single patent covering the EU territories. The UPC was to have courts in France, Germany and UK with cases being allocated on a subject matter basis. The UK branch of the UPC had been designated to handle pharmaceutical and chemical cases. In addition, the UPC faces constitutional challenge in Germany with little sign off resolution for some time as the German Federal Constitutional Court has not included this challenge among its cases to be decided in the next year.

A waiver for manufacturing medicinal products protected by Supplementary Protection Certificates in the UK and EU has been implemented which is intended to smooth supply chain logistics for protected medicinal products.

The present mechanism for obtaining European Patents through the European Patent Convention which has been in operation since the late 1970s is entirely unaffected by these setbacks, as the European Patent organisation is not an EU body.

Q2. Are there any compliance issues or potential pitfalls that firms need to be cautious about?



Robert Watson

Watson: With the UK leaving the EU, a limited nine-month period for the re-filing of pending EU Trade Mark and Registered Design applications was introduced. Therefore, these pending rights would need to be re-filed by 30 September 2021 to keep the original EU filing date.

Although retention of the EU filing date for Trade Marks may not be crucial, it is likely to be especially important for Registered Designs, which have to meet a novelty requirement pegged to their EU filing date (or priority date, if claimed). Registered Community Designs which were granted but had their publication deferred are counted as pending designs, so will need re-filing if UK protection is required. Care should be taken in deciding when to re-file, as the UKIPO only allows a 12-month deferment period, rather than then 30 month RCD deferment period.

Q3. How has COVID-19 impacted the intellectual property landscape?



Louise Myburgh

Myburgh: The South African government implemented an outright ban on the sale of liquor and tobacco, as a means to curb the spread of COVID-19. South Africa was amongst only three countries to implement a ban on tobacco. The lawfulness of this decision was challenged in *British American Tobacco South Africa (BATSA) v Department of Cooperative Governance and Traditional Affairs (COGTA)*, where the Western Cape High Court ruled that the tobacco sale ban was not necessary or consistent with the South African Constitution and administratively flawed. The Western Cape High Court handed down a judgement in favour of BATSA. The arguments accepted by the Court were that the minister failed to justify the limitations she placed on smokers’ rights to dignity, privacy and physical integrity – guaranteed in sections 10, 12 and 14 of the constitution respectively – and on tobacco producers not only to choose their trade but not to be deprived of the property that constitutes their livelihood through the economic impact of the ban. This judgment was only handed down after the ban on the sale of tobacco was lifted. The South African Government filed an application with the Supreme Court of Appeal to appeal the court ruling that the tobacco ban was unconstitutional and this appeal must still be heard.

The growth of illicit trade during the ban caused substantial damage to brand holders’ legitimate businesses. The revenue generated from the sale of counterfeit goods also impacted on the tax payable on legitimate products sold and it was estimated that the tobacco ban was costing the South African government R35 million in taxes daily while the ban remained in place. After 118 days of lockdown, the ban was estimated to have cost over R4 billion in excise taxes alone and also resulted in substantial job losses. The illicit suppliers made billions of Rand tax free and established networks to continue the illicit trade in tobacco and most likely other counterfeit products.

Q3. How has COVID-19 impacted the intellectual property landscape?



Louise Myburgh

The increase in the amount of counterfeit goods that made its way into the market during lockdown also placed brand holder at a disadvantage. Consequently, brand holders must now adopt more aggressive anti-counterfeiting strategies to combat the growth of illicit trade.

The physical lockdown measure also saw a rapid rise in online sales and many businesses were advised by their IP service providers to ensure that their trade mark protection extended to the other areas of business they may have had to embark on to deal with the changing commercial landscape.



Andrew Sherman

Sherman: COVID-19 has had a significant, direct and indirect impact on the ideation, creation, commercialisation and harvesting of intangible assets in both positive and negative ways. On the positive side, the pandemic has forced innovation in the biopharma and medical industries as the world struggled to keep up with demand for PPE, ventilators, hospital beds, ambulances and emergency transportation, and a host of other resources needed to combat the virus. Retailers and food services companies needed to shift their business models to meet changes in demand patterns and consumption. Another benefit of COVID-19 was that innovation cycles needed to be compressed in order to save lives. In the United States, significant credit needs to be given to the Trump Administration’s “Operation Warp Speed” which brought us highly effective vaccines nearly three times faster than the normal innovation cycle. On the negative impact, it remains unclear how the trend towards Work From Home (WFH) and the evolution of the work space and work place will impact innovation, teamwork, collaboration and related face-to-face brainstorming that sits at the root of so much of today’s innovation process. Although online meeting tools such as Zoom and Microsoft Teams purport to be reasonable substitutes for in-person meetings, we probably won’t know for many years how the intellectual property landscape has been affected.



Janice Denoncourt

Denoncourt: The pandemic is abating slowly across developed countries, while flaring up in many developing and emerging economies, notably India, Bangladesh, Pakistan, Turkey, the Philippines, Ethiopia, and Kenya. Throughout this period a heightened interest in the global patent system has grown given the increasing recognition of the importance of patented vaccines and medicines in the pharmaceutical industry.

The global COVID-19 vaccine market

In terms of the global COVID-19 vaccine market, revenue is expected to reach USD 5billion during 2021-2024. AstraZeneca, GlaxoSmithKline, Moderna, Gamaleya, Bharat Biotech, and Pfizer are the key manufacturers of COVID-19 vaccines. The technology R&D precedes the patent process. Pharmaceutical industries are intensely competitive and are characterised by rapid and significant technological progress in vaccine development. They will seek patent protection to secure freedom to operate and to avoid the risk of infringing other vaccine technology.

Multiple products have been approved by the USFDA, EU, and other regulatory bodies for emergency use authorisation (EUA) worldwide. Protein-based vaccines constitute the highest COVID-19 vaccine market share as they contain the purified pieces of pathogen – these vaccines are likely to observe substantial growth through to 2024. Novavax, Chinese Academy, and GSK/Sanofi are the major manufacturers that have approved protein-based vaccines for emergency use authorisation. With regards to patents flows from technology development and R&D, it is important to note that there are few actual granted COVID-vaccine patents at this point in time. In relation to COVID-vaccines there has been a high degree of public/private finance to ensure supply of fairly low price per dose (with some variation). However, the manufacture, supply and access are proving extremely challenging.

Innovation economies and successful vaccine development

Technology was identified by Nobel Laureate Joseph Stiglitz and Erik Brynjolfsson as the primary driver of recent increases in global inequality, especially post-2008. In the long term, what is the solution? According to the 13th edition of the *Global Innovation Index (GII) 2020*, published by the World Intellectual Property Organization (WIPO), the UK is a leading innovation nation. Its research and development (R&D) environment and ability to successfully develop COVID-19 vaccines so quickly should be studied more closely.

Upcoming vaccine vendors include: AnGes, AIVITA Biomedical, CanSinoBio, EuBiologics, Genexine, GreenLight Biosciences, Gennova, Heat Biologics, INOVIO, IIBR, Medicago, Symvivo, Valneva, Zydus Cadila. These SMEs will thrive on the competition engendered through a first-to-file patent application reward, ownership of their technology that will enable them to secure private finance to commercialise any approved vaccine. The patent incentive may be more important for young companies entering the vaccine markets than for established pharma firms such as AstraZeneca, GSK etc. There will be much to learn from the leading innovation nations such as the UK and its proven capacity to develop vaccines under pressure.

In my new research published in *The Future of Intellectual Property* (2021), I examine company classification taxonomy and corporate intellectual property rights owners. I shed light on how the framework of company law can inform and lead to a recalibration of the accountability of corporate intellectual property rights owners. The nature of the owner can influence, and change, the use and meaning of intellectual property. I suggest that it may be time to build a new taxonomy of different types of corporate IP owners, including the distinction between start-ups, SMEs, private and public companies, and the role of subsidiaries and intermediary IP firms. I believe this would assist those who deal with companies to better understand the role of IP and patent incentives depending on the type of firm.¹



Stacey Kalamaras

Kalamaras: It varies greatly by industry and jurisdiction, but in the U.S., we have seen a huge surge in new trademark application filings and that surge started in August 2020 and continues today. We had a record setting year of new trademark applications filed last year and while much of those new filings were from foreign trademark owners, when we eliminate those foreign filing numbers, we still see a slight increase in newly filed applications. This indicates that current trademark owners are likely pivoting their businesses and making sure their trademarks are keeping pace.

Likewise, we know that last year was a record setting year for new businesses being formed in the U.S. and with many of those businesses competing online, they want to be sure they can own a brand they can protect. This increase in filings has created a significant backlog at the USPTO and it has increased the time it takes to secure a new trademark. We have seen the time for the USPTO to examine an application increase by as much as eight to 10 weeks. As of the time of this interview, new applications are being examined in five to six months, instead of three to four months. This means, that trademark owners need to be patient and plan ahead, especially in the case of recording assignments and post-registration renewals.

¹ Sources:

‘Global COVID-19 Vaccine Market Outlook and Forecast 2021-2024: Emergence of Next-Generation Vaccine Platforms & Contract Manufacturers Accelerating COVID-19 Vaccine Production’ (26 March 2021) www.prnewswire.com
[The Global Innovation Index 2020: Who Will Finance Innovation?](http://www.prnewswire.com) Ithaca, Fontainebleau, and Geneva.

Janice Denoncourt, Chapter Four Company classification taxonomy and corporate intellectual property rights owners in: *The Future of Intellectual Property* (20 May 2021) Edited by Daniel J. Gervais, Milton R. Underwood Chair in Law, Vanderbilt University Law School, US.

Q3. How has COVID-19 impacted the intellectual property landscape?



Robert Watson

Watson: There have been some shifts in filing patterns, particular for patents. The number of healthcare applications has grown steadily in 2020, although many of these cases will have been in progress in the International Phase before the pandemic struck. What we therefore haven't seen is a similar cut in filings in the healthcare sector that has occurred in other areas. This is not surprising given the increasing focus on healthcare globally, and continued investment.

Conversely, filings in the transport space fell in 2020 (at the EPO, aviation and aerospace applications dropped by nearly 25%) – it seems likely that many filings were not entered into the European regional phase due to severe budgetary restraints brought about by the pandemic. This is borne out by much smaller drops in filings in other 'engineering' sectors, such as automotive (with only a 1.6% drop in filings).



Sumi Nadarajah

Nadarajah: The COVID-19 pandemic and the measures taken by public authorities to control it have caused disruptions across all sectors of society around the world. Businesses have been prevented from performing their contractual obligations due to lockdown orders, disruptions in travel and import or export bans. IP-related contracts have been equally disrupted. Licences containing provisions for the payment of royalties, or other obligations such as minimum purchases or sales, have become difficult to fulfil in this highly unsettled business environment. Force majeure clauses in contracts have taken on a new significance.

Brands are having to adapt to new ways of doing business, with the more traditional "brick and mortar" businesses having to immerse themselves into the online world to maintain revenue streams. This has created both opportunity and risk from an IP perspective, particularly as brands look for ways to gain a commercial advantage over competitors. In addition, IP protection for COVID-19 vaccines and therapies have, in some instances, resulted in the inhibition of their development or availability – although IP protection is undeniably vital to the development of innovative treatments, tests, vaccines and other technology. The debate on the importance of public interests in the pharmaceutical sector rages on.



Patricia McGovern

McGovern: COVID-19 has impacted the intellectual property landscape in many different ways. While times of crisis can give rise to upheaval, sometimes that upheaval can lead to positive developments. We have seen the pharmaceutical industry and the relevant regulatory authorities work with significant speed to develop and bring to market lifesaving vaccines.

Unfortunately, we have also seen an increase in counterfeit products (e.g. counterfeit versions of vaccines, testing kits and PPE). The increased use of the internet in times of lockdown has given counterfeiters many more opportunities to engage in their activities and play on consumer vulnerability.

Many businesses have had to change their business strategy and their end products during COVID-19. This, of necessity, involves a review of registered rights (e.g. trade marks, to ensure that the specification is now appropriate for the goods and services on which any marks are used), with further filing programs as necessary. We may see controversy down the line as issues arise about genuine use of trade marks or vulnerability as a result of non-use.

Many businesses have found advertising budgets slashed or have had to repurpose their advertising to ensure that it reaches target audiences, bearing in mind that more people are now working from home and socialising habits may have changed. Cessation of advertising may have implications down the line when a proprietor is trying to establish proof of use.

On a broader level, data protection issues have come even more to the forefront, whether in the context of contact tracing, or the issues that arise from remote working and perhaps the perception of less control over employees.



Stephen Geary

Geary: COVID-19 has raised a number of issues both as regards the administration of law through the processes of patent offices and courts and also as a matter of substantive policy.

In broad terms on the administrative aspects, patent offices and courts around the world have generally responded to the pandemic rapidly by implementing suspensions to deadlines and payment of fees where the legal framework allows while maintaining their services in large part. Staff have been encouraged to work remotely and the use of online systems, forms and procedures with electronic signatures has been encouraged.

Q4. How has pandemic enforced closures to the courts and intellectual property offices around the world impacted the registration and enforcement of IP rights during this time?



Louise Myburgh

Myburgh: The South African IP Office (Companies and Intellectual Property Commission) suspended all functions during the hard lockdown. During this period no new applications could be made for the registration of IP rights. The lockdown has resulted in substantial delays at the various registries throughout Africa as records are not fully digitised.

Most of the registries in Africa were either completely shut down for weeks on end or only partially functioning. As time progressed, and COVID-19 regulations were relaxed, more electronic channels were introduced to CIPC. As from 1 March 2021, CIPC has shifted several of its operations to an online based system. Practically speaking, in a South African context, this posed challenges for a country with limited electricity supply and access to internet and/or electronic mediums. This in essence has led to a backlog in the processing of all forms of applications, acceptances, recordals, renewals and the like while adapting to new regulations.

IP enforcement was also affected, as most existing cases were adjourned, extension for deadlines were given for filing actions or appeals, and we saw a delay in opposition and infringement proceeding and hearings. The courts are still functioning at a limited capacity to hear matters. The courts now rely on an electronic system called Case Line, to manage the set-down and hearing of matters.



Robert Watson

Watson: In general, we have seen the IP Offices remain operational, whilst many offered blanket extensions in the early days of the pandemic. These blanket extensions were very useful to applicants as they coped with switching to a remote working model. The IP Offices have done a remarkable job in keeping operating, and the pandemic has forced the acceleration of the switch to e-communication, particularly at the UKIPO and EPO.

There were considerable delays associated with oral proceedings at the EPO in both Opposition and Appeal, as these were traditionally held in person. At the moment, these oral proceedings are going ahead mainly via use of Video Conferencing, although there is opposition to this modernisation in some quarters. As the EPO and attorneys adjust to this new way of working, and the physical kit needed for smooth operation is adopted, I think that this will become the normal mode for oral proceedings, which will bring many benefits.

*"Most of the registries in Africa were either completely shut down for weeks on end or only partially functioning. As time progressed, and COVID-19 regulations were relaxed, more electronic channels were introduced to CIPC."
- Louise Myburgh -*

Q4. How has pandemic enforced closures to the courts and intellectual property offices around the world impacted the registration and enforcement of IP rights during this time?



Sumi Nadarajah

Nadarajah: At the start of the pandemic, IP and legal practitioners around the globe were extremely concerned that lockdown measures would negatively affect IP registration and enforcement. This was borne out, to some extent, by significant delays being faced in many jurisdictions worldwide, while the world scrambled about to find workable solutions around this. IP Offices around the world automatically extended or suspended deadlines or made extensions available to brand/patent owners. It is now feared that the legality of some of these relaxations introduced by the IP Offices/courts could actually be challenged.

IP offices and courts have been forced to adapt to new ways of working and fortunately, many IP offices had adopted electronic filing and communication available to their users well in advance of the pandemic, which has enabled proceedings to continue with relatively minimal disruption in many jurisdictions in relation to IP registration. Similarly, courts in many jurisdictions have improvised to make remote hearings and judgments available to parties via video conferencing or other tools. So for many brand owners, protection and enforcement of their IP rights have continued more or less as normal.

Given the spike in counterfeit activities in relation to goods such as medical devices, face masks, disinfectants, pharmaceuticals, and fake COVID-19 tests, as well as general consumer goods and even digital services, any delays in IP registration and enforcement could result in significant consequences to public health and consumers.



Patricia McGovern

McGovern: All things considered, the courts and the intellectual property offices with which I engage (Irish courts, Intellectual Property Office of Ireland, EUIPO and WIPO) have coped remarkably well with the impact of COVID-19.

As regards the courts here in Ireland, we have seen remote or hybrid hearings become much more common. New platforms have come on stream to facilitate the remote or hybrid hearings of court actions, including actions involving witness testimony. In addition, more routine applications can now be handled remotely. Thus, any negative impact on enforcing IP rights is minimised. It is hoped that some of these efficiencies can continue post COVID thus reducing the amount of time spent in court with consequent cost savings for clients.

At the start of COVID-19, many IP registries implemented automatic extensions of deadlines and exhibited flexibility on extendable deadlines. In many instances, COVID-19 has fast-tracked more electronic interactions, which again it is hoped will continue post COVID and thus permanently result in a time and hence a cost saving.

Bearing in mind the suddenness with which COVID-19 forced courts and governmental organisations to implement a working from home policy or procedures for significantly reduced physical attendance at hearings or remote hearings, they are to be commended.



Stephen Geary

Geary: Courts have sought to employ remote working practices with “virtual” hearings in many jurisdictions. Videoconferencing with Examiners before the USPTO have long been established and provided a seamless way for the USPTO to continue to operate with the occurrence of the pandemic. The European Patent Office has held examination and opposition hearings by video conference with, by and large, success which is due to continue until September 2021, pending further review and a decision by the Enlarged Board of Appeal (G1/21) as to the legality of hearings being conducted by videoconference. Whilst videoconference hearings provide a means of continuing to process cases in the patent offices and courts, there is a significant difference in holding a hearing in person, especially in inter partes proceedings where the “atmospherics” of the room may be lost to some degree with remote attendance.

As regards policy, the possibility of suspending or temporarily waiving patent rights relating to COVID-19 vaccines has been mooted, especially by India and South Africa and supported by the U.S. government. UK and EU authorities presently oppose such moves. This raises questions as to whether such a waiver would be effective without greatly increased manufacture and distribution capacity. More fundamentally, attempts to override property rights may have deeper consequences if employed in circumstances that do not provide adequate recompense to rights holders, specifically deterring future research into new diseases where a risk of loss of protection may manifest itself.

Q5. What IP challenges exist for the protection of human rights with regards to access to medicines?



Louise Myburgh

Myburgh: Just 25 years ago the Trade-Related Aspects of Intellectual Property Rights (TRIPS) raised a number of concerns about the high prices of medicine, market exclusivity and delay market for generics. These concerns have become quite relevant again during the COVID-19 pandemic, especially in the South African context.

Section 27 of the South African Constitution imposes a positive duty on the State to provide healthcare to its citizens, according to necessity rather than affordability. This requires the State to take legislative or other measures to insure the progressive realisation of this right.

The Patents Act in South Africa has a provision that allows compulsory licencing to prevent the abuse of patent rights. The Act permits a Minister to use an invention for public purposes on conditions that are either agreed with the patentee or determined by the commissioner of patents on application made by the Minister.

The State also passed the Medicines and Related Substances Act Control Amendment Act. The purpose of this was to allow the use of cheaper generic drugs in the country, at a large scale. Section 15(C)(a) further allows for the parallel importation of medicine, where the Minister is of the opinion that he is in the position where he must safeguard the health of public.

The Copyright Act 1978 also allows for the reverse engineering of someone’s work if it serves a utilitarian purpose and made by an industrial process. Since the Patents and Design Act do not protect apparatus such as ventilators, it would be possible to reverse engineer them without the fear of infringing on someone’s copyrights.



Q5. What IP challenges exist for the protection of human rights with regards to access to medicines?



Janice Denoncourt

Denoncourt: It is important for IP experts and policymakers to understand how IP law and related-innovation policies may have contributed to inequality and human rights issues with regard to accessed to medicines. In May 2020, the WHO launched the global COVID-19 Technology Access Pool (C-TAP) to encourage widespread voluntary sharing of pandemic-related intellectual property. Similarly, the COVID-19 Vaccine Global Access (COVAX) facility aimed to provide subsidised vaccines to less developed countries, with financial support from the developed world.

The debate surrounding morality, ownership and exploitation of patents when manufacturing and supplying vaccines against COVID-19 is still being resolved. In a communication to the TRIPS Council dated 2 October 2020 (IP/C/W/669), the Indian and South African governments proposed relaxing some of the treaty obligations that require countries to protect the intellectual assets of their own and other countries’ nationals (the ‘patent waiver proposal’). The Council was asked to recommend to the General Council of the World Trade Organization a waiver from the implementation, application and enforcement of Sections 1, 4, 5, and 7 of Part II of the TRIPS Agreement in relation to prevention, containment or treatment of COVID-19.

India and South Africa argued that patents and IP rights were “hindering or potentially hindering timely provision of affordable medical products to the patients”. This proposal has gathered support from the governments of other least and less developed countries. However, the waiver was resisted by governments of the countries where most of the R&D for the new vaccines took place. A press release dated 8 Dec 2020 ‘[Pharma delivers COVID-19 solutions, but calls for the dilution of intellectual property rights are counterproductive](#)’ sets out the Pharma industry’s response.

On 5 May 2021, the U.S. Trade Representative Katherine Tai offered unqualified acceptance of the patent waiver proposal stating: “This is a global health crisis, and the extraordinary circumstances of the COVID-19 pandemic call for extraordinary measures. The Administration believes strongly in intellectual property protections, but in service of ending this pandemic, supports the waiver of those protections. We will actively participate in text-based negotiations at the WTO needed to make that happen. Those negotiations will take time given the consensus-based nature of the institution and the complexity of the issues involved.” In essence, the U.S. is offering to negotiate to support equitable access to vaccines around the world to hasten the return to economic normality.

The patent waiver proposal is popular, is conceived as a moral and ethical duty, and will likely be agreed. However, COVID-related vaccines have no patent protection in the vast majority of low- and medium-income countries so can already be lawfully manufactured and supplied. The pragmatic issue that requires greater focus by the WTO, WHO and WIPO and leading economies is the raw materials supply, knowhow and lack of regional production capacity. The process of manufacturing vaccines is very complex and time consuming and patents are only part of the picture. Scaling up requires potential vaccine production facilities to be identified, equipped, staffed and regulated to develop safe quality-controlled product, continent by continent, region by region. Such facilities need to be established in every corner of the globe not only to address the current pandemic and to be ready for future global health emergencies that are inevitable. Thus the challenge is create operational public health technology hubs around the globe that become a vector for IP owners to collaborate with as part of the IP ecosystem.¹

1. Sources: [Press release published by WIPO](#), Cornell University, INSEAD, and WIPO (2020), Jane Lambert, ‘The Patent Waiver Debate’ (8 May 2021) NIPC Law Blog [www.nipclawblogspot.com](#), Janice Denoncourt, *Intellectual Property, Finance and Corporate Governance* (2018) Routledge



Sumi Nadarajah

Nadarajah: The WTO are being asked (at the behest of 66 nations) to agree to waive IP rules around vaccines – a proposal which was initially blocked by the U.S., UK, EU and Canada. One impetus for this has been a second wave of the virus engulfing countries such as India and South Africa – with the idea being that lower-income and developing nations can now benefit from the knowledge of companies such as Pfizer, Johnson & Johnson, AstraZeneca – and be allowed to produce their own generic vaccines without fear of legal reprisal. The U.S. has recently withdrawn its objection, which removes a major stumbling block to the waiver.

The pharmaceutical companies and drug industry lobby groups are naturally concerned that a waiver of this nature could have a long term negative impact for medical innovation – along with a legitimate concern that the waiver risks the entry of counterfeit vaccines in the supply chain around the world. The real challenge lies in the balance between addressing the shortage of vaccine production and distribution in the world against this move being interpreted as permitting IP theft.

There has been a shift in recent times in the corporate policies of some drug companies bringing them in line with the spirit of their human rights responsibilities. In December 2020, the UN Committee on Economic, Social, and Cultural Rights (UN CESCR) noted that “it is fair that private companies developing vaccines receive reasonable compensation for their investments and research” while instructing companies not to utilise their IP rights in a way that impinges on access to a safe and effective COVID-19 vaccine (bearing in mind that COVID-19 vaccine development benefitted from around €88 billion in public funding from governments). The UN CESCR clearly positions the use of IP rights in the scope of companies’ human rights responsibilities.

Q6. What trends are you seeing within the automation and technology industries when it comes to IP?



Andrew Sherman

Sherman: There are several important trends within the automation and technology industries that have had a direct and indirect impact on intellectual property.

The first trend surrounds a challenge to a long-standing principle of innovation known as Moore’s Law. This innovation premise assumes that technology will be available every 18 months and that it will be twice as powerful as previous applications at half the cost. The 18 month cycle has proven to be too long for an impatient business and personal consumer, especially in a fast-moving and highly competitive environment which puts pressure on innovation teams to produce incremental improvements that are truly “better, faster and cheaper” than what is available in the marketplace, which has turned into a flawed premise.

The second trend in automation and technology is around consolidation, such as the \$16 billion acquisition of Nuance by Microsoft and the \$27.7 billion acquisition of SLACK by Salesforce, as acquiring companies seeking to offer a more robust and diverse set of product offerings to their current and largest customers.

The third trend is that what was once considered “cutting edge technology” such as robotics, automated intelligence (AI), quantum computing, blockchain, cryptocurrencies and virtual reality (VR) are now mainstream technologies with their own industry leaders, mutual funds, exchange traded fund (ETF) and we are just in the early innings to identify the new cohort of cutting edge technologies, including autonomous vehicles, space travel, alternative energy sources and agri-tech.

“Florida has abolished the concept of “custody” and instead parents enter into (or the courts order) a parenting plan where the parties either share parental responsibility and timesharing with the children or the Court orders sole parental responsibility.”
- Jacqueline M. Valdespino -

Q6. What trends are you seeing within the automation and technology industries when it comes to IP?



Sumi Nadarajah

Nadarajah: The increase in innovation, inventions, and access to production is reflected in year over year growth of patent and trademark application filings globally. According to WIPO’s annual World Intellectual Property Indicators (WIPI) report, between 2008 and 2018, global patent filings showed continued overall growth, 72.3% (1.9million to 3.3 million), trademarks increased 159.9% (5.5 million to 14.3 million), and industrial designs were up 61.1% (814,000 to 1.3 million).

As technologies continue to improve and advance, we are seeing more artificial intelligence (AI) making its way into IP, everything from the automation of tasks and in-office actions to filings. WIPO Director General Daren Tang has recently opined: “The pandemic has accelerated long-building trends by fostering the adoption of new technologies and accelerating the digitisation of everyday life. Because IP is so connected to technology, innovation and digitalisation, IP will become even more important to a greater number of countries in the post-COVID world”.

Q7. Have there been any recent noteworthy case studies or examples of new case law precedent?



Stacey Kalamaras

Kalamaras: Last year there were a number of noteworthy cases from the U.S. Supreme Court which affect IP rights. One of the most important cases affecting trademark rights was *Romag Fasteners, Inc. v. Fossil, Inc.*, which was a unanimous decision issued in April 2020. This case centred around handbag fasteners. Fossil was authorised to use Romag’s fasteners in their products through an agreement. Romag eventually discovered that Fossil hired factories in China to create counterfeit Romag fasteners and Fossil did little to guard against those activities. Romag sued, claiming that Fossil infringed its trademark, falsely advertising that the fasteners were Romag fasteners.

The unanimous SCOTUS decision held that while wilful infringement is an important factor to weigh in a trademark infringement suit, it is not required. The court emphasised that reading words into a statute should be avoided, since that is the role of policymakers and not the Court. The Court opined that the Lanham Act was very clear with its mens rea requirement in other sections of the Act, for instance for dilution and counterfeit goods. As a result, the absence of the word in the section on trademark infringement is telling as to the intent of the statute.

This unanimous decision was less than seven pages, demonstrating the straightforwardness to which the Supreme Court Justices were able to conclude that no absolute wilfulness requirement exists in this context. This case resolved a circuit conflict about the Lanham Act, but also came at a very important time during COVID. A decision in favour of Fossil would have seriously affected many trademark owners’ cases in an already difficult litigation environment. This decision will help encourage many plaintiffs to enforce their rights where they may have otherwise been hesitant to bring a suit due to the high cost of litigation and low probability of recovering attorneys’ fees.

A second impact of the decision is that conducting full trademark searches and written availability decisions can help insulate a client and serve as proof that there is no wilfulness in the event litigation ensues. Similarly, to ensure a situation like this does not happen again is to ensure that a licensor has the ability to terminate the agreement if counterfeit goods are found, along with some penalty or liquidated damages clause. By proactively drafting and anticipating this exact scenario, trademark owners can attempt to avoid it in the future.



Sumi Nadarajah

Nadarajah: Some significant EU and UK cases of 2020 were:

Brompton Bicycle Ltd v Chedech/Get2Get (C-833/18): The Courts of Justice of the EU (CJEU) held that copyright protection can cover designs that are dictated by their technical function under certain conditions. In this judgement the overlap between copyright and design law was assessed and the Court’s decision to grant copyright protection to a product’s design has resulted in long-term copyright protection for the proprietor as opposed to the 25 years maximum protection provided by design rights. This case is hailed as a potential game-changer in the design world and will certainly have an impact on the IP choices made by designers going forward.

Galletas Gullón v EUIPO - Intercontinental Great Brands (gullón TWINS COOKIE SANDWICH), (T-677/18): The CJEU examined whether the shape of an Oreo is distinctive in the EU. This question was at the centre of a trade mark dispute between Oreo and Oreo Twins that has lasted several years. The CJEU decided that the mark applied for was “visibly a complex mark, which is composed of several figurative and word element”.

Italian Consorzio di Tutela della Denominazione di Origine Controllata Prosecco v Les Grands Chais De France (EWHC 1633): The Italian Consortium for the Protection of the Controlled Designation of Origin Prosecco successfully opposed a UKTM application for NOSECCO based on their Protected Designation of Origin in the Prosecco name.

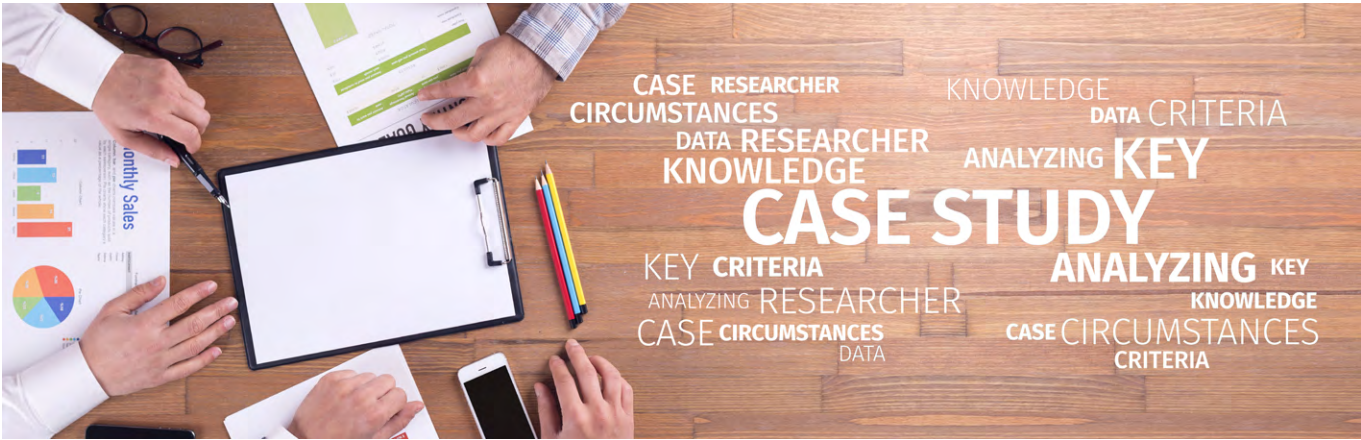


Patricia McGovern

McGovern: A blocking injunction can be a useful tool, resulting in internet service providers (ISPs) identifying and blocking access to certain websites engaged in infringing activity. The Irish courts have granted many of them over the last number of years. On two occasions in 2020, the Irish High Court dealt with these applications, one brought by The Football Association Premier League Limited and the other by Union of European Football Associations (UEFA). In both cases the Court reiterated the relevant legal test for the granting of a blocking order:

- it must be necessary;
- the costs involved must not be excessive or disproportionate and the order itself should not be unduly complicated;
- the cost sharing proposals must be fair and reasonable;
- the order must respect the fundamental rights of the parties affected, including internet users; and
- the duration of the order and the provisions for review must be reasonable.

The blocking injunctions were not opposed by the ISPs.



Q8. What are the main IP considerations during an M&A transaction?



Andrew Sherman

Sherman: From the seller’s perspective, the primary considerations are pre-sale audits to uncover embedded intangible assets and the subsequent presentation of the company’s intellectual properties and intangible assets to target buyers to maximise enterprise valuation, as well as favourable price and terms in the definitive purchase documents. This will require a strategic pre-sale audit of intangible assets, as well as a long-term commitment to building and maintaining a culture of innovation and avoiding excessive employee disengagement. Sellers must be cognisant that intellectual property “beauty is in the eye of the beholder” and should look at their developed strategies from the perspective of a potential buyer.

From the buyer’s perspective, intellectual property considerations have both a strategic and technical aspect of the buyer’s due diligence process. On the technical side, key tasks include a review of the chain of ownership, determining any third-party claims and ensuring proper transfers and recordation of intellectual property rates on a post-closing basis. On the strategic side, the due diligence process is more like an “Easter Egg Hunt” or “Where’s Waldo?” puzzle to find embedded value and hidden assets which can be drivers of long-term strategic value on a post-closing basis. Finding the diamonds in the rough, that sellers may not be able to identify for themselves, often drive successful, long-term M&A strategies.



Stacey Kalamaras

Kalamaras: During an M&A transaction, IP counsel should always be consulted to ensure all the IP rights potentially being transferred are properly vetted. This includes ensuring that the ownership is correct, that the chain of title is up-to-date, and that there are no outstanding unreleased security interests. If any of these issues are left unresolved, IP counsel can help advise how to resolve these issues before the deal closes either by drafting agreements to be signed at the deal table and/or putting money aside in escrow to ensure these issues are handled post-closing.

I have seen too many instances where IP counsel is not consulted and/or IP due diligence is not properly conducted and some of these loose ends can end up costing a buyer a lot of money or are difficult to resolve after the fact, especially in some jurisdictions. If you are the buyer, make sure you know exactly what you are buying, and that the IP is unencumbered from security interests and any lawsuits.



Robert Watson

Watson: The key considerations relate to assessing the existence, validity and enforceability of the IP rights owned or licensed and whether the scope, geographical extent, and term of the IP rights is appropriate to protect and complement the business of the company. However, it is also important to assess the chain of title (ownership) of the IP, and any possible encumbrances on it (such as licences and mortgages).

Depending on the stage of the company under consideration, it can be useful to carry out freedom to operate analyses on key commercial products, processes or trade marks used by the company, and also to investigate the existence or likelihood of IP-related litigation, and where it is present, understand the risk. Unregistered rights, and know-how, can often be crucial, and these need to be assessed, and ensure that they are part of the rights being transferred.

The way the company of interest manages its IP can be an indicator of the health of their IP estate, and reviewing IP policies can help determine this. This can lead to advice on future management of IP once the acquisition or investment has taken place.



Sumi Nadarajah

Nadarajah: Most corporate M&A transactions raise IP considerations. When an M&A transaction is at the negotiation process, certain key issues must be addressed. In addition to a general due diligence to investigate the financial and legal status of the target business, many corporate M&A’s seek an IP due diligence to help buyers not only to address which of the intangible assets will be within the power of disposition, but also to avoid prospective disputes. In some instances, the target company’s IP portfolio is the company’s most valuable asset.

There are many aspects of the IP due diligence: timespan, identification, sufficiency, ownership, freedom to operate, existing IP agreements, liens and encumbrances, cross-border transactions, validity checks, risk management on the payment, scope of rights granted in respect of licences-in, scope of licences-out already granted, chain of title to such assets, whether anybody is challenging the validity of the assets, and whether the third party is potentially infringing any other intellectual property rights.

For a prospective purchaser, failure to conduct proper IP due diligence could result in significant wasted transaction costs if the transaction fails due to an adverse issue that could have been identified early on. Additionally, failing to conduct an adequate review and having sufficient warranties could also mean paying for assets that are worth less than they thought. It could even mean paying for assets that have onerous liabilities to third parties attached to them and which they cannot use. For a prospective vendor, good IP housekeeping practices, and a structured approach to IP due diligence, will assist in maximising the value of your intellectual property assets.



Patricia McGovern

McGovern: IP is an asset and can be an extremely valuable asset. If you are a seller you will want to make sure that all IP is identified, valued and reflected in the price that you obtain. If you are considering selling your business, you should be doing this well in advance and have your house in order. If you are a buyer, you will have to carry out due diligence so that you know what you are getting and whether or not it comes with any problems or vulnerabilities.

When carrying out due diligence, important things to establish are the ownership of any IP and its current status. For example, has registration been obtained where appropriate and, if so, are there adequate records for when any registrations need to be renewed; has any IP been licensed in or licensed out; and are there any coexistence agreements in relation to its use. Become aware of any disputes that may exist and the chances of success in relation to those disputes. Also, establish if any of the IP is subject to vulnerabilities.



Stephen Geary

Geary: Understanding the nature and value of the IP portfolio of the parties to the transactions, including patents, designs, trade marks and proprietary technical and commercial information is key. The extent to which the technology and business involved in the M&A is protected by the IP portfolio and the value of the business that is protected by it provides a basis for valuing the portfolio. IP accordingly forms a cornerstone asset in enhancing the value of a business or, if not appropriately generated, managed and used, in devaluing the intrinsic value of a business.

Presenting the portfolio advantageously in M&A and, as a buyer, carrying out thorough due diligence to understand the relationship and coverage between the IP portfolio and the business will often be value-adjusting. In addition to the relevance to the products and business, further critical factors to consider include the status of the IP portfolio around the world; which rights are granted and pending; the remaining term of the protection and whether it protects next generation products; and monitoring and management of third party rights to ensure awareness of infringement risks including IP related court actions both offensive and defensive.

Q8. What are the main IP considerations during an M&A transaction?



Stephen Geary

Identifying key patents or other rights which protect key products and also competitor rights which may impact disproportionately on key products is essential so as to gauge the relative importance and value of the component parts of the business and its exposure to risk.

Where IP disputes arise, sale/purchase of a business or part thereof may provide a way of resolving the dispute, to the mutual benefit of the parties.

Q9. What are the challenges of managing a large IP portfolio?



Andrew Sherman

Sherman: Big portfolios usually mean big budgets and “lots of chefs in the kitchen.” Companies must appoint a Chief Innovation Officer who can navigate and manage through turfmanship, inefficiency, roadblocks to collaboration and silo’s that drive politics, nepotism, bias and favouritism in budgeting and allocation of strategic resources. Many companies lack an Intangible Asset Management (IAM) system or have an old system in place which is more mechanical than strategic. Large portfolios may also infer cross-border or multi-jurisdictional ownership which triggers cross-cultural or language barriers, as well as differences in the legal and regulatory aspects of each jurisdiction.



Stacey Kalamaras

Kalamaras: There are a number of challenges in managing a large IP portfolio, whether the IP rights are domestic or global. Here are a few of my tips:

- There should be one person responsible for monitoring upcoming deadlines, as it is critical that trade marks are properly maintained to be active. Make sure someone is in charge of the docket. If you are in-house, decide whether you want to manage the portfolio internally, or if you are working with outside counsel, I recommend maintaining a shadow docket to stay on top of your portfolio. One of the most successful relationships I had with in-house counsel on large portfolios is where we began setting out all the deadlines one year in advance. We spent a few months working together to identify which marks needed to be renewed and gathered all the necessary items to renew the marks. Then, we just had a team member working throughout the year to file the requisite information as deadlines approached, and the client could be certain all the deadlines were handled. With a little bit of planning it is possible to determine a method that works best for you, and that is not taxing on your internal resources every month.
- It is critical that you properly police your marks and the easiest way is to set up an annual watch service for your key marks. This will enable you to monitor newly filed and published marks in your jurisdictions of interest so that you know when to take appropriate action. You may want to also set up a Google alert for your main brands to highlight any use which you can review with your outside counsel for any potential threats that are not yet registered.
- To control costs, know which items you will handle in-house and which items you will outsource. Perhaps all preliminary searches will be done in-house, but all full searches will be sent to outside counsel. Or all applications will be filed in-house and any substantive Office Actions will be handled by outside counsel. Have clear processes identified up front to ensure there is no last-minute scrambling and that important projects do not fall through the cracks. Your outside counsel can also help you determine what a good workflow of projects might be.



Robert Watson

Watson: We see a key challenge to be prioritising individual families of rights within the portfolio and deciding where to file these at the key milestones, for example, 12 months, PCT national phase, and EP validation (for patents). At Mewburn Ellis, we recently concluded a detailed study of the validation of European Patents in the pharmaceutical sector, which turned up some interesting information about the countries chosen (see [here](#) for the full report).

However, continued review of an established portfolio is also needed to see whether all the rights in place are still needed. Although giving up hard-won IP rights may seem odd, the annuity costs of an established portfolio can make up a large proportion of IP spend, and often rights cover areas of technology which are no longer being actively pursued.



Sumi Nadarajah

Nadarajah: This question can be addressed from the perspective of company owners, or in-house legal/IP/marketing teams that have to deal with numerous products sold worldwide which have their own brand names, patent or design protection. Or indeed, from the perspective of attorneys or legal firms managing the global IP portfolios of their clients. Either way, the challenges are pretty much the same which revolve around the following:

Recognising IP as assets: Today’s IP owners tend to look at their IP portfolio as assets and not merely inventory, which would have traditionally been the case. It is said that successful IP portfolio management involves a larger scale of decisions, starting from product research and development, through the patent/trademark application, prosecution, enforcement, and until the end of life of the product or until the patent has expired (or the brand no longer in production). The decisions made during this period are all part of IP portfolio management, and this cycle will continue as the next generation technology or product carries on from the previous generation. The efficient management of the IP life cycle comes with its share of challenges that need to be addressed continuously and consistently to ensure the smooth prosecution life of the relevant IP.

Timelines: Each IP application has numerous deadlines during its lifecycle. The process and deadlines vary from country to country and differences exist in procedural laws and rules involved in the process of protection and management. Consequently, understanding the different laws and associated timelines and requirements are very important as failure to do so could result in IP rights being lost.

Co-ordination: At each stage of the IP lifecycle (i.e. from filing to payment of post-grant annuities or renewal of TM registrations), the portfolio manager has to interact with clients, attorneys and IP offices. Concerns with respect to receiving timely instructions from clients and prompt responses from foreign attorneys often arise. Additionally, interacting with different foreign IP offices can become challenging due to language and time barriers, which can often add to the difficulties faced.

Reliable Network of Advisors: One of the key requirements for the effective management of a global IP portfolio is to have a network of reliable, knowledgeable and efficient associates in jurisdictions around the world that share the goals and values of the portfolio manager. This is particularly the case as IP prosecution and enforcement varies significantly from country to country, and it is unrealistic to expect the portfolio manager to be completely au fait with these different regulations. As such, a good portfolio manager requires a reliable network to efficiently manage the IP assets in its care.

Docketing system: Portfolio managers will vehemently agree that docketing is paramount. The importance of well-maintained dockets can never be underestimated. If the docketing is not done timely or accurately, this may result in the loss of a patent or trademark. Hence, a systematic and well defined docketing process and investing in reliable portfolio management tools are of utmost importance.

Q9. What are the challenges of managing a large IP portfolio?



Patricia McGovern

McGovern: The most obvious solution to the challenge of managing a large IP portfolio is to ensure that you have a proper trade mark management system in place and competent people to manage it. This should ensure that any relevant deadlines (e.g., renewal deadlines), are recorded with suitable reminders.

Following on from that, the actual portfolio needs to be reviewed constantly to ensure that it is adequate. For example, have there been improvements to any inventions such that further patent protection should be sought? Are all trade marks being used in the form in which they are registered or do new filings need to be considered? Has your product line expanded such that you need to re-file to obtain protection for other goods and services? This may be particularly relevant if there is product diversification as a result of COVID-19. Have you kept adequate records of any coexistence agreements that you may have entered into or any licences of your IP that you may have granted? Do you own rights that are surplus to your requirements that perhaps could be income generating if you licensed them or assigned them?

Brexit has also introduced some challenges to portfolio management. From 1 January 2021, EU trade marks are no longer protected trade marks in the UK. On 1 January 2021, the UK Intellectual Property Office created a comparable UK trade mark for EUTMs registered prior to 31 December 2020.

This UK right:

- Is recorded on the UK trade mark register;
- Has the same legal status as if the proprietor had applied for and registered the trade mark under UK law;
- Keeps the original EUTM filing date;
- Keeps any original priority or UK seniority dates;
- Is a fully independent UK trade mark that can be challenged, assigned, licensed or renewed separately from the original EUTM.

It is not necessary to pay any official fee for the UK trade mark. It has a new number consisting of a prefix of “UK009” followed by the last eight digits of the current EU registration number. Managers of IP portfolios need to ensure that they create new records for these comparable UK registrations and ensure that they have an appropriately qualified address for service.

In addition, where an EUTM allocation existed as of 31 December 2020, the proprietor is entitled to:

- apply to register the same trade mark as a UK right on or before 30 September 2021;
- retain the earlier filing dates of the EUTM that was pending as of 31 December 2020;
- claim any valid international priority it had on the pending EU applications, along with any UK seniority claims.

The UK application must:

- relate to the same trade mark that was the subject of the EUTM application;
- seek protection in respect of goods and services that are identical to, or contained within, the corresponding EU application.

If the details of the UK application do not match those of the corresponding EUTM application, the earlier EU filing or priority dates cannot be claimed. Effectively the UKIPO will treat the pending EUTM application as a UK application and examine it under UK law.



Stephen Geary

Geary: Ensuring good decisions are made on what products or other innovation is to be protected, why, where and how is a primary objective in generating a valuable IP portfolio. Such decisions require an understanding of the gestation period for the technologies in question and the likely longevity of the product once launched before further innovation renders it obsolete. These factors also determine the appropriate IP strategy to adopt, for example filing patent applications to generate a large body of pending IP in the knowledge that product innovation may be on a timescale shorter than the period to patent grant or, as an alternative, focusing on “cornerstone” cases that will underpin the technology and business for the longer term.

Matching the portfolio with the global business needs so as to understand which part of the portfolio provides commercial benefit and in which countries and understanding which parts are of lesser value, enables active portfolio management. This may take the form of pruning to remove “dead wood” and amending applications so as to ensure commercial relevance. Sophisticated portfolio management requires an understanding of the entire portfolio and all the cost implications and having an appropriate budget and readily accessible expenditure information to enable effective cost control while retaining strategic value.

Q10. What strategies and systems can be utilised to ensure intellectual property rights (IPRs) are fully protected and effective?



Robert Watson

Watson: The most important strategy for ensuring full protection of an invention is to invest sufficient time and effort in the drafting process. Investment in a high-quality draft pays huge dividends during the prosecution of patent applications and in litigation.

The drafting process should be collaborative, with the client sharing all the information available around the invention – sometimes pieces of information the client considers insignificant can make a huge difference to the application. It is also important to consider including as much supporting data as possible in the application, as in global prosecution, a lack of such data can adversely affect the scope of rights granted.

It is also key that the client (and the inventors) reads and understands the draft application before it is filed. The inventors are often best placed to spot misunderstandings during the drafting process, which can harm the eventual outcome.



Sumi Nadarajah

Nadarajah: For many companies (for example, those in the pharmaceutical sector), IP is much more valuable than any physical asset. IP theft costs U.S. companies as much as \$600 billion a year according to the Theft of Intellectual Property Commission. With such figures at stake, it is clear that companies need strategies and systems in place to ensure the safekeeping of their IP. A prudent business owner should take the following steps to ensure the safety of their IP:

Prioritise IP by appointing an executive or team to oversee this area of their business: This entails collaboration between the CEO, COO, HR, Marketing, Sales, Legal, Production and R&D teams periodically to identify and protect the IP belonging to the business.

Adequate budgeting: Companies which are serious about their IP and recognise these as business assets make adequate budgetary provisions for securing the protection of IPRs as well as the enforcement of such rights. This can be more challenging for smaller businesses or start-ups which may not have the luxury of big budgets for IP – however it is extremely short-sighted to ignore or neglect IP protection as part of a cost-saving measure. Too often, start-ups end up forfeiting intellectual property rights by neglecting to protect their hard work.

Q10. What strategies and systems can be utilised to ensure intellectual property rights (IPRs) are fully protected and effective?



Sumi Nadarajah

Evaluating core assets and deciding on the IP protection required: Companies often believe that patent protection is the only way to protect itself. Technology start-ups, for instance, frequently ignore the value of non-patent intellectual property. While patents can be incredibly valuable, it does not necessarily ensure that a company's product is good or that it will sell well. Trade secrets, cybersecurity policies, trademarks, and copyrights can all be forms of IP that can be protected. Spending a little time to evaluate the company's value proposition, and the best way to protect it, can be very important over the long haul.

Ensure that the IP is owned by your company: I've often encountered clients that allow their foreign distributors to register their company's trade mark in the distributors own name only to have a falling out with the distributor who then refuses to return the IP to the rightful owner. This can result in a costly and often futile legal dispute in the foreign jurisdiction and sometimes even having to "buy" the mark back from the distributor for a grossly inflated fee (which would far outstrip the cost of having simply registered the mark in the owner's name in the first place).

Choose and protect your name with care: Your brand can be immensely valuable in the marketplace. Companies should make sure their name and any logos are clear for commercial use. If the names and logos are available to use, companies should register them as trademarks. In addition to preventing competitors from taking or using the company's name, trademarks help a young company build a unique and identifiable brand. This, in turn, promotes the company's visibility in the marketplace. Trademarks are also relatively cost effective (particularly when compared to patents).

Consider a global IP strategy: Having a global strategy in mind is an important consideration for companies. In an effort to protect their inventions quickly and cost effectively, smaller businesses often overlook international standards of protection. Accordingly, down the line when the company looks to start expanding to international markets, it may find itself stuck without protection in important countries. Filing without understanding what international protection a company requires may result in international application time frames lapsing, barring a company from international protection. At a minimum, companies should seek advice from IP professionals about a strategy and the costs involved.



Patricia McGovern

McGovern: To ensure that your intellectual property rights are fully effective and protected you should consider the following:

- Ensure that you own any intellectual property to which you claim to be entitled (e.g. by having appropriate assignment provisions in any contractor agreements);
- Ensure that any invention you develop is not disclosed to the public, before you have filed for patent protection, without a non-disclosure agreement being put in place.
- Ensure internally you protect your knowhow and trade secrets and that they are restricted to staff on a need to know basis.
- As regards trade marks, make sure that you cover all relevant jurisdictions. While budgets are always tight, ultimately this could be money well spent.
- Ensure that you file for trade mark protection for all the goods and services you anticipate that you will use your mark for. This is even more important in the COVID-19 era where we see businesses using their marks for goods and services that they were not used for previously (e.g. drinks manufacturers now producing hand sanitisers, sportswear manufacturers now producing medical uniforms etc.). Proprietors may need to consider new filings to protect their brands in these new areas. While you can rely on unregistered rights, there is no doubt that registered rights put you in a much stronger position if your right is ever challenged.
- Be conscious of the obligations in certain jurisdictions to provide evidence of use or whereby your marks may become vulnerable through non-use. COVID-19 may give rise to non-use issues.

- Consider design right filings. Design rights can be something of the Cinderella of IP, but they can be very useful in particular industries.
- While copyright protection arises automatically, it is helpful to keep records of your works created with timestamps for evidence as to when the creation was made.
- Enforce your rights when the need arises.



Stephen Geary

Geary: An effective IP strategy requires an understanding of the nature of the business to which any technology is directed, a thorough understanding of the essential technical ingredients supporting the business, the existing and emerging competition and competitive products, market trends and strategic shifts, alternative technologies and the supply chain, both suppliers and customers. These elements form the landscape against which an IP strategy may be set and the strategy must integrate these business and technical factors with detailed legal knowledge and practice in all markets of interest. Furthermore, an organisation must foster an IP culture and processes in which there are good working relationships between those with the technical expertise, the business leaders and the IP experts.

At a practical level, regular reviews of technical and commercial developments enable IPR's to be identified, developed in parallel with the evolving technical and commercial activities. Local attorneys in each country in which IP is sought are necessary and selection of attorneys that reflect the approach to IP of the instructing organisation is essential in enabling implementation of the IP strategy at a local level. Clear decisions, consistent with the IP strategy, informed by the business objectives and rolled-out by local, like-minded experts provides a means of developing focused and cost-effective IP portfolio.

Monitoring the competition including their products, marketing, public pronouncements and both their past and evolving IP portfolios and commercial activities are also essential functions and tasking specific people or groups to carry out this "early-warning" system enables the IP activities to reflect the changing competitive landscape.

These activities are complex and require timely action by appropriately trained and qualified experts. Bespoke systems for logging IP rights, deadlines, enable reliable and efficient management of the large volume of deadline-critical information and generation of reports and information to enable effective management of IP. Such tools also provide up-to-date cost information and predictive capabilities, having regard to the complexity of different procedures in different countries records and predictions to support cost-effective IP management.

Q11. What are the most common mistakes clients typically make and how can you rectify these?



Louise Myburgh

Myburgh: In South Africa, one of the common mistakes that clients make is not conducting a clearance search before filing an application for registration of a trade mark. Consequently, when the trade mark application is examined by the Registrar, it may be refused registration due to the existence of an earlier mark on the register. By adopting a trade mark before conducting the aforementioned clearance search, clients may also embark on using a trade mark which infringes on the rights of a third party that owns a prior registration.

Clients are also prone to attempting to register trade marks that are not inherently distinctive. The main reason for this may be that clients are in a rush to get their products onto the marketplace, which leads to them adopting generic or descriptive marks, in the mistaken belief that it would make it easier for them to market their goods or services. During the past year we saw a trend develop of individuals or businesses applying for COVID-19 related trade marks, such as SANITISE, CORONA and SOCIAL DISTANCE in the mistaken belief that this could be registered.

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Louise Myburgh

Clients are also not always aware of the broad spectrum of IP rights. In South Africa, it is possible to obtain protection for both aesthetic and functional designs with the emphasis being on the shape pattern or configuration of the products.

Clients furthermore do not fully appreciate the rights that are obtained and that need to be secured when copyright may be relevant. In many instances’ businesses would instruct an independent contractor to create a work which attracts copyright. In these instances, the work undertaken is paid for, but the business is not aware of the fact that these rights have to be objectively identified and assigned in writing to the business unless the creator of the work is employed by the business. If this assignment of the copyright is not in place then the independent creator of the work will own the rights to the copyright in terms of the South African laws that regulate the ownership of copyright.

We attempt to rectify and address these possible pitfalls by advising clients to conduct clearance searches, and by publishing articles and presenting training sessions dealing with the pitfalls and how to address it. Our firm also offers a free watching service for clients with trade marks on our records to alert them to possible issues that arise with regard to the registration of conflicting trade marks and company names.



Andrew Sherman

Sherman: One very common mistake is known as NIH (“Not invented here”) syndrome, where the client assumes that the best innovation will come from “within the four walls” of the company. Today’s innovation best practices are more fluid and more dynamic and the best ideas may come from the totality of the client’s ecosystem. Be careful to urge clients to look beyond their walls to distribution channels, supply chains, customer networks, franchised systems, universities, governments, industry experts and consultants to help trigger new innovations and strategic partnerships.



Stacey Kalamaras

Kalamaras: For SMEs in particular, there are three common mistakes:

- Hesitating about spending money on conducting a trademark search and then being surprised when their trademark is refused, or they otherwise learn that they are not entitled to use their trademark. A trademark search is one of the simplest, most cost-effective activities any trademark owner can and should do to ensure that it is not infringing on anyone else’s rights. In addition, by conducting a full availability search, we learn a lot of information about the mark which can help us in prosecuting the application.
- Waiting to apply for a trademark until it is generating some level of cash flow. This is a big mistake. In the United States, while the first user of a mark in connection with particular goods and services in interstate commerce will generally be the senior user, the USPTO examines applications in the order in which it receives them. By waiting, it can cost at least 10 times as much to secure a trademark registration than if the trademark owner had applied once it completed its search and had its business plans ready to go. For other jurisdictions, especially those that are first-to-file countries, it is even more important to file as soon as the trademark owner’s plans are set in place. Trademark counsel can be a great resource here as utilising the priority conventions can be helpful when expanding globally.
- Clients are not always strategic with respect to filing applications. They often take a shotgun approach before thinking through the strategy. This usually leads to increased costs and the need to re-file or backtrack. Always start with a strategy and discuss it with your trademark counsel. Be deliberate in everything you do. If you’ve

been opposed or receive a demand letter, don’t just ignore it or start filing new trademark applications without considering the bigger picture. Be strategic. Consider your marketing and business plans for at least the next three years. Does your current trademark strategy help you realise those goals? If not, what is missing? And do you have the budget to pay for your strategic plan? If not, that also needs to be part of the discussion and the strategy. Every action should be prioritised in line with your budget. A good trademark counsel partner can help you with all of that.



Robert Watson

Watson: The worst mistake that a client can make if they are seeking patent protection is to cause or allow information about the invention to be published before the application is filed. Although grace periods exist in some jurisdictions to exempt such publication from the prior art, they do not exist at the EPO or in China, two of the major patent jurisdictions.

In fact, publication of information about the invention is best delayed until after the PCT (and/or other 12 month) applications have been filed, as publication during the so-called ‘priority year’ can affect the 12 months applications if material is added to them.

As mentioned, it is possible to use the grace period in some jurisdictions to take the published information out of the prior art. However, in countries without a grace period, a careful comparison of the information disclosed, and the patent application can reveal avenues for protection of non-disclosed embodiments.



Sumi Nadarajah

Nadarajah: As a trade mark practitioner, the most common mistakes by clients that I have encountered are as follows:

- Securing a domain name registration for their brand/company name (www.brandname.com) and believing that it gives them ownership rights in the name. Only a registered trade mark gives them proprietary rights in the brand/company name.
- Registering a business or company name and believing that it entitles them to ownership in the name. Whilst Ireland is a common law jurisdiction and unregistered trade mark rights can exist in certain circumstances, these are more difficult to establish and the safest bet is to secure Trade Mark registration which is a statutory right.
- Self-filing Trade Mark applications without any legal background or specialist knowledge and failing to protect the correct goods/services offered by them resulting in being unable to enforce their rights at a later date against unauthorised use by a third party. If you are not an expert in this field, my recommendation is that you find one to assist you. It will pay off in the long run as you will have secured an asset which adds value to your business.
- Failing to secure Trade Mark protection for their company or brand name at an early stage and ending up having to re-brand due to a competitor obtaining registered rights in the identical name (often times by sheer coincidence).
- Failing to conduct proper due diligence when choosing a name including Trade Mark clearance searches on the chosen names resulting in a dispute at a later stage with the proprietor of prior conflicting Trade Mark rights demanding that they cease and desist all activity under the said name.
- Business owners should focus on their basic IP protection as early as possible to avoid these common pitfalls.

Q11. What are the most common mistakes clients typically make and how can you rectify these?



Stephen Geary

Geary: There are many pitfalls for the unwary in securing IP protection including

- Failing to consider IP at the right time in a venture, with it often being considered too late;
- Viewing IP as an overhead or simply a cost rather than a commercial asset offering a potential return;
- Approaching the IP as an extension of technical activity rather than it also being a business tool. Integration of business, technical and legal factors is essential in order to maximise commercial value;
- Researchers/inventors may not recognise protectable IP due to applying too high a technical standard rather than the applicable legal standard resulting in a difference in view between Patent Offices in many jurisdictions researchers;
- Overlooking the possibility that activities, products or processes in development or in commercialisation may fall within existing IP of third parties and failing to check for the existence of such IP;
- Lack of sophisticated awareness of IP processes generally and opportunities in different jurisdictions and the associated costs.

Whilst both small and large organisations may fall foul of one or more of these pitfalls, they may be remedied by:

- Education on the nature of IP and the basics thereof from the outset and creating an “IP-aware” culture;
- Involvement of IP experts in day-to-day activities;
- Establishment of an appropriate IP management structure that integrates the commercial, technical and legal aspects of the venture, with input to executive level decision-making;
- Recruitment of individuals who understand or are capable of understanding IP;
- Establishment of an IP budget;
- Regular reporting on the status of IP activities and the associated expenditure to expose the scope of the portfolio to those whose business it supports.



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