

CorporateLiveWire

INTELLECTUAL PROPERTY

EXPERT GUIDE 2024

www.corporatelivewire.com



NAVIGATING INTELLECTUAL PROPERTY LAW

IN THE GENERATIVE
AI REVOLUTION - P20

TECHNOLOGY'S IMPACT

ON INTELLECTUAL
PROPERTY - P54

TRADEMARK RIGHTS IN THE CROSSHAIRS

DECODING INVESTMENT
BOYCOTTS AND JUDICIAL
DYNAMICS IN ALGERIA - P32

THE PREVAIL ACT:

IMPENDING CHANGES TO
THE U.S. PATENT LITIGATION
LANDSCAPE - P46

IP CHECKLIST FOR SMALL AND MEDIUM ENTERPRISES

By Sumi Nadarajah

As an Intellectual Property (IP) practitioner, part of my job entails dealing with start-ups and new businesses and advising them on their rights and business assets. For me, it's probably the most energising aspect of my work. I love learning about new innovations and ideas, and it gives me untold pleasure when I come across my client's products or services in the marketplace – more so if I was personally involved at inception of the enterprise.

In my experience, SME's and start-ups often need help to identify, protect and tap into their IP, which is essentially a business asset that can so easily be lost by exposure to competitors. An IP checklist can help to prevent common pitfalls encountered. Unsurprisingly, there is no one-size-fits-all checklist as there are numerous factors involved, such as the type of business, the jurisdiction, the concept, technology or innovation involved, target markets, competitive landscapes, etc. Each business faces its unique challenges which necessitates a customised and tailored IP strategy. However, I have put together a "first instance" checklist as a starting point.

FIRST STEP: Identify the IP asset

SME's should examine their business model and functioning and assess which IP to protect:

TYPE OF ASSET	DESCRIPTION
Patents	An idea or invention which is novel
Trade marks	Brand name, logo, slogan
Designs	The look and shape of a product which can include patterns, colours, lines, etc.
Copyright	Protection of an original work of literature, music, etc.

NEXT STEP: Best practices

Once they have decided what to protect, these are some important considerations for SME's:

ACTIONS	DESCRIPTION
Clearance searches/ Prior art searches	<ul style="list-style-type: none"> Identify art that may bar patentability and that may present an infringement risk Identify Marks currently in use and potential infringement risk. Confirm that Marks are available for registration
Actively protect the IP	<ul style="list-style-type: none"> Seek a patent for new inventions or improved inventions Register your business/company name and your brand name/logo as a Trade mark Seek design protection for the aesthetics of your product (protect its looks)
Where to protect	<ul style="list-style-type: none"> IP rights are territorial Which jurisdictions are the main markets Are there plans for expansion into other markets
Domain names	Check availability and secure the .com if at all possible
Unregistered IP	Copyright and unregistered design rights can be protected without registration
Keep information confidential	Non-disclosure agreements
Monitor your IP	Check if others are infringing your IP assets.

Notes for checklist users

IP rights are about exclusivity so it is important to identify which part about the product or concept that the SME wishes to keep their competitors from using.

A patent is used to protect inventions which are unique. A grant of patent essentially gives its owner the right to exclude others from practicing their invention for a period of time. When deciding if they should apply for a patent, SME's should look at the invention and



consider the risks of not patenting it against the costs of doing so. Before applying for a patent, comprehensive searches should be conducted on existing patent information. They can then determine if the invention is novel and inventive ('prior-art' or novelty search), whether it is eligible for patent protection (patentability search) and whether it infringes on another party's patent (freedom to operate search).

Brand names are a source identifier and for that reason, businesses should take steps to prevent competitors from using these by way of trade mark registration. Before investing time and money in building up a business under a particular name, SME's (and in particular start-ups) should appreciate that it is imperative to check that their preferred name isn't already taken. Ideally, a search should be conducted for trade marks that are in use, both registered and unregistered, and a check for logos is equally important. This will help avoid unnecessary conflict with any pre-existing rights. Ideally, before deciding on their brand name (trade mark), business owners should

check if the corresponding domain name is available. It would be sensible to check for and register variants of the chosen domain name. This could assist in avoiding some common domain name and trade mark conflicts. Trade mark registration will help SME's to secure their rights and protect their assets from misuse.

If it is the look or appearance of the product or packaging that the business is seeking to protect, then they should consider seeking design registration. This gives the owner a monopoly right for the appearance of the whole or part of a product, resulting particularly from the lines, contours, colours, shape, texture and materials of a product or its ornamentation.

Certain rights arise automatically, for example, copyright and unregistered design rights. As there is no registration process for these rights, proof of ownership can be difficult. For such rights, it is good practice to keep documented evidence about the creation of the work to prevent possible conflict in the future.

In some instances, it is vital not to disclose information about any new ideas or inventions before applying for protection. This is particularly important when it comes to patents, as disclosure can make the application invalid. It is important for SME's to consider different ways of securing confidential information and the most obvious method is through a non-disclosure agreement. Finally, once the business has secured IP protection, it is important to be constantly vigilant in the marketplace to ensure

that their competitive edge is not being encroached upon. Any infringement of IP rights should be immediately acted upon. SME's are responsible for enforcing their own IP rights and should make sure no one else is using these rights without their express authorisation. IP serves not only as a protection granted to secure one's creative and inventive rights, but it also helps the owner to monetise from or commercialise their inventions and creative works.



Sumi Nadarajah is involved in the full spectrum of IP law and protection, Sumi counsels foreign and domestic clients in the selection, clearance, prosecution and monitoring of Irish, UK and EU Trade Marks. She coordinates the worldwide IP portfolios of a number of leading Irish companies and also represents the trade mark interests of a broad range of SMEs and private individuals, specialising in the food and beverage, FMCG and packaging sectors. Sumi has significant experience in domain name matters with expertise in UDRP proceedings before WIPO.

Originally hailing from Malaysia, Sumi joined FRKelly in 2005 after several years with a leading Dublin law firm. She was admitted to the Bar in England and Wales in 1997 and the Malayan Bar in 1998 and is now a non-practising member of both associations. Sumi was entered on the Roll of Solicitors (England and Wales) in 2003 and qualified as a Trade Mark Attorney in 2005. A contributor to the Irish chapter of *The Manual for the Handling of Applications for Patents, Designs and Trademarks Throughout the World* (Kluwer IP Law), Sumi is also periodically published in *Lexology*, *WIPR* and publications within the retail sector in Ireland. She chaired the Copyright & Designs Committee of the Irish Association of Patents and Trade Mark Attorneys (APTMA) from 2015–2017 and in 2020 was appointed as Treasurer of this Association.

FRKELLY

For more information please contact:
+353 1 231 4822 | s.nadarajah@frkelly.com